

**UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY**

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MARC DORSEY, :  
 :  
 Plaintiff, : 2:06-cv-02940-JAG-MCA  
 : ECF Case  
 – against – :  
 :  
 BLACK PEARL BOOKS, INC., :  
 FELICIA HURST and DAMION, :  
 MILLER, :  
 :  
 Defendants. :  
 :  
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**REPLY MEMORANDUM OF LAW  
IN SUPPORT OF PLAINTIFF’S MOTION  
FOR A PRELIMINARY NATIONWIDE INJUNCTION  
AND A RECALL ORDER**

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## **PRELIMINARY STATEMENT**

Plaintiff Marc Dorsey submits this reply memorandum of law in support of his application for a preliminary nationwide injunction based on his Lanham Act and common law misappropriation claims, enjoining defendants Black Pearl Books, Inc. and its owner and operator Felicia Hurst (collectively “Black Pearl”) from continuing to publish and distribute or otherwise exploit the book Legit Baller (the “Book”), which prominently and recognizably bears Mr. Dorsey’s likeness on the front and back covers, as well as other materials that contain Mr. Dorsey’s likeness, and requiring Black Pearl to recall any of Black Pearl’s other books and materials that contain Mr. Dorsey’s likeness, from bookstores and other commercial and retail outlets throughout the United States.

Black Pearl has, in its answering papers, not argued that its conduct does not violate the common law of New Jersey insofar as it pertains to the unauthorized use of an individual’s likeness, as set out in plaintiff’s moving papers. It thereby concedes plaintiff’s likelihood of success on the merits of his misappropriation claim. Its other arguments in opposition to the motion are unavailing, and mostly advert to the fact that Black Pearl is small and may be ruined if required to bear the costs of its outrageous and high-handed conduct. Black Pearl continues to ignore the effect of its actions on the one person whom they most affect: Mark Dorsey, who – it is uncontroverted – never gave permission for his face to be used to sell Black Pearl’s books.

## **REPLY STATEMENT OF FACTS**

Black Pearl admits that Black Pearl books are sold in major urban and entertainment centers, such as New York, Chicago, Los Angeles, Washington D.C., Baltimore and Atlanta – the same markets where an urban entertainer such as Marc Dorsey is most likely to find an

audience for his music and celebrity, and where his image is most susceptible to damage due to misappropriation.

Black Pearl's claims to a good-faith basis for believing it had permission to use Marc Dorsey's photograph are comically self-serving. The Hurst Affidavit attaches numerous documents in which the various defendants engage in an parody of licensing a third person's likeness almost worthy of the Marx Brothers' "party of the first part" routine: They go round in circles, purporting to license, to warrant, to "bond" – all agreeing with each other that what they are doing is right, honorable and guaranteed – all, that is, except the person whose image is actually being used, Marc Dorsey. Even if good faith were a defense to misappropriation and trademark infringement, which it is not, it is preposterous for defendants to suggest that the self-serving documents they exchanged between them somehow substitute for Mr. Dorsey's permission.

Underscoring the frivolousness of its arguments, Black Pearl points to an agreement between a "business associate" of defendant Damion Miller,<sup>1</sup> Ms. Hurst and Black Pearl Books, Inc. which purports to grant Black Pearl usage rights to Mr. Dorsey's image. The inherent problem in Black Pearl's argument is that neither Mr. Miller nor his business associate had any such rights to give Ms. Hurst or Black Pearl Books, Inc., regardless of whether they owned "the photos" or not. Suppose for example, that Mr. Dorsey took a photograph of a pop music star such as Madonna as she was walking on the street. Mr. Dorsey would be the legitimate copyright owner of that photograph. He could display it and show it off as his own work, but he would not have the right to use, or the authority to grant a third party the right to use, that image for commercial purposes without first obtaining a written model release from Madonna.

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<sup>1</sup> Mr. Miller, who has defaulted in this action, apparently has found time to swear out an affidavit for Black Pearl, Black Pearl and Hurst.

Deliberately or not, Black Pearl never obtained a model release from Mr. Dorsey here. That puts an end to its defense.

Apparently recognizing the precariousness of its position, Black Pearl claims that defendant Damion Miller himself had secured the licensing rights to the photographs in question because Kenny Flanagan of KAS Collection, the promoter who set up the photo session, signed a document purporting to grant Miller's company the right "to use photos as they see fit for advertising purposes or personal use." Exhibit A to Miller Aff. As the Certification of Kenny Flanagan, filed with this brief, makes clear, however, there is no basis for Black Pearl's assertion. At most the only permission purportedly granted was for **Miller's company and Miller personally** to utilize the photos to advertise Miller's own photography portfolio. Miller was granted no right to license the photos to anyone else. Again, even granting the fanciful interpretation of defendant Miller, the transaction is completely silent as to the man whose picture is being hawked and misappropriated, and there is not even a claim in this "release" that that man, Marc Dorsey, was to have anything to say about the matter.

Finally, Black Pearl makes much of its offer to pause adding insult to injury by restraining from further distribution of Marc Dorsey's face on its books, and simulates offense that this motion was not withdrawn in consideration of that supposedly generous offer. Black Pearl fails to explain or even address why, in its original communications with counsel, it repeatedly and high-handedly rebuffed Mr. Dorsey's demands that his picture not continue to be misappropriated and his image infringed, as set out in Mr. Dorsey's moving papers. Only when faced with the consequences of its behavior has Black Pearl made the slightest movement in the direction of compromise. Even then, it refused to remove from circulation what it claims is a relatively small number of books bearing photographs, front and back, of a man it cannot say

ever gave it permission to use them. And slight this movement it is: Legit Baller can still be purchased, and its cover featuring Mr. Dorsey can still be viewed in living color, online at Black Pearl's own website. See, Second Certification of Ronald D. Coleman, Esq.

## **ARGUMENT**

### **I. PLAINTIFF MEETS THE REQUIREMENTS FOR PRELIMINARY INJUNCTIVE RELIEF**

Black Pearl's brief is long on general principles of well-known law, but short on application of those principles to this case. As demonstrated below, for this reason plaintiff maintains that Black Pearl has failed to rebut his strong showing of entitlement to a preliminary injunction in this matter.

#### **A. Plaintiff is Likely to Succeed on His Claims Arising Out Of Black Pearl's Misappropriation and Use of His Likeness**

##### **1. Plaintiff's Misappropriation/Right of Publicity Claim**

Defendants' opposition brief discusses only Mr. Dorsey's Lanham Act claim in its legal analysis of the plaintiff's likelihood of success on the merits, the key element for the granting of a preliminary injunction. Thus, Black Pearl has conceded that Mr. Dorsey is likely to succeed on his state law claim for misappropriation/right of publicity, which alone meets the test of likelihood of success on the merits. Even if Mr. Dorsey were unlikely to succeed on his Lanham Act claim, which is not the case here, the law is clear that he would nevertheless still be entitled to injunctive relief on his misappropriation and the right of publicity claims. See Estate of Presley v. Russen, 513 F. Supp. 1339, 1352-53 (D.N.J. 1981); Edison v. Edison Polyform & Mfg. Co., 73 N.J. Eq. 136, 67 A. 392 (Ch. 1907); Palmer v. Schonhorn Enterprises, Inc., 96 N.J. Super. 72 (Ch. Div. 1967). See also Canessa v. J. I. Kislak, Inc., 97 N.J. Super. 327 (Law Div. 1967) (New Jersey always enjoins the use of plaintiff's likeness and name on the specific basis

that it is a protected property right; it is as much a property right after its wrongful use by defendant as it might be before such use).

**2. Plaintiff's Claim Under Section 43(a) of the Lanham Act**

Besides conceding the misappropriation/right of publicity claim, Black Pearl defends plaintiff's Lanham Act claim mainly by attempting to raise spurious fact issues. One is that "Mr. Dorsey's name is never mentioned" in Legit Baller – and odd point to make considering that Mr. Dorsey never claims that his name was mentioned. The only claim made here is that by placing Mr. Dorsey's **likeness** on the front and back covers of the Book, Black Pearl has confused and deceived the public into believing that Mr. Dorsey permitted this conduct and thereby endorsed, sponsored or otherwise approved of the Book. Black Pearl ignores the well established case law, set out in Mr. Dorsey's moving brief, that a false endorsement occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of the product or service, as set out in the extensive citations in plaintiff's moving brief. There is certainly little fact question, despite the claim that one exists, but that Mr. Dorsey is a recognized and recognizable person. He has described in his affidavit numerous instances of actual confusion that demonstrate that that Black Pearl's conduct has harmed the value of his image as a trademark. Dorsey Aff. at ¶¶ 9, 25, 34-36.

**B. Plaintiff Will Suffer Irreparable Harm If the Court Does Not Grant An Injunction**

Black Pearl insists that a preliminary injunction is not warranted because it has not yet had the opportunity to irreparably harm Mr. Dorsey's image. He has, it claims, not yet suffered an identifiable economic loss. This argument ignores the facts set out in detail in Mr. Dorsey's affidavit in which he clearly explains how the continued sale and promotion of this book is likely to damage his successful and accelerating entertainment career and community-oriented



activities. Once that damage is suffered, it will be impossible to estimate what economic value the image of this attractive young artist will be worth. Black Pearl urges this Court to wait and deny equitable relief to Mr. Dorsey until it is too late, even as it claims it is not capable of satisfying any serious financial damages award.

Because Legit Baller has supposedly not sold well, Black Pearl argues that the possibility of harm is slight. But it does not deny, nor could it, that its use of Mr. Dorsey's image is available to the whole world at any time over the Internet. Indeed no effort was made, nor was a request honored, to discontinue the use of that photograph on the Internet even pending the outcome of this hearing. But Black Pearl can comfortably argue that the probability of harm to Mr. Dorsey of the association of his photo with a scandalous fictional work is slight for a simple reason: As its behavior indicates, it simply does not reckon harm to him. It does not care what harm comes to him. Just as it paid him nothing to use his picture, and continues its use today, it values his right to control his own image at zero for the simple reason that it wants that right for themselves and believes that it should be allowed merely to take it.

**C. Any Harm that Black Pearl May Suffer Is Outweighed by the Harm to Plaintiff If No Preliminary Injunction is Issued**

Black Pearl argues that the balancing of harms favors it because Black Pearl is a small, poor company that chose to borrow money to hire a lawyer rather than acknowledge its misdeeds and attempt some form of cure prior to litigation and prior to the decision on this motion. In fact, it makes its own lack of success a virtue, stating that it is so unsuccessful that it **needs** to continue exploiting Marc Dorsey's image as a free advertisement for their wares. "The overall effect [of a recall] would snowball into financial ruin and complete corporate dissolution," it argues. And as between Black Pearl and Mark Dorsey, who, therefore, should bear the cost for

Black Pearl's shoddy licensing and clearance system; for its refusal to deal courteously with Mr. Dorsey prior to the filing of this litigation; for its repeated and ongoing insistence that, rather than protecting his own image and his own career, Mr. Dorsey and his attorneys were part of some sort of conspiracy?

Marc Dorsey, Black Pearl insists, should bear that cost. It is only his face. It is only his career. The law, however, does not support the argument that Marc Dorsey must be required to lend his image and mortgage his career to Black Pearl's emerging litigation strategy. Indeed, it is telling that while Black Pearl repeatedly insists it neither knew who Marc Dorsey was nor had – despite all indications to the contrary – any reason to believe he had not approved of the use of his pictures to sell its books, **today** – when it does know what is at stake; and when it does know who he is, and what he has to lose, and that he has indeed never given permission to use his picture on the covers of its books, on its website, in its advertisements – **today that use continues essentially unabated.**

Not only is Black Pearl's calculus wrong for failing completely to reckon the value of this young celebrity's financial and moral interest in his image. But also its faith, despite claims to the contrary, is bad. It has refused to abate its online use of his image in the slightest; it has withdrawn no books; it has merely stopped selling books it claims no one really wants to buy – all the while maintaining the use of Marc Dorsey's image in the full range of its promotional materials. It has in fact, since the first time it received a cease and desist letter months ago, not only failed to mitigate the hardship it faces but exacerbated it – because to this very moment, Black Pearl does not believe it has done, it is doing, anything wrong to Marc Dorsey.

The law, however, says otherwise. For this reason, Black Pearl simply cannot be heard to complain of an imbalance of hardships, and on this prong of the preliminary injunction analysis

