Expanding U.S. Trademark Protection for Celebrities Characters and Faces: The Effect on the Paparazzi and Mainstream Media

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Introduction

There is currently no comprehensive legal protection for celebrities’ characters or faces (i.e. a photo) under United States trademark law. Celebrities have relied on state privacy statutes and/or the federal cause of action of unfair competition, which derives from 15 U.S.C. § 1125(a), known as section 43(a) of the Lanham Act. They have also utilized the right of publicity as a basis for bringing a cause of action against persons or entities that have commercialized and financially benefited from use of their photo or character. Nevertheless, celebrities currently cannot register their characters or faces as a trademark or bring a cause of action under 15 U.S.C. § 1065 unless they are associated with, or affixed to, a product or its packaging.

As a result of the inability to register their characters or faces as a trademark without such association, several commercial developments have occurred that are questionable as to whether they violate the rights of celebrities’. First, independent photographers, also known as paparazzi, take, print, distribute and sell photos of celebrities for their own monetary benefit. Second, the mainstream media also commercially benefits from these photos by purchasing them from the paparazzi and using them for their own economic growth as well as to compete with tabloids. Lastly, celebrities do not directly benefit financially from the use of their photo in tabloids or in the mainstream media.

This paper examines the approaches courts have used to deny celebrity’s protection of their photographs under the Lanham Act and the First Amendment liberties of the paparazzi and mainstream media. The paper attempts to formulate a better framework for balancing the
competing interests that arise in such situations. It then further articulates factors based on a celebrity’s level of fame and the federal trademark law for courts to consider when determining whether the use of a celebrity’s photograph should be protected and use of it is an infringement of their rights.

Part I gives a brief overview of the U.S. Trademark Law and the lack of success celebrities have had in bringing claims for trademark infringement. Part II of this paper discusses the value of celebrity photographs and the influence their fame and public image has over American popular culture. Part III describes briefly the effect of celebrities’ failure to trademark their photographs. It goes on to propose an option for expanding the current trademark law in order to deter unauthorized use of celebrity photographs and characters and allow celebrities to control the use of his/her trademarked photograph. Moreover, it entertains the effect of the expansion on the paparazzi and mainstream media, counter-arguments of expansion, and opposing views regarding the benefits that celebrities’ may experience from the tabloids and media attention. Part IV overviews various trademark laws outside of the U.S. pertaining to protection of celebrity photographs in an attempt to contrast the reasoning used to pass such laws versus the U.S. denying the same protection. The paper concludes with a summary of the recommended expansion of trademark protection and challenges the counter-arguments.

I. U.S. Trademark Law

A. Trademark Protection and the Lanham Act

Trademarks are governed by both state and federal law. Originally, state common law provided the main source of protection for trademarks; however, in the late 1800s, the U.S. Congress enacted the first federal trademark law. Since then, federal trademark law has
consistently expanded, taking over much of the ground initially covered by state common law. The main federal statute is the Lanham Act, which was enacted in 1946 and most recently amended in 1996.\(^1\) Today, federal law provides the main, and by and large the most extensive, source of trademark protection, although state common law actions are still available. Most of the discussion in this paper focuses on federal law.

A trademark can be almost anything as long as it helps the consumer identify the particular product or service. It can be a word, phrase, symbol, image, sound, device, or even color.\(^2\) Section 43(a) of the Lanham Act defines a trademark as including "any word, name, symbol, or device, or any combination thereof" used by a person "to identify and distinguish his or her goods … from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."\(^3\) Examples include such marks as the Nike “swoosh,” the NBC three-toned chime “G E C,” and the distinctive shape of a Coca-Cola bottle.\(^4\) The essence of a trademark is a designation in the form of a distinguishing name, symbol or device which is used to identify a person's goods and distinguish them from the goods of another.\(^5\)

Normally, a mark for goods appears on the product or on its packaging, while a service mark appears in advertising for the services. In addition, a "tm" on a product indicates unregistered trademark rights and an "®" indicates a registered mark. It is illegal to place an "®" on a mark that does not have national registration. In order to receive a registration, a mark must fall into one of several categories: arbitrary or fanciful, suggestive, or descriptive.\(^6\)

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\(^2\) http://www.wipo.int/trademarks/en/about_trademarks.html#what_kind.
\(^4\) http://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm#8.
\(^5\) ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 921 (6th Cir. 2003).
\(^6\) http://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm.
a. Arbitrary and Fanciful Marks: these marks are most easily registered are those which are arbitrary or fanciful. These marks are those that have no obvious association with a particular good or service and do not require secondary meaning. Yahoo is a perfect example of a fanciful mark. Blue Diamond Almonds is an example of an arbitrary mark.

b. Suggestive Marks: these marks are next most easily registered but require the consumer to give some thought to understand the association. For example, a Greyhound Bus is suggestive because a consumer must think about the characteristics of a greyhound, fast, sleek and associate them with the bus service.

c. Descriptive Marks: these are marks that describe a product or service through use of a Surname (Smith's plumbing) or use of a geographical word (Napa Valley Chardonnay). These marks may be difficult to register. When a mark is truly "descriptive", as opposed to "suggestive," it is often subjective and depends on the USPTO examining attorney and how well an attorney can argue the application. “Unlike arbitrary or suggestive marks, descriptive marks are not inherently distinctive and are protected only if they acquire "secondary meaning.""7

Trademarks are generally not granted in generic words, phrases, symbols or designs; immoral or scandalous words, phrases, symbols or designs; false, misleading or mis-descriptive words, phrases, symbols or designs; or surnames.8 Section 43(a) of the Lanham Act is invoked by plaintiffs in order to protect their “rights in ‘marks,’ or brand names of ordinary merchandise; however, the scope of section 43(a) is broad enough that that it extends beyond disputes between commercial competitors.9 Relevant to this, is that it also allows celebrities to “vindicate property rights in their identities against allegedly misleading commercial use by others.”10 This is discussed in more detail in the next section of the paper.

8 Id.
10 Id.; see also Section 43(a) of the Lanham Act, 284 PLI/PAT 131, 257–69 (1989).
The overall purpose of trademark law is to protect the goods it represents, the goodwill and the secondary meaning it achieves. A descriptive mark acquires secondary meaning when the consuming public primarily associates that mark with a particular producer, rather than the underlying product. For example, when the owner of a good so effectively markets it with his or her mark, that consumers immediately associate the mark with only that owner.\footnote{http://legal-dictionary.thefreedictionary.com/Secondary+Meaning.} When trying to determine whether a given term has acquired secondary meaning, courts will often look to the following factors: (1) the amount and manner of advertising; (2) the volume of sales; (3) the length and manner of the term's use; (4) results of consumer surveys.\footnote{Zatarain's, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir. 1983).} In this case, a descriptive mark that would not have been registerable upon initial application may achieve trademark status and be subject to registration at some time in the future.

**B. Scope of Trademark Protection, Right of Publicity and the Court Approach**

When faced with a celebrity Lanham Act claim for trademark infringement, courts go through a traditional trademark infringement analysis, which includes a likelihood of confusion test and any asserted defenses such as a First Amendment or a fair use defense. The alleged mark being discussed here is a celebrity photograph. In applying the likelihood of confusion test to determine the level of consumer confusion, courts typically look to a number of factors. They include the strength of the mark, the proximity of the goods, the similarity of the marks, evidence of actual confusion, the similarity of marketing channels used, the degree of caution exercised by the typical purchaser, and the defendant's intent.\footnote{Polaroid Corp. v. Polarad Elect. Corp., 287 F.2d 492 (2d Cir. 1961), cert. denied, 368 U.S. 820 (1961).}
A celebrity typically brings a violation of his/her common law right of publicity in the same suit because it is analogous to his/her ability to sue under the Lanham Act for an alleged misleading commercial use of his/her photograph or character. Courts will consider these claims at the same time and in the same light. The common law right of publicity developed in order to protect celebrities’ commercial interest in their identities, and affords a person whose identity has commercial value, the right to control the commercial use of that identity. “The focus of the right of publicity is on protecting the celebrities’ identity from economic exploitation” and “providing an incentive for creativity and achievement.” Unlike trademark protection, the right of publicity does not require a celebrity to show a likelihood of consumer confusion as related to a product or service, only that their identity or likeness has been used commercially to benefit the defendant without consent and to the financial detriment of the owner. Right of publicity claims are also subject to First Amendment defenses and many times the celebrity fails in their claim against such a defendant.

14 While not the focus of this paper, the right of publicity is similar in many respects to a celebrity Lanham Act claim. For a discussion of the right of publicity, see Bruce P. Keller, The Right of Publicity: Past, Present, and Future, in ADVERTISING LAW IN THE NEW MEDIA AGE 2000, 159 (PLI Corp. Law & Practice Course, Handbook Series No. 808, 2000).
16 Parks, 329 F.3d at 459. (stating that “Parks’ [sic] right of publicity argument tracks that of her Lanham Act claim.”). In many cases where a claim is brought under section 43(a) of the Lanham Act, the plaintiff will allege a violation of his common law right of publicity will as well. See, e.g., id.
17 Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir. 1983). The theory of the right to publicity is that “a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.” Id. Other justifications for the right of publicity include furthering economic goals, such as promoting the efficient allocation of resources and protecting consumers, and protecting noneconomic interests, such as safeguarding natural rights and securing to the celebrity the fruits of his own labors. Cardtoons, 95 F.3d at 973.
18 Carson, 698 F.2d at 835.
19 Cardtoons, 95 F.3d at 973.
1. Trademark Infringement

Celebrities, their publishers, and licensing agents have been suing for trademark protection of images and likeness for many years and have been unsuccessful. Celebrities have standing to bring a cause of action under section 43(a) of the Lanham Act for alleged infringement of their image or photograph “because they possess an economic interest in their identities” similar to that of the traditional trademark holder. As discussed above, not only do celebrities consider their photograph to hold value, but so does the American popular culture, regardless of whether a celebrity decides to endorse a particular product or service. Nevertheless, the Lanham Act requires a plaintiff to prove that a use of their identity likely misled consumers into believing that the celebrity endorsed the product in question. Thus courts have typically rejected these particular claims of trademark protection.

The Sixth Circuit stated that "[i]n order to be protected, a mark must be capable of distinguishing the owner's goods from those of others." Not every word, name, symbol or device qualifies as a protectable mark; rather, it must be proven that it performs the job of identification, i.e. to identify one source and to distinguish it from other sources. If it does not do this, then it is not protectable as a trademark under the current law. A more detailed explanation of the goods supplied by a celebrity is discussed below in part II. In ETW Corp. v. Jireh Publ'g, Inc., the court holds that the plaintiff was claiming protection under the Lanham Act for any and all photographs of Tiger Woods and in effect asking the court to constitute Tiger Woods

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22 Id.
23 332 F.3d 915, 922 (6th Cir. 2003).
himself as a trademark.\textsuperscript{24} The court states that it was an untenable claim because “photographs and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation.”\textsuperscript{25} In essence, a celebrity photograph is not protected under the Lanham Act unless it unmistakably represents a good or service. The Sixth Circuit holds that photographs cannot function as a trademark because there are likely thousands of photographs and likenesses of celebrities taken by countless photographers, and drawn, sketched, or painted by numerous artists, which have been published in many forms of media, and sold and distributed throughout the world.\textsuperscript{26} This is because most celebrities have not attained the right within the current law to register their valuable photograph, or have it recognized as a protectable mark; therefore they also do not have the right to limit commercial use of it in relation to its use with products or services. The goods and/or services associated with a celebrity photograph, explained further in part II, are arguably their movie and television productions.

The court further speculates that no reasonable person could believe that merely because photographs or paintings contain a celebrity’s likeness or photograph, they all must have originated with that celebrity. Although its decision is supported by similar decisions of other courts that addressed the same issue, one could question whether its analysis may be extended; this is discussed further below in part IV. The Second Circuit rejected a trademark claim for the likeness of a photograph of Babe Ruth used in a calendar by the defendant. The court held that a “photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently 'distinctive' in the trademark sense of tending to indicate origin.”\textsuperscript{27} And similarly, the Sixth

\textsuperscript{24} 332 F.3d at 922.  
\textsuperscript{25} Id.  
\textsuperscript{26} Id.  
\textsuperscript{27} Pirone v. MacMillan, Inc., 894 F.2d 579, 583 (2nd Cir. 1990).
Circuit, the court concluded that a consumer could not reasonably believe that Ruth sponsored the calendar.

The above case law restricts, generally, celebrity’s rights under the Lanham Act by requiring him or her to show likelihood of consumer confusion. Without association with a particular product or good, the celebrity suing for trademark infringement under the Lanham Act will likely fail on section 43(a) cause of action each time.

2. Trademark Dilution

In addition to bringing an action for infringement, owners of trademarks can also bring an action for trademark dilution under either federal or state law. For example, a famous trademark used by one company to refer to tennis shoes might be diluted if another company began using similar mark to refer to computers or printers. Under federal law, a dilution claim can be brought only if the mark is "famous." In deciding whether a mark is famous, the courts will look to the following factors: (1) the degree of inherent or acquired distinctiveness; (2) the duration and extent of use; (3) the amount of advertising and publicity; (4) the geographic extent of the market; (5) the channels of trade; (6) the degree of recognition in trading areas; (7) any use of similar marks by third parties; (8) whether the mark is registered. Kodak, Exxon, and Xerox are all examples of famous marks. Under state law, a mark need not be famous in order to give rise to a dilution claim. Instead, dilution is available if: (1) the mark has "selling power" or, in other words, a distinctive quality; and (2) the two marks are substantially similar.

Once the prerequisites for a dilution claim are satisfied, the owner of a mark can bring an action against any use of that mark that dilutes the distinctive quality of that mark, either through

29 Id.
"blurring" or "tarnishment" of that mark; unlike an infringement claim, likelihood of confusion is not necessary.\textsuperscript{31} Blurring occurs when the power of the mark is weakened through its identification with dissimilar goods.\textsuperscript{32} For example, Kodak brand bicycles or Xerox brand cigarettes. Although neither example is likely to cause confusion among consumers, each dilutes the distinctive quality of the mark.\textsuperscript{33} Tarnishment occurs when the mark is cast in an unflattering light, typically through its association with inferior or unseemly products or services. So, for example, in a recent case, ToysRUs successfully brought a tarnishment claim against adultsrus.com, a pornographic web-site.\textsuperscript{34} The court found that ToysRUs had a registered and distinctive mark, which is used continuously in advertising its products across multiple channels both locally and nationally, and that the defendants began using the mark after it became famous.\textsuperscript{35}

There are few, if any, cases, on record where celebrities have brought trademark dilution claims, let alone be successful. This, primarily, is because celebrities must first establish that they own a valid trademark recognizable under the U.S. Trademark Law or state law. For instance, in \textit{Franklin Mint Co. v. Manatt},\textsuperscript{36} the court held the plaintiff lacked standing in a claim for trademark dilution related to Princess Diana products and dismissed the case. The plaintiff argued that Princess Diana’s name and likeness qualified as a trademark “because it was used on promotional materials to inform the public that she would perform a service.”\textsuperscript{37} Then, the plaintiff attempted to argue that Johnny Carson and Elvis Presley similarly obtained trademarks

\begin{itemize}
\item \textsuperscript{31} 15 U.S.C. § 1125(c) (2010).
\item \textsuperscript{32} Id.
\item \textsuperscript{33} Id.
\item \textsuperscript{35} Id.
\item \textsuperscript{36} 184 Cal. App. 4th 313 (Cal. App. 2d Dist. 2010).
\item \textsuperscript{37} \textit{Franklin Mint Co.}, 184 Cal. App. 4th at 315. (referring entertainment services).
\end{itemize}
in their names by using their names in association with services. Yet, the court distinguished Carson’s and Presley’s uses, as those that were “in close association with a clear reference…to entertainment services” at clubs or concerts. To qualify as a trademark, the name used cannot only identify the individual; it must also identify goods or services rendered by the individual in commerce. The use of Princess Diana’s name in association with appearances at or supporting a charitable event did not constitute use in a service mark manner; rather, her name was used only to identify her as an individual.

II. The Value Of A Celebrity’s Face

The word celebrity derives from the Latin word ‘celebritatem’ meaning ‘condition of being famous’. It indicates a celebration of individuals and the concept of an individual’s fame for their accomplishments, fame, mode of living, place in the public, and other aspects that arise as a result of their celebrated status. A celebrity is one who by his/her own voluntary efforts has succeeded in placing himself in the public eye.

Celebrities’ photographs and characters are often used to advertise products and services in the marketplace and many times they become known as the spokespersons for a particular

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38 Id at 335.
39 Id. (emphasis original).
40 Id. (the court indicated that to establish secondary meaning in this case, Manatt would have had to show that the primary significance of Princess Diana’s name was to identify charitable and humanitarian services rather than to identify the individual. The court again distinguished other celebrities: Elvis Presley, Glenn Miller, Johnny Carson, and Chef Paul Prudhomme all “achieved public name (or image) recognition in connection with their provision of services” (emphasis in original). The Princess Diana name, however, “came to strongly associate…with the person, long before she became associated with charitable work.” The court also rejected Manatt’s contention that because “Diana, Princess of Wales” could only refer to one person, it must be inherently distinctive. The court stated that Manatt overlooked the requirement that a “trademark must designate the source of goods or services” (emphasis original)).
41 Id.
44 Id.
product or service. But not all celebrities will allow their photograph or persona to be associated or used to endorse a product. Some, if not all, celebrities place so much value on the artistic nature of their photograph, that they feel it would be “selling out” to endorse a product. Although there are varying levels of beliefs and ideas regarding personality or photograph marketing, it stands to be argued that all celebrities who have made some name for themselves place significant value on his/her photograph.

For instance, in a thesis paper written by Elizabeth Lily Miller, a Georgetown University student, she classified celebrities into four levels of commercial entrepreneurship and ventures.\(^{45}\) The purpose of her thesis paper, and classification of celebrity entrepreneurship, is to detail the vast influence celebrities have over American popular culture in our consumption of endorsed products/services, how we choose to dress and wear our hair styles, and many other American tastes. Miller’s thesis expounds on a celebrities ability, and right, to “brand themselves as an extension of their products and ways of life” by pointing out that “[p]eople aspire to be like ‘them’, and buy into their images as a means of prescribing to their taste.”\(^{46}\) She gives the example of how Oprah Winfrey exercises a great deal of influence over public opinion, and how her marketing power has changed the tastes of many individuals in food, books, medical care, restaurants and many other commercial products and services.

Of course not all celebrities have the same vast influence over people as Oprah does, but most do have some influence in their own right. The following are the levels of celebrity commercial entrepreneurship that shows the value that both celebrities, and the public, place on their image. On the first level are those celebrities that do not endorse any products at all, a


\(^{46}\) Id at 3.
means of “maintaining their artistic integrity” and focusing on their “artistic endeavors.”\textsuperscript{47} The second level includes celebrities who are paid to lend their names and/or faces for an endorsement. For instance, Venus Williams endorses and advertises Avon products. This group is not specifically associated with the product or service that they promote, but the win-win is that they receive more exposure as a celebrity, and the product benefits from the endorsement.\textsuperscript{48} They also may use their image to promote a social, environmental or philanthropic cause, even those celebrities who choose not to promote commercial products may use their image in this way. The third level of endorsements involves the celebrity endorsing a product that they have some creative control over.\textsuperscript{49} The celebrity in this category is either actively involved in the creation of, or the sole creator, producer, designer of a product. An example would be Serena Williams’ “Signature” or “Aneres” clothing lines. She is the designer and also promotes her own clothing lines. The final group of celebrity commercial entrepreneurs is the “business mogul”, as Miller characterizes them, which presides over self-made empires. The popular influence that this group of celebrities has is limitless, and they tend to demonstrate the following qualities:

“1. Begins career as celebrity entertainer or athlete,

2. Likability,

3. Name brand extension of image and any products they endorse or develop,

4. Ability to develop multiple product lines into an empire,

5. Authenticity, and

6. Wide audience appeal.”

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\textsuperscript{47} Id at 10.
\textsuperscript{48} Id.
\textsuperscript{49} Id.
\end{flushleft}
These six qualities of the fourth level reveal the ability celebrities have to commercialize their photograph, and in many cases the purposeful actions taken by them to reach this level of value. These qualities can easily be attributed to the first through third levels of the celebrity commercial entrepreneur, because without them they may not have the ability to market themselves to the American popular culture by way of their artistic endeavors, clothing or hair styles, or endorsements. Given these qualities and the distinctive nature of each celebrity, there is a strong argument that each person who has reached celebrity status has commercial value in their photograph that should be protected within the United States law.

III. Effect of the Lack of Celebrity Trademark Protection and The First Amendment

Celebrities photographs are used significantly by the paparazzi in tabloids, television and other commercial mediums for its’ own financial benefit. Their photographs are also used more than a fair amount in the news. Because of the paparazzi and new media’s considerable use of celebrity photographs, this paper points out the effect of their use and purports to explain the historical connection between the paparazzi, celebrities, and the entertainment industry. It further discusses how the paparazzi has used the First Amendment defense to its benefit in order to continue its commercialization of celebrity photographs.

The paparazzi has become more recognized for their abilities in getting pictures of celebrities, which other media types do not have or do not set out to capture. Wikipedia states that the word derives from paparazzo, paparazzi is the plural form of paparazzo, the name of a news photographer in a 1960’s film who would go to great lengths to take pictures of American movie stars.\textsuperscript{50} Before the paparazzi was named as such, film studios used celebrity tabloids to promote phony romances and to cover up scandals. It was the studio system of “gossip control,”

\textsuperscript{50} http://en.wikipedia.org/wiki/Paparazzi.
well-timed leaks about a star’s purported romantic adventures helped the studios to create and sustain the public's interest in the studios' star actors.\textsuperscript{51} Also, “the movie studios' publicity agents acted as unnamed "well-informed inside sources" who provided misinformation and rumors to counteract whispers about celebrity secrets — such as homosexuality or an out-of-wedlock child — that could have severely damaged not only the reputation of the movie star in question, but the movie star's box office viability.”\textsuperscript{52} This studio system of “gossip control” collapsed in the 1950’s but reemerged in the mid-1950’s and strengthened in the 1970’s with a new purpose, to commercially benefit from taking celebrity photographs, selling and publishing them in gossip magazines and news stories.

Today the paparazzi like to consider themselves as photojournalists who report on celebrity news. Often these journalists sensationalize the lives of celebrities in tabloid newspaper allegations about the sexual practices, drug use, or private conduct of celebrities that is borderline defamatory.\textsuperscript{53} In many cases, celebrities have successfully sued for libel, demonstrating that tabloid stories have defamed them.\textsuperscript{54} It is this sense of the word that led to some entertainment news programs to be called tabloid television,\textsuperscript{55} and tabloid newspapers are sometimes “pejoratively called the gutter press.”\textsuperscript{56} Most photographers in this line of business are hired as salaried employees who work for magazines and entertainment television companies such as US, The Star, People Magazine, E! Entertainment Television, Hard Copy, or Entertainment Tonight. There are still some freelance photographers who sell their photographs to tabloid magazines, publishing companies, and the mainstream news media. Mainstream news

\begin{footnotes}
\item[52] Id.
\item[54] Id.
\item[55] Id.
\item[56] Id.
\end{footnotes}
media, such as NBC, ABC, or CNN, use the photographs for the same purposes as the tabloids and entertainment TV, to publish celebrity news.

If sued for trademark infringement or dilution from using a celebrities’ photograph, an artist, publisher, or news media company will ordinarily claim that they are protected by The First Amendment. More specifically, they may claim a defense under the doctrine of “incidental use” or newsworthy relevance, which exempts use of a person's identity in connection with any news, public affairs, or sports broadcast or account, or any political campaign, from the dictates of Section 43(a) of the Lanham Act. The paparazzi or news media generally cannot be held liable for using someone's name, likeness, or other personal attributes in connection with reporting or commenting on matters of public interest. Many courts view this as a constitutional privilege based on the First Amendment, and some states have statutes explicitly exempting news reporting and commentary on public issues from liability.

Courts traditionally have taken an extremely broad view of "news" and "commentary," it encompasses any reporting or commenting on current events or social issues, "soft news" which is of primarily entertainment value, and conveyance of information on past events of interest. The exception is extremely broad, and would encompass almost anything that conveys information or comments on a topic of even arguable public interest. Thus, publication of a photograph in a tabloid magazine, TV news report, or a book is permissive as long as it has entertainment value. When a court finds that a mark is valid and protectable, and the defendant’s
use is protected under the First Amendment, they engage in a balancing test to weigh the risk of consumer confusion against the public interest in the newsworthy expression.\(^{63}\)

### A. Expanding Celebrities’ Rights Within the Current Law

It is long settled that a name of a celebrity can be used as a trademark. Elvis Presley, Marilyn Monroe and John Lennon are all names protected by U.S. trademarks. The real question that now arises is to what extent a "persona" and/or a "likeness" can be treated as a trademark. As stated above, in the Tiger Woods case the Court did not allow a claim to protect Tiger Woods' photograph as a trademark.\(^{64}\) Nonetheless, the reasoning of that case and others seem to indicate that while not every likeness of a celebrity can function as a trademark - if in fact a likeness and persona are in use for certain classes of goods or services - trademark protection will follow. Indeed, in one decision, the Trademark Trial and Appeal Board denied registration to the likeness and photograph of Elvis Presley, when it was not limited to his dress, age, or pose.\(^{65}\) At the same time, however, one Court did allow a famous basketball player to maintain rights to his former name (i.e. a name no longer in use).

Considering the overriding restriction on the protection given to the indicia of a celebrity likeness and photograph under § 15 U.S.C. 1115, courts should consider a celebrity photograph to be a valid mark if it has been used consistently in promotional and advertising materials and thus has retained a "single and continuing commercial impression."\(^{66}\) In *Estate of Presley*,\(^{67}\) the court suggested that the only way a celebrity’s photograph may receive or be recognized as a

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\(^{63}\) *Parks*, 329 F.3d at 447.
\(^{64}\) *ETW Corp.*, 332 F.3d at 915.
\(^{67}\) *Id.*
valid registration is to be associated continuously with a consistent product. Therefore, a celebrity’s photograph is essentially blocked from receiving a trademark registration because of the nature of their work. For instance, Brad Pitt has been portrayed in multiple movies roles, but because he is not associated with one continuous product (a line of cars, a line of clothing) he may not register nor will his photograph be recognized as a protected mark.

Ironically, the court in ETW observed the following:

“Because celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity photographs can be an important avenue of individual expression. As one commentator has stated: ‘Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and of consumption. Whether or not celebrities are ‘the chief agents of moral change in the United States,' they certainly are widely used--far more than are our institutionally anchored elites--to symbolize individual aspirations, group identities and cultural values. Their photographs are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.’”

This excerpt suggests that courts do recognize the value of celebrity images, photos, and faces, yet they are pigeon-holed within the current requirements of trademark law.

This paper proposes an expansion of the current law for dealing with celebrity Lanham Act claims and recognition of their photograph as a valid and protectable trademark. The proposed expansion draws upon the four levels of celebrity commercial entrepreneurship discussed in part II and fitting them within the third category of trademarks, descriptive marks only if they have reached celebrity status or become famous (“famous”). Famous, as defined above in part II, indicates a celebration of individuals and the concept of an individual’s fame for their accomplishments, fame, mode of living, place in the public, and other aspects that arise as a

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68 Id at 1370.
69 ETW Corp., 332 F.3d at 935 (quoting an excerpt from (Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights (1993) 81 Cal. L. Rev. 125 at 128
result of their celebrated status. Each of the four levels of celebrity commercial entrepreneurship includes a celebrity who, by their own choice, is in the public eye and reached a level of fame due to their accomplishments. Courts should follow or develop a test or a set of factors to determine if a person has reached celebrity status, below is a list of suggested factors for determining whether a celebrity is famous:

1. How many movies, songs, games, television episodes, etc. they have completed;
2. Whether consumers buy into (demand) their image as a means of taste or style;
3. How much wealth they have acquired from their entertaining or sports activities;
4. How many television or radio appearances they have been in;
5. Whether they endorse any commercial products or services;
6. Whether they receive mass media attention.

The list is not all encompassing and courts should add or change to fit their region and/or reasoning. The first three factors should be weighed heavier than the last three factors simply because some celebrities may choose not to appear in television or radio, endorse commercial products, or may avoid (if possible) mass media attention. Each factor should have its own set of factors or separate test to determine if the factor has been met, again courts should develop these second level tests based on region and/or reasoning using in their courts.

Although, as the plaintiff in ETW argues, a celebrity may appear to be distinctive by way of his or her status and appropriations given by the American popular culture, courts struggle with recognizing the individual as the good or product an image represents. Therefore, if a court determines that a celebrity is famous courts should then place the celebrity’s claimed trademark photograph into the descriptive mark category and determine if the mark has attained secondary

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meaning. A celebrity photograph should be classified as descriptive because it conveys an idea of the qualities, characteristics, effect, or purpose of a celebrity’s product or service. Entertainment, whether it is in movies, professional sports, television, or theater, is a product or service provided to consumers.

Once a celebrity photograph is categorized as descriptive, courts should determine if the use of the photograph has acquired secondary meaning by looking to the traditional factors: (1) the amount and manner of advertising; (2) the volume of sales; (3) the length and manner of the photographs’ use; (4) results of consumer surveys. Celebrity’s works and photographs easily satisfy these factors in the following ways, 1) their movies, TV shows, games, or songs are advertised heavily in an attempt to market them to the consumer for sales; 2) the volume of sales can be determined by the box sales, ratings, ticket sales or record sales; 3) the length and manner of the use of a celebrity’s photograph can be based on how long a movie runs, a television show survives, an athlete plays, or how many songs are performed/produced; and 4) the result of consumer surveys can be based on how the American popular culture reacts to the celebrities’ fame.

If a court determines that a celebrity’s photograph as a mark has acquired secondary meaning, a court using this proposed test should then look to the traditional likelihood of confusion factors first, in order to establish whether the defendant’s use of the celebrity’s photograph does in fact create a likelihood of confusion for consumers before addressing any First Amendment concerns. If the court determines that the use creates a likelihood of confusion 

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71 Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 792 (5th Cir. La. 1983)
72 Zatarain’s, Inc., 698 F.2d at 794.
73 No Fear, Inc. v. Imagine Films, Inc., 930 F. Supp. 1381, 1383 (C.D. Cal. 1995). The district court in No Fear followed an approach similar in structure when it determined that it should analyze the likelihood of confusion present in a particular situation before proceeding to address the First Amendment issues. 930 F. Supp. at 1384. The court chose to first apply the likelihood of confusion factors, and then to weigh the likelihood of confusion against the First Amendment concerns. Id. at 1384.
consumer confusion, it should examine whether the defendant’s use of the celebrity’s photograph is protectable news worthy expression.\textsuperscript{74} To determine if the use is protected by the First Amendment, the court should examine whether the celebrity’s photograph is has newsworthy relevance to the underlying work. In deciding the newsworthy relevance of a particular use of a celebrity’s photograph, the court should draw upon concepts from the fair use defenses in trademark law.\textsuperscript{75} If the court finds that there is some level of newsworthy expression in the use, then the court must engage in a balancing test, similar to the one used in \textit{Parks} and \textit{ETW} mentioned above.

B. The Effect of Trademark Expansion on Paparazzi and Mainstream Media and Counter-Arguments to the Expansion

Expanding property rights associated with personas will likely raise concerns by the news media, paparazzi and even artists. Fortunately, the proposed expansion does not give celebrities the right to stop all mention, discussion, or reporting on their lives or activities. Therefore, as long as the use fits within the newsworthy or artistic exception for news reporting and commentary on matters of public interest, then both the paparazzi and the news media may continue to use the photographs. Also, many state statutes explicitly exempt news reporting and other expressive activities from liability,\textsuperscript{76} these statutes would likely not be amended under this proposition. The controversy surrounding paparazzi’s use of celebrity photographs is the question of where to draw the line between legitimate newsgathering and commercialization of characters and faces. If laws are left as they are, a celebrity's potential financial opportunities

\textsuperscript{74} If a court finds that no likelihood of confusion exists, then the defendant will prevail since the court will not find a trademark infringement.

\textsuperscript{75} Using defined factors will lessen any ambiguity of a defense, help lawyers more easily structure their claims and arguments for trial, and help judges analyze claims in a more straightforward manner.

\textsuperscript{76} http://www.citmedialaw.org/legal-guide/using-name-or-likeness-another.
will continue to be endangered by the ruthlessness of some photographers. On the other hand, if the laws become too restrictive then the freedom of the press could be jeopardized. A potential solution has been in the proposed expansion above.

Another challenge that is likely to come about is that celebrities do in fact financial benefit from the exposure of their photograph, negative or positive, which assist them in gaining more television appearances, movie roles, record deals, or better professional sports contracts. On the other hand, a negative article in a tabloid or in the news could worth in the opposite. A harmful, and potentially untrue, photograph and story of a celebrity may dilute the photograph that the celebrity has worked hard to develop, market, and sell to the public. The direct effect of it may be that the celebrity loses deals, contracts, or potential roles in movies or appearances.

A direct effect of the expansion is a potential limitation put on tabloids/paparazzi which could cause them to retaliate and limit their coverage of a celebrity. On the other hand, celebrities may welcome the limited exposure and appreciate being able to give consent or licensing rights for using their photograph in tabloids.

IV. Celebrities and Trademark Laws Outside the US

Specific anti-paparazzi legislation has gone into effect in various countries. France and Australia has very strict anti-paparazzi legislation. In the United States, California passed anti-paparazzi legislation into law after the death of Princess Diana. That event alone caused many governments to reexamine their paparazzi laws. German anti-paparazzi laws are much stronger than similar laws in most other countries, especially in the US and the UK. And, in certain circumstances, someone as famous as Will Smith also has the right to control how his photograph is used. For instance, a famous person’s photograph may not be used for commercial purposes without their consent, just as for any average person.
The actions of the paparazzi in other countries have prompted stricter laws and expansion of trademark law to allow celebrities to protect their photograph, person and financial interests. For instance the Canadian Trademarks Act prevents the appropriation by a third party of an individual's name, portrait or signature as a trademark unless his or her consent is obtained.\(^7\)

This protection is provided under Sections 9(1)(k) and 9(1)(l) of the Trademarks Act:

"9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...

(k) any matter that may falsely suggest a connection with any living individual;

(l) the portrait or signature of any individual who is living or has died within the preceding thirty years."\(^8\)

Under Section 9(1)(l) of the act, a celebrity’s photograph is protected against several forms of appropriation, even where there is not an exact reproduction of the celebrity’s photograph, provided that the use somehow suggests a connection with the celebrity.\(^9\) An additional protection is that after the celebrity’s death, “his or her portrait and signature are protected for up to 30 years (Section 9(1)(l) of the Trademarks Act).”\(^10\)

\(^7\) Trade-marks Act, RSC 1985, c T-13 (2008).
\(^8\) Id.
\(^10\) Id.
Australian trademark law provides a similar protection for celebrities under its reformed Trademark Act of 1995. The law provides celebrities greater protection for character and personality merchandising with or without a connection to a good or service. Similar laws are present in Germany, and other parts of Europe, which begs the question, why has the U.S. not followed suit and provided a more secure protection for its celebrities.

Conclusion

Although celebrities are able to turn to other laws to protect their rights of privacy and publication, there is still little if anything they can do within the current U.S. Trademark Laws to protect dilution and unauthorized commercial use of their photograph. Moreover, after building a reputation and level of success from the hard work in making movies, music, playing sports, or playing in television roles, their now valuable photograph is permitted to be used for another’s financial benefit. Granted, courts have been held to the current standards within the trademark laws in determining whether a valid trademark exists, and over time courts have more and more recognized the value of a celebrity photograph or likeness, if not its ruling, definitely in its dicta.

The suggested expansion in this paper satisfies both of the likelihood of confusion analysis required and the secondary meaning test, yet includes an additional test to determine if a celebrity has reached a certain status or fame level. This proposed test allows courts to sufficiently associate a celebrity with a product or service, such as their entertainment or sports activities, and balance the interests of a celebrity and those of the Lanham Act against the First Amendment. By determining the level of fame first, then examining the possible confusion caused by the use of the celebrity under the likelihood of confusion factors, courts begin with an

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81 Australia Trade Marks Act § 74-1063(3) (1995). (permits the assignment of trademarks with or without the goodwill of the business concerned in the relevant goods or services).
analysis that provides proper protection for celebrity trademark interests. If the court finds a likelihood of confusion, courts should then take into account the fair use element of the news worthy expression and determine its relevance by probing both common sense considerations and the factors of the fair use defenses in intellectual property law. By analyzing celebrity Lanham Act claims and First Amendment defenses in this manner, courts can provide the much needed identity protection that celebrities have been fighting for, and still consider the defense raised, and then strike the appropriate balance between the two competing interests.