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Right of Publicity

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The Use of Celebrity Look-Alikes in Advertising and the Interplay Between State Right of Publicity and Federal Trademark Infringement Claims

What is a world-wide, massively popular pop music star and actor supposed to do when a company negotiates with her to secure her image in an endorsement deal, declines to pay her asking price, but then goes ahead, without permission, and runs advertisements using a model that looks almost exactly like her, is dressed in almost identical clothing to what she wears in her music videos, and poses in ways that evoke her image as well? The complaint almost writes itself. Ariana Grande's lawyers had a lot to work with in preparing her lawsuit against retailer Forever 21 (which just filed for bankruptcy protection) and its affiliated beauty boutique Riley Rose, for their advertising campaign which allegedly "stole her name, likeness and other intellectual property to promote their brands for free." *Ariana Grande-Butera p/k/a Ariana Grande and Grandari, Inc. v. Forever 21, Inc.*, Case 2:19-cv-07600 (C.D. Cal. 2019).

Celebrity lawsuits based on the use of look-alikes are nothing new, nor is the sheer brazenness of the defendant to go ahead with a

campaign using a look-alike after negotiations with the genuine article failed. What does deserve some additional scrutiny from a legal perspective, however, is the interplay between the state-based celebrity right of publicity claim and a claim for false endorsement based on the federal Lanham Act. Although these claims are often asserted simultaneously, as they were in Ariana Grande's case, they vindicate different rights and have different burdens of proof.

The Right of Publicity

The right of publicity is a state-derived legal protection, giving individuals the inherent right to control the economic interest in and commercial use of their identity and persona. A majority of states extend this right to everyone, not just celebrities. J. Thomas McCarthy & Roger E. Schechter, *The Rights of Publicity & Privacy* § 4:16 (2d ed. 2019). The right is a property right, and thus its infringement is a commercial tort of unfair competition. *Id.* § 1:3.

The right of publicity can be either a statutory right, a common law right, or both, and it prohibits the unconsented use of one's identity to draw attention to a product or advertisement. *Id.* § 5:19. A *prima facie* claim requires pleading that the plaintiff owns an enforceable right in their identity, and that the defendant's commercial use is likely to cause damage to the commercial value of the identity. *Id.* § 3:2. The right is not absolute; certain commercial uses of a person's identity

are permissible, and common exceptions include uses in news, public affairs, sports broadcasts, political campaigns, criticism, parody, satire, and the advertising of a work created or performed by that person.

The use of celebrity look-alikes has long been restricted by the right of publicity, as the key is not that the celebrity's actual image is used, but rather that the celebrity's identity or persona is evoked in advertising without permission. Indeed, any evocation of the likeness of a celebrity—a look-alike, a drawing, even just an illustration—communicating a person's identity or persona may violate publicity rights. *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254 (Sup. Ct. 1984), *aff'd*, 110 A.D.2d 1095, 488 N.T.S.2d 943 (1985) (advertiser included photograph of actual celebrities along with Jacqueline Onassis look-alike). Even the use of a mere robot wearing a blond wig in front of a board of letters, evocative of a famous letter-turning game show hostess, may be sufficient to infringe the right of publicity. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (1993).

Ultimately, the basis for the right of publicity is that the law gives celebrities the right to control the economic interest in their own persona. An action for infringement of the right of publicity asserts that a third party used the celebrity's persona without consent, wrongfully enriching themselves while causing harm to the celebrity's identity.

Section 43(a) of the Lanham Act

The right of publicity is distinguished from Section 43(a) of the

Lanham Act, 15 U.S.C. § 1125(a) (2019), because the Lanham Act's focus is on preventing consumer confusion about celebrity affiliations with, and endorsement of, products or brands, not protecting the value of a person's commercial identity. As the Sixth Circuit explained, Section 43(a) protects celebrities against misleading commercial uses of their identities by third parties, and "courts routinely recognize a property right in celebrity identity akin to that of a trademark holder under §43(a)." *Parks v. LaFace Records*, 329 F.3d 437, 445-47 (6th Cir. 2003). Lanham Act claims are designed to protect the public from consumer confusion based on falsity, and that falsity may be a misleading description or representation of fact that either (a) constitutes a false endorsement, in that it is likely to cause confusion or deceive as to the affiliation, connection or association of a person with another, or as to the origin, sponsorship, or approval of a person with another's goods, services, or commercial activities, or (b) constitutes a misrepresentation of the nature, characteristics, qualities, or geographic origin of a person's goods, services, or commercial activities. 15 U.S.C. §§ 1125(a)(1)(A-B). For example, when an advertiser used an alleged sound-alike of Tom Waits, who has a very distinctive voice and singing style, in a commercial, Waits' Lanham Act false endorsement claim was successful because the evidence supported the jury's finding that the commercial caused consumers to be confused into thinking, falsely, that Waits endorsed the defendant's product. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992). Note further than a false endorsement claim under the Lanham Act requires a showing only of a likelihood

of confusion or deception as to sponsorship or endorsement, not proof of actual deception. 5 McCarthy on Trademarks and Unfair Competition § 28:15 (4th ed. 2008).

Differences between False Endorsement under the Lanham Act and the Right of Publicity

As in the *Ariana Grande v. Forever 21* complaint, when faced with advertisements using celebrity look-alikes, or indeed any allegedly wrongful use of a celebrity's persona without permission, plaintiffs usually plead both false association under section 43(a) of the Lanham Act and infringement of the right of publicity. While similar, the claims have important differences:

1. Falsity: a right of publicity claim does not require proof of falsity, whereas a false endorsement claim is expressly premised upon creation of a false impression of endorsement or affiliation in the minds of consumers between the advertiser's products or services and the celebrity;
2. State v. Federal claims: while the Lanham Act is a federal statute with its attendant (mostly) uniform treatment across the country, the right of publicity is a state-based claim that can and does treat celebrities' claims differently depending on the elements of a specific state's laws; and
3. Protection / Vindication of different parties' rights: the Lanham Act protects consumers from confusion about

celebrity endorsements, while the right of publicity protects celebrities' inherent right to control the commercial use of their identity or persona.

Kimberly Rubin, *The Key to Being a Good Referee: The Call The Ninth Circuit Missed When Evaluating False Endorsement Claims*, 64 Emory L.J. 1389, 1399 (2015).

The Use of Look-Alikes and Sound-Alikes

Advertisers make cost-benefit legal calculations about their actions and practices all the time—"Will they sue? Will they win?" The use of celebrity look-alikes and sound-alikes in advertising is no different a calculation, and some cases are stronger than others depending on the facts.

The *Ariana Grande* case likely falls into the "stronger" category given the facts, including allegations that Forever 21 specifically approached the singer and attempted to negotiate an endorsement deal. Other elements asserted in the complaint bolstering the action include:

- Use of a model who looks strikingly similar to Grande;
- Wearing a similar hairstyle and a similar distinctive hair accessory to those worn by Grande in a famous video;
- Dressed similarly to Grande in numerous well-known photographs;
- Using a pose virtually identical to the pose in which Grande was photographed;
- Using captions in social media posts containing lyrics from Grande's famous song.

Actress Lindsay Lohan was recently on the losing end of a similar claim, when she attempted to sue Take-Two Interactive for including an avatar that supposedly looked like Lohan in its game Grand Theft Auto V. The court dismissed Lohan's complaint for lack of potential confusion because "[t]he artistic renderings are indistinct, satirical representations of the style, look, and persona of a modern, beach-going young woman." *Lohan v. Take-Two Interactive Software, Inc.*, 31 N.Y.3d 111, 112, 97 N.E.3d 389 (2018).

Similarly on the losing end (a long time ago) was Nancy Sinatra, who was well-known in the 1960s for singing and popularizing the hit song "These Boots Are Made for Walkin." The Goodyear Tire & Rubber Company approached Sinatra's agent to negotiate a formal deal, but were unable to agree on terms. After Goodyear Tire ran a series of commercials using the song (and after legally and properly securing copyright licenses to use the song), Sinatra sued arguing that the song was so popular

and so connected with her persona, and that the commercials used a singer whose voice and style was deliberately intended to imitate her own, that the public was deceived into believing that Sinatra was a participant in the commercials, thus endorsing Goodyear Tire's products. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712 (9th Cir. 1970). The Ninth Circuit dismissed her complaint, concluding that mere "imitation alone does not give rise to a cause of action" and that her voice was not distinctive enough to be recognized. *Id.* at 713.

Conclusion

Celebrity endorsements in advertising have long been viewed as a better way to bring attention to a brand or product than an advertisement with unknown models or actors, which is why celebrities can command such a high price for their endorsements. Some celebrities even chose not to appear at all in any commercial advertising, which the right

of publicity (and the right of privacy) empowers them to do. When companies are not successful in properly securing the legal right to use a celebrity's image, identity, voice, or persona in an advertising campaign, they may be under the mistaken impression that it is nevertheless permissible to use a look-alike or sound-alike, in order to evoke the celebrity's image in the minds of the public in connection with its own product, while not actually using the celebrity's image. The right of publicity and the false endorsement branch of the Lanham Act, however, give celebrities powerful tools to correct any such mistaken impression.

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