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# Multiple Identities: Why the Right of Publicity Should Be a Federal Law

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*Given the increased use of the Internet and social media in this fast-moving age of information and technology, the right of publicity is becoming more problematic at the state level. Thus, this article attempts to persuade lawmakers and the public that the right of publicity must be modified to keep up with the fast-progressing times. What follows is a detailed analysis of the right of publicity and an argument for why the right should be a federal right. Drawing heavily on intellectual property scholarship and case law, this article examines the issues and benefits surrounding the right of publicity, and uses these to advocate for a federal right. Various case examples are provided to assist in exploiting the problems with the right of publicity remaining a state-based right. Additionally, the article provides a detailed look at how the right of publicity, as a state-based right, is conflicting with federal laws. Finally, the article concludes with suggestions on how to craft a solid federal right of publicity statute.*

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## I. INTRODUCTION

The purpose of the right of publicity is to provide all individuals with the right to control the commercial use of their attributes such as likeness, image or name. This state-based right is primarily concerned with protecting celebrities, hereinafter referred to as “personalities.”<sup>1</sup> As the right of publicity gained more recognition from courts and legislatures in the last twenty-five years, its value to personalities increased substantially. Public figures, like Tiger Woods, Bill Clinton, and Serena Williams, make millions of dollars from endorsements, speaking engagements, and right of publicity claims.<sup>2</sup> Personalities are also taking advantage of the wide variation in right of publicity laws to bring claims based on what appears to be infringement.

Significant variation in state laws and judicial interpretations has proven problematic, which will be examined throughout this Article.

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<sup>1</sup> IND. CODE § 32-36-1-6 (2002): “As used in this chapter, “personality” means a living or deceased natural person whose [protected attribute] has commercial value, whether or not the person uses or authorizes the use of the person’s rights of publicity for a commercial purpose during the person’s lifetime.”

<sup>2</sup> Lauren Streib, *How Celebrities Make Their Millions*, FORBES.COM, (June 3, 2009, 6:00 PM), <http://www.forbes.com/2009/06/03/forbes-100-celebrity-09-earnings-paycheckmillions.html>; Kevin Spak, *Clinton Speech Income Passes \$75M Mark*, NEWSER.COM (July 12, 2011, 3:19 PM), <http://www.newser.com/story/123246/bill-clinton-has-earned-75-million-from-speeches-over-last-decade.html>; *Woody Allen settles American Apparel infringement for \$5 million*, RIGHTOFPUBLICITY.COM (May 19, 2009), <http://rightofpublicity.com/woody-allen-settles-american-apparel-infringement-for-5million-51809>.

Considering the various issues with the right of publicity as a state-based right, the right's structure demands a federal right of publicity statute for the following reasons. First, a lack of uniformity among state laws causes uncertainty regarding the right's scope, limitation, and proper forum. Second, the right of publicity conflicts with other federally regulated intellectual property laws like copyright and trademark. Third, some states have overextended the right by protecting a personality's gesture, distinctive appearance, or personal object (e.g., a personality's sports car) and by retroactively granting postmortem rights of publicity.

This Article examines these issues and proposes that a federal statute be implemented to limit the right of publicity. Part I provides a brief background of the right of publicity's origin, underlying policy, and current state. Part II examines the problems with the right of publicity by focusing on differences among state laws, copyright implications in certain cases, and the expansion of personality rights. Part III examines arguments for and against a federal right of publicity statute. Part IV concludes that a federal statute is necessary and discusses what elements should be incorporated into such a statute.

## II. BACKGROUND

### A. *Origin of the Right of Publicity*

The right of publicity evolved from the right of privacy, and is a newer area of intellectual property law than areas such as copyright and trademark. The right of privacy is a concept generally credited to former Supreme Court Justices Louis Brandeis and Samuel Warren, as they discussed the idea of the "right to be left alone."<sup>3</sup> They proposed the privacy right in an 1890 law review article,<sup>4</sup> and it did not take long before states began adopting the privacy right by common law or statute.<sup>5</sup> In 1903, New York created a limited right for persons to control

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<sup>3</sup> Risa J. Weaver, *Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute*, 2010 DUKE L. & TECH. REV. 2, ¶ 5 (2010) (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 202, 203 (1954).

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

<sup>5</sup> Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203 (1954).

the commercial value in their image under its civil rights statute.<sup>6</sup> Soon thereafter in 1907, New Jersey adopted the right without calling it the right of publicity.<sup>7</sup>

It was not until 1953 that the term “right of publicity” was coined by the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>8</sup> This case was the first time any court clearly distinguished publicity rights from privacy rights, stating that the purpose of the right of publicity was to protect one’s right in the commercial value of one’s photograph, likeness, or image.<sup>9</sup> This case involved two chewing gum manufacturers claiming the right to use a baseball player’s photograph. The court announced that individuals have the exclusive right to the value of their photographs, and the right should be called “the right of publicity.”<sup>10</sup> It reasoned that prominent individuals would feel extremely deprived if corporations and businesses could use the individuals’ photographs without compensation.<sup>11</sup>

#### B. *Purpose and Policies for the Right of Publicity*

As discussed above, the right of publicity regulates who gets to exploit a personality’s attributes. Courts, legislatures, and commentators have identified this right as providing an economic incentive to create works of public interest. The U.S. Supreme Court in its only right of publicity case, *Zacchini v. Scripps-Howard Broadcasting Co.*, stated that the goals of the right of publicity were comparable to those of copyright and patent law, in that it provides an individual the right to realize the reward of his or her undertakings.<sup>12</sup>

Personalities are more motivated to invest in advancing and improving their talents and abilities when they know they are able to ex-

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<sup>6</sup> Memorandum in Opposition of Senate Bill 8373-A from the Comm. on Media Law (June 28, 2010), available at [http://www.nysba.org/AM/Template.cfm?Section=Legislative\\_Memoranda\\_2009\\_20101&ContentID=43117&template=/CM/ContentDisplay.cfm](http://www.nysba.org/AM/Template.cfm?Section=Legislative_Memoranda_2009_20101&ContentID=43117&template=/CM/ContentDisplay.cfm).

<sup>7</sup> *Edison v. Edison Polyform Mfg. Co.*, 73 N.J. Eq. 136, 144 (N.J. Ch. 1907).

<sup>8</sup> 202 F.2d 866, 868 (2d Cir. 1953).

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

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

<sup>12</sup> 433 U.S. 562, 576 (1977).

clusively capitalize on the commercial value developed in their identity, as expressed to the public as attributes.<sup>13</sup> These investments are likely to advance the common good because personalities will produce works that interest the public.<sup>14</sup> The right of publicity also prevents others from unjustly enriching themselves by free riding and commercially benefiting from the value personalities have worked hard to build around their image.<sup>15</sup> A similar rationale for the right of publicity is the “moral right” justification. This justification is based on the concept of natural rights, including the right of one to have the right in that in which he labors.<sup>16</sup> Therefore, personalities want to reap the benefits of their labor and prevent others from unjustly profiting from that labor.

### C. *Current Law Since Haelan*

After the *Haelan* decision, states began to establish the right of publicity in common law, by statute, or both. By the 1970s, courts and legislatures in several states were embracing the right of publicity. For example, California enacted a right of publicity statute in 1971.<sup>17</sup> Six years later, the right of publicity gained widespread notoriety as a result of the U.S. Supreme Court’s acknowledgment of the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>18</sup> The court held that because Ohio had an important state interest in protecting the plaintiff’s incentives, its recognition of the right of publicity did not offend the defendant’s First Amendment rights.

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<sup>13</sup> Jeremy T. Marr, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C. L. REV. 863, 874 (2003) (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 2:6 (2d ed. rev. Mar. 2002)); *see also*, Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 786 (1988) (discussing the benefit of having the right of publicity).

<sup>14</sup> Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125 (1993) (citing Simon Green, *Taking Talents Serious*, 2 CRITICAL REV. 202, 213 (1988)).

<sup>15</sup> Marr, *supra* note 14 (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 2:2 (2d ed. rev. Mar. 2002)).

<sup>16</sup> Madow, *supra* note 15, at 215 (citing Simon Green, *Taking Talents Serious*, 2 CRITICAL REV. 202, 213 (1988)).

<sup>17</sup> CAL. CIV. CODE § 3344 (West 1971).

<sup>18</sup> 433 U.S. 562, 564 (1977).

In 1983, Michigan followed by adopting the right in common law in *Carson v. Here's Johnny Portable Toilets, Inc.*<sup>19</sup> The court held that the defendant infringed the plaintiff's right of publicity because the public could make an association between the phrase, "Here's Johnny", and the personality, Johnny Carson. As of mid-2013, at least thirty-one states recognize the right of publicity through their common law, statutory regime, or both.<sup>20</sup> Although the laws of these states vary widely, most right of publicity causes of action arise and are heard in California and New York, as the majority of American personalities are domiciled in these states.<sup>21</sup>

### III. PROBLEMS WITH STATE RIGHT OF PUBLICITY LAWS

#### A. *Lack of Uniformity Among the States*

Each state determines whether it will recognize a right of publicity and what the scope and limits of the right will be. As a result, state laws vary greatly. It is important to note that while the right of publicity is a right developed and regulated by the state, infringement cases are often heard in federal court due to the interstate and federal law implications.

#### 1. Right of Publicity Statutory Differences

Of the thirty-one states that do recognize the right of publicity, several of the states' right of publicity laws conflict. The significant differences among states result in confusion and unpredictability of outcomes. Eric Goodman, a California intellectual property attorney and professor, agrees that it is difficult for lawyers to properly advise clients on right of publicity matters because parties engage in forum

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<sup>19</sup> 698 F.2d 831, 841-42 (6th Cir. 1983).

<sup>20</sup> JONATHAN D. REICHMAN, GETTING THE DEAL THROUGH: RIGHT OF PUBLICITY 2012 78 (Kenyon & Kenyon LLP, 2012), available at <http://www.kenyon.com/newspublications/publications/2011/~media/Files/Publication%20PDFs/2011/ROP2012%20Kenyon%20%20Kenyon.ashx>.

<sup>21</sup> *Id.*

shopping<sup>22</sup> for the jurisdiction most favorable to their case. New York, California, and Indiana laws are of particular interest to personalities because New York's right is almost in direct conflict with the right in California and Indiana. Although New York was a leader in the development of the right of publicity (as discussed above) and is considered a major cultural and entertainment center, its statutory right is narrow, while California's and Indiana's statutory rights are broad (as discussed below).<sup>23</sup> Also, New York does not recognize a common law right of publicity, but California and Indiana do.

*a. Protected Attributes*

Section 51 of the New York civil rights statute states that one who uses another individual's portrait, voice, picture, or name for trade or advertising purposes without written authorization violates that person's rights.<sup>24</sup>

While New York's statute is limited in scope, California's is much broader, as it protects attributes such as one's signature.<sup>25</sup> Moreover, the types of uses actionable under California's statute are much more expansive than under New York's, as California's statute prohibits use of another person's attributes, in any manner, on or in merchandise, products, or goods, or for purposes of soliciting, advertising or selling without prior authorization.<sup>26</sup>

Indiana protects even more attributes than both New York and California, including distinctive appearance, mannerisms, and gestures.<sup>27</sup> Further, Indiana is the only state that also applies its right of publicity

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<sup>22</sup> Krishan Thakker, *The Federalism Case Against a Federal Right to Publicity*, 10 U. DENV. SPORTS & ENT. L. J. 97, 120 (2011) (citing Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 227, 244 (1999)).

<sup>23</sup> A New York court, in deciding *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953), coined the term "right of publicity." This is discussed in Part I.

<sup>24</sup> N.Y. CIV. RIGHTS LAW § 51 (McKinney 1999 & Supp. 2000).

<sup>25</sup> CAL. CIV. CODE § 3344 (West 1971) (amended 1984).

<sup>26</sup> *Id.*

<sup>27</sup> IND. CODE ANN. § 32-36-1-6 (West 2002).

statute to non-residents who have an actionable claim, as long as the infringement occurred in Indiana.<sup>28</sup>

*b. Postmortem Rights*<sup>29</sup>

The recognition of a postmortem right of publicity turns on whether the state in question treats the right as a property right. Because personal rights are not inherently descendible, a state must treat the right of publicity as a property right in order for a postmortem right to exist. Some states, such as California and Indiana, regard the right of publicity as a property right and therefore allow it to descend.<sup>30</sup> Utah, by contrast, requires the personality to commercially exploit his persona during his lifetime in order for the right of publicity to descend<sup>31</sup> and appears to be the only state with this requirement.<sup>32</sup> Other states, such as New York and Wisconsin, regard the right of publicity as a personal right, meaning that it is non-descendible.<sup>33</sup>

For those states that allow publicity rights to descend, the duration of the postmortem right varies significantly. Virginia's descendible right of publicity only lasts twenty years after the personality's death while California's lasts seventy years and Indiana's and Oklahoma's both last 100 years.<sup>34</sup> Other states have different terms of duration depending on various factors. For example, Washington's descendible right lasts ten years if the person's attribute does not have

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<sup>28</sup> IND. CODE ANN. § 32-36-1-1 (West 2002); *see also* Experience Hendrix, L.L.C. v. Hendrixlicensing.com, Ltd, 766 F. Supp. 2d 1122, 1142 (W.D. Wash. 2011).

<sup>29</sup> A "postmortem" right of publicity, also called a "descendible" right of publicity, refers to the right surviving after the personality has died.

<sup>30</sup> CAL. CIV. CODE § 3344.1 (West 1984) (amended 2009); IND. CODE ANN. § 32-36-1-16 (West 2002).

<sup>31</sup> Reichman, *supra* note 21.

<sup>32</sup> Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete's Right of Publicity*, 10 MARQ. SPORTS L. J. 23, 65 (1999) (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 28:45, at 28-57 (1996)).

<sup>33</sup> N.Y. CIV. RTS. LAW § 50 (McKinney 1999 & Supp. 2000); WIS. STAT. ANN. § 995.50 (West 2013).

<sup>34</sup> VA. CODE ANN. § 8.01-40 (1950). CAL. CIV. CODE § 3344 (West 1971) (amended 2008). IND. CODE ANN. § 32-36-1-8 (West 2002) (amended 2012). OKLA. STAT. ANN. T. 12, § 1449 (West 1985).

commercial value and seventy-five years if it does,<sup>35</sup> whereas Tennessee allows the right to continue indefinitely as long as the deceased personality's attributes are continually exploited.<sup>36</sup>

***States Amend Postmortem Rights.*** In two 2007 federal cases involving Marilyn Monroe's postmortem right of publicity, *Shaw Family Archives Ltd. v. CMG Worldwide, Inc.*,<sup>37</sup> and *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*,<sup>38</sup> both courts ruled that Monroe's rights terminated at death regardless of whether she was domiciled in New York or California. The courts based their rulings on the fact that New York does not recognize a postmortem right of publicity and that Monroe died before California passed its Celebrity Rights Act in 1985.

In response to both federal courts' rulings, California amended its 1985 right of publicity law (§ 3344.1) to grant a retroactive right of publicity to deceased personalities with a date of death on or after January 1, 1915.<sup>39</sup> As a result of this amendment, the Central District Court of California granted CMG World's motion for reconsideration and held that the amended statute would apply in *Milton H. Greene Archives, Inc. v. CMG World, Inc.*,<sup>40</sup> if Monroe was domiciled in California at the time of her death.

The 2008 Washington State Legislature followed suit, revising its Washington Personality Rights Act<sup>41</sup> to protect the postmortem rights of publicity of individuals or personalities no matter where they are domiciled at the time of death.<sup>42</sup> The district court, however, held in *Experience Hendrix, L.L.C., et al. v. Hendrixlicensing.com, Ltd, et al.*,<sup>43</sup> that Washington's statute violated the Due Process and Full Faith

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<sup>35</sup> WASH. REVISED CODE ANN. § 63.60.040 (West 2004). Commercial value is the value something would have if it were offered for sale. INVESTORWORDS.COM, [http://www.investorwords.com/9228/commercial\\_value.html](http://www.investorwords.com/9228/commercial_value.html) (last visited May 31, 2013).

<sup>36</sup> TENN. CODE ANN. § 47-25-1104 (West 1984).

<sup>37</sup> 486 F. Supp. 2d 309 (S.D.N.Y. 2007).

<sup>38</sup> 568 F. Supp.2d 1152 (C.D. Cal. 2008).

<sup>39</sup> CAL. CIV. CODE § 3344.1 (2009).

<sup>40</sup> *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, 568 F. Supp. 2d 1152 (C.D. Cal. 2008).

<sup>41</sup> Lewis R. Clayton, *Right of Publicity, Trademark Dilution, Considering Copyright in Gardens*, 245 N.Y. L.J. 1 (2011), available at <http://www.paulweiss.com/media/103404/9Mar11IPL.pdf> (last visited May 2013).

<sup>42</sup> WASH. REVISED CODE ANN. § 63.60.010 (West 2008).

<sup>43</sup> *Experience Hendrix, L.L.C., et al. v. Hendrixlicensing.com, Ltd., et al.*, 766 F. Supp. 2d 1122, 1140 (W.D. Wash. 2011).

and Credit Clauses of the U.S. Constitution as well as the Dormant Commerce Clause.<sup>44</sup> Therefore, in Washington, the applicable law is the law of the state where a personality was domiciled at the time of death, as the legislature modified its statute after the decision.<sup>45</sup>

***Indiana's Expanded Postmortem Rights.*** Many states apply the statute of the state of domicile at the time of a personality's death.<sup>46</sup> Indiana, however, extends a postmortem right of publicity to personalities not domiciled in Indiana at the time of death.<sup>47</sup> Indiana's statute provides that regardless of domicile, residence, or citizenship, no one may use a personality's right of publicity commercially in Indiana without consent for a period of 100 years after the death of such person, unless the personality<sup>48</sup> dies intestate with no surviving heirs.<sup>49</sup> Therefore, states vary significantly in their postmortem guidelines for the right of publicity, which could lead to issues of forum shopping and unfairness.

## 2. Different Jurisdictions Interpret Similar Cases Differently

*Facenda v. NFL, Films, Inc.*,<sup>50</sup> and *The Romantics v. Activision Publishing, Inc.*,<sup>51</sup> both decided in 2008, are two similar cases with different outcomes based on jurisdiction. *Facenda* concerned the rights of a

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<sup>44</sup> Clayton, *supra* note 42, at 1 (quoting *Healy v. Beer Inst. Inc.*, 491 U.S. 324, 336 (1989)). The Dormant Commerce Clause is a reference to the implied prohibition of states passing laws that burden interstate commerce. Commerce Clause, Legal Information Institute, Cornell University Law, [http://www.law.cornell.edu/wex/commerce\\_clause](http://www.law.cornell.edu/wex/commerce_clause).

<sup>45</sup> *Experience Hendrix, L.L.C., et al. v. Hendrixlicensing.com, Ltd., et al.*, 766 F. Supp. 2d 1122 (W.D. Wash. 2011); *see also*, Aubrie Hicks, *The Right to Publicity After Death: Postmortem Personality Rights in Washington in the Wake of Experience Hendrix v. HendrixLicensing.com*, 36 SEATTLE U. L. REV. 275, 283 (2012).

<sup>46</sup> *Id.*

<sup>47</sup> Clayton, *supra* note 42, at 1.

<sup>48</sup> IND. CODE ANN. § 32-36-1-6 (2002): "Personality" defined. "As used in this chapter, 'personality' means a living or deceased natural person whose: (1) name; (2) voice; (3) signature; (4) photograph; (5) image; (6) likeness; (7) distinctive appearance; (8) gesture; or (9) mannerisms; has commercial value, whether or not the person uses or authorizes the use of the person's rights of publicity for a commercial purpose during the person's lifetime."

<sup>49</sup> IND. CODE ANN. § 32-36-1-8 (2002).

<sup>50</sup> 542 F.3d 1007 (3rd Cir. 2008).

<sup>51</sup> 532 F. Supp. 2d 884 (E.D. Mich. 2008).

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Philadelphia broadcaster, John Facenda, who provided his well-known and distinctive voice for many of NFL Films' productions. Several years after Facenda's death, NFL Films used samplings of Facenda's voice from its copyrighted sound recordings in a television production called "*The Making of Madden NFL 06*" to promote the *Madden NFL 06* football video game. The Facenda estate brought several claims, including infringement of Facenda's right of publicity, against NFL Films.

The district court granted summary judgment to Facenda's estate on the right of publicity claim. The Third Circuit affirmed the district court's ruling on the right of publicity claim. The Third Circuit applied the two-pronged copyright preemption test to determine if federal copyright law preempted the Facenda estate's right of publicity claim under Pennsylvania law.<sup>52</sup> The two prongs of the test seek to determine whether a state law that is in conflict with the exclusive rights provided to works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright.<sup>53</sup> The court found that the state law cause of action was not barred by the defendant's exclusive rights under the federal Copyright Act because Pennsylvania's right-of-publicity statute required a showing of commercial value, which is an additional element that copyright law does not require.<sup>54</sup> As discussed below, federal copyright law trumps any law that is its equivalent. Here, the court determined Pennsylvania's right of publicity law is not equivalent because it requires an additional element that the copyright law does not require. Thus, Pennsylvania's right of publicity law was not preempted.

The Third Circuit followed the lead of the Second Circuit, which had added an additional element for determining whether federal copyright law preempts a state right of publicity in *Harper & Row, Publishers, Inc. v. Nation Enterprises*.<sup>55</sup> The Second Circuit ruled that if a state law violation is predicated upon an act incorporating elements be-

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<sup>52</sup> The Copyright Act preempts state laws that conflict with the exclusive rights provided to works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by Sections 102 and 103.

<sup>53</sup> Copyright Act 17 U.S.C. §§ 102 and 103.

<sup>54</sup> The issues of copyright and right of publicity conflict, and preemption is discussed in Section B of this Part.

<sup>55</sup> 723 F.2d 195, 204 (2d Cir. 1983).

yond reproduction, the right of publicity is not equivalent to the copyright.<sup>56</sup> As for the second prong of the copyright preemption test, the court also found that Facenda's voice did not fall within the subject matter of copyright. Thus, the court held that Pennsylvania's right of publicity statute, as applied to Facenda's voice, did not conflict with and could not be preempted by copyright law.<sup>57</sup>

The Eastern District Court of Michigan reached a contrary holding in *The Romantics v. Activision Publishing*. In that case, The Romantics, a rock band, wrote and recorded a song titled "What I Like About You" in 1979. Several years later, Activision Publishing, a company that makes and sells video games, and its subsidiary, RedOctane, created the video game *Guitar Hero Encore: Rock's the 80s (Guitar Hero)*.<sup>58</sup> RedOctane had a license from the copyright owner, EMI Entertainment World, Inc., for the song "What I Like About You." The license allowed RedOctane to use the composition of the song to make a revised recording and include it with visual images in the *Guitar Hero* video game.

The Romantics sought a preliminary injunction to restrain Activision Publishing from offering or selling the *Guitar Hero* video game. The Romantics claimed Activision Publishing and RedOctane violated their right of publicity by recording a newer version of their song, "What I Like About You," which carried the subtitle, "as made famous by the Romantics," and using it in the *Guitar Hero* video game.<sup>59</sup> The court held that The Romantics did not establish that their right of publicity claim would succeed on the merits because "Michigan has never recognized right of publicity in the sound of a voice, even if distinctive, nor has it recognized a right of publicity for a combination of voices . . . ."<sup>60</sup> The court also stated that the Copyright Act preempted the right of publicity claim. The court applied the two-prong copyright preemption test and found that The Romantics' right of publicity claims to the sound of the song, "What I Like About You,"

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<sup>56</sup> *Id.* at 200.

<sup>57</sup> *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1032 (3rd Cir. 2008).

<sup>58</sup> *The Romantics v. Activision Publ'g*, 532 F. Supp. 2d 884, 886 (E.D. Mich. 2008).

<sup>59</sup> *Id.* at 886-88.

<sup>60</sup> *Id.* at 888.

fell within the subject matter of the Copyright Act because The Romantics' claims were based on the licensing of a copyrighted work. The court also found that the rights claimed by The Romantics were equivalent to the rights protected by the Copyright Act.

These two cases highlight that different jurisdictions vary in their applications of the copyright preemption test in similar cases. Pennsylvania's right of publicity recognizes one's voice as a protectable attribute while Michigan's does not. Although in both instances the voice was fixed in a copyrighted work, the court in *Facenda* focused on the attribute and not the copyrighted work, whereas the court in *The Romantics* focused on the copyrighted work.

### 3. The Same Jurisdiction Provides Conflicting Decisions

In *Downing v. Abercrombie & Fitch*<sup>61</sup> and *Laws v. Sony Music Entertainment, Inc.*,<sup>62</sup> the Ninth Circuit reached different holdings only five years apart despite the similar nature of the two cases.

In *Downing*, a former surfer named George Downing, and other individuals, filed suit against Abercrombie & Fitch, a specialty retailer, for infringement of their right of publicity. In 1965, Downing competed in an international surfing championship, which was filmed by Photographer Leroy Grannis. Years later, in 1999, Abercrombie obtained a copyright license for some of Grannis' photographs of the surfing championship to support the surfing theme for its upcoming "Abercrombie and Fitch Quarterly," ("Quarterly"). The Quarterly featured a photograph of the surfers, on which Grannis had written their names. On the adjacent page, Abercrombie advertised tee-shirts similar to those worn by the surfers in the photograph.

The court rejected Abercrombie's copyright preemption argument and found that Abercrombie used the photograph to promote its Quarterly's surf theme. However, there was no information in the catalog stating that the individuals in the photo endorsed or promoted Abercrombie or its products. Therefore, the court stated that the issue was not the publication of the photograph itself, but rather the use of Downing and the other surfers' likenesses and names. Citing Melville Nim-

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<sup>61</sup> *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

<sup>62</sup> *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134 (9th Cir. 2006).

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mer's treatise on copyright law,<sup>63</sup> the Court held that although the surfers' likenesses and names are fixed in a copyrighted photograph, the publicity rights asserted are not the subject matter of or equivalent to those protected under copyright law. Therefore, the right of publicity claim was not preempted by the Copyright Act.

In *Laws v. Sony Music Entertainment, Inc.*,<sup>64</sup> a case similar to *Downing*, the Ninth Circuit nonetheless reached a different result. In *Laws*, a professional singer, plaintiff Debra Laws, along with Spirit Productions, a recording company, made an agreement with Elektra and Asylum Records to create master recordings of Laws' vocal performances for Elektra. The agreement granted Elektra an exclusive license to the master recordings. Further, Elektra obtained the right to use and allow others to make use of Laws' likeness, name, and other identifying attributes in association with the master recordings. Elektra agreed to obtain written consent from Laws before using or authorizing others to sell records embodying the master recordings.

Years later, Elektra's agent entered an agreement with Sony Music Entertainment Inc. to grant Sony a "non-exclusive license" to use a sample of Laws' recording of "Very Special" in a song to be performed by other recording artists. The copyright owner, Elektra, did not receive permission from Spirit or Laws prior to releasing the video and disc, and neither Spirit nor Laws received compensation for the release. Sony then published a disc and music video which integrated short samples of "Very Special" into the Jennifer Lopez recording of "All I Have."

Laws brought a right of publicity claim against Sony for infringement. The Court found that Laws' action did not concern her name or image, but concerned the copyrightable work itself. The court stated that Sony licensed the use of Laws' actual sound recording and incor-

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<sup>63</sup> 1 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* § 1.01[B][1][c] (Matthew Bender, Rev. Ed.). [T]he "work" that is the subject matter of the right of publicity is the persona. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the copyright clause of the Constitution. A fortiori it is not a "work of authorship" under the Act. Such name or likeness does not become a work of authorship simply because it is embodied in a copyrightable work such as a photograph.

<sup>64</sup> *Laws*, 448 F.3d at 1134.

porated the sound recording of Laws singing her song into the “All I Have” song produced by Sony. While Laws argued that Sony misappropriated her voice, the court said Sony had a license and right to use her sound recording, making the case an issue of copyright and not an issue of right of publicity. The Court reasoned that using a recording of Laws’ voice is different than licensing a song and having someone imitate the singer’s voice who sang the song, as in *Midler v. Ford Motor Co.*<sup>65</sup> The Court also found that the right that Laws claimed was comparable to the right granted in Section 106 of the Copyright Act,<sup>66</sup> thus, the court held that Laws’ right of publicity claims were preempted by copyright.

These two cases highlight how the application of the copyright preemption test varies even within a jurisdiction. California’s right of publicity law protects voice, name, signatures, and images, but the Ninth Circuit nonetheless ruled differently on these cases. The Ninth Circuit seems to pick and choose how to view a case because in *Downing*, the court focused on the attributes, whereas in *Laws*, it focused on the copyrighted work, which is the sound recording embodying the plaintiff’s voice. Both cases involved works in a tangible medium; however, the court chose to view each case differently and not overturn itself, which causes confusion and is therefore problematic.

### B. *Conflict Between Right of Publicity and Copyright*

The purpose of the right of publicity is similar to that of copyright. Both rights protect artists and encourage creativity.<sup>67</sup> However, the right of publicity, which only began receiving recognition in 1953, conflicts directly and indirectly with copyright law. These conflicts are problematic because not all courts conduct the appropriate analysis or apply the copyright preemption test consistently to determine if the state law right of publicity claim is preempted by the Copyright Act when a conflict exists. Even courts that do conduct the appropriate

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<sup>65</sup> See *infra* Section D of this Part.

<sup>66</sup> 17 U.S.C. § 106 (1976): Exclusive rights in copyrighted works. “. . . the owner of copyright under this title has the exclusive rights to do and to authorize . . . to prepare derivative works based upon the copyrighted work.”

<sup>67</sup> Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 204 (2002).

analysis do not apply it uniformly, thereby reaching different conclusions, as demonstrated above. When courts do not properly apply the copyright preemption test in situations where copyright should trump the right of publicity (according to the statute), copyrights are devalued.<sup>68</sup> They are devalued because licensees will not be as interested in licensing copyrights when they know a right of publicity claim will trump their copyright license and cause them to pay additional money to use the same material.

Courts must consider federal preemption when deciding state cases. Section 301 of the Copyright Act specifically states that: “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . and come within the subject matter of copyright . . . are governed exclusively by this title.”<sup>69</sup>

The *Laws v. Sony Music Entertainment, Inc.* case (discussed above) is an example of a court properly applying Section 301, because the right of publicity cannot interfere with the copyright holder or licensee’s right to use the copyrighted work in a manner consistent with the Copyright Act. Section 301 is applied when state law claims, such as the right of publicity, attempt to protect equitable or legal rights that are equivalent to the exclusive rights already protected under Section 106 of the Copyright Act. Section 301 is also applied where the state law claim pertains to work that qualifies as a work protected under Sections 102 and 103 of United States Code Title 17, embodying the Copyright Act.<sup>70</sup>

The work in question in *Laws* was a vocal performance, which was entirely incorporated into a copyrighted medium, a sound recording.<sup>71</sup> Therefore, it satisfied the “subject matter” part of the test. The claim also satisfied the “equivalency” part of the test because Laws argued that she had the right to reproduce her sound recordings (a right pro-

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<sup>68</sup> *Laws*, 448 F.3d at 1145, (citing *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970)).

<sup>69</sup> 17 U.S.C. § 301 (1998).

<sup>70</sup> GREGORY J. BATTERSBY AND CHARLES W. GRIMES, *Trademark & Copyright Disputes: Litigation Forms and Analysis* § 3.03B (2003).

<sup>71</sup> 17 U.S.C. § 102(a)(7) (1976).

vided by the Copyright Act).<sup>72</sup> Laws further argued that her claim was not equivalent to rights provided under copyright law because her claim had the additional element of commercial exploitation. The court responded that the mere existence of an extra element does not significantly distinguish a right of publicity claim from a copyright claim.<sup>73</sup> By finding that the state law claim fell within the same subject matter and had an equivalent right as protected by copyright law, the *Laws* court properly applied section 301 preemption. This is contrary to the aforementioned *Facenda* decision, which held that an additional element takes the right of publicity out of the copyright realm. Therefore, personalities in different jurisdictions are treated differently.

Though Section 301 seems clear on its face, several examples exist that demonstrate courts inconsistently or improperly apply Section 301. Two examples where the courts improperly applied section 301 are discussed below.

1. *Wendt v. Host International*<sup>74</sup>

The *Wendt v. Host International* case, decided by the Ninth Circuit in 1997, is a good example of the conflict between copyright law and the right of publicity. Host, a company that provided shops and restaurants in airports, wanted to start a chain of bars in airports based on the television show *Cheers*. The company obtained a license to use the *Cheers* characters from Paramount Pictures, the copyright owner. The company created animatronic robots for the restaurants based on the two star characters from the show, Norm and Cliff, played by George Wendt and John Ratzenberger. Wendt and Ratzenberger then sued Host International for infringement of their rights of publicity.

After comparing photos of Wendt and Ratzenberger to those of the animatronic robots, the district court ruled that there was no likeness and granted Host's motion for summary judgment on the right of publicity claim. The Ninth Circuit reversed the district court's ruling, holding that there was an issue of material fact concerning the degree of likeness between the robots and the actors.

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<sup>72</sup> 17 U.S.C. § 106(1) (1976).

<sup>73</sup> *Laws*, 448 F.3d at 1145.

<sup>74</sup> *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997).

The Ninth Circuit reasoned that the case at hand was not a preemption case.<sup>75</sup> The Court quoted Congress, stating that plaintiffs' claims are not preempted by the federal copyright statute so long as they "contain elements, such as the invasion of personal rights . . . that are different in kind from copyright infringement."<sup>76</sup> Although the California statute does not provide such protection, the Court used the conflict between California's statutory and common law right of publicity to support the decision. The court stated that under the common law, the plaintiffs might be able to use the right of publicity to claim a right to the characters that are owned by the copyright owner because the characters embody their persona. Thus, the court held that the robots were not so different from the characters in the show so as to have their own persona to the point that a jury could not find that Host infringed the actors' rights of publicity.

This holding is a good example of the conflict between copyright and the right of publicity. Copyright permits a copyright owner or licensee to make a derivative work from the original work,<sup>77</sup> and the *Wendt* decision did not hold that copyright law preempted the actors' rights of publicity. Instead, the *Wendt* decision has effectively allowed the right of publicity to take away the right to produce derivative works, a right indirectly granted by copyright law.<sup>78</sup> While under certain circumstances, laws can be made to limit derivative works, the right of publicity does not rise to the level of importance and necessity to justify interference with any part of the federal copyright law.

Judge Alex Kozinski dissented and criticized the way the majority favored the right of publicity over federal copyright law. Judge Kozinski, who also dissented in *White v. Samsung Electronics* (discussed below),<sup>79</sup> was bothered more by the result of the *Wendt* case than the *White* case. Unlike the *White* defendants, Host International

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<sup>75</sup> *Id.* at 810.

<sup>76</sup> *Id.* (quoting *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992)).

<sup>77</sup> 17 U.S.C. § 106 (1976): Exclusive rights in copyrighted works. "[T]he owner of copyright under this title has the exclusive rights to do and to authorize . . . to prepare derivative works based upon the copyrighted work."

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

<sup>79</sup> Discussed in Section D of this Part.

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had obtained a license, which permitted it to use the *Cheers* copyrights. Kozinski stated that the *Wendt* decision is the result of the “sweeping standard” the court adopted in the *White* case.<sup>80</sup>

In *Wendt*, the court allowed the right of publicity to outweigh copyright law. The public and copyright holders are harmed and perplexed when courts choose to expand the right of publicity rather than find in favor of the copyright owner or licensee, especially since copyright is a federal law, which purportedly trumps state law. As a result, the right of publicity is reducing the significance of federal law, specifically copyright law.

## 2. *Brown v. ACMI Pop Division*<sup>81</sup>

In 2007, the Illinois Court of Appeals held that Brown’s right of publicity claims were not preempted by the Copyright Act. Corbis, a stock photography agency and copyright owner and licensor, offered more than 2.1 million photographs and images for licensing on its website. The Corbis collection included photographs of James Brown, a famous singer and musician. Brown brought a right of publicity infringement claim in Illinois<sup>82</sup> against Corbis for using his image on the Internet without permission.<sup>83</sup>

While Corbis did not use or sell Brown’s images or use his images to advertise or sell a product, the agency did offer to license particular rights granted by copyright law. Yet the trial court held that Corbis was marketing a “product” to earn revenue and that because Brown did not receive compensation from the unauthorized commercial use, his publicity rights were violated.

The Illinois trial court relied on the Seventh Circuit’s decision in *Toney v. L’Oreal USA, Inc.*,<sup>84</sup> to determine whether the Copyright Act preempted Brown’s right of publicity claims. In *Toney*, the court focused on the plaintiff’s likeness and not the copyrighted photograph,

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<sup>80</sup> *Wendt v. Host International, Inc.*, 197 F.3d at 1284, 1286 (1999).

<sup>81</sup> *Brown v. ACMI Pop Division*, 873 N.E.2d 954 (Ill. App. Ct. 2007).

<sup>82</sup> “The right to control and to choose whether and how to use an individual’s identity for commercial purposes is recognized as each individual’s right of publicity.” 765 Ill. Comp. Stat. 1075/10 (1999).

<sup>83</sup> *Brown v. ACMI Pop Division*, 873 N.E.2d at 955.

<sup>84</sup> *Toney v. L’Oreal USA, Inc.*, 406 F.3d 907 (7th Cir. 2005).

stating that the likeness of the plaintiff was not "fixed in a tangible medium of expression" and that the state publicity rights are not "equivalent" to any of the Copyright Act exclusive rights.<sup>85</sup>

Although Corbis argued that the Ninth Circuit ruling in *Laws*<sup>86</sup> (discussed above) should govern instead of *Toney*, the appeals court affirmed the trial court's ruling. The appeals court found that although the photos as displayed on Corbis' Internet Web page were most likely fixed in a tangible medium, Illinois's Publicity Act, as applied in this case, was not preempted by copyright law, because the display of the photos of Brown on the web page constituted an improper commercial use under both the Illinois common law and the Publicity Act.<sup>87</sup>

### C. *Inconsistent Application of Copyright Preemption*

Negative effects result when the two-part copyright preemption test is not applied or is applied incorrectly. The Copyright Act is a federal statute; therefore, it preempts conflicting state statutes. In the last fifteen years, various courts, especially the Ninth Circuit, have held that the right of publicity supersedes the Act's preemption provision. These courts have thus effectively created an exception to copyright preemption, and this exception prevents copyright holders from fully exploiting their copyrights.<sup>88</sup> Hence, these rulings have diminished the value and incentives provided by copyright law.

For example, the Third Circuit appears to have relied heavily on the late copyright expert Melville Nimmer to determine whether a right of publicity claim was preempted by copyright in the *Facenda* case (discussed above).<sup>89</sup> Nimmer proposed that if the primary use of the copy-

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<sup>85</sup> *Id.* This case concerns a model who consented to use of her picture for the defendant's hair packaging products for a contracted period of time; however, the defendant continued use her picture on the company's products beyond the agreed period.

<sup>86</sup> *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1142 (9th Cir. 2006) (distinguishing *Toney*, holding that plaintiff claimed misappropriation of her identity *was separate and apart* from the any copyrighted work.

<sup>87</sup> *Brown v. ACMI Pop Division*, 873 N.E.2d at 963.

<sup>88</sup> P. Stephen Fardy, *Feet of Clay: How the Right of Publicity Exception Undermines Copyright Act Preemption*, 12 TEX. INTELL. PROP. L.J. 443, 444 (2003-2004).

<sup>89</sup> *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3rd Cir. 2008).

right is for commercial advertising, then it should not preempt the right of publicity claim.<sup>90</sup> The Court held that NFL Films' twenty-two minute television production, which included Facenda's voice, was promotional. Thus, NFL Films' copyright did not preempt Facenda's estate's right of publicity claim. Both the literal reading of the right of publicity statute and the Nimmer test, however, fail to address the fundamental question of when state protection does conflict with federal policy.<sup>91</sup>

Nimmer's proposal is also problematic because it conflicts with the congressional goals of copyright law. The proposal does not foster a uniform copyright system, which is something the authors of the Copyright Act of 1976 specifically sought to have.<sup>92</sup> Nimmer's proposal fails to do so because it suggests that courts base preemption on the personality's contract with an advertiser, which leaves much open to interpretation<sup>93</sup> and can lead to inconsistencies among the courts.<sup>94</sup>

Copyright protects derivative works.<sup>95</sup> Therefore, copyright law permits the owner of a copy, lawfully obtained, to publicly display the work without having to ask permission of the copyright owner.<sup>96</sup> This right is devalued if courts do not hold that copyright law preempts the right of publicity.

When courts fail to hold that copyright law preempts a right of publicity claim when the preemption test indicates that it should, as

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<sup>90</sup> *Id.* at 1028.

<sup>91</sup> Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 814 (1990).

<sup>92</sup> *Id.* (citing Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act 1976*, 10 VAND. J. ENT. & TECH. L. 1, 2 (2007)). "The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law. The declaration of this principle in section 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection." 17 U.S.C. § 301.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> Library of Congress, *Copyright Registration for Derivative Works*, CIRCULAR 14 (2011), available at <http://www.copyright.gov/circs/circ14.pdf>.

<sup>96</sup> See Riccard, *supra* note 93, at 458; see also 17 U.S.C. § 109(c), which states that "the owner of a particular copy lawfully made under this title...is entitled, without the authority of the copyright owner, to display that copy publicly . . . ." <http://www.law.cornell.edu/uscode/text/17/109> (last visited Feb. 14, 2012).

demonstrated above, copyright holders, licensees, and the public are harmed. Copyright holders could lose out on licensing fees because the incentive the Copyright Act provides—ownership of exclusive rights for a specified length of time—is dwindling. Licensees will be harmed if they obtain a license to produce a derivative work but then lose a case regarding the right of publicity in the work. The money they have invested, as well as expected future earnings from the derivative work, would be lost. This type of loss will discourage licensees from obtaining licenses to copyrighted works, thereby depriving the public of new creative works and entertainment.

#### D. *Overprotection*

As discussed above, the right of publicity originally protected a personality's right to her likeness, image, or name.<sup>97</sup> The right has expanded far beyond those attributes, leading to overprotection. Overprotection occurs when the right of publicity either protects more attributes than necessary to accomplish the purpose and policies underlying the right or conflicts with other intellectual property rights like copyright. As noted in Part I, the primary policy reason underlying the right of publicity is an economic incentive for personalities to perform or create works of interest to the public.<sup>98</sup> Expanding the right to protect common actions and intangibles such as “evoking an image”<sup>99</sup> provides insufficient notice to the public as to what is or is not protected.<sup>100</sup> These kinds of expansions put the public at the whim of personalities, resulting in a “chilling effect on commercial innovation and opportunity.”<sup>101</sup>

The purpose of protecting a personality's right for the ultimate benefit of the public is no longer fulfilled when the right is expanded to the point that it discourages the creation of expressive work in the public

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<sup>97</sup> The origin of the right of publicity. See *supra* Part I.A.

<sup>98</sup> William M. Heberer III, Comment, *The Overprotection of Celebrity: A Comment on White v. Samsung Electronics America, Inc.*, 22 HOFSTRA L. REV. 729, 746 (1994).

<sup>99</sup> *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992).

<sup>100</sup> See Andrew W. Eaton, Note, *We're Not Gonna Take It!: Limiting the Right of Publicity's Concept of Group Identity for the Good of Intellectual Property, the Music Industry, and the People*, 14 J. INTELL. PROP. L. 173, 185 (2006).

<sup>101</sup> See Pesce, *supra* note 92, at 803.

domain. Because not all states adhere to the initial underlying policy rationale, the purpose and policies are no longer the focus of state legislatures and courts. In fact, the courts look to common law to find or create an attribute, not as a state statute. The federal circuit court cases, discussed below, are examples of overprotection of a personality's right.

### 1. Courts' Expansion of Protection Relates to Fame

The Ninth Circuit decided *Motschenbacher v. R.J. Reynolds Tobacco Co.*,<sup>102</sup> in 1974. Lothar Motschenbacher, an internationally known professional race car driver, sued R.J. Reynolds Tobacco Company for misappropriating his likeness, name, and personality. In 1970, Reynolds created a televised commercial that included a "stock" color photograph portraying various race cars on a racetrack. For its commercial, Reynolds used a car similar to that of Motschenbacher's but with several variations; Reynolds used the number "11" instead of "71", added a spoiler to the rear of the car, and added "Winston," Reynolds' product name. Motschenbacher's facial features were not discernible; his distinctive red car with white pinstripes, however, appeared to be in the foreground of the commercial with other race cars. Some of Motschenbacher's associates who saw the commercial assumed it was Motschenbacher's car and that his car was sponsored by Winston.

The court found in favor of Motschenbacher, as it held that Reynolds appropriated Motschenbacher's "proprietary interest" in his identity via its commercial. The court said that the use of the various distinctive characteristics without authorization violated Motschenbacher's right of publicity. With this decision, the Ninth Circuit extended the right of publicity to allow a personality to have exclusive rights over a type or style of car. The court, therefore, expanded protection to encompass physical markers, even when not physically attached to a personality so as to protect the personality from what they perceive to be injury to their image.<sup>103</sup>

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<sup>102</sup> *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974).

<sup>103</sup> 498 F.2d 821 (1974).

The Sixth Circuit decided *Carson v. Here's Johnny Portable Toilets, Inc.*<sup>104</sup> in 1983. Host and star of *The Tonight Show* Johnny Carson brought a suit against the Here's Johnny Portable Toilets company.<sup>105</sup> Each night since *The Tonight Show* began in 1962, Carson was introduced with the expression "Here's Johnny."<sup>106</sup> Carson granted a license to the clothing company Johnny Carson Apparel, Inc. to use his picture, name, and "Here's Johnny" on the company's promotional material, advertisements, and clothing labels. The toilet company, however, never received a license from Carson to use the phrase for its company or on its portable toilets, so the court found that the company had infringed Carson's right of publicity.

Applying Michigan's right of publicity law, the court reasoned that anything used without authorization in commercial advertising that conjures up an association with a personality violates that personality's right of publicity. As a result, the court held that Carson had the right to prevent anyone from exploiting the phrase, "Here's Johnny," commercially for the duration of his life. Further, his heirs or assignees could exploit the right commercially because Michigan allows for postmortem right of publicity.

Neither Carson's nor Motschenbacher's direct name or image was involved in either case. Yet, both circuit courts applied the right of publicity. These types of expansions exceed the scope of the right to protect a personality from commercial exploitation.<sup>107</sup> A personality is defined as a human being; therefore, protecting the car a personality drives does not comport with the policy reasons for the right of publicity, nor does protecting a generic phrase because these are common, everyday items in the public domain, not directly belonging to a particular personality. Protecting generic phrases or race cars does not benefit the public, as the protection of such elements does not encourage artists to be creative.

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<sup>104</sup> *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

<sup>105</sup> *Id.* at 833.

<sup>106</sup> *Id.* at 832.

<sup>107</sup> The scope of the right of publicity should be limited to protect direct attributes of personalities to the point necessary to fulfill the initial underlying policy.

*a. Sound-Alike Performance*

The singing voice became a major attribute of discussion in right of publicity cases in the late 80s and early 90s. In 1988, the Ninth Circuit decided *Midler v. Ford Motor Co.*<sup>108</sup> In this case, Ford, a vehicle manufacturer, hired an imitator to sing one of entertainer Bette Midler's songs for its car marketing advertisement. Ford had a license to use the song and the advertisement did not use Midler's name or picture. Midler, a nationally known singer and actress, brought a right of publicity claim against Ford. The Ninth Circuit found in favor of Midler and held that Ford had infringed Midler's right of publicity by hiring someone to imitate her voice while singing one of her songs.

Four years later, the Ninth Circuit expanded the right of publicity's protectable attributes in *Waits v. Frito-Lay, Inc.*<sup>109</sup> Frito-Lay, a snack food company, hired an advertising agency to produce an advertising campaign for a new product. The agency wrote a commercial and song to echo some of the words in Tom Waits' song "Step Right Up." The agency also hired a singer to imitate Waits' iconic voice since Waits, a professional singer with a deep, raspy voice, did not do commercial endorsements.

The Frito-Lay commercial premiered on over 250 radio stations in 1988. When Waits heard it, he brought suit against Frito-Lay and the advertising agency, claiming "voice misappropriation." The Ninth Circuit coined this term in *Midler* in 1988. The court found that Waits' right of publicity was infringed because the commercial "featured a deliberate imitation of Waits' voice."<sup>110</sup> The court held that a personality could protect an individual style of singing.

These Ninth Circuit decisions thus expanded the right to prevent sound-alikes and protect styles of singing. California's right of publicity statute only protects the use of a personality's actual voice, not the imitation of a personality's voice. Therefore, the district court in *Midler* found that there was "no legal principle preventing imitation."<sup>111</sup> Although the Ninth Circuit admitted that the statute did not

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<sup>108</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1998).

<sup>109</sup> *Waits v. Frito-Lay Inc.*, 978 F.2d 1093 (9th Cir. 1992).

<sup>110</sup> *Id.* at 1098.

<sup>111</sup> *See Midler*, 849 F.2d at 462.

protect imitation of a personality's voice, it created a "voice misappropriation" tort under California common law and found that the tort was comparable to a violation of the right of publicity.<sup>112</sup> By creating this tort and reversing the district court's summary judgment for Ford, the court held that imitating a personality's distinctive voice is actionable.

This type of expansion frustrates the purpose of copyright, as copyright has a goal of preserving the public domain and preventing artists, authors, and the like from protecting ideas. Imitations of sound recordings are allowed by the copyright Sound Recording Amendment.<sup>113</sup> Instead of expanding the right of publicity in *Midler*, the court should have affirmed the district court's ruling that the right of publicity claim was preempted by copyright and that Midler had a cause of action under the Lanham Act.<sup>114</sup> The same is true for *Waits*.

Also, by certain jurisdictions expanding the right of publicity and other jurisdictions, such as New York, not following suit, the disparity among states is becoming even greater. Additionally, these expansions limit future performers' creativity, as well as the quantity and type of works available to the public<sup>115</sup> because the public domain is depleted as a result of the expansions.

*b. Right Expanded to Include Simply "Evoking an Image"*

Four years after the *Midler* decision, the Ninth Circuit further expanded publicity rights in *White v. Samsung Electronics*.<sup>116</sup> Samsung Electronics, an electronic company, used a robot dressed like Vanna White standing in front of a *Wheel of Fortune* set in its advertisement for VCRs.<sup>117</sup> White, the *Wheel of Fortune* game show co-host, sued

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<sup>112</sup> *Id.* at 463.

<sup>113</sup> 17 U.S.C. §114(b) (2010) (explaining that exclusive rights of the copyright owner do not extend to creation of other sound recordings even though such sounds imitate or simulate those in the copyrighted sound recording).

<sup>114</sup> 15 U.S.C.A § 1125(a)(1) (making it an offense to misrepresent information in a way that is likely to deceive consumers about the origin or approval of such information).

<sup>115</sup> Rothman, *supra* note 68, at 221.

<sup>116</sup> *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992).

<sup>117</sup> According to Judge Alfred Goodwin, the board was "instantly recognizable as the Wheel of Fortune game show set." No information is provided in the case as to whether Samsung licensed the right to use the set.

Samsung for infringement of her right of publicity. Samsung argued that the fair use<sup>118</sup> defense should apply because the advertisement did not include a photo of White or her name; it simply parodied her persona.

The district court held that none of White's protected attributes were violated based on California law. The Ninth Circuit, however, reversed the district court and disagreed with the fair use defense based on parody. The court further expanded the right to include "evoking an image based on a role" as a protected attribute by holding that Samsung used White's persona by conjuring up her image in the mind of the public.

This decision, as Judge Kozinski stated in his dissent to the denial of an en banc review,<sup>119</sup> extended the right of publicity much too far. Kozinski said the decision to deny review of the case is a good example of overprotection.<sup>120</sup> He reasoned that the overprotection of intellectual property rights is just as detrimental as under-protection because of the stifling effect overprotection has on the same creative forces it is intended to foster.<sup>121</sup> Further, California's right of publicity statute does not protect a personality from parody. Therefore, to correct a perceived wrong done to White, the Court created law to protect an "evoked image" as an attribute. Cases in this area widen the gap between right of publicity claimants and their true identities.<sup>122</sup>

Thus, in 1999, when the Ninth Circuit in *Wendt v. Host International* (discussed above), held that simply evoking a celebrity's persona is sufficient to infringe the right of publicity, Judge Kozinski said, "*White's* voracious logic swallows up rights conferred by Congress under the Copyright Act."<sup>123</sup> The *White* case is a good example of overprotection, as it extended the right of publicity well beyond the most standard protected attributes of the right. Judge Kozinski warned

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<sup>118</sup> BLACK'S LAW DICTIONARY 16( (9th ed. 2009) (defining a parody as a form of critiquing or ridiculing an original work. Parodies are "protected as free speech." For copyright, a work is protected if it is a fair use of the original work).

<sup>119</sup> 989 F.2d 1512 (1993).

<sup>120</sup> *Id.*

<sup>121</sup> *Id.* at 1513

<sup>122</sup> See Jeffrey Malkan, *Stolen Photographs: Personality, Publicity, and Privacy*, 75 TEX. L. REV. 779, 781 (1997).

<sup>123</sup> See *Wendt*, 197 F.3d at 1285.

the court that, by allowing the expansion in *White*, it was jeopardizing creativity by depleting the public domain,<sup>124</sup> because intellectual property rights are supposed to protect only against particular types of appropriation. The expansions in *White* and *Wendt* failed to put the necessary limits on this intellectual property right that other intellectual property rights have. The court found no derivative work in *Wendt*, nor any idea-expression dichotomy or fair use exceptions in *White*.<sup>125</sup>

## 2. Personality Quest for Expansive Protection

The right of publicity, in jurisdictions like California and Indiana, has expanded to the point that personalities think that any reference or perceived reference to them qualifies as a violation of their right.<sup>126</sup>

### *a. Lindsay Lohan against E\*Trade Securities, LLC*<sup>127</sup>

Lindsay Lohan, an actress arrested on multiple occasions for drunk driving,<sup>128</sup> filed a 100 million dollar lawsuit against E\*Trade Securities, an investment company, for misappropriation of her name. E\*Trade is famous for producing baby commercials to advertise its services.<sup>129</sup> In 2010, the investment company produced another baby commercial, and this time one of the babies was named “Lindsay.” During the commercial, one baby asked about the “milkaholic Lind-

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<sup>124</sup> Risa J. Weaver, Abstract, *Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute*, 2 DUKE L. & TECH. REV., ¶10 (2010).

<sup>125</sup> *White v. Samsung Electronics Am. Inc.*, 971 F.2d 1395 (9th Cir. 1992).

<sup>126</sup> See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162 (2006).

<sup>127</sup> Complaint, *Lohan v. E\*Trade Sec. L.L.C.*, No. 10-004579 (N.Y. Sup. Ct., Nassau Cnty. filed Mar. 8, 2010) available at [http://tmz.vo.llnwd.net/o28/newsdesk/tmz\\_documents/0309\\_etrade\\_wm\\_01.pdf](http://tmz.vo.llnwd.net/o28/newsdesk/tmz_documents/0309_etrade_wm_01.pdf) (last visited Feb. 28, 2012).

<sup>128</sup> Crimesider Staff, “Free Lindsay Lohan”: Judge Ends Actress’ Probation Begun Over Drunk Driving Arrests, CBSNEWS (Mar. 29, 2012, 3:16 PM), [http://www.cbsnews.com/8301-504083\\_162-57406569-504083/free-lindsay-lohan-judge-ends-actress-probation-begun-over-drunk-driving-arrests/](http://www.cbsnews.com/8301-504083_162-57406569-504083/free-lindsay-lohan-judge-ends-actress-probation-begun-over-drunk-driving-arrests/)

<sup>129</sup> Jackie Kass, *The Sunday Funnies: E Trade Baby Commercial Returns for Super Bowl 2012*, EXAMINER.COM (Feb. 4, 2012), <http://www.examiner.com/article/the-sunday-funnies-etrade-baby-commercial-returns-for-super-bowl-2012>.

say” and then the supposed “milkaholic Lindsay” baby pops on screen, seemingly drunk, asking, “Milk-a-what?”

Although the commercial did not identify Lindsay Lohan,<sup>130</sup> Lohan asserted that she had achieved single-name recognition and E\*Trade used her name to sell its product. Her claim does not meet the first element of a right of publicity claim because she is not well-known by just her first name, ‘Lindsay,’<sup>131</sup> and in order to sufficiently plead a right of publicity claim, one must show that his or her identity was in fact used; and the advertisement did not use her full name or include any images of Lohan. Unlike Oprah, Cher, or Madonna, Lohan’s first name is not a brand and she is not well known as or referred to as ‘Lindsay.’<sup>132</sup> Although E\*Trade’s attorneys thought the claims were “meritless,” E\*Trade settled with Lohan.<sup>133</sup> One can assume that E\*Trade settled the suit because of courts’ history and willingness to expand the right of publicity to fit the claim.

*b. Burck v. Mars, Inc.*<sup>134</sup>

E\*Trade should have looked to the *Burck v. Mars* decision, decided in 2008 by the district court for the Southern District of New York, for precedent. In this case, Robert Burck, a street performer, also known as the Naked Cowboy, sued Mars, a famous candy manufacturer, for violation of his right of publicity under New York’s right of publicity statute. Mars created a billboard and mural in New York City with M&M candies pictured. Mars also ran animated cartoon advertisements. One of the candies was a blue M&M character wearing a white cowboy hat, boots, and underwear, and carrying a guitar; this outfit is similar to how Burck dresses.

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<sup>130</sup> Complaint, *supra* note 125.

<sup>131</sup> Daily Mail Reporter, *Just Call Me Lindsay: Miss Lohan Drops Her Last Name to Sever Ties with Her Father*, DAILYMAIL.CO.UK (Mar. 26, 2011, 5:37 PM), <http://www.dailymail.co.uk/tvshowbiz/article-1370120/Lindsay-Lohan-drops-sever-ties-father-Michael.html>; see also *Lindsay Lohan Is Changing Her Name, Her Mom Says*, FOXNEWS.COM (Mar. 25, 2011), <http://www.foxnews.com/entertainment/2011/03/25/lindsay-lohan-changing-mom-says/>.

<sup>132</sup> *Id.*

<sup>133</sup> Kieran Crowley, *Lindsay Lohan Wants \$100M Over E-Trade Ad*, N.Y.POST (Mar. 9, 2010, 2:32 AM), [http://www.nypost.com/p/news/national/lohan\\_such\\_baby\\_jVdQWABj9z0MgXzCv1Nh1O](http://www.nypost.com/p/news/national/lohan_such_baby_jVdQWABj9z0MgXzCv1Nh1O).

<sup>134</sup> *Burck v. Mars, Inc.*, 571 F.Supp.2d 446 (S.D.N.Y. 2008).

Only the first element of New York's three-element test was disputed, which was whether Mars used Burck's name, portrait, picture, or voice in its advertisement. The court likened the case to *White v. Samsung*<sup>135</sup> (discussed above), but held oppositely. The court found that using suggestive characteristics or evoking aspects of a personality without literally using the personality's picture or portrait was not actionable under New York's right of publicity statute. Therefore, the court held that Mars did not violate Burck's right of publicity, unlike the Ninth Circuit, which allowed White to proceed with a right of publicity claim based on a suggestive character under common law.

#### IV. ARGUMENTS FOR AND AGAINST A FEDERAL RIGHT OF PUBLICITY STATUTE

##### A. *Arguments for Enacting a Federal Right of Publicity Statute*

Several reasons bolster the argument for enacting a federal right of publicity statute. The following reasons will be addressed in this Section: a federal statute will (1) reduce confusion and uncertainty for attorneys, judges, personalities, and the general public; (2) ensure no conflict with current federal laws; (3) reduce overall court costs and the number of infringement suits; (4) prevent forum shopping for right of publicity matters; (5) limit litigation; and (6) permit easier Internet regulation and compliance. Additionally, it will prevent or minimize conflicts between state right of publicity law and copyright law. It will also ensure that litigants are treated uniformly among the states and will thus reduce the incentive to engage in forum shopping.

##### 1. Minimize Uncertainty

The current right of publicity system's lack of definitive boundaries has resulted in considerable confusion among potential litigants.<sup>136</sup> Personalities often are not sure whether their right of publicity is pro-

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<sup>135</sup> *White v. Samsung Elec. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992).

<sup>136</sup> See Christopher Pesce, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782 (1990).

tected or even what attributes are protected.<sup>137</sup> Defendants may not be aware of when they can use a personality's particular attributes. With the many variations in states' right of publicity laws, courts are either not applying the copyright preemption test or are applying it inconsistently.

Additionally, by providing certainty, a federal right of publicity statute will encourage personalities to engage in more creative and novel endeavors nationally, as the cost of enforcing their rights would be greatly reduced.<sup>138</sup> The personality could bring a claim against a particular infringing company in one federal court, and that court could issue a nationwide injunction. The infringing company, therefore, would be nationally banned from committing that infringing act, such as making a commercial including a personality's image.

Further, as noted in the various case examples provided, right of publicity claims often end up in federal court because right of publicity claims are often coupled with federal issues, which is problematic. Federal courts should not be deciding how to apply and expand state laws. A federal right of publicity would eliminate this problem.

## 2. Resolve Conflict

As discussed above,<sup>139</sup> major conflict exists between the right of publicity and copyright law, which a federal statute would resolve.

In creating the federal law, Congress would consider and address the demonstrated conflicts between the right of publicity and copyright. Specifically, federal courts will have a uniform federal law to apply, thus eliminating the issue of courts confusing various state laws and reversing their own decisions when determining whether a right of publicity claim is preempted by the Copyright Act. This instance occurred in *Toney v. L'Oreal* (discussed above).<sup>140</sup> The Seventh Circuit reversed itself, as the district court held that Toney's right of publicity

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<sup>137</sup> Blair Joseph Cash, "Hasta La Vista, Funny Guys": *Arnold Schwarzenegger's Fictional Voice Misappropriation Lawsuit Against Comedians Imitating His Voice and the Case for a Federal Right of Publicity Statute*, 18 J. INTELL. PROP. L. 207, 229 (2010).

<sup>138</sup> Krishan Thakker, *The Federalism Case Against a Federal Right to Publicity*, 10 U. DENV. SPORTS & ENT. L.J. 97, 118 (2011).

<sup>139</sup> The conflict between the right of publicity and copyright law is discussed in Part II.

<sup>140</sup> *Toney v. L'Oreal USA*, 406 F.3d 905 (7th Cir. 2005); *See also supra* text accompanying note 86.

claim was preempted based on the Seventh Circuit's 1986 decision in the *Baltimore Orioles v. Major League Baseball Players Association*<sup>141</sup> case. However, the Seventh Circuit, found no copyright preemption in *Toney*.

To reduce and possibly eliminate the conflicts, the statute could include the various measures that do affect the right of publicity, as it did in the federal trademark law, to protect people from misrepresentations.<sup>142</sup> By including measures to address conflicts, each court will apply the same criteria to determine whether the right of publicity should be preempted so that similar cases, such as *Facenda* and *The Romantics*, would have similar outcomes.

### 3. Reduce Compliance Cost

The current process of each state determining what attributes to protect under the right of publicity often leads to personalities and non-personalities receiving either no protection or too much protection. Forum choice directly affects many aspects of one's right of publicity case, including the specific rights and attributes protected.<sup>143</sup> As discussed above,<sup>144</sup> depending on the state in which the suit is brought, a particular right may or may not be protected.

There are several reasons why compliance cost would be reduced. First, it is costly and inefficient for personalities to bring suit in various states for the same controversy in order to ensure that their rights are not exploited. Secondly, the extensive research attorneys must conduct to decipher the laws of the various jurisdictions is burdensome and costly. As noted, several states do not recognize the right of publicity. Thirdly, requiring potential advertisers to research the laws of the various jurisdictions to ensure they are not infringing a personality's right of publicity is equally taxing.<sup>145</sup> Lastly, the concern of damages must

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<sup>141</sup> *Balt. Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).

<sup>142</sup> Thakker, *supra* note 136, at 117-18.

<sup>143</sup> Cash, *supra* note 135, at 229.

<sup>144</sup> *See supra* Part II.

<sup>145</sup> Matthew Savare, Comment, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 146 (2004).

be addressed. If personalities could bring suit in one federal court against defendants who have exploited commercially their attribute in multiple states, they could receive multiple damages from the same company for the same infringement.<sup>146</sup>

Additionally, an injunction imposed by a court may only be applicable in the state where the infringement occurred. A good example of this problem is demonstrated by New York courts. New York courts have stated that New York's right of publicity law does not apply to infringement concerning commercial exploitation of personalities' attributes in other states.<sup>147</sup>

The variations in the right of publicity law among the states, according to intellectual property law attorney and professor Eric Goodman, means that "lawyers cannot give their clients anything even resembling a qualified opinion under the current scheme . . . ." <sup>148</sup> Instituting a federal right of publicity would eliminate these concerns, as there would be one uniform law for each jurisdiction to follow and all decisions would apply nationwide. Personalities, therefore, would not have to bring multiple suits, and attorneys and defendants could rely on one governing law, which would reduce costs.

#### 4. Eliminate Forum Shopping

Forum shopping is a strategy where parties seek or "shop" for jurisdictions with laws that favor their position.<sup>149</sup> The vast discrepancies among the states regarding the right of publicity have created a chronic forum shopping issue, as personalities seek forums that will best protect the rights they believe should be protected instead of bringing their case in the proper jurisdiction.<sup>150</sup> A federal right of publicity statute will minimize forum shopping because the same rights will be protected everywhere; thus, it will not matter where the personality initiates the suit.

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<sup>146</sup> Rodrigues, *supra* note 143 at 1223.

<sup>147</sup> Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. 227, 244 (1999) (citing *Shamsky v. Garan, Inc.*, 632 N.Y.S. 2d 930, 959 (N.Y. Sup. Ct. 1995)).

<sup>148</sup> Thakker, *supra* note 140.

<sup>149</sup> Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 227, 244 (1999).

<sup>150</sup> *Id.*

The current state-based domicile-at-death rule<sup>151</sup> does not adequately address the problem of forum shopping. This rule only addresses cases in which a cause of action is brought regarding the descendible rights' of a deceased personality. However, the preference of a personality's heirs is to bring right of publicity claims in jurisdictions like California, Indiana, Oklahoma, or Tennessee, as they have the broadest right of publicity statutes.

Living personalities can choose which jurisdiction to bring a claim for right of publicity infringement when the infringement takes place in multiple states.<sup>152</sup> For example, Marilyn Monroe's estate sued a photography archive and licensing company in Indiana in 2005. The estate claimed that the company violated Monroe's postmortem right of publicity under Indiana's law, although Monroe lacked a connection with Indiana while she was alive.<sup>153</sup>

Another example involves California-based Bruce Lee Enterprises. In 2009, that company initiated suit in Indiana against a New York and New Jersey-based clothing company, claiming that the clothing company had infringed its right of publicity under Indiana law.<sup>154</sup>

This type of forum shopping will leave potential defendants guessing, as they will never know ahead of time which law they may be subjected to in a right of publicity case. Having an attorney explain all of the possible outcomes based on the state or states in which a personality may decide to bring a right of publicity suit is just not feasible, as discussed above.

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<sup>151</sup> *Id.* States that follow this rule apply the right of publicity statute of the state where the personality was domiciled when he died.

<sup>152</sup> Laura Hock, Comment, *What's in a Name? Fred Goldman's Quest to Acquire O.J. Simpson's Right of Publicity and the Suit's Implications for Celebrities*, 35 PEPP. L. REV. 347, 363 (2008) (citing 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY §§ 11:13 (2d ed. 2007), also available at <http://digitalcommons.pepperdine.edu/plr/vol35/iss2/4/>).

<sup>153</sup> Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Insert "Statute" is Necessary*, COMMUNICATIONS LAWYER, Aug. 28, 2011 at 14,16.

<sup>154</sup> *Id.* While the court granted the defendants' transfer of venue motion, the court recommended that Indiana right of publicity law be applied.

### 5. Limit Litigation

A public policy reason exists for federalizing the right of publicity. A federal statute will reduce litigation because it would preempt both common law and state statutory laws. Therefore, personalities will not have to bring multiple suits for the same infringement.<sup>155</sup> Further, advertising and retail companies will know which attributes are protected and may stray away from using those protected attributes since they know they can potentially use other attributes.

Personalities will not be forced to bring litigation in various jurisdictions to protect their rights of publicity, and injunctions against particular infringing activities will apply nationwide. It is arguable that introducing a federal statute will increase litigation because the right of publicity would be litigated in those nineteen states that currently do not recognize the right of publicity. This argument is weak because it fails to consider the fact that a federal right will mean that a decision by one court on the matter will apply in all states. Currently, personalities would have to bring approximately thirty-one<sup>156</sup> different suits for the same infringing actions, whereas a single federal right of publicity will allow a nationwide injunction.<sup>157</sup>

Personalities have to bring numerous suits because advertisers and retailers commercially exploit personalities across state borders, but the current right of publicity regime does not allow a personality to recover from or prohibit infringement by these entities by bringing suit in one jurisdiction. Personalities have to initiate suit in every state where their right of publicity is being infringed if the state does not enforce a judgment from another state. Therefore, while more states will hear right of publicity cases, there will be fewer right of publicity cases overall as a personality only has to bring one right of publicity suit under a federal right of publicity statute. Further, personalities and defendants will have a clear understanding of what attributes are protect-

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<sup>155</sup> Steven M. Getzoff, *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARDOZO ARTS & ENT. J. 209, 213 (1998).

<sup>156</sup> This number assumes that no states honor other states' injunctions.

<sup>157</sup> Jeremy T. Marr, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C.L. Rev. 863, 888-892 (2003), also available at <http://lawdigitalcommons.bc.edu/bclr/vol44/iss3/5>.

ed. The proposed federal statute, discussed below,<sup>158</sup> will protect only a limited number of attributes. Therefore, many of the current kinds of claims will no longer have merit.

#### 6. Regulate Internet Infringement

Allowing states to create right of publicity laws may have made sense when the right was in its infancy.<sup>159</sup> However, with ever-changing technology such as the Internet, a federal right of publicity has become more and more of a necessity. Melville Nimmer, a leading scholar on copyright, seriously doubted that the individual state law scheme for the right of publicity adequately satisfied the demands of the twenty-first century Internet Age.<sup>160</sup> Currently, companies are confronted with the issue of which state laws apply when they place advertisements on the Internet. The expansive Internet use significantly increases personalities' potential for economic loss, as those protected attributes are typically not fixed in a tangible medium, which means they can be more easily appropriated and exploited without approval.<sup>161</sup> Material online is not fixed in a tangible medium, such as a book or CD. A federal right of publicity statute will make compliance with personalities' rights of publicity easier, as companies will only have to be aware of one uniform statute when they create Internet advertisements.

A federal statute will provide uniformity, reduce the confusion and uncertainty, prevent or minimize copyright law and other potential federal law conflicts, and reduce the incentive to engage in forum shopping and litigation.

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<sup>158</sup> Specifics on what a federal right of publicity statute should include are discussed in Part VI.

<sup>159</sup> Risa J. Weaver, Note, *Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute*, 9 DUKE L. & TECH. REV. 1-25 (2010) (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 202, 203 (1954)).

<sup>160</sup> *Id.*

<sup>161</sup> Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183, 206 (1998).

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B. *Arguments Against Enacting a Federal Right of Publicity Statute*

Opponents of a federal right of publicity statute offer various arguments ranging from states' retaining autonomy to the right of publicity being a property right that states should regulate. The following arguments and concerns will be addressed in this Section: (1) the right of publicity is a property right and property rights are state-based rights; (2) a federal statute will force those states that do not recognize the right of publicity to recognize it; and (3) many variations of the right of publicity exist, making it difficult to determine which form should be adopted.

1. States Should Regulate Property Rights

The strongest argument against a federal right of publicity statute is that the right of publicity should be regulated by the state, because property rights are created and regulated by the states.<sup>162</sup> While it remains a founding principle of the Constitution that states must retain autonomy, the problems of inconsistency outweigh that concern. Deferring to states over this law is admirable and furthers federalism concerns, but the non-uniformity issues raise greater concerns, because personalities facing the same circumstances are treated differently based on jurisdiction. For example, personalities' publicity rights are not descendible if they are domiciled in New York at the time of death, whereas their publicity rights are descendible if they are domiciled in California at death.

Differences between the statutes concerning protectable attributes and postmortem rights result in mass confusion among personalities, entities, attorneys, and courts. The significant differences among the states regarding the right of publicity are therefore sufficient to limit state autonomy on this matter. Federal government regulation will eliminate lack of uniformity issues and reduce confusion. Currently, federal statutes govern copyright and patent laws. They are federal laws because the purpose for those laws is to promote the progress of science and useful arts. The right of publicity should be a federal right as well, as that appears to be the clear intention of the Framers of the U.S. Constitution. The Framers indicated that state regulation of works

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<sup>162</sup> Thakker, *supra* note 140, at 127

of authorship would be inefficient. This idea is demonstrated clearly in *Federalist No. 43*, where James Madison notes that the federal law should govern intellectual property matters:

The utility of this power will scarcely be questioned. The copy-right of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provisions for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.<sup>163</sup>

From this quote, it can be inferred that the Framers intended for federal law to regulate all varied areas of intellectual property, and as we know the right of publicity falls within intellectual property.<sup>164</sup>

## 2. States Should Have the Option to Recognize a Property Right

The issue of forcing states to recognize and enforce a law they have chosen not to adopt is another argument against a federal law and relates to the issue of autonomy.<sup>165</sup> While several states recognize the right of publicity, some do not. No good reason, goes the argument, justifies overriding those state choices.

This argument is outweighed in light of all the problems that result from not having a federal right of publicity statute. Further, the fact that the majority of the states do recognize some form of the right strengthens the argument for a federal right, as this demonstrates that lawmakers in general believe a right of publicity should be recognized. The easiest way to ensure it is recognized is to enact a federal law. A federal right of publicity would ensure all persons' right of publicity is protected. Additionally, the fact that some states do not recognize the right does not mean that no valid moral or economic considerations exist for a uniform law. An important economic consideration is the commercial value of personalities' attributes.

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<sup>163</sup> The Federalist No. 43 (James Madison).

<sup>164</sup> Jane C. Ginsburg, *U.S. Federalism and Intellectual Property*, 2 COLUM. J. EUR. L. 463 (1996).

<sup>165</sup> Cash, *supra* note 135, at 225.

The lack of a federal right of publicity means that corporations and other businesses can diminish personalities' commercial value and deprive them of the opportunity to make money. Those states that fail to recognize the right, therefore, are depriving personalities in their states of pecuniary gain, because personalities should have the right to decide if and when their attributes will be used. Thus, states that do not recognize the right of publicity allow companies to violate personalities' right to their attributes and diminish the value in those attributes.<sup>166</sup> They should have this right because of the work and effort that they have expended to create the commercial value in their attributes.<sup>167</sup>

### 3. No Methodology Exists to Determine the Best Law

Another argument concerns the issue of which form of the many variations of the law to adopt. It is argued that competition among the states should form the uniform right, as states will compete to have celebrities reside in their state and will adjust their laws accordingly.<sup>168</sup> Additionally, the right has not had sufficient time to develop.<sup>169</sup> Allowing states to develop and improve the right will allow the best version of the law to materialize.<sup>170</sup> This argument addresses the issue that the right of publicity is not a clear right, which is actually a good reason to enact a federal law. Also, the idea that the right is new and has not had the opportunity to develop is not a valid argument, because the right of publicity has received recognition since 1953. Therefore, the right has had ample opportunity to develop for sixty years. While it will be difficult to determine which form of the law should be enacted, the process would include looking at the scope of each law and determining if features of a law support the policy reasons for a right of

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<sup>166</sup> *Id.* at 226.

<sup>167</sup> Matthew Savare, Comment, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 146 (2004) (citing Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 195-96 (1993)).

<sup>168</sup> Krishan Thakker, *The Federalism Case Against a Federal Right to Publicity*, 10 DENV. U. SPORTS & ENT. LAW J. 97, 124-126 (2011).

<sup>169</sup> Blair Joseph Cash, Note, "*Hasta La Vista, Funny Guys*": *Arnold Schwarzenegger's Fictional Voice Misappropriation Lawsuit Against Comedians Imitating His Voice and the Case for a Federal Right of Publicity Statute*, 18 J. INTELL. PROP. L. 207, 226 (2010) (citing DAVID L. SHAPIRO, *FEDERALISM: A DIALOGUE* 85 (1995)).

<sup>170</sup> *Id.*

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publicity and have limits comparable to other federal intellectual property laws – copyright, patent, and trademark.

## V. FEDERAL STATUTE

### A. *Federal Right of Publicity Statute Should be Enacted*

A federal right of publicity statute is required to provide clarity, reduce litigation, incorporate moral and economic considerations, and reduce forum shopping. It is inefficient for a business that wants to use a particular phrase or design nationally, which may be associated with a personality, to have to know all the various state laws and apply the most burdensome requirements to avoid liability, since the laws vary so widely across states.<sup>171</sup>

Further, as discussed above,<sup>172</sup> state right of publicity statutes are interfering with federal intellectual property rights, particularly copyright. Also, some courts do not adequately address copyright preemption when considering whether a right of publicity claim is valid, which devalues copyright.<sup>173</sup> Thus, a federal right of publicity is needed to eliminate these concerns and issues.

Lastly, a federal right of publicity statute is required to prevent individual states from affecting commerce in other states and from expanding the right of publicity so far as to destroy its purpose and have a substantial effect on other intellectual property rights. A federal right will improve the overall status of the right of publicity and ensure that the public's interest is balanced with the interests of personalities.

### B. *What the Federal Statute Should Include*

The federal statute should address the primary purpose of the right of publicity. As discussed above,<sup>174</sup> the purposes for the right of pub-

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<sup>171</sup> INTERNATIONAL TRADEMARK ASSOCIATION, *Policy and Advocacy: Board Resolutions U.S. Federal Right of Publicity*, Mar. 3, 1998, <http://www.inta.org/Advocacy/Pages/USFederalRightofPublicity.aspx> (last visited Feb. 3, 2012).

<sup>172</sup> See Part III Section B.

<sup>173</sup> See Part III Section C.

<sup>174</sup> The purpose and policy reasons underlying the right of publicity are discussed in Part I.

licity are to prevent unjust commercial enrichment and to encourage personalities to engage in creative endeavors. Therefore, a federal right of publicity statute will help by limiting the pool of protected attributes, leaving broad categories such as the style of singing, a particular gesture, or generic phrase in the public domain for everyone to use and enjoy.

A federal statute should only protect the name, likeness, and image of a personality (or individual), because they most directly relate to a person's individuality. Further, name, image, and likeness are the first attributes protected under the privacy right and later under the right of publicity. Also, all states that recognize the right of publicity protect these attributes; therefore, these are clearly deemed important, protectable attributes.<sup>175</sup> Additionally, protecting only these attributes will fulfill the primary purpose and goals of the right of publicity, as intellectual property rights are supposed to only protect against particular types of appropriation. These attributes are specific and will ensure personalities can protect the value of their hard work to achieve fame and notoriety while encouraging them to continue to perform and contribute to the public domain for the public's benefit.

The federal statute should also include a section on a descendible postmortem right of publicity because it provides an additional incentive for personalities to work harder and achieve more, thus enriching the public domain. Personalities are more likely to produce if their heirs can benefit from the labor they expended during their lifetimes. Further, a majority of the states that recognize the right of publicity already recognize a postmortem right.<sup>176</sup> Including a postmortem right is essential, as it guarantees prevention of unjust enrichment by people who would exploit commercially the fame and notoriety personalities achieved during their lifetime.<sup>177</sup> Allowing corporations and businesses to exploit commercially a personality's attributes without permission is unjust because the personality invested and worked to build the

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<sup>175</sup> Jonathan D. Reichman, *Right of Publicity in 17 Jurisdictions Worldwide*, GETTING THE DEAL THROUGH, 2012, at 79, available at <http://www.kenyon.com/newspublications/publications/2011/~media/Files/Publication%20PDFs/2011/ROP2012%20Kenyon%20%20Kenyon.as hx> (last visited Feb. 8, 2012).

<sup>176</sup> *Id.* at 80.

<sup>177</sup> Cf. Andrew B. Sims, *Right of Publicity: Survivability Reconsidered*, 49 FORDHAM L. REV. 453, 498-99 (1981), acknowledging a need to prevent commercial exploitation.

commercial value in their attributes so they and their families could reap the benefits. Including the postmortem right of publicity, therefore, will satisfy the underlying policy for the right of publicity.

Postmortem rights of publicity should be limited in the same way copyright duration is limited. The same free speech and free enterprise considerations balanced in limiting copyright duration are relevant to a descendible right of publicity.<sup>178</sup> Applying similar criteria to the right of publicity's duration should achieve the necessary balance between the autonomy over one's attributes and the public's interest in the availability of ideas and information.<sup>179</sup> Further, the copyright post-mortem durational scheme can provide the legislature with guidance for the postmortem right of publicity.<sup>180</sup>

The difficulty lies in determining the actual duration for a postmortem right of publicity. The right of publicity is different from copyright in that personalities' commercial values quickly and drastically decline soon after death.<sup>181</sup> Therefore, a limited durational period, such as ten years, should be imposed<sup>182</sup> unless the assignees or heirs continue to commercially exploit the attributes after the death of the personality, as the Tennessee statute requires.

The statute should specify who is eligible to receive right of publicity protection. It should continue with the general trend, which allows non-personalities to receive protection along with personalities, as copyright and patent do not discriminate as to who can receive protection for their works or inventions. This section should also include definitions, as found in many of the state statutes, to avoid confusion. It should first define the right of publicity. A good definition to use is that provided by Professor J. Thomas McCarthy, the author of *The Rights of Publicity and Privacy*,<sup>183</sup> which provides an extensive exami-

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<sup>178</sup> *Id.*

<sup>179</sup> Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 821 (1988).

<sup>180</sup> Sims, *supra* note 172, citing *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 847-48 (1979).

<sup>181</sup> *Id.* (citing *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 285 (S.D.N.Y. 1977)).

<sup>182</sup> *Id.*

<sup>183</sup> J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* (2d ed. rev. Mar. 2002).

nation of the right of publicity.<sup>184</sup> McCarthy states that the right of publicity is “the inherent right of every human being to control the commercial use of his or her identity.”<sup>185</sup> Next, it should define key terms. For example, Indiana’s right of publicity statute includes a definition of personality that implies that if one’s publicity has no commercial value, one will not be able to recover more than nominal damages even if his right is infringed.<sup>186</sup> Nominal damages for non-personalities are sufficient, as they do not have commercial value but should be permitted to recover some damages when wronged. Damages should also take into consideration how much the infringer benefited.

## VI. CONCLUSION

The United States is in need of a federal right of publicity statute for several reasons, most notably to eliminate the lack of uniformity among the states, conflicts with copyright law, and overprotection. The lack of uniformity among the states causes several problems: individuals are uncertain of what rights are protected; federal courts are expanding state laws; right of publicity litigation is increasing,<sup>187</sup> and, similar cases are treated differently within and between jurisdictions.

Conflicts between the right of publicity and copyright are abundant, as the right of publicity is very similar to and often overlaps with copyright. Many courts have held that copyright does not preempt a right of publicity claim when it clearly should. As a result, copyright holders, licensees, and the public are harmed because these decisions undermine the purpose of copyright law.

Finally, overprotection of publicity rights also harms the public. A goal of intellectual property rights is to incentivize entertainers, authors, creators, and others to create appealing works and performances.

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<sup>184</sup> Jeremy T. Marr, Note, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C. L. REV. 863, 865 (2003).

<sup>185</sup> *Id.* (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* 1:3, :4 (2d ed. rev. Mar. 2002)).

<sup>186</sup> IND. CODE ANN. § 32-36-1-6 (2002).

<sup>187</sup> *CONSOR Intellectual Asset Management Expands its Right of Publicity Litigation Support Services*, CONSOR INTELLECTUAL ASSET MANAGEMENT, <http://www.consor.com/ip-news/consor-intellectual-asset-management-expands-its-right-of-publicity-litigation-support-services.html> (last visited Mar. 25, 2012).

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The current scheme of right of publicity laws, however, is spoiling this purpose and appropriating the rights granted to copyright holders. The overprotection of publicity rights is removing the same material and ideas placed in the public domain by copyright law. The *Wendt v. Host International*<sup>188</sup> case, where the court held that the actors could lay claim to the characters they played in *Cheers* against the copyright owners' right to license the characters for a derivative work, is a good example.

The right of publicity as a state-based property right is ineffective. The time has come for a federal right of publicity statute. Federal regulation will ensure uniformity among the states, remove the conflicts between the right of publicity and copyright law, and prevent overprotection. Federal regulation will allow right of publicity and copyright laws to coexist for the betterment of society. Federal regulation of the right of publicity will ensure that personalities, attorneys, and businesses alike all know what constitutes right of publicity infringement, thus reducing litigation. Federal regulation will define the appropriate scope for the right of publicity by drawing on copyright, trademark, and patent laws to ensure that the public domain is protected. Thus, it is now time for Congress to legislate on the matter.

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<sup>188</sup> *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997).

