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Recommended Citation

Robert Q. Romanelli, *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions 134 F.3d 749 (6th Cir. 1998)*, 8 DePaul J. Art, Tech. & Intell. Prop. L. 403 (1998)

Available at: <https://via.library.depaul.edu/jatip/vol8/iss2/8>

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ROCK AND ROLL HALL OF FAME AND MUSEUM, INC.

v.

GENTILE PRODUCTIONS

134 F.3d 749 (6th Cir. 1998)

INTRODUCTION

On January 20, 1998, Gentile Productions (“Gentile”) prevailed over the Rock and Roll Hall of Fame (“Museum”) when the Sixth Circuit United States Court of Appeals rejected a preliminary injunction granted in favor of the Museum by the United States District Court for the Northern District of Ohio.¹ The Court of Appeals overturned the injunction and vacated and remanded the district court’s decision because of the Museum’s inconsistent use of the design of its building. The court felt that the varying use of the trademark undermined the buildings source-identifying function. Because of the varied use of its trademark the Museum failed to demonstrate the requisite likelihood of success on the merits of its infringement claim.²

FACTS

In 1988, The Rock and Roll Hall of Fame Foundation registered the words, “The Rock and Roll Hall of Fame,” as its service mark on the principal register of the United States Patent and Trademark Office.³ In 1991, the Foundation hired I.M. Pei, a world famous architect, to design a facility for The Rock and Roll Hall of Fame and Museum in Cleveland, Ohio.⁴ Pei’s ultimate design was

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

2. *Id.*

3. *Id.*

brought to life in September 1995, on the edge of Lake Erie.⁵ The Museum stated in its brief that its building design was “a unique and inherently distinctive symbol of freedom, youthful energy, rebellion and movement of rock and roll music.”⁶ The Museum’s design was meant to be both unique and distinctive, and to this end, Pei and the Museum succeeded.⁷ On May 3, 1996, the State of Ohio approved the registration of the Museum’s building design for trademark and service mark purposes.⁸ The Museum has similar applications pending with the United States Patent and Trademark Office.⁹

Charles Gentile is a professional photographer whose work is marketed and distributed through Gentile Productions.¹⁰ During the spring of 1996, Gentile sold a poster featuring a photograph of the Museum against a colorful sunset.¹¹ The photo was framed by a black border.¹² In gold lettering in the border underneath the photo, the words “Rock N’ Roll Hall of Fame” appeared above the smaller, elongated word, “Cleveland.”¹³ Gentile’s signature appeared in small blue print beneath the picture of the building.¹⁴ Along the right-hand side of the photo, in very fine print, was the following explanation, “Copr.1996 Gentile Productions... Photographed by: Charles M. Gentile [;] Design: Division Street Design [;] Paper: Mead Signature Gloss Cover #80 [;] Printing: Custom Graphic Inc.[;] Finishing: Northern Ohio Finishing, Inc.”¹⁵ Gentile’s posters sold for price between forty and fifty dollars.¹⁶

5. *Id.*

6. *Rock and Roll*, 134 F.3d at 751.

7. *Id.* The front of the Museum is dominated by a large, reclining, triangular facade of steel and glass, while the rear of the building, which extends out over Lake Erie, is a combination of connected and unusually shaped white buildings.

8. *Id.*

9. *Id.*

10. *Id.*

11. *Rock and Roll*, 134 F.3d at 751.

12. *Id.*

13. *Id.*

14. *Id.*

15. *Id.*

16. *Rock and Roll*, 134 F.3d at 751.

PROCEDURAL HISTORY

In reaction to Gentile's poster, the Museum filed a five-count complaint against Gentile in district court.¹⁷ The Museum's complaint contended that Gentile's poster infringed upon, diluted, and unfairly competed with the Museum's registered trademark and service mark.¹⁸

The Museum sought a preliminary injunction and the district court held a hearing on the motion. The Museum's request for preliminary injunction was based on a two-part theory.¹⁹ First, that the Museum had used both its building design and its service mark, "The Rock and Roll Hall of Fame," as trademarks.²⁰ And second, that both the photograph of the Museum and the words that identified the Museum in Gentile's poster were uses of the Museum's trademarks that should be enjoined because they were likely to have led consumers to believe that Gentile's poster was produced and/or sponsored by the Museum.²¹ To bolster this theory, the Museum argued in its motion that Gentile used the Museum's trademarks on posters in a manner which reflected a deliberate attempt to confuse and mislead the public into believing that the posters were affiliated with the Museum.²² Gentile's deliberate deception, the Museum claimed, demonstrated an extremely strong probability of success on the merits of its trademark infringement and unfair competition claims.²³

17. *Id.*

18. *Id.* Count One of the Museum's complaint alleged trademark infringement, in violation of 15 U.S.C. § 1114(1). Count Two alleged unfair competition, false or misleading representations, and false designation of origin, in violation of 15 U.S.C. § 1125(a). Count Three alleged dilution of trademarks, in violation of 15 U.S.C. § 1125(c) and Ohio common law. Counts Four and Five alleged unfair competition and trademark infringement under Ohio law. *Id.*

19. *Id.*

20. *Id.*

21. *Rock and Roll*, 134 F.3d at 751.

22. *Id.*

23. *Id.*

The Museum submitted several exhibits in support of its motion.²⁴ At the center of the dispute was a poster produced and sponsored by the Museum that sold for \$20.²⁵ Like Gentile's poster, the Museum's poster featured a photograph of the Museum at sunset.²⁶ However, the photographs of the building itself were characterized by the court as "very" different.²⁷ Gentile's photograph was taken at ground-level, close-up when the Museum appeared to be closed.²⁸ The photograph was "artistically appealing...and virtually nothing else."²⁹ The Museum's photograph, on the other hand, was taken from an elevated and considerably more distant vantage point on the Museum's opening night, when red carpet stretched from the Museum's front doors, and interior lights highlighted its dramatic glass facade.³⁰ The court also characterized the Museum's photograph as artistically pleasing, but considered it to be a very different picture from that of Gentile's.³¹ The Museum's poster was framed by a white border, in which the words, "The Rock and Roll Hall of Fame and Museum – Cleveland," appeared beneath the photograph.³²

24. *Id.* at 752. In addition to the parties' posters, the record on appeal contained color copies of photographs of several items produced by the Museum; specifically, an advertisement for the Museum's opening, a paper weight, several postcards, and two T-shirts. One postcard featured the same photograph which appears in the Museum's poster, one featured a photograph of the rear of the Museum, and the third featured six different close-up photographs of various parts of the Museum. The T-shirts both had detailed drawings of the building on them. The paperweight is a "snow dome" that contains a three-dimensional rendition of the Museum and bears the words, "Rock and Roll Hall of Fame" on its base. The advertisement is for the opening night concert.

25. *Id.* at 751.

26. *Rock and Roll*, 134 F.3d at 751.

27. *Id.* at 752.

28. *Id.*

29. *Id.*

30. *Id.*

31. *Rock and Roll*, 134 F.3d at 751.

32. *Id.* at 752.

The Museum also submitted two affidavits in support of its motion.³³ Robert Bosak, the controller of the Museum, stated in his affidavit that “the Museum has used versions of the building shape trademark on T-shirts and a wide variety of products, including posters, since as early as June, 1993.”³⁴ Following a review of the Museum’s merchandise sales reports, Bosak concluded that items featuring the building shape were among the Museum’s top sellers.³⁵ The second affidavit was submitted by Rachel Schmelzer, an employee in the Museum’s licensing and sponsorship department.³⁶ In her affidavit, Schmelzer stated that she informed Gentile, on more than one occasion prior to Gentile selling its poster, that the Museum considered Gentile’s poster to be an infringing use of the Museum’s trademarked building design.³⁷

On May 30, 1996, the district court concluded that the Museum had shown the requisite likelihood of success in proving its federal and state claims, and it granted the Museum’s motion for a preliminary injunction.³⁸ The district court explained that as a result of the extensive advertising and promotional activities involving the Museum’s “Rock and Roll Hall of Fame” and building design trademarks, the public came to recognize these trademarks as being connected with, sold by, or licensed by the Museum.³⁹ Additionally, the district court found that the Museum’s building design was a fanciful mark, and Gentile’s use of the Museum’s building design coupled with the words, “Rock and Roll Hall of Fame,” was likely to cause consumer confusion.⁴⁰ After making these findings, the district court ultimately determined that the balance of equities favored granting the injunction. The court ordered Gentile to refrain from further infringements of the

33. *Id.*

34. *Id.*

35. *Id.*

36. *Rock and Roll*, 134 F.3d at 752.

37. *Id.*

38. *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions*, 934 F. Supp. 868, 872-73 (N.D. Ohio 1996) (hereinafter *Rock and Roll I*).

39. *Id.* at 871.

40. *Id.* at 871-72.

Museum's trademarks and to deliver to the Museum all copies of the poster for destruction.⁴¹ Aggrieved by the final order of the district court, Gentile sought relief on appeal.

LEGAL ANALYSIS

The appellate court reviewed the district court's decision to grant a preliminary injunction under the abuse of discretion standard.⁴² The findings of the district court could be disturbed only if the court relied upon clearly erroneous findings of fact, improperly applied the governing law, or used an erroneous legal standard.⁴³ When considering a motion for preliminary injunction the district court should have considered four factors: (1) whether the movant had a strong likelihood of success on the merits; (2) whether the movant would have suffered irreparable injury without the injunction; (3) whether issuance of the injunction would have caused substantial harm to others; and (4) whether the public interest would have been served by issuance of the injunction.⁴⁴

Gentile argued that the district court abused its discretion by concluding that the Museum had shown a likelihood of success on the merits for purposes of the preliminary injunction. Specifically, Gentile argued that his photograph of the Museum was not a trademark use of the Museum's building design.⁴⁵ Gentile further argued that his use of the words, "Rock and Roll Hall of Fame," was a non-trademark use which simply and accurately described his photograph of the building.⁴⁶

At the hearing on the Museum's motion, Gentile showed the district court a poster of an illustration of the Cleveland skyline, produced by another artist. The drawing included the Museum as

41. *Id.* at 872-73.

42. *See Sandison v. Michigan High Sch. Athletic Ass'n*, 64 F.3d 1026, 1030 (6th Cir. 1995).

43. *See Blue Cross & Blue Shield Mutual of Ohio v. Blue Cross and Blue Shield Ass'n*, 110 F. 3d 318, 322 (6th Cir. 1997).

44. *Sandison*, 64 F.3d at 1030.

45. *Rock and Roll*, 134 F.3d at 753.

46. *Id.*

one building among many.⁴⁷ Gentile also referred to a quilt or blanket which depicted numerous landmarks in Cleveland including the Museum.⁴⁸ In response, the Museum stated that the exhibits illustrate something that to them, was not at issue because the poster and quilt showed a whole collage of downtown buildings and scenes from around Cleveland. The Museum argued that Gentile's poster featured nothing but the Museum and a sunset. In the Museum's opinion, Gentile's production of the poster was like "going into a store, getting a bottle of [C]oke, taking a picture [of it and] putting...[C]oke underneath."⁴⁹

The court did not easily dismiss the Museum's Coke bottle analogy. In actuality, the argument was not entirely concocted.⁵⁰ Ultimately, the court accepted that a photograph which prominently depicts another person's trademark might intentionally or unintentionally use its object as a trademark.⁵¹ However, the court was not persuaded that the Museum used the building design as a trademark. The court concluded, "...we are not dissuaded from our initial impression that the photograph in Gentile's poster does not function as a trademark."⁵² The Court found that Gentile's exhibits, although differing in that each depicted more than one landmark, were significantly similar with their initial impression of Gentile's poster.⁵³ The court viewed the photograph in Gentile's poster not as an indicator of source of sponsorship, but as an accessible, well-known, public landmark.⁵⁴ In other words, according to the court, the Museum in Gentile's poster was not a separate and distinct mark on the good, but, rather, was the good itself.⁵⁵

47. *Id.* at 754.

48. *Id.*

49. *Id.*

50. *See Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

51. *Rock and Roll*, 134 F.3d at 754.

52. *Id.*

53. *Id.*

54. *Id.*

55. *Id.*

Although the district court found that the Museum's building design was fanciful and functioned as a trademark, the appellate court found several problems with these findings. First, there was no evidence on the record which documented or demonstrated public recognition of the Museum's building design as a trademark.⁵⁶ The court added, "...we are at a loss to understand the district court's basis for this significant finding of fact."⁵⁷

Second, although there was no doubt that the Museum's building design was fanciful, a picture or drawing of the building was not considered by the court to be fanciful in a trademark sense.⁵⁸ A fanciful mark was defined by the court as a mark that was a, "totally new and unique combination of letters or symbols" that are "invented or selected for the sole purpose of functioning as a trademark."⁵⁹ Although the Museum had "invented" the building, the court felt that its existence as a downtown landmark undermined its fancifulness as a trademark. The court added, "A picture or a drawing of the Museum is not fanciful in the same way that a word like Exxon is when it is coined as a service mark. Such a 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 rather than as an identifier of source."⁶⁰

Although a mark can be both ornamental and a source-identifier, the court felt that the many varying uses of the building by the Museum worked against a trademark designation.⁶¹ The court believed that the differing uses of the building's image removed any consistency and prevented the creation of a distinct commercial impression as an indicator of a single source of origin or sponsorship. The court added that consistent and repetitive use of a designation as a source indicator is the hallmark of a trademark. Although the record supported the conclusion that the

56. *Rock and Roll*, 134 F.3d at 754.

57. *Id.*

58. *Id.*

59. *Id.*

60. *Id.* at 754-755.

61. *Rock and Roll*, 134 F.3d at 755.

Museum had used its composite mark in this manner, according to the court, the record did not support the conclusion that the Museum has made such use of its building design.⁶² The court compared the use of a depiction of the building to that of a famous person's likeness and pointed out the judgment in *Estate of Presley v. Russen*, which concluded that, although one particular image of Elvis Presley had been used consistently as a mark, "the available evidence [did] not support the broad position" that all images of Presley served such a function.⁶³ Similarly, the court did not support the Museum's "broad proposition" that all images of its building served the origin-indicating function of a trademark.⁶⁴

The court additionally was not persuaded that Gentile's use of the words, "Rock N' Roll Hall of Fame – Cleveland," was sufficient to sustain an injunction.⁶⁵ Because the district court did not give separate treatment to the words and the building design, the appellate court was uncertain as to how the district court would have viewed the use of the words in the event that the photograph was found to be non-infringing.⁶⁶ Absent the district court making such a finding the appellate court could not sustain the preliminary injunction on the grounds that the use of the words, "Rock N' Roll Hall of Fame" was alone likely to constitute a trademark violation.⁶⁷

DISSENTING OPINION

In dissent, Chief Judge Boyce F. Martin, Jr. argued that the Museum had devised a distinguishable token, appropriated that token to a particular class of goods, and plainly demonstrated quantifiable good will.⁶⁸ The Chief Judge felt that it was not Gentile's photograph of the Museum that infringed on the

62. *Id.*

63. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364 (D.N.J. 1981).

64. *Rock and Roll*, 134 F.3d at 755.

65. *Id.* at 756.

66. *Id.*

67. *Id.*

68. *Id.*

Museum's mark. Rather, it was the commercial use of the mark that unfairly competes with the Museum.⁶⁹ The Chief Judge felt that the selling of a poster of one's own trademark does not give the Museum, or anyone else, the right to enjoin duplication of their mark. Only when a trademark owner is forced to compete with those using pictures of their trademark in similar channels of commerce may the owner enjoin the user of their trademark.⁷⁰

The Chief Judge agreed with the Museum's Coke bottle analogy citing three distinct reasons for the analogies importance.⁷¹ First, the bottle allows the consumer to identify immediately what's inside the bottle; second, the bottle serves a utilitarian function by containing Coke; and third, the bottle has three-dimensions, regardless of the angle from which it is viewed, the bottle is still recognizable as Coke. When the Coke bottle is photographed it loses a dimension, but according to the Chief Justice, the subject of the picture remains recognizable as one of a trademarked, three dimensional figure.⁷² If the photograph of a trademark can be sold by the owner of the mark, the judge felt, the poster naturally must be recognized as one of the owner's "goods," albeit a derivative of the original.⁷³

The Museum argued, and the chief justice was persuaded that the building symbolizes something unique and protectable under trademark law.⁷⁴ The physical structure of the building, like the shape of the Coke bottle, aroused feelings in whomever viewed the Museum. Beyond embodying the freedom and youthful energy of rock-and-roll music the building served a utilitarian function.⁷⁵ Similar to the Coke bottle, the building is also a container, but instead of Coke, the building holds memorabilia and nostalgia. Furthermore, the chief justice believed that because the building is unique and distinctive, the varying uses of the image should not

69. *Rock and Roll*, 134 F.3d at 758.

70. *Id.*

71. *Id.* at 757.

72. *Id.*

73. *Id.*

74. *Rock and Roll*, 134 F.3d at 757.

75. *Id.*

matter.⁷⁶ Again analogizing to the Coke bottle, a photograph of the bottle, or the Museum, in any form and from any angle is still a photograph of the trademark.⁷⁷

The chief justice felt that the majority's conclusion that the building was not a separate and distinct mark on the good, but the good itself exposed a flaw in their logic.⁷⁸ According to the chief justice, Gentile's photograph was not a photograph of "the good," but rather, was a photograph of "the mark."⁷⁹ Applying the majority's logic, the chief justice concluded that the Museum sells buildings and Gentile sells photos of buildings.⁸⁰

Although the majority also rejected the idea that the Museum used its building design as a trademark, the plain meaning of the wording of the Lanham Act suggested otherwise to the chief justice.⁸¹ The chief justice failed to see, and did not read, the Lanham Act to mean simply that because a trademark is also the subject of a poster it should enjoy any less protection.⁸² Rather, the chief justice answered any doubts the majority had about the Museum using its building as a trademark by looking at the sequence of events in the case.⁸³ According to the Museum, versions of the building shape were used on T-shirts and a wide variety of products two-years before the Museum itself opened. As properly noted by the majority, there can be no trademark without a dependent product. If the Museum was using its trademarks before the building was completed, what were its goods? According to the chief justice, the goods were the promotional material published and sold, which announced the coming of a Museum in the future.⁸⁴

76. *Id.* at 759.

77. *Id.*

78. *Id.* at 758.

79. *Rock and Roll*, 134 F.3d at 758.

80. *Id.*

81. Lanham Act, 15 U.S.C. § 1127 (1994).

82. *Rock and Roll*, 134 F.3d at 758.

83. *Id.* at 759.

84. *Id.*

CONCLUSION

Ultimately, the court concluded that the district court abused its discretion by treating the Museum's building design as a single entity.⁸⁵ The district court also abused its discretion by failing to consider to what extent the Museum's use of its building design served the source-identifying function.⁸⁶ In light of the Museum's irregular use of its building design, the court felt that it was quite unlikely that the Museum would prevail on its claims that Gentile's photograph of the Museum is an infringing trademark use of the Museum's building design.⁸⁷ Additionally, the appellate court concluded that the district court failed to properly assess Gentile's use of the words, "Rock N' Roll Hall of Fame – Cleveland."⁸⁸ For all of the foregoing reasons, the judgment of the district court was vacated and remanded for further consideration.⁸⁹

Robert Q. Romanelli

85. *Id.* at 755.

86. *Id.*

87. *Rock and Roll*, 134 F.3d at 756.

88. *Id.*

89. *Id.*