

**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

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	:	
MARC DORSEY,	:	
	:	
Plaintiff,	:	2:06-cv-02940-JAG-MCA
	:	ECF Case
- against -	:	
	:	
BLACK PEARL BOOKS, INC.,	:	
FELICIA HURST and DAMION,	:	
MILLER,	:	
	:	
Defendants.	:	
	:	
-----	X	

**MEMORANDUM OF LAW
IN SUPPORT OF PLAINTIFF'S MOTION
FOR A PRELIMINARY NATIONWIDE INJUNCTION
AND A RECALL ORDER**

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PRELIMINARY STATEMENT

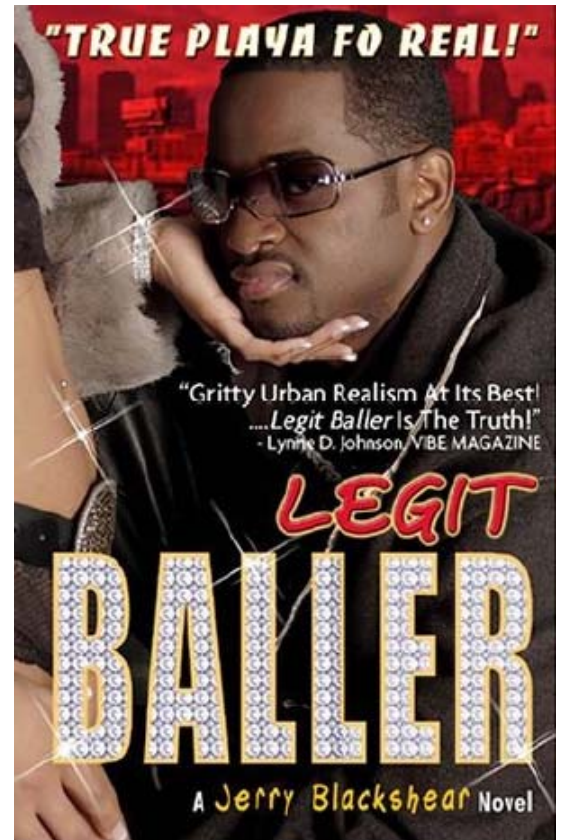
This action arises out of the misappropriation and unauthorized use of plaintiff's image for commercial purposes. Plaintiff Marc Dorsey submits this memorandum of law in support of his application for a preliminary nationwide injunction pursuant to Rule 65 of the Federal Rules of Civil Procedure, the Lanham Act and the common law of the State of New Jersey, enjoining defendants Black Pearl Books, Inc. and its owner and operator Felicia Hurst (collectively "Black Pearl") from continuing to publish and distribute or otherwise exploit the book Legit Baller (the "Book") in its current form, which prominently and recognizably bears Mr. Dorsey's likeness on the front and back covers, or otherwise exploit any other books or advertising or promotional materials that contain Mr. Dorsey's likeness. Plaintiff also seeks an order requiring Black Pearl to recall the Book, and any of Black Pearl's other books and materials that contain Mr. Dorsey's likeness, from bookstores and other commercial and retail outlets throughout the United States.

As set forth below and in the accompanying affidavits, Mr. Dorsey is a well known and respected celebrity. Black Pearl misappropriated two images of him, without his consent, and placed them on the front and back covers of Legit Baller, which is being sold and advertised in major bookstores and retail chains throughout the United States. Even though Mr. Dorsey placed defendants on notice of their wrongful conduct, Black Pearl has refused to stop using his images and continues to this day to sell and advertise the Book. This has caused actual confusion among consumers and irreparable harm to Mr. Dorsey's reputation, career and ability to control the commercial exploitation of his likeness.

Defendants' conduct violates the common law of New Jersey insofar as it pertains to the unauthorized use of an individual's likeness. Defendants' conduct also violates Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), which prohibits acts that suggest to the public a false endorsement of one's goods or services. Only a preliminary injunction and a recall of the offending works will ensure that defendants cease their ongoing misconduct and stop the irreparable harm that Mr. Dorsey is suffering.

STATEMENT OF FACTS¹

This case involves the blatant misappropriation and unauthorized use of Mr. Dorsey's image to sell the book Legit Baller by placing his picture on the front cover (shown at right) and back cover of the book. Legit Baller is a work of fiction about an African-American crack-cocaine dealer who is convicted on drug charges and sent to prison. The events depicted in the Book take place during the main character's incarceration in federal prison and after his release, and glamorize and glorify the stereotype of African American men as criminals. The Book is laden with violence, criminal activity, drug use and vivid descriptions of sexual promiscuity. Worse still, the term "baller" (which appears on the front cover of the Book, immediately below a picture of Mr. Dorsey's face) is a slang term that is used and



¹ All facts set forth herein are authenticated in the Affidavit of plaintiff, sworn to August 1, 2006 ("Dorsey Aff."), filed in support of this motion.

understood in the African American community to refer to a drug dealer. Dorsey Aff. at ¶ 3.

Mr. Dorsey never gave Black Pearl his consent or authorization to use his likeness in connection with the Book. Dorsey Aff. at ¶ 4. Moreover, the Book is not about Mr. Dorsey. His photographs have absolutely no connection or artistic relevance whatsoever to the content of the Book. The only reason that Mr. Dorsey's picture appears on the front and back covers of the Book is to advertise and sell defendants' product. In other words, defendants' prominent use of Mr. Dorsey's photographs is purely commercial and is in no way descriptive. Dorsey Aff. at ¶ 5.

A. Plaintiff and His Accomplishments

Mr. Dorsey is an internationally known and respected two-time Grammy nominated R&B singer, songwriter and producer. In 2003, he released his own critically acclaimed album entitled "Crave," which has sold over 400,000 copies. The album bears Mr. Dorsey's photograph on the cover. The title song to "Crave" is also featured on the soundtrack for the film "The Wood," which sold more than 2 million copies. Mr. Dorsey's name appears on the front cover of the soundtrack album for "The Wood." Mr. Dorsey's work also has appeared on numerous other feature film soundtracks, including those for the Spike Lee films "Crooklyn," "Clockers" and "Get on the Bus." Dorsey Aff. at ¶ 13.

Mr. Dorsey also has collaborated with some of the most popular performers in music today, including Jay-Z, LL Cool J, Chaka Khan, Branford Marsalis, Charlie Wilson, Omar Hakim, Faith Evans, Carl Thomas, Will Downing, Kelis and N.E.R.D. His collaboration with LL Cool J, for example, resulted in the song "Luv U Better," which

won the 2004 BMI award for the number one song in the United States. Taking into account sales figures for plaintiff's own records, as well as the albums, singles and collaborations that he has been involved with, the figure would exceed 10 million copies. He also has been retained to provide his talents to a number of Fortune 500 companies, including Sears, Toys R Us and Coca Cola. Mr. Dorsey's name, reputation and accomplishments have been highly publicized. Dorsey Aff. at ¶ 14. A recent search of "Marc Dorsey" on the Internet site Google, for example, returned more than 30,000 'hits.' Dorsey Aff. at ¶ 15.

To date, plaintiff has derived approximately \$200,000-300,000 in income from product endorsements that have used his voice. He also has earned well over \$1 million by allowing his name and talents to be associated with film soundtracks and work by other recording artists. Plaintiff has never authorized the use of his image to endorse or sell a product. Dorsey Aff. at ¶ 17.

Mr. Dorsey is also actively involved in philanthropical work on behalf of the African-American community. In 2005, for example, he founded the Dorsey Enrichment Program to help keep kids in urban communities off of the streets and away from drugs. The program aims to provide skills training for out of school youth, giving them an alternative to the far more dangerous and illegal choices that are all too often readily available to them on inner city streets. Mr. Dorsey also devotes a substantial amount of his time and energy to other community outreach programs, including those sponsored by the City of Hackensack and by the American Diabetes Association ("ADA"). Recently, he wrote, produced and sang on an educational video for the ADA that will be distributed throughout the entire medical community in the United States. For his work on behalf of

ADA, he is scheduled to be featured on ADA's website alongside actor Ossie Davis, singer/songwriter Gladys Knight, Pastor Daryl Coley and the Philadelphia Eagles' Quarterback Donovan McNabb in the Association's "Celebrity Corner." Dorsey Aff. at ¶ 18.

B. Defendants and their Activities

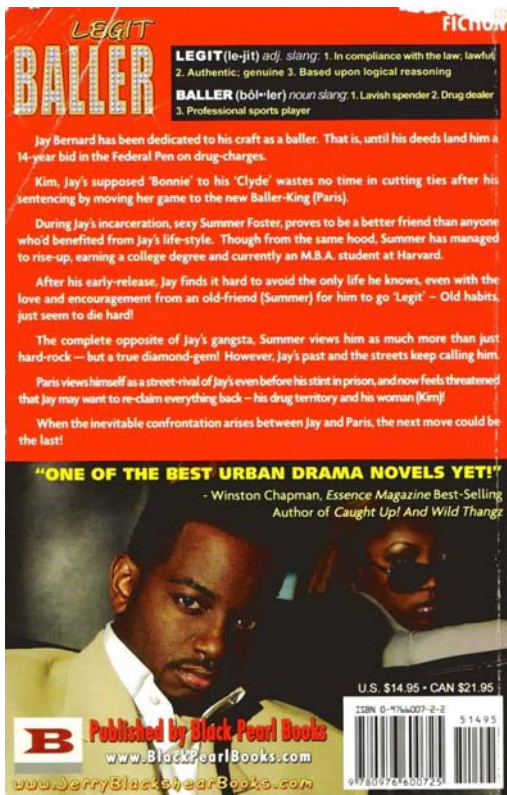
Upon information and belief, defendant Hurst owns and operates Black Pearl Books, Inc., a growing and popular publishing company. Together, these defendants have engaged in an aggressive (and apparently very successful) campaign to tap into and exploit the African American book market by publishing, promoting, marketing and advertising what they describe as "gritty and sexy urban stories." Dorsey Aff. at ¶ 21. Like Legit Baller, Black Pearl's other publications glamorize and glorify African American criminals, gang violence, drug use, the degradation of women, and hard-core sexual promiscuity, with such titles as Hustling Backwards ('*three partners in crime rise up the ranks from Project-Kids to Street-Don*'); Sex A Baller ('*mysterious Luva has sexed them all . . . and more importantly, she's made them all pay*'); Crunk ('*imagine a thug world divided by the Mason-Dixon line . . .*'); and Street Games ('*Lamont Limbo Adams, a hood-rich hustler is given the most difficult choice of his life: The Streets or his Family*'). *Id.*

Black Pearl's publications have been derided by critics, as evidenced by a recent, widely-published editorial that appeared in the *New York Times*. In this editorial, Nick Chiles, an award winning African-American journalist who has written for *Essence*, the *Dallas Morning News* and the *Newark Star Ledger*, singled out Legit Baller as a prime

example of the glorification of the stereotyped African American criminal, calling it “crass,” “smut” and “tasteless pornography.” Dorsey Aff. at ¶ 22.

C. The Photographs at Issue Here

In or about December 2004, defendant Damion Miller, a Maryland-based photographer, was hired to take photographs of plaintiff during a private photo session. The photographs were to be for Mr. Dorsey’s possible promotional and personal use. Mr. Miller did several ‘set-ups’ with Mr. Dorsey, photographing him in different outfits, in different locations and with different models. Although there was no written agreement between them, Mr. Miller understood and orally agreed that Mr. Dorsey owned and controlled the rights to the images from this photo shoot and that Mr. Miller would neither make nor authorize any use of the images for his own benefit or for anyone else’s benefit. Dorsey Aff. at ¶ 23.



Mr. Miller created and turned over to Mr. Dorsey several hundred photographs from the December photo session, including the two images that now appear on the front and back covers of the Book. A reproduction of the back cover is shown at left. Dorsey Aff. at ¶ 24.

D. Defendants' Unauthorized Use of Plaintiff's Likeness

In or about mid-May 2006, Mr. Dorsey's colleagues and fans began telling him that they had seen his photograph on the cover of a book called Legit Baller and asking why he was associating himself with this kind of work. Subsequently, Mr. Dorsey located the Book and discovered that Black Pearl had apparently obtained Miller's photographs without Dorsey's knowledge or permission and placed them prominently and recognizably on the front and back covers of the Book. Dorsey Aff. at ¶ 25.

Upon additional investigation, Mr. Dorsey discovered that Black Pearl had also used the photograph of him as it appears on the front cover of the Book to advertise and promote the Book, including by displaying this image in other of its publications and on its website at www.blackpearlbooks.com. Dorsey Aff. at ¶ 26.

Worse still, these images of Mr. Dorsey have reached millions of people as a result of the Book's display and sale at establishments such as Wal-Mart, Borders, Walden Books, B. Dalton, Barnes & Noble, Amazon.com and local bookstores in the State of New Jersey and throughout the United States, as well as worldwide via the Internet. Dorsey Aff. at ¶ 28.

Shortly after learning of this misappropriation, one of Mr. Dorsey's business associates contacted Mr. Miller to find out how Black Pearl had acquired the photographs. During this conversation, Mr. Miller admitted that he had licensed two images of Mr. Dorsey to Black Pearl. Dorsey Aff. at ¶ 29.

Following the conversation, Mr. Dorsey retained legal counsel and, through counsel, wrote to Black Pearl demanding that it immediately cease and desist from all use of these images. In this letter, counsel explained that Mr. Dorsey is a celebrity and that he never consented to the use of his likeness in connection with the Book. Black Pearl responded with an arrogant refusal to cease its wrongful conduct. Dorsey Aff. at ¶ 31. To this day, Black Pearl continues to use Mr. Dorsey's image to sell, advertise and promote the Book.

As plaintiff explains in his affidavit, he continues to receive comments from his fans and business associates questioning his involvement in the Book. Indeed, just last week, at the American Black Film Festival in Florida, at least *a dozen people* approached plaintiff to tell him that they had seen him on the cover of the Book. The American Black Film Festival is a five-day international film convention that provides, among other things, a forum for those interested in the film and entertainment industries to network, view upcoming films and promote themselves, their products and services. In nearly every instance, the first question each of the people who approached plaintiff asked was why plaintiff had agreed to associate himself with the Book. As a result, instead of promoting himself, developing his business, and networking his ability to write songs, sing and score films, plaintiff had to devote a significant portion of his time explaining to people that he had nothing to do with the Book, that he was unaware of it prior to seeing it on store shelves, that he did not authorize defendants to use his likeness, and that he was not affiliated with the Book or its publisher in any way. Dorsey Aff. at ¶¶ 9, 34-36.

Worse still, defendant's conduct has seriously jeopardized, if not eliminated, a potential endorsement deal that plaintiff was negotiating at the time he learned of the

publication of the Book. This deal was expected to generate significant revenues for plaintiff. Negotiations over the deal have now stalled. Dorsey Aff. at ¶ 38.

ARGUMENT

I. PLAINTIFF MEETS THE REQUIREMENTS FOR PRELIMINARY INJUNCTIVE RELIEF

This Court and the courts of the State of New Jersey have specifically held that injunctive relief is available for causes of action based on misappropriation and the right of publicity.² See Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981); Edison v. Edison Polyform & Mfg. Co., 73 N.J. Eq. 136, 67 A. 392 (Ch. 1907); Palmer v. Schonhorn Enterprises, Inc., 96 N.J. Super. 72, 232 A.2d 458 (Ch. Div. 1967). See also Canessa v. J. I. Kislak, Inc., 97 N.J. Super. 327, 235 A.2d 62 (Law Div. 1967) (New Jersey always enjoins the use of plaintiff's likeness and name on the specific basis that it is a protected property right; it is as much a property right after its wrongful use by defendant as it might be before such use). Injunctive relief is also available for a violation of Section 43(a) of the Lanham Act. See GlaxoSmithKline Consumer Healthcare, L.P. v. Merix Pharm. Corp., 2006 U.S. App. LEXIS 16377 (3d Cir. June 29, 2006) (injunction affirmed in false advertising case); Allen v. Men's World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988) (injunction granted in celebrity look-alike case).

In order to secure a preliminary injunction, a plaintiff must demonstrate that: (1) he is likely to succeed on the merits of his claims; (2) he will suffer irreparable harm if a preliminary injunction is not granted; (3) any harm that defendants may suffer is outweighed by the harm to plaintiff if no preliminary injunction is issued; and (4) the

² Plaintiff is not seeking preliminary injunctive relief, at this juncture, based on his claims for false light invasion of privacy, defamation or unjust enrichment.

public interest is advanced by the grant of the preliminary injunction. Clean Ocean Action v. York, 57 F.3d 328, 331 (3d Cir. 1995); Opticians Ass'n of America v. Independent Opticians of America, 920 F.2d 187, 191-92 (3d Cir. 1990); Marsellis-Warner Corp. v. Rabens, 51 F. Supp.2d 508, 520 (D.N.J. 1999). Mr. Dorsey easily meets all of these factors.

A. Plaintiff is Likely to Succeed on His Claims Arising Out Of Defendants' Misappropriation and Use of His Likeness

1. Plaintiff's Misappropriation/Right of Publicity Claim

New Jersey has long recognized the common law tort of misappropriation/right of publicity. Edison v. Edison Polyform & Mfg. Co., 73 N.J. Eq. 136, 67 A. 392 (Ch. 1907). It has adopted the elements of this tort as identified in the Restatement (Second) of Torts § 652C – namely, one who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other. Tellado v. Time-Life Books, Inc., 643 F. Supp. 904, 908 (D.N.J. 1986) (under New Jersey common law, the defendant would be liable for the tort of misappropriation of likeness if the defendant's use of the plaintiff's likeness was for a predominantly commercial purpose, i.e., if defendant was seeking to capitalize on defendant's likeness for purposes other than the dissemination of news or information). See also Faber v. Condecor, Inc., 195 N.J. Super. 81, 477 A.D.2d 1289 (App. Div. 1984), certif. denied, 99 N.J. 178, 491 A.2d 684 (1984) (misappropriation is the use of an individual's name or likeness for advertising or trade purposes without the individual's consent).

Although New Jersey has not specifically distinguished between misappropriation and right of publicity claims, this Court recently described “misappropriation” as being the use of another's name or likeness to enhance the sale of an article, and invasion of the

“right of publicity” as another’s use of one’s name or likeness for another’s advantage where one’s name, reputation or accomplishments have been highly publicized.³ See Jarvis v. A & M Records, 827 F. Supp. 282 (D.N.J. 1993). Several federal courts in this Circuit have addressed claims of the same general type as plaintiff’s as being based on the right of publicity. See Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981) (recognizing that one has a property right in one’s name and likeness); McFarland v. Miller, 14 F.3d 912 (3d Cir. 1994) (“the right of publicity signifies the right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for commercial benefit”). In the instant case, Mr. Dorsey is likely to succeed on his misappropriation/right of publicity claim whether or not these are viewed as distinct causes of action.

There is no question here that defendants’ conduct constitutes an unlawful “misappropriation” of Mr. Dorsey’s image. Defendant’s use of Mr. Dorsey’s likeness on the covers of the Book is strictly a commercial use for trade and advertising. The Book is not about Mr. Dorsey’s life or career, or even about musicians in general, and Mr. Dorsey’s photographs have no public interest, news or historical value insofar as the content of the Book is concerned. Thus, defendants have no colorable defense based on First Amendment or fair use grounds. The appeal of Mr. Dorsey’s pictures, and the only

³ The New Jersey State courts have identified the injury of misappropriation as an invasion of privacy. Canessa v. J.I. Kislak, Inc., 97 N.J. Super. 327; Faber v. Condecor, Inc., 195 N.J. Super. 81, 477 A.D.2d 1289 (App. Div. 1984), certif. denied, 99 N.J. 178, 491 A.2d 684 (1984). The federal courts have identified the injury in right of publicity cases as damage to a commercial interest of the plaintiff. McFarland v. Miller, 14 F.3d 912 (3d Cir. 1994); Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981).

reason they appear on the front and back covers of the Book, is that they attract a potential purchaser's attention. In other words, the images are being used expressly to generate sales of the Book.

The facts here are analogous to those in Faber v. Condecor, Inc., 195 N.J. Super. 81, 86, 477 A.2d 1289 (App. Div. 1984). In Faber, the plaintiff was not a celebrity, but rather an employee of Eastman Kodak Company who had allowed his employer to use a family photograph in the company catalog. The defendant obtained a copy of the photograph and, without the plaintiff's permission, inserted it into picture frames which were then sold throughout the United States. The plaintiff sued and prevailed at trial on his claims for the misappropriation of his image. On appeal, the court affirmed the trial court's award of damages, holding that a person is entitled to relief whenever his name has been used without his consent, either to advertise the defendant's product or to enhance the sale of an article.

Similarly, in Canessa v. J. I. Kislak, Inc., 97 N.J. Super. 327, 235 A.2d 62 (Law Div. 1967), the court recognized the value in a person's name and likeness and held that an individual has an exclusive right to his own name and the equivalent of a trade mark in his likeness that is properly recognized in appropriation actions. In denying the defendant's motion for summary judgment arising out of the unauthorized use of the plaintiffs' image on an advertisement, the court in Canessa held that an individual:

has an exclusive right to his picture, on the score of its being a property right of material profit. We also consider it to be a property right of value, in that it is one of the modes of securing to a person the enjoyment of life and the exercise of liberty, and that novelty of the claim is no objection to relief. If this right is, in either respect, invaded, he may have his remedy, either by restraint in equity or damages in an action at law. If there are special damages,

they may be stated and recovered; but such character of damage is not necessary to the action, since general damages may be recovered without a showing of specific loss; and if the element of malice appears, as that term is known to the law, exemplary damages may be recovered.

This is not to say that Mr. Dorsey's status as a celebrity is irrelevant. To the contrary, courts have routinely recognized that a celebrity has an even greater interest in controlling the commercial value and exploitation of his image. This 'right of publicity,' as courts have referred to it, permits a celebrity to prevent others from unfairly appropriating the value of his or her image for their own commercial benefit. See Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981), citing Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 575-78 (1977).

In Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981), for example, the Estate for Elvis Presley sought a preliminary injunction, under Section 43(a) of the Lanham Act and New Jersey's common law right of publicity, restraining the defendant from using the likeness or persona of Elvis Presley in connection with a theatrical production designed to imitate that famous entertainer's own past stage performances and from selling records and pendants bearing Elvis Presley's image.

At the outset of its decision, this Court analyzed New Jersey law and determined that this State would permit a cause of action for infringement of the right of publicity even though the New Jersey cases do not characterize the claim in those terms. The Court next determined that although the production in Presley contained informational and entertainment elements, it served primarily to commercially exploit the likeness of Elvis Presley and therefore was not entitled to immunity from liability. As a result, the court found that the Estate was likely to succeed on its right of publicity claim.

Ultimately, the court in Presley issued an injunction against the defendant on 43(a) grounds based on its finding that the defendant's use of Elvis Presley's image was likely to confuse consumers about Elvis Presley's affiliation with the production. The court specifically recognized that the Estate in Presley, like Mr. Dorsey here, has a significant stake in continuing to ensure both the substantial good will associated with Elvis Presley's image and that the services or products identified with Presley's image maintain standards of high quality entertainment. The injunction was necessary because the defendant's conduct there threatened to seriously harm the plaintiff "by the deprivation of its ability to control the nature and quality of a service which the public believes it provides." Id., 513 F. Supp. at 1382. See also McFarland v. Miller, 14 F.3d 912 (3d Cir. 1994) ("a famous individual's name, likeness, and endorsement carry value and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation").

The court's decision in Palmer v. Schonhorn Enterprises, Inc., 96 N.J. Super. 72, 232 A.2d 458 (Ch. Div. 1967), is also instructive. There, the defendant manufactured a golf game that consisted of playing cards with plaintiffs' profiles and pictures on them. The plaintiffs did not consent to the use of their names or photographs with the game and requested that the defendant cease and desist from doing so. The defendant refused, and the plaintiffs sought an injunction and damages from the defendant. The court held that although the publication of biographical data of the well-known figures did not invade the plaintiffs' privacy per se, the defendant's use for the purpose of capitalizing upon plaintiffs' names and likenesses did. In language particularly appropriate to the case at bar, the court in Palmer stated: "[t]here is little doubt that a person is entitled to relief

when his name has been used without his consent, either to advertise the defendant's product or to enhance the sale of an article.” The court went on to hold that: “While one who is a public figure or is presently newsworthy may be the proper subject of news or informative presentation, the privilege does not extend to commercialization of his personality through a form of treatment distinct from the dissemination of news or information.” Id., 96 N.J. Super. at 78.

The cases cited above easily demonstrate that Mr. Dorsey is likely to succeed on his claim for misappropriation/right of publicity.

2. Plaintiff's Claim Under Section 43(a) of the Lanham Act

By placing Mr. Dorsey's likeness on the front and back covers of the Book, defendants have confused and deceived the public into believing that Mr. Dorsey permitted this conduct and thereby endorsed, sponsored or otherwise approved of the Book. Accordingly, Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides an additional and independent ground for granting preliminary injunctive relief to plaintiff. Section 43(a) provides, in relevant part, as follows:

§ 1125. False designations of origin, false descriptions, and dilution forbidden

- (a) Civil action.
- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil

action by any person who believes that he or she is or is likely to be damaged by such act.

Courts have recognized that a false endorsement occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of the product or service. See, e.g., *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (animatronic robotic figures resembling actors in Cheers television program used to advertise chain of airport bars modeled on Cheers set), cert. denied sub nom., 121 S. Ct. 33 (2000); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (athlete's name and accomplishments used in television advertisement for Oldsmobile automobiles); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (imitation of singer's unique voice used in radio commercial advertising Dorito Chips); *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (female robot bearing resemblance to television celebrity, Vanna White, turning letters in what appeared to be the "Wheel of Fortune" game show set in television commercial advertising electronics products), cert. denied, 508 U.S. 951 (1993); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (photograph of Woody Allen look-alike in national advertising campaign for video club). The 'mark' at issue in such cases is the celebrity's likeness or persona. See *Wendt*, 125 F.3d at 812 n. 1; *White*, 971 F.2d at 1399-1400.

In *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. Cal. 2001), the Ninth Circuit, which has extensive experience in these types of cases, suggested the following factors for courts to consider in determining whether there exists a likelihood of confusion in a celebrity 43(a) case:

- (1) the level of recognition that the plaintiff 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 plaintiff to the defendant's product;
- (3) the similarity of the likeness used by the defendant to the actual plaintiff;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) likely degree of purchaser care;
- (7) defendant's intent on selecting the plaintiff; and
- (8) likelihood of expansion of the product lines. *Id.*, 265 F.3d at 1007-08.⁴

The Downing factors are similar in most respects to the factors used by the Third Circuit to determine likelihood of confusion in non-celebrity 43(a) cases. See Advance Magazine Publs. v. Vogue Int'l, 123 F. Supp. 2d 790 (D.N.J. 2000).

Each of the factors above weighs in favor of finding a likelihood of confusion here. With regard to the first factor, for example, as a result of, among other things, his professional career, his Grammy nominations, his community outreach work, and the sale of nearly 2.5 million records bearing his name or likeness on the cover, Mr. Dorsey has achieved significant level of recognition within the African-American community, which is the same societal segment at which Black Pearl has targeted the Book. *Dorsey Aff.* at ¶¶ 13-18.

⁴ Although these are all factors that are appropriate for consideration in determining the likelihood of confusion, they are not necessarily of equal importance, nor do they necessarily apply to every case. *Id.* at 1008.

With regard to the second and seventh factors, while plaintiff does not know for certain whether defendants originally intended to capitalize on Mr. Dorsey's fame by placing his photographs on the covers of the Book, there is no doubt that defendants are aware that they are doing so now and have refused adamantly to stop. Moreover, consumers have recognized and will continue to recognize Mr. Dorsey on the Book, and plaintiff's face and reputation are now inextricably linked with the drug dealer and convict portrayed in the Book. Accordingly, these factors favor plaintiff.

With regard to the third factor, defendants used Mr. Dorsey's actual picture. This is the most important factor in the analysis, and courts have held that where an infringer uses a trademark holder's exact mark, a great likelihood of confusion exists. See S & R Corp. v. Jiffy Lube Int'l, Inc., 968 F.2d 371 (3d Cir. 1992); Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981) (the greater the similarity of the marks, the greater the likelihood of confusion).

With regard to the fourth factor, plaintiff has described in his affidavit numerous instances of actual confusion that demonstrate that that defendants' conduct has harmed the value of his mark. Dorsey Aff. at ¶¶ 9, 25, 34-36.

With regard to the fifth and sixth factors, Mr. Dorsey's work is available at some of the same outlets where the Book is being sold and advertised. The potential pool of consumers who may be confused by defendants' use of Mr. Dorsey's image on the Book is vast; it includes purchasers (and potential purchasers) of the Book in stores and over the Internet. This factor, therefore, also favors plaintiff.

With regard to the final factor, Mr. Dorsey has not yet exploited his image for commercial endorsements but, as a celebrity, it is virtually certain that at some point he

will want to do. In fact, the value of a celebrity's endorsement is enhanced precisely by how few of them the celebrity does, particularly here, given Mr. Dorsey's desirability as an endorser. The record set out here of plaintiff's successful and accelerating entertainment career, along with a resume of community-oriented activities, undertaken sincerely but undoubtedly enhancing the value of his professional image – as well as defendants' own actions in stealing that image for their own profit – speak powerfully to that value. Accordingly, this factor favors plaintiff.

In short, plaintiff is able to demonstrate a likelihood of confusion arising from defendants' use of his image on the Book and, therefore, has demonstrated that he is likely to succeed on the merits of his claim under Section 43(a) of the Lanham Act.

**B. Plaintiff Will Suffer Irreparable Harm
If the Court Does Not Grant An Injunction**

Plaintiff has apply demonstrated that defendants' conduct will cause him irreparable injury including, among other things, the loss of reputation, the false portrayal of plaintiff to the public as a drug dealer and convicted felon, the loss of control over the use of his image, the loss of potential endorsement deals, the loss of potential philanthropical arrangements, and other confusion that defendants' conduct has caused in the marketplace.

Grounds for finding irreparable injury include loss of control of reputation, loss of trade, and loss of good will. See 2 McCarthy, Trademarks and Unfair Competition, at § 30:18. Most important, however, in the Third Circuit, a showing of a likelihood of confusion establishes irreparable harm. See Opticians Ass'n of America v. Independent

Opticians of America, 920 F.2d 187 (3d Cir. 1990). Accordingly, plaintiff has satisfied this element for injunctive relief.⁵

C. Any Harm that Defendants May Suffer Is Outweighed by the Harm to Plaintiff If No Preliminary Injunction is Issued

To the extent that defendants suffer any harm as a result of the Court issuing an injunction, they have brought such harm upon themselves as a result of their intentional or negligent failure to obtain Mr. Dorsey's permission before placing his image on the covers of their Book, amplified by their undoubtedly intentional insistence on continuing to do so even after being given notice and provided with a demand that they cease and desist. Further, any loss in trade to the defendants would be due only to the fact that they will no longer be unlawfully trading on Mr. Dorsey's good will and reputation.

Moreover, defendants' use of Mr. Dorsey's image serves no social function valued by the protection of free speech, since it is not intended to convey information which is neither false nor defamatory to the public debate of political or social issues, nor is it providing the free expression of creative talent which contributes to society's cultural enrichment. The use of Mr. Dorsey's image is strictly a commercial use intended to sell defendants' product.

D. The Public Interest Weighs in Plaintiff's Favor

The public interest weighs in favor of injunctive relief because the public is best served by the protection of trademarks and avoiding consumer confusion. See Bill Blass,

⁵ The Court in Presley held that to establish irreparable harm for a *right of publicity* claim, a celebrity must demonstrate sufficiently that the use of his name or likeness is likely to result in an identifiable economic loss. In a 43(a) claim, however, there is no such requirement. See Presley, 513 F. Supp. at 1378. Here, Mr. Dorsey has made a showing that the unauthorized use of his image is likely to result in economic loss and, therefore, has met his burden on both claims.

Ltd. v. Saz Corp., 751 F.2d 152, 156 (3d Cir. 1984). The public interest generally favors a preliminary injunction where the moving party has demonstrated a likelihood of success because “the public is . . . interested in fair competitive practices and clearly opposed to being deceived in the marketplace. Presley, 513 F. Supp. at 1382, citing McNeil Laboratories, Inc. v. American Home Products Corp., 416 F. Supp. 804, 809 (D.N.J. 1976).

II. THE COURT SHOULD ORDER DEFENDANTS TO RECALL ALL COPIES OF THE BOOK FROM THE MARKETPLACE, AS WELL AS ANY UNSOLD COPIES OF DEFENDANTS’ OTHER BOOKS AND MATERIALS THAT CONTAIN MR. DORSEY’S IMAGE

In light of the facts here, including the outrageous nature of defendants’ conduct and the irreparable harm that defendants have caused, and will continue to cause, to Mr. Dorsey, plaintiff further requests that the Court order defendants to recall all unsold copies of the Book, and any unsold copies of defendants’ other books, containing Mr. Dorsey’s image from the marketplace. Plaintiff is not seeking a recall from consumers, but rather a recall from bookstores and other commercial and retail outlets where these items are being sold and displayed to the public.

It is well settled that the district court's equity jurisdiction empowers it "to mould each decree to the necessities of the particular case." Hecht Co. v. Bowles, 321 U.S. 321, 329, 64 S. Ct. 587, 88 L. Ed. 754 (1944); Electronic Specialty Co. v. International Controls Corp., 409 F.2d 937, 947 (2d Cir. 1969).

Moreover, where, as here, there is a strong likelihood of consumer confusion, a court may order as part of a preliminary injunction that defendant recall infringing goods, so as to restore the status quo pending a final resolution on the merits. McNeil-Ppc, Inc. v. Merisant Co., 2004 U.S. Dist. LEXIS 27733 (D.P.R. July 29, 2004). See also

Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 997 (2d Cir. 1997) (affirming preliminary injunction that required defendant to remove all infringing trade dress from retail stores around the world during pendency of action); Chere Amie, Inc. v. Windstar Apparel, Corp., 191 F. Supp. 2d 343 (S.D.N.Y. 2001) (granting preliminary injunction and ordering that defendants recall from all distributors, wholesalers, jobbers, dealers, and retailers any products employing the plaintiffs' trademark) Kennedy Indus. v. Aparo, 2006 U.S. Dist. LEXIS 8624 (E.D. Pa. Mar. 6, 2006); Elizabeth Arden, Inc. v. Belcam, Inc., 2005 U.S. Dist. LEXIS 40734 (S.D. Ohio 2005). Finally, the Court has the power to enjoin unlawful conduct by a party before the court by fashioning an appropriate remedy without any geographical limitation. See Stiller v. Hardman, 324 F.2d 626 (2d Cir. 1963) (“The mandate of an injunction issued by a federal district court runs throughout the United States), citing Leman v. Krentler-Arnold Co., 284 U.S. 448 (1932).

Without a recall order, the evidence demonstrates that Mr. Dorsey will continue to be irreparably injured by the Books that remain on store shelves throughout the United States, including by having his face associated with a drug dealer and convicted felon and by having his own ability to fully exploit his image in ways that he sees fit permanently impaired.

CONCLUSION

For the reasons set forth above, plaintiff requests that the Court grant him the relief being sought in full.

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