

# GRAND THEFT ARCHITECTURE: ARCHITECTURAL WORKS IN VIDEO GAMES AFTER *E.S.S.* *ENTERTAINMENT V. ROCKSTAR GAMES*

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## INTRODUCTION

The video game industry has grown to become one of the, if not *the*, largest entertainment industries in the United States.<sup>1</sup> Part of this growth can be attributed to advances in the technology that powers the games industry, which allows games to become increasingly realistic and immersive. In the roughly three decades since the start of the mainstream games industry, the virtual worlds that users can explore and interact with have evolved from simple two-dimensional experiences to massive three-dimensional worlds.

This increased realism allows game developers to create immersive worlds that sometimes mirror their real life counterparts.<sup>2</sup> One of the ways that game developers can create a more engrossing world is to utilize representations of actual buildings to evoke the feel of the cities and environments represented in their games.<sup>3</sup> This technique, however, bears the risk of infringing a copyright or trademark of the real world counterpart.<sup>4</sup> The Ninth Circuit addressed this situation in *E.S.S. Entertainment v. Rockstar Games*<sup>5</sup> and concluded that the virtual building created by the game

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1. Ryan Kim, *Video game announces record revenue*, S.F. CHRON., Jan. 16, 2009, at C1; See also Posting of David Hinkle to Joystiq, *Gaming industry worth \$22 billion in 2008*, <http://www.joystiq.com/2009/01/28/gaming-industry-worth-22-billion-in-2008/> (Jan. 28, 2009 at 9:00 PM) (stating that the video game industry made \$22 billion in revenue in 2008 including a 22.9% increase in software sales over the previous year).

2. See, e.g., Seth Schiesel, *Grand Theft Auto Takes On New York*, N.Y. TIMES, Apr. 28, 2008, at E1 (describing the similarities between *Grand Theft Auto IV* and New York City); Mike Musgrove, *Washington's Role in Fallout 3 – Radioactive*, WASH. POST, Oct. 26, 2008, [http://voices.washingtonpost.com/posttech/2008/10/washingtons\\_role\\_in\\_fallout\\_3.html](http://voices.washingtonpost.com/posttech/2008/10/washingtons_role_in_fallout_3.html) (describing the similarities and differences between the world of *Fallout 3* and Washington D.C.).

3. E.g., Musgrove, *supra* note 2 (“[T]he immediate visual of the Capitol and the Washington Monument and things like that, they tell a story immediately.”).

4. *E.S.S. Entertainment 2000, Inc. v. Rockstar Games, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (involving claims of trademark infringement).

5. *Id.*

developers did not infringe the trademark of the real world counterpart.<sup>6</sup> *Rockstar Games* dealt only with the issue of trademarks in buildings;<sup>7</sup> however, protections for buildings exist under both trademark and copyright law.<sup>8</sup>

Uncertainty with whether a developer can use a building in a virtual world could cause them to avoid accurate representations of buildings in recognizable areas to avoid litigation.<sup>9</sup> This tactic hurts both the game developer's creative freedom and, as a result of decreased immersion, the user experience. This Note will argue that developers can utilize architectural works in games free from the risk of copyright or trademark infringement. It will start with an exploration of trademark and copyright law and cases dealing with protecting architectural works. The Note will then explore *Rockstar Games* and the impact that decision will have on game developers' freedom to utilize easily recognizable architectural works in their games. The Ninth Circuit's decision should allow game developers to freely utilize architecture without fear of resulting liability. The Note further argues that the test for trademark infringement should allow developers to use the actual trademarks of the businesses associated with the buildings in addition to the architecture. The legal protection of buildings must be explained completely to empower game developers to fully utilize recognizable locations, enhancing the immersion of their users, without fear of liability.

## I. BACKGROUND

The use of buildings in virtual worlds implicates both copyright and trademark law. This Part will provide the relevant background to address the issue completely.

### A. VIDEO GAMES

A video game consists of many distinct pieces that come together to create the overall user experience. Video games rely on a hardware component (either a computer or its equivalent) to run the software component, the actual game. The Ninth Circuit described the major components of a video game in *Micro Star v. FormGen, Inc.*<sup>10</sup> involving the game *Duke Nukem 3D*. The court stated that

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6. *Id.* at 1101. For more information about this case and the reasoning, see discussion *infra* Part II.

7. *Id.* at 1098.

8. See discussion *infra* Sections I.B–I.C.

9. And as the *Rockstar Games* case showed, non-exact reproduction is not always an exemption. See discussion *infra* Part II.

10. 154 F.3d 1107 (9th Cir. 1998).

[t]he game consists of three separate components: the game engine, the source art library and the [Duke Nukem game level layouts known as MAP] files. The game engine is the heart of the computer program; in some sense, it *is* the program. It tells the computer when to read data, save and load games, play sounds and project images onto the screen. In order to create the audiovisual display for a particular level, the game engine invokes the MAP file that corresponds to that level. Each MAP file contains a series of instructions that tell the game engine (and, through it, the computer) what to put where. . . . The MAP file describes the level in painstaking detail, but it does not actually contain any of the copyrighted art itself; everything that appears on the screen actually comes from the art library.<sup>11</sup>

Although not all games share this architecture, this generally describes the different parts of a game.<sup>12</sup> A video game may break a building into different parts that only come together when displayed on the screen. For example, these elements might include a map file (describing the layout of the world), a model for the building (describing the three-dimensional architecture of the building), and textures (essentially miniature pictures pasted on the model) that represent what the building looks like.<sup>13</sup> When the game engine detects the building on the screen, it uses these aspects to recreate the building based on the user's perspective.<sup>14</sup> The game then projects a two-dimensional representation of this building on the screen. Rapid updates of this image simulate real-life interactions with a true, virtual world.<sup>15</sup>

Sometimes, video games use buildings to help the player associate with the environment.<sup>16</sup> A game may utilize architecture and buildings taken from a city to create a more immersive world for the player.<sup>17</sup> Previous generation video games often utilized crude representations of architecture or previously

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11. *Id.* at 1110 (emphasis in original).

12. For more background on how video games work, *see generally* Jake Simpson, *Game Engine Anatomy 101*, EXTREMETECH, Apr. 12, 2002, <http://www.extremetech.com/article2/0,3973,594,00.asp>.

13. *Id.*

14. *Id.*

15. This is similar to how traditional animation works. *Cf.* Kerrie Murphy, *Animated Arguments*, AUSTRALIAN, Dec. 12, 2007, <http://www.theaustralian.com.au/news/arts/animated-arguments/story-e6frg8n6-111115186033>.

16. *Cf.* Seth Schiesel, *Grand Theft Auto Takes On New York*, N.Y. TIMES, Apr. 28, 2008, at E1.

17. *Cf.* E.S.S. Entertainment 2000, Inc. v. Rockstar Games, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008) (stating that a way to develop a cartoon-style parody of East Los Angeles was to create a “critical mass” of Los Angeles buildings and business).

captured images to evoke this feel.<sup>18</sup> Modern games, however, with more powerful hardware and larger storage mediums, can effectively recreate large parts of a city or full cities.<sup>19</sup> Game developers often travel to the cities that they hope to represent in order to take test pictures and ensure that their virtual representation accurately emulates the real world.<sup>20</sup> Although game developers might not reproduce entire cities due to time constraints or artistic choices, they may sufficiently recreate the architecture of a city to create a realistic feel.<sup>21</sup>

## B. TRADEMARK

Trademark protection for buildings and architectural works follows the traditional justifications for trademark law: protecting consumers from being misled or purchasing false products.<sup>22</sup> This Section will highlight the law and some relevant cases dealing with trademarks in architecture, focusing on how the consumer protective nature of trademark law applies to trademarks on buildings.

### 1. *The Underpinnings of Trademark Law*

Consumer protection is the basis of trademark law.<sup>23</sup> Utilizing and protecting known consumer marks serves the dual purpose of safeguarding

18. For example, the game *Duke Nukem 3D*, which was also set in Los Angeles, featured fairly generic buildings and not easily recognizable buildings. For more information on the game, *Cf. The Duke's Back and He's Bloody*, S. FLA. SUN-SENTINEL, Aug. 11, 1996, at 6E.

19. *See, e.g., supra* note 2.

20. *See Rockstar Games*, 547 F.3d at 1097 (“To generate their vision for [the parody of East Los Angeles], some of the artists who drew it visited Los Angeles to take reference photographs”).

21. *See, e.g., Musgrove, supra* note 2:

The problem [with completely recreating a city] is, when you get into a game, when you're actually playing and walking around, the scale doesn't work. It doesn't feel right. So we would go down [to Washington] and walk around and see how it felt and translate that to an appropriate scale in the game. So it has a similar feeling but it's dramatically compressed in some places, and some places are opened up a bit.

22. J THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:100 (database ed. 2009) [hereinafter, MCCARTHY ON TRADEMARKS].

23. “[The purpose of trademark law is to] avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping customers into buying a product they mistakenly believe is sponsored by the trademark owner.” *Rockstar Games*, 547 F.3d at 1100 (quoting *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 729, 806 (9th Cir. 2003)). *See also* MCCARTHY ON TRADEMARKS § 2:1 (“The law of unfair competition has traditionally been a battleground for competing policies. The interest of the public in not being deceived has been called the basic policy. Moreover the plaintiff's interest in not

the consumer from inferior products and being misled into purchasing an item that they did not intend to purchase.<sup>24</sup> The Ninth Circuit defines a trademark as “a word, phrase or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service.”<sup>25</sup> Trademark protection extends to both the physical mark a company uses to identify their goods and services and any recognizable aspects of the good consumers could associate with a specific company. The Ninth Circuit stated that the recognizable aspects—also known as trade dress—incorporate the “total image of a product” and could include “size, shape, color, color combinations, texture, or graphics.”<sup>26</sup> Trade dress protection can only be found in tangible aspects of the product or business; it does not protect “[i]neffable and vague aspects such as a product’s marketing theme, the ‘aura’ of a product or the ‘cachet that ownership or display of it creates’ . . . .”<sup>27</sup> Further, functional aspects of the trade dress are unprotectable for two reasons: to ensure (1) that these types of protections remain in the domain of patent law, and (2) that competitors can copy aspects of the product that they will need to create competitive alternatives.<sup>28</sup>

Trademark law, with its background in consumer protection, covers nearly anything capable of influencing a purchaser of goods and services.<sup>29</sup> In addition to a “word, phrase or symbol,” trademark law protects buildings used as a designation of origin for goods and services.<sup>30</sup> Protection is

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having the fruit of his labor misappropriated should not be disregarded.” (quoting *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963)).

24. MCCARTHY ON TRADEMARKS § 2:4 (“[T]rademarks create an incentive to keep up a good reputation for a predictable quality of goods. An important purpose underlying trademark law is the protection of the trademark owner’s investment in the quality of the mark and the quality of the goods or services the mark identifies.”).

25. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). *See also* MCCARTHY ON TRADEMARKS § 2:7 (“The emphasis and thrust of trademark protection and registration is in the direction of deciding whether an alleged symbol in fact functions to identify and distinguish the goods or services of one seller.”).

26. *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 613 (9th Cir. 1989) (internal quotation marks omitted); *See also* MCCARTHY ON TRADEMARKS § 8:4 (Modern trade dress “includes the total look of a product and its packaging and even includes the design and shape of the product itself. . . . [T]he Eleventh Circuit has stated that: ‘Trade dress involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.’” (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 219 U.S.P.Q. 515 (11th Cir. 1983))).

27. MCCARTHY ON TRADEMARKS § 8:4 (citing *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619 (6th Cir. 2002)).

28. *See* MCCARTHY ON TRADEMARKS § 7:63.

29. *See id.* § 3:1.

30. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1301.02(c) (6th ed. rev. 1 2009), available at [http://tess2.uspto.gov/tmdb/tmep/1300.htm#\\_T130102](http://tess2.uspto.gov/tmdb/tmep/1300.htm#_T130102) (stating that “[a]

available for the recognizable use of the exterior or interior of a building.<sup>31</sup> The defining characteristic is whether the building is used on goods and services.<sup>32</sup> For example, using an image of the Sears Tower, a famous and easily recognizable building, on goods might not cause consumers to think that the Sears Corporation created or distributed them. However, the use of the Cinderella Castle, one of a few variants of the main castle at the center of many Disneyland theme parks, would be more likely to cause consumer confusion. A representation of the structure is used as the introduction to many Disney films and on other goods sold by the company. The use of the same or a similar structure would have a higher likelihood of consumer confusion than the use of the Sears Tower; trademark law would protect this use in order to prevent confusion.

Trademark protection in buildings hinges on the use of that building or architecture in relation to goods and services; ownership of the building used is not a prerequisite for protection.<sup>33</sup> Confusingly, this allows a trademark to develop on a use of a building that the trademark owner does not own. As long as the building is used to identify their goods, trademark protection can be acquired. Although this type of use would normally apply to buildings where there is no valid copyright or trademark right, such as a public building or a building whose rights have already expired, the trademark protection only focuses on whether the building is associated with some goods or services.<sup>34</sup> Historically, protection for trademark and trade dress in buildings

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three-dimensional configuration of a building is registrable as a service mark only if it is used in such a way that it is or could be perceived as a mark. Evidence of use might include menus or letterhead that show promotion of the building's design, or configuration, as a mark.”).

31. MCCARTHY ON TRADEMARKS § 7:100.

32. In emphasizing the consumer protective nature of trademarks, the Sixth Circuit stated that “[i]t is well established that ‘[t]here is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.’” The court further stated that when alleging infringement, “a plaintiff must show that it has actually used the designation at issue *as a trademark*, and that the defendant has also used the same or a similar designation *as a trademark*.” *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions*, 134 F.3d 749, 753 (6th Cir. 1998) (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)) (emphasis in original).

33. MCCARTHY ON TRADEMARKS § 7:100 (“To possess valid trademark rights in a picture of a structure or building, it is not essential that the trademark owner own the actual real or personal property that is pictured.”).

34. *Id.* § 7:100 n.2 (citing *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513, 1541 (S.D. Tex. 1996), *aff’d*, 155 F.3d 526 (5th Cir. 1998) where a trademark owner used a lighthouse near their golf course for various corporate logos and promotional materials). McCarthy notes that possible examples would be use of the White House or Golden Gate Bridge as marks for bread and further that “[i]t is assumed that the owner of the physical

focused on consumer confusion caused by confusingly similar designs.<sup>35</sup> Two recent cases have dealt with trademark protection for buildings when modern technology is considered: the Sixth Circuit dealt with the issue of reproduction of trademarked buildings in posters,<sup>36</sup> and the Southern District of New York dealt with trademark aspects in film.<sup>37</sup>

There are four major categories of trademarks: arbitrary/fanciful, suggestive, descriptive, and generic.<sup>38</sup> Fanciful marks exist only for the purpose of being a mark.<sup>39</sup> Arbitrary marks may have other meanings but are not normally associated with the goods bearing the mark.<sup>40</sup> Suggestive marks require a logical leap to get to the goods that bear their marks.<sup>41</sup> Descriptive marks simply describe the products that bear the mark.<sup>42</sup> Generic marks are common terms that cannot acquire trademark protection.<sup>43</sup> Generic marks also include previously fanciful terms that have become generic through common use and consumer association with a general class of products as opposed to a specific product or producer.<sup>44</sup> Trademark protection requires that a protected mark, at a minimum, meet a low threshold of distinctiveness; the mark must be either arbitrary, fanciful, suggestive, or descriptive.<sup>45</sup> This

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object pictured does not own intellectual property rights in the object under trademark or copyright law . . . [because it could] use those intellectual property rights . . . to prevent infringement.” *Id.*

35. *See id.* § 7:100; *see also infra* Section I.B.2.

36. *See* Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions, 134 F.3d 749 (6th Cir. 1998); *see also* discussion *infra* Section I.B.2.

37. *See* Sherwood 48 Associates v. Sony Corp. of America, 213 F. Supp. 2d 376 (S.D.N.Y. 2002); *see also* discussion *infra* Section I.B.2.

38. *See* MCCARTHY ON TRADEMARKS § 11:1. Although arbitrary and fanciful marks are technically two separate categories, they are typically viewed as the same level or strength.

39. Examples of fanciful marks: Exxon, Kodak, Polaroid. *Id.* § 11:8.

40. Examples of arbitrary marks: Omega watches, Sun computer, and Amazon online bookstore. *Id.* § 11:13.

41. “[A] mark which merely suggested some quality or ingredient of goods was labeled as ‘suggestive. . . .’” *Id.* § 11:62. Examples of suggestive marks: Chicken of the Sea tuna, Coppertone sun tan oil, Q-Tips, and 7-Eleven. *Id.* § 11:72.

42. “A ‘descriptive’ term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.” *Id.* § 11:16. Examples of descriptive marks: Philadelphia Card to describe a credit card depicting Philadelphia and targeting consumers in Philadelphia, Oatnut for bread. *Id.* Foreign words that describe the shop or items available at the shop can also be considered descriptive, i.e., Le Croissant Shop for a baked goods store. *Id.* For a larger list of descriptive marks, *see id.* § 11:24.

43. Examples of generic marks: Brick Oven pizza, Computer Learning Center, and Lawyers.com. *Id.* § 12:18.

44. *See, e.g., id.* § 12:18 (noting Cellophane, Escalator, and Murphy Bed as examples).

45. “If a designation is not ‘distinctive,’ it is not a ‘mark.’ Without achieving distinctiveness, either inherently or through the acquisition of secondary meaning, then a

requirement also protects consumers by refusing to grant one producer control of a term that is, or has become, indistinct.<sup>46</sup> Arbitrary/fanciful and suggestive marks are considered inherently distinctive.<sup>47</sup> Descriptive marks, however, must show a secondary meaning, or a consumer association with the specified goods.<sup>48</sup> This requirement protects those marks that might not be unique enough to have consumer associations on their own but have built up a reputation through their use.<sup>49</sup>

When a trademark holder believes that another has made an unauthorized use of their mark causing consumer confusion, trademark law allows them to bring an infringement action.<sup>50</sup> The federal test for infringement highlights the consumer-protective nature of trademark law: “whether the defendant’s use is ‘likely to cause confusion, or to cause mistake, or to deceive.’”<sup>51</sup> To prevail on a claim of trademark infringement, the plaintiff must show that the defendant used: “(1) a ‘reproduction, counterfeit, copy or colorable imitation’ of plaintiff’s mark; (2) without consent of the plaintiff; (3) in interstate commerce; (4) in connection with the ‘sale, offering for sale, distribution or advertising’ of goods or services; and (5) ‘where such use is likely to cause confusion.’”<sup>52</sup> In cases of trademarks in buildings and architecture, there must be a likelihood that a customer will be misled because of the use of the building in the product.<sup>53</sup> This analysis is done on a case-by-case basis.<sup>54</sup>

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designation does not have the legal status of a ‘trademark’ or ‘service mark.’ No distinctiveness—no mark.” *Id.* § 11:2.

46. “To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish.” *Id.* § 12:2.

47. *Id.* § 11:2.

48. 15 U.S.C. § 1052(f) (2006).

49. *Cf.* MCCARTHY ON TRADEMARKS § 11:25.

50. *Id.* § 2:7 (“In trademark infringement litigation [one must] compare what has been determined to be a mark with that usage by another which is alleged to cause a likelihood of confusion. In trademark law, therefore, it is only the exclusive symbol characterized as a ‘trademark’ that is juxtaposed against another’s usage to determine whether or not the two uses by two sellers are likely to confuse customers”); *Id.* § 2:33 (“Confusion of the public is the essence of both trademark infringement and unfair competition” (citing *Dart Drug Corp. v. Schering Corp.*, 320 F.2d 745 (D.C. Cir. 1963))).

51. *Id.* § 23:1 (citing Lanham Act § 32; 15 U.S.C. § 1114(1) (2006)).

52. Annette Lesieutre Honan, *The Skyscraping Reach of the Lanham Act: How Far Should the Protection of Famous Building Design Trademarks Be Extended?*, 94 NW. U. L. REV. 1509, 1514 (2000) (citing *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem, Mfg., Inc.*, 510 F.2d 1004, 1009 (5th Cir. 1975)).

53. *See Rock and Roll Hall of Fame Museum, Inc. v. Gentile Products*, 134 F.3d 749, 753–54 (6th Cir. 1998) (“[T]he plaintiff must establish a likelihood that the defendant’s designation will be confused with the plaintiff’s trademark, such that consumers are

In addition to the use of a mark on goods and services, nationally famous marks demand additional protections.<sup>55</sup> To protect a famous mark's national reputation, trademark law protects additional uses of the mark even when there is no intent to cause customer confusion: dilution by blurring and dilution by tarnishment.<sup>56</sup> Dilution by blurring occurs when a famous mark is used on an unrelated good.<sup>57</sup> In these cases, even though the defendant is not necessarily trying to feed off the goodwill of the famous mark, the use might cause harm to the famous mark's distinctiveness.<sup>58</sup> Some hypothetical examples of this type of dilution include, "Dupont shoes, Buick aspirin, Schlitz varnish, Kodak pianos and Bulova gowns."<sup>59</sup> Dilution by tarnishment causes harm to the reputation of a famous mark.<sup>60</sup> The First Circuit described this type of dilution as an instance when "the goodwill and reputation of a plaintiff's trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner's lawful use of the mark."<sup>61</sup>

Use of another's mark will not always lead to a finding of infringement. There are two categories of fair use available for users of another's registered trademark: classic and nominative.<sup>62</sup> The classic fair use scenario occurs when a mark that has a descriptive as well as trademarked meaning is used in the descriptive sense.<sup>63</sup> This defense applies "only to marks that possess both a

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mistakenly led to believe that the defendant's goods are produced or sponsored by the plaintiff.").

54. Rashida Y.V. MacMurray, *Trademarks or Copyrights: Which Intellectual Property Right Affords Its Owner the Greatest Protection of Architectural Ingenuity?*, 3 NW. J. OF TECH. & INTELL. PROP. 111, ¶ 45 (2005), <http://www.law.northwestern.edu/journals/njtip/v3/n2/2/>.

55. The definition of a famous mark is provided at 15 U.S.C. § 1125(c)(2)(A) (2006) stating that "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." The statute also gives other relevant factors for determining whether a mark is famous. *See id.* § 1125(c)(2)(A)(i)-(iv).

56. *See id.* § 1125(c) (2006).

57. MCCARTHY ON TRADEMARKS § 24:69.

58. "The theory [of dilution by blurring] says that if customers or prospective customers see the plaintiff's famous mark used by other persons to identify other sources for many different goods and services, then the ability of the famous mark to clearly identify and distinguish only one source might be 'diluted' or weakened." *Id.*

59. *Id.*

60. *Id.* § 24:89.

61. *Id.* McCarthy lists instances of tarnishment in cases where a mark has been used for adult-oriented entertainment and drug references. *Id.*

62. *Id.* § 3:3.

63. *Id.* § 23:11 (stating that this instance occurs where a "descriptive, geographically descriptive, or personal name designation . . . [is used] to describe the defendant's goods or services, or their geographic origin, or to name the person running the business."); *see also* *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 809 (9th Cir. 2003) (stating that

primary meaning and a secondary meaning—and only when the mark is used in its primary descriptive sense rather than its secondary trademark sense.”<sup>64</sup> For classic fair use, the registered mark must not be used in a trademark sense and must be used in good faith and only to describe the goods.<sup>65</sup> The Ninth Circuit does not allow classic fair use if there is a likelihood of confusion for the origin of a product.<sup>66</sup>

The nominative fair use defense is available where the defendant has “used the plaintiff’s mark to describe the plaintiff’s product, *even if the defendant’s ultimate goal is to describe his own product.*”<sup>67</sup> The main purpose of nominative fair use is for the “purposes of comparison, criticism [or] point of reference.”<sup>68</sup> A defendant seeking to prove nominative fair use must satisfy three requirements:

- (1) the plaintiff’s product or service in question must be one not readily identifiable without use of the trademark; (2) only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff’s product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.<sup>69</sup>

In addition to the fair use defenses, the First Amendment permits unauthorized trademark use where there is an artistic element to the use and the likelihood of consumer confusion is very low.<sup>70</sup> This principle allows anyone to use a famous mark to “make fun of or to criticize the products or policies of the mark owner.”<sup>71</sup> This exception prevents a corporate trademark owner from silencing any non-commercial, negative, or offensive use of the mark.<sup>72</sup> The dominant First Amendment trademark test is from *Rogers v.*

classic fair use arises where the defendant “has used the [trademark owner’s] mark *only* to describe his own product, *and not at all to describe the [trademark owner’s] product.*” (quoting *Cairns v. Franklin Mint*, 292 F.3d 1139, 1151 (9th Cir. 2002) (emphasis in original)).

64. *Brothers Records, Inc. v. Jardine*, 318 F.3d 900, 905 (9th Cir. 2003).

65. MCCARTHY ON TRADEMARKS § 11:45. McCarthy describes a hypothetical scenario where the use of a trademarked credit card called “Adventure” in a slogan “Go on an adventure, with [competitor’s credit card]” would probably be considered classic fair use.

66. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1028 (C.D. Cal. 2006) (citing *Cairns v. Franklin Mint*, 292 F.3d 1139, 1151 (9th Cir. 2002)).

67. *Cairns*, 292 F.3d at 1151 (emphasis in original).

68. *Walking Mountain*, 353 F.3d at 809 (quoting *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992)).

69. *Rock Star Videos*, 444 F. Supp. 2d at 1029 (quoting *Walking Mountain*, 353 F.3d at 809) (internal quotation marks omitted).

70. For more information on the First Amendment as a defense, see *infra* Part II.

71. MCCARTHY ON TRADEMARKS § 24:90.

72. *Id.* The Second Circuit commented that “[free speech uses] risk some dilution of the identifying or selling power of the mark, but that risk is generally tolerated in the interest

Grimaldi,<sup>73</sup> which allows the use of a mark if the use has some artistic relevance to the work and there is a low likelihood of consumer confusion.

2. *The Evolution of Trademark Case Law Addressing Architectural Works*

As mentioned in the previous Section, trademark protection for architecture is rooted in consumer protection. An early California case, *Weinstock, Lubin & Co. v. Marks*,<sup>74</sup> dealt with protecting consumer associations in architecture. The plaintiff owned a dry goods store in Sacramento with a distinct architecture involving alcoves and arches.<sup>75</sup> The plaintiff sued a competitor who built a store nearby with a confusingly similar architecture and business name.<sup>76</sup> The court enjoined the defendant and stated that the defendant was “defrauding [the] plaintiff of its business [and] stealing its goodwill.”<sup>77</sup>

The theme of consumer protection is consistently emphasized in cases involving trademarks in buildings<sup>78</sup> and trade dress involving architecture.<sup>79</sup>

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of maintaining broad opportunities for expression.” *Id.* (quoting *Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39, 44 (2d Cir. 1994)).

73. 875 F.2d 994 (2d Cir. 1989). For more on the *Rogers* test, see *infra* Section II.B.

74. 109 Cal. 529 (1895).

75. MCCARTHY ON TRADEMARKS § 7:100. The court stated that the architecture of the building was unique within Sacramento. *Weinstock*, 109 Cal. at 534 (1894).

76. MCCARTHY ON TRADEMARKS § 7:100. The business name in question was “Mechanical Store” versus “Mechanic’s Store.” *Weinstock*, 109 Cal. at 537.

77. *Weinstock*, 109 Cal. at 539.

78. See MCCARTHY ON TRADEMARKS § 7:100 (listing cases involving trademarks in architecture and building design. Some noteworthy cases include: *White Tower System, Inc. v. White Castle System of Eating Houses Corp.*, 90 F.2d 67 (6th Cir.), *cert. denied*, 302 U.S. 720 (1937) (enjoining plaintiff from use of White Tower mark and architecture of a miniature castle because of confusion with White Castle restaurants); *House of Hunan, Inc. v. Hunan at Pavilion*, 227 U.S.P.Q. 803 (D.D.C. 1985) (finding two large marble lions in front of Chinese restaurant as a distinctive architectural feature and issuing injunction to competing Chinese restaurant using same design 150 yards away); *McDonald’s Corp. v. Moore*, 243 F. Supp. 255 (S.D. Ala. 1965) (finding trademark protection for McDonald’s golden arches restaurant design against competitor who used a series of twenty one yellow loops for their restaurant).

79. See MCCARTHY ON TRADEMARKS, § 7:100 listing cases involving trade dress in buildings. Some noteworthy cases include: *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 841 (9th Cir. 1987) (stating that trade dress protection could be acquired in the “restaurant’s décor, menu, layout and style of service.”); *Freddy Fuddrucker Inc. v. Ridgeline, Inc.*, 589 F. Supp. 72, 74 (N.D. Tex. 1984) (finding trade dress in combination including “an exposed glassed-in butcher shop for meat preparation, . . . a bakery showcase for the bakery products; a fresh vegetable condiment island with stacked vegetables, . . . dark brown and white checkerboard asbestos tile flooring; and interior green bands of neon lights and neon beer signs”).

Courts have also found protection in distinctive color combinations for buildings. See *Pure Oil Co. v. Ruthsatz*, 27 F. Supp. 688 (D. Mich. 1939); see also *Charles S. Cash, Inc. v.*

Building designers, however, must be careful that the court does not find their trade dress as functional or they risk losing protection.<sup>80</sup> Also, if a trade dress is shared by many similar businesses, the court might find that there is no chance of consumer confusion because there is nothing distinctive in the building design.<sup>81</sup>

Even a somewhat loose standard of trade dress protection was found to be valid by the Supreme Court. The Court found protection for a chain of Mexican-style restaurants in Texas.<sup>82</sup> Taco Cabana, which opened its first restaurant in 1978, sued Two Pesos, a competing restaurant, which opened in 1985.<sup>83</sup> The Court described the building as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals.”<sup>84</sup> The Supreme Court upheld the holding of the Fifth Circuit and found that Taco Cabana’s trade dress was entitled to protection.

The Sixth Circuit found that uniformity in the mark at issue was a key factor for establishing a trademark in architecture in a case involving the Rock and Roll Hall of Fame and Museum (the Museum), which had registered its name and unique building design as trademarks.<sup>85</sup> Professional photographer Charles Gentile took a sunset picture of the building and created a poster using the picture and the name “Rock N’ Roll Hall of Fame.”<sup>86</sup> The Museum filed a complaint alleging that it had used the name and building design as trademarks and Gentile’s poster infringed, diluted, and unfairly competed with these marks.<sup>87</sup> A district court found that the museum had shown a likelihood of success in proving the trademark claims

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Steinbook, 247 N.Y. 531 (1928) (finding trademark protection in color combination of blue and orange); MCCARTHY ON TRADEMARKS § 7:48 (discussing color combinations as trademarks).

80. *Prufrock, Ltd. v. Lasater*, 781 F.2d 129 (8th Cir. 1986) (finding design of “down home country cooking” restaurant which included exposed kitchen area, antique decorations, and small print wallpaper were functional). *See also* *Prints Plus, Inc. v. Classic Graphics, Inc.*, 225 U.S.P.Q. 679, 680 (N.D. Cal. 1985) (finding interior design elements were functional for selling prints including display racks, neutral color carpeting, high ceilings, removed work areas, and vertical storage bins).

81. *Ale House Management, Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137 (4th Cir. 2000) (denying trade dress protection for the interior of a bar including a centrally located rectangular bar with seating, television monitors, arcades, and pool tables decorated in wood and brass).

82. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

83. *Id.* at 765.

84. *Id.*

85. *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 751 (6th Cir. 1998).

86. *Id.*

87. *Id.*

and granted a preliminary injunction.<sup>88</sup> The Sixth Circuit reversed this finding, stating that it was not convinced that the Museum had used the building as a trademark.<sup>89</sup> The court also found that the characterization of the Museum building as a fanciful mark (which the plaintiff argued and the district court found) did not work with the concept of a building.<sup>90</sup> A fanciful mark has no purpose other than to be a trademark; using the museum as a building conflicted with characterizing it as fanciful.<sup>91</sup> The court also found that the Museum used various representations of the building taken from different angles as a mark instead of one, uniform image.<sup>92</sup> This hurt their trademark argument because it is tougher for consumers to gain an association when the mark in question is constantly changing.<sup>93</sup> The court made this clear by stating,

In reviewing the Museum's disparate uses of several different perspectives of its building design, we cannot conclude that they create a consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship. . . . Consistent

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88. *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 934 F. Supp. 868, 872–73 (N.D. Ohio 1996).

89. *Rock and Roll Hall of Fame*, 134 F.3d at 754. The court also stated that they did not view the protection of the photographed building as the type of protection that trademarks are meant to grant:

That is to say that, when we view the photograph in Gentile's poster, we do not readily recognize the design of the Museum's building as an indicator of source or sponsorship. What we see, rather, is a photograph of an accessible, well-known, public landmark. Stated somewhat differently, in Gentile's poster, the Museum's building strikes us not as a separate and distinct mark *on the good*, but, rather, as the good itself.

*Id.*

90. The court noted, Although the plaintiffs 'invented' the Museum, the Museum's existence as a landmark in downtown Cleveland undermines its 'fancifulness' *as a trademark*. . . . [A fanciful mark, such as a made up word] is distinctive as a mark because it readily appears to a consumer to have no other purpose. In contrast, a picture of the Museum on a product might be more readily perceived as ornamentation than as an identifier of source.

*Id.* at 754–55.

91. *Id.* at 755.

92. *Id.*

93. *Id.* The court compared this to earlier cases where certain images had been used for celebrity marks. In those cases, the owners of the rights to the celebrities had tried to use the association with one specific image to claim trademark protection of all images of the celebrity. The courts in these cases rejected those arguments. *Id.* (citing *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir.1990) (dealing with photographs of Babe Ruth) and *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1363–64 (D.N.J.1981) (dealing with photographs of Elvis Presley)).

and repetitive use of a designation as an indicator of source is the hallmark of a trademark.<sup>94</sup>

The court also stated that it was unsure whether the use of “Rock N’ Roll Hall of Fame” would be an infringement of the registered mark or a description of the building pictured.<sup>95</sup>

Adapting trademarks in architecture to the digital age leads to a new set of challenges. The Second Circuit upheld the non-infringement of the digital alteration of advertisements on famous buildings.<sup>96</sup> The film *Spider-Man* digitally altered advertisements placed on Times Square buildings and replaced them with other sponsorship.<sup>97</sup> The owners of the Times Square buildings sued Sony alleging trademark and trade dress infringement.<sup>98</sup> These plaintiffs alleged that by altering the advertisements that were already there, Sony had infringed the trademarks and trade dress of the buildings and had caused consumer confusion as to the building’s association with the substituted advertisements. In a two-page opinion, the district court dismissed the claims, stating that there was no consumer confusion as the alteration did not affect purchasing decisions.<sup>99</sup> The district court also dismissed the trade dress infringement by stating that the advertising dress of the buildings changes constantly.<sup>100</sup> The Second Circuit affirmed the decision and stated that the plaintiffs had failed to assert what exactly constituted the trade dress infringed.<sup>101</sup> This case is a good example of courts reiterating that trademark protection for buildings is rooted in consumer protection. Since there were no purchasing decisions affected by the alteration of the advertisements and no uniform trademark usage, the court found no infringement.

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94. *Id.*

95. *Id.* at 756.

96. *Sherwood 48 Associates v. Sony Corp. of America*, 76 F. App’x 389 (2d Cir. 2003).

97. *Sherwood 48 Associates v. Sony Corp. of America*, 213 F. Supp. 2d 376, 377 n.2 (S.D.N.Y. 2002) (stating that Sony substituted a “USA Today” ad for the “Samsung” ad that was in the original shot).

98. The owners also alleged a baseless trespass claim which was also dismissed. *Id.* at 377.

99. *Id.* at 377 (citing *Lang v. Retirement Living Publ’g Co., Inc.*, 949 F.2d 576 (2d Cir.1991)).

100. *Id.* at 377.

101. *Sherwood 48 Associates*, 76 F. App’x at 391.

### C. COPYRIGHT

Congress added copyright protection for buildings and other architectural works in 1990.<sup>102</sup> This protection carried with it an important limitation due to the public nature of these works. This Section will explore the law and cases around copyrights in buildings.

#### 1. *The Underpinnings of Copyright Law as to Architectural Works*

Unlike trademark law, copyright law protects artistic expression. Copyright law traditionally protects books, photographs, motion pictures, paintings, musical compilations, and other works containing artistic elements.<sup>103</sup> Unlike trademark law, copyright protection, like patent law, draws its support from the Constitution.<sup>104</sup> Patent law is meant to protect useful articles whereas copyright law is meant to protect those elements of artistic works that can be separated from the useful aspects.<sup>105</sup>

Congress granted buildings and architectural works copyright protection on December 1, 1990 with the Architectural Works Copyright Protection Act (AWCPA).<sup>106</sup> Before 1990, plans for buildings could be protected as graphical works but the buildings themselves could not.<sup>107</sup> Buildings were originally considered uncopyrightable because they were seen as functional and thus “useful articles” outside the realm of copyright protection.<sup>108</sup> However, to conform to the Berne Convention, Congress passed the AWCPA, which added architectural works to the list of protectable expression.<sup>109</sup> Congress defined an architectural work as “the design of a building as embodied in any

102. The Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, 701-706, 104 Stat. 5133 (1990) (codified at scattered sections of 17 U.S.C.).

103. 17 U.S.C. § 102 (2006).

104. See WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:1 (database ed. 2009) [hereinafter PATRY ON COPYRIGHT] (“Congress shall have the Power . . . To Promote the Progress of Science and useful Arts, by securing, for limited Times, to Authors and inventors, the exclusive Right to their respective Writings and Discoveries.” (quoting U.S. CONST. art. I, § 8)).

105. See, e.g., *Mazer v. Stein* 347 U.S. 201 (1954) (finding protection of an ornamental lamp base as a statue by separating the expressive aspects of the lamp base from the lamp itself). This idea is known as separability and will be discussed in *infra* Section I.C.2.

106. Architectural Works Copyright Protection Act of 1990, *supra* note 102.

107. JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 268 (2d ed. 2006).

108. *Id.*

109. PATRY ON COPYRIGHT § 3:107. The Berne Convention is an agreement between member countries, originally signed by ten countries in 1886, to guarantee certain minimum substantive standards for created works. Several areas of American copyright law had to be changed in order to conform to the minimum requirements that this agreement calls for. See COHEN, *supra* note 107.

tangible medium of expression, including a building, architectural plans, or drawings.”<sup>110</sup> By having protection available as soon as the work is fixed, Congress intended to protect the original designer of the building.<sup>111</sup> This intent is further emphasized by the fact that the fixation requirement for architectural works does not require the construction of the building before protection is acquired. Although completion of the building will meet this requirement, protection is available for “plans, drawings, blueprints and computer disks.”<sup>112</sup> Congress did not choose to protect all three-dimensional structures when they enacted the AWCPA; Congress made a policy decision to include only those structures that were human inhabitable as architectural works and to exclude “interstate highway bridges, cloverleaves, canals, dams and pedestrian walkways” because their protection was not required by the Berne Convention.<sup>113</sup>

The functional view of buildings persists even after the adoption of the AWCPA. The legislative history of the AWCPA shows that Congress envisioned a two-step analysis for determining copyrightability involving separation of the original design elements of the building and then judging whether these elements are functional.<sup>114</sup> Although buildings that lack

110. 17 U.S.C. § 101 defines “architectural works” as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.” Not protecting standard features is a common trend in copyright, which seeks to protect only what is original about the work.

111. PATRY ON COPYRIGHT § 3:108.

112. *Id.* § 3:108. The inclusion of computer disks is meant to protect plans in computer programs such as AutoCAD. Patry later mentions that Congress added protection for the schematics of a building because of a fear that “if an architectural work could be fixed only in a building, there would be no liability if an infringer ‘scooped’ the architect by constructing the building first.” *Id.*

113. *Id.* Patry later gives examples of protected buildings: “houses, apartments, office buildings, churches . . . [also] structures that are used by humans but not inhabited, such as belvederes, pergolas, gazebos, and garden pavilions.” *Id.* Patry also describes the definitions of a building from the copyright office:

The term building means humanly habitable structures that are intended to be both permanent and stationary, such as houses and office buildings, and other permanent and stationary structures designed for human occupancy, including but not limited to churches, museums, gazebos, and garden pavilions. [This definition excludes] [s]tructures other than buildings, such as bridges, cloverleaves, dams, walkways, tents, recreational vehicles, mobile homes, and boats.

*Id.*

114. COHEN, *supra* note 107, at 276 (quoting H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 20–21 (1990)):

originality (such as a generic office building composed of standard features) are generally not protectable, an original combination of standard features would still be.<sup>115</sup>

Congress added a “photographic exception” in § 120(a) to limit the protection granted to items classified as architectural works, stating that the exclusive rights do not include the “right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.”<sup>116</sup> Further, the legislative history of the Act implies that monuments, originally given full copyright protection as sculptures, were reclassified as architectural works with all the limitations that classification carries.<sup>117</sup> Case law also implies that works of art that are essential to or exist as part of a building can be classified as, and subject to the limitations of, architectural works.<sup>118</sup>

This exception is especially useful to the gaming industry because it allows the use of publicly viewable buildings to create a realistic game environment without opening the companies up to liability from the building architects. William Patry states this exact idea when talking about the photographic exception:

The limitation to two-dimensional reproductions is also important, since the exemption does not cover three-dimensional reproductions. By three dimensional is meant a *physical* three-dimensional object, and not a two-dimensional that is designed to appear three-dimensional. For example, no depiction of a work on a computer, whether in conjunction with a [Computer Aided Design or CAD] program on a virtual world such as second life

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First, an architectural work should be examined to determine whether there are original design elements present, including overall shape and interior architecture. If such design elements are present, a second step is reached to examine whether the design elements are functionally required. If the design elements are not functionally required, the work is protectable without regard to physical or conceptual separability.

115. PATRY ON COPYRIGHT § 3:108.

116. 17 U.S.C. § 120(a) (2006).

117. COHEN, *supra* note 107, at 278 (“Monumental, nonfunctional works of architecture are currently protected under § 102(a)(5) of title 17 as sculptural works. These works are, nevertheless, architectural works, and as such, will not be protected exclusively under section 102(a)(8).” (quoting H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 20 n.43 (1990))).

118. *See* Leicester v. Warner Brothers, 232 F.3d 1212 (9th Cir. 2000) (holding a statue erected as part of a building to be an architectural work, allowing Warner Brothers to film it without seeking the artist’s permission).

[sic], is a three-dimensional copy within the meaning of the statute.<sup>119</sup>

It is important to note that the CAD program mentioned by Patry is the screen representation of a CAD design. As was previously mentioned,<sup>120</sup> the fixation requirement is met when an architectural plan is fixed within a computer disk. However, the fixed design as rendered and displayed on a computer screen is not protected as an architectural work. When displayed on a screen, the design is viewable for the world to see.

The photographic exception for virtual worlds makes sense when we look at the reasons behind architectural copyright protection. Congress decided to protect plans because of the fear that someone would “scoop” the building, for example building the structure and obtaining copyright protection before the original architect.<sup>121</sup> Congress wanted to guarantee that the designer of the building would be the one to build it. Once the building is complete, the copyright ensures that no one else will create another identical physical building. By allowing an exception for two-dimensional representations, Congress protects the physical building while recognizing its public nature. A three-dimensional representation within a virtual world would not infringe the physical building since there is still only one physical copy of it. The architect’s design is still protected and embodied in the physical building. Further, a three-dimensional virtual reproduction is still a two-dimensional representation and within the photographic exception. Although the design might appear to be three-dimensional, the projection on the screen is a two-dimensional image drawn to appear three-dimensional.

The protection of architectural works would reach too broadly if a copyright holder was allowed to assert protection against virtual world representations of publicly visible buildings. This important realization also comes with a limitation for game developers because of how Congress decided to protect architectural works. Creators of virtual representations of buildings must be careful with their source material and ensure that reproductions only utilize pictures taken from publicly viewable vantage points. Virtual representations of real world buildings will fall within the photographic exception only if they are created from publicly accessible pictures; recreation from a building’s plans or schematics will not fall within the exception. Though the eventual representation would still be the same, a copyright violation would occur if a virtual representation of a building was

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119. PATRY ON COPYRIGHT § 3:111.10 (emphasis in original).

120. *See supra* note 112.

121. PATRY ON COPYRIGHT § 3:108.

created from architectural plans as opposed to pictures taken from a public space.

2. *Leicester v. Warner Bros. and Architectural-Sculptural Merger*

The Ninth Circuit in *Leicester v. Warner Bros.*<sup>122</sup> extended the protection afforded in the photographic exception to other copyrightable works incorporated into a building. The case dealt with the filming of a building used in the movie *Batman Forever*. A scene in the film contained both the actual building and a sculptural work built as a part of it. Warner Brothers also made a miniature reproduction of the sculpture for the filming.<sup>123</sup> The court in *Leicester* held that the photographic exception included sculptural works that are seen as part of the building as a whole.<sup>124</sup> The sculptor tried a separability argument and stated that his work was “conceptually separate” from the building it was built for.<sup>125</sup> If the court had accepted this analysis, it could have held that the photographic exception only applied to the actual building and not to the sculpture on top of it. This type of a holding would make little sense given the rationale behind the photographic exception, that the building was clearly in public view and thus pictures of it should not be considered copyright infringement.

The *Leicester* court rejected the sculptor’s separability analysis.<sup>126</sup> In doing so, the court applied the photographic exception to a completely separate

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122. 232 F.3d 1212 (9th Cir. 2000).

123. *Id.* at 1215.

124. *Id.* at 1217. The appeals court, reviewing the district court findings, found that [a]gainst this backdrop, the district court found that the lantern towers and the smoke towers, including the decorative elements at the top, are part of the 801 Tower as a whole. As it explained, each tower appears to be an integrated concept which includes both architectural and artistic portions. The court rejected Leicester's assumption that the decorative portion should be looked at alone as conceptually separate, artistic embellishments of the whole; rather, it found, the artistic and architectural impression is one created by the towers as a whole, complementing the pilasters and continuing the theme of the third floor lanterns of the building. Thus, it concluded, the four towers are part of the design plan of the building.

*Id.*

125. *Id.* at 1215.

126. *Id.* at 1219:

Leicester further maintains that the streetwall towers are a sculptural work which is “conceptually separate” from the building and thus independently entitled to copyright protection. Again, the district court found otherwise and we cannot say its finding lacks support. The streetwall towers were designed to extend the building visually, which they do along both Figueroa and Eighth. The Eighth Street smoke towers are

work of copyright. The court recognized that the practical purposes of the photographic exception outweigh independently copyrightable items of expression closely tied to the architecture in question.<sup>127</sup> The court treated these independent copyrightable works as a part of the building, demonstrating how powerful the photographic exception can be for the reproduction of buildings within a virtual world.<sup>128</sup>

## II. *E.S.S. ENTERTAINMENT V. ROCKSTAR GAMES*

A recent Ninth Circuit case attempted to synthesize the trademark aspects of architecture in video games and, in the process, adopted the *Rogers* test for uses that were not in the title of a work. This Part addresses the background of the case, the district court opinion, and the appellate opinion.

### A. BACKGROUND

E.S.S. Entertainment operates the Play Pen strip club in eastern Los Angeles. The logo of this establishment consists of the words “the Play Pen” and the words “Totally Nude” written in a publicly available font with a silhouette of a nude female dancer inside the stem of the first “P”.<sup>129</sup> The mark was an unregistered mark.<sup>130</sup>

Rockstar Games is the developer of many games, including the Grand Theft Auto (GTA) series. Rockstar is not a stranger to litigation; many

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equally integrated and serve the same purpose on Eighth as the Figueroa Street smoke towers do on Figueroa.

127. The court expounds on this when it states that “[g]iven the important public purpose served by these uses and the lack of harm to the copyright owner’s market, the Committee chose to provide an exemption, rather than rely on the doctrine of fair use, which requires ad hoc determinations.” *Id.* at 1217.

128. *Id.* at 1219–20:

Whether or not Leicester may have some *other* claim for a *different* infringement of his copyright in the Zanja Madre towers as a sculptural work, we believe he has none for a pictorial representation of the 801 Tower and its streetwall embodying a protected architectural work. Otherwise, § 120(a)’s exemption for pictorial representations of buildings would make no sense. When copyright owners in architectural works were given protection for the first time in 1990, the right was limited by § 120(a) so that publicly visible buildings could freely be photographed. See H.R. Rep. 101-735, at 1112, 21–22. This reflected a shift from the prior regime of relying on “ad hoc determinations” of fair use. *Id.* at 21–22. Having done this, it would be counterintuitive to suppose that Congress meant to restrict pictorial copying to some, but not all of, a unitary architectural work.

129. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1014–15 (C.D. Cal. 2006).

130. *Id.* at 1027 n.95.

lawsuits have been filed against the company, a majority of them involving the GTA series.<sup>131</sup> The GTA series was launched in 1997 and Rockstar has released new games under that brand every few years since.<sup>132</sup> Each game takes place in a fictitious city that is based on a real world counterpart.<sup>133</sup> *Grand Theft Auto: San Andreas* features three virtual cities, “Los Santos,” “San Fierro,” and “Las Venturas,” which are based on Los Angeles, San Francisco, and Las Vegas, respectively.<sup>134</sup> The neighborhoods are fictionalized versions of their real world counterparts.<sup>135</sup> The “Pig Pen” is a virtual strip club located within the Eastern portion of Los Santos.<sup>136</sup> Though the artists used images taken from East Los Angeles when creating the Los Santos section of the game, including images of the Play Pen, they testified that they were not trying to recreate the establishment.<sup>137</sup>

The two structures are very different. The court noted that the Pig Pen is “a totally different size, color, shape, and structure than the Play Pen. . . . [It] does not have a stone façade, a valet stand, large plants and gold columns around the entrance, or a six foot black iron fence surrounding the parking lot.”<sup>138</sup> The color schemes of the pole signs of the two places are different and the Pig Pen’s sign does not feature a trio of nude silhouettes nor does it have a “totally nude” sign below it.<sup>139</sup>

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131. See Duncan Mansfield, ‘Grand Theft Auto’ makers fight \$246M lawsuit, ASSOCIATED PRESS, Nov. 11, 2003, available at [http://www.usatoday.com/tech/news/2003-11-11-gta-lawsuit\\_x.htm](http://www.usatoday.com/tech/news/2003-11-11-gta-lawsuit_x.htm) (describing a lawsuit filed by the families of two people killed by individuals claiming video games motivated them to shoot); Rebecca Leung, *Can A Video Game Lead To Murder?*, June 19, 2005, available at <http://www.cbsnews.com/stories/2005/06/17/60minutes/main702599.shtml> (detailing the killing of three individuals by a minor who said after the incident that “Life is like a video game. Everybody’s got to die sometime.”); *Grandmother sues ‘Grand Theft Auto’ maker*, ASSOCIATED PRESS, July 27, 2005, available at <http://www.msnbc.msn.com/id/8728577/> (lawsuit over sexually explicit animation that was disabled in the final game but enabled through user hack).

132. E.g. “Grand Theft Auto”, Encyc. Britannica, 2010, available at <http://www.britannica.com/EBchecked/topic/1437176/Grand-Theft-Auto>.

133. *Rock Star Videos*, 444 F. Supp. 2d 1012, 1016.

134. *Id.*

135. *Id.* at 1017:

The neighborhoods [of Los Santos, the fictionalized Los Angeles,] are populated with cartoon-style liquor stores, ammunition dealers, casinos, pawn shops, tattoo parlors, bars, and strip clubs, among other things. The brand names, business names, and other aspects of the locations have been changed to fit the overall “Los Santos” theme and the [Grand Theft Auto series] irreverent tone.

136. *Id.* at 1017–18.

137. *Id.* at 1018–19.

138. *Id.* at 1019.

139. *Id.* at 1019–20.

## B. DISTRICT COURT OPINION

E.S.S. Entertainment filed suit against Rockstar Games in the Central District of California.<sup>140</sup> It claimed that Rockstar had used the Play Pen's distinctive logo and trade dress in *Grand Theft Auto: San Andreas* without authorization and created a likelihood of confusion among consumers as to whether E.S.S. Entertainment had endorsed, or was associated with, the game.<sup>141</sup> Rockstar Games moved for summary judgment on all the claims asserting nominative fair use and First Amendment protection as defenses.<sup>142</sup>

The district court dismissed the nominative fair use defense because it requires the defendant to use the mark to "clearly identif[y] and intentionally refer[] to the plaintiff's product or service."<sup>143</sup> Rockstar's artists and employees testified that they used the trade dress and mark to create a fictionalized strip club within Los Santos and not to refer to the actual Play Pen establishment.<sup>144</sup> The court, thus, denied summary judgment for nominative fair use.

For the First Amendment analysis, the district court stated that trademark protection does not allow the owner of the mark to "quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view."<sup>145</sup> The court further used the *Rogers* test,<sup>146</sup> which the Ninth Circuit adopted for previous trademark uses within the title of a work. The *Rogers* test allows trademark protection to apply to artistic works where the public interest in avoiding consumer confusion outweighs the public interest in free expression.<sup>147</sup> Rockstar's use of this defense was novel because the Ninth Circuit had not ruled on whether uses that did not involve the title of the work fell within it. In a previous case the Ninth Circuit had contemplated the use of the *Rogers* test in this context but chose not to apply it because other defenses applied.<sup>148</sup> In that case, the Ninth Circuit specifically mentioned that if nominative fair use had not been applicable, the

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140. Complaint, E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, No. CV05-2966, 2005 WL 3879981 (C.D. Cal. Apr. 22, 2005).

141. *Rock Star Videos*, 444 F. Supp. 2d at 1014.

142. *Id.* at 1027, 1036–37.

143. *Id.* at 1031.

144. *Id.* at 1034.

145. *Id.* at 1037 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)).

146. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

147. *Rock Star Videos*, 444 F. Supp. 2d 1012, 1037 ("A literary title falls outside the reach of the Lanham Act if it (1) has some artistic relevance and (2) does not explicitly mislead as to the source or content of the work." (citing *Mattel v. MCA Records*, 296 F.3d at 902)).

148. *Id.* (citing *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 729, 807 (9th Cir. 2003)).

court probably would have used the *Rogers* test.<sup>149</sup> The district court looked to other circuits that applied the *Rogers* test to all expressive uses of a trademark or trade dress in artistic works, whether titular or not, and found that the *Rogers* test should be used for Grand Theft Auto.<sup>150</sup>

Under the *Rogers* test, the district court first had to determine whether the Pig Pen had artistic relevance to the game.<sup>151</sup> E.S.S. argued that Rockstar's use of the Pig Pen was improper because the establishment had not reached the status of a landmark and was not relevant to creating a realistic depiction of the city.<sup>152</sup> The court, however, found that the mark did have artistic relevance to the game's depiction of Los Angeles.<sup>153</sup> The court found that the decision to borrow aspects of the Play Pen's design was closely connected to the artistic design of the fictional East Los Angeles city.<sup>154</sup> This satisfied the first prong of the *Rogers* test because the borrowed elements had *some* artistic relevance to the underlying work.<sup>155</sup> The court further found that

[the] defendants incorporated distinctive elements of the Play Pen name, logo, and trade dress . . . to create a locale that players would readily recognize as the Game's version of East Los Angeles. Because defendants' artistic objective was . . . [not to] produce an exact replica of East Los Angeles, it was unnecessary for defendants to copy everything about the Play Pen, including the architectural style of its buildings.<sup>156</sup>

The second requirement of the *Rogers* test requires "that the use of the mark [does] not explicitly mislead as to the source or content of the work."<sup>157</sup> Because the Pig Pen was not featured in any advertisements and the player did not even need to visit the establishment to finish the game, the court found that there was no chance of content confusion.<sup>158</sup> The court also found there was little risk of source confusion because neither the game nor promotional materials contained any explicit indication of endorsement by

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149. *Id.* at 1038 (citing *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 729, 809 n.17 (9th Cir. 2003)) ("Were the nominative fair use test not available and so attractive to this claim, we very well m[ight] have had to apply *Rogers*.").

150. *Id.* (citing cases and treatises including a Second Circuit and Sixth Circuit case applying the *Rogers* test).

151. *Id.* at 1040.

152. *Id.*

153. *Id.* at 1041.

154. *Id.*

155. *Id.* at 1043.

156. *Id.* at 1043–44.

157. *Id.* at 1044.

158. *Id.*

the Play Pen's owners.<sup>159</sup> The court further found that a small chance of association between the mark owner and the artistic work is not enough to defeat a First Amendment defense under the *Rogers* test.<sup>160</sup> Since Rockstar's use of the trademark passed both aspects of the *Rogers* test, the district court granted the motion for summary judgment.<sup>161</sup> The court further found that because the analysis for E.S.S.'s other state law claims was substantially the same as for the Lanham Act claim, summary judgment was appropriate.<sup>162</sup>

### C. NINTH CIRCUIT OPINION

On appeal, the Ninth Circuit affirmed the district court decision.<sup>163</sup> As a result, the court adopted the *Rogers* test for any use of a trademark in an artistic work and found that Rockstar Games's use of the Play Pen passed the test.<sup>164</sup> The Ninth Circuit held that the requirement for artistic relevance was a very low threshold.<sup>165</sup> The Ninth Circuit analysis focused on the artistic purpose of including Los Angeles architecture.<sup>166</sup> In finding artistic relevance, the court found that a reasonable way to create a cartoon-style parody of East Los Angeles was "to recreate a critical mass of the businesses and buildings that constitute it."<sup>167</sup> The Ninth Circuit further found that there was a low likelihood of misleading consumers based on the use of the mark.<sup>168</sup>

159. *Id.* at 1045.

160. *Id.* ("While the similar font and common use of nude silhouettes might suggest an association between the Play Pen and [*Grand Theft Auto: San Andreas*] to some consumers, this is not enough to defeat First Amendment protection under *Rogers*.").

161. *Id.* at 1048.

162. *Id.* at 1049.

163. *E.S.S. Entertainment 2000, Inc. v. Rockstar Games, Inc.*, 547 F.3d 1095, 1101 (9th Cir. 2008).

164. The Ninth Circuit stated that an artistic work's use of a trademark is not actionable "unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work." The Ninth Circuit further said that "[a]lthough the 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." *Id.* at 1099.

165. *Id.* at 1100 ("In other words, the level of relevance merely must be above zero.").

166. *Id.*

It is also true that Play Pen has little cultural significance, but the same could be said about most of the individual establishments in East Los Angeles. Like most urban neighborhoods, its distinctiveness lies in its "look and feel," not in particular destinations as in a downtown or tourist district. And that neighborhood, with all that characterizes it, *is* relevant to Rockstar's artistic goal, . . .

*Id.*

167. *Id.*

168. *Id.* ("Both *San Andreas* and the Play Pen offer a form of low-brow entertainment; besides this general similarity, they have nothing in common. . . . Nothing indicates that the

### III. VIDEO GAMES WILL RARELY INFRINGE LEGAL PROTECTIONS IN ARCHITECTURE

The adoption of the *Rogers* test, along with previous case law, leads to the conclusion that the First Amendment will usually allow the inclusion of architectural works in virtual worlds. This Part combines the protections from the *Rogers* test for trademark infringement with the exceptions to copyright to argue that video games will rarely infringe legal protections in architecture.

#### A. ARCHITECTURAL TRADEMARKS AFTER *E.S.S. V. ROCKSTAR GAMES*

For a game to infringe trademarks in architecture under the *Rogers* test, its use must lack artistic value to the game and explicitly mislead consumers. This Section will go through each of these prongs and conclude that such infringement will rarely, if ever, occur.

##### 1. *Artistic Intent*

The Ninth Circuit specifically stated that the recreation of public buildings is a sufficient artistic purpose for a First Amendment defense and that a developer could evoke the feel of Los Angeles by creating a critical mass of buildings.<sup>169</sup>

The Ninth Circuit stated that the artistic relevance of a work has to be “above zero.”<sup>170</sup> This low threshold gives game developers a lot of freedom when incorporating trademarks into their own works. The court allowed a game developer to utilize the trade dress and potentially trademarked architecture of a “critical mass” of Los Angeles buildings for the artistic goal of a cartoon-style parody of the city.<sup>171</sup> The same principle should hold true for creating a realistic representation of a city. In sum, any translation of the real world to a game representation should pass the artistic bar.

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buying public would reasonably have believed that ESS produced the video game or, for that matter, that Rockstar operated a strip club.”)

169. *Id.* (stating that “Rockstar’s artistic goal . . . is to develop a cartoon-style parody of East Los Angeles. Possibly the only way, and certainly a reasonable way, to do that is to recreate a critical mass of the businesses and buildings that constitute it.”).

170. *Id.*

171. Although the Ninth Circuit does not specifically tell developers to use the trademarked architecture, by stating that the easiest way to evoke the city is to create a critical mass of buildings that will be recognizable, it is not inconceivable that a large portion of these will be trademarked buildings. To assume that the Ninth Circuit is saying to copy *only* those buildings that do not have a trademark on them would not make sense, especially given the impracticalities of such an assumption.

A recent Central District of California case applied the *Rogers* test to a video game with a realistic artistic intent.<sup>172</sup> The case involved a football simulation game with the artistic intent of accurately modeling the sport. Even with the goal of realism, the court, citing to Ninth Circuit precedent, stated that “[i]t is well established that ‘video games are a form of expression protected by the First Amendment.’”<sup>173</sup> The court then found the use of a famous running back in the game furthered the artistic intent of creating a realistic representation of football and that there was no risk of consumer confusion.<sup>174</sup> The reasoning of that case along with the court’s use of the *Rogers* test for a realistic video game supports the idea that using actual buildings in a realistic representation of a city would pass the artistic intent prong.

The language of the Ninth Circuit and recent district court precedent shows that to meet the artistic goal of evoking a real world city, game developers can logically use real representations of buildings within that area. This proposition not only authorizes developers to make copies of individual buildings to further the artistic purpose of the game, it also allows trademark use on a massive scale to qualify as free speech. In terms of a video game and virtual world, this type of reasoning makes sense. A game developer will need to recreate a large portion of a city and many key buildings in order to evoke the feel of that city.<sup>175</sup> A single copied building would not be enough for the player to recognize the modeled area.<sup>176</sup>

## 2. *Likelihood to Mislead the Consumer*

The Ninth Circuit quickly dismissed any notion that including the Pig Pen in *Grand Theft Auto: San Andreas* would explicitly mislead a consumer into believing that E.S.S. was involved in the game.<sup>177</sup> This dismissal was based on

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172. *Jim Brown v. Electronic Arts, Inc.*, No. 2:09-cv-01598-FMC-RZx, slip op. (C.D. Cal. Sept. 23, 2009), available at <http://206.204.99.39/media/brown.pdf>.

173. *Id.* at \*5 (citing to *Video Software Dealers Ass’n v. Schwarzenegger*, 556 F.3d 950, 958 (9th Cir. 2009)).

174. *Id.* at \*9.

175. *Rockstar Games*, 547 F.3d at 1100 (“Possibly the only way, and certainly a reasonable way, to [create a cartoon-style parody of East Los Angeles] is to recreate a critical mass of businesses and buildings that constitute it. In this context we conclude that to include a strip club that is similar in look and feel to the Play Pen does indeed have at least ‘some artistic relevance.’”).

176. While many players might recognize the Staples center and associate it with downtown Los Angeles, it is unlikely that the game would evoke the feel of downtown Los Angeles if that one building was present. Further, it would probably look out of place and might break the feel of the game if one recognizable building existed in a sea of generic ones.

177. “Nothing indicates that the buying public would reasonably have believed that ESS produced the video game or, for that matter, that Rockstar operated a strip club. . . . It also

the fact that the game was not based around operating a strip club and that the club did not play a prominent role in the advertisements of the game. Under this logic, there are few instances where an in-game trademarked building could mislead the consumer.

It is possible that the building's use in a parody of Los Angeles influenced the Ninth Circuit's dismissal of the likelihood to mislead. The court mentions the GTA series' parody aspects in the description of the game but not in the analysis of consumer confusion. Even though the opinion might have implicitly considered this aspect, the opinion does not analyze the trademark use in this way. The Ninth Circuit opinion fully analyzed the mark as referring to the strip club and concluded that there would be no consumer confusion.<sup>178</sup> Although it would have been easier to state that there was little possibility of confusion between an obvious parody of the Play Pen mark and building and the in-game use, the Ninth Circuit's analysis includes statements that identify E.S.S. without mentioning the cartoon-style aspects of the use.<sup>179</sup> These statements reaffirm the difficulty of infringing architectural trademarks in video games; whether the use is an obvious parody or a complete architectural reproduction, the reasoning supporting a low likelihood to mislead will be the same.

However, the growth in traditional advertising uses within games could lead to more restrictions on the use of architecture based on the consumer confusion prong. More companies recognize the growing popularity of games and are increasing their advertising efforts in that area.<sup>180</sup> Burger King, M&Ms, Doritos, 7-UP, and others have all sponsored the creation of games based on their brands.<sup>181</sup> Additionally, many games prominently feature advertisements within the virtual world that promote various products,<sup>182</sup> and

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seems far-fetched that someone playing San Andreas would think ESS had provided whatever expertise, support, or unique strip-club knowledge it possesses to the production of the game." *Rockstar Games*, 547 F.3d at 1100.

178. The court does state, however, that the strip club is generic and the district court opinion goes into detail about the differences so it is possible that the court decided it was not worth addressing.

179. *Rockstar Games*, 547 F.3d at 1100–01 (“Nothing indicates that the buying public would reasonably have believed that ESS produced the video game . . . . 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.”).

180. See generally David Radd, *The Secrets of Advergaming*, BUSINESSWEEK, May 23, 2007, [http://www.businessweek.com/innovate/content/may2007/id20070523\\_844955.htm](http://www.businessweek.com/innovate/content/may2007/id20070523_844955.htm).

181. E.g., Lore Sjöberg, *Burger King Serves Up Tasty Games*, WIRED, Dec. 5, 2006, <http://www.wired.com/culture/culturereviews/news/2006/12/72217>.

182. The most interesting one being the Obama campaign's use of advertisements in various Electronic Arts games in the time leading up to the election. See Posting of Ross Miller to Joystiq, <http://www.joystiq.com/2008/10/14/obama-takes-campaign-to->

various companies have sponsored downloadable additions to games.<sup>183</sup> The fundamental difference between these types of uses and the use that occurred in *Rockstar Games* and other cases of trademarked architecture is the use of the trademark in a traditional advertising context. Traditional forms of sponsorship, including advertising billboards, prominent product placement, and overt splash screens and messages, would lead a consumer to conclude that a game is supported and endorsed by the trademark owner. This type of use approaches the level of explicitly misleading the consumer. Without these types of traditional sponsorship associations, the likelihood of explicitly misleading consumer would be low.

Though Rockstar used aspects of the Play Pen's architecture and some of the trade dress for the logo, it was still used as a public building in a way that the average consumer would not traditionally associate with sponsorship. There was little risk that a consumer would think that a location with little relevance to the overall story and not placed on any promotional screenshots, videos, or box art was somehow associated with the development or promotion of the game. This is the nature of architectural works in video games. The game developer's use of architecture will rarely lead to consumer confusion over the sponsorship of the game. Even if the architecture and trade dress are prominently displayed, the amount of time the player spends around or within the building will most likely be similar to that in *Rockstar Games*. Unless the developer decides to create the "McDonald's home base" or other similar locale that contains a prominent mission or repeated interactions, the use would not approach that of sponsorship. Essentially, a developer would need to actively attempt to evoke a sponsorship with the architectural work for it to lead to consumer confusion. Even the prominent placement of potentially trademarked architecture can lead to no consumer confusion and a mutually beneficial relationship.<sup>184</sup>

When games reproduce billboards and other traditional forms of advertisements, the result of this prong of the test is harder to predict. Even though the architecture of a billboard on its own is unlikely to raise any trademark liability due to its functional nature, the use of the trademarked

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burnouts-paradise-city/ (Oct. 14, 2008, 10:45). There was also a special "blooper reel" sponsored by Axe body spray in *Rainbow Six Vegas 2*. See Posting of Brian Crescente to Kotaku, <http://kotaku.com/226196/clips-rainbow-six-vegas-blooper-easter-egg/> (Jan. 4, 2007, 19:00).

183. Downloadable add-ons have been sponsored by Fanta, Monster Energy Drink, Sprint, Coca-Cola, and the Discovery Channel to name a few. See, e.g., Posting of Dustin Burg to Joystiq, <http://xbox.joystiq.com/2007/01/08/new-gow-maps-coming-thursday/> (Jan. 8, 2007, 00:30) (detailing new maps for a game sponsored by the Discovery Channel).

184. See *infra* Part IV.B.

advertisement might. Because these uses are more in-line with traditional advertising, the likelihood of consumer confusion could be greater. The reasoning of the Ninth Circuit, however, seems to miss the mark when applied to traditional advertisements. The Ninth Circuit focused on the likelihood of the mark to confuse the consumer as to the game's origin, but in cases of small advertisements within a large world, unless the same advertisement was reproduced throughout the city,<sup>185</sup> it is unlikely that a single advertisement would cause the consumer to think that the game was developed or produced by the company holding that trademark. Consumers might think that the company sponsored or endorsed the use of the mark in game, but it is unlikely that this could cause consumers to believe that the company was responsible for making the game or lending their expertise.<sup>186</sup> The trademark's use in traditional advertising is very different from having the logo appear on a splash screen or other prominent placement.<sup>187</sup>

The question of whether a trademark holder endorsed a game is more difficult. Considering that many games use in-game advertisements to generate revenue,<sup>188</sup> the likelihood that an in-game product advertisement for a famous trademark would lead to a consumer thinking the trademark owner had specifically endorsed it is high.<sup>189</sup> It is still questionable whether endorsement would actually mislead the customer in the traditional trademark sense. The Ninth Circuit analysis hinged on source confusion; even with an advertisement, it would still be clear that the advertising mark holder did not create the game or lend their expertise. Although this type of

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185. Such as having every billboard say, "Enjoy Coca-Cola."

186. This leads to the question whether consumer perception that a game is endorsed by a trademark holder would itself lead to consumer confusion. If the trademarks were not prominently featured on the game art or in advertisements, there would be little fear of initial interest confusion.

187. *Cf.* *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992). Sega filed a trademark infringement action for Accolade's inclusion of code which caused Sega's trademarked logo to appear during the start of the Accolade game. *Id.* at 1528. The Ninth Circuit, however, determined that Sega required the inclusion of the code for a game on their console to work properly, making the trademark functional. *Id.* at 1532. Had Accolade included the code for purposes other than getting the game start on a Sega console, however, the court could have come out differently.

188. *See* Posting of Greg Boyd, Vejay Lalla to Gamasutra, [http://www.gamasutra.com/view/feature/3927/emerging\\_issues\\_in\\_ingame\\_.php](http://www.gamasutra.com/view/feature/3927/emerging_issues_in_ingame_.php) (Feb. 11, 2009) (stating that in game advertising generated \$370 million in 2006 with projected growth to \$2 billion by 2012). *But see* Reena Jana, *Is That a Video Game -- or an Ad?*, BUSINESSWEEK, Jan. 25, 2006, [http://www.businessweek.com/innovate/content/jan2006/id20060124\\_792815.htm](http://www.businessweek.com/innovate/content/jan2006/id20060124_792815.htm) (stating that Electronic Arts decided against including in game advertising because of the feeling that it would break player immersion in the game).

189. Trademark dilution was discussed in *supra* Section I.B.1.

use would more closely approach an explicitly misleading endorsement by the trademark holder, the *Rogers* test might still allow it. The district court focused their analysis on misleading the consumer as to whether the mark holder had lent their specific expertise to development of the game.<sup>190</sup> Real world advertisements could contribute to the realistic artistic purpose of a city and should be allowed as long as they are neither prominently placed nor explicitly suggest sponsorship. If the usage does not mislead consumers as to the game's origin, the usage should be allowed under the *Rogers* test.

It is unlikely that developers would bother to try to incorporate trademarked advertisements in their games without permission. Because of the relative simplicity of replacing actual advertisements on architecture with fake or approved advertisements,<sup>191</sup> most game companies would avoid any liability altogether. Additionally, the ability of game developers to make substantial revenue from sponsored advertisements would likely prompt them to use ads that trademark owners endorse.<sup>192</sup> The developer that chooses to use authentic ads and forgo potential additional revenue would likely do this to further the player's sense of realism and immersion in the virtual world. When a developer makes this choice, the only factor considered should be the lost ad revenue; the law recognizes video games as protected artistic works and the fear of litigation should not be a motivator. The developer that chooses additional artistic immersion should not face litigation because of this choice.

#### B. COMBINING THE NINTH CIRCUIT'S TRADEMARK TREATMENT WITH COPYRIGHT LAW

The Ninth Circuit's treatment of the trademark usage of publicly viewable buildings in *Rockstar Games* complements the defenses for public architectural works built into the Copyright Act. The photographic exception<sup>193</sup> provides strong protection for game developers seeking to utilize copyrighted architecture in their virtual worlds, and this protection has only become stronger through case law. *Leicester* held that the photographic exception applies to traditional artistic works incorporated into a building

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190. E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc., 444 F. Supp. 2d 1012, 1047 (C.D. Cal. 2006).

191. The developer would simply need to replace the image used for the advertisement with a non-infringing version or substitute advertisement.

192. See, e.g., Matthew Yi, *Advertisers pay for video games*, S.F. CHRON., July 25, 2005, at E1 (estimating that in-game advertisements could increase game maker's profits by 16 to 40 percent).

193. See *supra* Section I.C.

because of their contribution to the building as a whole.<sup>194</sup> Indeed, this type of analysis is increasingly important for game developers seeking to use the exception for copyrighted architectural works containing other copyrighted expression.

It is possible that the result of *Leicester* was motivated by the fact that the city of Los Angeles required buildings to include their own separate artistic requirements, causing the work in question to be viewed more easily as a part of the whole.<sup>195</sup> However, this aspect of the case did not enter the appellate court's analysis. Rather, the analysis from the case focused on the similarity of the architectural work with the building.<sup>196</sup> Although some of this similarity might be attributed to the requirement of the city, the analysis holds up regardless of the city requirements.

There is an argument that games can more easily handle the removal of independently copyrightable elements of a building. Unlike the film crew in *Leicester*, who could not relocate the independently copyrighted statue, it is less burdensome for a game developer to substitute or remove these independently copyrighted elements. This requirement, however, would work against the artistic purpose of using actual buildings to give an authentic feel for the player. Copyright protections provide exceptions for two-dimensional reproduction of public buildings and trademark law provides an artistic exception if the use is artistic and does not cause consumer confusion.<sup>197</sup> Both of these uses are well suited for games. Combining these two should allow game developers to create accurate, realistic, and immersive worlds for their games without fear of liability from the use of buildings and architecture.

However, this is not enough. The conclusion of the Ninth Circuit in *Rockstar Games* should allow the free speech exemption to extend to other aspects of the building, including the logo. As long as there is a low likelihood of explicit consumer confusion, the law should allow the developer to use the associated logo. The Ninth Circuit's analysis (use of the trademark in an artistic work and a low likelihood of consumer confusion) should allow the use of traditional marks in video games. If the building is recognizable enough to acquire trademark protection, the addition of the logo associated with the architectural work should not change the result of the *Rogers* test. The *Rogers* test is flexible enough to allow the use of trademarked logos on their associated buildings, and copyright law would

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194. *Supra* Section I.C.2.

195. Refer to the separability analysis from *Leicester*, discussed in, *supra*, Section I.C.2.

196. *Leicester v. Warner Bros.*, 232 F.3d 1212, 1219 (9th Cir. 2000).

197. See discussion *supra* Sections I.B–I.C.

exempt their use under the photographic exception. These uses would contribute to the artistic intent of the developers and could further the immersive aspect of their virtual worlds.

#### IV. EXAMPLES FROM MODERN GAMES

##### A. USE OF BUILDINGS FOR IMMERSION<sup>198</sup>

Even though the use of fake or altered versions of trademarked, easily recognizable buildings could work against the artistic relevance of a game, developers typically sacrifice some realism for reduced liability. The law already shields developers from liability and any changes made only hurt the game-playing audience.

In *Rainbow Six: Vegas*, a game set in the city of Las Vegas during a terrorist incident, players are transported to a virtual recreation of the city.<sup>199</sup> The game used representations of Las Vegas hotels and casinos freely during the opening scenes. The Vegas scenario starts with a helicopter flying over the city. The use of Las Vegas landmarks is quickly apparent as the player surveys the city below and this use contributes to the sense of immersion. However, as soon as the player lands, the recognizable locales are only visible in the background. The areas where the player engages in combat with enemies are all fictional locations within the city.<sup>200</sup> Later, there is a scene where the player witnesses from an adjacent building the destruction of the top floor of a tower. Although the scene is an important plot point, the player having no association with the destroyed building lessens the impact of its destruction and the player's sense of immersion.

Contrast this scene with *Call of Duty: Modern Warfare 2*, in which the player must explore a war-torn Washington, D.C. As the player explores the level, they witness destroyed versions of the Washington monument, the White House, and the Capitol building. Although the idea is similar, the destruction of U.S. buildings as major plot points in a game, the fact that the player sees recognizable landmarks contributes to the immersive aspect of

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198. Spoiler Alert: the following Section talks about aspects of two games and reveals certain plot elements. Readers who do not wish to know about *Rainbow Six: Vegas* and *Call of Duty Modern Warfare 2* are advised to skip to the next Section.

199. Cf. Brian Haynes, *Players snapping up video game depicting terror attack on Las Vegas*, LAS VEGAS REV., Dec. 4, 2006, at 2B.

200. See *id.* (“Models of the city’s most-famous landmarks such as the MGM Grand, Bellagio and the Fremont Street Experience, were included, but all the action takes place in fictional casinos such as the underwater-themed Calypso and the Stratosphere-inspired Vertigo.”).

the scene and the impact it has on the player.<sup>201</sup> The destroyed buildings do not have trademark protection, and thus no risk of liability to the developer. Even so, from the player's perspective, the scene in *Modern Warfare 2*—seeing a destroyed Washington monument—has more impact than seeing an unnamed building destroyed in the distance.<sup>202</sup>

Although the destruction of video game representations of trademarked architecture has not been addressed by the courts, weighing the artistic relevance versus the likelihood to mislead the customer should allow the use and destruction of the trademarked building. This type of use might invoke trademark dilution by tarnishment or blurring. The First Amendment protections built into trademark law, however, should overcome these types of problems. Although most developers would probably rather take the *Rainbow Six: Vegas* approach and create fictional locations, the artistic loss from this practice hurts the players' experience and the game's atmosphere. The *Rogers* test should allow these types of uses and game developers should not be afraid to exploit these rights for their artistic works. The developers of *Call of Duty: Modern Warfare 2* were able to use these buildings because neither trademark nor copyright protect them—a decision which greatly helped the artistic goal of the game. Developers should not be forced to sacrifice artistic relevance because of fears of trademark and copyright liability. Since the law already encourages uses that further artistic pursuits, the destruction of trademarked buildings should be no different from a traditional use.

The same artistic protections under the First Amendment should overcome a dilution by tarnishment for questionable subject matter argument. Trademark owners, while protective of their mark, should not have the power to control its use in artistic works. Given the very low artistic bar of the *Rogers* test, a court will likely find that the use of a mark associated with a building will contribute to the artistic purpose of a game. Though the trademark owner might not want to associate with a video game in general or

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201. See, e.g., Musgrove, *supra* note 2.

202. Another example of realistic buildings and architecture helping immersion comes from a recent game-related podcast where one of the hosts talks about *Assassin's Creed II*, a game set in Renaissance Italy. The host was looking for a specific building in Florence and found it using Google Maps to map where it was in relation to his current location. Podcast: 4 Guys 1UP: 11/20/2009 at 1:43:00, available at <http://podcast.the1upnetwork.com/flat/1UPYours/4G1U112009.mp3>. Cf. Podcast: Joystiq Podcast Episode 119, 12/04/2009 at 22:00, available at <http://podcasts.aolcdn.com/joystiq/podcasts/12-04-09-joystiqpodcast-e119.mp3>, where a listener complained that a building known as the Baptistery was absent from *Assassin's Creed II*. The listener said that when he was playing the game, he noticed that something was missing and remembered from studying Renaissance Italy that a building was removed.

the specific content of a certain game, if the mark passes the *Rogers* test, then the owner should not be able to restrict its use.

#### B. THE CHURCH OF ENGLAND

Even the unauthorized use of architecture in a video game can have a mutually beneficial relationship for the building owner. The game *Resistance: Fall of Man* included a scene inside Manchester Cathedral.<sup>203</sup> The game recreates the interior of the cathedral and involves a firefight between the player and the alien enemies of the game. The scene contains the architecture and many of the interior artistic aspects of the cathedral, including stained glass windows and statues.

This reproduction caused controversy with the leaders of the Church of England. The Church claimed the depiction to be desecration and copyright infringement, stating that it was inappropriate of Sony to allow players to shoot guns in a city with a gun problem.<sup>204</sup> A good amount of back and forth between Sony and the Church ensued.<sup>205</sup> Sony issued an unreserved apology but refused to change the game or issue a donation as the Church demanded.<sup>206</sup>

In the end it appears that the use has resulted in a mutually beneficial effect. *Resistance: Fall of Man* went on to sell over a million copies worldwide.<sup>207</sup> During the controversy, its United Kingdom sales rank went from 40th to 22nd, and it remained in the top forty for two additional weeks.<sup>208</sup> The controversy also indirectly benefited Manchester Cathedral, which saw a significant increase in visitors after the controversy broke.<sup>209</sup> Although it would be tough to equate increased tourism with possible desecration of a religious building, the direct impact of the game's scene on

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203. See *Cathedral row over video war game*, BBC News (June 9, 2007, 17:32 GMT), available at [http://news.bbc.co.uk/2/hi/uk\\_news/england/manchester/6736809.stm](http://news.bbc.co.uk/2/hi/uk_news/england/manchester/6736809.stm).

204. *Id.*

205. See e.g., Ruth Gledhill, *Manchester Cathedral says Sony apology not enough and issues new digital rules*, TIMES ONLINE (July 6, 2007), <http://www.timesonline.co.uk/tol/comment/faith/article2036423.ece>.

206. The Wardman Wire, <http://www.mattwardman.com/blog/2007/06/18/sony-reponds-to-manchester-cathedral-concerns-with-partial-apology-and-offers-to-talk-analysis/> (June 18, 2007).

207. *Sony, church discuss violent game*, WASHINGTON TIMES (June 13, 2007), <http://www.washingtontimes.com/news/2007/jun/13/20070613-113034-9700r/>.

208. GfK ChartTrack for the week ending June 16, 2007, [http://www.chart-track.co.uk/index.jsp?c=p/software/uk/archive/index\\_test.jsp&ct=110016&arch=t&lyr=2007&year=2007&week=24](http://www.chart-track.co.uk/index.jsp?c=p/software/uk/archive/index_test.jsp&ct=110016&arch=t&lyr=2007&year=2007&week=24).

209. Posting of Ben Richardson to Games Radar, <http://www.gamesradar.com/ps3/resistance-2/news/resistance-fracas-a-blessing-for-church/a-2008021412592378031/g-200801289119828067>.

tourist numbers is highlighted by David Marshall, director of communications for the Diocese of Manchester: “Teachers tell us that teenagers in particular are interested to see a building which they thought was fictional.”<sup>210</sup> The cathedral did eventually forgive Sony for using the architecture in their game, but stated that the controversy was important to ensure that game developers have respect for the subjects of their games.<sup>211</sup>

Even though the law protecting the cathedral in this case is different from what U.S. law protects, it is important to note that copyright and trademark law would likely not have protected Sony’s use of the building. The reproduced section was the inside of the building and the photographic exception is only valid for parts of a building that are visible from publicly accessible areas.<sup>212</sup> Although there is a question of whether or not the inside of a church is publicly accessible, it would most likely not fall within this exception. Additionally, the developer reproduced many artistic aspects of the cathedral, including stained glass windows and sculptures. Even though some of these would likely have been absorbed into the *Leicester* definition of a building, some artistic aspects within the reproduction would probably retain their separate copyright status. Even so, the result from the case shows that the use of protected buildings can serve dual purposes. It helps the artistic intent of the work in question, and, in this case, it increased the awareness of the protected building within a new audience.

## V. CONCLUSION

The video game industry as a whole has become gun shy regarding the use of trademarks in video games. When the goal of the game is to recreate or evoke the feeling of a realistic city, the only people that are hurt by the lack of relevant architecture are the game-buying public. Architectural recreations in video games are exempt from copyright infringement by statute. Trademark protection for architectural works focuses on a different harm. Although some developers will still choose to alter their in-game architecture and buildings to avoid the risk of litigation, this attitude harms the artistic aspects of the work and the players in general. The courts should encourage game developers to utilize trademarked and copyrighted architecture for the artistic purpose of creating virtual worlds. The courts

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210. *Id.*

211. *Violent video game maker forgiven*, BBC News (Oct. 24, 2007, 7:38 GMT), available at [http://news.bbc.co.uk/2/hi/uk\\_news/england/manchester/7059429.stm](http://news.bbc.co.uk/2/hi/uk_news/england/manchester/7059429.stm).

212. 17 U.S.C. § 120(a) (2006) (stating no copyright protection against photographs “if the building in which the work is embodied is located in or ordinarily visible from a public place”).

should further prevent trademark and copyright holders of buildings from subsequently burdening these developers with lawsuits. Although Congress has already addressed these issues with the photographic exception, the protection for game developers from trademark infringement will most likely need to come from the courts. The *Rogers* test is a case-by-case analysis, similar to fair use in copyright law. What the courts can, and should, do is establish a strong precedent of dismissing these cases at the summary judgment phase to discourage frivolous claims. This practice would minimize the financial burden of using protected buildings and further the purpose of the *Rogers* test: encouraging minimal harm artistic uses of trademarks.

Although game developers have architectural works protections available, if the result of placing buildings in a game world is an expensive lawsuit, developers will most likely change buildings and architectural works at a cost of user immersion. Protections against infringement are available for both copyright and trademark claims, and developers should be able to rely on these to ensure that they can realize their artistic vision for an immersive world without fear of costly litigation.

Game on.