

Hollyweed: Using Right of Publicity for Cannabis Brand Protection

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I. Introduction

The growing legalization of cannabis in the United States presents a problem—how can cannabis products obtain brand protection? Because of the federal illegality of cannabis, federal trademark protection is unavailable. Moreover, in 2019, a California district court ruled that state trademark protections for cannabis products cannot defeat a challenge against a federal trademark holder.¹ The dual purpose of trademark protection is for consumers to have the ability to choose, based on reputation, products that they trust due to brand consistency as well as incentivize brands to maintain that level of quality and consistency. Without trademark protection, there is little incentive to build a quality brand when other companies may free ride off of one company's good reputation.

Thus, there must be an alternate route to protect the branding of cannabis products that does not conflict with the federally illegal nature of cannabis: using the right of publicity. The right of publicity is every individual's right to control and profit from the commercial use of their name, likeness, and persona. The right of publicity does not conflict with principles of illegality because it does not protect commerce, it protects identity and personal integrity. One who violates an individual's right of publicity does so by profiting off of one's identity without consent. There is no federal statute for the right of publicity; state statutes and common law govern. Therefore, there is no problem that federal illegality presents, like it does with trademark law.

Celebrity “cannapreneurs”—such as Snoop Dogg, Willie Nelson, Jim Belushi, and Jaleel White—have already tapped into right of publicity by branding cannabis products with their name, likeness, and persona. These public figures have the right of

¹ See *Kiva Health Brands LLC v. Kiva Brands Inc.*, 402 F. Supp. 3d 877 (N.D. Cal. 2019).

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publicity that allows them to control their image and protect their personal integrity, so by marking cannabis products using their name, likeness, and persona, they establish their own brands and prevent anyone else from using their marks, as the right of publicity does not allow others to profit off an individual's identity. Additionally, because of the value that the celebrity brand name adds, there is more variation in the market and establishment of a premium product. If cannabis companies and dispensaries marketed products using personas, they too could benefit from right of publicity protection for their brands.

II. The Importance of Branding in the Cannabis Market

In the 2020 Election, New Jersey, Arizona, South Dakota, and Montana voted to pass legislation permitting adult-use recreational marijuana, joining fourteen other states that have opted for legalization.² Additionally, voters from South Dakota and Mississippi approved medical marijuana initiatives, becoming part of 36 states that permit the legal distribution of medical marijuana.³ With the influx of adults able to consume legal cannabis, there is a need for the ability to market cannabis products.

Many adults benefitting from the legalization of cannabis will be new users who are unfamiliar with the effects of cannabis,⁴ especially with regard to cannabis-infused

² Jay Cannon, *These states legalized recreational marijuana on Election Day*, USA TODAY (Nov 5, 2020, 11:26 AM), <https://www.usatoday.com/story/news/politics/elections/2020/11/04/recreational-weed-legal-arizona-new-jersey-south-dakota-montana/6160708002/>.

³ *Id.*

⁴ See Andrew A. Monte, Shelby K. Shelton, Eleanor Mills, Jessica Saben, Andrew Hopkinson, Brandon Sonn, Michael Devivo, Tae Chang, Jacob Fox, Cody Brevik, Kayla Williamson & Diana Abbott, *Acute Illness Associated With Cannabis Use, by Route of Exposure: An Observational Study*, 170 ANNALS OF INTERNAL MED. 531 (2019) (finding that following legalization in Colorado there was an increase in marijuana-related hospitalizations from edibles causing paranoia).

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edibles,⁵ leading to a demand for safety and quality in the market.⁶ There is a nexus between quality and branding, as branding helps consumers continuously select products that are of high quality and reliable.⁷ Without branding, consumers could not reward the manufacturer with repeat purchases that indicate that the brand is of high quality and caters to the tastes of the consumer.⁸ Branding allows consumers to make choices based on reputation, reducing time and energy they would spend searching for quality products.⁹

For example, if there were no brand marks, a consumer could learn about the average quality of eggs, or the consumer could purchase many cartons of eggs every week to find one that satisfies the consumer.¹⁰ The consumer would not be able to save time and energy by buying products based on the consistent quality of a brand. Additionally, branding helps consumers indicate which products are of low-quality—the Supreme Court noted that brand protection “helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.”¹¹ Thus, brands that build trust through maintaining quality and consistency will rise to the top of the market, as consumers know that the cannabis products from that brand are reliable and safe.

⁵ See German Lopez, *Eating marijuana is riskier than smoking it*, Vox (May 9, 2014, 4:40 PM) <https://www.vox.com/2014/5/9/5700442/why-colorado-is-taking-a-hard-look-at-marijuana-edibles> (discussing how it is difficult to control the dose of edibles because they take longer to absorb, leading to many people eating more and resulting in an unpleasant effect or overdose).

⁶ See Melissa Schiller, *Build Customer Trust: Cannabis Branding and Marketing Explained*, CANNABIS BUSINESS TIMES (Oct. 5, 2018) <https://www.cannabisbusinesstimes.com/article/build-customer-trust-cannabis-branding-marketing-explained/> (interview with consumer brand and marketing expert Peter McDonough who states “it’s critical for a brand to create a foundation of trusted quality and safety assurance. This is particularly true within the cannabis and CBD market sector.”).

⁷ 1 THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:4 (5th ed. 1996).

⁸ *Id.* (citing leading Economist F.M. Scherer).

⁹ *Id.* at § 2.5

¹⁰ *Id.* § 2.5, see *id.* § 2.5 n.3.

¹¹ *Id.* § 2.4 (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017)).

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For cannabis companies, branding promotes accountability and encourages brands to maintain a standard of quality. If mistakes are anonymous or untraceable, there is little incentive to maintain quality.¹² Branding helps companies build a good reputation—when the company name brandishes the products, there is an incentive to strive for quality.¹³ A cannabis company that makes a relevant promise to consumers and delivers a product that fails to meet that promise due to inconsistent quality or lack of performance cannot maintain success in the market as there is a discrepancy between the brand promise and quality of the product. Without protection for branding, a company can misappropriate another company's brand mark and free ride off of the branded company's good reputation.¹⁴ Moreover, the misappropriating company could hurt the reputation of the branded company, as customers may purchase a product of inferior quality from the misappropriating company believing it is the branded company.¹⁵ There would be little incentive to invest in quality if one could not take action against such misappropriation.¹⁶

Branding is especially important for dispensaries—the connection between cannabis companies and consumers. Generally, dispensaries price cannabis flower in three tiers that consist of an affordable option, a middle-ground option, and a premium top-shelf option.¹⁷ Using a three-tier marketing method for cannabis flower allows dispensaries to promote product variety and distinguish between generic and premium

¹² *Id.*

¹³ *Id.* quoting Edward S. Rogers, *The Lanham Act and the Social Function of Trademarks*, 14 LAW & CONTEMP. PROBS. 173, 175 (1949).

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ Lauren Yoshiko, *Understanding The Difference (Or Lack Thereof) When Paying More For Cannabis Flower*, FORBES (Sep. 10, 2018, 8:10 AM), <https://www.forbes.com/sites/laurenterry/2018/09/10/understanding-the-difference-or-lack-thereof-when-paying-more-for-cannabis-flower/?sh=2004a845def3>.

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without relying on brand names. However, because the quality of the flower varies based on a variety of factors such as certifications, growing methods, levels of THC, general business practices of the grower, and origin, a more expensive flower is not what necessarily distinguishes it as the highest quality.¹⁸

With regards to dispensaries, there is the additional involvement of “budtenders,” dispensary staff members who work at the storefront and act as a dispensary’s representatives, offering suggestions to customers and answering their questions. Budtenders educate customers on the different cannabis strains, the typical effects of specific cannabis products, and the type of cannabis products that would best meet the customer’s request.

Budtenders have their own reputations that operate within mainstream influence—the involvement of budtenders is akin to personal trainers at a gym. While a gym has its own reputation, the individual personal trainers have different levels of expertise. A personal trainer may recommend certain exercises to suit the needs of certain gym members better—stretches for one trying to achieve flexibility and weight training for one trying to cultivate muscle mass. A gym would provide such trainers with the equipment they need to satisfy such needs. If a gym member suffers injury, it would be likely be clear whether the cause is equipment failure or the instruction from the personal trainer. At a dispensary where there is no branding for products, a customer cannot distinguish between who or what is at fault for poor product performance—the budtender or the cannabis product. Because there is no accountability for the cannabis product because of lack of branding, the customer would likely attribute the fault to the budtender, hurting the reputation of the budtender as well as the dispensary as a whole.

¹⁸ *Id.* (discussing factors that result in a fluctuation of price points regardless of quality).

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Thus, branding is essential in the cannabis market, but protections must be in place to incentivize cannabis companies to build and maintain a brand as well as ensure that other companies do not attempt to freeride off the good name of a brand. Generally, companies look toward obtaining a federal trademark to protect company and product branding. Trademark protection has a dual purpose. One is to protect the public from deception and confusion when distinguishing goods from competing manufacturers, another is to protect the trademark owner, who spent time and energy into building the product, against piracy and misappropriation.¹⁹

Unfortunately, cannabis products cannot benefit from federal trademark protection because the United States Patent and Trademark Office (“USPTO”) cannot grant trademarks for products that are federally illegal, a category under which cannabis falls.²⁰ Additionally, the decision in *Kiva* implies that courts are not willing to honor state trademark protections in legal states where a challenger has a federal trademark.²¹

III. The Federal Problem

For federal trademark protection, the use of a mark in commerce must be lawful.²² Generally, the USPTO presumes that an applicant uses the mark lawfully, and will not refuse protection based on absence of lawful use in commerce unless the following circumstances ensue:

either (1) a violation of federal law is indicated by the application record or

other

¹⁹ McCARTHY, *supra* note 7, § 2.2.

²⁰ 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.69.

²¹ See *Kiva*, 402 F. Supp. 3d 877.

²² 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.69; *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 526 (Fed. Cir. 1987) (“A valid application cannot be filed at all for registration of a mark without “lawful use in commerce.”).

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evidence, such as when a court or a federal agency responsible for overseeing activity in which the applicant is involved, and which activity is relevant to its application, has issued a finding of noncompliance under the relevant statute or regulation, or (2) when the applicant's application-relevant activities involve a per se violation of a federal law.²³

Additionally, the fact that a product or service is legal at the state level is “irrelevant to the question of federal registration when it is unlawful under federal law.”²⁴

The federal government uses the Controlled Substances Act (“CSA”) to regulate drugs.²⁵ Under the CSA, cannabis is a schedule I drug, meaning, it is a drug with no currently accepted medical use in the United States, a lack of accepted safety for use under medical professionals, and a there is high potential for abuse.²⁶ There is no differentiation between recreational and medical use—the CSA treats cannabis the same as any other schedule I drug, including cocaine and heroin, where possession and distribution is illegal.²⁷

The Constitution provides that federal law is the “supreme Law of the Land” and may expressly preempt state law, but whether it impliedly preempts state law is a question of Congressional intent.²⁸ The CSA uses language that suggests there is only

²³ *In re Brown*, 119 U.S.P.Q.2D (BNA) 1350, 1351 (Trademark Trial & App. Bd. July 14, 2016).

²⁴ *Id.*; TMEP § 907; *In re PharmaCann LLC*, 123 USPQ2d at 1126.

²⁵ 21 U.S.C.S. § 811.

²⁶ *Id.* § 812; see Schedule I, U.S. DRUG ENF'T ADMIN., <https://www.dea.gov/drug-scheduling>.

²⁷ 21 U.S.C.S. § 811.

²⁸ U.S. CONST. art. VI, cl. 2.

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preemption under certain, limited circumstances; there is no preemption “unless there is a positive conflict between that provision of this title and that State law so that the two cannot consistently stand together.”²⁹ There is a “positive conflict” when it is “physically impossible” to comply with both the federal law and the state law.³⁰ Because state laws permitting the possession of cannabis do not *require* citizens to possess cannabis, there is not a positive conflict.

States can benefit from the legalization of cannabis, but it is still federally illegal, so federal trademark protection is unavailable for cannabis products. While there are state trademark registrations for cannabis products available in legal states, they are not only state-specific, but ineffective to protect cannabis brands. Because federal regulation of trademarks is based on Congress’ Commerce Clause power,³¹ the Supremacy Clause overrides these state protections. Thus, the inability to register trademarks for cannabis products at the state level results in cases like *Kiva*.³²

IV. The *Kiva* Decision

Not only does federal trademark registration fail to protect cannabis products, but state trademark protection is also ineffective either due to federal trademark rights—even if the state registrant is first in time. In *Kiva*,³³ plaintiff Kiva Health Brands (“Kiva Health”) began selling health and wellness foods in 2010 and the USPTO registered the Kiva mark in 2014 for food items.³⁴ In 2015 and 2016, Kiva Health obtained two more trademark protections to use the mark on additional food and

²⁹ 21 U.S.C.S. § 903.

³⁰ *Wyeth v. Levine*, 555 U.S. 555, 589 (2009).

³¹ See U.S. CONST. art. I, §8, cl. 3.; U.S. CONST. art. VI, cl. 2.

³² *Kiva*, 402 F. Supp. 3d 877.

³³ *Kiva*, 402 F. Supp. 3d 877.

³⁴ *Id.* at 881.

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cosmetic items.³⁵ Defendant Kiva Brands, Inc. (“Kiva Cannabis”) began selling cannabis-infused edibles in 2010 and obtained California trademark protection in 2018 for the sale of the edibles with the Kiva mark.³⁶

Around 2016, Kiva Health became aware that customers were confusing Kiva Health with Kiva Cannabis and worried that the confusion would hurt the company’s brand, as Kiva Health does not infuse their food products with cannabis like Kiva Cannabis does.³⁷ In 2018, Kiva Health issued a cease and desist letter to Kiva Cannabis.³⁸ Kiva Cannabis asserted it had common law rights to use the Kiva mark in California that predated Kiva Health’s USPTO registration.³⁹ When Kiva Cannabis continued to use the mark, Kiva Health sued for trademark infringement.⁴⁰

Kiva Health asserted that Kiva Cannabis products are all infused with cannabis, which is illegal under federal law and therefore ineligible for federal trademark protection.⁴¹ Although Kiva Cannabis sold products in California where cannabis is legal at the state level, state legality is irrelevant because cannabis is still an illegal schedule I drug under federal law.⁴² While Kiva Cannabis contended, as it must, that cannabis is federally illegal, the company asserted that the lack of federal trademark protection cannot trump state common law rights to the Kiva mark.⁴³

Kiva Cannabis cited *Stone Creek*,⁴⁴ a case that evokes the *Tea Rose-Rectanus* doctrine, providing that “common-law trademark rights extend only to the territory where

³⁵ *Id.* at 881.

³⁶ *Id.* at 881-82.

³⁷ *Id.* at 883.

³⁸ *Id.* at 883.

³⁹ *Id.* at 883.

⁴⁰ *Id.* at 883.

⁴¹ *Id.* at 888.

⁴² *Id.* at 889.

⁴³ *Id.* at 889.

⁴⁴ *Stone Creek, Inc. v. Omnia Italian Design, Inc.*, 875 F.3d 426, 436 (9th Cir. 2017).

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a mark is known and recognized, so a later user may sometimes acquire rights in pockets geographically remote from the first user's territory."⁴⁵ While federal trademarks receive nationwide protection, they do not extinguish the rights of common-law trademark holders.⁴⁶ Additionally, the Lanham Act provides that common-law trademark holders can assert legal and equitable defenses prior to the senior user's registration with the USPTO.⁴⁷ However, Kiva Cannabis did not contend that the *Tea Rose-Rectanus* doctrine applied, nor can it assert that its mark on a product that is federally illegal is a legal and equitable defense to Kiva Health's registration with the USPTO.⁴⁸

Kiva Cannabis next relied on *Headspace*,⁴⁹ a case that recognized a cannabis business's state trademark rights in Washington, where cannabis is legal. The *Kiva* Court distinguished *Headspace*: the Washington cannabis business asserted state trademark rights over another Washington cannabis business—"Headspace did not involve a company with a federal trademark bringing a claim of federal trademark infringement against a state-legal marijuana company."⁵⁰ Because Kiva Cannabis asserted common-law rights to the Kiva mark as a defense to Kiva Health's federal trademark claim, and the defense relies on prior use in commerce, Kiva Cannabis could not prevail because they did not make lawful use of the mark.⁵¹

V. Right of Publicity

⁴⁵ *Kiva*, 402 F. Supp. 3d at 889; *Stone Creek*, 875 F.3d at 436.

⁴⁶ *Kiva*, 402 F. Supp. 3d at 889.

⁴⁷ *Id.*; 15 U.S.C. §§ 1057(b), 1115(a)

⁴⁸ *Kiva*, 402 F. Supp. 3d at 890.

⁴⁹ *Headspace Int'l LLC v. Podworks Corp.*, 5 Wn. App. 2d 883, 428 P.3d 1260,1264 (Wash. Ct. App. 2018).

⁵⁰ *Kiva*, 402 F. Supp. 3d at 890.

⁵¹ *Id.* at 890-91.

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Cannabis products cannot benefit from trademark protections at the federal or state level due to federal illegality, so the solution must rest in other state protections that do not overlap with federal law. Thus, cannabis products can receive protection from right of publicity laws. At its core, the right of publicity protects an individual's privacy interest as well as the individual's inherent right to control the commercial use of their identity.⁵² The right is not limited to celebrities, it is the right of every human being to recover from an unauthorized commercial use of their identity or persona.⁵³

Using the right of publicity—based in state tort law—can protect cannabis brands because there is no corresponding federal right. Congress can regulate trademarks on the basis that they affect interstate commerce, but the Commerce Clause has no power in protecting one's privacy and persona—the “supreme” Congressional policy embodied in the Controlled Substances Act is irrelevant for sake of right of publicity protection. While federal courts do hear right of publicity cases, they do so under their diversity jurisdiction and follow Erie as well as its progeny in making their choice of law.

There is no question about legality with the right of publicity—there is nothing illegal about one's identity, and the right of publicity is what protects that identity. Whether or not a product in commerce is legal is a nonissue because the right of publicity protects one's personal integrity, not commerce. Therefore, when celebrities use their name, likeness, or persona to market a product, whether the product is legal is irrelevant. These celebrities have the right to control and profit off of their identities under the right of publicity and marking their products with aspects of their identity is

⁵² 1 THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY § 1.3 (2d ed. 1987).

⁵³ *Id* § 1.3.; See William L. Prosser, *Privacy*, 48 CAL. L. REV. 3, 413-14 (1960).

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within their right. The right of publicity prohibits others from profiting off the identities of these celebrities, so whether the product is legal is not relevant because the exploitation of the celebrity identity is what the right of publicity protects.

The right of publicity covers everything to do with identity and persona—names, nicknames, and any other identifiers—and protects against someone using such for personal gain.⁵⁴ Thus, there still is a commercial aspect to right of publicity in the sense that appropriation of one's identity injures the personal integrity of a person, including their finances. The right of publicity gives an individual the ability to control whether they profit from their identity, so another person who takes initiative to profit off the individual's identity hurts the individual's autonomy because it hurts their ability to receive financial profit from their identity. The individual loses on profits that they have the right to control. Thus, it is more likely for celebrities to have a cause of action for right of publicity, rather than noncelebrities, because their identities are more likely to be profitable, as celebrity identities are recognizable and therefore can better attract consumers.

The right of publicity is a distinct legal category that grew from right of privacy, which all states recognize statutorily or at common law.⁵⁵ The right of privacy has become difficult to grasp because of its ever-evolving definition but generally is the "right to be let alone."⁵⁶ However, the ideal plaintiff for a right of privacy action is one who is relatively unknown, one whose injury is the mental anguish of a privacy invasion. There is difficulty applying the right of privacy to celebrities with known, public personas—they do not wish to bring action because of the exposure of identity, but

⁵⁴ William L. Prosser, *Privacy*, 48 CAL. L. REV. 3, 401-05 (1960).

⁵⁵ *Id.* § 1.2

⁵⁶ *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 561 (1902)

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because they want to control when, where, and how others commercialize their identity in order to protect personal integrity, not commerce.⁵⁷ Thus, states began to recognize the right of publicity either at common law or by statute, or a combination with components from both. Today, over 30 states have right of publicity laws for living persons, and about 20 states recognize a post-mortem right of publicity appropriation of the identity of the deceased.⁵⁸ Because right of publicity laws vary by state, the choice of law that applies is the law in the state where the individual is domiciled.⁵⁹

Among the states with the most developed right of publicity statutes is California.

California law § 3344 provides:

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof.⁶⁰

⁵⁷ McCARTHY, *supra* note 50, § 1.7

⁵⁸ *Id.* § 1.2

⁵⁹ See Milton H. Greene Archives, Inc. v. Marilyn Monroe Ltd. Liab. Co., 692 F.3d 983, 990 (9th Cir. 2012) (prohibiting Marilyn Monroe's descendants from profiting off her identity because she was domiciled in New York at the time she died, where there is no post-mortem right of publicity).

⁶⁰ CAL. CIV. CODE § 3344(a).

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The person who violates the statute is liable for the amount equal to the actual damages the injured party suffers from unauthorized use and any profits that are attributed to the unauthorized use that are not taken into account with the actual damages.⁶¹ The statute also does not only protect celebrities—even if there are no actual damages, the injured party receives a minimum of \$750 from the party in violation.⁶² A party need not obtain consent to use another’s name, voice, signature, photograph, or likeness for connection with news, public affairs, or sports broadcast or account, or any political campaign.⁶³

In addition to the statutory right of publicity, California also recognizes a common-law right. In 1983, actor Clint Eastwood sued the National Enquire tabloid for publishing an article alleging that Eastwood was involved in a “love triangle.”⁶⁴ Eastwood never submitted to an interview, but the Enquire used his name and photograph to publish a story about his romantic involvement with two other celebrities.⁶⁵ To establish a right of publicity cause of action, one would have to allege in complaint: “(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”⁶⁶ Eastwood claimed that the Enquire violated his right of publicity because it published a false front-page article featuring Eastwood’s name and photo without his consent and profited off of tabloid sales.⁶⁷

The Court contended that the Enquire did use Eastwood’s persona to attract consumers’ attention, gaining a commercial advantage from not only Eastwood’s fame,

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.* § 3344(d).

⁶⁴ Eastwood v. Superior Court, 149 Cal. App. 3d 409, 414 (1983).

⁶⁵ *Id.*

⁶⁶ *Id.* at 417.

⁶⁷ *Id.* at 418.

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but also from the allegedly false scoop on his romantic life.⁶⁸ Although the Enquire contended that § 3344(d) carves out an exception for lack of consent for news and public affairs, the Court rejected the argument, holding:

We do not believe that the Legislature intended to provide an exemption from

liability for a knowing or reckless falsehood under the canopy of “news.”

We

therefore hold that Civil Code section 3344, subdivision (d), as it pertains to news,

does not provide an exemption for a knowing or reckless falsehood.⁶⁹

Thus, the exception for newsworthy content does not apply to the Enquire, and it could infringe upon Eastwood’s right of publicity due to the fact that the Enquire used his name and image without his consent to attract more consumers and gain profit.

The right of publicity law in California allows a deeper protection than trademark in one aspect—it protects one’s name and likeness as well as the individual’s decisions not to evoke their name and likeness. In *Abdul-Jabbar*, formal basketball player Kareem Abdul-Jabbar sued General Motors for using his former name “Lew Alcindor” in a commercial advertisement without the consent of Abdul-Jabbar.⁷⁰ The basketball star was born Ferdinand Lewis “Lew” Alcindor and played basketball under the name Lew Alcindor throughout his college career and into his early years in the NBA.⁷¹ He

⁶⁸ *Id.* at 420.

⁶⁹ *Id.* at 425.

⁷⁰ *Abdul-Jabbar v. GMC*, 85 F.3d 407, 409 (9th Cir. 1998).

⁷¹ *Id.* at 409.

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converted to Islam, and after he legally changed his name to Kareem Abdul-Jabbar had not used his birthname commercially for ten years.⁷²

The district court held that the use was permissible under trademark law, and that Abdul-Jabbar had abandoned his former name due to nonuse.⁷³ The Ninth Circuit disagreed:

[A]n individual's given name, unlike a trademark, has a life and a significance quite apart from the commercial realm. Use or nonuse of the name for commercial purposes does not dispel that significance. An individual's decision to use a name other than the birth name—whether the decision rests on religious, marital, or other personal considerations—does not therefore imply intent to set aside the birth name, or the identity associated with that name.⁷⁴

The Court held that the fact that General Motors appropriated Abdul-Jabbar's identity by using his former name even though it had not been in use—the right of publicity not only protects a public figure's right to exploit their identity but also protects the decision not to use their name or identity for commercial purposes.⁷⁵

⁷² *Id.* at 409.

⁷³ *Id.* at 412.

⁷⁴ *Id.* at 412.

⁷⁵ *Id.* at 415.

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The East coast is home to a number of public figures as well, leading to the development of right of publicity laws. New York recognizes a common law right of publicity as well as a statutory right that is codified within the right of privacy statute.

New York civil law § 51 provides:

Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait, picture or voice, to prevent and restrain the use thereof.⁷⁶

The statute protects two distinct interests—first, the right of a private individual to protect against feelings of embarrassment if one uses the individual’s identity for trade and subjects the individual to an unwelcome thrust into publicity.⁷⁷ Second, the right protects public figures from others who appropriate the publicity value of the names and reputation of such public figures.⁷⁸

New York’s right of publicity extends to situations where the individual bringing the action does not have to be a competitor of the defendant. In 1973, actor Cary Grant asserted his right of publicity when *Esquire Magazine* republished a photo of his face

⁷⁶ NY CLS CIV. R. § 51

⁷⁷ See *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 880-81 (S.D.N.Y. 1973)

⁷⁸ See *id.* at, 880-81.

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from a former 1946 issue on top of a sweater-clad model's body in the 1971 issue.⁷⁹

Grant was not a fashion model nor did he ever sanction the commercial use of him as a photographic model.⁸⁰ The Court recognized that there may have been a first-time value that would come with the actor's debut into modeling, which diminishes with use.⁸¹ However, Grant did not want anyone—including himself—to profit off the publicity value of his name and reputation, meaning, he had no future intentions of reserving his debut as a fashion model for his own commercial gain.⁸²

Esquire contended it had the right to make use of the 1946 photo, but the court rejected the argument, stating that the magazine cannot “convert the original permission into a perpetual license to use the celebrity as an unpaid professional model.”⁸³ The Court held that Esquire did not have the right to appropriate Cary Grant's identity as a professional model without paying for such benefit, even though Grant had no intentions of using his identity to launch a modeling career himself.⁸⁴

VI. Celebrity Use of Right of Publicity for Cannabis Products

The right of publicity exists only at the state level—each state either has an explicit right of publicity statute or some type of common law right, but there is no federal cause of action.⁸⁵ The right of publicity differs from trademark law in that the Lanham Act, a federal statute, governs trademark protection, but there is no

⁷⁹ *Id.* at 877.

⁸⁰ *Id.* at 881.

⁸¹ *Id.* at 881.

⁸² *Id.* at 880.

⁸³ *Id.* at 884.

⁸⁴ *Id.* at 883-84.

⁸⁵ McCARTHY, *supra* note 50, § 1.2.

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overarching federal statute that governs the right of publicity. Therefore, the reasoning behind the *Kiva* decision does not transfer over to the right of publicity—there is no federal statute to rally against and inevitably squash state protection. Moreover, the right of publicity does not conflict with the federal illegality of cannabis because it protects personal integrity, rather than commerce. Therefore, public figures have the choice to market cannabis products using aspects of their identity and others cannot infringe upon that right but using the public figure’s identity to market products that are out of the control of the public figure. Additionally, companies that do not have the right to profit off the celebrity identity cannot market any products using the celebrity’s persona, even if the products do not compete with the celebrity products, because the cause of action is that the appropriating company injures the personal integrity of the celebrity, including the celebrity’s choice whether to profit of their identity.

Celebrities have taken tremendous advantage of right of publicity laws with regards to cannabis products. In 2015, rap musician and marijuana-enthusiast Snoop Dogg released his very own line of cannabis products in Colorado, “Leafs by Snoop.”⁸⁶ The line included eight different kinds of cannabis flower as well as cannabis-infused edibles and concentrates.⁸⁷ However, Snoop Dogg is not a Colorado resident, and therefore, does not legally own the brand.⁸⁸ The company Beyond Broadway, also known as “LivWell,” is the official owner and is responsible for cultivating the cannabis plants as well as producing the edibles and concentrate.⁸⁹ Even though Snoop Dogg is not the official owner of the cannabis company, he still benefits from the right of publicity

⁸⁶ Joanna Plucinska, Snoop Dogg Just Launched His Own Brand of Pot, TIME (Nov. 11, 2015 3:27 AM), <https://time.com/4107828/leafs-by-snoop-dogg-marijuana-weed-cannabis/>.

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

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with regards to Leafs by Snoop products because his name and persona are still attached. Beyond Broadway does not violate the right of publicity—Snoop Dogg authorized the company to produce products under his name.

Calvin Cordozar Broadus Jr. may be the rapper's birth name, but Snoop Dogg is a persona with worldwide recognition. When one reads a cannabis label that states "Leafs by Snoop," the rapper Snoop Dogg, who has contributed dozens of odes to marijuana in the music industry, immediately comes to mind. Additionally, Snoop Dogg has spent decades in the music industry building his identity, at times going by alternate names such as "Snoop Doggy Dogg" and "Snoop Lion." Snoop Dogg has since abandoned his alternate names, so he cannot benefit from federal trademark protection for such names. However, Snoop lives in California, where the right of publicity law protects the public figure's choice not to use former names for commercial benefit under *Abdul-Jabbar*. Thus, in California, he can prevent the sale of products in California that brandish his alternate names as well.

Snoop Dogg may be a pioneer—a celebrity "cannapreneur"⁹⁰—but he is not the only one who has used their persona in the cannabis market. In 2015, musician and marijuana-activist Willie Nelson established "Willie's Reserve," a cannabis production company that attaches Nelson's likeness and persona to cannabis products.⁹¹ The Willie's Reserve website emphasizes the role of the farmer as well as the mission behind the company: "for decades, as Willie and his band travelled from town to town, pot enthusiasts flocked to his shows, their pockets stuffed with offerings from their home

⁹⁰ See Adriana Kertzer, *Celebrity Cannapreneurs: 16 Celebrities Cashing in on the Green Revolution*, MEDIUM (May 30, 2018), https://medium.com/@adriana_kertzer/celebrity-cannapreneurs-78a801b3d945 (discussing the changing aesthetics of the cannabis industry and celebrity involvement as "cannapreneurs" who attach their personal brand to cannabis products).

⁹¹ *Id.*

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gardens and local communities. They happily shared their bounty. And Willie gladly returned the favor.”⁹²

The right of publicity likely has broad coverage with regards to Nelson’s widely known cowboy, Western aesthetic. He is one of the most recognizable country artists who has acted in over 30 films, coauthored books, and is on the advisory board of the National Organization for the Reform of Marijuana Laws. Willie’s Reserve products feature branding that resembles western saloon signage, incorporating Nelson’s aesthetic.⁹³ Because Western imagery, as well as cannabis itself, are so closely linked to Willie Nelson’s persona, the right of publicity could apply if another cannabis company incorporated such identifying aspects onto its products.

While some cannapreneurs simply authorize the use of their persona in connection with the sale of cannabis products, others opt for a more hands-on role. Actor Jim Belushi is the owner and farmer of Belushi’s Farm along the Rogue River in Oregon.⁹⁴ In 2020, Discovery produced a three-episode docuseries that dives into Belushi’s cannabis business where the actor has a place in operations at each level—he cultivates his cannabis with intense rigor. He visited Columbia to research strains of cannabis for his farm.⁹⁵ He sings and plays harmonica to the cannabis plants.⁹⁶ He even bestows names upon his plants.⁹⁷ Belushi states, “I study the plant, I

⁹² Story, WILLIE’S RESERVE, <https://williesreserve.com/story> (last visited Nov. 25, 2020).

⁹³ Kertzer, *supra* note 86.

⁹⁴ BELUSHI’S FARM, <https://www.belushisfarm.com/belushisfarm> (last visited Nov. 25, 2020).

⁹⁵ Javier Hasse, Jim Belushi’s Path From Cannabis Farming To Reality TV, FORBES (Aug. 11, 2020), <https://www.forbes.com/sites/javierhasse/2020/08/11/jim-belushi-cannabis-tv-show/?sh=597451de56f7> (interview with Jim Belushi).

⁹⁶ *Id.*

⁹⁷ *Id.*

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study the cultivars, the nutrients and the history, so I can own what my relationship is with them.”⁹⁸

Belushi has cultivated his own signature brands embodying multiple strains from his farm. His premium brand is Belushi’s Secret Stash, comprising over a dozen strains of flower representing what the actor has in his private vault.⁹⁹ However, his Blues Brothers brand is much more personal. In 1978, comedians Dan Aykroyd and John Belushi, Jim’s late brother, formed the soul band the Blues Brothers as part of a Saturday Night Live Musical Sketch. They spawned an album as well as a comedy film featuring the duo.

John Belushi died in 1982 of a drug overdose,¹⁰⁰ but the Blues Brothers band lives on. Jim Belushi had filled John’s place beside Aykroyd on SNL as “Zee” Blues and has since honored his late brother by performing with the band on tour.¹⁰¹ Based on Belushi’s passion for the power of music and his persona as Brother Zee, the cannabis brand embodies the spirit of forty years of the Blues Brothers living on through the music they bring to audiences. Belushi cultivated the brand to live up to the Blues Brothers standard, Belushi’s Farm states, “[i]n delivering superior experiences to audiences, The Blues Brothers established a level and standard of undisputed high quality. The promise of the Blues Brothers brand for cannabis is just that: to deliver the best possible stimuli to our endo-cannabinoid receptors.”¹⁰²

Belushi himself draws a link between the quality of a Blues Brothers performance and the quality of the Blues Brothers cannabis line. When one recalls the Blues

⁹⁸ *Id.*

⁹⁹ BELUSHI’S FARM, <https://www.belushisfarm.com/belushisfarm> (last visited Nov. 25, 2020).

¹⁰⁰ Robert W. Stewart, Either of 2 Drugs Could Have Killed Belushi—Coroner, L.A. TIMES (Sep. 12, 1985).

¹⁰¹ BELUSHI’S FARM, <https://www.belushisfarm.com/belushisfarm> (last visited Nov. 25, 2020).

¹⁰² BELUSHI’S FARM, <https://www.belushisfarm.com/belushisfarm> (last visited Nov. 25, 2020).

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Brothers, there is forty years of history to reflect on. The image and sound of the Belushi family immediately comes to mind. Jim Belushi currently performs for real-life audiences as his persona, Zee Blues. The right of publicity protects Belushi's choice to profit off of his name as well as his persona as Brother Zee. The right of publicity also protects Belushi's choice not to profit off of his identity and persona. For example, a farmer cannot sell produce called "Belushi's Apples" or "Blues Brothers Pears," even though Jim Belushi does not sell produce. Belushi controls his identity as Jim Belushi and persona as Brother Zee. Just as Belushi has the choice to profit off his name while selling cannabis products, he also has the choice not to profit off his name by not selling produce from Belushi's Farm. Thus, the Belushi name attached to his cannabis products adds great value that Jim Belushi may reap, and whether or not he chooses to expand his horizons as a farmer is entirely within his choice for how he wants to commercialize his identity.

Jim Belushi is not the only cannapreneur taking advantage of marketing cannabis products using an on-screen persona: "Steve Urkel" actor Jaleel White launched the cannabis brand ItsPurpl featuring variants of the cannabis strain "Purple Urkle."¹⁰³ The Steve Urkle character from the sitcom *Family Matters* is a cultural touchstone—the image of the quintessential nerd with thick glasses, multi-colored cardigans, and "flood" pants, held up by suspenders immediately comes to mind. White evokes his character by branding his cannabis line with the purple countenance of Steve Urkel, as he

¹⁰³ Lindsay Bartlett, 'Steve Urkel' Actor Jaleel White Launches Purple Urkle Cannabis Brand With 710 Labs, *FORBES* (Apr. 12, 2021, 2:20 PM), <https://www.forbes.com/sites/lindsaybartlett/2021/04/12/steve-urkel-actor-jaleel-white-launches-purple-urkle-cannabis-brand-with-710-labs/?sh=4d7258be65a1>.

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appeared on *Family Matters*, on sleek, black packaging. Not only does White have control over his own, personal identity, but also his televised persona.

Just as well as celebrities may market cannabis products under a televised persona, the right of publicity also protects against the use of one's unauthorized use of a televised persona. On July 12, 2021, film and television actor Sacha Baron Cohen filed a complaint against cannabis company Solar Therapeutics, Inc. for violating his right of publicity by using a photo and catchphrase of the actor's character "Borat" to advertise the sale of Solar Therapeutics' cannabis products.¹⁰⁴ The Borat character is Sacha Baron Cohen's film persona and using Borat's image implies that Baron Cohen himself endorses these cannabis products. The unauthorized use of the character has a material effect on the actor, hurting his reputation, as Baron Cohen has "never used cannabis in his life."¹⁰⁵ No matter the difference in appearance or personality, it is easy to conflate the characters with the actors they play—the unauthorized use of a character can harm the reputation of the actor. Thus, the right of publicity protects on-screen personas in addition to the identity of actors themselves.

VII. Alternative to Trademarks: Right of Publicity to Protecting Cannabis Product Branding

The right of publicity applied to product branding is a different legal theory but has the same effect as a trademark. Trademark and right of publicity protection both allow one to establish, grow, and invest in a brand. A product with trademark or right of publicity protection prevents others profiting off the product's brand. Trademark and

¹⁰⁴ Complaint at 1, 2, *Cohen v. Solar Therapeutics, Inc.*, No 1:21-cv-11139-DJC (D. Mass. July 12, 2021)

¹⁰⁵ *Id.* at 2.

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right of publicity product protection both ensure that consumers have a brand that is safe, as there is accountability—brands have incentive to uphold their reputations by maintaining quality and consistency. Both legal theories have the goal of protecting the integrity of the brand by prohibiting others from using the brand name to lure in consumers and allowing them to purchase an inferior product.

While most causes of action are for celebrities, the right of publicity is the right of every individual to control the commercialization of their identity.¹⁰⁶ The term “celebrity” is elusive because whether one is a celebrity varies from person to person.¹⁰⁷ For example, on the increasingly popular platform Tik Tok, American dancer and social media personality Charli D’Amelio has the greatest following with 77 million followers and is instantly recognizable to most members of Generation Z who populate the platform. However, many older people removed from the internet probably do not know of her existence. Thus, due to the subjectivity of “celebrity,” the right of publicity is still available for noncelebrities.¹⁰⁸

The right of publicity is a timely remedy: in the age of influencer marketing, brands often promote their products using social media influencers—individuals who develop themselves as brands and receive sponsorships to promote products to their large social media following. Influencer marketing is a highly effective way for companies to market their products:

[I]nfluencers strive to be authentic, consumers cite authenticity as driving their

¹⁰⁶ See McCARTHY, *supra* note 50.

¹⁰⁷ See *id.* § 4.2 (discussing the difficulty of defining who is a celebrity”).

¹⁰⁸ See *id.* § 4.6 (the right of publicity availability for noncelebrities is the majority view).

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engagement with influencer content, and companies partner with influencers to link their products with trusted sources. And brands employ influencer marketing because it works. Influencer ads generate greater emotional intensity and higher memory encoding. One agency found companies earned an impressive 520% return on every dollar they spent on influencer marketing.¹⁰⁹

Cannabis companies can receive effective brand protection by enlisting influencers to market cannabis products. Not only is influencer marketing an effective form of advertising, but cannabis companies would also be taking advantage of the right of publicity by attaching influencer personas to cannabis products. Because the right of publicity protects the identity and persona of the individual, it also protects the authorized use of the persona of the influencer to brand cannabis products.

Cannabis companies do not necessarily have to enlist influencers to receive brand protection, they can make anyone the “face” of the cannabis brand—so long as the individual authorizes the use—and receive protection from the right of publicity. Because the company obtained consent from the “face,” the company may market using identifying aspects of that individual and obtain protection from the right of publicity. If any other company tries to appropriate the individual’s identity on its products, it infringes upon the right of publicity, because it does not have the right to control and profit off the individual’s persona.

¹⁰⁹ Alexandra J. Roberts, False Influencing, 109 Geo. L.J. 81, 84 (2020).

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For dispensaries, there are individuals who could be readily available as faces of the dispensary—the budtenders. Budtenders carry their own reputation and following themselves. Turning back to example of personal trainers at a gym, they are employees but have their own reputations and, at times, receive their own following. Gym members may have joined a certain studio based on desire for training from a particular trainer, called “Marvelous Melissa” that has a reputation for professionalism and effectiveness. Thus, it would be unfair for a competing gym to advertise as having personal trainers who use the “Marvelous Melissa” method, as they are using her name and persona for commercial gain without her consent. While Marvelous Melissa cannot gain trademark protection, she has the right to prevent others from profiting off her name and likeness in order to protect her personal integrity.

Like trainers at a gym, people may frequent dispensaries because of preference for certain budtenders, and both dispensaries and budtenders can use that to their advantage. With a budtender’s consent, dispensaries can brand cannabis products with the name, likeness, and persona of the budtenders, and it would receive protection from the right of publicity. Another dispensary cannot appropriate the identity of this budtender for branding its own cannabis products, because the budtender did not consent to another dispensary profiting off their identity.

With the unavailability of trademarks at the federal and state level, cannabis companies and dispensaries must use a different means to reach the same end—by using the right of publicity. Celebrities have tapped into the cannabis market in a way that noncelebrities have failed to do by utilizing the legal theory. While the right of publicity may seem unattainable due to lack of celebrity status, the right of publicity is a

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human right—a right every individual has to control the commercialization of their identity. Using the right that protects personal integrity, not commerce, has the ability to defeat not only the *Kiva* decision, but the trademark challenge due to federal illegality of cannabis itself.