PROTECTING THE TERMINATOR: AN ANALYSIS OF TRADEMARK PROTECTION FOR AN ACTOR’S PORTRAYAL OF A CHARACTER

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I. Introduction

While other forms of intellectual property rights are concerned with the encouragement of innovation, trademarks protect words and symbols used to identify and distinguish goods and services to consumers.¹ Trademarks are meant to symbolize the origin of a product. As a result, they prevent consumer confusion, unfair competition, and protect the goodwill that was earned by the trademark owner from his use of the mark. Consumers can associate the quality of the product by knowing the source. By preventing uses of a mark that confuse consumers, trademark law protects the integrity of a mark’s meaning. But what happens when people are misled by the use of an actor’s portrayal of a character? A similar goal would be to offer some protection to the consumer from being misled and protection to the expressive aspect of an actor’s art. The question is whether trademark law should protect the consumer from confusion and the goodwill an actor has built into a character from this unassigned commercial use.

Suppose Arnold Schwarzeneger, who has played the same character in four Terminator movies wanted protection against other actors portraying his famous role. Although he did not write the script, direct, or produce any of the Terminator movies, all of his famous one-liners and

¹ 15 U.S.C. § 1127 (2000) (The term “trademark” includes any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and to identify and distinguish his or her goods).
action moves that made his character so memorable to the general public came directly from him ad-libbing on the set.\textsuperscript{2} The writer and director created the concept of a futuristic robot for Arnold to imitate. However, no one had ever played a character quite like this before, so Arnold, in a sense, had to create a character out of thin air. Arnold’s body builder frame and Austrian accent help create a character that the public has idolized for over 25 years. Not only has Arnold played the Terminator character for four major motion pictures spanning fifteen years, the character is referenced in other motion pictures and commercials, and has sold a million posters world wide. Unfortunately, Arnold recently heard from his agent that an actor that looks like the Terminator character has recently been photographed for advertisements for Craftsman tools. Additionally, the production company has decided to either hire another actor to play Arnold’s character in Terminator 5 or create the character by using his digital image from previous Terminator movies.\textsuperscript{3} The question that needs to be addressed is what, if any, federal trademark protection does Arnold have.

\textbf{II. Overview of Trademark Law}

Trademark law analysis provides reasons for protecting characters that actors and actresses portray and provides limits to those very protections. Trademarks are protected under the Lanham Act, otherwise known as the U.S. Trademark Act, which is a federal statute

\textsuperscript{2} Hypothetical created for the purpose of analyzing current case law. Although this is a hypothetical, Arnold actually only had 18 lines in first Terminator, allowing the Terminator character to be developed mostly by Arnold’s actions and not by the script. The Terminator, http://en.wikipedia.org/wiki/The_Terminator. The Director and critics have said that Arnold’s Austrian accent and physical frame created the Terminator character. Id.

\textsuperscript{3} Although this is a hypothetical, Arnold actually approved that his Terminator character in Terminator 4, Terminator Salvation, to be done using all computer graphics and he never had to act in the movie. How Schwarzenegger Came to ‘Terminator Salvation,’ http://www.accesshollywood.com/action-stars/how-schwarzenegger-came-to-terminator-salvation_article_18006.
governing trademark law in the United States. The Lanham act is not the exclusive law governing U.S. trademark law because both state statutes and common law also control some aspects of trademark protection. In order to obtain trademark protection, trademarks require adoption and use. The principal purpose of trademark law is to protect consumers from confusion as to the source of a product or service. This typically requires that only one party be awarded ownership of the trademark. Ownership typically belongs to the party who makes first commercial appropriation or use, and continues using the mark. U.S. federal registration of a trademark creates a presumption of validity in the trademark registration. The unregistered user of a trademark has the burden of proving prior use.

Trademark rights are ordinarily acquired to protect the marks and brand names of merchandise, but the Lanham Act is broad enough to give well known actors “property rights in their identities against allegedly misleading commercial use by others.” A celebrity’s identity

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4 See 15 U.S.C. § 1125(a) (Section 43(a) states in relevant part: (1) Any person who, on or in connection with any goods or services or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact which -- (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . .)


10 See Id.

11 Parks v. LaFace Records, 329 F.3d 437, 445 (6th Cir. 2003) (plaintiff alleges song title Rosa Parks misleads consumers into believing that the song is about her or that she is affiliated with the defendants); See also Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1110 (9th Cir. 1992) (celebrity suit against snack manufacturer for unauthorized use of his distinctive voice in a commercial); See also Allen v. Nat’l Video, Inc., 610 F.Supp. 612, 624-25 (S.D.N.Y. 1985) (celebrity suit against a video retailer for use of a celebrity look-alike in its advertisements).
or persona is at issue when a celebrity sues under section 43(a).\textsuperscript{12} Under section 43(a) of the Lanham Act, well known actors and actresses have standing “because they possess an economic interest in their identities” similar to that of the traditional trademark holder.\textsuperscript{13} A celebrity’s mark is his persona.\textsuperscript{14} A celebrity’s identity or persona can provide two different services, endorsement\textsuperscript{15} and entertainment.\textsuperscript{16} Two prongs of section 43(a) of the Lanham Act pertain to a claim of false endorsement or misleading representation. The first is when a claim of false endorsement of misleading representation falls under section 43(a)(1)(A) as a form of trademark infringement, and the second is when a claim falls under section 43(a)(1)(B) as a form of false advertising.

A. Distinctiveness

In order to succeed on a trademark claim, federal or state law, a plaintiff must show that its mark is first, distinctive, and two, that the defendant’s use of the mark is likely to cause confusion among consumers.\textsuperscript{17} The first element to analyze is if the mark is distinctive. Marks fall into five categories of distinctiveness which include (in order of weakest to strongest): generic, descriptive, suggestive, fanciful, and arbitrary.\textsuperscript{18} The categorization is important because suggestive, fanciful, and arbitrary marks are considered inherently distinctive, generic.

\textsuperscript{12} White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1400 (9th Cir. 1992).

\textsuperscript{13} Parks, 329 F.3d at 445 (citing Waits, 978 F.2d at 1110).

\textsuperscript{14} White, 971 F.2d at 1400 (citing Allen, 610 F.Supp. at 627).

\textsuperscript{15} See Id. at 1401 (The court analyzed whether an endorsement ad for VCRs featuring a robot invoking the identity of Vanna White was liable for trademark infringement.)

\textsuperscript{16} See Ligotti, 562 F.Supp.2d at 215, 228 (An actor received trademark protection of a character he portrayed for use in entertainment services and media appearances).

\textsuperscript{17} See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992).

\textsuperscript{18} Colt Def. LLC v. Bushmaster Firearms, Inc., 486 F.3d 701, 705 (1st Cir. 2007).
marks are never distinctive, and descriptive marks can only become distinctive upon a showing of secondary meaning.\textsuperscript{19}

Courts have to determine if the mark is suggestive, inherently distinctive, or if the mark is descriptive, requiring secondary meaning. “The descriptive-suggestive borderline is hardly a clear one.”\textsuperscript{20} A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the [services]. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the [services].”\textsuperscript{21} Although a mark can be considered descriptive for one product, it can still be considered suggestive, arbitrary or fanciful for a different product. For example, the trademark “Apple” for a company selling apples is a descriptive mark, but the trademark “Apple” for a computer company is arbitrary and inherently distinctive.

1. Secondary Meaning

For a descriptive mark to be eligible for trademark protection, the showing of secondary meaning “requires the trademark holder to establish that in the minds of the public, the primary significance of the mark is to identify the source of the product rather than the product itself.”\textsuperscript{22} “Proof of secondary meaning entails vigorous evidentiary requirements,” the burden of which falls on the party claiming secondary meaning.\textsuperscript{23} A trademark owner can prove secondary meaning through direct evidence such as customer surveys and testimony of individual consumers. If direct evidence is not available, secondary meaning can also be proven through

\textsuperscript{19} Two Pesos, 505 U.S. at 769.


\textsuperscript{21} See, e.g., \textit{Equine Techs., Inc. v. Equitechnology, Inc.}, 68 F.3d 542, 544 (1st Cir. 1995).

\textsuperscript{22} \textit{Ligotti}, 562 F.Supp.2d at 215 (citing \textit{Inwood Labs., Inc. v. Ives Labs., Inc.}, 456 U.S. 844, 851 n. 11 (1982).

\textsuperscript{23} \textit{Perini Corp. V. Perini Constr., Inc.}, 915 F.2d 121, 125 (4th Cir. 1990).
circumstantial evidence, including, but not “limited to: (1) the length and manner of the mark’s use, (2) the nature and extent of its advertising and promotion, (3) the efforts made to promote a conscious connection between the mark and the source of the services, and (4) the services established placed in the market.”\(^\text{24}\) Although evidence of these factors is relevant to determining secondary meaning, the true test is the \textit{effectiveness} of this effort to create it.\(^\text{25}\)

Secondary meaning can also be used to determine which party owns a trademark. When a mark is inherently distinctive, ownership of a mark belongs to the party who makes first commercial appropriation or use, and continues using the mark.\(^\text{26}\) On the other hand, if the mark is merely descriptive, mere priority of use is insufficient. Ownership belongs to “the party who first achieved trademark significance through secondary meaning.”\(^\text{27}\)

**B. Likelihood of Confusion**

The second element to analyze is whether the use of the mark is likely to cause confusion among consumers. For example, an owner of a trademark can accuse a similar mark of trademark infringement if consumers are confused as to the origin. Most circuits look at likelihood of confusion as a question of fact, which is harder to overturn, especially from a jury trial. Some circuits view likelihood of confusion as a question of law, which would be reviewed de novo. When determining whether there was confusion among consumers, courts apply a likelihood of confusion test.\(^\text{28}\)

\(^{24}\) Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25, 43-44 (1st Cir. 2001).

\(^{25}\) Int’l Jensen, Inc. v. Metrosound U.S.A., Inc., 4 F.3d 819, 824 (9th Cir. 1993).

\(^{26}\) Ligotti, 562 F.Supp.2d at 217-218.

\(^{27}\) \textit{Id.} at 218.

The two most prevalent factors used while applying the likelihood of confusion test are the Sleekcraft factors\(^\text{29}\) and the Polaroid factors\(^\text{30}\). The Sleekcraft factors for determining likelihood of confusion include: (1) the strength of the original mark;\(^\text{31}\) (2) the relatedness/proximity of the goods or services provided between the original and accused mark;\(^\text{32}\) (3) the similarity of the marks;\(^\text{33}\) (4) evidence of actual confusion;\(^\text{34}\) (5) the marketing channels used;\(^\text{35}\) (6) the type of goods and the likely degree of purchaser care;\(^\text{36}\) (7) the accused owner’s intent in selecting the mark;\(^\text{37}\) and (8) the likelihood of expansion in the product lines of the parties.\(^\text{38-39}\) The Polaroid test includes eight relatively similar factors: (1) the strength of the original mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the original owner will bridge the gap between the two markets; (5) the existence of actual confusion; (6) the accused owner’s good faith in adopting the mark;

\(^{29}\) AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, (9th Cir. 1979).

\(^{30}\) Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2nd Cir. 1961).

\(^{31}\) The stronger the mark, the more likely consumers will recognize it.

\(^{32}\) Greater likelihood of confusion as to the origin when the original and accused marks symbolize the same products compared to if the original mark symbolizes computer products and the accused product symbolizes bananas.

\(^{33}\) The greater the marks resemble one another, the greater the likelihood of confusion.

\(^{34}\) For example, surveys proving there is confusion among consumers between the marks.

\(^{35}\) Similar marketing channels are used increases the likelihood of confusion. White, 971 F.2d at 1400 (finding the likelihood of confusion was increased when both parties appeared in the same magazine).

\(^{36}\) There is a greater likelihood of confusion when consumers do not particularly care about the origin of the product. White, 971 F.2d at 1400 (finding “consumers are not likely to be particularly careful in determining who endorses VCRs, making confusion as to their endorsement more likely”).

\(^{37}\) There is a greater likelihood of confusion when the accused tried to profit from using a similar mark. White, 971 F.2d at 1400

\(^{38}\) The greater the likelihood the owners will sell similar products in the future, the greater the likelihood of confusion.

\(^{39}\) AMF, 599 F.2d at 348-49.
(7) the quality of accused owner’s product; and (8) the sophistication of the purchasers.\textsuperscript{40} There is no meaningful difference between the two tests. No single factor is dispositive of the likelihood of confusion question, and neither list is considered exhaustive or exclusive.\textsuperscript{41} “[D]ifferent factors will weigh more heavily from case to case depending on the particular facts and circumstances involved.”\textsuperscript{42}

A well known actor’s ability to sue under the Lanham Act for use of her identity or persona is “analogous to a celebrity’s ability to sue for alleged violation of his common law right of publicity.”\textsuperscript{43} The objective of right of publicity protects a celebrity’s identity and persona from economic exploitation.\textsuperscript{44} In fact, when a celebrity brings a Lanham act section 43(a) claim involving issues of their name, identity or persona, courts often consider these claims at the same time and in the same light as any state claim for a violation of the celebrity’s right of publicity.\textsuperscript{45} Unlike the right of publicity, focus remains “on the likelihood of consumer confusion created by the use of the celebrity’s name or identity.”\textsuperscript{46}

Under section 43(a), a well known actor “must show that use of his or her name is likely to cause confusion among consumers as to the affiliation, connection, or association” between the actor and the defendant’s goods or services or as to the actor’s participation in the “origin, sponsorship, or approval.”\textsuperscript{47} When dealing in the context of a well known actor, two factors

\textsuperscript{40} Polaroid, 287 F.2d at 495.

\textsuperscript{41} Marathon Mfg. Co. v. Enerlite Products Corp., 767 F.2d 214, 218 (5th Cir. 1985).

\textsuperscript{42} Id.

\textsuperscript{43} Zimdahl, supra at 1824.

\textsuperscript{44} Id. at 1825.

\textsuperscript{45} See, e.g., Parks, 329 F.3d at 459-460.

\textsuperscript{46} Zimdahl, supra at 1825 (citing White, 971 F.2d 1399).

\textsuperscript{47} Parks, 329 F.3d at 446. See also 15 U.S.C. § 1125(a)(1)(A).
from both the Sleekcraft and Polaroid tests refer to different meanings. First, the strength of plaintiff’s mark factor refers to the “level of recognition that the celebrity enjoys among members of society.”48 And second, the proximity of the products concerns “the reasons for or source of the plaintiff’s fame.”49

III. Analysis

There are two elements a plaintiff must show in order to succeed on a trademark claim. First, the mark must be distinctive, and second, that the defendant’s use of the mark is likely to cause confusion among consumers.50 To determine whether Arnold is entitled to trademark protection, current case law pertaining to each element is analyzed then applied to Arnold’s scenario.

A. Case Analysis Regarding Distinctiveness

A trademark is a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic.51 When a role becomes inseparable from the actor’s own public image, then the role has become part of the actor’s persona.52 In Wendt, two actors who played characters in a popular television series sued the defendant for trademark protection.53 The two actors claimed the defendants used an imitation of their unique physical characteristics

48 White, 971 F.2d at 1400. See also Wendt v. Host Intern., Inc., 125 F.3d 806, 812 (9th Cir. 1997) (finding the plaintiffs had a strong mark because they were principle players on the show Cheers and were well-known).

49 Wendt, 125 F.3d at 813 (finding the source of the plaintiffs’ fame was the show Cheers which is identical to the defendant’s product which was a bar designed after the show). When looking at the proximity of the goods, the celebrity’s goods concern the reasons for or source of his fame. Id.


51 Wendt, 125 F.3d at 809 (citing Waits, 978 F.2d 1110).

52 McFarland v. Miller, 14 F.3d 912, 920 (3rd Cir. 1994) (Reversing summary judgment with respect to plaintiff’s Lanham Act claims regarding the character Spanky from Little Rascals).

53 Wendt, 125 F.3d at 806.
to endorse the defendant’s bar.\textsuperscript{54} The bar was designed to look like the television film set of Cheers.\textsuperscript{55} The bar contained two robots that were similar to the characters portrayed by the plaintiffs in the television series.\textsuperscript{56} The court held that the two characters “were principle players” on the show, and jury could reasonably conclude that their persona or identity is a strong mark.\textsuperscript{57} The Cheers’ characters the plaintiffs portrayed and others characters such as the Marx Brothers or Charlie Chaplin are easy to characterize as part of the actor’s persona.\textsuperscript{58}

Unlike the court in \textit{Wendt} where the plaintiffs’ marks were inherently distinctive, the court in \textit{Ligotti} held the parties’ mark was only descriptive.\textsuperscript{59} The defendant in \textit{Ligotti} came into agreement with the plaintiff, an actor, to portray a character in a series of internet episodes called webisodes.\textsuperscript{60} After the defendant created the concept of the character which he called “The Guy from Boston,” he began writing, directing and editing webisodes with the plaintiff.\textsuperscript{61} The court found the character, “Guy from Boston,” descriptive because it did not require imagination, thought or perception to reach a conclusion.\textsuperscript{62} “The [mark] conveys the salient characteristics of the services, namely, the attitudes of a ‘regular guy’ from Boston, without demanding any

\textsuperscript{54} \textit{Id.} at 812.
\textsuperscript{55} \textit{Id.} at 809.
\textsuperscript{56} \textit{Id.} at 809.
\textsuperscript{57} \textit{Id.} at 812.
\textsuperscript{58} \textit{See Id.} at 809.
\textsuperscript{59} \textit{Ligotti}, 562 F.Supp.2d at 215, 219.
\textsuperscript{60} \textit{Id.} at 208.
\textsuperscript{61} \textit{Id.}
\textsuperscript{62} \textit{Id.} at 215.
imaginative leap whatsoever.” Additionally, geographic terms that merely identify location or origin are descriptive marks. The term “Guy from Boston”, just references a man that was raised near that particular geographic area.

1. Secondary Meaning

Secondary meaning is achieved when the primary significance to the public is to identify a particular source of a service, rather than simply the service itself. Similarly, it’s the same when a role an actor portrays becomes the actor’s persona. The true test of secondary meaning is the effectiveness of this effort to create. Although the mark in Ligotti was descriptive, it was still able to claim trademark protection because it acquired secondary meaning. The court looked at circumstantial evidence in determining which party established secondary meaning because the parties did not have direct evidence. Although the defendant did all the initial advertising, conceived the character, set up the website, wrote, directed and edited the video, his effort did not generate much interest. The notoriety of the character grew simultaneously as plaintiff’s control over the character grew. Furthermore, the plaintiff was ad-libbing about topics, instead of reading directly from cue cards. After the judge held the public associates “The Guy from Boston” with Ligotti’s personality and physical appearance, he made the

63 Id.
64 Id. at 215-16.
65 Id. at 218 (held the plaintiff had trademark protection after obtaining secondary meaning because the character was used to identify entertainment services).
66 Id. at 219.
67 Id. at 218.
68 Id. at 217, 219.
69 Id. at 219, 221.
70 Id. at 221.
additional remark the Ligotti is the one who controls the quality or characteristic of the mark.\textsuperscript{71} The court held that secondary meaning was established after the plaintiff had taken greater control over the character.

Although the character was under the control of the defendant’s directions at first, the character didn’t acquire secondary meaning until the plaintiff began to control the character more independently.\textsuperscript{72} To protect consumers from confusion, public interest normally requires an “exclusive [ownership] of the mark to one party or the other.”\textsuperscript{73} Ownership is determined by first appropriation or use only when the mark is inherently distinctive. Priority of use was determined insufficient with descriptive marks.\textsuperscript{74} The court held plaintiff the owner of the “Guy from Boston” because it wasn’t until the plaintiff uniquely portrayed the character and garner national attention did the mark achieve secondary meaning and receive trademark protection.\textsuperscript{75}

B. Application of Arnold’s Scenario to Case Law Regarding Distinctiveness

Arnold’s trademark would be his persona or identity. Arnold’s continuous and unique portrayal of the terminator for 15 years garnered national attention and fame similar to the plaintiffs in \textit{Wendt} who gained fame from a television series that aired over a long period of time. His mannerisms and ad-lib classic one-liners are still used today in ordinary conversation when the Terminator character is mentioned. Arnold’s unique identity and appearance gives him a distinctive mark similar to the unique physical attributes of the plaintiffs in \textit{Wendt}.

\textsuperscript{71} \textit{Id.} at 224.

\textsuperscript{72} \textit{Id.} at 221.

\textsuperscript{73} \textit{Ligotti}, 562 F.Supp.2d at 216.

\textsuperscript{74} \textit{Id.} at 218.

\textsuperscript{75} \textit{Id.}
Even if Arnold’s character portrayal of the Terminator is determined to be descriptive because the mark describes a monotone indestructible killing machine, Arnold would still be able to achieve secondary meaning. Similar Ligotti, Arnold did not write, edit, or direct the movie. But it can be argued that his ad-libbing, great acting, unique body builder appearance and Austrian accent morphed the concept of the robot killer into what the Terminator is known today. And similar to the plaintiff in Ligotti, the character portrayal of the Terminator did not gain secondary meaning until Arnold had gained control over it. Ownership would be awarded to Arnold and not the concept creator/director similar to the facts in Ligotti. The circumstantial factors would be in favor Arnold, let alone any direct evidence such as consumer surveys showing the public associates the terminator role with Arnold, giving him secondary meaning. Arnold’s trademark is distinct because the Terminator role became Arnold’s persona.

C. Case Law Regarding Likelihood of Confusion

“The heart of a successful [trademark] claim . . . is the showing of likelihood of confusion as to the source.” To satisfy the element of likelihood of confusion, a well known actor “must show that use of his [character portrayal] is likely to cause confusion among consumers as to the affiliation, connection, or association” between the actor and the defendant’s goods or services or as to the actor’s participation in the “origin, sponsorship, or approval.” When a role becomes inseparable from the actor’s own public image, then the role has become part of the actor’s persona. The court in two Allen cases granted Summary Judgment for

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77 Parks, 329 F.3d at 446. See also 15 U.S.C. § 1125(a)(1)(A).

78 McFarland v. Miller, 14 F.3d 912, 920 (3rd Cir. 1994) (Reversing summary judgment with respect to plaintiff’s Lanham Act claims regarding the character Spanky from Little Rascals because the character became synonymous with the actor’s persona).
plaintiff Woody Allen for violation of section 43(a) by false endorsement. Woody Allen sued a look-alike, the look-alike’s manager, and advertising company seeking an injunction restraining the look-alike from portraying him. The defendants’ used a look-alike who looked very similar to Woody Allen for advertising a video store.

The court analyzed the factors to consider whether there was an issue of likelihood of confusion. The court found that Mr. Allen’s likeness is well-known to the public, he built up considerable investment in his unique image, the look-alike is very similar to Mr. Allen, a movie store is related to Mr. Allen’s line of services and goods, and the intent of the defendants’ was to evoke an association with Mr. Allen. Even though the court found that the target market is “comparatively sophistication”, at a cursory glance, the court held that the target market would likely still be confused. Noting the defendant’s use of a look-alike in an advertisement created a likelihood of confusion over whether plaintiff endorsed the defendant’s goods or services. The court pointed out that when “a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement.” The court rejected the defendants’ argument that using a disclaimer is sufficient to dispel the impression of plaintiff’s endorsement or approval. The court remarked that the disclaimer needed to not only say this was a look-alike but that the plaintiff had nothing to do with the

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80 Allen, 610 F.Supp. at 612.
81 Id. at 627.
82 Id. at 628.
83 Id.
84 Id. at 627. Men’s World Outlet, 679 F.Supp. 360.
85 Id. at 627 n. 8.
86 Id. at 629.
project. Consumers could know that it was a look-alike but still infer that plaintiff was endorsing the product.\textsuperscript{87}

Relying on the \textit{Allen} case, a court upheld a complaint by the performing rap group known as “The Fat Boys” alleging trademark infringement and false endorsement for the use of look-alikes in a beer commercial.\textsuperscript{88} The plaintiffs in \textit{Tin Pan Apple} denied a request by the defendant, a beer manufacturer and distributing company, to appear in a commercial.\textsuperscript{89} Defendant created the commercial with a group of look-alikes to perform similar rap song wearing similar style clothes the Fat Boys wear.\textsuperscript{90} One of the messages that the rap group tries to convey to the youth is to stay away from drugs and alcohol, the very product the defendant represents.\textsuperscript{91} After analyzing the \textit{Polaroid} likelihood of confusion factors, the \textit{Tin Pan Apple} court held that the plaintiff had a strong mark, the marks were similar because they were look-alikes, and that both parties are in a relevant market because it’s safe to assume that many rap artists drink beer.\textsuperscript{92} Additionally, the court went on further to say the case was stronger than the \textit{Allen} case because there were allegations the defendant hired the look-alikes after the plaintiff refused the job.\textsuperscript{93}

Continuing from where the \textit{Allen} and \textit{Tin Pan Apple} courts left off, a Ninth Circuit court in \textit{White} held a celebrity plaintiff’s “mark means the celebrity’s persona.”\textsuperscript{94} In \textit{White}, an ad

\textsuperscript{87} Id. at 630-31.
\textsuperscript{88} \textit{Tin Pan Apple}, 737 F.Supp. at 835.
\textsuperscript{89} Id. at 828.
\textsuperscript{90} Id.
\textsuperscript{91} Id.
\textsuperscript{92} Id. at 835.
\textsuperscript{93} Id.
\textsuperscript{94} \textit{White}, 971 F.2d at 1400.
depicting a robot, dressed in a wig, gown, and jewelry which resembles the plaintiff’s hair and
dress endorsed the defendant’s product.95 “The robot was posed next to a game board which is
instantly recognizable as the Wheel of Fortune game show set, in a stance in which [plaintiff] is
famous.”96 The ad appeared in the same magazine as the plaintiff appeared.97 The court
disagreed with defendant’s argument that it tried to spoof the plaintiff Vanna White when it used
a robot that the court thought embodied the persona of the plaintiff.98 The court found that the
section 43(a) issue as to whether the advertisement created a likelihood of confusion over
whether plaintiff was endorsing defendant’s VCR products was an issue of fact for the jury. In
particular, the court held plaintiff raised a genuine issue of material fact concerning a likelihood
of confusion after analyzing the eight factor Sleekcraft test.99 Furthermore, the court found the
strength of plaintiff”s mark, which is the level of cognition the celebrity enjoys among members
of society, to be strong.100 Even though the court recognized the robot is not very similar to a
human, the court remarked that all the aspects of the ad in general identify plaintiff.101

Similar to White, the court in Wendt held the likelihood of confusion was a fact for a jury
to decide.102 Applying the factors for likelihood of confusion at the summary judgment stage,

95 Id. at 1397.
96 Id.
97 Id. at 1400.
98 Id. at 1401
99 Id.
100 Id. at 1400.
101 Id.
102 Wendt, 125 F.3d at 812.
the court found a jury could reasonably conclude most of the factors weigh in plaintiff’s favor.\textsuperscript{103}

First, the plaintiffs were two principle characters on the hit television show Cheers,\textsuperscript{104} and were clearly well known among the target customers of Host’s Cheers bars. Second, their goods, their skill and fame as actors, are obviously related to defendant’s product.\textsuperscript{105} The source of the plaintiff’s fame and defendant’s bars are both related to Cheers. Court held a jury could conclude it would be reasonable for a customer to be confused as to the nature of plaintiff’s association with defendant’s bars. The third factor includes the similarity of the marks is meant for a jury to determine the degree in which robots resemble plaintiffs. The court found the remaining factors all weight in favor of the plaintiff.\textsuperscript{106}

Contrary to Allen, Tin Pan Apple, White and Wendt, the court in Landham v. Lewis Galoob Toys held the strength of plaintiff’s of mark is weak.\textsuperscript{107} The plaintiff in Landham played a character in the movie Predator.\textsuperscript{108} He additionally played small supporting roles in action movies and in some adult movies.\textsuperscript{109} The defendant created micro machine children toys similar to the characters from the movie.\textsuperscript{110} The toy was so small you could not make out any detail in face or any other physical characteristic from the plaintiff.\textsuperscript{111} The defendant loosely based the

\textsuperscript{103} Id. at 813.
\textsuperscript{104} Id.
\textsuperscript{105} Id.
\textsuperscript{106} Id. at 813-14.
\textsuperscript{107} Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 627 (6th Cir. 2000).
\textsuperscript{108} Id. at 621.
\textsuperscript{109} Id.
\textsuperscript{110} Id.
\textsuperscript{111} Id.
toy from the movie and mostly based it off of a general Native American.\textsuperscript{112} The plaintiff made it appear his mark did not possess any significant degree of strength among consumers of children’s toys, the part of society relevant to his claim, because of his adult roles.\textsuperscript{113} Although the plaintiff’s argument is correct that he doesn’t need all or a majority of the eight factors to be in his favor for determining likelihood of confusion, he was missing crucial factors.\textsuperscript{114} Further more, defendant’s intent, expansion of the product lines and similarity of the marks weigh against him because the figurine action characters were intentionally created not to look like plaintiff and they were created so small that you couldn’t see any facial traits.\textsuperscript{115} These objective factors helped the court determine there was no likelihood of confusion.

D. Application of Arnold’s Scenario to Case Law Regarding Consumer Confusion

When a look-alike plays Arnold’s Terminator character in a Craftsman commercial, it’s very similar to the first four consumer confusion cases where there is a likelihood of confusion that consumers associate Arnold’s portrayal of the Terminator character with endorsing Craftsman tools. Arnold’s mark would be considered strong similar to Allen and White after playing the same character for over 15 years and being an international movie star. The goods are reasonably related because Craftsman goods are sturdy, never break, never quit tools which relates to the Terminator machine that is indestructible, won’t stop until the job is done character. The marks are very similar when comparing a look-alike similar to Allen and Tin Pan Apple. Similar to both of those cases, there is no actual confusion evidence, but the intent of Craftsman would lean towards trying to benefit from consumers association with Arnold’s character

\textsuperscript{112} Id. at 621-22

\textsuperscript{113} Id. at 621

\textsuperscript{114} Id.

\textsuperscript{115} Id.
portrayal. Similar to White, consumers are not likely to be particularly careful in determining who endorses tools, making confusion as to their endorsement more likely. Looking at the factors as a whole, it would be reasonable to conclude that a customer will be confused as to the nature of Arnold’s Terminator association with Craftsman’s tools.

When a look-alike plays Arnold’s Terminator character in Terminator 5, there is a likelihood of confusion that consumers associate Arnold’s entertainment service with the new movie. Similar to the above paragraph’s analysis, Arnold has a strong mark, the goods (entertainment services) are identical, the look-alike marks are very similar, and defendant’s intent seems for profit off of the consumer’s association with Arnold’s character. When the Terminator character becomes inseparable from the Arnold’s own public image, then the role has become part of the Arnold’s persona. The element of likelihood of confusion is satisfied because Arnold’s portrayal of the Terminator character is likely to cause confusion among consumers as to Arnold’s participation in the origin, sponsorship, or approval of Terminator 5.

IV. Copyright Overlap

A. Public Domain

Copyrights that are in the public domain can legally be copied.\(^{116}\) Although copyrights in the public domain are not protected by copyright law, the court in Warne held that a character that has fallen into the public domain can still acquire independent trademark significance.\(^{117}\) Defendant had the right to copy the complete Peter Rabbit book in full because it was part of the public domain.\(^{118}\) Defendant’s new book raised a question of fact as to trademark infringement

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\(^{117}\) Id. at 1196.

\(^{118}\) Id. at 1197.
when plaintiff’s character illustrations were used in a way in which those illustrations were never used in the public domain book. The defendant infringed plaintiff’s trademarks if the new book went “beyond mere copying” such that the defendant’s use of the illustrations may confuse consumers that defendant’s different book has been published or somehow associated with plaintiff.

Arnold could argue under the Warne case that the production company’s decision to use a computer graphic image of Arnold’s previous portrayals of the Terminator character would be trademark infringement because it tries to duplicate the same portrayal in a different story. Similar to Warne, Arnold does not own any copyrights to his character portrayal. But the previous expression of the actor’s art is now being used in a new movie. The movie producers when beyond just copying the old Terminator movies for reproduction, they are taking Arnold’s expressive art and using it in a way they were never used in the original Terminator movies. Terminator 5 is a new story with a different plot. The movie producers’ use of Arnold’s previous expressions of the Terminator character may confuse consumers that Terminator 5 has been produced or somehow associated with Arnold.

B. Trademark Protecting Expression

A celebrity’s trademark or service mark is his persona. A celebrity’s identity or persona can provide two different services, endorsement and entertainment. When looking

\[^{119}\text{Id. at 1197.}\]
\[^{120}\text{Id.}\]
\[^{121}\text{White, 971 F.2d at 1400 (citing Allen, 610 F.Supp. at 627).}\]
\[^{122}\text{See Id. at 1401 (The court analyzed whether an endorsement ad for VCRs featuring a robot invoking the identity of Vanna White was liable for trademark infringement.)}\]
\[^{123}\text{See Ligotti, 562 F.Supp.2d at 215, 228 (An actor received trademark protection of a character he portrayed for use in entertainment services and media appearances).}\]
at the entertainment service an actor provides, you look at the way an actor can transform a character. After an actor gets a script, the actor must bring to life what is written down about the character. What the consumer sees when watching a film is the actor’s expression of what the character should be. So in essence, it’s the expressive aspect of the actor’s art. In Ligotti, an actor received trademark protection of a character he portrayed for use in entertainment.124 The defendant came up with the character, told the actor what he was looking for, but it was the actor persona that brought the character to life.125 The defendant is not allowed to copy the way the actor portrayed the character “Guy from Boston.”126

C. Copyright Preemption

Copyright provides the creators or original works of authorship, including artistic and dramatic works, protection. A copyright gives the owner an exclusive right to reproduce the work, to prepare derivative works, to perform the copyrighted work, or to display the copyrighted work. The copyright protects the form of expression rather than the subject matter of the work itself. For example, a picture of the Grand Canyon could be copyrighted and would protect against others copying that exact picture. But it would not prevent others from taking their own picture. If the subject is the Grand Canyon, copyright law protected the way the photographer expressed the subject.

Similar to trademark protecting the way the actor in Ligotti portrayed or expressed “The Guy from Boston” character. “The copyright act exclusively governs a [trademark] claim when the particular work to which the claim is being applied falls within the type of works protected

124 Id.
125 Id. at 208.
126 Id. at 228.
by the copyright act . . . and the claim seeks to vindicate legal or equitable rights that are equivalent to one of the bundle of exclusive right already protected by copyright law.”

The “claim must not include any extra elements that make it qualitatively different from a copyright infringement claim.”

A trademark claim requires a likelihood of consumer confusion which makes it qualitatively different from a copyright claim. Additionally, unauthorized use of someone’s persona is different from copyright infringement.

In Wendt, the holder of the copyright of the television show intervened. The court stated that the claims are not preempted by the federal copyright statute so long as they contain elements, such as the unauthorized commercial use of one’s identity which is different in kind from copyright infringement. Copyright preemption occurs when plaintiff is seeking to prevent a party from exhibiting a copyrighted work, which is an exclusive right within the general scope of copyright.

Arnold’s potential claims against Craftsman and the producers of Terminator 5 would not be subject to copyright preemption. Similar to the Wendt case, Arnold’s claims are different in kind from copyright infringement and require a likelihood of consumer confusion.

V. Conclusion

An actor’s character can receive trademark protection from commercial uses. Trademark law would protect the consumer from confusion and the goodwill an actor has built into a

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127 Briarpatch Ltd. v. Phoenix Pictures, Inc., 373 F.3d 296, 305 (2nd Cir. 2004).

128 Id.

129 Wendt, 125 F.3d at 806.

130 Id. at 810.

131 Compare Id., with Fleet v. CBS, 58 Cal.Rptr.2d 645, 651 (1996) (actor may not bring an action for misappropriation when the distribution of the actor’s performance in a copyrighted movie was the claimed exploitation.)
character from this unassigned commercial use. There seems there is some trademark protection available against other actors portraying the character the same. Arnold would argue his mark is as strong as the marks in *Parks*, *White*, and *Allen*, because his role became inseparable from his own public image, then the role has become part of his persona.

Using *Ligotti*, *Wendt* and *Frederick*, Arnold would argue that the producer and writer of the character don’t have ownership because secondary meaning wasn’t established until he had control over the quality. His unique physical appearance, Austrian accent, mannerisms, actions, emotions and timing created the character and over the course of 15 years in the national spotlight the character gained secondary meaning. Arnold could argue that he has protection over any character that is portrayed so similarly it will cause consumer confusion. Similar to *Frederick*, protection would be offered if the same portrayal is used in a different story that confuses the public.

There is much greater protection against false commercial endorsements similar to *Allen*. Arnold’s claim against Craftsman would be very strong. Arnold would argue under *Allen*, *White* and *Wendt*, showing circumstantial evidence as to why there is a likelihood of confusion. Furthermore, he can always show direct evidence from customer surveys and interviews how the public associates his character.