

No. 23-\_\_\_

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**In the Supreme Court of the United States**

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PAULE McKENNA,  
*Petitioner,*

v.

SONY PICTURES ENTERTAINMENT, INC, et al.  
*Respondents.*

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**On Petition for a Writ of Certiorari  
to the California Court of Appeal  
Second Appellate District, Division Five**

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**PETITION FOR A WRIT OF CERTIORARI**

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DAVID ZARMI  
*Counsel of Record*  
ZARMI LAW  
9190 W Olympic Blvd.,  
Ste. 191  
Beverly Hills, CA 90212  
310-841-6455  
davidzarmi@gmail.com

*Counsel for Petitioner*

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## **QUESTION PRESENTED**

Does the Lanham Act properly prohibit the unauthorized use of a celebrity's persona advertising third party brands with logos in a commercial motion picture as a trademark infringement?

## PARTIES TO THE PROCEEDING

Petitioner Paule McKenna was the plaintiff in the Los Angeles County Superior Court and the appellant in the California Court of Appeal. Respondents Sony Pictures Entertainment, Inc., Boss Film Productions, Inc., and Visiona Romantica, Inc. were defendants in the Los Angeles County Superior Court and respondents in the California Court of Appeal.

## STATEMENT OF RELATED PROCEEDINGS

This case arises from and is related to the following proceedings in the California Superior Court for the County of Los Angeles, the California Court of Appeal, and the California Supreme Court:

- *McKenna v. Sony Pictures Entertainment, Inc.*, No. 19SMCV01329 (Cal. Super. Ct.), order issued Jan. 29, 2020;
- *McKenna v. Sony Pictures Entertainment, Inc.*, Nos. B304256, B310814<sup>1</sup> (Cal. Ct. App. 2d Dist. Div. 5), judgment issued Feb. 15, 2023;
- *McKenna v. Sony Pictures Entertainment, Inc.*, No. S279159 (Cal.), petition for review denied Apr. 26, 2023.

There are no other proceedings in state or federal trial or appellate courts directly related to this case within the meaning of this Court's Rule 14.1(b)(iii).

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<sup>1</sup> Case no. B310814 was from an attorney fees order in the same superior court case and was consolidated for appeal.

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## **PETITION FOR WRIT OF CERTIORARI**

Petitioner respectfully seeks a writ of certiorari to review the judgment of the California Court of Appeal Second Appellate District, Division Five.

### **OPINIONS BELOW**

The California Court of Appeal's opinion is unpublished but can be found at 2023 WL 2007687 and is reproduced as Appendix A. The California Supreme Court denied review in an order reproduced as Appendix C.

### **JURISDICTION**

The California Supreme Court declined to exercise its discretionary review on April 26, 2023. On July 20, 2023, Justice Kagan granted an extension to file petition for writ of certiorari until September 5, 2023. This Court has jurisdiction under 28 U.S.C. § 1257(a).

### **CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED**

The First Amendment to the United States Constitution states that “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.”

Lanham Act, § 32, 15 U.S.C. § 1114 provides:

Any person who shall, without the consent of the registrant—



(a)use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b)reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Lanham Act, § 43(a), 15 U.S.C. § 1125(a), provides:

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.

Lanham Act, § 45, 15 U.S.C. § 1127, provides, in part:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof[] used by a person[] . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

## INTRODUCTION

Petitioner urges this Court to review a judgment of the California Court of Appeal that applies

the Lanham Act restrictively so as not to apply to the unauthorized use of a celebrity's persona in a commercial movie as trademark infringement. The federal circuit courts have held that a celebrity's persona is a trademark under the false endorsement prong of the Lanham Act and this Court should logically extend the same definition to trademark infringement.

The result of artificially limiting the Lanham Act allows commercial movie producers to earn money off of the use of celebrity's persona while promoting brands without the need to obtain the permission of or to even compensate the celebrity and his heirs. Therefore, this Court should grant certiorari to mitigate this injustice unintended by the Lanham Act itself.

## STATEMENT OF THE CASE

### A. The Legacy of Christopher Jones

Christopher Jones was a popular actor in the 1960s. He starred in the television series *The Legend of Jesse James* and many movies including *3 in the Attic* and *Wild in the Streets*. He stopped acting in Hollywood in 1969 and passed in 2014. Petitioner was Mr. Jones's partner and is the executor of his estate.<sup>2</sup>

*Once Upon a Time . . . in Hollywood* (the film), is a film written and directed by Quentin Tarantino. It was produced by Boss Film Productions and re-

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<sup>2</sup> As noted *infra*, n.4, petitioner was also assigned the rights to Mr. Jones's likeness and persona prior to his death.

leased by Sony Pictures Entertainment in 2019. The film stars Leonardo DiCaprio as fictional actor Rick Dalton, Brad Pitt as his fictional stunt-double Cliff Booth, and Margot Robbie as real-life actor Sharon Tate. It depicts a few days in the lives of the three main characters in 1969.

Mr. Jones's name is used twice in the movie, once on Booth's television screen advertising *3 in the Attic* and once on a marquee advertising the same.<sup>3</sup> Additionally, Booth wears a name brand Champion spark plugs t-shirt and cooks Kraft macaroni and cheese while Wheaties and Wonder Bread are visible. Additionally, Mr. Jones's name appears several times in promotional materials advertising the film. (*See generally* App. A at 3, 6-7.)<sup>4</sup>

## **B. The Litigation**

In July 2019, petitioner brought suit against respondents alleging, inter alia, trademark infringement in violation of the Lanham Act.<sup>5</sup>

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<sup>3</sup> Mr. Jones's name is also heard twice during that advertisement.

<sup>4</sup> In addition to the instances noted by the Court of Appeal (*see* App. A at 3, 6-7), Mr. Jones's face was used in close-up to promote the film at Tarantino's theater.

<sup>5</sup> Although the Court of Appeal appears to have believed that petitioner brought suit as executor of Mr. Jones's estate (App. A at 2), and while it is true that petitioner was *also* executor of his estate, she had separately and earlier been assigned the rights to the use of his likeness and sued under that capacity. (*See* 2-CT-498-503, 525.)

In the complaint, petitioner alleged that Tarantino based the Dalton and Booth characters taken together on Mr. Jones. The complaint alleged that Tarantino instructed the hairstylist for DiCaprio and Pitt to copy Mr. Jones's hair. The complaint also alleged that the characters mirrored Mr. Jones's life. Mr. Jones had roles as a spy, a soldier, and in a musical and was filmed shirtless for one of his movies. Dalton is portrayed shirtless on a roof and his movie credits in the film include portraying a soldier and a spy, and acting in a musical. As another example, the complaint alleged Mr. Jones often wore cowboy boots, wore a gold pendant necklace, spent some time with Tate while filming in Rome, and had a flashy agent, and that these elements are also present in the film as to Dalton or Booth (or both).

Respondents filed a motion to strike the complaint under California's anti-SLAPP statute, California Code of Civil Procedure § 425.16. The Los Angeles County Superior Court agreed and dismissed the complaint because the movie was protected speech and because petitioner failed to establish a probability of prevailing on the merits on any of her causes of action. (*See* App. B)

### **C. The Appellate Opinion**

On appeal, the California Court of Appeal found, *inter alia*, that the Lanham Act did not apply to Mr. Jones's "name and likeness." (App. A at 27.) Although the appellate court earlier explained why Mr. Jones was famous (an opinion that Tarantino obviously held because he put Mr. Jones's name in his movie twice and asked the hairdresser to use Mr.

Jones's style, if nothing else) (*see id.* at 2-5, 8), the court concluded that "[Mr.] Jones's name is not inherently distinctive." (*Id.* at 27.)

The court also cited a Sixth Circuit case for the proposition that, "as a general rule, a person's image or likeness cannot function as a trademark" because it does not "perform the trademark function of designation." (App. A at 28, quoting *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003).)

### **REASONS FOR GRANTING THE PETITION**

This Court should grant certiorari because the courts need guidance as to the application of the Lanham Act to commercial infringement on the trademark of celebrity persona. Although the courts have settled that a celebrity persona is a trademark for false endorsement purposes they have yet to make the logical extension to trademark infringement, leaving movie producers free to use celebrity personas without their consent.

As to trademarks, the Lanham Act "secure[s] to the owner of [a] mark the goodwill of his business" and "protect[s] the ability of consumers to distinguish among competing producers." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (internal quotation marks omitted). The Lanham Act provides for civil liability when "[a]ny person who shall, without the consent of the registrant--use in commerce any reproduction . . . of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion." Lanham Act § 32(1)(a), 15 U.S.C. § 1114(1)(a).

A “trademark” means “any word, name, symbol, or device, or any combination thereof” which a person uses “to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.” Lanham Act, § 45, 15 U.S.C. § 1127. A trademark thus is “a limited property right in [a] particular word, phrase, or symbol . . . that is used to identify a manufacturer or sponsor of a good or the provider of a service.” *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 n.12 (9th Cir. 2003) (quotation and internal citation omitted). The limited purpose of the Lanham Act’s trademark protection is “to avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.” *Id.* at 806 (quotation and alteration omitted).

To prevail on a trademark claim, a plaintiff must show that the alleged mark at issue is a cognizable trademark, i.e., that the public recognizes the symbol as identifying the plaintiff’s goods or services and distinguishes those goods or services from those of others. *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 594-95 (9th Cir. 2000). A plaintiff may meet this burden by showing either that its symbol is inherently distinctive, or that even if not inherently distinctive, the symbol has become distinctive through the acquisition of secondary meaning. *Id.* If the plaintiff establishes it has a cognizable mark, it then must show the defendant’s use of the plaintiff’s trademark is “likely to cause confusion or to cause mistake, or to deceive as to the affiliation,

connection, or association of the two products.” *Mat-  
tel*, 353 F.3d at 807; *see generally Fifty-Six Hope Rd.  
Music, Ltd. v. A.V.E.L.A., Inc.*, 688 F. Supp. 2d 1148,  
1158 (D. Nev. 2010).

But while the Sixth Circuit case quoted above held that a celebrity’s persona does not “generally” constitute a trademark, *ETW*, 332 F.3d at 922, other cases, even within the Sixth Circuit have held to the contrary for other Lanham Act violations.

In *Parks v. La Face Records*, 329 F.3d 437, 447 (6th Cir. 2003), the Sixth Circuit held that “courts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a).” 15 U.S.C. § 1125(a). Similarly, the Ninth Circuit decided, “In cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona.” *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992); 5 J. Thomas McCarthy on Trademarks and Unfair Competition § 28:15 (4th ed. 2011). A deceased celebrity’s persona is also described as a trademark under the Lanham Act. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (finding that the plaintiff’s “voice is a distinctive mark [and] the Estate owns the mark); *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013 (C.D. Cal. 1998) (“phrase ‘another person’ in § 43(a)(1)(A) indicates that Congress selected language broad enough to encompass a claim by a deceased celebrity’s [e]state or by any celebrity’s assignee,” internal quotation marks omitted); 15 U.S.C. § 1125(a)(1)(A).



Those courts that view the celebrity's persona as his trademark are right. The Lanham Act was intended to protect trademark holders from unauthorized use and this Court should clarify for all the lower courts, state and federal, that celebrities' personas are their own property and not open for the abuse of commercial productions depicting them with obvious brand advertising.

### CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

DAVID ZARMI

*Counsel of Record*

ZARMI LAW

9190 W Olympic Blvd., Ste. 191

Beverly Hills, CA 90212

310-841-6455

davidzarmi@gmail.com

*Counsel for Petitioner*

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