

The logo for Astrachan Gunst Thomas features a stylized, swirling blue graphic to the left of the firm's name. The name "astrachan gunst thomas" is written in a lowercase, sans-serif font, with "astrachan" and "thomas" in a darker blue and "gunst" in a lighter blue.

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**GET IN ON IT!**

By: James B. Astrachan

Seems like a lot of buds have legal issues these days. Maybe it's just the people I hang out with. But, I guess that's good for business.

Joe – we'll name him this to protect his identity – develops and markets video games and does pretty well. He has several vacation homes and a 5,000 bottle wine cellar. In school, he was a member of the computer and math clubs and usually wore mismatched plaid pants and wore shirts with a pocket protector, and always studied, even on the weekends. Today, he employs one of the cool frat guys as his gardener. One of Joe's product lines is a series of video games called "East Coast", and each game in the series takes place in a fictional east coast city patterned after a real city. One of the games is called "More Bodies". Play the game for a few minutes and it becomes crystal clear that More Bodies is Baltimore City. The game is, of course, irreverent, crude and coarse, and is full of violence and sexual escapades. It portrays More Bodies as a downright seedy place to visit. Hey, "Get In On It!"

The videos are cartoonish, and the streets of "More Bodies" are populated with virtual stores: gun shops, liquor stores, lottery outlets, fast food restaurants, pawn shops, tattoo parlors and strip clubs. It's not likely the Mayor of Baltimore will hand Joe the keys to the City any time soon. Joe, of course, changes the names of the businesses he lampoons in his video game, but sometimes maybe not enough. His cartoons depict their signs and facades in a close, but not exact manner.

One of the strip clubs on More Bodies Street is called the 0'Oclock Club, and the cartoon depiction of 0'Oclock's building in the video game is similar, but not exactly the same, as that of the 2'Oclock Club that's been a fixture on the Block for decades. In fact, to get the cartoon depictions of streets and businesses close to real, photos are taken and the cartoons are created from the photos by off-shore cartoonists.

Joe was about to launch "Bodies More" and began to develop clay feet, fearing that he may be infringing the trademark rights of the 2'Oclock Club and maybe others.

He asked for an opinion. Of course, I had to test play the game for a few days to develop a sense of what he was doing.

Not that I have ever visited the 2'Oclock Club, but clearly, I saw that Joe's artists were inspired by the actual 2'Oclock Club. They pretty much copied the sign and exterior but not exactly, leaving off certain details. But clearly, if players of "More Bodies" knew Baltimore, they would get it.

"The question," I told Joe, "is whether you need to get the authorization of the 2'Oclock Club for your depiction? The answer is no."

"There are two possible defenses available to you if they object to your use and sue you," I said. "The first is the fair use defense of nominative use, but that likely won't succeed because you are not deliberately using 2'Oclock's mark for the purpose of comparison, criticism or point of reference." This occurs, for example, when someone writes about the Super Bowl and prints the words "Super Bowl." In other words, Joe could freely use the mark to describe the Club in a way that did not apply association between the Club and Joe. Here, though, Joe named the Club in his video game the 0'Oclock Club. Having not used the 2'Oclock mark, a nominative fair use should not apply. This was buttressed when Joe said he had not intended to comment on or criticize, the 2'Oclock Club in his game. It was just added for flavor.

Joe didn't look pleased with my comment, but I reminded him I had said there were two defenses, and the second was a dead-on, bell-ringing winner. It is called the First Amendment to the U.S. Constitution. "Courts," I said, "should use the Lanham Act to restrict an artistic work only where the public interest in avoiding consumer confusion trumps the public interest in free and artistic expression." I explained that the appropriate test to be applied is two-pronged. "That is," I said, "if your use of another's mark is artistic, that use will only violate the Lanham Act if the use has no artistic relevance to the video game you have created, or even if it does have relevance, its use explicitly misleads as to source or the content of your game – in other words, would your users think that the game was created by the 2'Oclock Club owners?" I explained that this test was first created by the courts to apply to the use of another's trademark in the title of a work, "But really," I told Joe, "there is no reason not to apply this test to your use of the mark in the video game.

I explained to Joe that a mere indication that the 2'Oclock Club might be associated with his video game will not be enough to fail prong two of the test. If that was the case, the First Amendment would never provide a defense. Joe shook his head in acknowledgement. He got it.

Joe's mere use of the 2'Oclock Club trademark variant, the 0'Oclock Club, is not enough to make the use explicitly misleading. The only similarity is that the game and the Club each provide somewhat of a coarse form of entertainment. Video games and

strip clubs are not like peanut butter and jelly, that is, they don't naturally associate in the minds of consumers. We discussed there is nothing in the game to evidence that the owner of the 2'Oclock Club had anything to do with "More Bodies."

"Hey," I questioned. "Why don't you approach the 2'Oclock Club folks and see if they want to sell your game in the Club?" Joe thought it was a great idea. He had never visited a strip club.

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*James B. Astrachan is the author of The Law of Advertising, published by Matthew Bender-Lexis/Nexis.*