Against the Grain

Volume 16 | Issue 6 Article 20

December 2004

Cases of Note -- Lanham Act Preempts State Claims -- Ultra Sheen Model Falls Off the Legal Runway

Bruce Strauch
The Citadel, strauchb@citadel.edu

DOI: https://doi.org/10.7771/2380-176X.4447

Cases of Note — Lanham Act Preempts State Claims — Ultra Sheen Model Falls Off the Legal Runway

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

June Toney v. L'Oreal, The Wella Corporation, and Wella Personal Care of North America United States Court of Appeals for the Seventh Circuit, 2004 U.S. App. LEXIS 19576 (2004).

June Toney is a model — print, T.V. and runways — who authorized **Johnson Products Corp** to use her likeness for "Ultra Sheen Supreme," a "hair relaxer" product. The term ran from November 1995 to November 2000.

Johnson sold Ultra Sheen to **Carson Products** which sold it to **L'Oreal** which sold to **Wella Corporation**. And in the process they used her photo beyond Nov. 2000.

Toney sued these companies in state court for using her likeness beyond the contract term relying on the **Illinois Right of Publicity Act**, 765 Ill. Comp. Stat. 1075/1, *et seq.* (2003) **(IRPA),** and the **Lanham Trademark Act** of 1946, 15 U.S.C. § 1125(a).

Fatally, she did not allege breach of contract. And this is where those law review brains in the big defense firms will outsmart and out-civil-procedure you in a flurry of motions.

First, defendants moved the case to federal court where the judge held the **Lanham** claim preempted the state one. Then defendants moved to dismiss Under Rule 12(b)(6) of the Federal Rules of Civil Procedure. **Toney** didn't take the pictures and didn't own the copyright!

Toney dropped her **Lanham** claim with prejudice and "the case was closed." She appealed the preemption decision in a desperate bid to get back into state court where she could claim a cause of action under **IRPA**.

So what's up with IRPA?

IRPA as you've no doubt guessed gives Illinois the "right to control and to choose whether and how to use an individual's identity for commercial purposes." 765 Ill. Comp. Stat. 1075/10. Anyone wanting to use your identity for commercial purposes must obtain written consent. 765 Ill. Comp. Stat. 1075/30.

But then there's this preemption thing.

Yes, indeed. **The Copyright Act** preempts under § 301 if (1) the work is in tangible form, and it falls into the subject matter of copyright under § 102; AND (2) the state rights are the same as the federal ones under § 106.

Curiously, if the work is too minimal in its originality to qualify for federal protection, the states may not protect the right either. *See Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n,* 805 F.2d 663, 676 (7th Cir. 1986).

Which sounds like pretty thorough preemption.

§ 102

"Original works of authorship fixed in any tangible medium" are the subject matter of copyright. 17 U.S.C. § 102(a). It's fixed when "sufficiently permanent ... to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101.

So, hair relaxer photos meet the requirement, but ... what do not? A hypnotic vision produced by a magician? Smoke signals? Morse code?

And if that isn't enough, § 101 flat says that photos are "pictoral works" covered by **Lanham**.

Toney gets creative.

Realizing she was up the creek without authority, **Toney's** lawyer got creative, arguing her **IRPA** claim is directed at Defendants' use of her "identity" rather than her likeness in the negatives and photo prints. But **Toney** had not stated this in her complaint, and in her response to Defendants' motion to dismiss she had stated the claim was limited to use of the likeness. She can't just raise this on appeal. *Bell v. Duperrault,* 367 F.3d 703, 708 n.1 (7th Cir. 2004) (citing *Williams v. REP Corp.,* 302 F.3d 660, 666 (7th Cir. 2002).

And *Baltimore Orioles supra* held no distinction between publicity rights and art — in this case, players playing a game and photos or broadcast of the same. Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.09[F] (1999).

Footnote 24 in *Baltimore Orioles* did say the question would not be preempted if a company used a player's **name** to advertise a product. But that's not what's going on here. The public doesn't know **Toney's** name and it wasn't used anyhow. It was a photo.

§ 106

For preemption, **IRPA's** rights must be the equivalent of any rights under § 106 which has six rights of which four are on point: (1) to reproduce in copies, (2) to prepare derivative works, (3) to distribute copies, (4) to display.

These were all **Toney's** rights under **IRPA**.

And **Toney** didn't hold copyright. That belonged **Carson Products.** Which as you recall was why **Toney's** case got dismissed.

The court rounds out by saying she should have brought a breach of contract action which would have avoided the preemption issue.

Ouch!

But of course now she can't because you're supposed to plead all theories that are available in the one action.

Questions and Answers
from page 56

written agreement among copyright holders; the default is tenants in common.

A library should contact one author or his or her heirs to seek permission to put the work on the Web. Often joint owners are considerate of each other and will not grant permission without contacting the other owner, however.

Adventures in Librarianship — A Passion for Public Television

by **Ned Kraft** (Ralph J. Bunche Library, U.S. Department of State) <kraftno@state.gov>

Voice over with still shot of town square: WETT 62 — Your Public Television. Bringing high school orchestral concerts, pictures of far away cities, our local poets, and whatnot to the greater Farmington area.

Scroll: Two Minutes in the Library.

SA: Hello, I'm **Stratford Avon** bringing you Two Minutes in the Library.

[Music with montage of happy readers, young and old]

SA: Today we're going to talk to **Helen Bacque**, the children's librarian. Welcome, **Helen**. And, may I say, that's a lovely dress you have on. And your shoes look incredibly comfortable.

HB: Well, thank you **Mr. Avon**.

SA: Tell me **Helen**... may I call you **Helen**?

HB: Certainly, **Stratford**, if I may be so bold.

SA: Indeed you may, **Helen**. Did I mention your lovely dress and comfy shoes?

HB: You did, **Stratty**. Thank you.

SA: Well... yes, then.... Tell me, **Helen**, is

continued on page 58