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RIGHT OF PUBLICITY AND THE INTERSECTION OF COPYRIGHT AND TRADEMARK LAW

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I. Introduction to Right of Publicity Law

The Right of Publicity has its root in privacy law. Samuel Warren and Louis Brandeis, in an 1890 article in the Harvard Law Review, first defined this right as the right “to be left alone”. William Prosser followed their lead by enunciating a personal right of privacy based in four categories: 1) Protection against intrusion into one’s private affairs; 2) Avoidance of disclosure of one’s embarrassing private facts; 3) Protection against publicity placing one in a false light in the public eye; and 4) Remedies for appropriation, usually for commercial advantage, of one’s name or likeness.

The first three of these categories sound in tort – they protect a person’s right to privacy; but the fourth category doesn’t fit well with the first three – and appears based more on a personal right – an asset if you will – which sounds more like a property right than a personal one. Reflective of this difference is the fact that rights of privacy have generally not found their way into statutory construction, and are instead articulated and refined in case law – whereas rights of publicity are based equally in statutory law as well as case law.

Three elements are commonly accepted as comprising the Right of Publicity: the use of a well known person’s “name, image and likeness.” While slight differences in this configuration are found in different state statutes, the concept embodied in these elements are found in all of the statutes. What is often missing is a broader view of the right – a view which incorporates not just name, image and likeness, but also any and all personality and appearance characteristics, such as distinctive clothing and voice. These added items, referred to as the “elements of identifiability”, are generally deemed to be “common law” right of publicity elements. The protection of these elements is what critics generally decry as an unwarranted expansion of the right of publicity. California is one state that embraces, through the doctrine of common law right of publicity, this expansive view. Ninth Circuit Chief Judge Alex Kozinski has been sharply critical of this trend, writing spirited dissents in the *Vanna White v. Samsung*, and *Wendt v. Host International* cases.

Another issue in Right of Publicity law is the scope of its coverage – i.e., is it limited to celebrities, or can anyone own this right. The majority view is that the Right of Publicity extends to every individual, not just those who are famous. California’s law refers to the right as belonging to a “personality”. But as a practical matter, Right of Publicity disputes usually involve celebrities, since it is they who possess the names and images that help enhance advertisements and sell or “hype” products. Professionals whose names are used in their businesses, such as law firm partners, are also people for whom Right of Publicity claims can be asserted.

Another important issue is whether the Right of Publicity should apply only during the life of a well-known person, or should extend to post-mortem contexts. California and some of the other states which have enacted Right of Publicity statutes, allows post-mortem rights – New York does not. In states where post-mortem rights do exist, some statutes require that a person must have exploited their celebrity status during their life; others do not impose this requirement, but do require that the name and related rights acquired commercial value during life.

The Right of Publicity is generally taught in law schools as a subset of entertainment law, and is distinguished from the major intellectual property rights sources of copyright and trademark.

Jonathan Faber, in an article praising the state of Indiana’s approach to Right of Publicity, offers an excellent summary of how the Right is to be distinguished from traditional copyright and trademark law:

“The Right of Publicity has little to do with copyright. Copyright applies to the bundle of rights one acquires in “original works of authorship fixed in any tangible medium of expression,” according to 17 U.S.C. Section 102 (a), so the exclusive rights held by a copyright owner apply to the work itself. This can get complicated, as Right of Publicity and copyright considerations can simultaneously be implicated in a single usage. An advertisement featuring a celebrity’s picture may require authorization from the photographer for the copyright use, and from the celebrity for the Right of Publicity use. Because these are wholly distinct claims with independent parties charged with standing to assert them, federal copyright laws generally will not preempt a state-based, Right of Publicity claim.

There are, however, some noteworthy similarities between the Right of Publicity and trademark law. Theoretically, the Right of Publicity is of the same genus as unfair competition and, more precisely, the doctrine of misappropriation—two hallmarks of trademark law, as reflected in the Lanham Act. Like a trademark, the Right of Publicity can function as a quality assurance to a consumer, especially if a celebrity, or his or her estate, maintains self-imposed quality standards and exercises discretion in licensing publicity rights. Also, proprietors of both trademark and publicity rights seek to prevent others from reaping unjust rewards by appropriation of the mark or celebrity’s fame.

The Supreme Court of the United States has reviewed the Right of Publicity only once, in the seminal case of *Zacchini v. Scripps-Howard Broadcasting*. *Zacchini* involved a famous “human cannonball” who objected to his entire 15-second performance being

televised on the local news. The value of his act depended on the public's desire to witness the event, so televising the event detracted from the demand of people willing to pay to see his act.

The Court recognized Zacchini's Right of Publicity and rejected the Broadcasting Company's First and Fourteenth Amendment defenses. In so doing, the Court noted that the decision was not merely to ensure compensation for the performer; rather, it was to provide "an economic incentive for him to make the investment required to produce a performance of interest to the public." 433 U.S. 562, 576 (1977). Thus, in language reminiscent of the policies supporting copyright and patent laws, Justice White solidified the foundation of the Right of Publicity.

Despite the financial wealth and adulation that often (but not always) accompany fame, celebrity status carries a hefty price tag. Benedict (Baruch) Spinoza, writing more than 300 years ago, identified this trade-off: "Fame has also this great drawback, that if we pursue it we must direct our lives in such a way as to please the fancy of men, avoiding what they dislike and seeking what is pleasing to them." (1632.1677; from *Tractatus de Intellectus Emendatione*).

Recognition of this dilemma underscores the policies supporting the Right of Publicity. Celebrities typically invest considerable energy in nurturing their public image, and few can argue that it would be anything but unfair for a business to siphon the celebrity's success into their advertising or products to increase sales, without compensating the celebrity for the heightened profits, profile or recognition of the product or company.

If the manipulation of one's image in order to increase revenue streams is nothing new, the advent of publicity laws in the 20th century at least ensure that the profits derived from these valuable personas are more equitably channeled. Indeed, publicity laws have led to results that the achievers and celebrities of previous ages, could merely wish for, as *The Wall Street Journal* recently explored in a special Millennium edition: "Thanks to their ability to sell tickets and raise television ratings, top stars now command contrasts and fees that make them more wealthy than the royal patrons who supported entertainers of yore." Peter Gumber, "Fame and Fortune," *The Wall Street Journal*, Jan. 11, 1999 at R34).

The policies supporting Right of Publicity laws are not simply about ensuring that a celebrity or celebrity estate gets paid. It is also about the right to control how a celebrity is commercialized, or if he or she will be used at all. As Vince Lombardi Jr. has said: "Nothing anyone can do is going to enhance my father's reputation, but they certainly can detract from it." (Mark Hyman, *Dead Men Don't Screw Up Ad Campaigns*, *Business Week*, March 10, 1997). Thus, the ability to control commercialization in the first place is as much a policy objective of the Right of Publicity as is providing revenue streams for the rightful recipient.

As of this writing, nineteen states recognize the Right of Publicity via statute (California, Florida, Indiana, Illinois, Kentucky, Massachusetts, New York, Nebraska, Nevada, Ohio,

Oklahoma, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington and Wisconsin). The majority view is that the right exists by common law in every state that has not defined its position through legislation. The American Law Institute's Third Restatement of Unfair Competition (1995) §46 also recognizes the Right of Publicity as a distinct and viable legal theory. However, the parameters of the right vary from state to state, depending on the provisions of any given statute.

The variations between state Right of Publicity laws occasionally generate scholarly debate over whether a federal Right of Publicity statute would be beneficial. Because of the aforementioned parallels with trademark law, some have proposed that the proper place for a federal Right of Publicity statute is in the Lanham Act. But as the policies and function of Right of Publicity and trademark laws vary, this notion is problematic, if not untenable.

The Patent, Trademark & Copyright Section of the American Bar Association has occasionally explored federalization of the Right of Publicity. To date at least, these types of efforts have broken down under the strain of competing interests and unresolved debate. Even without a Federal Right of Publicity statute, the state-based regime is not as unmanageable as it may appear, as there is a discernible consistency in Right of Publicity case law, even from jurisdiction to jurisdiction. It just takes some getting used to, perhaps."

Adapted from Indiana: A Celebrity Friendly Jurisdiction, by Jonathan Faber, published in *Res Gestae*, March 2000, Vol. 43, No. 9.

II. Right of Publicity Law in California

California joined the nineteen states with Right of Publicity statutes in 1972, with the adoption of Section 3344 of the California Civil Code. This section codified case law and created a Right of Publicity for living persons. In 1995, California extended the right to deceased personalities via the enactment of Section 990 of the Civil Code, giving the heirs a right to protect the publicity value of a deceased personality for a period of fifty years after death. Confusion resulted due to the numbering scheme for these sections, and in 1999 Section 990 was renamed Section 3344.1, so that both Right of Publicity statutes would be found next to one another.

Robyn Astaire, the widow of famous movie star and dancer Fred Astaire, was a leading force behind the amendment and renumbering of the bill. At her urging the amended Section 3344.1 banned the alteration or manipulation of a deceased's name, voice, signature, photograph or likeness in a false manner that is portrayed as factual, unless the personality's heirs consent. The impetus for this amendment was a 1997 Super Bowl television commercial for a Dirt Devil vacuum cleaner, which took a black and white film clip of Astaire dancing, and put a vacuum cleaner in his hands – a use condemned as beyond creepy by most critics. Absent the amendment, there was little that heirs could do but watch helplessly as these public domain films, no longer covered by copyright law, were used to suggest that Ed Sullivan endorsed Mercedes-Benz M-Class vehicles, or that Lucille Ball shopped at Service Merchandise.

Section 3344.1 was amended in 2008 to provide that the post-mortem Right of Publicity was available to the heirs of personalities who died before 1985. The right would be held by any personality whose likeness, name, voice or photograph had commercial value at the time of their death. Another effort to modify the statute, although passed by the California legislature in the 2009-10 sessions, was apparently vetoed by the Governor of California. This amendment sought to extend the rights to deceased persons who became celebrities *because* of their death.

Below is the current text of the California statutes:

CAL. CIV. CODE § 3344

(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney's fees and costs.

(b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable.

(1) A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.

(2) If the photograph includes more than one person so identifiable, then the person or persons complaining of the use shall be represented as individuals rather than solely as members of a definable group represented in the photograph. A definable group includes, but is not limited to, the following examples: a crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.

(3) A person or persons shall be considered to be represented as members of a definable group if they are represented in the photograph solely as a result of being present at the time the photograph was taken and have not been singled out as individuals in any manner.

(c) Where a photograph or likeness of an employee of the person using the photograph or likeness appearing in the advertisement or other publication prepared by or in behalf of the user is only incidental, and not essential, to the purpose of the publication in which it appears, there shall arise

a rebuttable presumption affecting the burden of producing evidence that the failure to obtain the consent of the employee was not a knowing use of the employee's photograph or likeness.

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(e) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a use for which consent is required under subdivision (a) solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

(f) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that such owners or employees had knowledge of the unauthorized use of the person's name, voice, signature, photograph, or likeness as prohibited by this section.

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

CAL. CIV. CODE § 3344.1 (as amended in 2008 – amended language underlined)

(a)(1) Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the person or persons specified in subdivision (c), shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by the injured party or parties, as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing these profits, the injured party or parties shall be required to present proof only of the gross revenue attributable to the use and the person who violated the section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party or parties in any action under this section shall also be entitled to attorney's fees and costs.

(2) For purposes of this subdivision, a play, book, magazine, newspaper, musical composition, audiovisual work, radio or television program, single and original work of art, work of political or newsworthy value, or an advertisement or commercial announcement for any of these works, shall not be considered a product, article of merchandise, good, or service if it is fictional or nonfictional entertainment, or a dramatic, literary, or musical work.

(3) If a work that is protected under paragraph (2) includes within it a use in connection with a product, article of merchandise, good, or service, this use shall not be exempt under this subdivision, notwithstanding the unprotected use's inclusion in a work otherwise exempt under this subdivision, if the claimant proves that this use is so directly connected with a product, article of merchandise, good, or service as to constitute an act of advertising, selling, or soliciting purchases of that product, article of merchandise, good, or service by the deceased personality without prior consent from the person or persons specified in subdivision (c).

(b) The rights recognized under this section are property rights, freely transferable or descendible, in whole or in part, by contract or by means of any trust or any other testamentary instrument, executed before or after January 1, 1985. The rights recognized under this section shall be deemed to have existed at the time of death of any deceased personality who died prior to January 1, 1985, and, except as provided in subdivision (o), shall vest in the persons entitled to these property rights under the testamentary instrument of the deceased personality effective as of the date of his or her death. In the absence of an express transfer in a testamentary instrument of the deceased personality's rights in his or her name, voice, signature, photograph, or likeness, a provision in the testamentary instrument that provides for the disposition of the residue of the deceased personality's assets shall be effective to transfer the rights recognized under this section in accordance with the terms of that provision. The rights established by this section shall also be freely transferable or descendible by contract, trust, or any other testamentary instrument by any subsequent owner of the deceased personality's rights as recognized by this section. Nothing in this section shall be construed to render invalid or unenforceable any contract entered into by a deceased personality during his or her lifetime by which the deceased personality assigned the rights, in whole or in part, to use his or her name, voice, signature, photograph or likeness, regardless of whether the contract was entered into before or after January 1, 1985.

(c) The consent required by this section shall be exercisable by the person or persons to whom the right of consent, or portion thereof, has been transferred in accordance with subdivision (b), or if no transfer has occurred, then by the person or persons to whom the right of consent, or portion thereof, has passed in accordance with subdivision (d).

(d) Subject to subdivisions (b) and (c), after the death of any person, the rights under this section shall belong to the following person or persons and may be exercised, on behalf of and for the benefit of all of those persons, by those persons who, in the aggregate, are entitled to more than a one-half interest in the rights:

(1) The entire interest in those rights belong to the surviving spouse of the deceased personality unless there are any surviving children or grandchildren of the deceased personality, in which case one-half of the entire interest in those rights belong to the surviving spouse.

(2) The entire interest in those rights belong to the surviving children of the deceased personality and to the surviving children of any dead child of the deceased personality unless the deceased personality has a surviving spouse, in which case the ownership of a one-half interest in rights is divided among the surviving children and grandchildren.

(3) If there is no surviving spouse, and no surviving children or grandchildren, then the entire interest in those rights belong to the surviving parent or parents of the deceased personality.

(4) The rights of the deceased personality's children and grandchildren are in all cases divided among them and exercisable in the manner provided in Section 240 of the Probate Code according to the number of the deceased personality's children represented. The share of the children of a dead child of a deceased personality can be exercised only by the action of a majority of them.

(e) If any deceased personality does not transfer his or her rights under this section by contract, or by means of a trust or testamentary instrument, and there are no surviving persons as described in subdivision (d), then the rights set forth in subdivision (a) shall terminate.

(f)(1) A successor in interest to the rights of a deceased personality under this section or a licensee thereof may not recover damages for a use prohibited by this section that occurs before the successor in interest or licensee registers a claim of the rights under paragraph (2).

(2) Any person claiming to be a successor in interest to the rights of a deceased personality under this section or a licensee thereof may register that claim with the Secretary of State on a form prescribed by the Secretary of State and upon payment of a fee as set forth in subdivision (d) of Section 12195 of the Government Code. The form shall be verified and shall include the name and date of death of the deceased personality, the name and address of the claimant, the basis of the claim, and the rights claimed.

(3) Upon receipt and after filing of any document under this section, the Secretary of State shall post the document along with the entire registry of persons claiming to be a successor in interest to the rights of a deceased personality or a registered licensee under this section upon the World Wide Web, also known as the Internet. The Secretary of State may microfilm or reproduce by other techniques any of the filings or documents and destroy the original filing or document. The microfilm or other reproduction of any document under the provisions of this section shall be admissible in any court of law. The microfilm or other reproduction of any document may be destroyed by the Secretary of State 70 years after the death of the personality named therein.

(4) Claims registered under this subdivision shall be public records.

(g) No action shall be brought under this section by reason of any use of a deceased personality's name, voice, signature, photograph, or likeness occurring after the expiration of 70 years after the death of the deceased personality.

(h) As used in this section, "deceased personality" means any natural person whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death, whether or not during the lifetime of that natural person the person used his or her name, voice, signature, photograph, or likeness on or in products, merchandise or goods, or for purposes of advertising or selling, or solicitation of purchase of, products, merchandise, goods, or services. A "deceased personality" shall include, without limitation, any such natural person who has died within 70 years prior to January 1, 1985.

(i) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any video tape or live television transmission, of any person, such that the deceased personality is readily identifiable. A deceased personality shall be deemed to be readily

identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine who the person depicted in the photograph is.

(j) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(k) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a use for which consent is required under subdivision (a) solely because the material containing the use is commercially sponsored or contains paid advertising. Rather, it shall be a question of fact whether or not the use of the deceased personality's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

(l) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that the owners or employees had knowledge of the unauthorized use of the deceased personality's name, voice, signature, photograph, or likeness as prohibited by this section.

(m) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

(n) This section shall apply to the adjudication of liability and the imposition of any damages or other remedies in cases in which the liability, damages, and other remedies arise from acts occurring directly in this state. For purposes of this section, acts giving rise to liability shall be limited to the use, on or in products, merchandise, goods, or services, or the advertising or selling, or soliciting purchases of, products, merchandise, goods, or services prohibited by this section.

(o) Notwithstanding any provision of this section to the contrary, if an action was taken prior to May 1, 2007, to exercise rights recognized under this section relating to a deceased personality who died prior to January 1, 1985, by a person described in subdivision (d), other than a person who was disinherited by the deceased personality in a testamentary instrument, and the exercise of those rights was not challenged successfully in a court action by a person described in subdivision (b), that exercise shall not be affected by subdivision (b). In such a case, the rights that would otherwise vest in one or more persons described in subdivision (b) shall vest solely in the person or persons described in subdivision (d), other than a person disinherited by the deceased personality in a testamentary instrument, for all future purposes.

(p) The rights recognized by this section are expressly made retroactive, including to those deceased personalities who died before January 1, 1985.

Because the California statutes only prohibit use of the personality's name, voice, signature, photograph, or likeness, it fell to common law and case law to resolve the issue of whether other aspects of a personality's elements of identifiability were protected. So in *Midler v. Ford Motor Co.* 849 F.2d 460 (9th Cir. 1989) and *Waits v. Frito-Lay, Inc.* 978 F.2d 1093 (9th Cir. 1992), the

Ninth Circuit extended protection to prevent imitators of celebrity voices from appropriating the distinctive sound of these singers. In *Motsenbacher v. J. Reynolds Tobacco Co.* (498 F.2d 921, 9th Cir. 1974), the Court added the distinctive racing suit and car of a professional race car driver to the elements of identifiability protected at common law.

In *White v. Samsung Electronics America, Inc.*, Defendant Samsung, as part of an ad campaign projecting the continued viability of their products in the future, they created an ad that utilized a robot that looked and acted like Vanna White of “Wheel of Fortune” fame. 971 F.2d 1395 (9th Cir. 1992). The case drew a great deal of attention because the robot did not have a face – just a blonde wig and pearls. However, the robot was depicted in a Wheel of Fortune set, and was turning letters on a light board, just as Vanna White did on the actual show. That was enough for the majority of the Court. Over a stinging dissent by Judge Alex Kozinski, the award to White of \$403,000 was affirmed. .

In a 1999 case, noted actor Dustin Hoffman asserted his Right of Publicity against a local magazine publisher, over a use of his image which did not suggest an endorsement, nor was it for an overtly commercial use. In *Hoffman v. Capital Cities/ABC, Inc., Los Angeles Magazine* ran a feature photo spread that used celebrity images from famous movie still shots without obtaining permission from the celebrities. 33 F.Supp. 2d 867 (C.D. Cal. 1999). The feature depicted digitally manipulated images through which it appeared that the celebrities were wearing newly created designer clothing. A photo of Hoffman’s award-winning character in “Tootsie” was dressed in a Richard Tyler gown and Ralph Lauren heels. Hoffman was awarded \$3,270,000 for the violation of his publicity rights, comprised of \$1.5 million in compensatory damages, \$1.5 million in punitive damages, and \$270,000 in attorney fees. On appeal, the case was overturned on First Amendment grounds.

III. Right of Publicity Law in New York

The first Right of Publicity law in the United States was enacted by New York with the New York Civil Right Law in 1903. The statute prohibits the use of the name, portrait, or picture of any living person without prior consent for “advertising purposes” or “for the purposes of trade.” This statute appears to have been influenced by the Warren and Brandeis article, and reflects the influence of celebrity culture in New York City. The focus of the statute was on the invasion of privacy that would accompany an appropriation of image – for that reason the statute was not labeled a Right of Publicity law.

It wasn’t until 1953 that the term “right of publicity” was used to identify this right. Judge Jerome Frank, in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* 202 F.2d 866 (2nd Cir. 1953), distinguished the “right of publicity” from the “right of privacy” by focusing on the economic interests involved, rather than the personal interests characteristic of the right of privacy. *Haelan* is credited as the first articulation of these interests under the label, “Right of Publicity.”

Here is the text of the current Right of Publicity law in New York State, which is still denominated as a right of privacy.

CIVIL RIGHTS LAW, ARTICLE 5. RIGHT OF PRIVACY
NY CLS Civ. R § 50 (2000)

§ 50. Right of privacy

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 her parent or guardian, is guilty of a misdemeanor.

CIVIL RIGHTS LAW, ARTICLE 5. RIGHT OF PRIVACY

NY CLS Civ. R § 51 (2000)

§ 51. Action for injunction and for damages

Any person whose name, portrait [fig 1] , picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait [fig 2] , picture or voice, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person's name, portrait [fig 3] , picture or voice in such manner as is forbidden or declared to be unlawful by section fifty of this article, the jury, in its discretion, may award exemplary damages. But nothing contained in this article shall be so construed as to prevent any person, firm or corporation from selling or otherwise transferring any material containing such name, portrait [fig 4] , picture or voice in whatever medium to any user of such name, portrait [fig 5] , picture or voice, or to any third party for sale or transfer directly or indirectly to such a user, for use in a manner lawful under this article; nothing contained in this article shall be so construed as to prevent any person, firm or corporation, practicing the profession of photography, from exhibiting in or about his or its establishment specimens of the work of such establishment, unless the same is continued by such person, firm or corporation after written notice objecting thereto has been given by the person portrayed; and nothing contained in this article shall be so construed as to prevent any person, firm or corporation from using the name, portrait, picture or voice of any manufacturer or dealer in connection with the goods, wares and merchandise manufactured, produced or dealt in by him which he has sold or disposed of with such name, portrait [fig 7] , picture or voice used in connection therewith; or from using the name, portrait [fig 8] , picture or voice of any author, composer or artist in connection with his literary, musical or artistic productions which he has sold or disposed of with such name, portrait [fig 9] , picture or voice

used in connection therewith. Nothing contained in this section shall be construed to prohibit the copyright owner of a sound recording from disposing of, dealing in, licensing or selling that sound recording to any party, if the right to dispose of, deal in, license or sell such sound recording has been conferred by contract or other written document by such living person or the holder of such right. Nothing contained in the foregoing sentence shall be deemed to abrogate or otherwise limit any rights or remedies otherwise conferred by federal law or state law.

IV. Right of Publicity Law in Pennsylvania

In 2002, the Pennsylvania legislature amended the PA Judiciary Code to create a cause of action in tort extending to natural persons the right to protect the use of their likenesses from unauthorized commercial exploitation. This right is in addition to, and distinguished from, other related torts such as false advertising, trademark and service mark infringement, copyright infringement, and various rights of privacy.

The statute, codified at 42 Pa.C.S.A. § 8316 and which became effective on February 7, 2003, requires written consent in order to use a person's likeness for commercial purposes. The right provided by the PA statute provides for such protections to last for thirty years after death, absent consent. The consent must be obtained from either the natural person or such person, firm or corporation with the authority to grant the same, such as: (i) a parent or guardian (if the natural person is a minor); (ii) an executor, surviving spouse, heirs or such other person, firm or corporation authorized in writing to represent the interests of such person if deceased; or (iii) any person, firm or corporation authorized in writing by such natural person to license the person's name or likeness for commercial or advertising purposes.

Prior to the statute's enactment, Pennsylvania courts had recognized a right of publicity under either the *Restatement (Third) of Unfair Competition* §46 or the *Restatement (Second) of Torts* §652C.

Here is the current text of the Pennsylvania statute:

§ 8316. Unauthorized use of name or likeness.

(a) Cause of action established. -- Any natural person whose name or likeness has commercial value and is used for any commercial or advertising purpose without the written consent of such natural person or the written consent of any of the parties authorized in subsection (b) may bring an action to enjoin such unauthorized use and to recover damages for any loss or injury sustained by such use.

(b) Parties authorized to bring action. -- Such action may be brought by:

(1) The natural person.

(2) A parent or guardian of a natural person, if the natural person is a minor.

(3) If such natural person is deceased, any person, firm or corporation authorized in writing to license the commercial or advertising use of the natural person's name or likeness by the natural person during the natural person's lifetime or by will or other testamentary device; an executor named in a will or designated by a court of competent jurisdiction; or where there is no such authorization, then by the deceased person's surviving spouse at the time of death until the surviving spouse's death or, in a case where there is no surviving spouse, then any other heir or group of heirs having at least a 50% interest in the deceased person's estate as provided for under law.

(4) Any other person, firm or corporation authorized in writing by such natural person to license the commercial or advertising purposes of the person's name or likeness.

(c) Repose. -- No action shall be commenced under this section more than 30 years after the death of such natural person.

(d) Immunity. -- No person, firm or corporation, including their employees and agents, in the business of producing, manufacturing, publishing or disseminating material for commercial or advertising purposes by any communications medium shall be held liable under this section unless they had actual knowledge of the unauthorized use of the name or likeness of a natural person as prohibited by this section.

(e) Definitions. -- As used in this section, the following words and phrases shall have the meanings given to them in this subsection:

"Commercial or advertising purpose."

(1) Except as provided in paragraph (2), the term shall include the public use or holding out of a natural person's name or likeness:

- (i) on or in connection with the offering for sale or sale of a product, merchandise, goods, services or businesses;
- (ii) for the purpose of advertising or promoting products, merchandise, goods or services of a business; or
- (iii) for the purpose of fundraising.

(2) The term shall not include the public use or holding out of a natural person's name or likeness in a communications medium when:

- (i) the natural person appears as a member of the public and the natural person is not named or otherwise identified;
- (ii) it is associated with a news report or news presentation having public interest;
- (iii) it is an expressive work;
- (iv) it is an original work of fine art;
- (v) it is associated with announcement for a commercial or advertising purpose for a use permitted by subparagraph (ii), (iii) or (iv); or
- (vi) it is associated with the identification of a natural person as the author of or contributor to a written work or the performer of a recorded performance under circumstances in which the written work or the recorded performance is lawfully produced, reproduced, exhibited or broadcast.

"Commercial value." --Valuable interest in a natural person's name or likeness that is developed through the investment of time, effort and money.

"Communications medium." --Includes, but is not limited to, a newspaper, magazine, book, newsletter, billboard, telephone, radio, television, recording, computer software, digital communications network, transit ad, audiovisual work or global communications network.

"Expressive work." --A literary, dramatic, fictional, historical, audiovisual or musical work regardless of the communications medium by which it is exhibited, displayed, performed or transmitted, other than when used or employed for a commercial or advertising purpose.

"Name" or "likeness." --Any attribute of a natural person that serves to identify that natural person to an ordinary, reasonable viewer or listener, including, but not limited to, name, signature, photograph, image, likeness, voice or a substantially similar imitation of one or more thereof.

"Natural person." --A living person or a deceased person who was domiciled within this Commonwealth at the time of such person's death.

In order to have an actionable claim under the statute, the plaintiff must an enforceable right in the name or identify of human being or group of human beings, and the name(s) or likeness(es) must have "commercial value," defined in the statute as a valuable interest "developed through the investment of time, effort and money." Further, the defendant must have used some aspect of such person's name or likeness (e.g., name, signature, photograph, image, likeness, voice or imitation of or more of the foregoing) without authorization in such a way that the person is identifiable from the defendant's commercial use, and such use has caused or is likely to cause damage to the commercial value of the plaintiff's enforceable right.

Certain activities are clearly carved out by the statute as not constituting a commercial or advertising purpose, including news reporting, and the statute provides immunity for any person, firm or corporation involved in the production, manufacture, publication or dissemination of materials unless they had actual knowledge of the unauthorized use of a person's name or likeness as prohibited by the statute. Plaintiffs may seek injunctive relief, as well as damages for any loss or injuries sustained by the unauthorized use.

V. The Intersection of Copyright and Right of Publicity Law

Noted entertainment attorney Marc J. Apfelbaum concisely summarized the issues arising in the intersection of Right of Publicity law and Copyright Law as follows:

"The incentives for creativity embodied in copyright law and the incentives for fame embodied in the right of publicity conflict when creative individuals use the personal attributes of others in their works. Under copyright law, a work is controlled by its creator. Thus, a book about a person belongs to its author, a sculpture of a person belongs to its sculptor, and a photograph of a person belongs to its photographer. Under the right of

publicity, however, control is often placed in the hands of the subject depicted in the creative work”

Apfelbaum also addresses the issue of what happens when a right of publicity claim is asserted, and the defense of First Amendment protection is proffered. His conclusion, that “the right of publicity is largely preempted by federal copyright law”, is generally true, however there have been some notable exceptions to this principle. In *Comedy Productions III v. Gary Saderup, Inc.* 25 Cal. 4th 387 (2001), the California Supreme Court noted, “The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.” Noting that Saderup’s drawings of The Three Stooges lacked a transformative contribution but were rather skillful but literal depictions of the actors, the Court held:

“Turning to Saderup’s work, we can discern no significant transformative or creative contribution. His undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame. Indeed, were we to decide that Saderup’s depictions were protected by the First Amendment, we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.”

The policy rationale behind preemption of right of publicity by copyright law is cogently articulated by the Ninth Circuit in their decision in *Laws v. Sony Music Entertainment*, 448 F. 3d 1134 (9th Cir. 2006). In that case, songwriter and performer Debra Laws entered into a standard recording agreement with Elektra/Asylum Records. She transferred copyright in the master recordings she did for the label, and also granted the label rights to use her publicity rights (name, image, likeness) for use in promoting sales of her recordings. She also gave Elektra the right to license her recordings for third party use, subject to her consent.

Elektra, quite possibly in breach of its contract with her, subsequently licensed rights to sample her recording of a song entitled “Very Special”, to Sony Music Entertainment for use on a sound recording and video starring Jennifer Lopez, joined on this particular track by well known artist L.L. Cool J. The song, in which the sample was added, “All I Have”, became the number one song in the U.S., and the album it was a part of, “This is Me...Then”, was a massive success, earning in excess of forty million dollars.

Laws sued Sony in state court, seeking damages on common law and statutory right of publicity grounds. Sony removed the case to federal court on the grounds that the gravamen of the complaint sounded in copyright law, and that the rights of publicity claims were preempted. Sony then filed a motion for summary judgment, which the District Court granted on the grounds that both the common law and statutory right of publicity claims were preempted.

On appeal, the Ninth Circuit affirmed the district court. The Court explained that the right of publicity is based on a desire to compensate the performer for the time and effort invested in his act, as opposed to the intellectual property rights which arise from the creation of a work of expression. The Court held that:

“[t]he right of publicity is not a license to limit the copyright holder’s rights merely because one disagrees with decisions to license the copyright. ...Were we to conclude that Laws’s voice misappropriation claim was not preempted by the Copyright Act, then virtually every use of a copyrighted sound recording would infringe upon the original performer’s right of publicity. ...It is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used.” *Id.* at 1145.

In a more recent case, the 9th Circuit reaffirmed the doctrine that copyright law generally preempts right of publicity claims. In *Jules Jordan Video, Inc. v. 144942 Canada, Inc.*, 617 F. 3d 1146 (2010), the 9th Circuit Court of Appeals held that Jordan, an adult movie actor, who sought damages for both copyright infringement and right of publicity violations based on the unauthorized copying of videos in which he performed, had to settle just for his copyright claims. The Court found the gravamen of his complaint was that defendants violated his right of publicity by making and distributing unauthorized copies of his videos. That claim was preempted, found the Court, by his copyright claim.

VI. The Intersection of Trademark and Right of Publicity Law

Founded primarily in the law of unfair completion, and even detailed in Sections 46-49 of the *Restatement (Third) of Unfair Competition*, the right of publicity arises as a cause of action when there has been an unauthorized and improper use of a person’s name, likeness or other unique identifier for the purposes of trade. Given its origins, the Right of Publicity has strong ties to the laws of trademarks and unfair competition, and close parallels can be drawn between infringements of both trademarks and rights of publicity.

In the same manner in which brand owners gain the right to control their brands and the goodwill associate with the same, the law of right of publicity “grants a natural person an ‘exclusive right to control the commercial value of his name and likeness and to prevent others from exploiting that value without permission.’” *World Wrestling Fedn. Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 433 (WD Pa. 2003), citing *Brockum Co. v. Blaylock*, 729 F. Supp. 438, 445 (E. D. Pa. 1990). Unlike trademarks, however, for a plaintiff to have a colorable right of publicity claim requires a showing such name or likeness has an associated level of commercial value; otherwise, there is nothing being appropriated by the defendant.

When examining the causes of action available to persons under the right of publicity laws, the unauthorized association of a natural person with a particular product or service gives rise to two distinct issues that clearly mirror issues found in trademark claims. First, the misappropriation of value arising from the commercial use of a person’s name or likeness, without compensation or permission, parallels “classic” trademark infringement and unfair competition claims, including the possibility of tarnishment should the defendant’s product or service be of inferior quality. Defendants in these situations are unfairly benefiting from the efforts of another that has established value in their brands, and does so by taking and using those brands without authorization; in the case of right of publicity, the “brand” in which value has been created is the

natural person's name and identity – a value developed with the investment of time, effort and money.

This first category of concern extends beyond simply using an individual's name and likeness to promote or advertise another's product or service. It also extends to merchandise which is manufactured and sold which itself bears the name or likeness being misappropriated, adopting the individual's image as an aesthetic element of the product itself. Such merchandising uses are often subjected to a First Amendment analysis in determining if they are sufficiently transformative to overcome the claim under right of publicity statutes. See, e.g., *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001) (finding posters and t-shirts "expressive works and not an advertisement for or endorsement of a product").

The second category of issues involves false association arising from the unauthorized use of a person's name or likeness, causing consumers to believe an affiliation or sponsorship exists between that person and the product or service being promoted making such unauthorized use. "The right of publicity is often invoked in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product." *World Wrestling Fedn.*, 280 F. Supp. 2d at 444; see also *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

In determining the applicable portions of the Lanham Act applicable unauthorized celebrity endorsements, the Pennsylvania courts have (like courts in other Circuits) relied on § 43(a), stating that "[a] celebrity is entitled to vindicate property rights in his or her identity under this section of the Lanham Act, because he has an economic interest in his identity akin to that of a traditional trademark holder. *Facenda v. N.F.L. Films, Inc.*, 488 F. Supp. 2d 491, citing *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *cert. denied* 508 U.S. 951, 124 L. Ed. 2d 660, 113 S. Ct. 2443 (1993). The Court of Appeals for the Sixth Circuit has explained:

In order to prevail on a false advertising claim under § 43(a), 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. See 15 U.S.C. § 1125(a)(1)(A).

Parks v. LaFace Records, 329 F.3d 437, 445 (6th Cir.), *cert. denied* 540 U.S. 1074, 157 L. Ed. 2d 744, 124 S. Ct. 925 (2003). District courts within the Third Circuit have agreed with this position, and have determined that to succeed in a claim, a plaintiff must show a likelihood of confusion, mistake, or deception as to his affiliation with defendant's product or service.

The Third Circuit's test for likelihood of confusion, referred to as the Lapp factors, are set out in *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000). These factors are:

- (1) the degree of similarity between the owner's mark and the alleged infringing mark;
- (2) the strength of the owner's mark;
- (3) the price of the goods and other factors indicative of

the care and attention expected of consumers when making a purchase; (4) the length of time the defendant has used the mark without evidence of actual confusion arising; (5) the intent of the defendant in adopting the mark; (6) the evidence of actual confusion; (7) whether the goods, competing or not competing, are marketed through the same channels of trade and advertised through the same media; (8) the extent to which the targets of the parties' sales efforts are the same; (9) the relationship of the goods in the minds of consumers, whether because of the near identity of the products, the similarity of function, or other factors; and (10) any other factors suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market, or expect that the prior owner is likely to expand into the defendant's market.

Not all district courts within the Third Circuit have applied the Lapp factors to such cases, however, some believing a more appropriate set of factors to be used was that established by the courts in California. Specifically, the court in *Dorsey v. Black Pearl Books, Inc.*, 2006 U.S. Dist. LEXIS 83093 (D.N.J. Nov. 14, 2006) considered a modified set of factors established by the Ninth Circuit in *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) for courts to consider in determining whether a plaintiff has demonstrated a likelihood of confusion in cases involving celebrity false endorsements. The Ninth Circuit factors are: (1) the level of recognition that the plaintiff has among the segment of the society for whom the defendant's product is intended; (2) the relatedness of the fame or success of the plaintiff to the defendant's product; (3) the similarity of the likeness used by the defendant to the actual plaintiff; (4) evidence of actual confusion; (5) the marketing channels used; (6) the likely degree of purchaser care; (7) defendant's intent on selecting the plaintiff; and (8) the likelihood of expansion of the product lines. *Id.* at 1007-1008.

No matter which test is applied, however, the fact remains that the analysis being brought to bear by the courts is a trademark law-based analysis, demonstrating the overlap of these related, although distinct, tort claims. It is clear that many factual situations could feasibly arise for right of publicity claims that would draw clear parallels to trademark causes of action and issues, such as consumer confusion, dilution, famous marks, and even gray market goods. As the right of publicity case law continues to develop, there is no doubt that such law, and the accompanying reasoning and analysis, will continue to intersect with trademark law and follow the trademark framework.

VII. Conclusion

In his 1987 article in the *Southern California Law Review*, J. Eugene Salomon, Jr., joined a number of scholars and practitioners in calling for a federal right of publicity law. He noted that the right of publicity's frequent intersections and conflicts with First Amendment law and with copyright law were exacerbated by the welter of diverse state law interpretations of publicity rights. His point is strengthened by the global nature of digital communications and the jurisdictional issues presented by that digital revolution – in a borderless world of cyberspace, with the ever-increasing value and importance attached to celebrity rights, requiring parties to navigate a dizzying array of state publicity rights laws invites inconsistent and unpredictable

results. The time may indeed be ripe for the adoption of such a more uniform approach to this important body of law.

VIII. Resources

1. <http://rightofpublicity.com/statutes>
2. J. Thomas McCarthy, *The Rights of Publicity & Privacy*, (Thomson Reuters 2011 ed.)
3. *Symposium: Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 *Cardozo Arts & Ent. L. J.* 209, 1998.
4. Marc J. Apfelbaum, *Copyright and the Right of Publicity: One Pea in Two Pods*, 71 *Geo.L.J.* 1567 (1983)
5. J. Eugene Salamon Jr., *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 *S. Cal. L. Rev.* 1179 (1987)
6. Stacey L. Dogan, Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 *Stan. L. Rev.* 1161 (2006)

Credits

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