

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK: 1AS PART 15

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SPIKE LEE, an individual,

Plaintiff,

-against-

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.
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Mtn Seq. 001

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WALTER B. TOLUB, J.:

What appears, at first blush, to be an exercise in egocentricity, becomes on closer review an earnest attempt by a prominent personality to limit what he regards as the commercial exploitation of his public persona.

The Parties

For the benefit of those of us who have been in cultural isolation for the last decade and a half, Shelton Jackson Lee, more commonly known as Spike Lee, is a filmmaker, writer, producer, director, and actor, who since 1986 has produced fifteen feature films, two HBO documentaries, a dozen or so television specials, and at least thirty-five (35) television commercials. A highly regarded member of the African-American community, Mr. Lee has received numerous honorary degrees and currently is the Artistic Director at NYU's Tisch School of Arts and Graduate Films.

Defendant Viacom is a Delaware corporation known for its global media presence. Defendant MTV Networks is a division of Viacom, and defendant TNN is a unit/division of

defendant MTV.

This action arises out of the defendants' collective decision to rename the TNN network "Spike TV." The decision, in the words of defendant Viacom, was made as part of a strategy to reposition the network, ultimately creating the "first network oriented primarily to male viewers" (Hecht Affidavit, p. 2). In a Viacom news release dated April 15, 2003, Viacom described the new network as "unapologetically male; it's active, it's smart and contemporary with a personality that's aggressive and irreverent" (Lubell Affidavit, Ex. 25). Additionally, TNN President, Albie Hecht has conceded that Spike Lee was one of the role models for the network name, albeit along with the character Spike of "Buffy the Vampire Slayer" fame, and director Spike Jonze (Hecht Affidavit, p. 9; Lubell Affidavit, Ex. 26). The selection of the name "Spike TV" represents, according to the defendants, the culmination of a long process to position the channel as the preeminent male oriented network. The plaintiff regards it as a misappropriation and exploitation of his public persona, without his consent. Plaintiff seeks a preliminary injunction based on violations of sections 50 and 51 of the New York Civil Rights Law and section 133 of New York General Business Law.

Civil Rights Law Sections 50 and 51

New York, unlike several other states, does not recognize a common law cause of action for an invasion of the right to privacy (*Shields v. Grass*, 58 N.Y.2d 338 [1983]). Protection against claims of invasion of privacy is predicated solely upon sections 50 and 51 of the New York Civil Rights Law. Section 50 of the law is penal in nature and, as is relevant to the instant case, makes it a misdemeanor to use a person's name for commercial purposes without the written consent of such person. Section 51 is remedial in that it creates a civil cause of action on behalf of the injured party and allows an aggrieved party to seek injunctive relief, and/or damages. The right to injunctive

relief under section 51 is absolute. Once the violation is established, an injunction will lie and the court need not consider the balancing of the equities test nor the requirement that the plaintiff demonstrate irreparable injury (*Blumenthal v. Picture Classics, Inc.*, 235 A.D. 570 [1st Dept. 1932], *aff'd* 261 N.Y. 504 [1933]; *Loftus v. Greenwich Lithographing Co.*, 192 A.D. 251 [1st Dept. 1920]; *Durgham v. Columbia Broadcasting System, Inc.*, 29 Misc.2d 394 [Sup Ct, Special Term, NY County 1961]).

General Business Law Section 133

New York General Business Law section 133, commonly referred to as the deceptive trade law, is somewhat similar to Civil Rights Law sections 50 and 51 in that the first portion of section 133 is penal in nature. It is a misdemeanor to "with intent to deceive or mislead the public," misappropriate any name, designation, et al. The second portion of section 133 allows for injunctive relief where the "adoption or use of such name may deceive or mislead the public...without any proof that any person has in fact been deceived or misled thereby" (NY Gen Bus L. §133, McKinney's 2003).

Preliminary Injunction

It is well established in this State that a preliminary injunction is a provisional remedy designed to maintain the status quo between the parties (*Uniformed Firefighter's Association of Greater New York v. City of New York*, 79 N.Y.2d 236 [1992]; Barr, Altman, Lipshie and Gertsman; *New York Civil Practice Before Trial* [James Publishing 2001-2002] §17:03; CPLR 6301). The determination to grant or deny a preliminary injunction lies within the sound discretion of the trial court (*Borenstein v. Rochel Properties*, 176 A.D.2d 171 [1st Dept. 1991]). Generally, in order for a court to grant a preliminary injunction pursuant to CPLR 6301, a movant is required to

demonstrate: (1) success on the merits of the action; (2) irreparable harm absent issuance of a preliminary injunction; and (3) a balancing of the equities in favor of the movant (*Aetna v. Capasso*, 75 N.Y.2d 860 [1990]). Because the instant application is brought pursuant to Civil Rights Law sections 50 and 51, this court is solely concerned with whether plaintiff has made a prima facie showing of entitlement to the relief sought and a likelihood of success on the merits.

At the outset, the court emphasizes that the requirement of showing entitlement to relief sought and a likelihood of success on the merits should not be equated with a showing of a certainty of success (*Egan v. New York Care Plus Insurance Company, Inc.*, 266 A.D.2d 600 [3rd Dept. 1999]; *Rosemont Enterprises Inc. v. McGraw-Hill Book Company*, 85 Misc.2d 583 [Sup Ct, Special Term NY County 1975];). Nor will the existence of facts in and of themselves defeat an application for a preliminary injunction (CPLR 6312 (c); *Frank May Associates, Inc. v. Boughton*, 281 A.D.2d 673 [3rd Dept. 2001]). Lastly, this court recognizes that “[i]t is well settled that a likelihood of success on the merits may be sufficiently established even where the facts are in dispute and the evidence is inconclusive” (*Four Times Square Associates, LLC v. Cigna Investments, Inc.*, 2003 WL 21267190 [1st Dept. 2003]; *Ma v. Lien*, 198 A.D.2d 186 [1st Dept. 1993]; *lv. dismissed*, 83 N.Y.2d 847 [1994]). That having been said, this court now addresses the question of whether plaintiff has shown a likelihood of success on the merits as to his claims under Civil Rights Law §§ 50 and 51, and General Business Law § 133, thereby warranting the granting of a preliminary injunction.

In the instant matter, defendants claim that plaintiff cannot establish a likelihood of success on the merits because Mr. Lee cannot prove that he is identifiable as the “Spike” in “Spike TV.” Defendants correctly point out that there are no reported cases in New York in which a celebrity’s first name, standing alone, without some other indicia of his or her persona, has received the

protection that Mr. Lee seeks here. Where celebrities have succeeded in obtaining injunctive relief, the movants have demonstrated the presence of a combination of elements where, when taken as a whole, invoke or imply the name, image, or ideal of the celebrity (see *Allen v. Men's World Outlet, Inc.*, 679 F.Supp. 360 [S.D.N.Y. 1988] (use of celebrity look-alike for advertisement); *All v. Playgirl Inc.*, 447 F.Supp. 723 [S.D.N.Y. 1978] (drawing of nude African-American Male seated in a corner of a boxing ring with arms outstretched bearing the caption, "The Greatest"); *Orsini v. Eastern Wine Corp.*, 190 Misc. 235 [Sup Ct, Special Term, NY County 1947], *aff'd* 273 A.D. 947 [1st Dept. 1948] (use of family crest in addition to surname to promote wine products); *Adrian v. Untermyer*, 281 A.D. 81 [1st Dept. 1952] (dress designer's surname wrongfully used to sell perfume); *Onassis v. Christian Dior New York, Inc.*, 122 Misc.2d 603 [Sup Ct, Special Term, NY County 1984] (look-alike used in advertising campaign); *Apple Corps Limited v. Adironack Group*, 124 Misc.2d 351 [Sup Ct, Special Term, NY County 1983] (use of names John, Paul, George, and Ringo as a title of a recording album would be understood by the public as a reference to the Beatles).

Moreover, as defendants point out, "spike" is both a common name and a word with multiple meanings. In addition to Spike Lee, other show business "Spikes" include Spike Jones, the comedic song writer, and Spike Jonze, the highly acclaimed film director; musicians Spike Hughes and Spike Robinson; British comedian Spike Milligan; and jazz musician Spike Wilner. The list of famous "Spikes" in sports and the arts is far too exhaustive to set forth here. As for multiple meanings, Webster's New Collegiate Dictionary lists at least eight (8) definitions for the word "spike".

Plaintiffs counter by submitting affidavits of several prominent individuals including film critic Nelson George; two elected officials, Ronald Dellums and Bill Bradley; actors Ozzie Davis and Edward Norton; Reverend Calvin Butts; Keith Reihand, Chairman of DDB Worldwide

Communications Group Inc.; entertainment attorney Thomas Handel; Leila McDowell, Director of the Commission for the Center of Community Change; and Mildred Bond Roxborough, Development Consultant for the NAACP. All of these affidavits attest to Mr. Lee's celebrity status and express that each of these prominent people believed, on first impression, that "Spike TV" was in some way the product of, or is in some manner associated with Spike Lee.

Of greater probative value however is the affidavit of Dr. Samuel Popkin, a professor of political science at the University of California, San Diego. Dr. Popkin specializes in "the study of cognition and choice, particularly with respect to voters, elections, and public policy." (Popkin Affidavit p. 1). Dr. Popkin, who appears to be well credentialed, claims "expertise in the evaluation of consumer perception of advertising marketing and other forms of mass communications" (Popkin Affidavit p. 1). Dr. Popkin states in part,

It is my professional judgment that if an impartial survey were conducted in New York and similar urban center cities, a substantial portion of black men and women aged 18-45, and also a substantial, though smaller, proportion of young white professionals would infer from Viacom press releases that Spike Lee was associated with Spike TV. I believe that irreverent, hip, aggressive and brash are words which will associate Spike Lee with Spike TV. (Popkin Affidavit p. 4).

Additionally, the plaintiff has submitted "a comprehensive database search of newspapers, magazines, and internet websites" which establish Mr. Lee's artistic reputation for irreverence and aggressiveness, and his recognition by both the entertainment industry and the general public solely by his name, Spike. (Lubell Affidavit p. 1 and Exhibits).

It is the court's opinion that injunctive relief will not lie under General Business Law section 133, as there has been no evidence of intent to deceive or damage and "proof of the adoption of a

similar name, without any evidence of intention, deception or damage, is an insufficient ground for summary relief" (*Frank Rest., Inc. v. Lauramar Enterprises, Inc.*, 273 A.D.2d 349, 350 [2nd Dept. 2000]). The court is of the belief that a preliminary injunction will issue under Civil Rights Law section 51, as counsel has made out a prima facie case for relief and a likelihood of success on the merits. Contrary to defendants' position, the court is of the opinion that in this age of mass communication, a celebrity can in fact establish a vested right in the use of only their first name or a surname. There are many celebrities that are so recognized, including Cher, Madonna, Sting, and Liza. Moreover, is there any question that protection would be afforded if a network proposed a program called the "Cronkite News Hour" or the "Brinkley News Hour" without the consent of Walter Cronkite or the late David Brinkley?

The court is not required to reach this point, because in addition to the name Spike, there are other indicia that defendants sought to exploit Mr. Lee's persona, most notably Mr. Lee's reputation for irreverence and aggressiveness. Finally, although the word "spike" has many meanings, the focus of this case is the application of the word "spike" to the film and television industry. No one would seriously suggest that Mr. Lee could successfully claim the protection of Civil Rights Law sections 50 and 51 for the use of the word "spike" in an unrelated field, i.e. dog food or breakfast cereal.

Although a preliminary injunction will lie, it is only a provisional remedy designed to maintain the status quo between the parties. This court reiterates that it is not a final determination on the merits and must not be equated with the showing of a certainty of success (*Egan v. New York Care Plus Insurance Company, Inc.*, 266 A.D.2d 600; *Times Square Books, Inc. v. City of Rochester*, 223 A.D.2d 270 [4th Dept. 1996]; *Rosemont v. McGraw Hill*, 85 Misc.2d 583).

Having concluded that a preliminary injunction will lie, the question of what constitutes an

adequate undertaking is before the court. The size of any undertaking is as plaintiff's counsel correctly points out, "a matter within the sound discretion" of the court (*Blueberries Gourmet, Inc. v. Aris Realty Corp.*, 255 A.D.2d 348 [2nd Dept. 1998]). The court, having not taken testimony, has little by way of hard figures. However, the defendants' affidavits indicate the extensive amount of work that has gone into the planning and execution of this project. Accordingly, the court requires that a bond in the amount of \$500,000 be posted as an undertaking in this matter subject to a future application by the parties for an upward or downward modification.

The application for a preliminary injunction enjoining the defendants from utilizing the name "Spike", in connection with any television network, is granted on condition that plaintiff post an undertaking by way of bond or cash deposit in the sum of \$500,000.

Defendants' cross-motion to dismiss pursuant to CPLR 3211(a)(7) is denied with leave to renew upon the completion of discovery. Accordingly it is

ORDERED that plaintiff's motion for a preliminary injunction is granted; and it is further

ORDERED that the undertaking is fixed in the sum of \$500,000 conditioned that the plaintiff, if it is finally determined that he was not entitled to an injunction, will pay to the defendants all damages and costs which may be sustained by reason of this injunction; and it is further

ORDERED that defendants, their agents, servants, employees and all other persons acting under the jurisdiction, supervision and/or direction of the defendants, are enjoined and restrained, during the pendency of this action, from doing or suffering to be done, directly or through any attorney, agent servant, employee or other person under the supervision or control of defendants or

otherwise from using the name "Spike" in connection with any television network, and it is

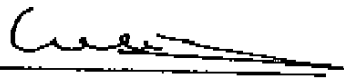
ORDERED that defendants' cross motion to dismiss is denied; and it is

ORDERED that the Clerk of Court enter judgment in favor of the respective parties.

Counsel for the parties are directed to appear for a Preliminary Conference at I.A. Part 15, Room 335, 60 Centre Street, New York, New York on June 23, 2003 at 9:30 a.m. for an expeditious discovery schedule.

This shall constitute the decision and order of the Court.

Dated: 6/12/2003



HON. WALTER B. TOLUB, J.S.C.

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