

Professional Perspective

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Trademarks and the Right of Publicity

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Often taught in law school torts or intellectual property classes, *White v. Samsung Electronics America, Inc.*, [971 F.2d 1395](#) (9th Cir. 1992) may be the most well-known right of publicity case in the United States.

In 1992, Vanna White, hostess on “Wheel of Fortune,” sued Samsung Electronics America, Inc. for violations of her right of publicity. Samsung ran a series of advertisements conveying the message that Samsung would be around in the future. One featured a robot with a wig, gown, and jewelry made to resemble White and posed next to a game board resembling the “Wheel of Fortune” show set. Though the general public referred to the advertisement as the “Vanna White” ad, White neither consented to nor was paid for the content.

The Ninth Circuit held, in part, that “[t]elevision and other media create marketable celebrity identity value . . . [and] [t]he law protects the celebrity's sole right to exploit this value[.]” The decision was important for many reasons, but primarily because the Ninth Circuit reframed how courts analyzed the right of publicity. The advertisement at issue did not make use of White's name or image, but the Ninth Circuit held that the right of publicity “does not require that appropriations of identity be accomplished through particular means to be actionable.” Per the court, the relevant inquiry is whether there was appropriation, not how it was done—to find otherwise would have eviscerated the common law right of publicity.

Right of publicity law continues to develop. Recently, the Trademark Trial and Appeal Board heard cases implicating that right within the trademark context. In these cases, the Board has signaled a shift in how the United States Patent and Trademark Office (USPTO) might view the right of publicity within the framework of US trademark law.

What Is the Right of Publicity?

The [right of publicity](#) “protects against the misappropriation of a person's name, likeness, or other indicia of personal identity—such as nickname, pseudonym, voice, signature, likeness, or photograph—for commercial benefit.” This right grew out of the general principles of invasion of privacy and also falls under the umbrella of privacy rights, but the right of publicity is not the right to be left alone. Although celebrities and other notable figures can attempt to prevent their names or images from being used to sell commercial products without their consent, they cannot invoke the right of publicity to prevent the use of

their names, likenesses, or personas for news or public interest purposes. No federal statute recognizes the right of publicity—thus, it is largely protected by state common or statutory law and [varies by jurisdiction](#).

Right of Publicity & Trademark Law

A [trademark](#) is a word, phrase, symbol, design, or even a sound, that identifies an owner's goods or services, providing consumers the means to identify the source of goods or services and distinguish competitors. To that end, trademark law is necessarily consumer-centric—it is based on the consumer's point of view and intended to protect consumers from confusion in the marketplace. Accordingly, the USPTO, which issues and maintains federal trademark registrations, may refuse to register a mark for a variety of reasons based on how the consumer would perceive the mark. For example, an application may be refused if the mark is likely to be confused with a previously registered or applied-for trademark, if it is generic or descriptive, or if it fails to function as a trademark because it is a commonly used phrase that expresses an ordinary concept or sentiment.

The right of publicity, at least in part, also protects against unauthorized commercial uses of a trademark by others that are likely to confuse consumers. This explains why many celebrities attempt to use trademark registration as a means of controlling how their names and images are used for commercial purposes. Under the [Lanham Act](#), an individual's name or likeness can develop into a protectible trademark if that person can establish an aspect of their individual identity as a source of particular goods and/or services. [15 U.S. Code § 1125](#).

Celebrities from Kylie Jenner, to Jay-Z, to Donald Trump, to Taylor Swift have all applied to register trademarks associated with their public personas and have used these registrations to control how the marks are used for commercial purposes. For example, Paris Hilton registered the catchphrase “THAT'S HOT” and successfully sued Hallmark for using the expression and a picture of her on a greeting card. Curtis Jackson registered his stage name “50 CENT” and successfully sued Taco Bell for using the name in an ad campaign without his consent.

Not everything a celebrity says and does can be protected with trademark law. Historically, one of the biggest obstacles facing a celebrity seeking trademark registration is that the proposed mark is a commonly used phrase, which is a basis for the increasingly common “failure-to-function” refusal. The Board has recently started to give more weight to evidence of consumer perception, however, resulting in more registrations for phrases closely associated with celebrity personas.

Emerging Trends/Takeaways

Earlier this year, the Board reversed a refusal to register “100% THAT BITCH” for the musician Lizzo,” a phrase that gained popularity as a lyric in one of Lizzo's songs: “I just took a DNA test, turns out I'm 100% that bitch.” See *In re: Lizzo LLC*, [2023 U.S.P.Q.2d 139](#), (T.T.A.B. 2023). The examining attorney had issued a refusal on the basis that the phrase was a “commonplace expression widely used by a variety of sources to convey an ordinary, familiar, well-recognized sentiment,” and therefore failed to function as a trademark. The Board disagreed and, in determining how the designation would be perceived by the relevant public, found that the evidence did not “demonstrate that Applicant's proposed mark is used in general parlance or that it conveys a common social, political, patriotic, religious, or other informational message such as DRIVE SAFELY, THINK GREEN or WATCH THAT CHILD.” Instead, the evidence showed the phrase was used “predominantly in an ornamental manner” that typically references Lizzo and her music.

More recently in *Major League Baseball Players Association and Aaron Judge v. Michael P. Chisena*, [2023 U.S.P.Q.2D 444](#) (T.T.A.B. 2023), the Board found in favor of Yankees captain Aaron Judge, who sought to block Chisena's attempt to register the slogans “ALL RISE” and “HERE COMES THE JUDGE” with the USPTO. In support of their position that there would likely be consumer confusion if registration was granted, Judge and the Player's Association submitted evidence of use of the phrases and their association with Judge, including third-party license agreements permitting use of the phrases in an ornamental manner. Chisena, the respondent, argued that those uses of the phrases did not function as source-identifying trademarks. The Board disagreed, likening the case to *In re Lizzo* and finding that unlike commonplace expressions like DRIVE SAFELY and GOD BLESS THE USA, the record showed that “the consuming public recognizes the subject of the slogans and symbols carrying judicial connotations as pointing to only one baseball player on one major league team.”

Actual use of these phrases guided the analyses in each of these decisions, which is a departure from how the [Board](#) typically analyzes applications. Evidence of marketplace realities, including how a mark is actually used, is not usually considered by the USPTO and the Board, despite the fact that trademark rights derive from use. Rather, the USPTO and the Board usually limit their analyses to the “four corners” of an application and/or registration. The *Lizzo* and *Judge* decisions indicate not only that actual use of a mark in the marketplace is becoming more relevant in analyzing applications for widely used phrases, but that widely used messages that are linked to celebrities might be viewed differently than non-celebrity messages.

According to the Trademark Manual of Examining Procedure, when it comes to widely used messages, the “more commonly a term or phrase is used in everyday speech or in an associational or affinitive manner by various sources, the less likely consumers will perceive the matter as a trademark or service mark for any

goods and services.” T.M.E.P. § 1202.04(b). Furthermore, “[m]essages that merely convey ordinary, familiar concepts or sentiments that are widely used by a variety of sources in the marketplace are considered commonplace and will be understood as conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function.”

Although phrases like “100% THAT BITCH,” “ALL RISE,” and “HERE COMES THE JUDGE” were demonstrably widely used by the public, that was overcome because the phrases predominantly referred to a single person. That finding reflects a shift in the board's perception of widely used messages. These cases also indicate an implicit recognition of the right of publicity by acknowledging that an otherwise common phrase can be elevated to a protectable mark when the phrase has been perceived by the public to reflect a notable person's persona.

Much like a robot that, to the public, is unmistakably meant to reference Vanna White, a phrase that is inextricably or overwhelmingly tethered to a celebrity's commercial persona can be protected as a source-identifying trademark.