"It's Third and Eight!" The Third Circuit Adopts an Eight Factor Test For Likelihood of Confusion in False Endorsement Claims in Facenda v. N.F.L. Films

Justin Kerner, Villanova University School of Law
“It’s Third and Eight!”: The Third Circuit Adopts an Eight-Factor Test for Likelihood of Confusion in False Endorsement Cases and Flags Related Defenses in *Facenda v. NFL Films*

by

JUSTIN KERNER*

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* J.D. candidate, Villanova University School of Law (2010); B.S. in Business, The College of New Jersey (2002). I would like to thank my wife, Dawn Kerner—her unwavering love and support are a daily inspiration.
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The Autumn Wind is a Raider
Pillaging just for fun
He’ll knock you ‘round and upside down
And laugh when he’s conquered and won.¹

I. Introduction

To many, John Facenda was the voice of Philadelphia news;² to others, he was the “Voice of God.”³ Facenda was a Philadelphia news and television broadcaster between the 1940s and 1970s, but earned national fame after joining the NFL Films team.⁴ As an NFL Films employee, Facenda narrated nationally broadcast highlight films and quickly earned the nickname “voice of God” because of his


This case brief concludes that plaintiffs raid like the Autumn Wind. It explores the Third Circuit’s analysis and discusses plaintiffs’ “home field advantage” when raising false endorsement claims under Section 43(a)(1)(A) of the Lanham Act.


4. John Facenda – Biography, supra note 2 (detailing how Facenda secured his position with NFL films and noting that “his rich, dramatic voice [was] a perfect complement to the long passes, thrilling runs and violent line play.”). Interestingly, Facenda fell into his career with NFL Films after accidental meeting with company founder Ed Sabol. Id.
deep-voiced, methodical, and passionate readings. His voice was and remains synonymous with the NFL.

Because of his widespread following, NFL Films had Facenda sign a release shortly before his death authorizing the company to use his audio sequences for any purpose other than endorsement. Nevertheless, in *Facenda v. NFL Films, Inc.*, John Facenda Jr.—on behalf of his father’s estate—sued NFL Films and related parties for false endorsement under the Lanham Act. NFL Films had used a small portion of Facenda’s earlier voice-over work in a television program promoting the popular video game “Madden NFL 06.” The estate claimed that NFL Films’ use of Facenda’s voice constituted a false endorsement of the video game. On cross-motions for summary judgment, the district court found the use of Facenda’s

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5. *Lost Treasures of NFL Films: NFL Films Style* (ESPN Classic television broadcast Dec. 12, 2002) (summary available at http://www.tv.com/lost-treasures-of-nfl-films/nfl-films-style/episode/307742/summary.html?tag=ep_guide;summary.html) (noting Facenda’s gift for narration). Steve Sabol, son of NFL Films founder Ed Sabol, once commented that Facenda “may have made a game seem more important than it was because he read the lines with a dramatic directness.” Id. Magistrate Judge Hart, in the district court opinion in this case, noted that “although John Facenda is not a ‘legend’ in the same category as, say, Hercules, or John Henry, Plaintiff has shown that he was, and remains, a very popular figure among football fans; that he was strongly associated with NFL [sic] Films.” *Facenda v. NFL Films* (*Facenda I*), 488 F. Supp. 2d 491, 495 (E.D. Pa. 2007).


7. *Facenda I*, 488 F. Supp. 2d at 495 (noting that before Facenda’s death in 1984, he signed release which gave NFL Films “unequivocal” rights to his previously recorded audio works “in perpetuity and by whatever media or manner NFL [sic] Films, Inc., sees fit, provided, however, such use does not constitute an endorsement of any product or service.”).

8. Id. at 493. Facenda’s original complaint also included charges of invasion of privacy under Pennsylvania common law and “right of publicity” under 42 Pa. Cons. Stat. § 8316 (2008). Nevertheless, this casebrief addresses only the false endorsement claim and related defenses.

9. Id. at 495. The popularity of the John Madden video game series is best demonstrated by its longevity; in 2008, Madden celebrated the twentieth anniversary of the game’s original release and the release of the twentieth version (update) of the series. Mike Snider, *As John Madden would say, ‘Boom!’ His NFL game turns 20*, USA TODAY, Aug. 6, 2008 at 01D, available at http://www.usatoday.com/tech/gaming/2008-08-05-madden-game-main_N.htm (noting that, since 2005, game series has been among top game franchises each year and has grossed over $2.4 billion); see also ESPN.com, *Madden Nation 4*, http://sports.espn.go.com/videogames/news/story?id=3047668 (last visited Aug. 27, 2009) (chronicling fourth season of television show “Madden Nation 4,” which tracks men who compete in “Madden” video game showdown).

voice to be in violation on the Lanham Act.\textsuperscript{11} NFL Films appealed, arguing that the estate failed to meet its burden of proof and, alternatively, that the Lanham Act presented an unconstitutional restriction on commercial speech.\textsuperscript{12} While the Third Circuit rejected both arguments, it vacated the summary judgment and remanded the case on other grounds.\textsuperscript{13}

This case brief identifies the Third Circuit’s analysis in false endorsement cases and serves as a guide for practitioners bringing or defending such claims. Part II of this case brief presents an overview of trademark law, the history and need for the Lanham Act in governing false endorsement claims, and the case precedent which informed the Third Circuit’s \textit{Facenda} opinion. Part III discusses the Third Circuit’s newly adopted eight factor test for likelihood of confusion in false endorsement cases, and the methodology and analysis that Third Circuit courts will use when defendants raise First Amendment defenses. Finally, Part IV discusses approaches that practitioners may use in trying such cases.

\textbf{A. Learning the Game, Play by Play: Basic Terminology, Relevant Precedent, and Defenses Against Lanham Act Claims}

Although the nation’s founders foresaw the need to protect some intellectual property—namely, patents and copyrights—they did not foresee a need to protect trademarks.\textsuperscript{14} As a result, states freely enacted their own trademark laws and state courts were bound by such legislation.\textsuperscript{15} Federal courts, on the other hand, relied upon the federal common law in their review of trademark cases because Congress had abstained from enacting federal trademark laws.\textsuperscript{16}

\begin{itemize}
\item \textsuperscript{11} Id. at 493.
\item \textsuperscript{12} \textit{Facenda v. NFL Films, Inc. (Facenda II)}, 542 F.3d 1007, 1014–15 (3d Cir. 2008).
\item \textsuperscript{13} Id. at 1033.
\item \textsuperscript{14} See U.S. CONST. art. 1, §8 (“The Congress shall have power . . . [t]o promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive right to their respective writings and discoveries.”); \textsc{Arthur H. Seidel, et al., what the general practitioner should know about trademarks and copyright law} 1 (6th ed. 1992) (noting founders’ failure to provide for trademark protections in U.S. constitution).
\item \textsuperscript{16} \textit{See generally Swift v. Tyson}, 41 U.S. 1 (1842) (recognizing federal court’s power to rely on substantive federal common law in diversity actions). However, in \textit{Erie R.R. Co. v. Tompkins}, 304 U.S. 64 (1938), the Supreme Court struck down the notion of federal common law, overturning the \textit{Swift} doctrine. 32 AM. JUR. 2D \textit{Federal Courts} § 372 (2008).
\end{itemize}
Congress' first attempts to enact trademark laws were overturned as unconstitutional.\footnote{Connecticut Legal Information Portal: CLIP Guides, Trademark Law, at 3, http://www.law.uconn.edu/system/files/private/trademark_0.pdf (last visited Feb. 10, 2009). Subsequent trademark laws were passed in the late nineteenth and early twentieth century but were limited in scope. Id. For a compilation of the proposed bills and Congressional reports for trademark law between 1925 and the 1988 amendment to the Lanham Act, refer to the Franklin Pierce Law Center: IP Mall, Legislative IP Acts/History Archive: Trademark, http://ipmall.info/hosted_resources/lipa/lipa_trademarks_index.asp (last visited Feb. 16, 2009) (providing links to trademark legislation documentation).}

Following the Supreme Court's landmark decision in \textit{Erie Railroad Co. v. Tompkins},\footnote{304 U.S. 64 (1938).} Congress changed the rules of the game.\footnote{MCKENNEY & LONG III, supra note 15, at § 1:2 (citing H.R. Rep. No. 944, 76th Cong., 1st Sess. 4 (1939)) (noting that Committee on Trademarks and Patents called for creation of federal trademark statute after \textit{Erie}). The Committee recognized that a national economy required uniform trademark laws, holding that, "[i]t would seem as if national legislation along national lines securing to the owners of trademarks in interstate commerce definite rights should be enacted and should be enacted now." \textit{Id.}} Congress signed the Lanham Act into law in 1946, breathing new life into the federal government's power to regulate trademarks and related issues.\footnote{See Ethan Horwitz and Benjamin Levi, \textit{Fifty Years of the Lanham Act: A Retrospective of Section 43(a)}, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 59, 60–64 (1996).} Congressional authority to regulate trademarks stemmed from the authority to regulate interstate commerce.\footnote{See SEIDEL, ET AL., supra note 14, at 2 (6th ed. 1992) (noting that federal trademark laws are based upon Constitution's interstate commerce clause). As Seidel notes, "since its passage in 1946, Section 43(a) of the Lanham Act has played an increasingly pivotal role in the resolution of trademark and unfair competition claims adjudicated in the federal courts." \textit{Id.} at 3.}

Today, Section 43(a) of the Lanham Act provides broad protections against trademark infringement, false endorsement or advertising, and unfair competition.\footnote{15 U.S.C. § 1125(a) (2008). Claims arising under Section 43 fall under the general heading of "Unfair Competition." See generally McKenney & Long III, supra note 15 (detailing various kinds of Section 43 claims, and elements of and precedent for each). For a description of Section 43 as it pertains to false endorsement, see infra notes 30–48 and related text.} To better understand the protections offered by the Lanham Act, and the elements required to successfully pursue a false endorsement claim, one must understand what trademarks are and why the Lanham Act is necessary. This section, in turn, offers a definition of trademarks, explains trademark law and The Lanham Act, and provides guidance as to relevant federal case precedent.
1. Before You Memorize the Playbook, You Separate Xs From Os: A Definition of Trademarks

A trademark is “any word, name, symbol or device adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured and sold by others.”

The terms “symbol” and “device” should be broadly interpreted.

Justice Frankfurter observed in Mishawaka Manufacturing Co. v. Kresge Co.:

The protection of trade-marks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon

23. See MCKENNEY & LONG III, supra note 15, at § 3:2 (citations omitted) (providing traditional definition of trademarks). By comparison, the U.S. Patent and Trademark Office defines trademarks as “a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others” and distinguishes them from service marks. U.S. Patent and Trademark Office, “Trademark, copyright or patent?”, http://www.uspto.gov/go/tac/doc/basic/trade_defin.htm (last visited Feb. 16, 2009).

24. See Mishawaka Rubber & Woolen Mfg. Co. v. Kresge Co., 316 U.S. 203, 205 (1942) (recognizing trademarks as symbols by which manufacturers and merchants communicate value or other characteristics of products and services); Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1106–07 (9th Cir. 1992) (recognizing broad judicial interpretation of terms name, symbol, and device); Q-Tips, Inc. v. Johnson & Johnson, 206 F.2d 144, 145–46 (3d Cir. 1953) (defining trademarks). In Q-Tips, the Third Circuit gave a broader definition, stating that a trademark is

any mark, word, letter, number, design, picture or combination thereof in any form of arrangement, which (a) is adopted and used by a person to denominate goods which he markets, and (b) is affixed to the goods, and (c) is not . . . a common or generic name for the goods or a picture of them, or a geographical, personal, or corporate or other association name, or a designation descriptive of the goods or of their quality, ingredients, properties or functions.

Id.
which it appears. Once this is attained, the trademark owner has something of value. 25

So long as a mark, symbol, or device is strongly associated with a particular product, it will be recognized and treated as a trademark. 26

The protections offered by trademark law are extended to both the owner of the trademark and to consumers. 27 To determine the scope of a trademark—that is, how great the protections afforded should be—courts must determine the likelihood of confusion between the trademark at issue and the trademark from another company or person. 28 As one court explained, “[t]here is no litmus rule which can provide a ready guide to all cases.” 29

2. History of, and Need for, the Lanham Act

a. History of the Lanham Act

Congress passed the Lanham Act in 1946 to modernize trademark laws to keep pace with modern business practice. 30 Further, Congress intended to provide a bar against unfair competition and, accordingly, wrote the Lanham Act to: “(1) allow customers to identify a product’s manufacturer or sponsor, and (2) enable producers to differentiate

25. 316 U.S. at 205 (emphasis added).

26. See McKenney & Long, supra note 15, at § 3:2 (demonstrating that strength of association between marks or symbols, and related products or services, determines scope of trademark protection).

27. See Malletier v. Dooney & Burke, Inc., 561 F. Supp. 2d 368, 384 (S.D.N.Y. 2008) (observing that trademark infringements have adverse effects on both owner of trademark and confused consumers); see also Joshua Beser, False Endorsement or First Amendment?: An Analysis of Celebrity Trademark Rights and Artistic Expression, 41 San Diego L. Rev. 1787, 1792–93 (2004) (discussing importance of titles within entertainment industry). Beser explained, “[t]itles have two purposes: to catch the eye and to promote the value of the underlying work. Ordinary trademark infringement requires labels to refrain from misleading or confusing the public as to the good’s source. Consumers are protected insofar as they can identify what they buy.” Id.

28. J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition § 24:6 (4th ed. 2009) (defining scope of trademarks by noting that likelihood of confusion “encompasses any type of confusion, including: confusion of source; confusion of sponsorship; confusion of affiliation; or confusion of connection.”). Courts may further extend the scope of trademarks to cover the mark and any reputation or goodwill associated with it. See Nermien Al-All, Comprehensive Intellectual Capital Management 271 (2003).


30. See McKenney & Long III, supra note 15, at § 1:2 (quoting Vidal Sassoon, Inc. v. Bristol-Meyers Co., 661 F.2d 272, 276 (2d Cir. 1981)).
the[ir] product[s and services] from others [available for purchase].”  

Congress thus protected both registered and unregistered trademarks.  

Soon after the Lanham Act’s passage, federal courts recognized the need for more expansive protections than those found within the Act.  Accordingly, courts expanded their reading of the text of Section 43(a), generally, and 43(a)(1)(A), specifically, to offer greater trademark protection. In the forty-two years between the Act’s inception and its amendment, federal courts expanded the list of wrongs cognizable under Section 43. The federal judiciary consistently read more power into the Lanham Act than existed in its text.  

Accordingly, Congress amended the Act in 1988. Justice Stevens commented that the amendment recognized and codified...
federal case law. Further, Justice Stevens noted with approval that the federal courts and the 1988 amendment gave plaintiffs greater protection under the Lanham Act than previously existed.

Commentators have also recognized that the revised Section 43(a)(1)(A) explicitly provided protections for wrongs that earlier federal courts had read into the Act. In pertinent part, Section 43 of the revised Act reads:

(1) Any person who, on or in connection with any goods or services... uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities... shall be liable...

Accordingly, Section 43(a) covers a wide range of unfair competition claims, including, but not limited to, false endorsement.

b. Applying the Act

Since Congress passed the 1988 amendment to the Lanham Act, false endorsement cases have become more prominent. Recent

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38. Two Pesos, 505 U.S. at 784 n.18 (Stevens, J., concurring). Justice Stevens noted that Congress gave “its imprimatur to a growing body of case law from the Circuits that had expanded the section beyond its original language.” Id. at 783 (Stevens, J., concurring). Although Two Pesos was decided in 1992, the case was raised based on events that occurred before the 1988 amendment to the act. Id. at 776 (majority opinion). Accordingly, the Court applied the pre-amendment law, as interpreted by the Federal Courts. Id. at 766 nn.2–4.

39. Id. at 781 (Stevens, J., concurring) (“Even though the lower courts’ expansion of the categories contained in 43(a) is unsupported by the text of the Act, I am persuaded that it is consistent with the general purposes of the Act.”).

40. McKENNEY & LONG III, supra note 15, at § 1:3 (noting that 1988 changes to Lanham Act “sought to codify...the case law arising under Section 43(a)” and “expressly extend[ed] protection to claims not previously actionable.”).


42. See id.; McKENNEY & LONG III, supra note 15, at § 7:1–13 (discussing celebrities and media personnel in context of trademark claims, most notably false endorsement).

43. See SEIDEL, ET AL., supra note 14, at 3 (discussing importance of Lanham Act, generally, and increased importance of Act since 1988 amendments created an environment where “Section 43(a) now specifically applies to misleading and literally false advertising...”).
false endorsement cases have been brought by celebrities, deceased celebrities’ estates, and the owners of fictional characters.\textsuperscript{44} Such lawsuits often involved a physical likeness of a celebrity or parody thereof.\textsuperscript{45} Others involved aural likenesses.\textsuperscript{46}

\begin{quote}
44. See, e.g., Parks v. LaFace Records, 329 F.3d 437, 463 (6th Cir. 2003) (resolving issue whether popular rappers “OutKast” infringed Rosa Parks’ trademark or likeness by naming song “Rosa Parks”); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1396 (9th Cir. 1992) (finding genuine issue of material fact whether advertiser’s use of robot dressed to look like Vanna White was either trademark infringement or false endorsement); Seale v. Grammercy Pictures, 964 F. Supp. 918, 931 (E.D. Pa. 1997) (determining that use of well-known Black Panther’s likeness was not false advertising). For a more thorough list and explanation of such cases, refer to McKENNEY & LONG III, supra note 15, at § 7:2. Such cases often involve only some aspect of the celebrity’s likeness. See, e.g., White, 971 F.2d at 1396 (acknowledging trademark as model’s physical likeness in specific context of game show set).

For examples and discussion of cases dealing with deceased celebrities, see, e.g., Elvis Presley Enters., Inc. v. Capeci, 141 F.3d 188, 191 (5th Cir. 1998); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981). As it relates to the power of a deceased celebrity’s estate to bring suit where another party uses the celebrity’s likeness without permission, the Russen court noted, “the right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for their commercial benefit.” 513 F. Supp. at 1353. See also Cairns v. Franklin Mint Co., 107 F. Supp. 2d 1212, 1223 (C.D. Cal. 2000) (resolving trademark issues after Franklin Mint Co. used Princess Diana’s likeness, after her death and without her estate’s permission, on set of commercial commemorative plates).

Finally, for examples and discussion of cases dealing with fictional celebrities and characters, see generally HIT Entm’t, Inc. v. Nat’l Discount Costume Co., Inc., 552 F. Supp. 2d 1099 (S.D. Cal. 2008) (resolving dispute between owners of intellectual property in popular children’s television characters, including “Bob the Builder,” “Barney the Dinosaur,” and “Thomas the Tank Engine,” and costume supplier who sold costumes of these characters); Marvel Enters., Inc. v. NCSOFT Corp., 74 U.S.P.Q.2d 1303 (C.D. Cal. 2005) (resolving dispute between owner of comic book character “Captain America” and possible trademark infringer); Sony Pictures Entm’t, Inc. v. Fireworks Entm’t Group, Inc., 156 F. Supp. 2d 1148 (C.D. Cal. 2001) (resolving trade dress dispute related to Zorro). Those defending such trademark actions may have a more difficult case than attorneys defending actions involving actual celebrities, because fictionalized characters often represent the entirety of a trademark, whereas an actual celebrity’s trademark is often limited to select attributes (e.g., a model’s stance). Compare HIT Entm’t, 552 F. Supp. 2d at 1101–02 (recognizing plaintiffs’ trademarks in entirety of “Bob the Builder” and other characters), with White, 971 F.2d at 1396 (acknowledging trademark as model’s physical likeness in specific context of game show set).

45. See White, 971 F.2d at 1396 (comparing Vanna White and robot made to look like Vanna White); Groucho Marx Prods., Inc. v. Day and Night Co., Inc., 689 F.2d 317 (2d Cir. 1982). Although decided before Congress passed the 1988 Lanham Act amendment, Groucho Marx still serves as a valid example of a parody.

46. See Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (determining that voice may be protectable as it is attributable to specific celebrity). Although Bette Midler’s action against Ford was successful, Midler did not raise her claim under Section 43(a) of the Lanham Act. See generally id. The last paragraph of the Ninth Circuit’s opinion, however, remains instructive:
\end{quote}
The Third Circuit has articulated that plaintiffs who raise false endorsement claims under Section 43(a)(1)(A) of the Lanham Act must demonstrate that: (1) the plaintiff’s mark is legally protectable; (2) the plaintiff owns the mark; and (3) the defendant’s use of the mark to identify the defendant’s own goods or services will likely create (or has likely created) confusion as to the plaintiff’s endorsement or sponsorship of the defendant’s goods or services. Several circuits have clearly stated that the third element, likelihood of confusion, must be determined on a case-by-case basis.

For example, the Ninth Circuit, in *Downing v. Abercrombie & Fitch*, articulated a list of factors to consider for likelihood of confusion in false endorsement cases. Leading up to *Facenda*, however, the

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We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort . . . .

*Id.* at 463. In this respect, *Midler* accords with other voice-emulation decisions and traditional false endorsement claims stemming from use of physical likeness. See *McKenney & Long III*, supra note 15, at § 7.3, nn.2–5 (citing Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970); Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962)) (discussing voice emulation in context of Section 43(a) celebrity likeness and false endorsement claims).

47. *Facenda II*, 542 F.3d 1007, 1014 (3d Cir. 2008).
48. *See, e.g.*, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 1314–15 (Fed. Cir. 2003). As the court explained:

We determine likelihood of confusion by focusing on the question whether the purchasing public would mistakenly assume that the applicant’s goods originate from the same source as, or are associated with, the goods in the cited registrations. We make that determination on a case-by-case basis . . . .

*Id.*

49. 265 F.3d 994, 1007–08 (9th Cir. 2001). Those factors are:

1. the level of recognition that the plaintiff has among the segment of society for whom the defendant’s product is intended;
2. the relatedness of the fame or success of the plaintiff to the defendant’s product;
3. the similarity of the likeness used by the defendant to the actual plaintiff;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;
7. defendant’s intent on selecting the plaintiff; and
8. likelihood of expansion of the product lines.
Third Circuit had not articulated such a ready set of factors\textsuperscript{50} to determine whether likelihood of confusion was met.\textsuperscript{51} Instead, the Third Circuit had only outlined factors for consideration under the broader heading of Section 43(a) claims.

Generally, Third Circuit courts have recognized that claimants under Section 43(a)(1)(A) must demonstrate only a likelihood of confusion, whereas claimants under Section 43(a)(1)(B) must demonstrate actual confusion.\textsuperscript{52} One district court opinion, however, required proof of actual confusion in order to successfully bring a claim under Section 43(a)(1)(A).\textsuperscript{53} This disparity between the courts creates room for parties to argue that, under 43(a)(1)(A), the plaintiff must show evidence of actual confusion.\textsuperscript{54} This may be problematic

Although these are all factors that are appropriate for consideration in determining the likelihood of confusion, they are not necessarily of equal importance, nor do they necessarily apply to every case.

\textit{Id.}

\textsuperscript{50} See Interpace Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir. 1983). Under the Third Circuit test, the factors to consider when determining likelihood of confusion are:

1. the degree of similarity between the owner’s mark and the alleged infringing mark;
2. the strength of the owner’s mark;
3. the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
4. the length of time the defendant has used the mark without evidence of actual confusion arising;
5. the intent of the defendant in adopting the mark;
6. the evidence of actual confusion;
7. whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media;
8. the extent to which the targets of the parties’ sales efforts are the same;
9. the relationship of the goods in the minds of consumers because of the similarity of function;
10. other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant’s market, or that he is likely to expand into that market.

\textit{Id.}

\textsuperscript{51} See \textit{Facenda II}, 542 F.3d at 1019–20 (outlining factors to consider generally for Section 43(a) claims, recognizing that such factors do not function adequately in context of false endorsement claims, and outlining new list of factors to consider when examining false endorsement claims). Generally, the Third Circuit had applied the \textit{Lapp} factors to claims arising under Section 43(a). \textit{Id.} at 1019. Nevertheless, the court had not had an opportunity until \textit{Facenda} to announce a test specific to false endorsement claims. See \textit{id.} (noting question presented to court and district court’s resolution of same).

\textsuperscript{52} See, e.g., Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466, 473 & n.8 (3d Cir. 1994).


\textsuperscript{54} See, e.g., \textit{Facenda II}, 542 F.3d at 1022 (demonstrating that defendants might rely on \textit{Seale} holding to require plaintiffs to bring proof of actual evidence to court). For further discussion of the discrepancy created by the \textit{Seale} opinion and the need for proof of actual confusion (or lack thereof), see \textit{infra} notes 118–20 and related text.
for plaintiffs, because proving actual confusion—most often through survey evidence—involves a lengthy and very expensive process.  

3. A Good Defendant Is the Best Offense: Using the First Amendment to Defend Claims Raised Under Section 43(a)(1)(A) of the Lanham Act

The First Amendment guarantees American citizens the right to speech free from government interference. Accordingly, defendants have used the First Amendment to defend against false endorsement cases raised under the Lanham Act by claiming that the Act is effectually government interference with free speech. This section identifies relevant Supreme Court precedent for such defenses, and explains the protections offered to different kinds of speech.

Before 1975, commercial speech—speech which invites participation in a commercial transaction—was offered little protection under the First Amendment. In 1975, however, commercial speech garnered greater protections from the Supreme Court in *Bigelow v. Virginia* and *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.* In these cases, the Court held that speech that only proposes a commercial transaction—

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56. U.S. CONST. amend. I. (“Congress shall make no law . . . abridging the freedom of speech”). For First Amendment primers, see generally JOHN H. GARVEY AND FREDERICK SCHAUER, THE FIRST AMENDMENT: A READER (1996); THOMAS L. TEDFORD AND DALE A. HERBECK, FREEDOM OF SPEECH IN THE UNITED STATES (5th ed. 2005). Nevertheless, the Supreme Court recognized that the government may regulate or ban certain types of speech. See, e.g., Chaplinsky v. State of N.H., 315 U.S. 568, 571–72 (1942) (stating that “the right of free speech is not absolute at all times and under all circumstances,” and noting that “fighting words” are exempt from general rule); R.A.V. v. City of St. Paul, 505 U.S. 377, 382–83 (1992) (noting that government may regulate areas of speech which are “of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.”).

57. See, e.g., *Facenda II*, 542 F.3d at 1015. For a more in-depth discussion of NFL Film’s First Amendment defense and the court’s treatment and analysis of it, see infra notes 96–115.

58. For discussion of Supreme Court and Third Circuit precedent interpreting commercial speech, and the protections therefore afforded, see infra notes 59–79, and related text.


60. 421 U.S. 809 (1975).

that is, wholly truthful speech that does not invite speculation—should enjoy constitutional protections.  

Still, commercial speech remains subject to greater regulation than other kinds of speech because: (1) advertisers are well equipped to determine the accuracy of their messages before broadcast or print; (2) commercial speech is considered the “offspring of self interest;” and (3) commercial speech, as a whole, is not likely to suffer if subjected to government regulation. For example, because commercial speech relates to specific products or services, the veracity of such speech is more easily verified as it relates to those products or services. Following this rationale, the Court held that the government may also regulate trademarks which arise in commercial speech.

The Supreme Court also created a framework by which to gauge whether speech is commercial (which the government may regulated) or noncommercial (which the government may not regulate). In Ohralik v. Ohio State Bar Ass’n, the Supreme Court stated that it would employ “a common sense approach” to separating commercial speech from other kinds of speech.


64. See Cent. Hudson, 447 U.S. at 563 n.5. (demonstrating why government regulation of commercial speech is per se constitutional).

65. See Friedman v. Rogers, 440 U.S. 1, 15–16 (1979) (holding that prohibition on optometry practice under trade name was constitutionally permissible as regulation of commercial speech).

66. For an explanation of the Supreme Court’s test, see infra notes 67–68 and related text.

67. 436 U.S. 447, 455–56 (1978). Legal Ethics texts often cite Ohralik for the proposition that lawyers may not directly solicit clients. See, e.g., Lisa G. Lerman and Philip G. Schrag, Ethical Problems in the Practice of Law 799–800 (2d ed. 2008). Nevertheless, practitioners may also cite Ohralik for the proposition that courts
Products Corp., the Court more precisely articulated a test for 
commercial speech, which asks whether the communication: (1) was 
an advertisement; (2) referred to specific products or services; and (3) 
was economically motivated. 68  
The Third Circuit adopted the Bolger test in U.S. Healthcare, Inc. 
v. Blue Cross of Greater Philadelphia. 69  In so doing, the circuit court 
noted that an affirmative answer to each question strongly supports 
the conclusion that the speech in question is commercial. 70  Moreover, 
while acknowledging that this test will not control all cases, the circuit 
noted that the “commercial speech doctrine rests heavily on ‘the 
common sense distinction between speech proposing a commercial 
transaction . . . and other varieties of speech.’”  71  
In instances when commercial and noncommercial speech are 
“inextricably intertwined,” the Supreme Court requires courts to 
treat the mixture as noncommercial speech. 72  Not all mixtures, 
however, should be treated as noncommercial. 73  The Court held that 
mixed speech should be treated as commercial speech where 
noncommercial speech was merely injected into either sales calls or 
advertisements. 74  
In the context of false endorsement cases, the Second Circuit 
articulated a test for determining when mixed speech is commercial
or noncommercial in Rogers v. Grimaldi.\footnote{875 F.2d 994, 999 (2d Cir. 1989). The Second Circuit’s Rogers test superseded an earlier Second Circuit ruling. See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979).} \cite{footnote:875}

Actress Ginger Rogers sued the producers and distributors of a film titled “Ginger and Fred,” alleging that the use of her name in the film title was a false endorsement of the film.\footnote{See Rogers, 875 F.2d at 996–97.} \cite{footnote:Rogers}

There, the Second Circuit held that, to determine whether mixed speech is commercial or noncommercial, courts should weigh “the public interest in avoiding consumer confusion” against “the public interest in free expression.”\footnote{Id. at 999 (articulating court’s test for First Amendment limitations on Lanham Act). While finding in favor of those associated with the film, the Second Circuit stated that:}

This construction of the Lanham Act accommodates consumer and artistic interests. It insulates . . . 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.

\cite{footnote:1000}

II. As Madden Says: “Whoa!” An Account of Facenda v. NFL Films and the Third Circuit’s Analysis

John Facenda enjoyed a long career with NFL Films.\footnote{See ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 927–28 (6th Cir. 2003) (adopting Rogers test in Sixth Circuit); Parks v. LaFace Records, 329 F.3d 437, 448–52 (6th Cir. 2003) (same); Mattel, Inc. v. MCA Records, 296 F.3d 894, 902 (9th Cir. 2002) (adopting Rogers test in Ninth Circuit); Sugar Busters LLC v. Brennan, 177 F.3d 258, 269 (5th Cir. 1999) (adopting Rogers test in Fifth Circuit). The Second Circuit ratified its Rogers decision in a notable 1989 case, Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc., 886 F.2d 490, 495 (2d Cir. 1989).} \cite{footnote:332}

Some credit his longevity to the notable characteristics of his voice, others

\cite{footnote:332}
to his work ethic. But many consider him a legend, both in and outside the football community. To that end, NFL Films had Facenda sign a release contract before his death, granting NFL Films the right to use any of Facenda’s prerecorded work for any purpose, “provided [that] such use does not constitute an endorsement of any product or service.

In 2005, NFL Films produced “The Making of Madden NFL 06,” a program about the 2006 update of the popular video game. The twenty-two minute program aired eight times in the three days prior to the game’s retail release. It featured interviews with NFL players, comparisons of video game play to prerecorded NFL sequences, and commentary extolling the realism of many of the game’s elements. Notably, the program included three sentences, which Facenda earlier recorded, lasting a total of thirteen seconds. NFL Films admitted that it used the clips “to underscore the degree to which the videogame authentically recreate[d] the NFL experience.”

Facenda’s estate contended that NFL Films’ use of the sound clips was a false endorsement of the video game and brought suit in the district court. The court subsequently split the case into liability and

81. Facenda II, 542 F.3d at 1011–12 (commenting on Facenda’s notoriety); The Broadcast Pioneers of Philadelphia, supra note 2 (highlighting Facenda’s work ethic). Several NFL Films employees, when deposed, commented that Facenda’s “deep baritone voice” was distinctive, recognizable, and even legendary. Facenda I, 488 F. Supp. 2d 491, 494 (E.D. Pa. 2007).

82. See The Broadcast Pioneers of Philadelphia, supra note 2. Recognition for Facenda’s work and accomplishments stems from all corners of the broadcasting community. See Lost Treasures of NFL Films: NFL Films Style, supra note 5 (noting that Ed Sabol, son of NFL Films founder Steve Sabol, once commented that Facenda “may have made a game seem more important than it was because he read lines with a dramatic directness.”). In fact, the defendant released a video of compiled clips of Facenda’s voice-over work, entitled “The Legendary John Facenda.” Facenda I, 488 F. Supp. 2d at 494 (signifying that defendant recognized plaintiff’s fame).

83. Facenda II, 542 F.3d at 1012. As the court recited, the contract stated that NFL Films enjoyed “the unequivocal rights to use” Facenda’s “audio and visual film sequences,” and that the company held such rights “in perpetuity and by whatever media or manner” it saw fit. Id.

84. Id.

85. Id.

86. Id.

87. Id. The sentences Facenda read were: (1) “Pro Football, the game for the ear and the eye,” (2) “This sport is more than spectacle, it is a game for all seasons,” and (3) “X’s and O’s on the blackboard are translated into aggression on the field.” Id.

88. Id. (demonstrating NFL Films’ defenses to Facenda’s false endorsement claim).

89. Facenda I, 488 F. Supp. 2d 491, 493, 510 (E.D. Pa. 2007). Although this case brief focuses only on Facenda’s false endorsement claim, Facenda also pursued claims under right-of-publicity and invasion of privacy under Pennsylvania common law. Id. at 493.
Following discovery in the liability phase, both parties moved for summary judgment, agreeing that the court could determine liability based on the evidence presented. The district court granted the Facenda estate’s motion for summary judgment on the false endorsement claim, and NFL Films appealed to the Third Circuit Court of Appeals.

Initially, the Third Circuit determined that the estate’s false endorsement claim arose under Section 43(a)(1)(A) of the Lanham Act. It then addressed and flagged NFL Film’s affirmative defense. Finally, the court discussed the elements of false endorsement claims and adopted a new eight-factor test for determining when plaintiffs meet their burden of proof for likelihood of confusion. Subsections A and B, below, set forth the parties’ arguments and the court’s analysis.

A. NFL Films Asserted That Its Production Was Artistic Speech and That the First Amendment Thus Protected It From False Endorsement Challenges

NFL Films argued that “The Making of Madden NFL 06” was a documentary, and thus was artistic, rather than commercial, speech. In support, the company presented several independently produced articles, which contained substantially the same information as NFL Films’ program. It argued that, like those articles, its film only

The District Court properly had jurisdiction under 15 U.S.C. § 1121 because of the false endorsement claim. Facenda II, 542 F.3d at 1013–14. This case brief does not examine the right-of-publicity claim; and Facenda dropped his invasion of Privacy claim.

90. Facenda II, 542 F.3d at 1013.
91. Id.
92. Id. at 1012–13.
93. Id. at 1014.
94. Id. at 1015–18 (detailing NFL Films’ claim and court’s treatment of same).
95. Id. at 1018–22.
96. Facenda II, 542 F.3d at 1016–17.
97. Facenda I, 488 F. Supp. 2d at 496 (referencing objective articles and critiques of game published by L.A. TIMES, COLUMBUS POST-DISPATCH, and WALL STREET JOURNAL). The L.A. Times article, for example, detailed the accurate game play and cited interviews with NFL players such as Jerome Bettis. See Sam Farmer, Madden Obsession Turns NFL Pros into Real Gamers, L.A. TIMES, Dec. 24, 2005, at A1, available at http://articles.latimes.com/2005/dec/24/sports/sp-madden24 (explaining technical aspects and accuracy of game). These articles, however, also noted flaws in the game. See Nick Chordas, Mad about “Madden,” COLUMBUS POST-DISPATCH, Aug. 21, 2006 (criticizing manufacturer because price of game did not reflect minimal effort put forth to update game each year).
served to inform the public about the game. The company further contended that, even if the program contained instances of commercial speech, the program as a whole was noncommercial. NFL Films finally argued that, because the program was artistic speech, application of the *Rogers* test demonstrated that the public’s interest in free expression outweighed its interest in avoiding consumer confusion.

Facenda’s estate demonstrated that the NFL Films program was commercial. The estate produced evidence, which showed that NFL Films enjoyed a contractual relationship with EA Sports, the creator of the John Madden Football video games. The relationship was such that NFL Films’ parent company agreed to provide “media, promotional and marketing support” for the video game. The estate argued that NFL Films engaged in this contract because it earned incrementally more money for each copy of the video game sold. The estate further contended that the NFL Films’ program was thus commercial speech.

The Third Circuit agreed with Facenda’s estate and noted that precedent outlined a three-part test to determine whether speech was commercial or non-commercial. The test asked whether the speech:

1. was an advertisement;
2. referred to a specific product; and
3. was economically motivated.

The court further noted that “an

98. *Facenda I*, 488 F. Supp. 2d at 496 (demonstrating that several objective authors produced magazine or newspaper articles that reviewed essentially same material as NFL Films' video).

99. *Facenda II*, 542 F.3d at 1015–17 (noting NFL Films' argument that, if program was not wholly artistic, it must be treated as such because commercial and non-commercial aspects were inextricably intertwined). The company's argument follows the Supreme Court’s discussion of “inextricably intertwined” commercial and non-commercial speech, discussed in notes 75–79, *supra*, and related text.

100. For a full explanation of the *Rogers* test, see *supra* notes 75–79 and related text.

101. *Facenda II*, 542 F.3d at 1015.


103. *Id.* at 496 (noting financial incentive for NFL Films’ work on program). The parties did not disclose the details of the financial relationship between NFL Films and EA Sports. *Id.* (noting that, due to bifurcation of trial into liability and damages phases, this information was not relevant in discovery). Nevertheless, the record clarified that the NFL and related parties profited from increased sales of “Madden NFL 06.” *Id.* (noting that EA Sports paid royalties to NFL for rights to use intellectual property).

104. *Id.*

105. *Id.* (noting royalty arrangement).

106. *Facenda II*, 542 F.3d at 1017 (“The estate contends that the program is commercial speech . . . ”).

107. *Id.* (“. . . and we agree.”).

108. *Id.*
affirmative answer to all three questions provides ‘strong support’ for the conclusion that the speech is commercial.”

The court considered the first question a novel issue because the “Madden NFL 06” program was not a traditional 30 or 60 second advertisement. The court thus engaged in what it referred to as a “commonsense [sic] distinction between speech proposing a commercial transaction . . . and other varieties of speech.” In analyzing the issue, the court determined that the program was, at its core, an infomercial: it focused on one product and it was repeatedly broadcast only in the days immediately before the game’s release.

The court also determined that the program referred to a specific product and that NFL Films had economic motivation for the speech, thus satisfying the latter two factors. The program only referred to one product, and NFL Films had clear economic motivation for the program’s creation and airing. Thus, the court labeled the program commercial speech.

**B. The Third Circuit Hears Facenda’s False Endorsement Claim Against NFL Films**

Having set aside the affirmative defense, the court determined that, to successfully bring an action for false endorsement under Section 43(a)(1)(A) of the Lanham Act, the estate had to prove that: (1) its mark (Facenda’s voice) was legally protectable; (2) it owned the mark; and (3) NFL Films’ use of the mark to identify goods or services was likely to create confusion concerning Facenda’s sponsorship or approval of those services.

Noting that NFL Films did not deny that Facenda’s voice was a protectable mark, nor that

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109. *Id.* (quoting U.S. Healthcare, Inc. v. Blue Cross of Greater Phila., 898 F.2d 914, 933 (3d Cir. 1990)). Any combination of these factors may be determinative, as courts must examine facts and apply the factors on a case-by-case basis.

110. *Facenda II*, 542 F.3d at 1017.

111. *Id.* (quoting In re Orthopedic Bone Screw Prods. Liab. Litig., 193 F.3d 781, 792 (3d Cir. 1999)).

112. *Facenda II*, 542 F.3d at 1017 & n.6 (3d Cir. 2008).

113. *Id.* at 1017.

114. *Id.*

115. *Id.* at 1017–18. After determining that the program constituted commercial speech, the court did not return to its *Rogers* analysis. *Id.* at 1018–20 (sidestepping *Rogers* analysis). This was curious, given that the *Rogers* analysis would have further supported the court’s opinion with respect to its treatment of NFL Film’s First Amendment defense. See *id.* at 1015 (noting that test weighs interest in avoiding consumer confusion, which here is seemingly high, against interest in free expression).

the estate established the first two prongs, the court focused on likelihood of confusion.117

NFL Films argued that, under the Eastern District of Pennsylvania’s analysis in Seale v. Gramercy Pictures, the estate was required to prove actual confusion.118 The circuit court rejected this argument, noting that Seale stood alone in requiring evidence of actual confusion.119 The court further speculated that the holding in Seale was a typographical error because the opinion recited the language of Section 43(a)(1)(A) of the Lanham Act, but stated the standard for claims raised under 43(a)(1)(B).120

Having decided that the estate need only prove a likelihood of confusion rather than actual confusion, the court adopted a new set of factors for likelihood of confusion in false endorsement cases.121 The court recognized that, generally, claims raised under section 43(a)(1)(A) were subject to the ten-factor test outlined in Interpace Corp. v. Lapp for likelihood of confusion.122 It also noted, however, that the Lapp test was designed to compare the marks of competing or non-competing goods and was thus “an uncomfortable fit” in false endorsement cases.123

Thus, the Third Circuit adopted the Ninth Circuit’s test for likelihood of confusion in false endorsement cases, as set forth in Downing, with minor changes.124 Under the Third Circuit’s reasoning, the courts should now consider the following factors when deciding likelihood of confusion for false endorsement claims raised under Section 43(a): (1) the level of recognition that the plaintiff has among the segment of society for whom the defendant’s product is intended; (2) the relatedness of the plaintiff’s fame or success to the defendant’s

117. Facenda II, 542 F.3d at 1014.
118. Id. at 1021–22 (noting NFL Films’ reliance on Seale v. Gramercy Pictures, 964 F. Supp. 918 (E.D. Pa. 1997)). In fact, NFL Films also relied on a series of cases decided under Section 43(a)(1)(B), the false advertising prong of Section 43 of the Lanham Act. Facenda II, 542 F.3d at 1022. Those cases, however, are not controlling.
119. Facenda II, 542 F.3d at 1022.
120. Id.
121. Id. at 1019–20 (setting forth amended Lapp factors for consideration in determining likelihood of confusion in false endorsement cases).
122. Id. (noting the factors laid out in Interpace Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir. 1983)).
123. Facenda II, 542 F.3d at 1019 (“The Lapp factors allow courts to compare the marks of two competing or non-competing goods. But this makes Lapp an uncomfortable fit in a false-endorsement case like this one . . . .”).
124. Id. at 1020 (adopting amended Lapp factors). As discussed supra at notes 50–51 and related text, the Ninth Circuit adopted this approach first. See Downing v. Abercrombie & Fitch, 265 F.3d 994, 1007–08 (9th Cir. 2001) (espousing test).
product; (3) the similarity of the likeness that the defendant used to the actual plaintiff; (4) evidence of actual confusion and the length of time the defendant employed the allegedly infringing work before any evidence of actual confusion arose; (5) marketing channels used; (6) likely degree of purchaser care; (7) the defendant’s intent in selecting the plaintiff; and (8) the likelihood that the product lines will expand. The court carefully noted, however, that these are only factors to be considered and, as such, plaintiffs are not required to show all or even a majority of them to prove their case. Importantly, the court clarified that, while actual confusion may be considered as one of eight factors, plaintiffs need not prove actual confusion in every case.

The court concluded by noting that the question of likelihood of confusion is a genuine issue of material fact. Accordingly, the court held that the district court erroneously issued the summary judgment. The court thus vacated the district court’s grant of summary judgment and remanded the case back to the district court for a decision consistent with the Third Circuit court of appeals’ decision.


126. Id. at 1019 (citing Downing, 265 F.3d at 1008) (noting that factors are not equal, nor does each factor necessarily apply in given case).

127. Facenda II, 524 F.3d at 1019. As the court recited, “no single factor is dispositive.” Id. at 1021.

128. Id. at 1023–24.

129. Id. at 1024. See FED. R. CIV. P. 56 (setting forth standard and procedure for summary judgment).

III. Play Calling from the Sidelines: Analysis of the Court’s Decision and Advice for Practitioners

A. Offensive Play Calling: Advice for Plaintiff’s Counsel

As amended in 1988, Section 43(a) of the Lanham Act allows plaintiffs to bring a wide range of actions, all of which fall under the general umbrella of unfair competition. Specifically, plaintiffs may pursue actions for false endorsement under the amended act, under either subsection (a)(1)(A) or (a)(1)(B). Nevertheless, *Facenda* instructs that plaintiffs enjoy substantial advantages by raising false endorsement claims under subsection (a)(1)(A).

As demonstrated in *Facenda*, Third Circuit plaintiffs must meet the three-prong test for all false endorsement cases. As outlined, plaintiffs must prove that their mark is legally protectable, that they own the mark, and that the defendant’s use of the mark is likely to create consumer confusion. In turn, this section analyzes how plaintiffs should approach Section 43(a) false endorsement claims.

As to the first factor—demonstrating that a plaintiff’s mark is legally protectable—courts have demonstrated a willingness to interpret “marks” and “symbols” rather broadly. While leading trademark law experts note that some courts hesitate to recognize aural work as protectable marks, *Facenda* and its progeny demonstrate that sounds and voices are protectable. After

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131. *See generally* MCKENNEY & LONG III, supra note 15 (reviewing history of, amendment of, and various unfair competition causes of action under Section 43(a) of Lanham Act).


133. For discussion of plaintiffs’ advantages in bringing a false endorsement claim under Section 43(a)(1)(A) rather than Section 43(a)(1)(B) of the Lanham Act, see infra notes 145–52 and related text.

134. *Facenda II*, 542 F.3d at 1014.

135. *Id.*

136. *See Mishawaka Mfg. Co. v. Kresge Co.*, 316 U.S. 203, 205 (1942) (instructing that trademarks are broad symbols which represent businesses, goods, or services); *Facenda II*, 542 F.3d at 1014 (recognizing that courts demonstrate willingness to broadly interpret marks and symbols); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992) (recognizing broad judicial interpretation of terms name, symbol, and device).

137. *See MCKENNEY & LONG III, supra* note 15, at 7:3 (noting that section 43(a) did not protect simulations of celebrity’s voice). Nevertheless, courts have demonstrated a willingness to extend broad trademark protection to aural works. *See Waits*, 978 F.2d at 1106–07 (recognizing judicial willingness to broadly interpret marks and symbols); *see
Facenda, plaintiffs in the Third Circuit enjoy the home field advantage.  

Facenda provides more guidance on the third prong of the test. As discussed above, plaintiffs may bring false endorsement cases under either subsection 43(a)(1)(A) or (a)(1)(B) of the Lanham Act. But plaintiffs enjoy significant advantages by bringing claims under 43(a)(1)(A), rather than (a)(1)(B), as the former requires proof of a likelihood of confusion and the latter requires proof of actual confusion.

Plaintiffs who bring false endorsement claims under Section 43(a)(1)(A) should also recognize that none of the eight factors for likelihood of confusion are determinative. Further, in some cases, some of the eight factors may not apply. Accordingly, plaintiffs should focus their argument on the factors that most strongly prove their case. Each argument presents a colorable question of fact. Plaintiffs thus have an opportunity to advocate for their clients based on the best facts and circumstances available.

B. A Defensive Playbook: Advice for Defense Counsel

The best advice for any defendant is to apply pressure to the offense. Defense counsel should advocate for application of Section 43(a)(1)(B), rather than Section 43(a)(1)(A), thereby forcing

generally Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (demonstrating Ninth Circuit’s willingness to treat established songstress’ voice as trademark); see Facenda II, 542 F.3d at 1014 (demonstrating Third Circuit’s willingness to treat John Facenda’s voice as trademark).

138. For a greater description and explanation of the advantages Third Circuit plaintiffs enjoy after Facenda, see infra notes 139–44 and related text.
139. See Facenda II, 542 F.3d at 1014 (recognizing that opinion focuses on third prong of false endorsement test, likelihood of confusion).
140. For discussion of plaintiffs’ rights to bring false endorsement claims under either Section 43(a)(1)(A) or 43(a)(1)(B) of the Lanham Act, see supra notes 139–41 and related text.
141. Facenda II, 542 F.3d at 1018–22.
142. Id. at 1019–20. As noted in Facenda, although these factors “are appropriate for consideration in determining the likelihood of confusion, they are not necessarily of equal importance, nor do they necessarily apply to every case.” Id. at 1020.
143. Id.
144. Id. at 1024–25 (recognizing that question of likelihood of confusion presents question of material fact).
the plaintiff to provide evidence of actual confusion.\(^{146}\) As
demonstrated in *Facenda*, this strategy may prove more successful
where plaintiffs raise ambiguous complaints.\(^{147}\) Further, should
plaintiff’s counsel raise a false endorsement claim under Section
43(a)(1)(A) of the Lanham Act, defense counsel should first attack
the claim based on the three part test articulated in *Facenda* for all
false endorsement claims, and then on the eight factors espoused to
prove likelihood of confusion.\(^{148}\)

Most defendants, however, are ill-advised to raise a First
Amendment defense to false endorsement claims under either part of
Section 43.\(^{149}\) *Facenda*, and the Supreme Court cases which preceded
it, instruct that the government maintains a valid interest in regulating
commercial speech that may mislead consumers.\(^{150}\) Accordingly, to
press such a defense, counsel must show that the speech in question is
either wholly artistic or, under the *Rogers* test, was created such that
the public interest in free speech outweighs the public interest in
avoiding consumer confusion.\(^{151}\) With *Facenda* as a guide, this
argument will likely not succeed in the Third Circuit.\(^{152}\)

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146. *Facenda II*, 542 F.3d at 1021 (instructing that claims brought under section 43(a)(1)(B) of Lanham Act for misleading advertisements require showing of actual confusion).

147. *Id.* (noting that Third Circuit would not “muddle” case law for Sections 43(a)(1)(A) and (B) where complaint clearly implicated 43(a)(1)(A)).

148. *Id.* (outlining elements and factors court must examine in false endorsement claims raised under Section 43(a)(1)(A) of Lanham Act). As discussed at note 145, *supra*, a defendant’s best argument is often to simply disprove the plaintiff’s case.

149. *Facenda II*, 542 F.3d at 1015–18 (demonstrating relative ineffectiveness of First Amendment attacks on Lanham Act claims). For further discussion of commercial speech classifications and the government’s right to regulate commercial speech, see *supra* notes 59–74 and related text.

150. For an overview of the Supreme Court cases that informed *Facenda*, see *supra* notes 59–74 and related text. For Third Circuit instruction on the same, see *Facenda II*, 542 F.3d at 1014–18 (demonstrating court’s reluctance to allow First Amendment defense to false endorsement claims raised under Lanham Act).

151. For a description of the *Rogers* test, see *supra* notes 75–79 and related text. As applied to *Facenda*, see *Facenda II*, 542 F.3d at 1015–17 (demonstrating that courts pen artistic speech opinions differently). Once the Third Circuit determined that “The Making of Madden NFL 06” was commercial speech, it rejected the defendant’s First Amendment defense. See *id.* at 1017–19 (determining that program was commercial speech and failing to return to *Rogers* analysis). Seemingly, had the opinion rested on artistic speech, the defendant may have won.

152. For an explanation of the Third Circuit’s analysis and advice for defendants in such cases, see *supra* notes 24–26, 40–42, 48–55, 59–79 and related text.
IV. Post-Game Highlights: Reflections on Facenda and Predictions for the Future

Facenda once recited that “the Autumn Wind is a Raider, Pillaging just for fun—He’ll knock you ‘round and upside down and laugh when he’s conquered and won.”153 Similarly, the Third Circuit analysis in Facenda allows plaintiffs to raid, lording superior legal arguments over opposing counsel.154 Facenda provides a playbook for false endorsement claimants and, as any good referee might, flags the defense when it steps over the line.155

153. See Oakland Raiderfans Network, Your Raiders Port-O-Call, supra note 1 (reciting “The Autumn Wind”).

154. For discussion of the plaintiff’s “home field advantage” when raising false endorsement claims under Section 43(a)(1)(A) of the Lanham Act in the Third Circuit, see supra notes 141–57 and related text.

155. For the Third Circuit’s analysis in Facenda, see supra notes 115–40 and related text. See also Sherri Hunter, NFL Called for Unsportsmanlike Conduct in Voiceover Use to Promote Video Game, MEDIA LAW BULLETIN (Sedgwick, Detert, Moran & Arnold, LLP), Dec. 2008, at 1, available at http://www.sdma.com/nfl-called-for-unsportsmanlike-conduct-in-voiceover-use-to-promote-video-game-12-30-2008/ (noting that “Third Circuit threw a penalty flag on the NFL’s play.”).