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## 'Here's Johnny' belongs to Carson

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A Michigan salesman's strategy for promoting his outhouses is in the toilet — again.

The salesman, Earl J. Braxton, was trying to register "Here's Johnny" — the phrase that long introduced "Tonight Show" host Johnny Carson — as a trademark for his portable potties. And when intellectual property attorneys from Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP caught wind of it, they got to work to stop it.

The lawyers were recently awarded summary judgment for their client, The John W. Carson Foundation, in a ruling that the phrase is not available for use as a slogan for the portable toilets company — even though Carson is no longer alive. The ruling came in late March from the Trademark Trial and Appeal Board, a Virginia-based administrative tribunal of the U.S. Patent and Trademark Office.

Pattishall partner Robert M. Newbury thought the matter had been put to rest in 1983, a few years after Braxton started Here's Johnny Portable Toilets Inc. Back in the late 1970s, Newbury represented Carson in a federal lawsuit against the toilet company, alleging unfair competition, trademark infringement, and invasion of privacy and publicity rights. The U.S. District Court for the Eastern District of Michigan found for the defendant.

However, in a major case over the misappropriation of a celebrity's publicity rights, the Cincinnati-based 6th U.S. Circuit Court of Appeals in 1983 found that Carson had the identity rights in the "Here's Johnny" phrase. Based on that holding, the district court issued a nationwide injunction against the Michigan man from using "Here's Johnny" for commercial purposes, which was subsequently affirmed by the 6th Circuit.

Decades after that 1983 decision in *Carson v. Here's Johnny Portable Toilets Inc.*, 698 F.2d 831, "I was curious to see this thing come up again," Newbury said. This time initiated by the owner of Toilets.com, the same owner of the portable toilets company in the earlier Carson case. He had submitted an application after Carson died to register the phrase as a trademark for a company with a name different from the one in the previous federal case.

Newbury said one of his partners

discovered the publication of the mark in the Official Gazette — a journal of the U.S. Patent and Trademark Office that displays trademarks that are potentially about to be registered. The Pattishall attorneys contacted the principals of Carson's foundation, who gave the green light to oppose the registration of the mark.

"They still consider this ["Here's Johnny"] an important aspect of Johnny Carson's identity," Newbury said.

It was important enough to Carson in the late '70s and early '80s, Newbury said, when the celebrity was in his prime.

"Certainly the toilet connotation — that I could speak to from the prior case — was not something he was happy about," Newbury said.

David M. Beeman, a third-year associate at the firm, said he studied the 1983 decision when he first read about it in law school.

"In some ways, it was great because it almost represents a full circle coming together — from the classroom, where you're learning about a case, and then being able to work on the successor to that case shortly after law school," Beeman said.

In addition to Newbury and Beeman, Pattishall partners Jonathan S. Jennings, and Phillip Barengolts represented the John W. Carson Foundation in the latest go-around before the Trademark Trial and Appeal Board. Michigan attorney Remy J. Vanophen represented Toilets.com. He could not be reached for comment.

The 6th Circuit ruling in 1983 was precedential, Beeman said, in that it expanded the scope of the right of publicity. The court concluded that Carson had a publicity right in the "Here's Johnny" phrase because it famously referred to him on the television show, and that the defendant's use of the phrase in association with portable toilets violated Carson's right, Beeman said.

"Typically, if you use someone's name in association with a product, that's the traditional right of publicity infringement," Beeman said. "Few courts had ever really expanded the right of publicity out beyond the narrow confines of name and image," he said. "Here, there's something that's more abstract, yet it's closely associated with this person."

In the latest case before the Trademark Trial and Appeal Board, Carson's foundation alleged that Toilets.com could not have a bona



This image was used in the early '80s as a trial exhibit in federal litigation against a Michigan portable toilets company that was attempting to use the phrase "Here's Johnny" for commercial purposes.

vide intent to use the "Here's Johnny" mark in commerce because the 1983 permanent injunction prohibited it from doing so. Also, the foundation contended that the doctrine of *res judicata* prohibited the company from registering the signature phrase because the same parties litigated the same issues to final judgment in the 1983 proceedings.

Toilets.com argued that it is a different party from the defendant in the prior civil action and therefore the injunction did not bar it from using the mark for portable toilets, according to the appeal board's precedential written opinion.

The board awarded summary judgment to the foundation on both counts.

It also found that Carson's rights to the signature phrase had passed to his foundation upon his death. The appeals board noted that the jurisdiction of the court that issued the permanent injunction — Michigan — recognizes a common law postmortem right to publicity and that California, where Carson lived at the time of his death, also has a statutory postmortem right of publicity.

The Pattishall attorneys said the decision shows that even in death, Carson, and individuals similarly situated, have a commercial right in their image, likeness and in things that are closely associated with their identity, and that they can protect that from commercial exploitation from other people.

"That association hasn't been extinguished by death," Newbury said. "His estate has something that should be protected."

Beeman said while the board does not have a precedential force like that of a federal district court, the decision is important for other cases that come before it with similar circumstances.

"I think it will be, at the very least, influential and persuasive," Beeman said.