SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

SPIKE LEE, an individual, Plaintiff, v. VIACOM, INC., a Delaware corporation; MTV NETWORKS, a division of defendant Viacom, Inc.; THE NEW TNN: THE NATIONAL NETWORK; a unit or division of defendant MTV Networks; and ALBIE HECHT, an individual; and DOES 1-20, Defendants.	X : : : : : : : : X	Index No.

PLAINTIFF'S MEMORANDUM OF LAW IN SUPPORT OF PRELIMINARY INJUNCTION

I. INTRODUCTION

Plaintiff Spike Lee respectfully requests that this Court enjoin defendants from unfairly and unlawfully trading on his name and hard-earned reputation for defendants' commercial gain. Faced with sagging ratings for their cable television network "TNN: The National Network," defendants recently announced that they will rename their network "Spike TV," to take effect as of June 16, 2003. Defendants decided to change the network's name with the direct intention of capitalizing on the name recognition that plaintiff Spike Lee -- one of the leading African-American filmmakers, a well-known actor, commercial personality, and N.Y. Knicks fan, who has been dubbed by Interview Magazine as one of a handful of celebrities who is a "household name" and "a

II. STATEMENT OF FACTS

A. Spike Lee is Widely Known as a Filmmaker, Actor and Television Personality

Spike Lee is an acclaimed filmmaker, writer, producer, director and actor. He is repeatedly referred to as a prominent and important filmmaker, such as the following: "the most important African-American filmmaker of his generation"; "not only one of the best filmmakers in America, but one of the most crucially important"; "the most visible and influential black filmmaker of this past century"; "one of Hollywood's most important and influential filmmakers in the past decade"; "one of the greatest living directors"; "one of America's premier directors. Affidavit of Jonathan Lubell ("Lubell Aff") ¶5; Affidavit of Thomas N. Hansen ("Hansen Aff") ¶10; Affidavit of Ossie Davis ("Davis Aff") ¶9; Affidavit of Nelson George ("George Aff") ¶4; Affidavit of William W. Bradley ("Bradley Aff") ¶4; Affidavit of the Rev. Dr. Calvin O. Butts, III ("Butts Aff") ¶6; Affidavit of Mildred Bond Roxborough ("Roxborough Aff") ¶¶5, 6; Affidavit of Edward Norton ("Norton Aff") ¶3. Spike Lee has directed and produced more than twenty-five films, including *She's Gotta Have It, School Daze, Do The Right Thing, Jungle Fever, Malcolm X, Crooklyn, Clockers, Girl 6, 4 Little Girls, He Got Game, Summer of Sam, The Original Kings of Comedy, Bamboozled,* and the recent *25th Hour.* Affidavit of Spike Lee ("Spike Lee Aff") ¶¶9, 13A, 13B; Lubell Aff ¶6. He has received numerous film awards, including Academy Award nominations. Spike Lee Aff ¶9; Lubell Aff ¶7, Exh A12. For nearly every one of Lee's films, Lee has received substantial media attention. Lubell Aff ¶8, Exh A13.

Not only is plaintiff Spike Lee known for his film directing and writing, but he is also well known for his public persona and image, both as an actor and as himself.

Plaintiff Spike Lee has appeared as an actor in numerous films, both by Spike Lee and by other directors. Lubell Aff ¶9.

With respect to television, Spike Lee is well-known as a television personality. He has appeared regularly on television shows – as himself – and also is featured in television commercials, as himself. Spike Lee Aff ¶12; Lubell Aff ¶10, Exh A14. For example, in a widely disseminated advertising campaign beginning in 1988 promoting Nike's Air Jordan basketball shoe, Spike Lee was featured with the basketball star Michael Jordan, with Lee as an aggressive, fast-talking, irreverent character. This advertising campaign was one of Nike's most popular ad campaigns. Lubell Aff ¶10.

Spike Lee's work is also directed towards television. In addition to Spike Lee's television appearances in commercials and on television shows and films, he is well-known as a director and producer of widely acclaimed television shows, films and segments. His work for television includes: *4 Little Girls*, an Emmy- and Oscar-nominated documentary for HBO, about a civil rights era bombing of a Birmingham church; an HBO/Real Sports segment on Georgetown's John Thompson, which received an Emmy award (1995); an HBO/Real Sports segment on Mike Tyson (1991); comedian John Leguizamo's Broadway show, *Freak* for HBO (1998); *Pavarotti & Friends* for PBS' Great Performances (1999); *A Huey P. Newton Story* for BET cable channel (2001); several Art Spot Shorts for MTV (1989); short films for *Saturday Night Live* (1986); and public service announcements featuring Michael Jordan for the United Negro College Fund, called *Two Michaels*. In 2000, Lee signed a development deal with Studios USA to create both dramatic and humorous television series. Lubell Aff ¶¶11, 13; Exhs A15, A17.

Spike Lee's work for television is so well-known that some news articles have referred to news about plaintiff Spike Lee's work for television as "Spike TV." Lubell Aff ¶14, Exh A18.

Plaintiff Spike Lee is also well-known as a director and producer of music videos, which are regularly shown on television. He has directed and produced music videos for famous artists such as Miles Davis, Michael Jackson, Tracy Chapman, Anita Baker, Chaka Khan, Public Enemy, Bruce Hornsby and Naughty by Nature. Spike Lee Aff ¶10; Lubell Aff ¶15, Exh A19.

Plaintiff Spike Lee is also well-known as an author of six books on filmmaking and other topics. Spike Lee Aff ¶11; Lubell Aff ¶16, Exh A20. In addition, numerous books have been written about Spike Lee and his work. Lubell Aff ¶17, Exh A20.

Plaintiff Spike Lee is well-known solely by his first name, Spike, in both the entertainment industry and to the general public. In the entertainment industry, he is often referred to by his first name only. Spike Lee Aff ¶7; Hansen Aff ¶12; Affidavit of Keith Reinhard ("Reinhard Aff") ¶7; Norton Aff ¶4; Lubell Aff ¶18.

Spike Lee recently started a full service advertising agency using just his first name. The agency is Spike/DDB (in partnership with a well-known advertising agency, DDB Needham). Lubell Aff ¶18, Exhs A21, A22. This illustrates how widely Spike Lee is known by just his first name, and that plaintiff selected the name "Spike" for the agency because of the wide name recognition of plaintiff by his first name. Spike Lee Aff ¶8; Reinhard Aff ¶¶7, 8.

B. Defendants, Faced with Sagging Ratings, Decide to Rename TNN as "Spike TV" in Part Because of its Connotation of Plaintiff Spike Lee

Defendants Viacom, MTV Networks and TNN have been faced with dropping ratings for TNN for years. Two years ago, defendants renamed TNN, which originally was known as "The Nashville Network," as "The New TNN: The National Network," in order to combat sagging viewership. This attempt was unsuccessful, and ratings have continued to drop. For the first quarter of 2003, TNN's ratings were down 16% from the same period in 2002, and TNN dropped from the eighth most popular basic cable to station to the fourteenth most popular. Lubell Aff ¶¶19, 20; Exhs A23, A24.

On April 15, 2003, in order to combat these sagging ratings, defendants Viacom, MTV Networks, TNN and Hecht held a conference call with national consumer, trade and business media, in which Hecht stated that TNN would change its name to "SPIKE TV," to begin on June 16, 2003. Lubell Aff ¶21, Exh A25. In this conference call and in interviews with the media, Hecht explained that defendants chose the word "Spike" as part of the proposed new name for TNN because of the audience recognition of plaintiff Spike Lee, and to trade on the public recognition of plaintiff Spike Lee, in the expectation that association with acclaimed director and filmmaker Spike Lee would increase ratings and reviews. For example, Hecht stated that his role models for the name "Spike TV" included film director Spike Lee. Lubell Aff ¶27, Exh A26.

Hecht stated that one of the reasons for the selection of the name "Spike" for the new network was that "we just like the idea of having a guy's name." Hecht also stated that defendants chose the "Spike TV" name because defendants "were looking for a name that would reflect the attitude that we wanted a smart, sexy, active, irreverent, slightly aggressive and unapologetically male." In defendants' press release announcing the

name change and the conference call, defendants state: "Spike TV captures the attributes and essence of what we want the first network for men to be. It's unapologetically male; it's active; it's smart and contemporary with a personality that's aggressive and irreverent. It's a name we feel our audience will get and make a connection with. I like Spike!" Lubell Aff ¶23, Exh A25. As discussed immediately below (pp.6-8), the adjectives used by defendants to describe Spike TV are exactly those adjectives that have been publicly used to describe plaintiff Spike Lee, demonstrating that defendants chose the name "Spike TV" to trade on the association with Spike Lee.

C. Defendants' Description of Spike TV is the Exact Manner in Which Spike Lee is Described

Defendants described Spike TV as having a "guy's name" and a "personality" that is "aggressive," "irreverent," "unapologetically male," and "smart and contemporary." These adjectives have repeatedly been used to describe Spike Lee.

Spike Lee has often been referred to with the adjective "aggressive," including: Spike "hardly lets up on his tense, aggressive hectoring manner"; "Lee's storytelling is tense, aggressive and true"; "This Spike Lee masterpiece [*Do The Right Thing*] is the most ingenious movie imaginable dealing with topics such as racism . . . caring – aggressive – irritated – sad"; "The famously prickly, combative, provocative, even surely Spike Lee." Lubell Aff ¶28; Exhs D1, D2, D3, D4.

He has often been referred to with the adjective "irreverent," including: "When asked what he would do to combat violence in the United States, the always irreverent filmmaker, Spike Lee was quoted . . . ."; "he stages his tantalizing characterizations with an irreverent forcefulness"; "To NBA fans when they find out Lee is producing a series of irreverent television promotional spots"; "Lee to receive Maverick Spirit Award."

Lubell Aff ¶29; Exhs E1, E2, E3, E4.

Spike Lee has often been referred to as unapologetically male or similar adjectives, including: "Fight the power could easily be Spike Lee's personal motto"; "Male bonding drives this Bus ["*Get on the Bus*"] to the march"; "Director Spike Lee's larger aim is ... the group dynamics of that masculine, insular . . . ."; In *Summer of Sam*, Spike Lee "arouses the neighborhood enmity by working in a male strip club"; Spike Lee was recruited by the Navy to direct TV advertising spots; the National Football League hired Spike Lee to put together a massive television advertising campaign for the NFL; "Spike Lee's movies have always offered [serious well written roles for male characters] . . . . black men empowering themselves"; "One of New York's most famous superfans." Lubell Aff ¶30, Exhs F1, F2, F3, F4, F5, F6, F7, F8.

D. The Public Associates Spike Lee with "Spike TV"

Numerous members of the public believe that the name "Spike TV" used as TNN's proposed new name is because of an association with Spike Lee. Spike Lee Aff ¶6; Davis Aff ¶13; Affidavit of Leila McDowell ("McDowell Aff") ¶¶4, 6; Affidavit of Ronald V. Dellums ("Dellums Aff") ¶4; Reinhard Aff ¶¶11, 14; George Aff ¶¶5, 6; Hansen Aff ¶13; Norton Aff ¶5; Bradley Aff ¶6; Roxborough Aff ¶¶8, 9; Butts Aff ¶¶10, 11; Lubell Aff ¶25. In addition, media stories about defendants' proposed name change for TNN demonstrated that the public would associate plaintiff Spike Lee with the proposed new name for the network, as these stories referred to plaintiff Spike Lee. For example, an Associated Press news article about the proposed name change had the following lead sentence: "Spike is no longer just the name of a famous film director." Lubell Aff ¶25, Exhs B1, C1, C2.

E. Defendants Refuse to Cease and Desist

Plaintiff Spike Lee first learned about defendants' plan on or about April 15, 2003. Spike Lee did not give permission to defendants to use his name in connection with their TNN network. Spike Lee Aff ¶4. On April 28, 2003, plaintiff's counsel sent a cease and desist letter to defendants. On May 8, 2003, defendants responded, refusing to alter their decision to rename TNN as "Spike TV," stating that the reason for the selection of the name was because it referred to a type of athletic shoe – contradicting prior public statements by Hecht that the reason the name was picked was because it was a man's name. Lubell Aff ¶26, Exh C4.

III. ARGUMENT

A. Preliminary Injunction Should Issue Enjoining Defendants from Using the Name "Spike/TV"

A preliminary injunction should issue because, as shown below, plaintiff Spike Lee is likely to prevail on his claim that defendants have misappropriated his name and identity without his consent and used it in a misleading fashion, under N.Y. Civil Rights Law §§ 50 and 51, N.Y. Gen. Bus. Law § 133, and under New York unfair competition law. Under Civil Rights Law §§ 50 and 51, the showing that plaintiff Spike Lee is likely to prevail on the merits is alone sufficient to support a preliminary injunction.

In any event, an injunction should issue, under Civil Rights Law §§ 50 and 51, under Gen. Bus. Law § 133, and under New York unfair competition law because Spike Lee has also met the other requirements for a preliminary injunction under CPLR 6301: irreparable harm if the injunction is denied, and a balance of the equities in favor of granting the injunction. *Aetna Ins. Co. v. Capasso*, 75 N.Y.2d 860, 862, 552 N.E.2d 166, 167, 552 N.Y.S.2d 918, 919 (1990); *Archdiocese of Ethiopian Orthodox Church in U.S.*

and Canada, Inc. v. Yesahaq, 232 A.D.2d 332, 333, 648 N.Y.S.2d 605, 606 (1st App. Dep't 1996). As shown below (pp. 22-23, infra), Spike Lee will suffer irreparable injury if defendants are permitted to use his name to advertise and promote their cable channel, removing from his control the public's view of his hard-earned reputation and goodwill. Spike Lee thus is entitled to a preliminary injunction that enjoins defendants from using the name "Spike" in connection with their television network. The balance of equities favors plaintiff because of the irreparable harm in the absence of an injunction, and because any harm to defendants will be from their own wrongdoing, it will be minimal, and it will be solely economic.

1. Spike Lee Has Shown A Likelihood of Success on The Merits

a. Spike Lee Is Likely to Prevail on His Claim Under Civil Rights Law §§ 50 and 51

Civil Rights Law §§ 50 and 51 bar the use of a person's name for advertising or trade purposes without the person's prior written consent, and provide for damages and automatic injunctions.[1] The statutes offer protection not merely to a person's "property interest" in their name, portrait or picture, but is "designed to protect a person's identity." *Cohen v. Herbal Concepts, Inc.* 63 N.Y.2d 379, 384, 472 N.E.2d 307, 309, 482 N.Y.S.2d 457, 459 (1984); *see also Onassis v. Christian Dior-New York, Inc.*, 122 Misc.2d 603, 612, 472 N.Y.S.2d 254, (Sup. Ct. 1984) ("While the statute may not, by its terms, cover voice or movement, characteristics or style, it is intended to protect the essence of the person, his or her identity or persona from being unwillingly or unknowingly

[1] Section 50 provides: "A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or parent or guardian, is guilty of a misdemeanor." Civil Rights Law § 50. Section 51 authorizes injunctive relief, damages, and exemplary damages for violation of Section 50.

misappropriated for the profit of another."), *aff'd without op.*, 110 A.D.12d 1095 (1985). Accordingly, the statute should be vigorously enforced. As explained by the Court of Appeals:

> The purpose of the statute is remedial and rooted in popular resentment at the refusal of the courts to grant recognition to the newly expounded right of an individual to be immune from commercial exploitation. Justice Shientag, in his opinion in the *Lahiri* [*v. Daily Mirror*, 162 Misc. 776, 779 (Sup. Ct. 1937)] case, in establishing a guide in the construction of these sections, has said that "A statute of this kind is not to be obeyed grudgingly, by construing it narrowly and treating it as though it did not exist for any purpose other than that embraced within the strict construction of its words." It is "not an alien intruder in the house of the common law, but a guest to be welcomed as a new and powerful aid in the accomplishment of its appointed task of accommodating the law to social needs."

Flores v. Mosler Safe Co., 7 N.Y.2d 276, 280 (1959) (citation omitted). Thus, "the courts have broadly construed what constitutes commercial misappropriation of a person's name or picture under the statutes." *Davis v. High Soc. Magazine, Inc.*, 90 A.D.2d 374, 457 N.Y.S.2d 308, 313 (2nd Dep't 1982). "The most self-explanatory, comprehensible type of invasion of privacy is . . . appropriation of a person's name, likeness or personality for advertising or commercial purposes or for one's own use or benefit." Bruce W. Sanford, *Libel and Privacy* (2d ed. 2001 Supp. § 11.5.1, p. 586-587). In *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 358 (1952) the Court of Appeals declared, "the [New York] statute was born of the need to protect the individual from selfish, commercial exploitation of his personality."

Celebrities' particularly strong interest in their identity is to be protected accordingly. *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D. 620, 396 N.Y.S.2d 661, 662 (2nd Dep't. 1977) ("there is no question but that a celebrity has a legitimate proprietary interest in his public personality"); *Shamsky v. Garan, Inc.*, 167 Misc.2d 149,

632 N.Y.S.2d 930 (Sup. Ct. 1995) ("if 'virtually any' unauthorized commercial use is actionable, certainly the use of a frontal photograph of some thirty formerly famous sports personalities must be one such case"); *Onassis*, 122 Misc.2d at 612-14 (use of Onassis look-alike in advertisement wrongful as "she is the very image of one of the most instantly recognizable and most respected women in the world--a legend in her own time"); *see also Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174, 182-83 (1984) (Civil Rights Law §§ 50-51 encompasses "right of publicity" claims, such as wrongful use of famous personality to promote a product).

To prevail on a claim under Sections 50 and 51, a plaintiff need only show: "(i) usage of plaintiff's name, portrait, picture, or voice, (ii) within the state of New York, (iii) for purposes of advertising or trade, (iv) without plaintiff's written consent." *Molina v. Phoenix Sound Inc.*, 747 N.Y.S.2d 227, 230 (1st Dep't 2002). Each element is met here.

i. Defendants Are Using Spike Lee's Name and <u>Thereby Misappropriating His Persona</u>

Use of a name violates Civil Rights Law §§ 50 and 51 when the name, in context, identifies the plaintiff in the minds of more than a de minimus number of people. *See Cohen v. Herbal Concepts, Inc.*, 63 N.Y.2d 379, 385, 472 N.E.2d 307, 482 N.Y.S.2d 457 (1984) (establishing test of "identifiability" for pictures; identifiability by husband alone "was *prima* facie sufficient"); T. McCarthy, *The Rights of Publicity and Privacy* § 3.18 (2003)("To establish liability, plaintiff need prove no more than that he or she is reasonably identifiable in defendants' use to more than a de minimus number of persons"); *Orsini v. Eastern Wine Corp.*, 273 A.D. 947, 78 N.Y.S.2d 224, 224-25 (1st Dep't 1948) ("the use of the name Orsini, together with the family crest and the princely crown, identifies the plaintiff in the public mind as the individual whose name is being

used without his consent"); *Adrian v. Unterman*, 281 A.D. 81, 118 N.Y.S.2d 121 (1ST Dep't 1952) (following *Orsini*); *see also Onassis v. Christian Dior-New York, Inc.*, 122 Misc.2d 603, 612, 472 N.Y.S.2d 254, (Sup. Ct. 1984) ("[n]o one is free to trade on another's name or appearance and claim immunity because what he is using is similar to but not identical with the original"), *aff'd without op.*, 110 A.D.12d 1095 (1985); *Allen v. Gordon*, 86 A.D. 514, 446 N.Y.S.2d 48 (1ST Dep't) (no identification of plaintiff by name of character in book as "Dr. Allen" where dissimilarities between book character and plaintiff meant that nothing would "prompt a rational reader to conclude" that name referenced plaintiff), *aff'd*, 56 N.Y.2d 780 (1982); *Henley v. Dillard Dep't Stores*, 46 F. Supp. 2d 587, 591 (N.D. Tex. 1999) ("[c]ourts have recognized that a defendant may be held liable for using a phrase or image that clearly identifies the celebrity, in addition to finding liability for using a plaintiff's precise name"; collecting cases); *Restatement (Third) of Unfair Competition* § 46 (name is appropriated if it is "understood by the audience as referring to plaintiff"). As identifiability is the legal requirement, it is not relevant whether a full or legal name is used. As one court has explained: "Having in mind the evident purpose of the statute, its application to a public or stage name, as well as a private one, seems inevitable. If the stage name has come to be closely and widely identified with the person who bears it, the need for protection against unauthorized advertising will be as urgent as in the case of a private name; if anything, the need will be more urgent." *Gardella v. Log Cabin Prod. Co.*, 89 F.2d 891, 894 (2d Cir. 1937) (citations omitted); *see also DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30, 53 (E.D.N.Y. 1994); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 137 (Wis. 1979) ("The fact that the name, 'Crazylegs,' used by Johnson, was a nickname rather

than Hirsch's actual name does not preclude a cause of action. All that is required is that the name clearly identify the wronged person.").

Defendants' use of the name "Spike TV" and its abbreviation SPIKE, identifies Spike Lee. Members of the public believe that "Spike TV" has this name because it is associated with or sponsored by plaintiff Spike Lee. Spike Lee Aff ¶4; Davis Aff ¶11, 13; Reinhard Aff ¶¶12, 14; Hansen Aff ¶13; Norton Aff ¶5; McDowell Aff ¶4; Dellums Aff ¶¶4, 5; Butts Aff ¶¶10, 11; Bradley Aff ¶¶6, 7; Roxborough Aff ¶8. News reports about the proposed name change for TNN referred to Spike Lee, Lubell Aff ¶25, Exhs B1, C1, C2, demonstrating that even the media find an association between the name "Spike TV" and Spike Lee. Spike Lee's television work has previously been referred to in the media as "Spike TV." Lubell Aff ¶14. Defendant Hecht stated that one of the reasons defendants chose the name "Spike TV" was because of the connotation of plaintiff Spike Lee. Lubell Aff ¶22, Exh A26. Defendants' other descriptions of why they chose the name "Spike TV" – because it is a "guy's name" with a "personality" that is "aggressive," "irreverent," "unapologetically male," and "smart and contemporary" (Lubell Aff ¶27, Exhs A25, B1) demonstrate that the name "Spike TV" is identified with Spike Lee, as all of these adjectives describe Spike Lee and how he is known by the public. Lubell Aff ¶¶28-31.

Given these factors, Viacom's use of "Spike TV" and SPIKE undeniably identifies Spike Lee. *See Cohen,* 63 N.Y.2d 379 at 383-84 (establishing "identifiability" test); *Orsini,* 273 A.D. 947, 78 N.Y.S.2d at 224-25 (use of partial name plus other factors "identifies the plaintiff in the public mind as the individual whose name is being used without his consent"); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y.1978) (drawing of

boxer similar in likeness to Muhammad Ali with accompanying verse referring to "the Greatest," violated Civil Rights Law §§ 50-51); *Henley*, 46 F. Supp. 2d at 591 (advertising a Henley-type shirt as "Don's" misappropriates musician Don Henley's identity).

That Defendants only use part of Spike Lee's name is not a defense, since Spike Lee is well-known by his first name alone. Spike Lee Aff ¶7; Reinhard Aff ¶7; Hansen Aff ¶12; Norton Aff ¶4; Bradley Aff ¶4; Lubell Aff ¶¶23, 25, Exhs A25, B1. That other people might share the name Spike also is no defense, because the use of "Spike" in this context – to refer to a television network – clearly creates an identification with a particular Spike, *i.e.*, Spike Lee, since he is the only Spike well-known for his widely acclaimed work in television, including television films and segments, television shows, television commercials, and television appearances. Spike Lee Aff ¶13; Reinhard Aff ¶¶6, 7, 8; Hansen Aff ¶12; Lubell Aff ¶¶11, 12, Exhs A15, A16. That "there were others who were known by the same name . . . does not vitiate the existence of a cause of action." *Hirsch*, 280 N.W.2d at 137. Rather, "[a]ll that is required is that the name clearly identify the wronged person." *Id.*; *accord Orsini*, 273 A.D. 947, 78 N.Y.S.2d at 224-25 (violation of Civil Rights Law § 50 where partial name plus other factors "identifies the plaintiff in the public mind as the individual whose name is being used without his consent"); *Apple Corps Ltd. v. Adirondack Group*, 124 Misc.2d 351, 354, 476 N.Y.S.2d 716 (Sup. Ct. 1983) ("Four persons named 'John, Paul, George and Ringo' will not be taken by the public as a reference to the Moskowitz Brothers, to the Pope and two other people, or to anyone else except the members of the best known singing group in the world."); *Hillerich & Bradsby Co. v. Christian Bros., Inc.*, 943 F. Supp. 1136, 1141

(D. Minn. 1996) (sale of hockey sticks with name "Messier" identified professional athlete; injunction granted).

Finally, evidence that a defendant used the name in order to create some association with a celebrity is evidence that the name used identifies the celebrity. *See* J. McCarthy, *Rights of Publicity and Privacy* § 3:33 (proof that defendant knew of plaintiff and made a commercial use from which it intended the audience would identify plaintiff creates a presumption of identification); *Restatement (Third) Unfair Competition* § 46 Comment d (1995), Reporters' Note ("The defendant's intent to identify the plaintiff is also evidence that the plaintiff is in fact identified"); *Henley*, 46 F. Supp. 2d at 595 (defendant's intent to associate their Henly shirt product with musician Don Henley by calling it "Don's Henly" proves that the name of the product identifies Don Henley). Here, defendants' own pronouncements demonstrate that one of the reasons that defendants chose the name "Spike" for their renamed network is because of the association of that word with plaintiff Spike Lee. Lubell Aff ¶22. Thus, the fact that defendants themselves recognized that the name "Spike TV" had a connotation of the plaintiff Spike Lee is sufficient evidence that the name "Spike TV" is identifiable with Spike Lee, within the meaning of Civil Rights Law §§ 50, 51.

It is anticipated that defendants will argue that they chose the name "Spike" in "Spike TV" because of some uses or connotations of that word other than to refer to plaintiff Spike Lee, such as dictionary definitions for the word "spike." Lubell Aff ¶26. Such an argument is irrelevant to the issues in this case. First, it is irrelevant because, as described above, defendant Hecht admitted that one of the reasons defendants chose the name "Spike TV" was because of its association with plaintiff Spike Lee. Second, even

if evidence of defendants' intent is disregarded, the affidavits submitted herein establish that the name "Spike TV" was understood to refer to Spike Lee, Spike Lee Aff ¶4; Davis Aff ¶¶10, 13; Reinhard Aff ¶¶11, 14; Hansen Aff ¶13; Norton Aff ¶5; Dellums Aff ¶4; George Aff ¶5; McDowell Aff ¶¶3, 4, 6; Butts Aff ¶¶10, 11; Bradley Aff ¶6; Roxborough Aff ¶8; Lubell Aff ¶22, thus demonstrating that the challenged name does identify Spike Lee in the minds of the general public. Third, that there might be other uses or connotations of the word "Spike" other than plaintiff Spike Lee does not lessen defendants' liability. *Hirsch v. S.C. Johnson & Sons, Inc.*, 280 N.W.2d 129, 137 (Wis. 1979). All that is required for liability under Civil Rights Law §§ 50, 51 is that the challenged name, in context, identifies the plaintiff in the minds of more than a de minimus number of people. *See,* p.12 *supra.* There is no requirement that the challenged name not have any other connotations. Though Defendants now may conjure up additional reasons to justify the selection of the name "Spike," those reasons simply have no bearing under Civil Rights Law §§ 50, 51 on whether members of the public will identify Spike TV with Spike Lee.

ii. Defendants' Misappropriation Is for Advertising and Trade Purposes

Under Civil Rights Law § 50, use of a name is wrongful when it is used for either advertising or trade purposes. "Use for 'advertising purposes' is defined as solicitation for patronage, intended to promote the sale of some collateral commodity or service." *Davis*, 90 A.D.2d 374, 457 N.Y.S.2d at 313. Use for "trade purposes" means "use for the purpose of making profit." *Delan by Delan v. CBS, Inc.*, 91 A.D.2d 960, 458 N.Y.S.2d 608 (2nd App. Div. 1983).

Defendants' use of Spike Lee's name clearly satisfies either standard. Defendants have used, or will use, the name "Spike TV" to advertise and promote the cable channel formerly known as TNN. This is undeniably use for advertising purposes. Moreover, the reason for this advertising, and more generally, the self-professed reason that defendants chose the name "Spike TV," is to improve TNN's sagging ratings, and thereby improve defendants' advertising sales. Lubell Aff ¶¶19, 20, Exhs A23, A24. Thus, the use of Spike Lee's name is for the purpose of making profit, *i.e.*, for trade purposes.[2]

iii. <u>The Remaining Elements Are Shown</u>

The final elements of this cause of action, that the defendants used plaintiff's name in New York and that plaintiff did not consent in writing, are also easily shown. Defendants' acts are centered in New York, as the corporate headquarters for all three corporate defendants are here. Moreover, defendants plan to use Spike Lee's name and identity to pitch their "Spike" channel to the millions of New York television viewers. Spike Lee has not consented in writing, or otherwise. Spike Lee Aff ¶4; Lubell Aff ¶26, Exh C3.

b. Spike Lee Is Likely to Prevail on His Claim <u>Under General Business Law § 13</u>

General Business Law § 133 (formerly codified as Penal Law § 964) provides: "No person, firm or corporation shall, with intent to deceive or mislead the public, assume, adopt or use as, or as part of, a corporate, assumed or trade name, for advertising purposes or for the purposes of trade, or for any other purpose, any name, designation or

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[2] Defendants have no First Amendment defense on this element because defendants' use of Spike Lee's name is not a "report[] of newsworthy events or matters of public interest." *Messenger v. Gruner Jahr + Printing and Pub.*, 208 F.3d 122, 126 (2d Cir. 2000); *see also Time, Inc. v. Hill*, 385 U.S. 374, 383 (1967).

style . . ., or a part of any name, designation or style . . ., which may deceive or mislead the public as to the identity of such person, firm or corporation or as to the connection of such person, firm or corporation with any other person, firm or corporation." Section 133 further provides: "[I]f it shall appear to the satisfaction of the court or justice that the defendant is in fact assuming, adopting or using such name, or is about to assume, adopt or use such name, and that the assumption, adoption or use of such name may deceive or mislead the public, an injunction may be issued by said court or justice, enjoining and restraining such actual or threatened violation without requiring proof that any person has in fact been deceived or misled thereby." N.Y. Gen. Bus. Law § 133.

Section 133 "permits a State court possessing jurisdiction to issue an injunction to prevent an entity from adopting a name for advertising and trade purposes that would 'deceive or mislead the public ... as to the connection of such [entity] with any other [entity],' even without requiring proof that any person has in fact been misled or deceived." *Gallina v. Giacalone*, 171 Misc.2d 645, 655 N.Y.S.2d 317, 319 (Sup. Ct. 1997). As set forth above, plaintiff has clearly demonstrated that defendants are using his well-known "Spike" name for trade and advertising purposes in a manner that would "deceive or mislead the public." As set forth above, members of the public believe that "Spike TV" has this name because it is associated with or sponsored by plaintiff Spike Lee; the media has noted that the proposed new name for TNN brings to mind plaintiff Spike Lee; Spike Lee's television work has previously been referred to in the media as "Spike TV"; defendant Hecht stated that one of the reasons defendants chose the name "Spike TV" was because of the connotation of plaintiff Spike Lee; and defendants' other descriptions of why they chose the name "Spike TV" – because it is a "guy's name" with

a "personality" that is "aggressive," "irreverent," "unapologetically male," and "smart and contemporary" – all describe Spike Lee and how he is known by the public. *See* pp. 6-8, *supra.*

As plaintiff has easily made this showing based on defendants' blatant attempt to misappropriate plaintiff's name and hard-earned reputation, plaintiff is also likely to succeed on this claim, and thus is entitled to a preliminary injunction based solely on N.Y. Gen.Bus. Law § 133. *See, e.g., Gasoline Heaven at Commack, Inc. v. Nesconset Gas Heaven, Inc.*, 191 Misc.2d 646, 743 N.Y.S.2d 825 (Sup. Ct. 2002) (granting preliminary injunction under Section 133); *Blaich Assoc., Inc. v. Coach/Blaich Real Estate of Manhasset Inc.*, 186 Misc.2d 594, 719 N.Y.S.2d 820 (2000) (same).

c. Spike Lee Is Likely to Prevail on His Claim Under New York Unfair Competition Law

New York unfair competition law encompasses a broad range of unfair practices "generally described as the misappropriation of the skill, expenditures and labors of another." *Diversified Mktg., Inc. v. Estee Lauder, Inc.*, 705 F. Supp. 128, 131 (S.D.N.Y.1988). It is "a broad and flexible doctrine" encompassing "any form of unfair invasion or infringement" and "any form of commercial immorality." *Metropolitan Opera Ass'n, Inc. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 792, 796, 101 N.Y.S.2d 483, 488-89, 492 (Sup.Ct.1950), *aff'd*, 279 A.D. 632, 107 N.Y.S.2d 795 (Sup. Ct. 1951). New York law recognizes as unfair competition the "misappropriation for the commercial advantage of one person of a benefit or property right belonging to another." *Id.* at 793, 101 N.Y.S.2d at 489. "[I]n essence, an action for unfair competition turns not upon the acquisition of a secondary meaning [for a plaintiff's trademark or trade name], but upon whether the acts of the defendant can be characterized as unfair." *Allied*

Maintenance Corp. v. Allied Mechanical Trades, Inc., 42 N.Y.2d 538, 542 n.2, 399 N.Y.S.2d 628, 631 n.2 (Ct. App. 1977).

Here, based on his fame, plaintiff Spike Lee clearly has a property right "akin to that of a traditional trademark holder" in his identity. *Parks v. LaFace Records*, __ F.3d __, 2003 WL 21058571, at *4 (6th Cir. May 12, 2003); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 624-25 (S.D.N.Y. 1985); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 28:15 (4th ed. 2002) (discussing cases). As shown above, it is equally obvious that defendants have misappropriated plaintiff Spike Lee's identity for their own commercial advantage. Indeed, a claim for unfair competition under New York law "closely resemble[s]" a federal Lanham Act claim. *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 149 (2d Cir.1997); *Girl Scouts v. Bantam Doubleday Dell Publishing Group, Inc.*, 808 F. Supp. 1112, 1131 (S.D.N.Y. 1992). The Lanham Act permits celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others. *Parks*, 2003 WL 21058571, at *4 (citing numerous cases). To prevail, "a celebrity must show that use of his or her name is likely to cause confusion among consumers as to the 'affiliation, connection, or association' between the celebrity and the defendant's goods or services or as to the celebrity's participation in the 'origin, sponsorship, or approval' of the defendant's goods or services." *Id.* at 5. Plaintiff has made this showing based on his fame in the entertainment industry, the proximity of defendants' use, and defendants' intent to profit from this association, and thus has demonstrated a likelihood of success on his claim for unfair competition, as well.

2. An Injunction Should Issue on the Showing of Likelihood of Success Alone, Without Any Need To Show Irreparable Injury

As plaintiff has shown a likelihood of success on his claims under Civil Rights Law §§ 50-51, an injunction should issue. Under Civil Rights Law § 51, a preliminary injunction is available based on a showing of a meritorious claim alone, without any need to show irreparable injury or balancing of the equities. *See Onassis*, 122 Misc.2d 603, 472 N.Y.S.2d at 607 ("Once the violation is established, the plaintiff may have an absolute right to injunction, regardless of the relative damage to the parties."); *Durgham v. Columbia Broadcasting System, Inc.*, 29 Misc.2d 394, 396, 214 N.Y.S.2d 752 (Sup. Ct. 1961) ("Regardless of what the equities of the situation may be and the damage to defendants from the granting of the injunction, a denial of injunctive relief for a conceded violation of the [N.Y. Civil Rights Law §§ 50 and 51] would emasculate the provisions for injunctive relief and cannot be justified."); *see also Blumenthal v. Picture Classics*, 235 A.D.2d 570, 257 N.Y.S. 800 (1st App. Dep't 1932), *aff'd*, 261 N.Y. 504 (1933); *Loftus v. Greenwich Lithographing Co.*, 192 A.D. 251, 182 N.Y.S. 428, 431-32 (1st Dep't 1920). As shown above, Spike Lee has demonstrated a violation of Civil Rights Law § 50, and is therefore entitled to an injunction under Civil Rights Law § 51 without the necessity of any additional showing.

3. In Any Event, Spike Lee Faces Irreparable Injury Were An Injunction Not to be Granted, and The Balance of Equities Tips in His Favor

As described in Section B, above, Spike Lee need make no showing of irreparable injury or balancing of equities to prevail on this motion. Nonetheless, both are present in this case.

At stake in this proceeding is Spike Lee's single most important, most valuable, and most hard-won asset: his reputation and goodwill. Permitting defendants to misappropriate Spike Lee's name and mislead consumers about his endorsement or sponsorship of defendants' "Spike TV" without Spike Lee's consent, would impact his reputation in important ways that money damages could never recompense. *See Adirondack Appliance Repair, Inc. v. Adirondack Appliance Parts, Inc.*, 538 N.Y.S.2d 118, 120 (3rd Dep't 1989) (loss of goodwill is irreparable harm); *King v. Innovation Books*, 976 F.2d 824, 831 (2d Cir.1992) ("wrongful attribution to the individual in the eye of the general public, of responsibility for actions over which he or she has no control" creates irreparable harm; use of title "Stephen King's The Lawnmower Man" enjoined since it falsely attributed King's "involvement in" or "approval of" the movie); *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625-26, 630 (S.D.N.Y. 1985) (irreparable harm from false endorsement; commercials with Woody Allen look-alike enjoined); *see also Ryan v. Volpone Stamp Co., Inc.*, 107 F.Supp.2d 369, 404 (S.D.N.Y. 2000) (specific harm to reputation need not be shown; "mere loss of control over that reputation is what constituted the requisite irreparable harm"); *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 349-50 (M.D. Tenn. 1993) (loss of control of the use of the Beatles' names and likenesses constitutes irreparable injury); *also see* Spike Lee Aff ¶15; Lubell Aff ¶32.

The balance of equities clearly favors Spike Lee. As described above, the damage to Spike Lee's reputation and goodwill in the absence of an injunction will be substantial, and money damages cannot offer a complete remedy. Any benefits the defendants expect to see from the change in name to "Spike TV" is not an equitable consideration, for those benefits flow, at least in large part, from misappropriating the name and identity of Spike

Lee. *See Park South Associates v. Blackmer*, 171 A.D.2d 468, 567 N.Y.S.2d 226, 228 (1st App. Dep't 1991) (balance favored plaintiff where injunction "merely restrain[ed] defendant from continuing any unlawful or wrongful activities"). Any impact on defendants will be limited, as the injunction sought by this motion would only maintain the status quo until the final determination of the action, at worst, delaying defendants' implementation of their plans to adopt Spike Lee's name. It is quite significant that defendants have not invested any substantial sums in their proposed new name for the TNN network – this proposed name change was announced only one month ago, and there is no built-up public recognition that defendants would lose were the proposed name change to be delayed during the pendency of this litigation. Finally, any losses from such delay, besides being minimal, are entirely economic and thus are protected with an undertaking. *See Delta Properties Inc. v. Fobare Enter. Inc.*, 251 A.D.2d 960, 674 N.Y.S.2d 817 (3rd Dep't 1998) (injunction to maintain status quo proper where possibility of recovery on undertaking adequately protected defendant). Thus, there is nothing equitable to outweigh the irreparable harm to Spike Lee that would follow from denial of the motion.

4. <u>At Most, A Minimal Undertaking Should be Required</u>

The size of any undertaking "is a matter within the sound discretion" of this Court. *Blueberries Gourmet, Inc. v. Aris Realty Corp.*, 255 A.D.2d 348, 680 N.Y.S.2d 557 (2nd Dep't 1998). Any harm from delaying defendants' use of the name "Spike" until the final determination of this action will be temporary and minor. Defendants have used their current TNN name for several years. An order merely requiring them to maintain this status quo for a temporary period – *i.e.*, to keep using a name of their own

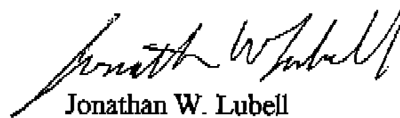
choosing -- is far from likely to lead to any certain, substantial detriment. The Court need not consider claims of potential injury that are speculative. *Id.*; *Visual Equities Inc. v. Sotheby's, Inc.*, 199 A.D.2d 59, 604 N.Y.S.2d 117 (1st App. Dep't 1993). Accordingly, the size of any undertaking should be minimal.

IV. CONCLUSION

For the foregoing reasons, the Court should grant plaintiff's motion for a preliminary injunction, and enter an order enjoining defendants from utilizing the name "Spike" in connection with any television network.

Dated: New York, New York
June 2, 2003

Respectfully submitted,



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