LJN LAW JOURNAL NEWSLETTERS
Entertainment LAW & FINANCE

Persona Rights on Trial

Inside the Nevada Litigation by Bob Marley's Heirs Against the Unauthorized Use of Marley's Image

March 2011
By Barry E. Mallen and Paul Bost

Celebrities have often used claims of unfair competition by false association or false endorsement under §43(a) of the federal Lanham Act as a basis for recourse against the unauthorized use of aspects of their identities and personas. The potency of a celebrity association claim was recently reinforced in the U.S. District Court for the District of Nevada, where in February 2011 a jury found for Fifty-Six Hope Road Music Ltd. (composed of Bob Marley's heirs) and Zion Rootswear LLC (Hope Road's exclusive licensee for apparel) in their claims against A.V.E.L.A. Inc., its principal, Leo Valencia, and two of A.V.E.L.A.'s licensees, JEM Sportswear and Central Mills Inc. (d/b/a Freeze), for willful unfair competition under the Lanham Act and tortious interference with prospective economic advantage. *Fifty-Six Hope Road Music Ltd. v. A.V.E.L.A. Inc.*, 2:08-CV-00105.

Lanham Act As Alternative to Right to Publicity

The jury awarded the plaintiffs $300,000 in actual damages on their interference claim. Also, District Judge Phillip Pro issued a permanent injunction. In a second phase scheduled to commence shortly, Judge Pro will decide the amount of profits earned by the defendants as result of their infringing activities that are to be disgorged in favor of the plaintiffs (an amount estimated at approximately $3 million), as well as the issue of "enhanced" damages under the Lanham Act based on the jury's finding of willful infringement. This jury verdict confirms that under certain circumstances a celebrity association claim under the Lanham Act is a powerful addition or alternative to a state right of publicity claim, including, based on the enforcement of a federal statute, the advantage of being able to obtain a nationwide injunction. The verdict also serves as a cautionary tale to indemnified licensees, namely, that they risk a finding of willful infringement if, in reliance on their right of indemnification, they turn a blind eye to whether their licensor owns the rights it purports to license.

Hope Road filed suit against the defendants in January 2008 after learning that A.V.E.L.A. had licensed Bob Marley photographs, most of which it had acquired from well-known photographer Roberto Rabanne, to manufacturers for use on apparel, towels and other merchandise, including, and rather infamously, a cartoonish Marley bobblehead doll, its packaging adorned with images of Bob Marley. The products were sold by major retailers such as WalMart and Target. JEM, the biggest seller among A.V.E.L.A.'s licensees, alone earned approximately $2.8 million from its sale of Marley apparel.

Celebrity Identities

In this case, the plaintiffs were unable to avail themselves of the Nevada state right of publicity statute, NRS §597.770 *et seq.*, given the statute's unique registration requirement. The defendants alleged that the statute effectively acted as a bar on Hope Road's ability to enforce Bob Marley's right of publicity within Nevada, based on Hope Road's failure to register its claim to Bob Marley's right of publicity within six months of allegedly having knowledge of an unauthorized use of Marley's likeness in Nevada.

Alternatively, the plaintiffs alleged violation of §43(a) of the Lanham Act, along with the state law claim for interference with prospective business relationships. The plaintiffs' ultimately successful Lanham Act claim was

based on the position that the defendants' use of Bob Marley's image on merchandise falsely associated their products with, or constituted a false endorsement of their products by, Bob Marley's rights holders. The U.S. Court of Appeals for the Ninth Circuit and other circuit courts have held that celebrities have a protectable right in their identities and personas, akin to a trademark owner's rights in a trademark, such that the unauthorized use of an aspect of a celebrity's identity — *e.g.*, image, likeness, voice or other distinguishing characteristics — may constitute false association or endorsement.

Famous examples of celebrities suing on these grounds have included Tom Waits' suit against Frito-Lay for use of an alleged sound-alike in a commercial (*Waits v. Frito-Lay Inc.*, 978 F.2d 1093 (9th Cir. 1992)), Rosa Parks' suit against the rap group Outkast for use of her name as a title to a song (*Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003)), and George Wendt and John Ratzenberger's ("Norm" and "Cliff" of Cheers fame) suit against an operator of airport bars that installed robotic bar patrons resembling their famous characters (*Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997)). In these and other cases, courts have reaffirmed that celebrities are entitled to recourse under the Lanham Act if their identity is used without their permission and consumers are likely to be confused as to the celebrity's association with or endorsement of the commercial activities at issue.

Celebrity association and right of publicity claims are similar; courts have noted as much. For example, the Sixth Circuit noted that a "Lanham Act false endorsement claim is the federal equivalent of the right of publicity." *See*, *ETW Corp. v. Jireh Publishing Inc.*, 332 F.3d 915, 924 (6th Cir. 2003), citing Bruce P. Keller, "The Right of Publicity: Past, Present, and Future," 1207 *PLI Corp. Law and Prac. Handbook*, 159, 170 (Oct. 2000). Both protect against the unauthorized use of a person's image, voice or name. Both are also descendible property rights. And both protect against a wider scope of unauthorized uses than a trademark right in a discrete word or image. Unlike a Lanham Act claim, though, the contours of a right of publicity claim are shaped by the law of the state at issue, including notably whether a particular state recognizes posthumous claims and whether it has implemented a registration scheme of some sort. Similarly, and important for a celebrity whose image or persona is being exploited nationally, a right of publicity claim only protects unauthorized use on a state-by-state basis, whereas a celebrity association claim calls for national relief.

Also importantly, unlike a right of publicity claimant, a celebrity association plaintiff must show that the use of the celebrity's identity has resulted in a likelihood of consumer confusion as to the celebrity's association with or endorsement of the unauthorized user's commercial activities. Thus, celebrity Lanham Act claimants have to establish that the celebrity essentially has "trademark rights" in his or her identity, that those rights are viable and protectable, and that the defendant's unauthorized use has resulted in the aforementioned likelihood of confusion. That said, the court in *Parks* clarified that a Lanham Act celebrity claimant need not establish that the defendant's use of the celebrity's identity is a trademark use, per se; the lynchpin is whether it causes consumer confusion.

Consumer Confusion

Because the instant Nevada case was pursued by Hope Road, not Bob Marley himself (who passed away in 1981), Hope Road, as the Bob Marley rights' holder, had to establish that consumers were likely to be confused as to its association with, or endorsement of, the defendants' goods and commercial activities. Hope Road successfully demonstrated to the jury that Bob Marley had accrued "trademark" rights in his identity during his lifetime and that those rights were acquired by his heirs. Hope Road presented evidence of Bob Marley's substantial commercial activities and fame during his lifetime, including his sale of merchandise such as t-shirts bearing his name and image. Hope Road then established the series of posthumous transfers of Bob Marley's intellectual property rights since his death that ultimately resulted in Hope Road's purchase of those rights in 1995. Finally, Hope Road presented evidence of Hope Road's and their predecessors' in interest concerted and robust efforts to police the unauthorized use of Bob Marley's identity and persona, thus protecting against its dilution. In essence, the plaintiffs established that Bob Marley created a brand in his identity and persona, and that the plaintiffs had succeeded to ownership of the brand, where they policed unauthorized uses and, through licenses, such as that with Zion Rootswear, popularly and successfully exploited it.

After establishing that Bob Marley had a protectable right in his identity akin to a trademark, the plaintiffs had to establish, as noted above, that the defendants' use of Bob Marley's image on apparel and merchandise was likely to confuse consumers as to the plaintiffs' association with or endorsement of the defendants' apparel and merchandise. In other words, the plaintiffs sought to establish that due to the defendants' use of Bob Marley's image on products, consumers were confused into thinking that these products were part of the Bob Marley brand, when, in fact, they were not. In *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001), the Ninth Circuit adapted the traditional trademark likelihood-of-confusion factors established in *AMF Inc. v. Sleekcraft*

Boats, 599 F.2d 341 (9th Cir. 1979), to celebrity association cases. Although contested during discovery, by the time of the Nevada federal trial, many of these factors were essentially undisputed by the Marley dispute parties: the extraordinary fame of Bob Marley; the defendants' use of Bob Marley's exact likeness; the relatedness of the reasons for Bob Marley's fame and the defendants' goods; and the parties' use of similar marketing channels for their goods.

Although the defendants argued that their labeling and neck tags sufficiently distinguished their goods from Zion Rootswear's t-shirts and other products licensed by Hope Road, thereby avoiding consumer confusion, defendant JEM's licensing officer conceded under cross-examination that, notwithstanding the presence of identifying neck tags, it was essentially impossible for a consumer to distinguish between a t-shirt bearing a celebrity's image that was authorized and/or licensed by a celebrity and one that was not.

The plaintiffs also presented evidence of the defendants' creation and use of designs for their Marley products that included Marley's song titles, some of which were also registered trademarks of Hope Road. The plaintiffs argued that the defendants' use of these famous Marley song titles (*e.g.*, "Get Up, Stand Up," "Buffalo Soldier," "One Love") increased the likelihood that consumers would associate A.V.E.L.A.'s licensees' products with Bob Marley and his rights holders, namely, Hope Road. Indeed, the evidence presented at trial was that A.V.E.L.A., knowing that it could not utilize the name "Bob Marley" on its products featuring Marley's image (given that "Bob Marley" is a registered trademark), elected instead to utilize well-known Marley's song titles on the garments as a way of creating an association on the part of the consumer with Bob Marley and the image that appeared on the garment that A.V.E.L.A. and its licensees were marketing.

Conclusion

In sum, the Nevada federal jury found that the defendants' use of Bob Marley's image on apparel and merchandise infringed Hope Road's rights in Bob Marley's identity and persona, because it was likely to cause consumer confusion as to Hope Road's association with or endorsement of the defendants' activities. Moreover, the jury found that each of the defendants, including the defendant licensees JEM and Freeze, willfully infringed Hope Road's rights, potentially entitling the plaintiffs to increased profits under the Lanham Act. The plaintiffs presented evidence of JEM's and Freeze's total lack of due diligence, much less simple inquiry, into whether A.V.E.L.A. actually had the right to license images of Bob Marley for use on apparel and merchandise. JEM and Freeze testified that in reliance on A.V.E.L.A.'s agreement to indemnify them against all claims, they did nothing to investigate or question A.V.E.L.A.'s representations to them that it had the right to license Bob Marley images — despite knowing that officially licensed Marley product was in the marketplace. The plaintiffs argued that such recklessly indifferent and willfully blind dealings were tantamount to willfulness. The jury presumably concurred.

Barry E. Mallen is Co-Chair of Manatt, Phelps & Phillips' national Entertainment and Media Litigation Group. He is based in the firm's Los Angeles office. He can be reached at Bmallen@manatt.com. **Paul Bost**, also in Los Angeles, is an associate in the firm's litigation department. He can be reached at Pbost@manatt.com. Mallen, along with Manatt IP Chair, **Jill Pietrini**, was trial counsel for Fifty-Six Hope Road Music Ltd. in the case discussed in this article.