

**PROTECTING CELEBRITY NAMES AND IMAGES:**  
**THE LANHAM ACT VERSUS THE FIRST AMENDMENT**

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A celebrity's name and image is a valuable commodity. Some celebrities go so far as to seek trademark protection for their name and image, for use on t-shirts, mugs, and other merchandise. As one court has held:

A celebrity has a . . . commercial investment in the 'drawing power' of his or her name and face in endorsing products and in marketing a career. The celebrity's investment depends on the good will of the public, and infringement of the celebrity's rights also implicates the public's interests in being free from deception when it relies on a public figure's endorsement in an advertisement.

Allen v. National Video, Inc., 610 F. Supp. 612, 25-26 (S.D.N.Y. 1985).

But how far can a celebrity go in protecting his or her name and image without running into the First Amendment? While the different circuits articulate different tests, they ultimately say the same thing: the more likely that consumers will (incorrectly) believe that the celebrity has endorsed the use – in other words, the more likely that consumers will be confused – the less likely the use will be protected by the First Amendment.

**The Ninth Circuit Speaks**

The Ninth Circuit examined this issue under the rubric of "fair use" in The New Kids on the Block v. News America Publishing, 971 F.2d 302 (1992), in which two newspapers

published “reader polls” about the then-popular band The New Kids on the Block. The polls required readers to call in on a 900 number (thereby making money for the newspapers) and used both the name and image of the band in promoting the poll.

The Ninth Circuit focused on whether the use at issue merely used the name to describe the band or whether it implied sponsorship or endorsement:

For example, one might refer to ‘the two-time world champions’ or ‘the professional basketball team from Chicago,’ but it’s far simpler and (more likely to be understood) to refer to the Chicago Bulls. In such cases, use of the trademark does not imply sponsorship or endorsement of the product because the mark is used only to describe the thing, rather than to identify the source.”

Id. at 306.

Ultimately, the Ninth Circuit determined that the user of the celebrity mark was entitled to a “nominative fair use” defense if three requirements could be met:

First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

Id. at 308 (emphasis added).

The last element is, again, the critical one: is the public confused into believing that the trademark holder has sponsored the use? If so, “fair use” considerations will take a

back seat. See also Downing v. Abercrombie & Fitch, 265 F.3d 994, 1009 (9<sup>th</sup> Cir. 2001)(reversing summary judgment on Lanham Act claim involving image of famous surfers because “[t]here is a genuine issue of material fact as to whether . . . [defendant] did nothing that would in conjunction with [plaintiff’s] names and pictures suggest sponsorship or endorsement by [plaintiffs]”).

Courts using a more traditional First Amendment analysis also focus on whether or not the use of the name or image is misleading. For example, Parks v. LaFace Records, 76 F. Supp. 2d 775 (E.D. Mich. 1999), involved the use of Rosa Park’s name as the title of a rap song by the band Outkast. While the court gave lip service to the overriding principles of the First Amendment (i.e., that the Lanham Act does not ordinarily apply at all to “expressive works in which First Amendment concerns are paramount”), it ultimately rested on the conclusion that the song title was sufficiently connected with the content of the song that “it is abundantly clear that the title does not ‘explicitly’ mislead as to source or content.” Id. at 782. Where the title did “blatantly” or “explicitly” mislead, “the consumer’s interest in avoiding deception might warrant application of the Lanham Act.” Id.

No matter whether you call it “fair use” or “First Amendment,” the issue remains the same: does the use of the celebrity name and image deceive the consumer into believing that the celebrity has sponsored or endorsed the use? If so, the Lanham Act will trump the First Amendment and restrict the deceptive use. If not, free speech principles will prevail.