

# **Still Dancing: An Article on *Astaire v. Best Video* and its Lasting Repercussions**

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## **I. INTRODUCTION**

Marilyn Monroe is selling Levi's Jeans, Humphrey Bogart and Ingrid Bergman are telling us to buy diamonds from Kay Jewelers, and John Wayne is telling his troops that he drinks Coors beer. The persona of an individual can now live in perpetuity as long as Madison Avenue and Hollywood see profit and technology providing better and more realistic methods of resuscitation. While advertisers delight in, and Hollywood dreams of, fantasies previously unimaginable, our courts are forced to grapple with rights that seem to become obsolete as quickly as Windows 95.

In an effort to craft legislation that would protect an individual from the unauthorized use of their persona, lawmakers have attempted to avoid conflicts with the First Amendment. As such, state legislators create a list of exemptions that typically include, plays, books, newspapers, magazines, films, musical compositions, radio and television

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programs. Courts, however, are then left to define each of these exemptions in a rapidly changing technological era where, for example, books may be a series of codes delivered over the Internet. Recently the court was asked to consider just such a question in *Astaire v. Best Video*.

This Article will explore the development of the right of publicity from its inception as a privacy right to its recognition as a property right. The discussion will focus on an analysis of section 3344.1 of the California Civil Code which provides for a decedent's right of publicity.<sup>1</sup> While the California statute does not grant the broadest rights (that distinction rests with Indiana), California does provide the largest body of case law with which to analyze the post-mortem right of publicity.<sup>2</sup> The discussion will then turn to an analysis of *Astaire v. Best Video*. This Article will examine the court's reasoning with respect to the exemptions found in the previous version of the California right of publicity statute, and conclude that relying on a list of enumerated exemptions will result in an overly broad interpretation of the statute. Finally, this Article will offer a test that would allow a court to consider the purpose of the use of this valuable property rather than relying solely on an inadequate list of exemptions.

## II. THE RIGHT OF PUBLICITY

Right of publicity statutes typically prevent the use of an individual's name, image, voice or likeness in advertisements for goods and services, or on or in products without that person's permission. The problem lies, predictably, in how the courts interpret these statutes. The solution is found in an understanding of the intent and purpose of the law.

For all of the confusion surrounding this area of law, the right of

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<sup>1</sup> Section 3344 of the California Civil Code addresses a living individual's right of publicity. In addition, California recognizes a common law right of publicity for living individuals. Previously, California recognized a decedent's right of publicity codified at section 990 of the California Civil Code. This statute was revised and renumbered as 3344.1 effective January 1, 2000.

<sup>2</sup> See IND. CODE §32-13 (1996) (descendible right of publicity extends for 100 years and standing is based upon the site of the infringement rather than the domicile of the plaintiff at the time of death).

publicity can be stated as nothing more than the right of every person to control the commercial use of his or her identity.<sup>3</sup> While this burgeoning legal theory applies to the entire population, there is little wonder why litigation of this type usually involves those in the entertainment industry. An individual whose livelihood depends upon the calculated exploitation of his or her name, image, and likeness will inherently suffer the greater loss by its unauthorized use. Perhaps the greatest asset a celebrity has to sell is his or her "persona." To fully understand this area of law and the direction in which it is headed, it is critical to examine its history.

### III. THE TRANSITION FROM THE RIGHT OF PRIVACY TO THE RIGHT OF PUBLICITY

Although the word "privacy" is not found in the United States Constitution, one of the first champions of the right to privacy theory was Justice Louis Brandeis, Associate Justice to the United States Supreme Court from 1916 through 1939. In his eloquent dissent to a Supreme Court holding that wiretapping did not constitute a violation of the Fourth Amendment, Brandeis wrote, "[t]he makers of our Constitution conferred as against the government, the right to be let alone — the most comprehensive of rights and the right most valued by civilized man."<sup>4</sup>

In addition to Justice Brandeis' service on the high court, he is often remembered for a 1890 law review article written with his then law partner, Samuel D. Warren.<sup>5</sup> In this article, Warren and Brandeis opined that an individual had a common law right to determine "the time when, and the manner in which his thoughts, sentiments, and emotions shall be communicated to others."<sup>6</sup> The motivation behind the introduction of this new right however, has been questioned.<sup>7</sup>

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<sup>3</sup> J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY*, §1.1(A) (1) (C. Boardman 1995) (1987).

<sup>4</sup> *Olmstead v. United States*, 277 U.S. 438, 478 (1928).

<sup>5</sup> Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

<sup>6</sup> *Id.*

<sup>7</sup> See Sudakshina, *Fluency of the Flesh: Perils of an Expanding Right of Publicity*, 59 ALB. L. REV. 739, 743 (1995) ("Warren had married Miss Maybel Bayard,

At first the courts of New York accepted this new legal theory of a right of privacy. However, in 1902, the court of appeals in *Robertson v. Rochester Folding Box Company* completely rejected the doctrine.<sup>8</sup> The defendant in *Robertson* had, without authorization, used the photograph of an attractive young lady to advertise its flour. In holding that there was no right to privacy, the court expressed fear that a “vast amount of litigation involving not only pictures, but even ‘a comment on one’s looks, conduct, domestic relations or habits’” would follow should such a right be recognized.<sup>9</sup>

The result of this decision was the enactment in 1903 of a statute now known as New York Civil Right Law §§ 50–51. This 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.”<sup>10</sup>

It would, however, be another fifty years until the moniker “right of publicity” was created by Judge Jerome Frank in the Haelean baseball trading card case.<sup>11</sup> In his opinion for the federal court of appeals, Judge Frank stated that, under New York law, there was something called a “right of publicity” that was separate and apart from the right of privacy which enabled individuals to protect themselves from unauthorized commercial appropriations of their personas.<sup>12</sup> In so doing, Judge Frank recognized an independent common law right protecting economic interests rather than the personal, emotional interests associated with the right of privacy.

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daughter of Senator Thomas Francis Bayard, Sr. They set up housekeeping in Boston’s exclusive Back Bay Section and began to entertain elaborately. The Saturday Evening Gazette, which specialized in the ‘blue blood items,’ naturally reported their activities in lurid detail. This annoyed Warren, who took up the matter with Brandeis. The article was the result.”); See also Oliver Goodenough, *Go Fishing: Evaluating the Restatement’s Formulation of the Law of Publicity*, 47 S.C. L. REV. 709, 1996 (claiming the myth surrounding the article has been convincingly disproved).

<sup>8</sup> *Robertson v. Rochester Folding Box Co.*, 171 N.Y. 538, 64 N.E. 442 (1902).

<sup>9</sup> *Id.* at 545.

<sup>10</sup> N.Y. CIV. RIGHTS LAW §§ 50-51.

<sup>11</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

<sup>12</sup> *Id.*

This right might be called a "Right of Publicity." For it is common knowledge that many prominent persons. . . , far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses [sic], trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.<sup>13</sup>

Since these early decisions, courts and legal scholars have struggled with this "haystack in a hurricane" area of law.<sup>14</sup> In 1960, William L. Prosser identified four torts that fell within the doctrine of the right of privacy.<sup>15</sup> Prosser outlines these torts as:

- 1) Unreasonable intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.
- 2) Publication which places the plaintiff in false light in the public eye[.]
- 3) Public disclosure of true, embarrassing private facts about the plaintiff.
- 4) Appropriation of the plaintiff's name or likeness for commercial purposes.<sup>16</sup>

Prosser's attempt to link the right of publicity to a right of privacy, however, may have added more confusion than clarity to the debate. For this reason, opponents to a decedent's right of publicity continue to point to the limitations of the right of privacy. The two rights are, however, separate and distinct.

The right of privacy is a personal right. The damage to human dignity alleged in an action for the invasion of a right of privacy is measured by mental distress.<sup>17</sup> As such, injury is said to die with the

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<sup>13</sup> *Id.* at 868.

<sup>14</sup> *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481, 485 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956).

<sup>15</sup> William Prosser, *Law of Torts*, §117, Privacy, 48 CAL. L. REV. 383 (1960).

<sup>16</sup> *Id.*

<sup>17</sup> J. Thomas McCarthy, Remarks at the Horace S. Manges Lecture – *The Human Persona as Commercial Property; The Right of Publicity* at Columbia University School of Law (March 9, 1995).

plaintiff. The right of publicity, on the other hand, is a property right. The damage is commercial injury to the business value of one's personal identity.<sup>18</sup> It is for this reason that damages for infringement of a person's right of publicity are calculated in terms of the fair market value of the plaintiff's identity, unjust enrichment, and damage to the business of licensing the plaintiff's identity.<sup>19</sup> The commercial use of an individual's persona is a business. The control of this right is the basis by which famous persons generate income. It is this distinction, however, that is missing from the Prosser definition of appropriation.

Recognizing the right of publicity as a property right rather than a privacy right, allows for this valuable asset to be descendible and transferable. In this manner, the heir to the estate of a famous individual may continue to be supported by the life-long efforts of their loved one for a limited period of time. To view this right otherwise would allow commercial entities to benefit from the use of an individual's persona without compensation to the heirs. Moreover, if the right of publicity were not descendible, a deceased performer's likeness could be used to endorse a product that they may have considered reprehensible in their lifetime.

Neither trademark nor copyright laws offer protection against the unauthorized use of an individual's persona. As such, many scholars insist that the right of publicity must be viewed as a separate and distinct area of law. Most notably, J. Thomas McCarthy claims:

The right of publicity is not a kind of trademark. It is not just another kind of privacy right. It is none of these things although it bears some family resemblance to all three. The right of publicity is a wholly different and separate legal right.<sup>20</sup>

It can be argued that the Supreme Court agrees with this most recent characterization. In the high court's only foray into this doctrinal

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<sup>18</sup> *Id.*

<sup>19</sup> *Id.* On remand in October 1989, a Los Angeles jury awarded Bette Midler \$400,000 in a verdict against Young and Rubicam for the advertising agency's unauthorized use of a sound-a-like singing the song "Do You Wanna Dance" in a car commercial. *Id.* In 1992, a jury in Los Angeles federal court awarded Tom Waits almost \$2,500,000 for infringement of his right of publicity by Frito-Lay who used a sound-a-like of Mr. Waits in a commercial for Dorito's Chips. *Id.*; See *infra* note 33 and accompanying text.

<sup>20</sup> Prosser, *supra* note 15.

jungle, the Court noted:

[p]etitioner's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in the act; the protection provided an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright law long enforced by this court.<sup>21</sup>

This language by Justice White remains the backbone of the right of publicity.

Most recently, the right of publicity has been included in the American Law Institute's Restatement of Unfair Competition as a separate legal theory. It is interesting to note, however, that the drafters of the Restatement adopted Prosser's concept of "appropriation." By employing Prosser's terminology, the Restatement may have the unfortunate effect of perpetuating the "personal right" versus "property right" confusion.<sup>22</sup>

#### IV. THE CURRENT STATE OF THE RIGHT OF PUBLICITY

The transition from right of privacy to right of publicity has resulted in a hodge-podge of state statutes and common law that vary greatly. As of the time this Article was published, twenty-five states recognized a common law right of publicity for living persons.<sup>23</sup> Fourteen states had a statutory right of publicity.<sup>24</sup> New York continues to recognize a version of the right of publicity for living individu-

<sup>21</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

<sup>22</sup> For an extensive examination of the Restatement in this area see Goodenough, *supra* note 5.

<sup>23</sup> Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L. J. 47 (1994).

<sup>24</sup> CAL. CIV. CODE §§ 990, 3344 (West Supp. 1994); FLA. STAT. ANN. § 540.08 (West 1988); IND. CODE §§ 32-13 (1994); KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984); MASS. ANN. LAW ch. 214, § 3A (Law co-op. 1986); NEB. REV. STAT. § 20-202 (1991); NEV. REV. STAT. ANN. §§ 597.770-.810 (Michie tit.12, §§ 1448-1449 (West 1993)); OKLA. STAT. ANN. tit. 21, §§ 839.1-.2 (West 1993), tit. 12, §§ 1448-1449 (West 1993); R. I. GEN. LAWS § 9-1-28 (1985); TENN. CODE ANN. §§ 47-25-1101 TO -1108 (1988 & Supp. 1994); TEX. PROP. CODE ANN. §§ 26.001-.015 (West Supp. 1994); UTAH CODE ANN. §§ 45-3-1 TO -6 (1993); VA. CODE ANN. §§ 8.01-40 (Michie 1992); WIS. STAT. ANN. § 895.50 (West 1983 & Supp. 1993).

als under a theory of right of privacy.<sup>25</sup> A postmortem right of publicity has been recognized by statute in fourteen states.<sup>26</sup> Despite the piecemeal development and evolution of the right of publicity, a patchwork of reasonably consistent precedent has begun to emerge.

#### A. *The Use of a Name and Image*

In 1909, the courts of Kentucky held that the use of a person's name and picture without consent in an advertisement violated the right of privacy.<sup>27</sup> Similarly, in 1918, the courts of Kansas held that the unauthorized use of a person's photograph in a moving picture theatre, used for business purposes, violated the right of privacy.<sup>28</sup> In 1938, a North Carolina court held that the unauthorized use of a radio entertainer's photograph in a bread commercial and a commercial for a stage show violated the entertainer's rights of privacy.<sup>29</sup> In each of these examples, the courts recognized the value inherent in the commercial use of an individual's image. Today, the unauthorized use of a living individual's name or image is generally accepted as an infringement.

#### B. *The Use of a Persona*

Decades later, a court in California determined that a famous race car driver's well-known race car, televised in a cigarette commercial without permission, was identifiable with the driver and therefore an infringement of his right of publicity.<sup>30</sup> Similarly, the Sixth Circuit Court of Appeals held that the phrase, "Here's Johnny," used to advertise a portable toilet, was actionable because the famous introduction was so closely associated with Johnny Carson that the unauthorized use infringed upon his right of publicity.<sup>31</sup> In addition, a robot dressed and designed to mimic Vanna White and used to advertise

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<sup>25</sup> Robertson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442 (1902).

<sup>26</sup> Prosser, *supra* note 20, at 52.

<sup>27</sup> Foster-Milburn Co. v. Chinn, 120 S.W. 364 (KY. 1909).

<sup>28</sup> Kunz v. Allen, 172 P. 532 (Kan. 1918).

<sup>29</sup> Flake v. Greensboro News Co., 195 S.E. 55 (N.C. 1938).

<sup>30</sup> Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974).

<sup>31</sup> Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983).

merchandise was actionable in California in 1993.<sup>32</sup> Similarly, in 1996, the Ninth Circuit held that the "birth name" of a sports figure was an infringement of his right of publicity when used to advertise automobiles, even though the sports figure had legally changed his name.<sup>33</sup> In each of these cases, the actual image of the individual was not used, but rather, it was the persona of the celebrity that was being usurped for commercial gain. Thus, the courts acknowledged that certain objects, phrases, or characteristics could be so closely associated with a particular individual as to infringe upon his right of publicity.

### C. *Impersonators*

In both New Jersey and Tennessee a look-a-like performer who recreates a performance "just like [a famous artist] would have done" has been found to be an infringement upon the entertainer's right of publicity.<sup>34</sup> Not surprisingly, however, the Nevada right of publicity statute specifically exempts impersonators from right of publicity claims by their subjects.

The most famous of the "impersonator" cases involve singers Bette Midler<sup>35</sup> and Tom Waits.<sup>36</sup> In separate instances, impersonators were used to re-create vocal performances in television commercials. In *Midler v. Ford Motor Company*, an impersonator was used only after Ms. Midler declined an offer to record the commercial. Young and Rubicam, the advertising agency, sought out a vocalist who had previously worked as a backup singer for Ms. Midler and asked her to "sound as much as possible like the Bette Midler record."<sup>37</sup> In *Waits v. Frito Lay, Inc.*, the court noted Mr. Waits' policy that "musical artists should not do commercials because it detracts from their artistic integrity." In addition, the trial record revealed that a second version

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<sup>32</sup> *White v. Samsung Electronics America, Inc.*, 871 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993), *cert denied*, 113 S. Ct. 2443 (1993)).

<sup>33</sup> *Abdul-Jabbar v. General Motors Corp.*, 75 F.3d 1391 (9th Cir. 1996).

<sup>34</sup> *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). *See also* *Apple Corps. Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342 (M.D.Tenn. 1993).

<sup>35</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

<sup>36</sup> *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

<sup>37</sup> *Midler*, 849 F.2d at 461

of the commercial was produced because of concerns that legal action might result because the impersonator sounded too much like Waits.<sup>38</sup>

The common theme throughout these decisions is that the right of publicity for an individual resides in the associative value of his or her name, likeness, and image.<sup>39</sup> It is the persona of the individual that attracts our attention to the advertisement.<sup>40</sup> "Such commercial use of an individual's identity is intended to increase the value or sales of the product by fusing the celebrity's identity with the product and thereby siphoning some of the publicity value or goodwill in the celebrity's persona into the product."<sup>41</sup> It is this goodwill or publicity value that becomes a marketable product belonging to the individual. "While this product is concededly intangible, it is not illusory."<sup>42</sup>

It is the question of a decedent's right of publicity, however, which forces a return to the "personal right" verses "property right" controversy. Some states continue to cling to the Prosser model, seeing the right of publicity as a personal right, and as such, any claim for such an invasion is said to die with the plaintiff.

For example, under the 1903 New York statute, the right to object to the use of one's identity in advertising ends at death.<sup>43</sup> As recent as 1993, the New York Court stated, "we have no common law right of privacy" in New York. The adoption of a right of privacy is "best left to the legislature."<sup>44</sup>

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<sup>38</sup> *Waits*, 978 F.2d at 1097.

<sup>39</sup> Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853 (1995).

<sup>40</sup> Professor McCarthy suggests an extreme example of something called a negated endorsement: "Famous football quarterback Ira Idaho may be the best in the league, but he has never tasted Double D Beer. Why don't you?" McCarthy, *The Rights of Publicity and Privacy*, § 5.4[A] (Rev. 1995). "This outright admission that the person depicted is completely unaware of, let alone unassociated with, the product in question, is based on an actual ad which ran in England. A billboard sized picture of Ronald Reagan drew attention to an ad for Mansfield Beer, even though it admitted Reagan had never tasted the stuff." Goodenough, *supra* note 5, at 709.

<sup>41</sup> Halpern, *supra* note 33, at 856.

<sup>42</sup> *Lugosi v. Universal Pictures*, 160 Cal.Rptr. 323, 336 (1979).

<sup>43</sup> N.Y. CIV. RIGHTS LAW §§ 50-51

<sup>44</sup> *Howell v. New York Post Co., Inc.*, 612 N.E.2d 699, 703 (N.Y. 1993); *see also Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990).

## V. CALIFORNIA CIVIL CODE SECTION 990

Enacted in 1988, California Civil Code, section 990 established a fully descendible property right in a deceased celebrity's right of publicity. It provided, in pertinent part:

(a) 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 . . . , shall be liable.

Further, section 990 provided such protection for a term of fifty years following the death of the individual<sup>45</sup> and required that the deceased personality's name, voice, signature, photograph, or likeness has commercial value at the time of his or her death whether or not he or she used such name, voice, signature, photograph, or likeness during his or her lifetime.<sup>46</sup>

The focus of section 990, and most other similar state statutes, is on the "commercial use" of an individual's persona. While differences remain from state to state, often the easiest way to understand the scope of these laws is to consider what right of publicity laws do not do.

The right of publicity cannot prevent the use of someone's name in news reporting.<sup>47</sup> It cannot be used to prevent the use of identity in an unauthorized biography.<sup>48</sup> It cannot be used to prevent satire or parody which includes the use of an individual's identity.<sup>49</sup> The right of publicity applies only to advertising and similar commercial uses.<sup>50</sup>

The California Civil Code requires that the use of the deceased personality's name, voice, signature, photograph or likeness to be actionable, it must be used either:

- 1) On or in products, merchandise or goods, or

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<sup>45</sup> CAL. CIV. CODE § 990(g) (Deering 1990).

<sup>46</sup> CAL. CIV. CODE § 990(h) (Deering 1990).

<sup>47</sup> *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580 (N.Y. 1984).

<sup>48</sup> *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994).

<sup>49</sup> MCCARTHY, *supra* note 3, at § 8.15(B).

<sup>50</sup> J. Thomas McCarthy, Remarks at the Horace S. Manges Lecture – *The Human Persona as Commercial Property; The Right of Publicity* at Columbia University School of Law (March 9, 1995).

- 2) For purposes of advertising or selling, or
- 3) Soliciting purchases of products, merchandise, good or services.

The legislators in California further attempted to clarify their position by adopting subdivision (n) to section 990 which read:

(n) This section shall not apply to the use of a deceased personality's name, voice, signature, photograph, or likeness, in any of the following instances:

- (1) A play, book, magazine, newspaper, musical composition, film, radio or television program, other than an advertisement or commercial announcement not exempt under paragraph (4).
- (2) Material that is of political or newsworthy value.
- (3) Single and original works of fine art.
- (4) An advertisement or commercial announcement for a use permitted by paragraph (1), (2), or (3).

Some have suggested that the legislators eviscerated section 990 by the addition of subdivision (n). Critics argued that subdivision (n) exempts too many uses, leaving only a narrow area of the celebrity persona protected.<sup>51</sup> Proponents of the exemptions argued, however, that protection under section 990 was intended to be very limited and that subdivision (n) provided the much-needed focus. Not surprisingly, the language of section 990(n) forced the courts to define such seemingly simple terms as "book", "magazine" and, most notably, the word "film".

#### VI. *ASTAIRE V. BEST FILM & VIDEO CORP.*<sup>52</sup>

Fred Astaire has been called, by some, the world's greatest dancer. During his famed career he was partnered with Hollywood's most glamorous leading ladies and starred in some of the industry's most extravagant productions. Mr. Astaire's dedication and hard work earned him his place as a true Hollywood legend.

During his lifetime, Mr. Astaire became one of Hollywood's high-

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<sup>51</sup> Opening Brief for Appellee/Cross-Appellant at 4, *Astaire v. Best Film & Video Corp.* 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).

<sup>52</sup> 116 F.3d 1297 (9th Cir. 1997), *amended by* 136 F.3d 1208 (9th Cir. 1998), *and cert. denied*, 525 U.S. 868 (1998).

est paid performers. The studios could justify his salary because they knew that the name and the talent of Fred Astaire sold tickets. Thanks to technology, Fred Astaire is still dancing. Now the question is, does he still deserve to be paid?

### A. *Background*

The Fred Astaire Dance Studios were founded by Fred Astaire and Chester Casanave in 1946. The studios, which would become a nationwide business, utilized a step-by-step method of dance instruction developed by the legendary dancer and film star.<sup>53</sup> In 1953, Mr. Astaire withdrew from the business and sold his rights under a contract that granted him a 40-year royalty from the company's revenues. In 1965, the Fred Astaire Dance Studios Corporation changed its name to Ronby Corporation.<sup>54</sup>

Best Film & Video Corporation ("Best") is a New York corporation, engaged in the business of manufacturing, producing, marketing, distributing, and selling pre-recorded video cassettes throughout the United States. On March 15, 1989, Ronby and Best entered into an agreement to co-produce a series of dance instructional videotapes.<sup>55</sup> The series of five videotapes known as the FRED ASTAIRE DANCE SERIES included the individual titles, SWING, TOP 40, LATIN DANCING, BALLROOM, and COUNTRY WESTERN DANCING. Each videotape began with an introduction, approximately 3 minutes in length, comprised of photographs and film clips of Fred Astaire.<sup>56</sup> The film clips, 93 seconds in duration, were from the films, ROYAL WEDDING<sup>57</sup> and SECOND CHORUS<sup>58</sup>. Each film was originally copyrighted by the film company. However, at the time of this action, the copyright had been allowed to lapse and the films had passed into public domain.<sup>59</sup> Best

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<sup>53</sup> Opening Brief of Appellant/Cross-Appellee at 12, *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).

<sup>54</sup> *See id.*

<sup>55</sup> Opening Brief of Appellee/Cross-Appellant at 4, *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).

<sup>56</sup> *See id.*

<sup>57</sup> ROYAL WEDDING was produced in 1951 by MGM.

<sup>58</sup> SECOND CHORUS was produced in 1940 by National Picture Corporation

<sup>59</sup> Opening Brief of Appellee/Cross-Appellant at 4, *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633). *See id.*

Video never requested permission from the heirs of the legendary entertainer.<sup>60</sup>

One of the marketing tools used in connection with the sale of these videocassettes was a complete version of each video (known as "screeners") which were made available to potential wholesale buyers.<sup>61</sup> The purpose of the screeners was to give buyers a sense of the quality and content of the videos.<sup>62</sup> As part of its marketing campaign, Best gave away hundreds of copies of the videos in question. Moreover, Best displayed the videos at the consumer electronics show in Chicago during the summer of 1989. This trade show was open only to industry buyers and the Fred Astaire clips were displayed prominently.<sup>63</sup>

Mrs. Robyn Astaire, the widow of the legendary celebrity, succeeded to all rights in the name, voice, signature, photograph, likeness, and general right of publicity in Fred Astaire's persona, including all rights under the California Civil Code section 990. She was granted those rights under the terms of the Fred Astaire Trust, dated December 31, 1985.<sup>64</sup> Mrs. Astaire complied with the statutory registration requirements contained in section 990(f)<sup>65</sup> by registering her claim with the California Secretary of State.<sup>66</sup> Mrs. Astaire filed a civil action on December 14, 1989, alleging various claims including violation of California Civil Code section 990.<sup>67</sup> The district court determined that Best's use of the film clips was covered by section 990(a). With respect to Astaire the court held that the use was not a use for "advertising, selling or soliciting".<sup>68</sup> In addition, in response to arguments

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<sup>60</sup> *Id.* at 5.

<sup>61</sup> *Id.* at 4.

<sup>62</sup> *Id.*

<sup>63</sup> *Id.* at 5.

<sup>64</sup> *Id.* at 3

<sup>65</sup> Section 990(f) requires that a successor-in-interest to the rights of a deceased personality register their claim to such a right with the Secretary of State. A fee of \$10.00 is charged. A successor-in-interest may not recover for any use prohibited under section 990 which occurs prior to such a registration. Most states which recognize a decedent's right of publicity require similar registration.

<sup>66</sup> Opening Brief of Appellee/Cross-Appellant at 4, *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).

<sup>67</sup> *Id.* at 3.

<sup>68</sup> *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297, 1298 (9th Cir. 1997).

made by Best, the court stated that the use was not exempt under subsection (n); that Ms. Astaire's claim was not pre-empted by federal copyright law; and that Best's use was not protected by the First Amendment.<sup>69</sup> Both sides appealed.

### B. *The Case on Appeal*

On March 3, 1997, the United States Court of Appeals for the Ninth Circuit heard arguments in the case. In its opinion, the court focused on the question of exemption under section 990(n) by stating, "We first address Best's subsection (n) argument, because if Best's use is exempt from section 990 liability altogether, we need not reach the other issues presented by this case."<sup>70</sup> In furtherance of this theory, the court applied the "plain meaning rule" which suggests that if the language of the statute is clear and unambiguous, there is no need to resort to the indicia of the intent of the legislature.<sup>71</sup> As such, the court first considered whether the videotapes produced by Best were "A play, book, magazine, newspaper, musical composition, film, radio or television program, other than an advertisement or commercial announcement not exempt under paragraph (4)."<sup>72</sup>

Not finding the word "videotape" specifically listed in the statute, the court also noted, "It is a settled rule of statutory interpretation that language of a statute should not be given a literal meaning if doing so would result in absurd consequences which the legislature did not intend."<sup>73</sup> With that in mind, the court reasoned, "Interpreting subsection (n) (1) to exempt a film or television program but not a videotape creates an absurd result: a motion picture is exempt from section 990 liability when it is shown in a theater or on cable television but not when someone rents it at a video store and plays it on his VCR."<sup>74</sup> Based upon this reasoning, the court determined that the use of Fred Astaire in the videotapes produced by Best were exempt from liability

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<sup>69</sup> *Id.* at 1300.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.* at 1301 (citing *Lungren v. Deukmejian*, 248 Cal. Rptr. 115, 120 (1988)).

<sup>72</sup> *Astaire*, 116 F.3d at 1300.

<sup>73</sup> *Id.* at 1301 (citing *Younger v. Superior Court*, 577 P.2d 1014, 1021-22 (Cal. 1978)).

<sup>74</sup> *Id.*

under section 990(n) and, as such, held for Best.<sup>75</sup>

### C. *Discussion*

There is no doubt that a film produced on videotape would remain exempt under section 990(n)(1). Reproduction in a different format does not change the essential nature of the work. Here, however, the court focused on the specific objects listed in section 990(n)(1) arguably arriving at the absurd result they so carefully sought to avoid. To interpret the statute in this manner requires that the physical object becomes the sole consideration rather than the manner in which the individual persona is used within that object. Based on this logic, the courts could be asked to revisit this issue with every new advent of technology. For example, does a CD ROM or DVD fall within the purview of the statute even though these technologies are not specifically enumerated? Moreover, the court's analysis is in direct conflict with its reasoning earlier in the opinion.

Recognizing the difficulties in interpreting section 990, the court provides three thoughtful examples, which offer guidance in the interpretation of the statute:

Example 1. A magazine article about the history of television that uses a deceased personality's name without authorization. Neither the writer nor the magazine publisher could be sued under S 990: the writer's use of the deceased personality's name would be exempt from S 990 liability pursuant to subsection (n)(1).

Example 2. Manufacturer wanted to advertise its latest model in the same magazine with a splashy color layout that included the picture of a deceased personality. Although the use appears in a magazine, the use of the deceased personality's photograph would not be exempt under subsection (n)(1) because it appears in an advertisement. The use is not permitted in subsections (n)(1), (n)(2) or (n)(3), so it is not exempt under subsection (n)(4).

Example 3. Suppose that the magazine publisher from Example 1 wanted to advertise its magazine by referring to various articles that had appeared within its pages, including the article about the history of cinema. If that advertisement used the deceased personality's name, that use would be exempt under subsection (n)(4), because the advertisement

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<sup>75</sup> *Id.* at 1302.

was for a magazine, a use permitted by subsection (n)(1).<sup>76</sup>

In each of the examples provided, the court focused on the manner in which the personality's persona was used rather than on the object itself. Moreover, the court recognized that the entire contents of a magazine are not exempt simply because section 990(n)(1) uses this particular definition of the object. In *Astaire*, however, the court seems to have suggested that videotape is the same as film and since film is exempt under section 990(n)(1), any images which are reproduced through this photographic process are also exempt. Taken to its logical conclusion, the *Astaire* court's holding requires that every television commercial shot on film or videotape would be exempt because of the medium in which it was produced.

Having determined that the use of Mr. Astaire's image was exempt under section 990 (n)(1), the court proceeded to examine whether the use was for advertisement or commercial announcement. Since the parties to the action disagreed as to whether the use was an advertisement, the court suggested in dicta that, "[i]f the Astaire film clips are an advertisement, they are certainly an advertisement for the videotape themselves rather than some other product."<sup>77</sup> This analysis, however, serves only to beg the question because once the use is determined to be exempt, any advertisement will likewise escape liability pursuant to section 990 (n)(4).

The issue before the court required consideration of the use of Mr. Astaire's persona as it appeared in the videotapes. As the court demonstrated in its own examples above, analysis under section 990 (n) requires consideration of each of the constituent parts of any of the exempt objects to determine the purpose of the use. Where the advertisement in Example 2 was unrelated to the articles within the magazine and the magazine itself, the court determined that the use of the personality's name was not exempt. Presumably the court recognized that the magazine was simply a vehicle for the advertisement. In Example 3, the court instructs, "[i]f that advertisement used the deceased personality's name, that use would be exempt under subsection (n)(4), because the advertisement was for a magazine, a use permitted by sub-

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<sup>76</sup> *Id.* at 1301.

<sup>77</sup> *Id.* at 1302.

section (n)(l).”<sup>78</sup> However, in this hypothetical, the court specifically states that the use was an advertisement for the magazine which referred to various articles that had appeared within its pages including the article about the history of cinema.<sup>79</sup> What if, however, the advertisement used the name of a deceased personality that had never appeared in a story in the magazine?

Is it reasonable to suggest that a magazine, which has never produced an article about Marilyn Monroe, should be allowed to feature this famous personality’s image in an advertisement, without compensation, simply because the magazine publishes stories about the film industry? This distinction did not escape the entire court. Dissenting in *Astaire*, Judge Schroeder considered this very scenario by stating, “Under the majority’s reasoning one could with impunity hawk a videotape on fashion for the next century by introducing it with footage of Jacqueline Kennedy. The statute was intended to prevent such exploitation, not immunize it.”<sup>80</sup> Judge Schroeder astutely recognized that a celebrity persona is so valuable that the unscrupulous will find creative ways to avoid the purview of the law.

#### D. *The Forth Scenario: Purpose of the Use*

In presenting its three illustrative examples above, the Court failed to consider a fourth, more relevant scenario: that of the purpose of the use of the celebrity image. By ignoring this more applicable scenario, the court was able to employ a plain meaning analysis to factually simplistic examples which allowed the court to avoid this greater issue.

For example, if someone wrote a book about the life of James Dean, it makes perfect sense that Mr. Dean’s image should appear on the cover. The book is about James Dean and the purpose of the book would be to tell the public more about the actor and his life. Even if the book was fictional rather than biographical, and James Dean appeared as a character or served some purpose integral to the story, the use of Mr. Dean’s photo should be permitted. Mr. Dean’s photo could

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<sup>78</sup> *Id.* at 1301.

<sup>79</sup> *Id.*

<sup>80</sup> *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297, 1304 (9th Cir. 1997) (Schroeder, J., dissenting).

be considered a component in furtherance of the purpose of the book.

What if, however, the same book was the story of fictional characters Betty and Ralph and their romantic college days. No reference to James Dean is made in the book except that Ralph attended a showing of *REBEL WITHOUT A CAUSE* during the course of the story. Assuming that Ralph's life, nor the story, was affected by the viewing of the film, the use of James Dean on the cover of the book would not further any purpose of the book nor the underlying story. Moreover, Mr. Dean's image on the cover would likely cause fans of this Hollywood legend to reasonably assume that Mr. Dean was part of the story and mistakenly purchase the book. More precisely, the use of James Dean would be merely ornamental and designed to attract attention to the book. In this manner, the use would be for the purpose of advertising, selling, or soliciting sales of the book rather than serving as a substantive component in furtherance of the purpose.

This Component / Purpose test simply allows for consideration of the reason why the celebrity persona was used. Consideration of the purpose of the use is the basis of each of the Court's scenarios above and yet the Court persisted in disguising the examples as a plain meaning analysis.

Applying the Component / Purpose Test to the *Astaire* case, the following result would occur. Best claimed that the videos in question were educational in nature.<sup>81</sup> As such, Best contended the use of Fred Astaire was part of a protected expression which utilized the medium of videotapes as a manner of display.<sup>82</sup> However, the film clips of Fred Astaire did not further the purpose of the educational value of the videos itself. In each of the 93-second clips Fred Astaire was featured in dance combinations that were completely separable from the skills needed to learn Latin Dancing, Ballroom Dancing, or Country Western Dancing. In fact, the particular skills demonstrated in the educational portion of the videotapes bear no resemblance to the skills Mr.

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<sup>81</sup> Opening Brief of Appellant/Cross-Appellee at 27, *Astaire v. Best Film & Video Corp.* 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).

<sup>82</sup> *Id.* The *Astaire* Court avoided the First Amendment issues alluded to by Best's statement of the purpose of the video tapes; as such, the issue will not be discussed in this Article. However, *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977), might provide instruction with respect to that issue.

Astaire performed. Therefore, the particular use of Mr. Astaire's images did not become a substantive component in the furtherance of that purpose simply by their insertion into the otherwise exempt work.

## VII. THE ASTAIRE CELEBRITY IMAGE PROTECTION ACT

Prompted in part by the decision in *Astaire v. Best Video*,<sup>83</sup> an amendment to section 990 was introduced by Senator John Burton in the California legislature in January of 1999.<sup>84</sup> Codified at 3344.1 of the California Civil Code, the amendment extends the term of protection from fifty years to seventy years.<sup>85</sup> In addition, section 990 was amended to revise the exceptions and allow for an action to be brought by a plaintiff where an unauthorized use occurred in the State of California rather than basing standing on the domicile of the decedent at the time of death.<sup>86</sup> Finally, the amendment would require that the listing of successors-in-interest be posted on the World Wide Web.<sup>87</sup>

It has been argued that the extension of the term of protection was designed to coincide with the recent extension of the period of protection offered to copyright holders. This rationale makes sense in that in 1987 when section 990 was debated, opponents of the bill argued that protection should be no longer than the term of protection allow under copyright laws.

The posting on the Internet of those who claim rights in and to the name, likeness, image, signature, and voice of a deceased individual promises to decrease confusion for those involved in the use of these personalities. As such, unauthorized users will be less likely to claim that they were unable to ascertain who controlled rights in a particular instance.

The prior statute has been interpreted to require that the famous personality who is the subject of a claim under section 990 must have been domiciled in California at the time of his or her death.<sup>88</sup> This re-

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<sup>83</sup> *Astaire*, 116 F.3d at 1297.

<sup>84</sup> S.B. 209, 1999 Cal. Legis. Serv. 5959 (Introduced Jan. 20, 1999 by Sen. John Burton, Amended in Senate Mar. 3, 1999).

<sup>85</sup> CAL. CIV. CODE § 3344.1(g) (West 1999).

<sup>86</sup> *Id.* at § 3344.1(n).

<sup>87</sup> *Id.* at § 3344.1(f)(3).

<sup>88</sup> CAL. CIV. CODE § 990 (Deering 1990).

quirement, however, might allow a defendant to produce a television commercial without liability if the commercial featured a celebrity who died while domiciled in Georgia and the commercial was only shown in California. There is little doubt, however, that the celebrity would be damaged by such an unauthorized use. The issue of standing will increase judicial efficiency by allowing a plaintiff who was damaged in the State of California to find redress in California.

Each of the revisions above passed through both the California House and the Senate without protracted or overly heated debate. However, the wording of the exemptions remained problematic.

The original draft of the legislation attempted to revise the exemptions in section 990 (n) to read "shall not apply to the use of a deceased personality's name, voice, signature, photograph, or likeness to the extent the use is protected by the constitutional guarantees of freedom of speech or freedom of the press"<sup>89</sup> After much debate, the language in the final draft reads:

(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 non-fictional entertainment, or a dramatic, literary, or musical work.<sup>90</sup>

Arguably, the current legislation has simply traded one litany of undefined examples for another, leaving the courts likely again to focus on the form rather than the function of the use. The real issue when evaluating the use of a personality in any particular format should be the purpose of the use rather than the format. It would seem that the most direct path through this definitional jungle would be an analysis that places content over form.

## VIII. CONCLUSION

Television, theatre, the film industry, and book publishers rely on the life stories of the famous and the infamous. Yet most representatives of celebrities and their estates would agree that section 3344.1 is

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<sup>89</sup> Cal. SB 209 (Amended Mar. 3, 1999).

<sup>90</sup> Cal. SB 209 (Signed Oct. 10, 1999, effective Jan. 1, 2000).

not intended to prevent the telling of their life stories. It is, however, designed to prevent the unauthorized use of a celebrity persona on or in products or for the purpose of selling goods or services that section 3344.1 is designed to prevent.

Best's argument that, "Film is film, and film is exempt," lead the court down a precarious path.<sup>91</sup> Under current analysis, evaluation based upon form over content will change with the advent of every new technology. Moreover, the majority's decision in *Astaire* promises that courts will continue to dance around the real question, the purpose of the use, for many years to come.

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<sup>91</sup> Opening Brief of Appellant/Cross-Appellee at 11, *Astaire v. Best Film & Video Corp.* 116 F.3d 1297 (9th Cir. 1997) (Nos. 95-56632 and 95-56633).