

PRECEDENTIAL

UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

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No. 07-3269

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JOHN FACENDA, JR., Executor  
of The Estate of John Facenda

v.

N.F.L. FILMS, INC.; THE NATIONAL FOOTBALL  
LEAGUE;  
N.F.L. PROPERTIES, LLC,

Appellants

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Appeal from the United States District Court  
for the Eastern District of Pennsylvania  
(D.C. Civil Action No. 06-cv-03128)  
Magistrate Judge: Honorable Jacob P. Hart

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Argued June 6, 2008

Before: AMBRO, CHAGARES and COWEN, Circuit Judges

(Opinion filed: September 9, 2008)

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OPINION OF THE COURT

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AMBRO, Circuit Judge

John Facenda, a Philadelphia broadcasting legend, provided his voice to many productions of NFL Films, Inc. before his death in 1984. These well-known productions recounted tales of the National Football League with filmed highlights, background music, and Facenda’s commanding narration. More than two decades after Facenda’s death, NFL Films used small portions of his voice-over work in a cable-television production about the football video game “Madden NFL 06.” That production, entitled “The Making of Madden NFL 06,” sparked this controversy.

Facenda’s Estate (“the Estate”) sued NFL Films, the National Football League, and NFL Properties (which we refer to collectively, where appropriate, as “the NFL”) in the United States District Court for the Eastern District of Pennsylvania. The Estate claims that the program’s use of Facenda’s voice falsely suggested that Facenda endorsed the video game, violating the federal Lanham Act, which deals with trademarks and related theories of intellectual property. The Estate also claims that the program was an unauthorized use of Facenda’s name or likeness in violation of Pennsylvania’s “right of publicity” statute. In its defense the NFL argued, among other things, that its copyrights in the original NFL Films productions

that Facenda narrated gave it the exclusive right to use portions of those productions' soundtracks as it saw fit, including in the television piece at issue.

We must resolve this clash between parties claiming different types of intellectual property. Although we agree with much of the Court's trademark analysis, for the reasons that follow we vacate the Court's grant of summary judgment for the Estate and remand for trial on the Lanham Act claim. We affirm, however, the District Court's grant of summary judgment to the Estate on the Pennsylvania right-of-publicity claim.

### **I. Facts**

Facenda won national acclaim for his NFL Films work. His Estate credits that fame to the special qualities of his voice. In various depositions, several representatives for NFL Films described Facenda's deep baritone voice as "distinctive," "recognizable," "legendary," and as known by many football fans as "the Voice of God." As recently as 1999, NFL Films released works branded as featuring "the Legendary Voice of John Facenda."

For decades, Facenda worked on a session-by-session basis under an oral agreement, receiving a per-program fee. But shortly before he died from cancer in 1984, Facenda signed a "standard release" contract stating that NFL Films enjoys "the

unequivocal rights to use the audio and visual film sequences recorded of me, or any part of them . . . in perpetuity and by whatever media or manner NFL Films . . . sees fit, provided, however, such use does not constitute an endorsement of any product or service.”

In 2005, NFL Films produced “The Making of Madden NFL 06” about the soon-to-be released annual update of the video game that simulates NFL games. This production is 22 minutes long and was shown on the NFL Network eight times in a three-day span leading up to the release of the video game to retail stores. It featured interviews with NFL players, the game’s producers, and others. It also included several sequences comparing the video game’s virtual environment with the actual NFL environment, extolling the realism of everything from the stadiums to the game play. The end of the program featured a countdown to the video game’s release.

The District Court<sup>1</sup> found that not a single critical observation was made in this video regarding Madden NFL 06; all the commentary was positive. Other media, outside of the NFL Network, also covered the release of the game and addressed similar topics (albeit with the inclusion of the occasional criticism or recitation of the game's perceived faults).

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<sup>1</sup> With the consent of the parties, Magistrate Judge Jacob P. Hart exercised jurisdiction as the District Court in this case pursuant to 28 U.S.C. § 636(c).

The program used sound recordings, taken from earlier NFL Films' productions, of three sentences read by Facenda: (1) "Pro Football, the game for the ear and the eye," (2) "This sport is more than spectacle, it is a game for all seasons," and (3) "X's and O's on the blackboard are translated into aggression on the field." These excerpts from his NFL Films work total 13 seconds of the program. In its opening brief to our Court, the NFL admits that these excerpts were chosen "to underscore the degree to which the video game authentically recreates the NFL experience."

The producers of the program used the excerpts in a slightly altered form. The sound waves in the original recording of Facenda's voice were digitally filtered to sound more like the synthesized speech one might hear from a computer. (NFL Films President Steve Sabol described the results of this aesthetic choice by the show's producers as "awful.")

The NFL has an agreement with EA Sports, the makers of Madden NFL 06, which provides the NFL with royalty revenue in return for the use of the NFL's intellectual property. Various e-mail messages in the record suggest that NFL Films sought to create the television program as a promotion for Madden NFL 06, describing it as the "Madden Promo" or as "the Advertisements" in actors' release forms. But in their depositions, many NFL Films executives testified that the program was a documentary and denied that it was a commercial or that it was motivated by promotional considerations.

## II. Procedural History

Facenda's Estate initially sued the NFL for false endorsement under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and for unauthorized use of name or likeness (known as the "right of publicity") under 42 Pa. Cons. Stat. Ann. § 8316.<sup>2</sup> The District Court split the case into a liability phase and a damages phase. After discovery in the liability phase, the parties cross-moved for summary judgment and agreed at a hearing that the District Court could resolve the liability issues on the evidence already before it. The District Court granted the Estate's motion for summary judgment on both the false-endorsement claim and the right-of-publicity claim. *Facenda v. NFL Films, Inc.*, 488 F. Supp. 2d 491, 514 (E.D. Pa. 2007).

## III. Jurisdiction

The District Court had jurisdiction under 15 U.S.C. § 1121 because of the Estate's Lanham Act claims. It exercised

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<sup>2</sup> The Estate's complaint also included a claim for invasion of privacy under Pennsylvania common law. The Estate effectively abandoned this claim at the summary judgment stage, possibly because, as the District Court stated, Pennsylvania's right-of-publicity statute subsumed the common-law tort of invasion of privacy. The District Court entered summary judgment for the NFL on this claim and the Estate did not appeal.

supplemental jurisdiction over the state-law claims under 28 U.S.C. § 1367.

Because our Court has not yet issued an opinion interpreting the Lanham Act in the context of a false-endorsement claim, and because the District Court perceived a conflict between our caselaw (on the general interpretation of § 43(a)(1)(A) of the Lanham Act) and a single district-court case from the Eastern District of Pennsylvania (which dealt with the specific issue of false endorsement), the District Court certified the issue for interlocutory appeal. *Facenda v. NFL Films, Inc.*, No. 06-3128, 2007 WL 1575409, at \*2–3 (E.D. Pa. May 24, 2007). It also certified whether copyright law preempts the Estate’s state-law right-of-publicity claim because the caselaw (across all federal courts of appeals) does not reflect a “consistent line of reasoning.” *Id.* at \*3. We granted the petition for interlocutory appeal and have jurisdiction under 28 U.S.C. § 1292(b).

#### **IV. Standard of Review**

We review the District Court's legal conclusions *de novo*, reading all facts in the light most favorable to the party that did not move for summary judgment—the Estate. *Lucent Info. Mgmt., Inc. v. Lucent Techs., Inc.*, 186 F.3d 311, 315 (3d Cir. 1999). The Estate argues that we review the District Court’s “factual findings” under a “clearly erroneous” standard. But, to support this proposition, the Estate cites a case reviewing a

preliminary injunction. *Sandoz Pharms. Corp. v. Richardson-Vicks, Inc.*, 902 F.2d 222, 226 (3d Cir. 1990). We recently explained the important distinction between the standards of review for a preliminary injunction and summary judgment. *Doebler's Pa. Hybrids, Inc. v. Doebler*, 442 F.3d 812, 820 (3d Cir. 2006).

“Failure to strictly observe the principles governing summary judgment becomes particularly significant in a trademark or tradename action, where summary judgments are the exception.” *Country Floors, Inc. v. P'ship Composed of Gepner & Ford*, 930 F.2d 1056, 1062-63 (3d Cir. 1991). On a summary judgment motion, the District Court must not find facts. *See Doebler's*, 442 F.3d at 820 (“A District Court should not weigh the evidence and determine the truth itself, but should instead determine whether there is a genuine issue for trial.”). Rather, it should identify undisputed facts and resolve the remaining disputed facts in favor of the non-movant. For example, “[c]redibility determinations that underlie findings of fact are appropriate to a bench verdict,” but “[t]hey are inappropriate to the legal conclusions necessary to a ruling on summary judgment.” *Country Floors*, 930 F.2d at 1062. When considering the District Court’s grant of summary judgment to the Estate on a particular claim, “the sole question before [our] Court is whether plaintiff met its burden of demonstrating that it was entitled to judgment as a matter of law.” *Doebler's*, 442 F.3d at 820.

## **V. False Endorsement Under the Lanham Act**

The Estate alleges that the use of sound samples of Facenda's voice in "The Making of Madden NFL 06" falsely implied that the Estate had agreed to endorse the video game that is the production's subject. This false endorsement, they argue, violates § 43(a)(1)(A) of the Lanham Act. This provision reads as follows:

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

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another

person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1).<sup>3</sup> To prove a violation of § 43(a)(1)(A) in a false endorsement case, a plaintiff must show that: (1) its mark is legally protectable; (2) it owns the mark; and (3) the defendant's use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff's sponsorship

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<sup>3</sup> The phrase "another person" in § 43(a)(1)(A) indicates that "Congress selected language broad enough to encompass a claim by a deceased celebrity's [e]state or by any celebrity's assignee." *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1032 (C.D. Cal. 1998) (explaining that Princess Diana's estate had stated a cognizable claim for false endorsement under § 43(a)(1)(A) against a manufacturer of jewelry, commemorative plates, sculptures, and dolls featuring the Princess's likeness).

or approval of those goods or services. *See Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 437 (3d Cir. 2000) (listing the three prongs of a § 43(a) claim).

The NFL does not deny that courts broadly interpret the terms “name, symbol, or device” in § 43(a)(1) to include other indicia of identity, such as a person’s voice. *See Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992) (holding that § 43(a) claims based on voice are cognizable). Nor does the NFL deny that Facenda’s voice is distinctive and generally protectable as an unregistered mark. Thus, the Estate has satisfied the first prong of a § 43(a) claim. The NFL also declines to contest the second prong—that the mark is owned by the Estate.

Our case thus focuses on the third prong: whether the NFL’s use of Facenda’s voice was “likely to cause confusion” among consumers by suggesting that Facenda’s Estate has an “affiliation, connection, or association” with EA Sports’s video game implying that the Estate “sponsor[s]” or “approve[s] of” that product. 15 U.S.C. § 1125(a)(1)(A).

#### **A. The Legal Standard for Likelihood of Confusion in False Endorsement Claims Brought Under § 43(a) of the Lanham Act**

The NFL contends that the District Court applied the wrong legal standard under § 43(a)(1) to the Estate’s false-

endorsement claim. It also argues that our Constitution’s First Amendment right to free speech prohibited application of the Lanham Act to its television production in this case. Because the NFL’s First Amendment defense presents a threshold issue that would affect how we apply trademark law in this case, we address that argument first. Ultimately rejecting the First Amendment defense, we outline the multi-factor test courts use to evaluate the likelihood of consumer confusion when faced with a false-endorsement claim under § 43(a)(1)(A). Finally, we respond to the NFL’s various disagreements with the District Court’s analysis. The NFL’s primary argument is that the legal standards under § 43(a)(1)(A) and § 43(a)(1)(B)<sup>4</sup> do not differ from each other, which implies that the Estate was required to bring evidence of actual confusion to prove a likelihood of confusion. We reject that argument and thus adopt a trademark analysis similar to the District Court’s.

### **1. First Amendment Limits on the Lanham Act**

The NFL argues that its production constitutes informational expression, artistic expression, or both, and is thus protected by the First Amendment. It asks our Court to adopt

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<sup>4</sup> Subsection 43(a)(1)(B) prohibits the use of another person’s mark that, “in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities.” 15 U.S.C. § 1125(a)(1)(B).

the balancing test of the Second Circuit Court of Appeals' decision in *Rogers v. Grimaldi*, which weighs "the public interest in avoiding consumer confusion" against "the public interest in free expression." 875 F.2d 994, 999 (2d Cir. 1989). In that case, the dancer and actress Ginger Rogers sued the producers and distributors of "Ginger and Fred," a film about a pair of Italian dancers nicknamed for Rogers and Fred Astaire. The court rejected Rogers's false-endorsement claim. Under the *Rogers* test, the proper balance between trademark law and free expression "will normally not support application of the [Lanham] Act unless the title [1] has no artistic relevance to the underlying work whatsoever, or . . . [2] the title explicitly misleads as to the source or the content of the work." *Id.* Because the film's title (1) had an "ironic" and "ambiguous" meaning related to its subject, *id.* at 1001, and (2) did not directly state that it depicted Rogers, free-speech concerns outweighed survey evidence that "some members of the public would draw the incorrect inference that Rogers had some involvement with the film," *id.*

The analysis of *Rogers* has been adopted by three other Courts of Appeals. See *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (applying *Rogers* to a song title); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (same); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 & n.7 (5th Cir. 1999) (adopting *Rogers* in a case concerning a book title). Soon after announcing the *Rogers* test, the Second Circuit stated that the test is "generally applicable to Lanham Act claims

against works of artistic expression, a category that includes parody.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group*, 886 F.2d 490, 495 (2d Cir. 1989) (applying *Rogers* to a parody book cover). But we have identified only one federal appellate case other than *Cliffs Notes* that applies the *Rogers* test to something other than the title of a creative work. See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003) (applying *Rogers* to a commemorative sports painting of Tiger Woods’s victory at the Masters golf tournament in 1997). *But see id.* at 943–49 (Clay, J., dissenting) (declining to endorse the application of *Rogers* in that case and arguing that the majority had applied *Rogers* in a faulty fashion).

The NFL asks us also to adopt *Rogers* and apply it to the use of “The Making of Madden NFL 06.” Before considering whether either prong of the *Rogers* test applies, however, we must decide whether the television production is a “work[] of artistic expression,” *Cliffs Notes*, 886 F.2d at 495, as understood in the context of construing the Lanham Act narrowly to avoid a conflict with the First Amendment, *see Rogers*, 875 F.2d at 998. Although the District Court did not address the NFL’s First Amendment defense in its opinion,<sup>5</sup> the categorization of

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<sup>5</sup> Nor did it certify the First Amendment question for interlocutory appeal. We may, however, address any issue implicit in the District Court’s order granting summary judgment to the Estate on liability. See *NVE, Inc. v. Dep’t of Health & Human Servs.*, 436 F.3d 182, 196 (3d Cir. 2006).

speech is a question of law that we must resolve through independent review of the program. *See Connick v. Myers*, 461 U.S. 138, 148 n.7, 150 n.10 (1983) (“[W]e are compelled to examine for ourselves the statements in issue and the circumstances under which they are made to see whether . . . they . . . are of a character which the principles of the First Amendment . . . protect.” (quotation marks omitted)).

The NFL posits that its program, taken as a whole, is a work of artistic expression, and that the producers’ use of the particular sound clips at issue in this case represented an artistic choice. In the NFL’s view, the strong association between Facenda’s voice and the NFL means that the use of his voice conveyed the message that Madden NFL 06 provides an accurate rendering of NFL game play. By applying digital sound effects to make the voice sound computerized and adding a metallic echo, the program’s producers aimed to connect the NFL’s history (symbolized by Facenda’s voice, which narrated much of that history) to a modern video game (symbolized by digital filtering of the voice). The NFL contends that it had the right to choose how to convey those messages, even if it meant using portions of recordings of Facenda’s voice.

The NFL argues additionally that its program cannot be mere commercial speech—which is defined as “speech that does no more than propose a commercial transaction,” *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001), and is not as protected as artistic expression, *id.*—because it contains