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Presidents, Public Figures and the Right of Publicity

by Allison Gifford

Have you encountered the omnipresent presidential or political figure novelty items and wondered, “Is that allowed?” or “That product couldn’t possibly be endorsed by politician So-and-So”? Can a party profit from using someone else’s name and likeness without permission? Almost weekly there are news reports of celebrities (although private citizens can also assert their right of publicity against unauthorized use) enforcing their right of publicity against a third party using their name, likeness or voice. For example, Olivia de Havilland, the 101-year-old actress of “Gone With the Wind” fame, is currently challenging an FX Networks’ portrayal of her in its docudrama “Feud: Bette and Joan,” claiming that she was portrayed in a false light and that her name and image were taken without any compensation.

It would follow that a president or any public figure could assert his or her right of publicity against third parties. Interestingly, not many presidents or public figures have made the assertion, given the adverse publicity from asserting a claim and not being able to “take a joke.” But what if the president of the United States were a businessman in his pre-presidential life who built his business around his brand, name and likeness? That would call to mind only one person, and that is President Donald J. Trump.

A. Right of Publicity – An Overview

Every individual has the inherent right to control the commercial use of his or her identity. An individual’s right of publicity is infringed by an unpermitted use, which will likely damage the commercial value of this inherent right of human identity. Unlike federal trademark law, however, the right of publicity is almost exclusively the domain of state law. Although there is no federal right of publicity statute, the U.S. Supreme Court recognized the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). The Court held that the right of publicity is a proprietary right with goals similar to the goals of patent and copyright law. No other U.S. Supreme Court case has considered a right of publicity claim.

Almost all states currently recognize a right of publicity claim, about 30 under their common law and the rest under statute (e.g., Pennsylvania). A few states (e.g., California) have both a common law and a statutory right of publicity cause of action. The New York courts have held that there is no common law right of publicity and that publicity rights exist only within a 1903 statute. The Restatement (Third) of Unfair Competition embraces the concept, providing in Section 46 that “one who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.”

Trademarks and the right of publicity are similar but differ in several ways. Although both are considered intellectual property and are considered under the law of unfair competition,

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the purposes of both are different. The right of publicity hinges on the commercial value of human identity; trademark rights hinge on words or symbols identifying and distinguishing a commercial source.

Generally, the following are elements of a claim for infringement of the right of publicity: (1) the plaintiff owns an enforceable right in the identity of a human being; (2) without permission, the defendant has used some aspect of the identity or persona in such a way that the plaintiff is identifiable from the defendant's use; and (3) the defendant's use is likely to cause damage to the commercial value of that persona.

The standard test for trademark infringement is likelihood of confusion as to source, sponsorship or affiliation. Trademark infringement claims can be brought under both federal and state law. Because the federal and state laws are largely consistent, most cases are brought in federal court. Most of the federal courts recite a list of the factors for considering likelihood of confusion, including (1) similarity of the marks, (2) strength of the plaintiff's mark, (3) intent of defendant in adopting the mark and (4) product similarity.

B. Celebrities and the Right of Publicity

There are thousands of right of publicity lawsuits that have been brought by celebrities and professional athletes. A sampling follows:

1. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). The U.S. Court of Appeals for the Sixth Circuit held that night-show host Johnny Carson's right of publicity was violated by the defendant's use of the phrase "Here's Johnny" and the phrase "World's Foremost Comedian." The appellate court affirmed the district court's ruling, however, that the "Here's Johnny" trademark was not infringed because there was no likelihood of confusion: There is no likelihood that the public would believe Johnny Carson sponsored or otherwise approved the use of the trademark in connection with toilets.
2. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992). Vanna White, the letter-turner for "Wheel of Fortune," sued Samsung over its use of a robot that looked and acted like White. White prevailed because her image and popularity were deliberately used and White was readily identified in the Samsung advertisement.



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3. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Calif. 2001). Many times defendants assert a defense based on First Amendment principles. There is often a free speech defense to a right of publicity claim, and in some jurisdictions, such as California, the courts consider tests for balancing the right of publicity against free speech policies according to the relative importance of the interests at stake. For example, in California, a "transformative test" was used to balance the right of publicity of deceased comedians The Three Stooges against free speech interests in artistic drawings of The Three Stooges on art reproductions and T-shirts. The right of publicity was upheld.
4. *Cardtoons, L.C. v. Major League Baseball Players Association*, 95 F.3d 959 (10th Cir. 1996). This case upheld a First Amendment defense of parody, a recognized form of free speech. The Tenth Circuit found that the defendant's parody of professional baseball player trading cards received full protection under the First Amendment, as the cards provided social commentary on public figures. The court further stated that the speech was not core political speech but was commentary on an important social institution, baseball, and was protectable expression. But consider...
5. *Hart v. Electronic Arts Inc.*, 717 F.3d 141 (3d Cir. 2013). The Third Circuit reversed the district court's ruling that First Amendment protection applied to creative use of college athletes' likenesses in NCAA video games. The Third Circuit found no transformative use of the college athletes, balancing the right to free expression in the video games against the interests in protecting the right of publicity. This case was a big win for athletes and celebrities alike.

C. Presidents and Public Figures

Moving from a celebrity's to a public figure's or president's

right of publicity, it is rare that a sitting politician or president brings a right of publicity action. Oftentimes the politician does not want to appear sensitive or spend the time and expense on such litigation. One case that stands out in recent years is former Gov. Arnold Schwarzenegger's 2004 suit in California against an Ohio company that created and sold a machine gun-toting bobblehead doll in his image. The suit settled with the Ohio company agreeing not to sell the Schwarzenegger doll. The defendant company sold other bobblehead dolls of political figures and had no issues, and defended its right to manufacture and sell the Schwarzenegger bobblehead doll because it was a legitimate expression of First Amendment rights and was clearly a satire or parody of the governor.

The Schwarzenegger case was apparently the first time a politician in office sued under the right of publicity to prevent the sale of a product that incorporated the politician's image or likeness. The lead attorney for the bobblehead manufacturer found the case to be one of first impression in California, in which the scope and limits of the right of publicity were considered against a First Amendment right of free speech. In addition, Schwarzenegger was not only a political figure but also a Hollywood star. Unfortunately, with the settlement of the Schwarzenegger case, this first impression case did not lead to a decision by the California courts and, therefore, offers little guidance.

President Barack Obama asserted his right of publicity several times during his presidency, in particular when his children were involved. No lawsuits were initiated by Obama, so it is safe to assume that the alleged infringers involved ceased their challenged activity. Other examples follow of public figures asserting their right of publicity, with differing results.

1. Jesse Ventura, as governor of Minnesota, sent a cease and desist letter to a Valentine's Day card manufacturer that depicted a likeness of Ventura wearing a feather boa and a heart-covered wrestling leotard. The card manufacturer complied.
2. Spiro T. Agnew, Richard Nixon's vice president, brought legal action against a dartboard manufacturer that produced a dartboard bearing Agnew's likeness. This suit appears to be the straw that broke Agnew's back, as other novelty items featuring him were taken in good humor by Agnew. The manufacturer argued that its dartboard was political commentary and protected by the First Amendment. The parties settled out of court.

3. New York City Mayor Rudy Giuliani was unhappy that his name was used in advertisements for *New York* magazine that appeared on buses. His complaint was rejected by a federal judge because Giuliani chose to be a public figure by running for mayor and could not avoid publicity – whether good or bad.

D. President Trump's Right of Publicity

Go to Amazon.com and type in "Donald Trump," and a plethora of novelty items appear, including talking toilet paper rolls, talking dolls, talking pens, masks and stress balls – among other items. Many other websites sell novelty items bearing the Donald Trump name, his likeness and his voice. To date, Trump does not appear to have taken legal action against any of the novelty manufacturers. What is difficult to know is whether he, through his personal lawyers, is sending cease and desist letters to any alleged infringers. On the other hand, we know that The Trump Organization files letters of protest against any application to register a trademark containing the word TRUMP filed with the U.S. Patent and Trademark Office, thus enforcing rights in the TRUMP trademark.

Should Trump assert his right of publicity and trademark rights against unlicensed and unauthorized use? Trump continues to have a brand to protect. But is that brand better protected via The Trump Organization or himself as a sitting president? Should he use the resources of his White House attorneys to enforce his right of publicity? Does it matter what the product is? For example, will a naked Trump doll, exaggerating and drawing attention to certain body parts, with his actual voice discussing those body parts, be the proverbial straw that breaks the camel's back, as happened with Agnew? Would he win? There remains the tension between First Amendment rights and protecting a public figure's likeness from commercial gain.

Trump, like Ventura and Schwarzenegger, was a celebrity before becoming a politician, so the need to continue to protect his brand remains. Should he assert his right of publicity against those profiting from selling an unlicensed and unauthorized talking pen bearing his likeness and using his voice, he does so knowing that he might appear to the public to be sensitive and unable to take a joke. On the other hand, others are profiting from his likeness and name, and he has a right to enforce publicity and trademark rights. Further, if Trump waits until he leaves office, he runs the risk of being barred from bringing an action or that he implicitly authorized the use of his image by inaction. We can only guess at whether those issues are being considered by Trump and his team. ■

Trademark Genericness: What Is the “Primary Significance”?

by Kevin R. Casey

A trademark or, more generally, a mark, is a “designation” or “symbol” that allows purchasers to identify goods or services that, in the past, have been satisfactory and to reject goods or services that, in the past, have been unsatisfactory. Marks also allow businesses to distinguish their goods or services from those of competitors and to identify themselves as the source of particular goods or services; thus, marks are symbols of the good will of products or services of the business. A common synonym for a mark is a brand name, like CREST for toothpaste or SAKS for department store services.

The common name for the kind of good or service identified can never be a trademark because it cannot perform the functions of a trademark outlined above. An example is LITE for low alcohol beer. Terms not initially generic can become generic. Xerox has taken pains recently to stop people from calling copies “xeroxes.” The reason: If Xerox becomes, through use, another noun meaning copy, then it has lost its ability to distinguish Xerox copies from those of Ricoh, Toshiba and others. A mark must be an adjective: Xerox copy. If a designation becomes a noun or verb, it is no longer a mark. The table following this text shows a graveyard of once and former marks that have lost their source-identifying significance and, as victims of “genericide,” have become generic terms free for all to use.

Of course, the determination of whether a designation is generic depends on the goods or services in connection with which it is used. The designation “apple” would be generic if used on apples, for example, but is a strong trademark when used on computers because it is distinctive as arbitrary (i.e., a term unrelated to computers). The test used to determine whether a term is generic is whether the “primary significance” of the term in the minds of the consuming public is the product (a generic term) or the producer (a trademark). Two noteworthy cases just applied that test.

In *Elliott v. Google*, Case No. 15-15809, the U.S. Court of Appeals for the Ninth Circuit considered the appeal of two men (the plaintiffs) who have bought hundreds of domains containing the term “google” and argue that “google” is so commonly used that it has become a generic term meaning “to search the internet” and, therefore, is not a valid trademark for the popular search engine. The district court had dismissed the case, granting Google summary judgment on the issue. The Ninth Circuit heard

oral argument on March 17, and decided the case on May 16, 2017.

During the argument, counsel for the plaintiffs summarized evidence – including consumer surveys, the testimony of two linguists and dictionary definitions – suggesting that the term has become generic. The evidence at least raised an issue of fact sufficient to go before a jury, counsel argued, and avoid summary judgment. The Ninth Circuit panel wondered, in response, why the consuming public could not use the term “google” colloquially in a general sense, while understanding it as a trademark referring to a specific company as well, just as “coke” can mean Coca-Cola but can also refer to similar sodas, like Pepsi. (The court made an interesting reference, given the second case highlighted below.) The court asked, “If the consumer understands there is a distinction between the two, why does that establish [genericide]?” and answered for itself, “It just means that we’ve developed a shorthand term, which everyone knows comes from the preeminent search engine on the internet.”



“That’s exactly what happens in genericide,” plaintiffs’ counsel replied. “Look at the marks that have been made generic. People use ‘escalator’ to mean a moving staircase, and the court [there] said, ‘Sorry, I know you spent a lot of time developing this and marketing it, but you’ve done so well that everyone knows a moving staircase is an escalator [so] we’re going to adopt that.’ Yo-yo, aspirin, heroin: these are all generic forms of a trademark that the owners were not happy about.”

Google’s counsel questioned the plaintiffs’ evidence. She told the court: “It was plaintiffs’ burden in this case, where we have a registered mark, to show that the Google mark had become generic. ... The fact that many people may use a mark casually in conversation as a verb, an adjective or some other part of speech doesn’t answer the question of whether its primary significance is as a trademark or not. That question goes to what people understand, the mind of the consumer. Their evidence is not sufficient. It was plaintiffs’ burden, and they didn’t meet it.” All are encouraged to “google” the internet and read the Ninth Circuit’s decision affirming the district court’s summary judgment in favor of Google: The GOOGLE mark is not generic.

In the second recent case addressing genericness, the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office ruled in May 2016 that Coca-Cola Co. can

register a slew of trademarks for its “Zero” brand. The ruling gave the company a major victory in its 13-year quest to win exclusive control of the brand. The TTAB rejected claims from Dr. Pepper Snapple Group Inc. that the term “Zero” is a generic, unregistrable term for zero-calorie soft drinks. The TTAB found the evidence that consumers consider “Zero” to be a generic type of beverage “insufficient.” “This handful of public references spread over five years does not establish that ordinary consumers primarily use or understand the term Zero to refer to the genus of soft drinks,” stated the TTAB. “This is particularly true in the context of the ubiquity of [Coca-Cola]’s Zero products, which have had billions of dollars in sales since they first entered the market in 2004.”

Dr. Pepper Snapple Group Inc. urged the U.S. Court of Appeals for the Federal Circuit last November to reverse the TTAB’s decision, arguing the numerical term is widely used in the soft drink industry “and must remain free for use.” The Federal Circuit heard oral arguments on Aug. 8, 2017. Thus, all might



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want to enjoy a few “zero” drinks while waiting for the Federal Circuit to decide the fate of the ZERO term. Interestingly, Coca-Cola has faced challenges around the globe in securing rights to “Zero.” The U.K. refused to register the brand in 2008 following a challenge from PepsiCo, and the Canadian Intellectual Property Office rejected the name in 2016. ■

 <p>ASPIRIN</p>	 <p>ZIPPER</p>	 <p>CELLOPHANE</p>
 <p>KLEENEX</p>	 <p>YO-YO</p>	 <p>TRAMPOLINE</p>
 <p>ELEVATOR</p>	 <p>LINOLEUM</p>	 <p>SHREDDED WHEAT</p>

IP Client Spotlight

Stradley Ronon handles IP law (patents, trademarks, and related areas) matters for Fiber-Line, Inc. The company was founded in 1987 as a part-time venture for recycling high-performance synthetic fiber products. The Fiber-Line name describes the process of turning fiber into line ready for use. At its inception, the company had four part-time employees and occupied 400 square feet of space. Today, 30 years later, Fiber-Line is an international company with over 150 employees and four locations (Hatfield, Pennsylvania; Hickory, North Carolina; the Netherlands; and Shanghai) that provides high-quality products to a broad range of markets for customers around the globe. Among its products are ripcords, water-blocking yarn, fiber-reinforced polymer, strength members, packing yarn, belt and hose reinforcement yarn, industrial fabric yarn, wire harness yarn, and customized Kevlar® solutions. Its markets include fiber optics, oil and gas, industrial, and synthetic wire.

The focus of Stradley Ronon's IP work with Fiber-Line has been on securing (1) patent protection for Fiber-Line's water-

swellable coatings, coated substrates and methods of making coated substrates and (2) trademark protection for Fiber-Line's various logos and brands. Other IP issues addressed by Stradley Ronon on behalf of Fiber-Line have been enforcement of IP rights, IP licensing, and patent searching and analysis in support of entry into new markets. Stradley Ronon is proud to assist Fiber-Line in its efforts to navigate complex IP issues faced by a startup company as it grows and expands, along with a variety of non-IP work (including business negotiations, contracts and acquisitions). ■



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