The Interplay between Trade Marks and Identity Rights

By

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What Are Identity Rights?

• Identity: name, likeness, voice, or potentially any other characteristic that identifies someone (a person, not your company or pet)

• Typically called “the right of publicity” in the U.S., it is state-based protection

• Property right

• No federal right
Elements of a Claim

• Identity Rights (right of publicity) claim:
  – Does use (name, likeness, etc.) identify individual?
  – Commercial use?
  – No need to show likelihood of confusion or dilution

• State laws vary in scope of protection

• Not all states have statutes, some governed solely by common law or a mix of the two (or no clear protection)
Obama’s Brush With Identity Rights
Identity Rights Not Just for the Famous

- Protection extends to average people in most cases, including trademark lawyers.
- Pharma should consider identity rights when seeking U.S. trademark registrations, entering into endorsement contracts with celebrities, website promotions, and engaging in social media.
Lynda Carter: Zelnorm

Forbes Magazine article from 2002: “Novartis Calls Wonder Woman”
Ricky Williams: Paxil
Paula Deen: Victoza
Larry the Cable Guy: Prilosec
Personal Endorsements

• Conduct Clauses: “If [celebrity] commits any act or becomes involved in any situation or occurrence which brings her into public disrepute, scandal or ridicule, or shocks or offends the community, or derogates from the public image or reflects unfavorably upon [company]....”

• Control all manifestations of identity, obtain waiver of privacy interests and right to use biographical information

• Knowledge of scope of identity rights helps to avoid pitfalls
Oddball Case Puts Identity Rights on the Map

- U.S. Supreme Court recognized identity rights-based laws—right of publicity
- May co-exist with copyright law
- Not subsumed by First Amendment
Identity Rights distinguished from Trademark Law

Trademark count fails, but ROP claim prevails in federal court
Application blocked in USPTO
Identity rights pushed to an extreme?

- Game show hostess portrayed as robot: spurs debate
When is a compliment an ad?

A Shoe In!
After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan’s elevation in the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was “just around the corner” for so many years.
Singing Voice (two case examples): Astrud Gilberto and Tom Waits

Court in Waits: “Waits has a raspy, gravelly singing voice, described by one fan as ‘like how you’d sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades…. Late at night. After not sleeping for three days.’”
Post-Mortem rights (two case examples)

- Many states have not addressed the issue
- A few states have no post-mortem rights: New York, Wisconsin, and arguably Louisiana
- Terms range from 10 years or eternity through use in Tennessee (like trademark law)
- 50 (Illinois and Texas), 60, 70, 75, and 100 years: Some statutes reach back
Challenging claim/defenses

Challenge the merits:
- No identification
- Minority of states: insufficient fame/commercial value

Defenses:
- First Amendment
  - Anti-Slapp
- Copyright preemption
- Communications Decency Act
- First sale doctrine
First Amendment Question
Over Avatar Use

- Class action suits over use of avatar images of college athletes in video games
- 9th and 3rd Circuits found use not protected by 1st Amendment because not transformative
- Settlements included high $ payments
Interplay with Trademark Rights

• Many celebrities obtain trademark registrations in their names
  – Tiger Woods’ Signature

• Registrations may extend post-mortem
  – As long as there is use in commerce, a mark may be used forever if unchallenged
  – Trademark rights supplement identity rights protection
Trademark Infringement, Unfair Competition, False Endorsement
Interplay With Trademark Law

Section 2(a) of Lanham Act embraces right of publicity concepts to block or cancel a registration:

- NO Likelihood of confusion necessary
- Falsely suggest a connection
- Someone uniquely identified with mark

• Section 2(c) of Lanham Act similarly influenced by right of publicity
U.S. Trademark Office: Two §2(a) Disputes – Twiggy and Margaritaville
Clearance

- Does the mark identify someone?
- Check right of publicity post-mortem recordation provisions in some states, such as California
- Deciding what state’s ROP law to apply can be difficult, yet may be determinative
- Identity right also may be covered by a trademark registration
International Protection

• Different bases for protection than within the United States
• Protection akin to right of publicity and privacy laws in some places
• Not every country has this protection
• Need to look at each country or region
Conflicts of laws (three cases): State ROP laws versus UK law
Assignments and Licenses: Basic Considerations

Similar to trademark agreements:

- Territory covered (country, one website or others)
- Products or services at issue
- Duration (e.g., post-mortem) and scope (degree of exclusivity)
- Termination clauses pertaining to conduct of celebrity
Securing Consent to Use Identities

• E-Sign Act
• Click-through license
• Create and follow verification procedures (college roommate problem)
• Need consideration or be ready to take down
• Remember consent from employees too
Social Media

- Analyzing the FDA’s Draft Guidance on Social Media Important
- Another point of consideration is the impact of identity rights
- Websites and applications that operate as platforms for users’ identities
Social Media

- Landscape is continually shifting and growing
- Creates potential for right of publicity infringement by: platforms themselves, individual users, corporate users
- Identities of celebrities and regular users at issue
#TeamBistro @SneakerBistro
Available Now @SneakerBistro! #LINSANITY twitpic.com/a66o3d

View photo
Katherine Heigl & Duane Reade

Duane Reade
@DuaneReade

Love a quick #DuaneReade run? Even @KatieHeigl can’t resist shopping #NYC's favorite drugstore bit.ly/1gLHctl pic.twitter.com/uGTC3k1Mii

Reply Retweet Favorite More
Twitter: Case in Illinois

Co-workers take over plaintiff’s personal Twitter account to send tweets while she is hospitalized—ROP claim stated
Infringement by Platforms: Fraley v. Facebook, Inc.

- Class Action suit permitted to proceed
- Settlement: Better notice ordered re terms of use
- Terms of settlement closely analyzed
Room for Parody
Pinterest

Most content not user generated;

Pin images to boards; share, follow, and comment on boards
Practical Tips for Companies: ROP in Social Media

- Have a social media clearance plan and procedure, not just for right of publicity, but for FDA, copyright, trademark and advertising issues as well
- Consider strictly limiting re-tweeting or re-pinning
- Have a point person trained in social media and corporate policies
The End! Enjoy Chicago!
Citations In the Order Presented

- 1A Lindey on Entertainment, Publishing and the Arts § 3:34 (endorsement contract language)
- White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992), reh'g denied, Judge Kozinski dissent, 989 F.2d 1512 (9th Cir. 1993) (suggest reading main decision and dissent)
- Jordan v. Jewel Food Stores, Inc., 743 F.3d 509 (7th Cir. 2014)
- Oliveira v. Frito-Lay, Inc., 251 F.3d 56 (2d Cir. 2001)
- Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992)
- Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188 (5th Cir. 1998)
- Hart v. Electronic Arts, Inc., 717 F.3d 141 (3rd Cir. 2013)
- In re NCAA Student-Athlete Name & Likeness Licensing Litigation, 724 F.3d 1268 (9th Cir. 2013)
Citations Continued

- Carson v. Here's Johnny Portable Toilets, Inc. 698 F.2d 831 (6th Cir. 1983)
- Bi-Rite Enterprises, Inc. v. Bruce Miner Co., 757 F.2d 440 (1st Cir. 1985)
- Love v. Associated Newspapers, Inc., 611 F.3d 601 (9th Cir. 2010)
- [link](http://www.hollywoodreporter.com/thr-esq/katherine-heigl-ends-lawsuit-duane-728552) (Katherine Heigl dispute did not result in a published opinion)