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United States: Ninth Circuit Court Of Appeals: Use Of Deceased Celebrity's Image On T-Shirts Constitutes False Endorsement Under Lanham Act

Last Updated: June 10 2015

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Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc., 778 F.3d 1059 (9th Cir. 2015)

In a recent decision, the United States Court of Appeals for the Ninth Circuit affirmed a jury verdict in favor of Fifty-Six Hope Road Music, Ltd. ("Fifty-Six Hope Road"), an entity formed by Bob Marley's children and heirs to exploit Bob Marley's persona, that A.V.E.L.A., Inc. ("A.V.E.L.A.") and other defendants' (together with A.V.E.L.A., "Defendants") unauthorized use of Marley's image on t-shirts and other merchandise constituted false endorsement under Section 43(a) of the U.S. Trademark (Lanham) Act, 15 U.S.C. § 1125(a). See *Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059 (9th Cir. 2015).

This appeal arose from a dispute between, on the one hand, Fifty-Six Hope Road and Zion Rootswear ("Zion," and together with Fifty-Six Hope Road, "Plaintiffs"), holder of an exclusive license from Fifty-Six Hope Road to design, manufacture, and sell t-shirts and other merchandise bearing Marley's image, and on the other, Defendants, entities involved in the sale of unlicensed, competing merchandise bearing images of Marley at Target, Walmart, and other large retail outlets. See *id.* at 1066. Plaintiffs initially sued Defendants in the United States District Court for the District of Nevada on five claims stemming from Defendants' unauthorized use of Marley's likeness: (1) trademark infringement under 15 U.S.C. § 1114, (2) false endorsement under 15 U.S.C. § 1125(a), (3) common law trademark infringement, (4) unauthorized commercial use of right to publicity under Nev. Rev. Stat. § 597.770 *et seq.*, and (5) intentional interference with prospective economic advantage. *Id.* The district court granted summary judgment to Defendants on the infringement and right of publicity claims, and allowed the remaining claims for false endorsement and interference to proceed to a jury. *Id.* at 1067.

Following a trial, the jury found in favor of Plaintiffs and against all Defendants on the false endorsement claim, and in favor of Plaintiffs and against only A.V.E.L.A. on the intentional interference claim. The jury awarded \$300,000 in compensatory damages for the intentional interference. Following post-trial discovery, the district court entered judgment against Defendants for an additional \$800,000 representing their net profits from the false endorsement. The district court further granted Plaintiffs' motion for attorneys' fees in an amount of approximately \$1.5 million. See *id.* at 1067.

Defendants appealed the judgment and the award of profits and attorneys' fees. Plaintiffs cross-appealed on several points, including the grant of summary judgment on the Nevada right of publicity claim and the amount of profits awarded. *Id.* The Ninth Circuit upheld the district court's determinations and the jury's verdict on all points.

The decision is significant for its treatment of the false endorsement claim, so we focus on that issue here.

In upholding the jury's verdict on Plaintiffs' false endorsement claim, the Court first found that that under the law of the Ninth Circuit, there is a cognizable claim under Section 1125(a) for misuse of a celebrity's persona, even when the celebrity is

deceased. *Id.* The panel further found that Plaintiffs introduced sufficient evidence at trial to support the jury's finding that consumers would likely be confused about whether Plaintiffs had sponsored or approved Defendants' Marley products. *Id.* at 1068-72.

In celebrity cases, as the court noted, eight factors are applied to determine likelihood of confusion: "(1) the level of recognition that the celebrity has among the segment of the society for whom the defendant's product is intended; (2) the relatedness of the fame or success of the celebrity to the defendant's product; (3) the similarity of the likeness used by the defendant to the actual celebrity; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent on selecting the celebrity; and (8) likelihood of expansion of the product lines." *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007–08 (9th Cir. 2001) (quoted by *Fifty-Six Hope Road*, 778 F.3d at 1069). The court further noted that "[w]here the plaintiff is not the celebrity himself," as was the case here, "an additional factor becomes relevant: the strength of association between the mark and the plaintiff." *Fifty-Six Hope Road*, 778 F.3d at 1069.

Reviewing factors 1-7, the panel found that the evidence did not compel a finding contrary to the jury's verdict. *See id.* at 1069-71. Specifically, the panel noted that sufficient evidence was presented to establish that there was a high level of recognition of Marley's image within Defendants' target market, that Marley's image had long been associated with apparel, indicating that the fame of the celebrity was related to the defendant's product, and that A.V.E.L.A. had used actual photos of Marley, not simply likenesses, on the merchandise in question. *Id.* at 1069. The panel further credited evidence indicating that the marketing channels were identical, since A.V.E.L.A.'s licensees had sold A.V.E.L.A. Marley products in some of the same stores where Plaintiffs and their licensees sold authorized Marley products, that purchaser care was likely low given the inexpensive nature of the items, and that A.V.E.L.A.'s merchandise was similar to that of Hope Road, implying an intent to associate their products with Plaintiffs. *See id.* at 1070-71.

With respect to the fifth factor, evidence of actual confusion, the panel reviewed Plaintiffs' consumer confusion survey, which consisted of 509 face-to-face interviews conducted by professional interviewers with individuals in shopping malls. *Id.* at 1069-70. As part of the survey, interviewers had shown the test group an A.V.E.L.A. t-shirt bearing Bob Marley's image and the control group a t-shirt bearing the image of a different, unrenowned African–American man with dreadlocks. Several questions were put to both groups, including: "Who do you think gave their permission or approval for this particular T-shirt to be made or put out?" 37% of the test group answered: "Bob Marley/the person on the shirt or his heirs, estate, or agents." With the control group, 20% answered the same. *See id.* at 1070.

Defendants argued on appeal that the survey questions were indefinite, and that a valid false endorsement claim "should have an identifiable person as the putative endorser." *Id.* at 1070. But, as the panel stated, there was "no precedent showing that it must be a single entity that is falsely attributed as the party that approved the product or that the survey taker must be able to identify the party." *Id.* Therefore, the panel disregarded Defendants' arguments on the survey, holding that "identifying Marley or whoever holds the rights to his persona in the alternative does not render the survey data useless or irrelevant. Rather, the imprecision of the data merely decreases its probative value." *Id.*

The panel further found sufficient evidence to support the additional factor of association between the mark and Plaintiffs, which, as the court noted, was particularly important in this case, given that a review of the standard *Downing* factors primarily supported a finding that Marley himself and not the Fifty-Six Hope Road entity had sponsored or approved Defendants' products. *Id.* at 1071. Here, however, "Marley sold merchandise bearing his image during his lifetime, and his successors-in-interest have continued to do so, implying that his image served (and continues to serve) a source-identifying function." *Id.* Thus, the panel held, "the jury was free to infer that the source-identifying function of Marley's persona had not weakened to the extent that there was no likelihood of confusion." *Id.*

The court likewise was not persuaded by Defendants' argument that the judgment overextended the Lanham Act by creating a federal right of publicity. Defendants claimed that "consumers would always 'associate a deceased celebrity's image with that of his or her estate.'" *Id.* at 1073. As the court noted, though, federal claims "require an additional element" above and beyond a right of publicity claim: namely, "that the use be likely to confuse as to the sponsorship or approval of a defendant's goods." *Id.* Moreover, the court observed that Defendants had raised a number of "potentially salient" arguments on appeal. *Id.* at 1067-68 & n.1. However, given that they had failed to first assert those arguments—which included an aesthetic functionality defense, a Copyright Act defense under *Dastar Corp. v. Twentieth Century Fox Film, Corp.*, 539 U.S. 23 (2003), and a First Amendment defense under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989)—before the district court, Defendants had waived them in their entirety. *Id.* Thus, the court observed, the outcome of the case was "in part a function of defenses expressly waived by Defendants." *Id.* at 1073. Since the jury found likelihood of confusion, and Defendants waived so many potentially critical defenses, the panel felt bound to uphold the jury verdict. *See id.*

Judge Morgan Christen concurred in part and dissented in part, noting in particular that "the narrow holding . . . is dictated by

the standard of review on appeal, and by the defenses actually pursued by defendants." *Id.* at 1083. Focusing on the confusion survey introduced by Plaintiffs, she opined that the answers to the survey question "Who do you think gave their permission or approval for this particular T-shirt to be made or put out?" only indicated that many members of the public held a lay legal opinion that Marley or someone connected with him must have sponsored the shirt. *Id.* at 1084. As she pointed out, "this lay legal opinion is likely to be held by the majority of survey respondents every time merchandise bears a readily recognizable celebrity image." *Id.* Ultimately, in her analysis, "[w]ithout a showing that consumers cared whether permission had been given, the second survey question only shows that most consumers share [that opinion]; it does nothing to suggest that the use of Marley's image on the T-shirt runs afoul of the purpose of the Lanham Act." *Id.* at 1085.

Given these problems of causation, "where a celebrity image is itself the only indication of sponsorship," Judge Christen would have held that "a finding of actual confusion under § 43(a) must be supported by some evidence that the confusion could have had an impact on the consumers' purchasing decisions. *Id.* Therefore, she would not have given weight to the survey, since it "did not show that consumers might be misled into buying the T-shirt based on whether permission had been given." *Id.* Since evidence of actual consumer confusion was just one of the Downing factors, though, she still supported upholding the jury verdict on likelihood of confusion. *Id.*

As the Court observed, the outcome of this case may well have been different had Defendants not waived several key defenses. Nevertheless, the case serves as a reminder that even if a right of publicity claim is not available under state law, the successors of a deceased celebrity may still have a federal remedy under the Lanham Act. This lingering right can create difficult clearance issues for companies that wish to use a deceased celebrity's persona for commercial purposes, particularly where the celebrity's successors are not known. Given the potential recovery of damages, profits, and attorneys' fees, as well as injunctive relief, for violations of the Lanham Act, companies considering whether to use a deceased celebrity's persona should perform due diligence of any potential successors-in-interest and seek the advice of experienced counsel.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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