



Pattishall Attorneys Win Summary Judgment for The John W. Carson Foundation, Defeating Application to Register HERE'S JOHNNY as a Trademark for Portable Toilets

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In a precedential decision, the Trademark Trial and Appeal Board ("TTAB") awarded summary judgment to Johnny Carson's The John W. Carson Foundation in its opposition to Toilets.com's application to register HERE'S JOHNNY as a trademark for portable toilets in the Patent and Trademark Office ("PTO"). *The John W. Carson Foundation v. Toilets.com, Inc.*, Opposition No. 91181092 (T.T.A.B. Mar. 25, 2009).¹ Pattishall attorneys Robert Newbury, Jonathan S. Jennings, Phillip Barendolts and David Beeman represented The John W. Carson Foundation in the action.

This was not the first time that Pattishall attorneys defended Johnny Carson against an attempt to register HERE'S JOHNNY as a trademark for portable toilets. In 1983, Pattishall successfully represented Johnny Carson in federal litigation against Here's Johnny Portable Toilets, Inc., when it applied to register HERE'S JOHNNY for portable toilets, as shown in the image below:



See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). In a decision that expanded the scope of the right of publicity, the Sixth Circuit found that Johnny Carson had a publicity right in the phrase "Here's Johnny" because it famously referred to Johnny Carson on The

¹ The case has received substantial media attention, including the following reports:
http://www.nypost.com/p/entertainment/tv/john_case_gets_flushed_5R2pmLc1hxzPutxQApWrMM and
<http://thresq.hollywoodreporter.com/2010/04/johnny-carson.html>.



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Tonight Show, and defendant's use of the phrase in association with portable toilets violated Carson's right. As a result, the court permanently enjoined the defendant—as well as its "agents" and "employees"—from using the phrase "Here's Johnny" commercially. Based on the injunction, the PTO refused the defendant's application to register HERE'S JOHNNY as a trademark in 1984.

In 2006, a new company, Toilets.com applied to register HERE'S JOHNNY for portable toilets. The owner and president of Toilets.com was the same individual who owned and operated Here's Johnny Portable Toilets, the defendant in the prior *Carson* case. The John W. Carson Trust, which transferred Johnny Carson's publicity rights to The John W. Carson Foundation during the pendency of the dispute, alleged that Toilets.com could not have a *bona fide* intent to use the HERE'S JOHNNY mark in commerce because the 1983 permanent injunction prohibited it from doing so. Additionally, The Foundation alleged that the doctrine of *res judicata* prohibited Toilets.com from registering HERE'S JOHNNY because the same parties litigated the same issues to final judgment in the 1983 proceedings.

The TTAB awarded summary judgment to The John W. Carson Foundation on both counts, finding that the parties in the current proceeding were legally equivalent to the parties in the 1983 proceeding, the case raised the same issues, and the prior case reached a final adjudication on the merits. Therefore, *res judicata* precluded a retrying of the case. Significantly, in finding that the issues were the same, the TTAB clarified the relationship between the right of publicity and Section 2(a) of the Trademark Act, explaining: "A claim of false suggestion of a connection under Section 2(a) of the Trademark Act is merely a codification of a claim of violation of the right of publicity." *John W. Carson Foundation*, Opposition No. 91181092 at 16. The TTAB also found it a "legal impossibility for applicant [Toilets.com] to have a *bona fide* intent to use the mark in commerce," because the permanent injunction, by its words, prohibited use in commerce. *Id.* at 19-20. Finally, the decision reaffirmed the law of California and Michigan, holding that the right of publicity extends beyond death in those states.

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