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The Service Mark Alternative to the Right of Publicity: *Estate of Presley v. Russen*

Patrick J. Heneghan*
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In recent years, the development of the doctrine of the right of publicity¹ has gained significant attention from both courts and commentators.² In essence, the doctrine protects the right of an individual, especially a public celebrity, to reap the benefits of the commercial use

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1. The first case articulating the phrase "the right of publicity" and correctly identifying the values the right protects was *Halean Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), cert. denied, 346 U.S. 816 (1953); see also *Nimmer, The Right of Publicity*, 19 LAW & CONTEMP. PROB. 203 (1954).

2. See generally *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977); *Factors Etc., v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), vacated on other grounds, 652 F.2d 278 (2d Cir. 1981); *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Prods, Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981); *Groucho Marx Prods. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), rev'd, 689 F.2d 317 (2d Cir. 1982); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978); *Factors Etc. v. Creative Card Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), rev'd on other grounds, 616 F.2d 956 (6th Cir. 1977), cert. denied, 449 U.S. 953 (1980); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979); *Felcher & Rubin, Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577 (1979); *Gordon, Right of Privacy in Name Likeness, Personality and History*, 55 NW. U.L. REV. 553 (1960); *Note, The Right of Publicity—Protection for Public Figures and Celebrities*, 42 BROOKLYN L. REV. 527 (1976); *Note, Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard*

of his or her persona.³ Because the right of publicity evolved from the common law right of privacy,⁴ the right of publicity has often been confused by courts as protecting the privacy interest an individual has in his or her right to be left alone, rather than the commercial interest an individual has in the right to exploit his or her persona.⁵ The right of publicity, which protects the commercial interest individuals (generally celebrities) have in their names and likenesses, is recognized today as a right that is separate and distinct from the right of privacy. As a result, certain general propositions circumscribing the right of publicity have evolved, enabling courts to determine when a plaintiff will find relief under a right of publicity claim.⁶ Nevertheless, just as most courts agree with some of those general propositions,⁷ some courts disagree regarding other aspects of the right.

Not all jurisdictions recognizing the right of publicity allow the right to survive the holder's death. Some courts require commercialization or exploitation of the celebrity's persona in order for the right to survive,⁸ while other courts hold that regardless of exploitation the right is

Broadcasting Co., 30 STAN. L. REV. 1185 (1978) J. GILSON, TRADEMARK PROTECTION AND PRACTICE, §215 (1982) [hereinafter cited as GILSON].

3. For the purpose of this article, the term "person" refers to a celebrated individual's name, likeness, photograph, or image.

4. The right to privacy was initially defined in Warren & Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

5. For examples of earlier cases where the courts confused the protection of commercial interests with the protection of privacy interests see *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1942); *Maritote v. Desilu Prods., Inc.*, 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965); *James v. Screen Gems, Inc.*, 174 Cal. App.2d 650, 344 P.2d 799 (1959). The confusion between the commercial and the privacy interests has been compounded by Dean Prosser's definition of the invasion of the right of privacy. See W. PROSSER, HANDBOOK OF THE LAW OF TORTS §117, at 804 (4th ed. 1971). Dean Prosser's fourth type of invasion of privacy, "of the appropriation, for the defendant's benefit or advantages, of the plaintiff's name or likeness," *id.*, caused some of the earlier courts confronted with the issue to conclude that a celebrated plaintiff asserting a right of privacy claim had no cause of action because the celebrity was only getting the publicity which he sought. See *Maritote*, 345 F.2d 418; see also GILSON, *supra* note 2, §§2.15[4], [5].

Section 652(c) of the Restatement (Second) of Torts echoes Dean Prosser's definition of the right of privacy and, likewise, adds to the confusion. It states that "[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for the invasion of his privacy." RESTATEMENT (SECOND) OF TORTS §652(c) (1977). While it is generally accepted that an action for the invasion of the right of privacy may only be maintained by the living individual whose privacy was invaded, section 652(l) comment a of the Restatement (Second) of Torts, is an exception to the general rule and indicates that in situations involving the commercial appropriation of an individual's name and likeness, an action may survive that individual's death. The Restatement's survivability proviso departs from Dean Prosser's view of the survivability issue.

6. See *infra* notes 33-40 and accompanying text.

7. A majority of the courts addressing the right of publicity issue have characterized it as a property right, thereby viewing the right as both alienable and descendible as are most other property rights. See *infra* notes 51-58 and accompanying text.

8. See, e.g., *Factors, Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215; *Groucho Marx Prods. v. Day & Night Co.*, 523 F. Supp. 485; *Martin Luther King Jr. Center for Social Change, Inc. v. American Heritage Prods.*, 508 F. Supp. 854; *Hicks v. Casablanca Records*, 464 F. Supp. 426.

But see *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Prods., Inc.*, 51 U.S.L.W. 2308 (Ga. S. Ct. Oct. 28, 1982). After the question concerning the right of

not survivable.⁹ In California, for example, where the need to protect a celebrity's persona is particularly acute by virtue of the number of celebrities in the jurisdiction, the California Supreme Court nevertheless held in *Lugosi v. Universal Pictures*¹⁰ that the right of publicity does not survive the holder's death in any circumstance.¹¹ Although *Lugosi* represents the minority view regarding a descendible right of publicity, and in fact, an extreme position, that decision has a tremendous impact on the large number of celebrities residing and working in California.

As a result of *Lugosi* and similar vagaries attending the right of publicity, a plaintiff seeking to protect the commercial interest in his or her persona may be required to resort to a more traditional, judicially acceptable cause of action such as a service mark infringement claim. The service mark infringement claim is a viable alternative to a right of publicity claim because both generally afford the aggrieved plaintiff the same relief—an injunction which will halt the defendant's misappropriation of a person's name, symbol, likeness, image or words.¹² In addition, it is generally easier to enjoin conduct infringing on a service mark rather than conduct infringing on the right of publicity because an identifiable economic loss is not required in the former,¹³ whereas it is required in the latter.¹⁴

Recently, in *Estate of Presley v. Russen*,¹⁵ District Court Judge Stanley S. Brotman of the Northern District of New Jersey exhaustively explored the plaintiff's alternatives to a right of publicity claim. In that case the plaintiff, the estate of the late entertainer Elvis Presley, moved for a preliminary injunction against the defendant, Russen, the producer of a live stage show patterned after a Presley performance.¹⁶ In

publicity was certified by the United States Court of Appeals for the Eleventh Circuit to the Georgia Supreme Court, the Georgia Supreme Court held that the right of publicity is inheritable and devisable. The court found no compelling reason to require the right to be exploited in order for it to survive the holder's death.

9. See *Memphis Development Foundation*, 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953 (1980); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

10. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979) (en banc).

11. *Id.* at 824, 603 P.2d at 431, 160 Cal. Rptr. at 329.

12. Compare *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir.), cert. denied, 423 U.S. 868 (1975) (injunction issued to protect the name and configuration of a professional hockey team's service mark); *Caesars World, Inc. v. Caesar's Palace*, 490 F. Supp. 818 (D.N.J. 1980) (injunction issued to protect the name and design of the service mark "Caesar's Palace"); *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693 (D.N.J. 1977) (injunction issued to protect the name and design of the service mark "Fotomat") with, *Pro Arts*, 579 F.2d 215 (injunction issued under a right of publicity claim to halt the sale of Elvis Presley posters); *Groucho Marx Prods.*, 523 F. Supp. 485 (injunction issued to enjoin the presentation of a Broadway show); *Creative Card*, 444 F. Supp. 279 (injunction issued to stop the sale of Elvis Presley posters).

13. See *infra* notes 94-95 and accompanying text.

14. See *infra* note 17 and accompanying text.

15. 513 F. Supp. 1339 (D.N.J. 1981).

16. *Id.* at 1344. The preliminary injunction was sought pursuant to Rule 65 of the Federal Rules of Civil Procedure. The estate's ultimate goal was to permanently enjoin Russen's stage

pertinent part, the estate alleged both a violation of its right of publicity and a common law service mark infringement.¹⁷ The infringement at issue was the promotion and presentation of "The Big El Show," which was billed as a "Tribute to Elvis Presley."¹⁸ The estate sought to preliminarily enjoin both the actual stage presentation and the production and sale of "Big El Show" albums, pendants, and buttons bearing the likeness of Elvis Presley.¹⁹ The estate claimed that Russen's use of Presley's name and likeness reduced the estate's ability to license the Presley image and caused confusion in the eyes of the consuming public as to the source of the entertainment services.²⁰

The court evaluated the estate's claims under the standards for granting a preliminary injunction²¹ and concluded that the estate had made

show as well as the attendant sale of record albums, pendants, buttons, etc. In addition, the estate sought an impounding of the advertising materials which promoted Russen's show, an accounting of Russen's profits, and an award of reasonable attorney fees. *Id.*

17. *Id.* The estate also alleged that Russen violated both section 43(a) of the Lanham Trademark Act, 15 U.S.C. § 1125(a) (1976) (federal trademark law) and the New Jersey common law of unfair competition. *Id.* After granting an injunction on the common law service mark infringement claim, the *Estate of Presley* court was not compelled to exhaustively address the practicality of either the section 43(a) claim or the unfair competition claim as alternatives to a right of publicity claim. Thus, both the section 43(a) claim and the unfair competition claim are beyond the scope of this article and will not be addressed here.

To prove a bona fide common law service mark infringement, the estate needed to establish two elements: first, that the estate had a valid service mark in Elvis Presley's persona which was recognized by members of the consuming public, and second, that Russen's activity either was likely to confuse members of the public as to the source of the entertainment services or caused the estate to suffer an identifiable economic loss. *See also infra* notes 113-156 and accompanying text.

18. 513 F. Supp. at 1349. The court recognized three factors critical to the estate's common law service mark infringement claim. First, Russen never entered into any licensing agreements with the estate in connection with the advertising or promotion of either the stage show or other related goods (i.e., record albums, pendants, buttons, etc.). *Id.* at 1350. This fact eliminated any solace Russen may have enjoyed with a defensive claim of either laches or acquiescence. Second, the court recognized that Russen's production was not merely a modest mimicry of an Elvis Presley production. Rather, it was a full scale imitation patterned after an actual Elvis Presley stage show. *Id.* at 1348. Finally, the court concluded that 'Big El Show' promotional material and bona fide Elvis Presley records and promotional material were confusingly similar. *Id.* at 1349-50. These final two conclusions were essential elements to the estate's common law service mark infringement claim—that a reasonable consumer was likely to be confused as to the source of the entertainment services. *See also infra* notes 182-193 and accompanying text.

19. 513 F. Supp. at 1344.

20. *Id.* at 1362.

21. A preliminary injunction is an injunction issued to protect the *status quo* of the litigants. *See* *Burton v. Matanuska Valley Lines, Inc.*, 244 F.2d 647, 650 (9th Cir. 1957). It also protects the plaintiff from irreparable injury and preserves the court's ability to render a meaningful decision after a trial on the merits. In order to prevail on a motion for a preliminary injunction, generally the plaintiff must establish four elements: that there is a significant threat of irreparable injury to the plaintiff if the injunction is not granted; that the injury to the defendant if an injunction is issued is less than the injury to the plaintiff if an injunction is not issued; that the plaintiff has a probability of success on the merits; and that the public interest favors the granting of the injunction. *See* *Lungrin v. Claytor*, 619 F.2d 61, 63 (10th Cir. 1980); *Ekanem v. Health & Hosp. Corp.*, 589 F.2d 316, 319 (7th Cir. 1978); *National Tank Truck Carriers, Inc. v. Burke*, 608 F.2d 819, 923 (1st Cir. 1979); *see also* 11 C. Wright & A. Miller, *FEDERAL PRACTICE & PROCEDURE*, §2948 at 430-31 (1973). *But see* *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979) (preliminary injunction is appropriate where plaintiff establishes possible irreparable harm and either probable success on the merits or sufficiently serious questions going to the merits to make them a fair ground for litigation or a balance of hardships tipping in the plaintiff's

an adequate showing that it would succeed on the merits on all four counts.²² The court concluded, however, that the estate failed in its right of publicity claim to show that it would meet the second preliminary injunction requirement, a showing of irreparable injury.²³ Despite the failure of the right of publicity claim, the court nevertheless issued a preliminary injunction because the requisite irreparable injury was established in the estate's remaining claims²⁴—infringement of the estate's service marks and unfair competition.²⁵

This article will examine the *Estate of Presley* court's decision to grant relief on the Presley estate's service mark claim and explore how plaintiffs seeking to protect the commercial interest in their names and likenesses may do so with the more traditional service mark infringement cause of action. Part I will discuss the development of the right of publicity and identify some of the infirmities attending the right of publicity as it is currently recognized. Part II will discuss the common law service mark infringement action as an alternative to a right of publicity claim and will outline the essential elements which must be established in order for a court to conclude that a valid and protectable service mark exists. Part III will discuss how the *Estate of Presley* court employed the principles of service mark law to issue a preliminary injunction which halted Russen's misappropriation of the estate's service marks.

I. THE RIGHT OF PUBLICITY

The right of publicity may be defined as an individual's right to have "personal control over [the] commercial display and exploitation of his [or her] personality and the exercise of his [or her] talents."²⁶ This right has evolved over the last three decades to protect a celebrity's investment of the time, energy, and money expended to create a marketable commodity—his or her persona. Although traditionally a celebrity's reward for the creation of a persona was an increase in his or her ap-

favor). The Ninth Circuit Court of Appeals' test for a preliminary injunction is slightly different. In the Ninth Circuit the party requesting a preliminary injunction must first show that there is a probability of success and a possibility of irreparable injury. Then that party must demonstrate that serious questions are raised and that the balance of hardships are tipped sharply in its favor. *See Miss Universe, Inc. v. Fleisher*, 605 F.2d 1130, 1134 (9th Cir. 1979).

22. 513 F. Supp. at 1382.

23. *Id.* at 1378. Irreparable injury is generally equated with a showing of an identifiable economic loss. *See, e.g., Brown v. Choate*, 411 U.S. 452 (1973); *National Tank Truck Carriers, Inc.*, 608 F.2d 819, 829; *G.T.E. Sylvania, Inc. v. Consumer Prods. Safety Comm'n*, 404 F. Supp. 352, 373 (D. Del. 1975).

24. 513 F. Supp. at 1380-81.

25. *Id.* at 1382. The *Estate of Presley* court found that the two remaining injunction requirements, a balance of the equities and a showing of a public interest, were met. *Id.* at 1381-82.

26. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 569 (1977) (citations omitted).

peal to the public, the endorsement and licensing opportunities recently available to popular celebrities has vastly increased the commercial worth of the persona created. The right of publicity is designed to afford celebrities the exclusive right to capitalize on that investment.²⁷

A. *The Origin and Development of the Right of Publicity*

In some of the earlier cases addressing the unauthorized commercial use of an individual's persona, the courts almost uniformly denied recovery because the right of publicity was often confused with the right of privacy. In *O'Brien v. Pabst Sales Co.*,²⁸ for instance, the plaintiff, a famous football player, failed in his attempt to assert either a right to prevent the use of his picture on a calendar advertising beer or a right to recover for the advertising value of his photograph.²⁹ In denying relief, the court concluded that as a celebrity O'Brien had forfeited his right of privacy, and thus, there was no actionable wrong.³⁰ The court further posited that O'Brien was only getting the publicity that he sought.³¹ Judge Holmes, however, dissented, recognizing that although O'Brien may have pleaded the wrong theory, invasion of privacy, an athlete has a pecuniary interest in his or her name and likeness.³²

Judge Holmes' dissent was vindicated in *Halean Laboratories, Inc. v.*

27. Recognizing the exponentially growing endorsement and licensing opportunities for prominent individuals, Chief Justice Bird of the California Supreme Court recently stated in her *Lugosi* dissent:

Today it is commonplace for individuals to promote or advertise commercial services or products or . . . even have their identities infused in the products. Individuals prominent in athletics, business, entertainment and the arts, for example, are frequently involved in such enterprises. . . . As a result, the sale of one's persona in connection with the promotion of commercial products has unquestionably become big business. . . .

Such commercial use of an individual's identity is intended to increase the value or sales of the product by fusing the celebrity's identity with the product and thereby siphoning some of the publicity value or good will in the celebrity's persona into the product. This use is premised, in part, on public recognition and association with that person's name or likeness, or an ability to create such recognition.

Lugosi v. Universal Pictures, 25 Cal.3d at 834, 603 P.2d at 437-38, 160 Cal. Rptr. at 335-36 (Bird, C.J., dissenting (citations omitted)).

28. 124 F.2d 167 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1942).

29. *Id.* at 170.

30. *Id.* at 169.

31. *Id.*

32. *Id.* at 170-71 (Holmes, J., dissenting). It was this critical distinction which the *O'Brien* majority and other courts were not prepared to recognize. Compare *Maritote v. Desilu Prods. Inc.*, 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965) (Al Capone's widow and son sued for unjust enrichment based on defendant's use of Al Capone's name and likeness in the television series, "The Untouchables," and failed because the court concluded that plaintiffs were attempting to assert the privacy rights of a deceased person) and *Carson v. National Bank of Commerce Trust & Savings*, 501 F.2d 1082 (8th Cir. 1974) (court rejected Johnny Carson's claim against a travel agency for damages based on the unauthorized use of his name and picture on the ground that Nebraska state law did not yet recognize the right of privacy, and no cases were found distinguishing a protectable right of publicity) with *Edison v. Edison Polyform*, 73 N.J. Eq. 136, 67 A. 392 (1907) (plaintiff, the famous inventor Thomas Edison, successfully enjoined the activities of a company which sold medicinal products under the same Edison—the court identified the exclusive commercial interest an individual has in his or her name and likeness).

Topps Chewing Gum, Inc.,³³ the first case to articulate the phrase “the right of publicity” and clearly identify the commercial interests the right was designed to protect. The *Halean* court recognized the right of an individual to protect the publicity value of his or her photograph.³⁴ The plaintiff, a bubble gum manufacturer, had contracted with several professional baseball players for the exclusive right to use the ball-players’ photograph in connection with the sale of its product.³⁵ Subsequently, the plaintiff sued the defendant for inducing the players to breach their contracts with the plaintiff and enter into similar contracts with the defendant.³⁶ The defendant argued that the plaintiff had no legal interest in the publication of the players’ photographs beyond the player’s right to privacy, a right courts traditionally had deemed as personal to the individual.³⁷ The court rejected the defendant’s claim and concluded that the athletes had assigned a right of publicity that was separate and distinct from the right of privacy.³⁸ The court also reasoned that this right is concerned with the pecuniary interests involved and affords judicial protection to individuals (generally prominent persons) wishing to receive money for the exclusive endorsement of goods and services.³⁹ Thus, the right of publicity bars other advertisers from using an individual’s name, likeness, photograph, or image.⁴⁰

The pinnacle of judicial recognition of the right of publicity was reached when the United States Supreme Court interpreted the Ohio common law right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*⁴¹ The plaintiff in that case, an entertainer, performed a

33. 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

34. *Id.* at 868.

35. *Id.* at 867.

36. *Id.*

37. *Id.* at 868.

38. *Id.*

39. *Id.*

40. Several courts have reached similar conclusions and protected the right of celebrities to grant exclusive licenses for their persona, although these courts did not necessarily employ the phrase “the right of publicity.” *See, e.g.*, *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (professional race car driver’s right of publicity grants him an exclusive proprietary interest in his own identity); *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969) (professional baseball player has a valuable property right in his name, photograph, and image and may grant to another the exclusive right to use his name and photo); *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956) (prizefighter has “right of action” against television station where television station broadcasted an old film clip of prizefight without his consent); *Uhlaender v. Henricksen*, 316 F.Supp. 1277 (D. Minn. 1970) (baseball players have proprietary interest in their names, sporting activities, and accomplishments which enables players to enjoin manufacturer of baseball table games from using players’ names without a license); *Palmer v. Schonhorn Enters, Inc.*, 96 N.J. Super. 72, 232 A.2d 458 (1967) (professional golfers could recover damages where defendant exploited and commercialized golfer’s names, reputations, and accomplishments in connection with defendant’s golf table game); *Hogan v. A.S. Barnes & Co.*, 114 U.S.P.Q. 314 (Pa. C.P. 1957) (professional golfer has enforceable property right in his name and photograph).

41. 433 U.S. 562 (1977).

“human cannonball” act in which he was shot from a cannon into a net.⁴² Without Zacchini’s consent, a local television station filmed his entire fifteen second act and broadcasted the film clip on the evening news.⁴³ Zacchini sued for damages alleging that the news broadcast violated his right of publicity.⁴⁴ The United States Supreme Court agreed and upheld Zacchini’s claim.⁴⁵ The *Zacchini* Court identified and protected two critical values: the proprietary interest an individual has in his or her act⁴⁶ and the prevention of unjust enrichment as a result of the theft of goodwill by third parties.⁴⁷ Drawing a parallel to federal patent and copyright laws,⁴⁸ the Court concluded that the right of publicity protection provides the economic incentive for an individual to make the investment required to produce an act of interest to the public.⁴⁹ Moreover, the Court recognized that there was no justification for allowing the defendant to get free of charge that for which he or she would normally have to pay.⁵⁰

The *Zacchini* decision is important not only because it is the first Supreme Court decision recognizing the right of publicity but also because it advances the fundamental property interests that are deeply rooted in our economic and judicial system. Providing economic incentives for creative individuals and protecting their interests from unjust interference on the part of third parties is an essential element in the development of commercial, artistic, athletic and entertainment endeavors, and as *Zacchini* illustrates, those interests are not solely confined to the area of patent and copyright law.

B. Survivability of the Right of Publicity

Whether the right of publicity survives a person’s death is important because in jurisdictions which have some type of limitation on the survivability of the right of publicity, it may be necessary for the plaintiff to resort to an alternative to that right when unable to satisfy the

42. *Id.* at 563.

43. *Id.* at 564.

44. *Id.*

45. *Id.* at 578.

46. *Id.* at 575.

47. *Id.* at 576.

48. Consideration of the federal copyright statute, 17 U.S.C. §301 (1976), is important for identifying the values that are protected by the statutory scheme and for developing a workable time frame within which the right of publicity would survive after the celebrity’s death. Although they are analogous, the right of publicity and copyright protection are not equivalent; a copyright protects a creator from the taking of specific expressions or arrangements, whereas the right of publicity protects against unauthorized appropriation of an individual’s persona which would result in unearned commercial gain to another. *See Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting).

49. 433 U.S. at 576.

50. *Id.*

limitation.⁵¹ The modern trend has been to recognize that the right of publicity is like any other property right. As such, it is fully alienable and survivable.⁵² In *Factors Etc. v. Pro Arts, Inc.*,⁵³ for example, the United States Court of Appeals for the Second Circuit upheld an injunction against the unauthorized sale of a memorial poster bearing the likeness of Elvis Presley and concluded that Elvis Presley's right of publicity survived his death.⁵⁴ The court recognized that during his lifetime Presley had licensed his right of publicity to a corporation which in turn licensed its rights to the plaintiff following Presley's death.⁵⁵ The theoretical foundation upon which the court held that the right was assignable and not extinguished by Presley's death was the purely commercial nature of the protected right.⁵⁶ Since the court recognized that the exclusive right to profit from a celebrity's name and likeness was a transferable interest in property, the court held that this factor "compel[led] the conclusion that the right survive[d] the celebrity's death."⁵⁷ The court distinguished claims based on the right of privacy which do not survive because they are enforced solely to prevent injury to feelings.⁵⁸

Some courts have held that regardless of exploitation, the right of publicity does not survive the holder's death.⁵⁹ Thus, in *Memphis Development Foundation v. Factors Etc., Inc.*,⁶⁰ the United States Court of Appeals for the Sixth Circuit held that under Tennessee law, Elvis Presley's right of publicity did not survive his death.⁶¹ In its opinion the court asserted that the right of publicity is similar to other "personal attributes" which are not inheritable such as titles and offices,

51. For an exhaustive exploration of the survivability problems associated with the right of publicity, see Felcher & Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125 (1980); Sims, *Right of Publicity: Survivability Reconsidered*, 49 FORDHAM L.REV. 453 (1981). Comment, *Lugosi v. Universal Pictures: Descent of the Right of Publicity*, 29 HASTINGS L.J. 751 (1978).

52. See *supra* note 51.

53. 579 F.2d 215 (2d Cir. 1978), *vacated on other grounds*, 652 F.2d 278 (2d Cir. 1981).

54. *Id.* at 222.

55. *Id.* at 221-22.

56. *Id.*

57. *Id.* at 221.

58. *Id.* at 222. See also *supra* note 51. The survivability of the right of publicity finds additional support in the longstanding judicial policies of preventing unjust enrichment by the theft of another's goodwill and encouraging the investment of effort and creativity. See *Zacchini*, 433 U.S. at 576. The *Pro Arts* court recognized that to hold that Presley's death extinguished the right that was purchased by the plaintiff would grant a windfall to competitors and render the exclusive right virtually worthless. 579 F.2d at 221.

59. Some courts have avoided taking this drastic position because of the circumstances of the respective cases. See, e.g., *Pro Arts*, 579 F.2d at 222 n.11 (because right was exploited during celebrity's lifetime, court had no need to decide whether the right would survive celebrity's death absent such exploitation); *Martin Luther King*, 508 F. Supp. at 864 (because right was not exploited during celebrity's lifetime, the court not need decide whether right was devisable).

60. 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

61. *Id.* at 962.

friendship, trust, and employment contracts.⁶² Although the court identified the policy underlying the right of publicity as "the encouragement of effort and creativity",⁶³ the court failed to address the commercial and assignable nature of that right.⁶⁴

A similar result was reached in *Lugosi v. Universal Pictures*.⁶⁵ In *Lugosi* the California Supreme Court evaluated a right of publicity claim advanced by the heirs of the late actor Bela Lugosi against Universal Pictures.⁶⁶ The heirs claimed that Lugosi created a right of publicity in the Count Dracula character, which he portrayed in a series of Universal Films. The court viewed the heirs' claim essentially as an invasion of the right of privacy claim and held that "the right to exploit [one's] name and likeness is personal to the artist and must be exercised, *if at all*, by him during his lifetime."⁶⁷

The court was persuaded by Dean Prosser's definition of the right of

62. *Id.* at 959. This analogy was incorrect because unlike these personal attributes, celebrated names and faces have a publicity value that is regularly exploited to sell commercial products through mass-marketing techniques. While trust per se cannot be sold, the right to use a name or likeness that inspires trust in a product or service, like the right to use a service mark which has goodwill, can be.

63. *Id.* at 958.

64. *Id.* at 957. The *Memphis Development* decision failed to recognize that in our commercial society, the ability to pass on the fruits of one's work to one's heirs spurs America's producers to create new wealth. See *Factors, Etc. v. Pro Arts, Inc.*, 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting) ("To maintain, as *Memphis Development* did, that 'leaving a good name to one's children is sufficient reward in itself for the individual,' . . . constitutes a rather heavy burden to impose on creativity," (citation omitted)).

The continuing viability of *Memphis Development* has been seriously questioned. In 1981, in an unpublished opinion, a Tennessee chancery court held that under Tennessee law there exists a survivable right of publicity. See *Commerce Union Bank v. Coors of Cumberland, Inc.*, 551 PAT. TRADEMARK & COPYRIGHT J. (BNA) A-3 (Oct. 2, 1981). In 1982, however, another Tennessee chancery court held that the right to publicity is not survivable under Tennessee law. See *Lancaster v. Factors Etc., Inc.*, No. 88 927-2 (Shelby Co. Ch. Ct. Nov. 24, 1982). Prior to *Commerce Union* and *Lancaster* the Second Circuit had deferred to the Sixth's Circuit's *Memphis Development* decision in a case concerning the right of publicity in Tennessee. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 102 S. Ct. 1973 (1982) (Factors II). After *Commerce Union* and *Lancaster*, however, the plaintiffs in *Factors II* petitioned the United States Court of Appeals for the Second Circuit for a rehearing alleging that there is evidence that Tennessee recognizes a survivable right of publicity. At the time this article was published, the Second Circuit had not yet decided this petition.

65. 25 Cal. 3d 813, 602 P.2d 425, 160 Cal. Rptr. 323 (1979).

66. *Id.* at 816-17, 603 P.2d at 427, 160 Cal. Rptr. at 325.

67. *Id.* at 824, 603 P.2d at 431, 160 Cal. Rptr. at 329 (emphasis added). Throughout the opinion the court took judicial notice of the fact that, during his lifetime, Lugosi had never exploited his name or likeness in connection with any business, product, or service. See *id.* at 818-20, 603 P.2d at 428-29, 160 Cal. Rptr. at 326-27. The court postulated that Lugosi could have exploited his right of publicity if he had sold "commercial tie-ups," *id.* at 818 n.5, 603 P.2d at 428 n.5, 160 Cal. Rptr. at 326 n.5, such as endorsements or licenses to his name, face, or likeness.

The court's extensive discussion about exploitation leads one to conclude that the court would have been compelled to find a *survivable* right of publicity if Lugosi had exploited his right of publicity during his lifetime. This conclusion is erroneous. The exploitation discussion was predicated at the outset of the opinion on an understanding of California unfair competition laws. Stated simply, the *Lugosi* court said that the right of publicity will not survive in any circumstance; however, in the event that the individual's name has achieved a "secondary meaning" in the public's eyes, see *infra* notes 144-152, then the individual's estate or heirs may raise an unfair competition claim. Since service mark law is a part of the broader law of unfair competition, the

privacy, and concluded that death terminated Lugosi's right of publicity and released his name into the public domain.⁶⁸ The court justified a rule of nondescendibility because, in its view, the right was personal and because courts would have difficulty in selecting an appropriate durational limit within which the right would survive.⁶⁹

Recently, the United States Court of Appeals for the Second Circuit applied the *Lugosi* decision in *Groucho Marx Productions, Inc. v. Day and Night Company, Inc.*⁷⁰ and held that the Marx Brothers' rights of publicity did not survive their death.⁷¹ In *Groucho Marx Productions* the heirs and assignees of the Marx Brothers' rights of publicity asserted that the right protected against the production of the Broadway play, "A Day in Hollywood/A Night in the Ukraine."⁷² Concluding that New York law governed, the district court held that the heirs and assignees had asserted a valid right of publicity claim.⁷³ The Second Circuit reversed, holding that the district court erred in its conclusion that New York law applied.⁷⁴ The court of appeals reasoned that, under the circumstances, California law should have been applied.⁷⁵ Thus, the court of appeals looked to *Lugosi* and its progeny for the

Lugosi unfair competition proviso is yet another reason why the *Estate of Presley* service mark infringement action is a viable alternative for would-be California right of publicity litigants.

Two days after the *Lugosi* decision was released, the California Supreme Court summarily affirmed the *Lugosi* rationale in *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979). In that case the plaintiff, the nephew of the late actor Rudolph Valentino, claimed that the defendant's television program depicting Valentino's life violated Valentino's right of publicity. As Valentino's legal heir, Guglielmi argued that he was the present owner of the right and was entitled to damages and injunctive relief. The court denied recovery. Stating that *Lugosi* controlled, the court held that "the right of [of publicity] is not descendible and expires on the death of the person so protected." *Id.* at 861, 603 P.2d at 455, 160 Cal. Rptr. at 353.

68. 25 Cal. 3d at 820, 603 P.2d at 429, 160 Cal. Rptr. at 327. As explained *supra* at note 5, Dean Prosser's position that the commercial misappropriation of one's name and likeness constitutes an invasion of the right of privacy is a position shared by few.

69. 25 Cal. 3d at 823 n.8, 603 P.2d at 431, 160 Cal. Rptr. 329. If one accepts that the right of publicity, despite its genesis, is a right which protects against unfair competition, then the concerns expressed by the *Lugosi* court are about the duration of the right are easily answered—the right of publicity, just as a service mark or a trademark right, exists only as long as the mark is used and not abandoned. *See, e.g.*, *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (the right of a trademark is not a right in gross; it exists only as a right appurtenant to an established business for the protection of the business' goodwill).

70. 689 F.2d 317 (2d Cir. 1982).

71. *Id.* at 318.

72. *Id.* at 318-19.

73. 523 F. Supp. 485, 487 n.1 (S.D.N.Y. 1981). The district court reasoned that New York law governed since the injury occurred in New York, the defendants were New York residents, the play ran in New York longer than anywhere else, and the Marx Brothers' characters were originally developed and perfected in New York. *Id.*

74. 689 F.2d at 319.

75. *Id.* at 319-20. The circuit court rejected the reasons which the district court cited in concluding that New York law governed. *See supra* note 73. Instead, the Second Circuit was persuaded by, among other things, the facts that all three of the Marx brothers were California residents at the time of their death, the plaintiff, Groucho Marx Productions, is a California corporation and plaintiff Susan Marx is a California resident, and Groucho Marx, while in California, assigned his right of publicity to Groucho Marx Productions. *Id.* at 320.

operative law governing the descendibility issue.⁷⁶

The Second Circuit exhaustively analyzed the rationale and holding in *Lugosi*. Recognizing that there is some confusion regarding the language employed by the *Lugosi* court, the Second Circuit noted that the "secondary meaning" discussion in *Lugosi* "is the language of trademark [and service mark] law."⁷⁷ The Second Circuit posited that this language may have been designed to relegate a celebrity's heirs and assignees solely to their rights under trademark (and service mark) law.⁷⁸ It is critical to note that instead of foreclosing all avenues of relief for the heirs and assignees of a celebrity by recognizing "that California does not recognize any descendible right of publicity,"⁷⁹ the Second Circuit concluded that "the heirs [or assignees] of a celebrity [may] rely on trademark [or service mark] law"⁸⁰ to protect the commercial interest in the celebrity's name and likeness.⁸¹

The *Groucho Marx Productions* court is the first court to suggest that as a means to circumvent *Lugosi*, an heir or an assignee may find relief under a trademark or service mark infringement claim. The *Groucho Marx Productions* decision is persuasive authority for the proposition that a would-be right of publicity litigant should assert, in addition to or instead of, a right of publicity claim, a common law trademark or service mark infringement claim.

C. Right of Publicity Conclusion

Although the right of publicity has received widespread judicial recognition, going as high as the United States Supreme Court,⁸² the right of publicity vagaries that exist in some jurisdictions necessitate that plaintiffs seeking to protect the commercial interest in their persona plead an additional, alternative cause of action. As Section II will illus-

76. *Id.* at 319-23.

77. *Id.* at 9 (citing *Polaroid Corp. v. Polarad Elecs Corp.*, 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961)). For a distinction between service marks and trademarks see *infra* notes 89-90 and accompanying text.

78. 689 F.2d at 322.

79. *Id.* at 323.

80. *Id.*

81. The court suggested that in addition to the trademark interpretation, *Lugosi* may be subject to a second interpretation. Under this alternative interpretation, *Lugosi* may mean that California recognizes a descendible right of publicity, but it is limited solely to the use of the celebrity's name and likeness in connection with any product or service that the celebrity promoted by exploiting his right of publicity during his lifetime. *Id.* By definition, the second interpretation is more restrictive than the trademark interpretation. In the "exploitation" interpretation, the use of the celebrity's name and likeness may be applied only to those products and services that the celebrity authorized during his lifetime, while in the trademark interpretation, service marks and trademarks may be used in connections with goods and services that are developed and endorsed after the celebrity's death.

82. See *supra* notes 41-50 and accompanying text.

trate, a viable alternative cause of action which may grant the requested relief is the service mark infringement claim.

II. COMMON LAW SERVICE MARK INFRINGEMENT ALTERNATIVE

When a plaintiff has failed to establish a valid right of publicity claim, either because those elements necessary for a preliminary injunction to issue have not been established⁸³ or because the jurisdiction places some limitation on the right of publicity, it becomes necessary for the plaintiff to resort to another cause of action which will protect his or her pecuniary interest in his or her name and likeness. One such alternative cause of action to the right of publicity claim is a common law service mark infringement claim.

Service marks are protected under both federal and state laws.⁸⁴ The Lanham Trademark Act of 1946⁸⁵ provides protection under the federal system while the California Trademark Law affords protection for trademarks, service marks, and trade names under the laws of California.⁸⁶ Although both the federal and the California systems of trademark protection permit the owner of a valid service mark to register a mark,⁸⁷ in the event that the owner fails to register the mark, he or she is nevertheless given full protection over the mark.⁸⁸ Frequently, the owner of a service mark will have a cause of action under both the state law and the Lanham Act.

In the common law a service mark is defined as any name, word, symbol, device, or any combination thereof used in connection with the sale or advertising of the services of one person to distinguish them

83. See *supra* notes 21-23 and accompanying text.

84. A leading commentator on trademarks and service marks has noted that most states provide for registration of trademarks and service marks used in that state. See J. MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION*, §§22:1, 22:5 (1973) (hereinafter cited as MCCARTHY); see also Stroup, *A Practical Guide to the Protection of Artists Through Copyright, Trade Secret, Patent, and Trademark Law*, 3 COMM/ENT L.J. 189, 217-24 (1981).

85. 15 U.S.C. §§1051-1127 (1976).

86. CAL. BUS. & PROF. CODE §§14200-14325.

87. See 15 U.S.C. §1053 (1976) (federal registration of service marks); CAL. BUS. & PROF. CODE §§14220-14233 (registration of service marks in California).

88. Under section 43(a) of the Lanham Act, 15 U.S.C. §1125(a) (1976), a service mark does not have to be registered to be afforded protection. Under section 14203 of the California Business and Professional Code, a "mark" as used in the Trademark Act "includes any trademark or service mark entitled to registration pursuant to . . . (the Trademark Act) *whether registered or not.*" CAL. BUS. & PROF. CODE §14203 (emphasis added). Although not required, it is strongly suggested that the owner of any valid and legally protectable service mark endeavor to register that mark under the state trademark statute, the Lanham Act, or both. Registration of a mark has several legal and strategic advantages. Under the state law registration serves as *prima facie* proof of ownership; places others on constructive notice of a claim of ownership so as to eliminate any defense of good faith in adopting an infringing mark; and serves as a powerful bargaining chip in settlement negotiations. When a service mark owner registers that mark under the Lanham Act, in addition to the advantages outlined above, the owner is entitled to bring his or her case in federal court and be able to recover profits, damages, costs, and treble damages. See MCCARTHY, *supra* note 84, §§19:5, 22:1; GILSON, *supra* note 2, §§4.01-4.04, 4.06.

from the services of others.⁸⁹ Historically, service marks were designed to indicate the origin of services.⁹⁰ They are intended both to assist customers in the identification of the services they sought⁹¹ and to prevent competitors from "palming off" their services.⁹²

A successful common law service mark infringement action extends protection to the owner of the mark one step beyond that protection afforded in a right of publicity claim. In the former, the plaintiff asserts that he or she owns a valid and protectable service mark and that the defendant's subsequent use of the same or similar mark to identify its services either infringed on the plaintiff's service mark or is likely to cause confusion as to the origin of the goods or services.⁹³ Because service mark laws exist not to protect the service mark *per se*, but rather to achieve the twin goals of protecting the right of the consuming public to be free from confusion and the right of the owner to control his or her service's reputation,⁹⁴ a plaintiff asserting a service mark infringement need not show an identifiable economic loss. Instead, he or she only needs to show a likelihood of confusion as to the source.⁹⁵

89. *Caesars World, Inc. v. Caesar's Palace*, 490 F. Supp. 818, 823-24 (D.N.J. 1980). Frequently, the terms service mark and trademark are used interchangeably. Although the general principles governing service mark infringement are also applicable in a trademark infringement, see *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004, 1009 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975); *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693, 702-03 (D.N.J. 1977), it is important to note that a service mark identifies a service while a trademark identifies a good. See generally *Caesars World*, 490 F. Supp. 818; GILSON, *supra* note 2, § 3.02[1]. Under the California Trademark Law a service mark is defined as "a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." CAL. BUS. & PROF. CODE §14206.

90. See *McLean v. Fleming*, 96 U.S. 245 (1878) (an infringement would be found upon a showing by plaintiff that members of the public exercising ordinary caution are likely to be misled into buying an article believing that the article is manufactured by plaintiff); see also *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868 (E.D. Mich. 1968), *aff'd*, 411 F.2d 792 (6th Cir. 1969) (after 15 uninterrupted years of employing the mark "Sun Control," the public recognized and distinguished defendant's goods and services as emanating from a particular source); *Stork Restaurant Inc. v. Marcus*, 36 F. Supp. 90 (E.D. Pa. 1941) (where plaintiff operated a restaurant named "The Stork Club" and defendant subsequently operated and promoted a restaurant under the same name, a violation of trademarks and service marks would be found because of the resulting confusion to the public).

91. *Howard Dustless Duster Co. v. Carleton*, 219 F. 913 (D. Conn. 1915) (defendant's packaging and selling of dustcloths would be enjoined where packaging deceived the public into believing product was that of plaintiff's).

92. Generally, the phrase "palming off" means the practice by a commercial competitor of deceiving the public into purchasing its (the competitor's) services under the mistaken belief that they are offered by another (usually the plaintiff). *Compro Corp. v. Day-Bright Lighting, Inc.*, 376 U.S. 234, 238 (1964).

93. See *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229-30, (3d Cir. 1978); *Caesar's World*, 490 F. Supp. 818, 823-24; *Fotomat*, 425 F. Supp. 693, 702-03; *Time Mechanisms, Inc. v. Qonaar Corp.*, 422 F. Supp. 905, 915 (D.N.J. 1976).

94. *James Burrough, Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274-76 (7th Cir. 1976), *rev'd on other grounds on retrial*, 572 F.2d 574 (7th Cir. 1978).

95. See *James Burrough*, 540 F.2d at 275-76 (plaintiff, a distiller, was not required to show that defendant's (a restaurant owner) infringing mark caused plaintiff to suffer an economic loss; instead, plaintiff only needed to show that a viewer of the infringing mark would be likely to associate that mark with the plaintiff's goods or services); *Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc.*, 486 F. Supp. 414, 429 (S.D.N.Y. 1980) (because of a trademark's unique func-

On the other hand, in the right of publicity context, because the right is designed to protect the commercial value of the celebrity's name and likeness,⁹⁶ the plaintiff must not only show that he or she owns the right and that he or she is likely to succeed on the merits but must also show with sufficient certainty that the defendant's infringement caused or is likely to cause an identifiable economic loss.⁹⁷ Often, this is an onerous burden for the plaintiff to meet, and as a result, the plaintiff's right of publicity claim may fail.⁹⁸

Individuals, particularly entertainers and professional athletes, may acquire service mark or trademark protection for their names,⁹⁹ nicknames,¹⁰⁰ photographs, likenesses, or images.¹⁰¹ A valid service mark protects the holder of the mark against another's use of the mark in connection with the offering of similar services. For example, if an entertainer advertises and promotes his or her show under his or her name and the consuming public recognizes that the production is one performed by that entertainer, another's subsequent, unauthorized use of that entertainer's name in connection with the promotion and presentation of a second show is a violation of the entertainer's service marks. In addition to offering entertainment services, that same entertainer may license his or her name and photograph to a manufacturer

tion in representing intangible assets such as reputation and goodwill, plaintiff only needed to show a high probability of confusion in order to satisfy the irreparable injury requirement of a preliminary injunction); *Russ Berrie & Co. v. Jerry Elsner Co.*, 482 F. Supp. 980, 990 (S.D.N.Y. 1980) (if a likelihood of confusion is established in a trademark infringement case, irreparable injury is presumed, notwithstanding a showing of monetary loss); *Louis Rich, Inc. v. Horace W. Longacre, Inc.*, 423 F. Supp. 1327, 1338 (E.D. Pa. 1976) (to prevail on a trademark infringement claim, plaintiff only needed to show that defendant's infringing mark was likely to cause confusion with plaintiff's marks). See also MCCARTHY, *supra* note 84, §30:18; GILSON, *supra* note 2, §5.01.

96. See *infra* note 158 and accompanying text.

97. See *supra* note 23.

98. Of course, if this is always the case, the obvious question becomes, "Why does a plaintiff assert a right of publicity claim when he or she could find relief under the alternative service mark infringement claim?" It is the authors' position that because of the novelty of the service mark infringement action and because of the twin obstacles of proving a valid service mark and showing a likelihood of confusion, a plaintiff may feel more secure resorting to a right of publicity claim. After *Estate of Presley*, however, it is more likely that a plaintiff will be more receptive to the service mark infringement alternative.

99. In order for one's name to become a service mark under the common law, the individual must show that his or her name has achieved what is referred to as a "secondary meaning." That is, a substantial number of the consuming public associates the entertainer's personal name as a symbol which identifies and distinguishes his or her services from those offered by others. The secondary meaning requirement is more fully discussed *infra* at notes 132-40 and accompanying text. See also MCCARTHY, *supra* note 84, §13:2; GILSON, *supra* note 2, §2.08.

100. See *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129 (1979) (former football player's nickname "Crazylegs" was protectable under a trade name infringement action).

101. See, e.g., *In re Carson*, 197 U.S.P.Q. 554, 555 (T.T.A.B. 1977) (the name "Johnnie Carson" is a valid service mark which identifies a comedian of that name); *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976) (the name "The Platters" is a valid service mark which identifies a singing group); *In re Folk*, 160 U.S.P.Q. 213 (T.T.A.B. 1968) (the fictitious name "The Lollipop Princess" is a valid service mark which identifies a storyteller); *In re Ames*, 160 U.S.P.Q. 214 (T.T.A.B. 1968) (the name "Neal Ford & The Fanatics" is a valid service mark which identifies a group of performers).

for the production of tee-shirts bearing his or her name and likeness. A subsequent, unauthorized manufacturer's production of the same or similar tee-shirts would be a violation of the entertainer's common law trademark rights.¹⁰²

A successful service mark infringement action is predicated on a showing that the plaintiff owned the mark, that the defendant's infringement was likely to confuse or deceive the consuming public, and that the names or symbols are valid, legally protectable service marks.¹⁰³

A. Ownership of Service Marks

The first requirement that the plaintiff asserting a service mark infringement claim must meet is that he or she is the legal owner of the service mark.¹⁰⁴ In the common law, since service mark protection arises from use, the general rule is that if the plaintiff can establish that he or she was the first user in commerce of that particular service mark then he or she has made a strong showing of ownership.¹⁰⁵ In addition,

102. In *Estate of Presley* the estate claimed that Russen's activity infringed on the estate's common law service mark rights and the estate's common law trademark rights. 513 F. Supp. at 1362. The court chose, however, to concentrate its attention on the estate's service mark infringement claim. Before focusing on the service mark claim, the court noted that the same marks that were asserted as service marks might also be trademarks which identified goods or particular products licensed by either the estate or Presley himself. *Id.* at 1363.

The recognition by the *Estate of Presley* court that a service mark may also serve as a trademark affords additional protection to the would-be service mark litigant. Many celebrities license their name and photograph in connection with matters tangentially related to their primary (entertainment or athletic) service. For example, the right of publicity infringement in the Elvis Presley line of cases typically concerned the production and marketing of Elvis Presley memorabilia such as posters and statuettes). *See, e.g.,* Pro Arts, 579 F.2d 215 (Presley posters); *Creative Card*, 444 F. Supp. 279 (Presley posters); *Memphis Development Foundation*, 441 F. Supp. 1323 (Presley statuettes). Recognizing that celebrities have common law service mark and common law trademark rights in their names and likenesses permits these celebrities or their heirs to assert either a service mark infringement claim or a trademark infringement claim. The service mark infringement claim halts the promotion and advertising of an actual performance which imitates the celebrity, whereas a trademark infringement claim stops the production and sale of memorabilia (posters, buttons, key chains, etc.) which infringes on the holder's trademark. *See, e.g.,* Wyatt Earp Enters, Inc. v. Sackman, Inc., 157 F. Supp. 621 (S.D.N.Y. 1958) (plaintiff, the producer of the television series "The Life and Legend of Wyatt Earp", successfully enjoined a children's clothing manufacturer from merchandising children's playsuits under the name, mark, and symbol "Wyatt Earp"). One commentator has suggested that a trademark owner's "Right of Identity", that is, the owner's right to protect his or her trademark's "persona", is analogous to an entertainer's right of publicity. *See* Winner, *Right of Identity: Right of Publicity and Protection for a Trademark's "Persona"*, 71 TRADE-MARK REP. 197 (1981).

103. *See Scott Paper Co.*, 589 F.2d 1225; *Perfectform Corp. v. Perfect Brassiere Co.*, 256 F.2d 736 (3d Cir.), cert. denied, 358 U.S. 919 (1958); *Caesars World*, 490 F. Supp. 818; *Fotomat*, 425 F. Supp. 693; *Oonaar*, 422 F. Supp. 905.

104. If the plaintiff asserting a service mark infringement claim can show that his or her mark was registered under either the Lanham Act or the applicable state statute, this fact establishes a rebuttable presumption that the mark is both valid and owned by the plaintiff. *See supra* note 88.

105. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415 (1916). Ownership is often an essential requirement to prove standing. As the Supreme Court stated in *Warth v. Seldin*, 422 U.S. 490 (1975), the test to determine standing is "whether the plaintiff has alleged such a personal stake in the outcome of the

however, the plaintiff must allege that the service mark is still being used in commerce to identify the plaintiff's services.¹⁰⁶ The rationale here is that a service mark has no existence independent of the service in connection with which the mark is used.¹⁰⁷ If the plaintiff shows that there has been no severance between the existence of the service mark and its actual use, then the plaintiff still maintains title in the mark.¹⁰⁸

Although service marks are considered intellectual property, they, nevertheless, are accorded traditional property right protection¹⁰⁹ and are fully alienable and descendible.¹¹⁰ Thus, unlike the situation in a right of publicity context, descendibility of the service mark never becomes an issue. Title to the service mark simply passes to the administrator or executor of the estate¹¹¹ who is entrusted with the duty of preserving and managing the assets of the estate.¹¹² A valid service mark classification, in addition to or instead of a right of publicity classification, therefore, grants the owner of the service mark a distinct legal advantage. In the former, title to a valid service mark will pass to the estate regardless of whether the jurisdiction prohibits a descendible right of publicity.

B. Likelihood of Confusion

The most critical requirement which the plaintiff asserting a common law service mark infringement claim must establish is a likelihood of

controversy' as to warrant his invocation of federal court jurisdiction and to justify exercise of the court's remedial powers of his behalf." *Id.* at 498-99 (citations omitted). Proof of the ownership of the service mark at issue in the infringement claim aids in satisfying the "personal stake" requirement.

106. *See, e.g., La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271-72 (2d Cir. 1974) (defendant constructively surrendered exclusive right to a trademark when evidence showed that defendant's federal trademark registration expired and that defendant made only 89 sales of trademarked perfume in a 20 year period).

107. *United Drug*, 248 U.S. at 97.

108. The proponent of the mark must also show that the use of the mark has been deliberate and continuous and not sporadic, casual, or transitory. *See Jean Patou*, 495 F.2d at 1272; *see also* R. CALLMANN, UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES, §76.2(d) (3rd ed. 1969).

109. *See Hanover Star Milling*, 240 U.S. 403, 413 (trademark owner's common law right of exclusive use of the trademark may be classified as a property right; however, the right grows out of use and not mere adoption); *see also* MCCARTHY, *supra* note 84, §2:6.

Section 654 of the California Civil Code defines property. It states that "the ownership of a thing is the right of one or more persons to possess and use it to the exclusion of others. In this Code, the thing of which there may be ownership is called property." CAL. CIV. CODE §654. Section 655 of the California Civil Code goes further and indicates that trademarks are "property" within the meaning of section 654. *See* CAL. CIV. CODE §§654-655.

110. Mr. Justice Holmes recognized that "in a qualified sense the [trade]-mark is property, protected and alienable." *Beech-Nut Packing Co. v. P. Lorillard Co.*, 273 U.S. 629, 632 (1927).

111. *See Dilworth v. Hake*, 64 S.W.2d 829 (trade name passed from decedent to the executrix of the estate as part of the assets of the estate) (Tex. Civ. App. 1933). *Cf. Ward-Chandler Bldg. Co. v. Caldwell*, 8 Cal. App. 2d 375, 377, 47 P.2d 758, 759-60 (1935) (trademark may be preserved and assigned where the mark is deprived of all personal aspects and used in connection with the operation of a business).

112. RESTATEMENT (SECOND) OF TRUSTS §174 (1957).

confusion as to the source of the services.¹¹³ Likelihood of confusion exists when members of the consuming public viewing the service mark may assume that the service it represents is associated with the source of a different service identified by a similar mark.¹¹⁴ The question then is not whether the services per se would be confused, but whether prospective purchasers of the services are likely to believe that the services originate or are performed by the same party.¹¹⁵

To answer this question, courts have developed workable formulas which account for the essential factors necessary to the determination.¹¹⁶ These formulas evaluate the strength of the plaintiff's marks, the similarity between the plaintiff's and the defendant's marks, the evidence of actual confusion by members of the consuming public, the intent of the defendant in adopting the mark, and whether the services are marketed through the same channels of trade.¹¹⁷

As discussed in the above section regarding the protectability of the plaintiff's marks, the strength or weakness of the plaintiff's marks is an important consideration in a showing of likelihood of confusion.

113. See generally *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979); *Scott Paper Co.*, 589 F.2d at 1231; *Caesars World*, 490 F. Supp. at 823-24.

114. *Scott Paper Co.*, 589 F.2d at 1229.

115. See E. VANDENBURGH, TRADEMARK LAW AND PROCEDURE, §5.2 at 139-40 (2d ed. 1968) [hereinafter cited as VANDENBURGH].

116. A court will balance these factors through the eyes of "ordinary purchasers, buying with ordinary caution." *McLean v. Fleming*, 96 U.S. 245, 251 (1878). Of course, by definition, when employing the "ordinary purchaser" as the guide to determine a likelihood of confusion, the court is required to speculate regarding the impressions each of these factors has on the ordinary purchaser. Because of this speculation as well as the case by case approach used by the courts, it often becomes difficult to see any consistency within the case law. Compare *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 439 F. Supp. 1022 (D. Del. 1977), *rev'd*, 589 F.2d 1225 (3d Cir. 1978) (*Scott I*), with *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225 (3d Cir. 1978) (*Scott II*). Nevertheless, it is this very burden of speculation thrust on the court that affords it the opportunity to balance the equities of the competing claims and draw reasonable conclusions based on a totality of the circumstances.

117. Additional factors considered by the courts include the price of the goods, the length of time the defendant has used the mark without evidence of actual confusion arising, the extent to which the targets of the parties' sales efforts are the same, and the relationship of the goods in the mind of the public because of the similarity of function. See, e.g., *Scott II*, 589 F.2d at 1229; *Scarves by Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976); *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 381-82 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *Caesars World*, 490 F. Supp. at 823-24; *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 800 (9th Cir. 1970); *Scott I*, 439 F. Supp. at 1036-37; *Fotomat* 425 F. Supp. at 703; *McNeil Laboratories, Inc. v. American Home Prods Corp.*, 416 F. Supp. 804, 806 (D.N.J. 1976).

In *Bell v. American Trial Lawyers Ass'n*, 14 Cal. App. 3d 289, 92 Cal. Rptr. 228 (1971), a trade name infringement action initiated by the American College of Trial Lawyers against the American Trial Lawyers Association, the California Court of Appeal formulated a nonexhaustive checklist to determine whether a likelihood of confusion existed under the common law. The checklist included an inquiry into whether actual confusion in the mind of the average prudent man had occurred, a side-by-side comparison of the names in question, and an inquiry into whether the defendant knew about the plaintiff's mark before the defendant used its mark. *Id.* at 309-10, 92 Cal. Rptr. at 241-42. The court posited that, in any event, the critical factor in a likelihood of confusion determination was the impression the mark as a whole created, by sight, sound, or meaning, on the average, reasonably prudent member of the relevant public. *Id.* at 307, 92 Cal. Rptr. at 240.

Strength refers to the ability of a service mark to identify, in the eyes of the consuming public, goods as emanating from a particular, although possibly anonymous, source.¹¹⁸ In a likelihood of confusion assessment, time, goodwill and the amount of energy and capital expended in the course of marketing a service all contribute to the development of a strong service mark. Generally, strong service marks are given a wide range of protection over related services while weaker marks are given a narrower range of protection.¹¹⁹

The similarity between the service marks at issue is another relevant factor. The greater the similarity between the plaintiff's and defendant's marks, the greater the likelihood of confusion.¹²⁰ An evaluation of the similarity of the marks in question requires a determination based on a totality of the individual features,¹²¹ including a comparison with respect to similarity of appearance, pronunciation, and meaning. One commentator has suggested that the similarity of service marks evaluation involves nothing more than an "eyeball" test on the part of the finder of fact.¹²² The test, by definition, requires the finder of fact to view the conflicting marks and evaluate the likelihood of confusion based on the overall impression which the marks create.¹²³

Although a showing of actual confusion by members of the ordinary public is not required,¹²⁴ it is strongly recommended that a complainant always endeavor to discover and assert the best possible evidence of actual confusion in any controversy.¹²⁵ The plaintiff may show actual confusion by resorting to such means as interviews or surveys. Sometimes an inartfully drafted answer to a complaint may serve as an admission by the defendant that his or her mark actually confused members of the consuming public. This occurred in *Ball v. American Trial Lawyers Association*.¹²⁶ In that case, the defendant acknowledged

118. See *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979). The *McGregor-Doniger* court identified and arranged in ascending order of strength four categories of marks—generic, descriptive, suggestive, and arbitrary and fanciful. *Id.* The relative strength or weakness of a descriptive personal name service mark, such as an entertainer's name, depends on the amount of secondary meaning the name has acquired in the public's mind.

119. See *Family Circle, Inc. v. Family Circle Assoc., Inc.* 332 F.2d 534, 540 (3d Cir. 1964) (distinctive or unique marks are given a wider range of protection against infringement than less distinct marks because distinctive marks create a deeper, longer-lasting impression on the public's consciousness).

120. See *Exxon Corp. v. Texas Motor Exch. of Houston, Inc.*, 628 F.2d 500, 505 (5th Cir. 1980) (after considering the overall impression created by the marks Tex-On and EXXON, the court concluded that the marks were not sufficiently similar in design to find a likelihood of confusion).

121. RESTATEMENT OF TORTS §729 comment b (1938).

122. MCCARTHY, *supra* note 84, §23:7.

123. *Id.*; see also *supra* note 117.

124. See *Caesars World*, 490 F.Supp. at 825.

125. See VANDENBURGH, *supra* note 115, at §5.52; GILSON, *supra* note 2, §5.01.

126. 14 Cal. App. 3d 289, 92 Cal. Rptr. 228 (1971).

that as a result of the great publicity sought and attained for its name, a member of the public may associate the defendant's name with the plaintiff's services when that member later encounters the plaintiff's organization, "The American College of Trial Lawyers".¹²⁷

The determination of the defendant's intent in his or her adoption of the infringing mark is often difficult. However, if the plaintiff can establish that the defendant adopted the mark in question with the intention of capitalizing on the plaintiff's goodwill, that fact alone may be dispositive of the issue of confusing similarity.¹²⁸ Essentially, it amounts to the defendant's admission that the respective service marks are interchangeable. Without an absolute showing of the defendant's intent, the court may nevertheless draw reasonable inferences regarding the defendant's intent.¹²⁹ In *Caesars World, Inc. v. Caesar's Palace*,¹³⁰ for example, the court drew reasonable inferences and found that the defendant intended to adopt its infringing service mark "Caesars Palace" when it was shown that the defendant had a prior awareness of plaintiff's marks, and the defendant's own marks were virtually identical in design and name.¹³¹

The similarity of service factor does not require the plaintiff to show that members of the consuming public actually believe that the service is performed by the plaintiff. Rather, the test is whether ordinary purchasers generally familiar with the plaintiff's service marks are likely to believe that the defendant's service mark is somehow related to the entity that provides the plaintiff's services.¹³² Thus, if members of the consuming public are inclined to believe that the defendant's service is licensed by the plaintiff, then this is sufficient to establish the similarity of service factor. In *Boston Professional Hockey Association v. Dallas Cap & Emblem Mfg., Inc.*¹³³ for example, the court concluded that since members of the consuming public were likely to believe that Dallas Cap & Emblem was licensed by the Boston Bruins Hockey team to

127. *Id.* at 309, 92 Cal. Rptr. at 241.

128. See RESTATEMENT OF TORTS §729 comment f (1938). Although proof of fraudulent intent is very helpful in a likelihood of confusion showing, the California courts have consistently held that fraudulent intent is not required to prove either a trademark or a service mark infringement. See *Stork Restaurant v. Shati*, 166 F.2d 348, 360 (9th Cir. 1948); *Dodge Stationery Co. v. Dodge*, 145 Cal. 380, 390, 78 P. 879, 883 (1904); *Ball*, 14 Cal.App.3d at 306, 92 Cal.Rptr. at 239-40; *MacSweeney Enters., Inc. v. Tarantino*, 235 Cal.App.2d 549, 561, 45 Cal.Rptr. 546, 554 (1965).

129. California has adopted the familiar tort concept that every person is presumed to intend the natural and foreseeable consequence of his actions. See *Dodge Stationery Co.*, 145 Cal. at 390, 78 P. at 883. As a result, the California courts have wide latitude in drawing the reasonable inferences necessary in determining the defendant's intent. See also MCCARTHY, *supra* note 84, §23:33(D); GILSON, *supra* note 2, §5.03.

130. 490 F.Supp. 818 (D.N.J. 1980).

131. *Id.* at 824-26.

132. See, e.g., *Exxon Corp.*, 628 F.2d at 504; *Schmid Laboratories v. Young Drug Prods. Corp.*, 482 F.Supp. 14, 19-20 (D.N.J. 1979).

133. 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975).

manufacture Boston Bruins emblems, the test for similarity of services was met.¹³⁴

After an examination of all of these relevant factors, the court will ultimately look through “the eyes of ordinary purchasers buying with ordinary caution”¹³⁵ to determine whether a likelihood of confusion exists. Since a “likelihood of confusion” analysis is often a conjectural process subject to the vagaries of consumer purchasing, the fictional “ordinary purchaser” enables the court to analyze realistically the impact the defendant’s alleged infringing mark has on the plaintiff’s service mark and established goodwill.

C. *Validity and Protectability of Service Marks*

The final requirement that a plaintiff alleging a service mark infringement must establish is that his or her service mark is valid and protectable. A service mark is valid and protectable when it is adopted and employed in connection with the rendering of services in order to identify those services and distinguish them from the services of others.¹³⁶ The mark can be a word, name,¹³⁷ symbol,¹³⁸ or device; and as long as the mark is used in connection with the services, it may achieve protected status.¹³⁹ However, the service mark must not be the service itself, but rather a designation of the source of those services.¹⁴⁰

A showing by the plaintiff that the mark was used in promoting, ad-

134. *Id.* at 1012.

135. *McLean v. Fleming*, 96 U.S. 245, 251 (1878).

136. *See Caesars World*, 490 F.Supp. at 822.

137. A name achieves service mark status not because it identifies an individual but because it identifies a service provided by that individual or his or her affiliates. *See In re Carson*, 197 U.S.P.Q. 554 (T.T.A.B. 1977) (the name “Johnnie Carson” is a valid service mark not because it identifies the comedian John W. Carson but because it identifies the entertainment services which Carson provides); *see also Capetola v. Orlando*, 426 F.Supp. 616 (E.D. Pa. 1977); *Five Platters v. Purdie*, 419 F.Supp. 372 (D. Md. 1976). *But see In re Lee Travino Enterprises, Inc.*, 182 U.S.P.Q. 253 (T.T.A.B. 1974) (the name “Lee Travino” was held merely to identify a famous professional golfer of that name and not services that he may have rendered).

138. *See Boston Hockey*, 510 F.2d 1004; *Fotomat*, 425 F.Supp. 693; *In re Pierce*, 164 U.S.P.Q. 369 (T.T.A.B. 1970).

139. *See Orlando*, 426 F.Supp. 616; (E.D. Pa. 1977); *Five Platters*, 419 F.Supp. 372; *In re Carson*, 197 U.S.P.Q. 554.

140. Since a service mark is designed to inform the public of the origin of the services and not to protect the owner’s ability to render those services, the service mark cannot be the service itself. Thus, in *In re Lee Travino*, the Trademark Trial and Appeal Board refused to grant service mark protection because the asserted mark was only descriptive of the endorsements which Travino gave. The mark did not inform the public of the origin of the services, 182 U.S.P.Q. at 254. *See also Cebu Ass’n of California, Inc. v. Santo Nino de Cebu U.S.A., Inc.*, 95 Cal. App. 3d 129, 137, 157 Cal. Rptr. 102, 107 (1979) (service mark must be distinctive, separate, and apart from identity of service itself, so as to permit many others to offer the same service; one cannot appropriate identity of service mark or else all others would be excluded from the field); *KGB, Inc. v. Giannoulas*, 104 Cal. App. 3d 844, 856-57, 164 Cal. Rptr. 571, 582-83 (1980) (to be entitled to service mark protection, service mark must be stationary and unchanging; since former employee of radio station had appeared in a chicken costume similar, though not identical, to radio station’s chicken costume and developed his own distinctive mannerisms while appearing in costume, a service mark infringement did not occur).

vertising, or selling the services generally warrants service mark recognition and protection.¹⁴¹ Although a court uses its powers to draw reasonable inferences from all the facts to determine whether a service mark is valid, it is critical that the plaintiff show how the service mark was used in relation to the identification of services.¹⁴² A court will not recognize a mark that is only tangentially related to the services rendered without a showing that the mark actually identified the services provided.¹⁴³

The extent of protection afforded in a service mark infringement action initially depends on the classification of the mark itself.¹⁴⁴ One classification of marks, those which either are descriptive or which use common words or symbols, must acquire secondary meaning¹⁴⁵ through use before protection is afforded.¹⁴⁶ The other classification of marks, inherently distinctive marks,¹⁴⁷ gain protected status upon their first use in commerce.¹⁴⁸ It is unnecessary for a plaintiff who owns an inherently distinctive mark to prove that his or her mark has acquired secondary meaning.¹⁴⁹ Thus, in *Caesars World*,¹⁵⁰ the plaintiff's service marks consisting of the phrase "Caesars Palace" written in a Romanesque letter style¹⁵¹ were protectable as inherently distinctive marks because "the marks are unique, arbitrary, and nondescriptive."¹⁵²

In some cases where the service mark infringement claim is used as an alternative to the right of publicity, the secondary meaning require-

141. See, e.g., *Dallas Cowboys Cheerleaders*, 604 F.2d 200, 205-06; *Caesars World*, 490 F.Supp. 818, 822; *James Burrough*, 540 F.2d 266, 274.

142. See *Hirsch v. S. C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 381, 280 N.W.2d 129, 131 (1979) (to establish a common law trade name infringement, plaintiff was required to show that his nickname designated his vocation or occupation as a sports figure and that the use of his name on a shaving gel for women created a likelihood of confusion as to sponsorship).

143. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1133 (2d Cir. 1979). Affording protection to marks bearing only a tangential relation to a service would not advance the primary goal which service marks are designed to achieve—ensuring that the consuming public is not misled into believing that the services it associates with a particular mark are the services it wants.

144. See *Caesars World*, 490 F. Supp. at 822.

145. The word "secondary" in "secondary meaning" does not refer to the relative importance of a descriptive as opposed to an inherently distinctive mark. Instead, "secondary" refers to the passage of time. Thus, material which originally may have had only descriptive significance now with the passage of time has acquired a secondary meaning which informs the consuming public what the origin of the services are. See *VANDENBURGH*, *supra* note 115, §4.70; *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912); see also *GILSON*, *supra* note 2, §2.09.

146. *Caesars World*, 490 F.Supp. at 822.

147. Inherently distinctive marks are also called technical marks. *Id.* Fanciful or arbitrary words and symbols warrant the inherently distinctive mark classification. See *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 439 F. Supp. 1022, 1034 (D. Del. 1977), *rev'd on other grounds*, 589 F.2d 1225 (3d Cir. 1978).

148. 490 F. Supp. at 822.

149. *Id.* at 823.

150. 490 F. Supp. at 818.

151. *Id.* at 823.

152. *Id.* In *Caesars World*, the court also noted that the plaintiff's service marks were invented solely for use in connection with its resort hotel. *Id.* at 822.

ment may be an obstacle to the assertion of a valid claim. A plaintiff asserting a personal name as a service mark, such as the name Elvis Presley, must show that because the marks have been used for such a long period of time in connection with the advertising and promotion of certain entertainment services, the mark has acquired a secondary meaning which distinguishes those entertainment services from any other entertainment service.¹⁵³ This was the result reached in *Scarves by Vera, Inc. v. Todo Imports Ltd.*,¹⁵⁴ where the court recognized that although the plaintiff's trademark "Vera" was a common personal name,¹⁵⁵ the plaintiff established secondary meaning in the eyes of the consuming public by showing that its sales figures and advertising expenses reflected a wide public acceptance of the mark "Vera."¹⁵⁶

III. BRIDGING THE GAP: *ESTATE OF PRESLEY V. RUSSEN*

In evaluating the estate's causes of action, the *Estate of Presley* court first turned to the right of publicity issue. The court concluded that the estate established a likelihood of success on the merits for the right of publicity claim because New Jersey has recognized and supported an individual's right to prevent the unauthorized, commercial appropriation of one's name and likeness¹⁵⁷ and because the right of publicity, as it is known today, protects against theatrical imitations.¹⁵⁸ Nevertheless, the court denied the preliminary injunction based on the right of publicity claim because the estate failed to establish an irreparable injury.¹⁵⁹ Concluding that the right of publicity is designed to protect an individual's exclusive right to reap the commercial benefits of his or her persona, the court asserted that the estate must establish that Russen's activity somehow impeded the estate's ability to capitalize on Presley's persona.¹⁶⁰ Moreover, since in a right of publicity claim the court is often asked to balance the societal considerations of free expression against the individual's right to capitalize on his or her persona, the

153. See *Five Platters*, 419 F. Supp. at 381.

154. 544 F.2d 1167 (2d Cir. 1976) ("VERA" for scarves enforced against "VERA" for toilet-tries); see also *Jerrico, Inc. v. Jerry's Inc.*, 376 F. Supp. 1079 (S.D. Fla. 1974).

155. 544 F.2d at 1173.

156. *Id.*

157. 513 F. Supp. at 1354-55.

158. *Id.* at 1355-56. *Accord* *Groucho Marx Prods., Inc. v. Day and Night Co.*, 523 F.Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982). Critical to the court's determination that the estate's right of publicity protected against Russen's imitation of a Presley performance was the conclusion that Russen's activity was commercial in nature rather than being newsworthy, informative, or contributing to the public debate of political or social issues. Had Russen's production stemmed from the latter, it is likely that he would have been immune from liability because this activity would have been protected under the first amendment.

159. 513 F. Supp. at 1379.

160. *Id.* at 1378.

need for showing a bona fide injury is heightened.¹⁶¹ Thus, since the estate failed to establish irreparable injury here, it was necessary for the court to explore the estate's alternative causes of action.

The critical alternative cause of action which the estate asserted was the service mark infringement claim.¹⁶² As explained in Part II above, a plaintiff asserting the service mark claim must establish that he owned the marks, that the marks were valid and protectable, and that the defendant's use of a similar mark was likely to confuse members of the consuming public as to the source of the defendant's products.¹⁶³

A. Ownership of Service Marks

In *Estate of Presley*, after a detailed, methodical analysis of the estate's common law service mark infringement claim,¹⁶⁴ the court concluded that the estate possessed valid service marks in Elvis Presley's persona;¹⁶⁵ in the names of Elvis, Elvis Presley, and Elvis in Concert;¹⁶⁶

161. *Id.* at 1378-79.

162. *Id.* at 1361-72.

163. The estate was also successful in alleging violations of both the New Jersey common law of unfair competition, and section 43(a) of the Lanham Act. The court concluded that under New Jersey common law service mark infringement claims are but a part of the broader law of unfair competition; consequently, there are more restrictions on service mark claims than on unfair competition claims. Thus, since the estate had proven a likelihood of success on the merits regarding its service mark infringement claim, it had also proven a likelihood of success on the merits concerning its common law unfair competition claim. As part of its common law unfair competition claim, the estate also alleged that the "Big El Show" itself, and not merely the infringement on the service marks in question, constituted unfair competition because the audience viewing the performance is necessarily deceived into believing it is dealing with a service of the estate of Elvis Presley. The court was unconvinced that the doctrine of unfair competition was designed to prohibit the performance of an individual imitating a famous performer like Presley, particularly since the original performer was no longer living. The court held that the unfair competition doctrine, just as the service mark infringement doctrine, could be invoked only to prohibit the use of the estate's marks in the promotion and advertising of Russen's production.

Similarly, with respect to the section 43(a) claim, the court held that although section 43(a) may proscribe competitive torts not covered by trademark infringement law or common law unfair competition, as a general rule, the same facts which would support an action for service mark infringement or common law unfair competition would also support an action for unfair competitive practices under section 43(a). Therefore, since the estate had proven a likelihood of success on the merits with respect to the common law service mark infringement claim, it also established a violation of section 43(a). The court correctly observed that section 43(a) created a distinct federal statutory tort not limited solely to trademark or service mark infringement claims. Section 43(a) was designed to afford broad protection against various forms of unfair competition and false advertising. It remains to be seen whether section 43(a) will have utility as an alternative to the right of publicity in those cases where even a common law service mark cannot be established. See GILSON, *supra* note 2, §7.02; Note, *Section 43(a) of the Lanham Act: Its Development and Potential*, 3 LOY. U. CHI. L.J. 327 (1972). The court offered suggestions as to how Russen could conduct his activity without violating section 43(a). These suggestions stressed the importance of Russen making clear on the face of the advertising that his production was not affiliated with, sponsored by, or in any way connected with the same people who provided actual Elvis Presley entertainment services. This would facilitate achieving the laudable goals of section 43(a)—preventing and alleviating deceptive and misleading advertising and stressing the need for providing the public with truthful information about the services and their sources or sponsorship.

164. 513 F. Supp. at 1361-72.

165. *Id.* at 1363-64. The estate maintained that any likeness or image of Elvis Presley serves as a service mark; however, the court was unwilling to accept such a broad position. The court

and in the TCB logo.¹⁶⁷ The court was, however, cautious in concluding that the estate owned the service marks. This conclusion came only after a lengthy discussion regarding the contractual arrangement between the estate, the Boxcar Corp. (Presley's publicity corporation), and Boxcar's licensee, Factors.¹⁶⁸ The court recognized that the agreements, the estate-Boxcar arrangement and the Boxcar-Factors contract, were terminable.¹⁶⁹ Upon termination, the existing rights to the Presley name, likeness, image, and service marks reverted to the estate.¹⁷⁰

B. Validity and Protectability of Service Marks

The court concluded that with the exception of one of the asserted service marks, "The King",¹⁷¹ the estate established that the names Elvis, Elvis Presley, and Elvis in Concert;¹⁷² the TCB logo;¹⁷³ and the likeness and image of Presley embodied in the "Elvis Pose" were valid service marks.¹⁷⁴ Each had appeared in connection with the advertising of concerts or performances,¹⁷⁵ the conduct of day-to-day business affairs,¹⁷⁶ or the production of goods (i.e. records).¹⁷⁷

For a person's name to achieve valid service mark protection, it generally must acquire secondary meaning and be identified with the services offered.¹⁷⁸ The *Estate of Presley* court concluded that, indeed, the names Elvis, Elvis Presley, and Elvis in Concert,¹⁷⁹ as well as the "Elvis Pose", had acquired a secondary meaning.¹⁸⁰ Thus, these words were afforded traditional service mark protection. The court also concluded that the TCB logo warranted service mark protection since the mark

did, however, conclude that an illustration of Elvis Presley dressed in one of his typical jumpsuits and holding a microphone in a singing pose was likely to be construed as a service mark. The court referred to this service mark as the "Elvis Pose" and concluded that, indeed, it had been used in connection with the promotion and advertising of Elvis Presley entertainment services to identify those services. *Id.*

166. *Id.* at 1363.

167. *Id.*

168. *Id.* at 1345-58.

169. *Id.* at 1347.

170. *Id.* at 1348.

171. *Id.* at 1363. Although the court recognized that Elvis Presley's nickname was "The King", the estate failed to present sufficient evidence showing that "The King" identified the services provided by Presley. If the estate had demonstrated that the phrase "The King" was not only Presley's nickname, but was also used in connection with radio or television promotions for concerts, tours, records, etc., then the court would have found the requisite nexus between the name and the identification of services.

172. *Id.*

173. *Id.*

174. *Id.* at 1364.

175. *Id.* at 1363 (names).

176. *Id.* (the TCB logo appearing on Presley letterheads and business cards).

177. *Id.* at 1363-64 (both the names and the "Elvis Pose" used to advertise and sell record albums).

178. *See supra* notes 153-156 and accompanying text.

179. 513 F. Supp. at 1364.

180. *Id.* at 1365.

could be characterized as inherently distinctive.¹⁸¹

C. Likelihood of Confusion

After evaluating the necessary elements in a likelihood of confusion determination, the *Estate of Presley* court concluded that the estate had made a strong showing of likelihood of confusion.¹⁸² The court found that the estate's service marks were very strong, had acquired a great distinctiveness in the eyes of the consuming public, and strongly identified the entertainment services provided by Elvis Presley or his estate.¹⁸³ The court also found that both the estate's marks and Russen's marks were extremely similar.¹⁸⁴ Although the court determined that all of the defendant's marks were confusingly similar to those owned by the estate, it took particular notice of the similarity between actual Elvis Presley photographs and "Big El Show" promotional information.¹⁸⁵ The conclusion that the marks were extremely similar mitigated against the defendant's claim that there was no likelihood of confusion.

The evaluation of the "similarity of services" and the "similarity of channels of trade" factors was a bit more difficult for the court. Although both Russen and the estate were involved in the offering of entertainment services,¹⁸⁶ Russen claimed that since most people recognized that Elvis Presley died, this fact alone eliminated the conclusion that members of the consuming public were likely to be confused.¹⁸⁷ Russen asserted that this was particularly true with respect to a showing of similarity of services or similarity of channels of trade.¹⁸⁸ The Court recognized, however, that although Russen primarily offered live entertainment services in the form of a stage show¹⁸⁹ and the estate primarily offered entertainment services in the form of video or audio recordings,¹⁹⁰ the fact that the defendant could make a film of the "Big El Show" strongly suggested that both the services and channels of trade were extremely similar.¹⁹¹ The court also recognized that since members of the consuming public might be led to believe that the "Big El Show" was authorized or sponsored by the estate, a showing of similarity of services and trade was established.¹⁹²

181. *Id.* at 1364; *see also supra* note 147-152 and accompanying text.

182. 513 F. Supp. at 1372.

183. *Id.* at 1367.

184. *Id.*

185. *Id.*

186. *Id.* at 1368-69.

187. *Id.* at 1371.

188. *Id.* at 1369-70.

189. *Id.* at 1369.

190. *Id.* at 1368.

191. *Id.* at 1369 n.34.

192. *Id.* at 1371.

These four factors combined—the strength of the estate's marks, the similarity of the marks, the similarity of services, and the similarity of channels of trade—enabled the estate to establish with sufficient certainty a likelihood of confusion.¹⁹³

IV. CONCLUSION

By virtue of the amount of money involved in the entertainment and professional athletic industries, along with a public eager to praise its celebrities, an environment conducive to commercial parasites misappropriating a celebrity's property rights is created. While a right of publicity claim may provide solace for some injured plaintiffs, often the right is inadequate to protect the full commercial interests of either the celebrity or the estate. In those jurisdictions placing some limitation on the right of publicity or in situations when the plaintiff fails to satisfy the requirements for a preliminary injunction to issue, *Estate of Presley v. Russen* represents a viable alternative which will provide relief in the wake of a traditional right of publicity claim. *Estate of Presley* advances the fundamental values of protecting the plaintiff's goodwill, providing for an informed consuming public, and compelling the defendant to create a quality production without resorting to deceiving the public or piggybacking on the plaintiff's goodwill.

The service mark infringement claim should be asserted with caution, both because not all courts may be as receptive to this alternative as the *Estate of Presley* court and because the plaintiff still must show a valid service mark identifying the services offered as well as a likelihood of success on the merits. There remains little doubt, however, that the viability of *Estate of Presley* will be tested shortly, concomitant with the expansion of the right of publicity.

193. *Id.* at 1372.

