

# THE RIGHT OF PUBLICITY: STAR VEHICLE OR SHOOTING STAR?

BARBARA SINGER\*

## I. INTRODUCTION

Advertisers have long known that "celebrity"<sup>1</sup> sells.<sup>2</sup> In today's cutthroat commercial market, famous personalities, from Jim Palmer<sup>3</sup> to Jimmy Stewart,<sup>4</sup> can regularly be seen or heard hawking the wares of one manufacturer or another.

This form of advertising has become particularly popular

---

\* Associate Professor, St. Thomas University School of Law; A.B., 1972; J.D., 1976, Indiana University; LL.B., 1978, Cambridge University. The author would like to thank Professors Larry Ritchie, Jay Silver, and Siegfried Wiessner for their helpful comments and suggestions. The author would also like to thank research assistants John Curran and Philip Mugavero for their research, proof-reading and cite-checking efforts.

<sup>1</sup> The Oxford English Dictionary broadly defines "celebrity" variously as "[a] person of celebrity; a celebrated person: a public character" or as "[t]he condition of being much extolled or talked about; famousness, notoriety." II OXFORD ENGLISH DICTIONARY 1019 (2d ed. 1989). A precise definition of "celebrity" is thus difficult to attain. As one commentator has suggested, "The list of who qualifies as a celebrity in a right of publicity context is endless." Richard B. Hoffman, *The Right of Publicity—Heirs' Right, Advertisers' Windfall, or Courts' Nightmare?* 31 DEPAUL L. REV. 1, 3 n.13 (1981). According to another commentator, a celebrity is an "actor, author, artist, politician, model, athlete, musician, industrialist, executive, playboy, or any other of a hundred types who wish to be in the public eye for any of a hundred reasons." Alice G. Donenfield, *Property or Other Rights in the Names, Likenesses, or Personalities of Deceased Persons*, 16 BULL. COPYRIGHT SOC'Y 17, 20 (1968).

According to the court in *Brockum Co. v. Blaylock*, 729 F. Supp. 438 (E.D. Pa. 1990), a group of performers (in that case, the Rolling Stones) also has a protectable interest in its name. Note, however, that statutes in some jurisdictions restrict the right to natural persons. See, e.g., NEV. REV. STAT. § 598.980(2) (1986-1989); OKLA. STAT. ANN. tit. 12, § 1448H (West 1991). In the context of this article, "celebrity" will be used in its broadest sense to include anyone who enters or is thrust into the public eye for any reason whatsoever.

<sup>2</sup> According to one journalist, "Famous names, experts explain, imbue otherwise mundane products with credibility, trustworthiness and excitement." Gail Bronson, *In Advertising, Big Names Mean Big Money*, U.S. NEWS & WORLD REP., Jul. 4, 1983, at 60.

<sup>3</sup> Since 1975, Baseball Hall-of-Famer Jim Palmer has been seen modeling *Jockey* shorts. Mark Hyman, *Jim Palmer More Than Ever an Ex-ballplayer*, L.A. TIMES, Feb. 12, 1990, at P11. Palmer reportedly now receives over \$100,000 annually for his modeling efforts. *Id.*

<sup>4</sup> The voice of Stewart, a veteran actor, has recently been featured in voice-overs for a series of advertisements extolling the virtues of Campbell's "Home Cookin'" soup. *Listen to Who's Pitchin' the Next Time Soup's On*, NEWSDAY, Dec. 28, 1988, at 9. Stewart maintains that he did the ads "for fun." Bettelou Peterson, *TV Mailbag*, CHI. TRIB., Apr. 9, 1989, (TV Week), at 26. While Stewart's unmistakable voice is prominent in the ads, his face is nowhere to be seen. When the ads first hit the small screen in 1988, Campbell was flooded with calls and letters from consumers wondering whether the voice was really Stewart's. William C. Trott, *Glimpses*, UPI, Sept. 20, 1989. A happy Campbell official responded, "'It's a tribute to Jimmy that even though he never appears on camera, people recognize it's him.'" *Id.* That was, of course, exactly the effect that Campbell hoped to achieve with the ads.

with advertisers attempting to tap into the burgeoning wealth of the “baby boom” generation. These advertisers constantly seek to target baby boomers by conjuring up the sights and sounds of the sixties.<sup>5</sup> The Beach Boys’ “Good Vibrations,” for example, has been rewritten to sing the glories of orangeade<sup>6</sup> and the Beatles’ recording of their rock classic, “Revolution,” was briefly pirated by Nike to herald the wonders of running shoes.<sup>7</sup>

In the case of ads such as those featuring Palmer, Stewart and the Beach Boys, the celebrities consented to the commercial use of some aspect of their “persona.”<sup>8</sup> Where the celebrity

---

<sup>5</sup> In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), the defendant automobile company had sought to capture the baby boom market by running ads featuring a particularly clever imitation of singer Bette Midler’s rendition of “Do You Want To Dance.” Ford dubbed this commercial series “The Yuppie Campaign.” The purpose of this campaign was “to make an emotional connection with Yuppies, bringing back memories of when they were in college.” *Id.* at 461. This yuppie/celebrity approach to advertising has become very popular as the baby boom generation begins to reach the relative financial security of middle age. As one writer aptly suggests, “The music of the flower children bloomed into big business.” David M. Rheins, *Starstruck: Rock Music in Television Advertising; Spotlight: Music & Sound*, BACK STAGE, Apr. 29, 1988, at 8B (1988).

Not everyone is enamored with this particular advertising gimmick. Marc Eliot, author of *Rockonomics*, has lamented that,

[t]he first adolescent dreams inspired by songs like ‘Revolution’ and ‘Heard it through the Grapevine’ are being turned into huckster nightmares . . . Rock is supposed to be this wonderful music that bridges the gap to adulthood. Now, businessmen are taking those ideals and using them to shove a product down young people’s throats.

Greg Kot, *McRock ‘n’ roll*, CHI. TRIB., Aug. 28, 1989, Tempo 1, at 5.

<sup>6</sup> With the Beach Boys’ blessings, Sunkist has been using “Good Vibrations” in television advertisements since 1979. Jube Shiver, Jr., *New Entrants in Fruit Juice Segment; Royal Crown, Sunkist Attack in the Soda War*, L.A. TIMES, Nov. 19, 1985, § 4, at 2. In connection with the license granted by the Beach Boys, Sunkist has sponsored Beach Boys tours. *Beach Boys to Kick Off 25th Anniversary Tour in 1986*, BUS. WIRE, Nov. 18, 1985, available in LEXIS, Nexis Library, BWIRE File.

<sup>7</sup> See *infra* note 11.

<sup>8</sup> The Oxford English Dictionary defines “persona” as “[i]n Jungian psychology, the set of attitudes adopted by an individual to fit himself for the social role which he sees as his; the personality an individual presents to the world.” II OXFORD ENGLISH DICTIONARY 598 (2d ed. 1989). The precise parameters of this set of attitudes are difficult to ascertain. One commentator has argued that, for the right of publicity, this set should encompass, at a minimum, name, nickname, stage name, picture, likeness, image, identity, act, traits, walk, habits, style, reputation, history, statistics, facts concerning professional careers, signature and any identifiable personal property. See Hoffman, *supra* note 1, at 3-4. Entertainment law specialist Leonard Marks has recently suggested that “even the actual sound of a horn or drum player” could be considered part of someone’s persona. Stan Soocher, *License to Sample*, NAT’L L.J., Feb. 13, 1989, at 1, 26. See also Thomas C. Moglovkin, *Original Digital: No More Free Samples*, 64 S. CAL. L. REV. 135, 166-67 (1990) (persona should include aspects of the individual which would have market value).

Apparently even eyeglasses can become a recognizable aspect of a celebrity’s persona. The round, wire-rimmed glasses that John Lennon wore during the later years of his career became an integral part of the Lennon mystique and were featured prominently (in the shattered condition that resulted from his December 1980 assassination) on Lennon’s posthumously released album, *Season of Glass*. Mary Gottschalk, *Lennon’s Glasses Go Commercial; Yoko Ono Gives License to Firm*, MIAMI HERALD, Feb. 11, 1991, at 1C.

Under a licensing agreement recently entered into between Yoko Ono and Eagle

agrees to participate in the advertising plan, both the advertiser and the celebrity may laugh all the way to the bank. The advertiser presumably sells more of its product,<sup>9</sup> and the celebrity earns a tidy sum for minimal efforts.<sup>10</sup>

In the case of the Nike "Revolution" ads, however, the Beatles did not consent to the commercial use of the group's persona.<sup>11</sup> Under such circumstances both the celebrity and adver-

---

Eyewear, Eagle has been granted the exclusive right to market replicas of Lennon's glasses with his signature on the inside of the right temple. *Id.* All licensing profits will go to the Spirit Foundation, which is sponsored by the Lennon estate. The Foundation will use the proceeds to establish an international John Lennon Scholarship Fund for music students. *Id.*

One commentator has recently argued that the right of publicity should be restricted to the traditional "identity" aspects of name and likeness. Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?* 65 N.Y.U. L. REV. 782 (1990). Such a narrow approach, however, makes it too easy for advertisers to take unfair advantage of nontraditional, yet clearly recognizable celebrity traits, such as voice or trademark phrase. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987).

In this Article, "persona" will be used broadly to mean any unique aspect of the individual capable of appropriation by a third party.

<sup>9</sup> See James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 646-47 (1973).

<sup>10</sup> See *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979), where an expert witness for Elroy "Crazylegs" Hirsch testified that in 1979, minimum compensation for the use of an athlete's name to promote a product was five percent of the gross.

Superstar athletes may, of course, earn far more from endorsements. For example, in 1989, basketball phenomenon Michael Jordan received an estimated \$12.5 million plus royalties for a lifetime contract with Nike. Elizabeth Comte & Chuck Stogel, *Getting Rich on Commercial Appeal*, THE SPORTING NEWS, Jan. 15, 1990, at 46.

Rock superstars also earn top dollar for their commercial efforts. For example, in 1987, Pepsi paid Michael Jackson more than \$10 million dollars to appear in two television commercials and to serve as creative consultant and possible director for future commercials. Nancy Giges, *Pepsi Rekindles Cola War*, ADVERTISING AGE, May 4, 1987, at 3. Several years ago Chrysler offered Bruce Springsteen an estimated \$12 million to advertise its automobiles. Springsteen, who steadfastly refuses to sell his name, turned down Chrysler's offer. Jay Cocks, *Wanna Buy a Revolution?*, TIME, May 18, 1987, at 78.

Even classical ballet dancers are able to cash in on their fame. In 1989, superstar Mikhail Barishnikov received \$250,000 for lending his name to the women's fragrance "Misha." Barishnikov will also be paid a guaranteed annual license fee that will reach \$750,000 in 1995. Denise Hamilton, *Stars Boost Perfumes' Sweet Smell of Success*, MIAMI HERALD, Dec. 16, 1990, at 81.

Celebrity musicians can also receive direct and indirect financial benefits through commercial sponsorship of their tours. Such sponsorship can result in large cash payments to the celebrity and can also serve as a welcomed security blanket to help cover the skyrocketing costs of touring. For example, as sponsor of The Who's 1982 North American tour, Schlitz made a seven-figure cash payment to the group and footed a multimillion-dollar ad campaign for the tour. Leo Sacks, *Is Rock Going Madison Avenue? Well, the Whodunit*, TIME, Dec. 6, 1982, at 48.

<sup>11</sup> In 1988, Nike unveiled its notorious "Revolution" ads, designed to promote Nike's latest line of running shoes. The Beatles' "Revolution" was, of course, one of the most important rock anthems of the sixties. Nike wanted to use the Beatles' original recording of the song, rather than a cover version, to appeal to the vivid memories the baby boomers associated with the Beatles and their unique sound. In other words, Nike believed that the Beatles' mystique, not just their song, would sell its running shoes. According to Philip Knight, Nike founder, president, and chairman, "We could have

tiser stand to lose a great deal. The value of the celebrity's persona becomes diluted,<sup>12</sup> and he receives no compensation for

---

used other artists to record the song, but the authenticity and originality of the music is consistent with NIKE's style.' " NIKE President Asks For Meeting with Beatles, BUS. WIRE, Aug. 4, 1987, available in LEXIS, Nexis Library, BWIRE File. Added Kelley Stoutt, an account executive at Wiedan & Kennedy, "it was the Beatles or no one." Cocks, *supra* note 10, at 78.

Nike approached Michael Jackson, who owned the copyrights for the entire Beatles' library. Jackson, together with Capitol, the Beatles' recording company, granted Nike's advertising agency a license for the use of the Beatles' recording of "Revolution." Kot, *supra* note 5, at 1. Jackson and Capitol both received \$250,000 for this license; the Beatles, however, neither consented to nor received any payment for the license. *Id.*

Capitol allegedly knew it did not have the right to license "Revolution," but the company did so anyway in hopes of persuading the Beatles to drop other litigation that they had pending against them. *Id.* Instead, Paul McCartney, George Harrison, Ringo Starr and Yoko Ono (John Lennon's widow) filed a \$15 million suit against Nike, Nike's advertising agency and Capitol-EMI, claiming that Nike was using the Beatles' "persona and goodwill" in its advertising without their permission. Steve Hochman, *McCartney Masters the Possibilities, Inks Deal With Visa*, L.A. TIMES, Nov. 28, 1989, at F4; *Nike to Give Disputed Beatles Song the Boot*, CHI. TRIB., Feb. 25, 1988, Business, at 1.

Nike ran the ads for a short period but then pulled them before the scheduled end of their run, claiming that the premature termination of the run had nothing to do with the Beatles' suit. *ABC Scores in Calgary*, ADVERTISING AGE, Feb. 29, 1988, at 8. The Beatles' suit against Nike was subsequently dropped in 1990, probably as a result of the generous settlement that the Beatles received in their other suit against Capitol-EMI. Bruce C. Pilato, *All You Need is Litigation*, 76 A.B.A. J. 54 (1990); Warren Berger, *They Know Bo*, N.Y. TIMES, Nov. 11, 1990, § 6, at 36.

<sup>12</sup> See, e.g., *Sharkey v. National Broadcasting Co.*, 93 F. Supp. 986 (S.D.N.Y. 1950). In *Sharkey*, heavyweight boxing champion Jack Sharkey complained that the defendant's unauthorized use of his name and likeness decreased the value of his persona in his professional entertainment and sports dealings. Also, Paul McCartney recently remarked that Michael Jackson had "cheapen[ed] the whole Beatles catalogue" by making two-thirds of it available for use in advertisements. John Milward, *Getting Back to Where He Once Belonged*, CHI. TRIB., Nov. 26, 1989, Arts, at 4. According to McCartney, "we were offered all these [commercial] things in the '60s, but we turned them all down." *Id.*

See also *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987) (talk show host/comedian Johnny Carson objected to the use of his trademark phrase, "Here's Johnny," to hawk portable toilets); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979) (Elroy "Crazylegs" Hirsch maintained that he refused to do cigarette or liquor ads).

In a recent decision, singer Tom Waits succeeded in recovering a \$2.475 million jury verdict against Frito-Lay and its advertising agency for mimicking his distinctive, gravelly singing voice in an advertisement. Waits' voice has been described as "the sound of Louis Armstrong gargling with razor blades." *\$2.4 Million For Singer Imitated in Ad*, CHI. TRIB., May 9, 1990, News, at 5. This verdict included \$475,000 in actual damages plus \$1.5 million in punitive damages against the advertising agency and \$500,000 against Frito-Lay. Cleveland Horton, *Sounds Bad to Frito*, ADVERTISING AGE, May 4, 1990, News, at 61. The verdict marked the first time that punitive damages were awarded in a sound-alike case. *Id.* During the course of this litigation, Waits firmly maintained that he never sells his persona for advertising purposes. *A Singer Wins Frito-Lay Suit*, N.Y. TIMES, May 10, 1990, at D21. Following the jury verdict, a delighted Waits exclaimed, "Now I have a fence and a gate round my voice." *\$2.4 Million For Singer*, *supra* at 5.

Similarly, during the Beatles' protracted litigation with Nike concerning the infamous "Revolution" ads, Paul McCartney steadfastly insisted that he was "appalled" by the ad and did not wish to lower himself by selling either his persona or his songs for advertising. Milward, *supra* at 4. Ironically, McCartney has recently been criticized for "selling out" by making a deal with American Express for the sponsorship of his 1989-90 "Flowers in the Dirt" world tour. Hochman, *supra* note 11, at F4. According to Jim Henke, managing editor of *Rolling Stone* magazine, "an ex-Beatle . . . has that tradition

the exploitation of his persona.<sup>13</sup> As a result, the advertiser may well find itself slapped with a lawsuit seeking to remedy the celebrity's losses.<sup>14</sup>

During the 1980s, the right of publicity was enthusiastically embraced as a vehicle for protecting stars from the unauthorized exploitation of their personae. The right of publicity enables the celebrity or his *inter vivos* or *post mortem* transferee to seek money damages or injunctive relief for the unauthorized commercial use of the persona that the celebrity worked so hard to create. In this classic form, the right of publicity serves the dual purpose of encouraging achievement in the arts and preventing unjust enrichment by uninvited commercial exploiters.<sup>15</sup>

Yet like so many of the celebrities that it was designed to protect, the right of publicity now seems to be following the path of a shooting star. In their attempt to mold the right of publicity into a commercially viable, freely transferable right, courts and legislatures alike have increasingly cast publicity as a property rather than as a personal right. The more the right of publicity approaches the status of a property right, the closer it comes to resembling the economic rights embodied in the Federal Copyright Act of 1976 ("Copyright Act").<sup>16</sup> The more publicity re-

---

and body of works to uphold.' " *Id.* McCartney has responded to such criticism, retorting that "[t]his is a capitalist country. . . . As far as I'm concerned, it's them promoting us." *Id.*

McCartney has also been criticized for selling to advertisers songs he owns from the Buddy Holly catalogue ("Oh, Boy!" for example, has become "Oh, Buick!"). *Id.* But McCartney defends this action on the grounds that Holly did commercials while he was alive and that his heirs have consented to, and receive royalties from these licenses. *Id.*

<sup>13</sup> Note that, while this problem is most prominent in the case of celebrities, the use of "average person" endorsements can also cause the same problems for non-celebrities. See Treece, *supra* note 9, at 643 n.27.

<sup>14</sup> Consumers may also find themselves on the losing end of the stick. John Doig, of the advertising agency Ogilvy & Mather, has stated that, "I don't think there is any music too sacred for appropriate use in a commercial. . . . It depends on the product and the usage. It is very easy to be crass and blasphemous." *Claim That Tune, ADVERTISING AGE*, Mar. 6, 1989, at 28S. But according to Robert Kahn of RK Music Productions, "'often the consumer is insulted and boycotts the product that ruined his favorite song.'" *Id.*

Chris Morris, the rock critic of the *L.A. Reader*, has succinctly capsulized the problem in the following remark: "'When 'Revolution' came out in 1968 I was getting teargassed in the streets of Madison. That song is part of the sound track of my political life. It bugs the hell out of me that it has been turned into a shoe ad.'" Jon Wiener, *Beatles Buy-Out*, *THE NEW REPUBLIC*, May 11, 1987, at 13. Nike was even forced to admit to the negative consumer reaction that resulted from the infamous "Revolution" ads. Kevin Brown, Nike's director of corporate communications, remarked that, in reference to those ads, Nike received letters "'that border on obscene.'" Bruce Horovitz, *Specialty Firms Pitching Pizazz in Ads for \$40 Billion Disabled Market*, *L.A. TIMES*, Jan. 5, 1988, § 4 (Business), at 6.

<sup>15</sup> *Carson*, 698 F.2d at 831.

<sup>16</sup> Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. §§ 101-810).

sembles those economic rights, the more vulnerable it is to federal preemption under the Copyright Act.

The right of publicity must not be allowed to fade away. For with its demise, celebrities will lose a valuable weapon for combatting unscrupulous advertising tactics. This Article will attempt to identify a proper and practical method for rescuing publicity from its destructive path. First, this Article will attempt to identify the manner in which the seeds of destruction were sown, by following the right of publicity from its privacy roots, to its quiet birth in 1953, and up through its revival in the late 1970s. Second, this Article will examine the manner in which the seeds so sown grew into legal weeds that now threaten to choke the life from the right of publicity. Specifically, the Article will consider the problems that have developed concerning the *inter vivos* and *post mortem* transferability of the right of publicity and its consequent susceptibility to federal preemption. Finally, this Article will propose a method for eliminating these serious problems.

## II. THE SEEDS AND WEEDS OF DESTRUCTION

### A. *The Privacy Roots of the Right of Publicity*

#### 1. Warren and Brandeis: The Right to Privacy

The problems that currently plague the right of publicity stem, in part, from the turn-of-the-century birth of its close cousin, the right of privacy. An individual's ability to protect his solitude by controlling the public use of his name or likeness first received public attention in 1890,<sup>17</sup> when Samuel Warren and Louis Brandeis published their seminal article, "The Right to Privacy."<sup>18</sup>

---

<sup>17</sup> Note, however, that a privacy-like right was apparently suggested as early as 1869. In January of that year, an article entitled "*The Legal Relations of Photographs*" was published in the *Law Register*. See *Atkinson v. John E. Doherty & Co.*, 80 N.W. 285 (Mich. 1899) (citing 8 L. REG. (N.S.) 1 (1869)). The article explored certain legal questions raised by the then relatively new art of photography. In examining the use of unauthorized photographs, the author reported the case of an Austrian woman who had recovered damages for the unlicensed sale of her photograph "as that of some notorious woman." *Id.* at 286. The author of the *Law Register* article then stated that "if no special damage were found, it could not be doubted that her right to control the market of her own beauty could not have been denied her by any court, and that she must have recovered on the ground that her right had been infringed." *Id.* Although the *Atkinson* court proclaimed itself at a loss to determine exactly what the *Law Register* author meant, it is clear that privacy-like theories were materializing some time before Warren and Brandeis penned their seminal work.

<sup>18</sup> Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

This article, which stands as a landmark in tort law scholarship, was in part motivated by the authors' self-interest. Throughout their marriage, Warren and his wife were constantly plagued by overzealous journalists eager to detail the social activities of this well-known couple from Boston's elite.<sup>19</sup> To defend themselves against this brand of "yellow" journalism that had invaded their personal lives,<sup>20</sup> Warren and Brandeis called for a renewed acknowledgement of the individual's common law right<sup>21</sup> to determine if and when "his thoughts, sentiments, and emotions shall be communicated to others."<sup>22</sup>

Although they initially spoke in broad terms of an individual's right to control the public use of his unique personal assets,

---

<sup>19</sup> A biography of Brandeis' life explains:

Warren had married Miss Mabel Bayard, daughter of Senator Thomas Francis Bayard, Sr. They set up housekeeping in Boston's exclusive Back Bay section and began to entertain elaborately. The *Saturday Evening Gazette*, which specialized in "blue blood items" naturally reported their activities in lurid detail. This annoyed Warren who took the matter up with Brandeis. The article was the result.

Edward Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 966 (1964) (quoting ALPHENS, ET AL., *BRANDEIS: A FREE MAN'S LIFE* 70 (1960)).

According to Dean Prosser, "The matter came to a head when the newspapers had a field day on the occasion of the wedding of a daughter." William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960). This theory, however, has been challenged by at least one commentator. Genealogical studies of the Warren family and other published records purportedly reveal that Warren's daughter could not have been more than seven years old when Warren and Brandeis wrote their landmark article. James H. Barron, *Warren and Brandeis, The Right to Privacy*, 4 HARV. L. REV. 193 (1890); *Demystifying A Landmark Citation*, 13 SUFFOLK U. L. REV. 875, 893 (1979). See also Irwin R. Kramer, *The Birth of Privacy Law: A Century Since Warren and Brandeis*, 39 CATH. U.L. REV. 703 (1990).

<sup>20</sup> Warren and Brandeis thus argued compellingly in favor of protecting personality from "idle or prurient curiosity." Warren & Brandeis, *supra* note 18, at 220.

<sup>21</sup> According to Warren and Brandeis, the common law traditionally protected the individual's right to be left alone. *Id.* at 193-94.

By the end of the nineteenth century, however, this right had begun to take on a new significance. The authors warned that "[i]nstantaneous photographs and newspaper enterprise have invaded the sacred precincts of private and domestic life; and numerous mechanical devices threaten to make good the prediction that 'what is whispered in the closet shall be proclaimed from the house-tops.'" *Id.* at 195.

<sup>22</sup> *Id.* at 198 (footnote omitted). Implicit in this right is the power to control the publication of personal writings. *Id.* at 198-99. The protection of such writings, Warren and Brandeis maintained, involved the right of an "inviolable personality." *Id.* at 205. The most obvious case for protection under this notion is "[t]he right of one who has remained a private individual, to prevent his public portraiture." *Id.* at 213. The authors concluded, however, that the right to an inviolable personality must be broad enough to protect "the acts and sayings of a man in his social and domestic relations . . . from ruthless publicity." *Id.* at 214.

Nevertheless, the authors did admit that the right was not without limits. Borrowing from French law, Warren and Brandeis listed the following limitations on the right to privacy: (1) publication of a matter of public or general interest; (2) privileged communications under the law of libel and slander; (3) a requirement of special damages in the case of an oral publication; (4) publication of the facts by or with the consent of the individual; (5) the unavailability of truth as a defense; and (6) the unavailability of malice as a defense. *Id.* at 214-18.

Warren and Brandeis appeared to have been guided by their own particular motivations and needs in reaching their conclusions. In the end, their article focused on and argued vigorously for the recognition and enforcement of the “general right of the individual to be let alone.”<sup>23</sup>

## 2. New York’s Civil Rights Law

The publication of *The Right to Privacy* did achieve the authors’ desired effect. During the decades following the publication, the courts,<sup>24</sup> and later legislatures,<sup>25</sup> followed Warren’s and Brandeis’s lead by acknowledging the individual’s right to be left alone.

Nowhere was the move to legitimize this so-called “right to privacy”<sup>26</sup> played out more openly or more completely than in the courts and legislature of New York. In *Roberson v. Rochester Folding Box Co.*,<sup>27</sup> decided in 1902, the New York Court of Appeals was presented with an action brought by a woman whose unauthorized likeness appeared on a flour advertisement. The plaintiff phrased her claim in terms of a violation of her right to privacy. The court looked to the legal commentaries of Blackstone, Kent and the common law<sup>28</sup> for a validation of Warren’s and Brandeis’s right to privacy, but to no avail.<sup>29</sup> Absent clear

<sup>23</sup> *Id.* at 205.

<sup>24</sup> *See, e.g.*, *Corliss v. E.W. Walker Co.*, 64 F. 280, 282 (C.C.D. Mass. 1894) (declaring that “a private individual has a right to be protected in the representation of his portrait in any form”). *See also* *Schuyler v. Curtis*, 147 N.Y. 434, 443, 42 N.E. 22, 24 (1895) (stating that “it is unnecessary to wholly deny the existence of the right of privacy to which the plaintiff appeals as the foundation of his cause of action”). *But see* *Martin v. F.I.Y. Theatre Co.*, 10 Ohio Op. 338, 340 (1938) (the court reluctantly admitted that a right of privacy might exist but nevertheless declined to extend its protection to “any person following the theatrical business for a life’s work”).

<sup>25</sup> Foremost in statutory recognition of the right to privacy were §§ 50 and 51 of the New York Civil Rights Law. *See* N.Y. CIV. RIGHTS LAW §§ 50-57 (McKinney 1991). Other statutes also embody the traditional right of privacy. *See, e.g.*, NEB. REV. STAT. §§ 20-202 (1989).

<sup>26</sup> For good summaries of this legitimization process, see *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979); *Canessa v. J.I. Kislak, Inc.*, 235 A.2d 62 (N.J. Super. Ct. Law Div. 1967).

<sup>27</sup> 171 N.Y. 538, 64 N.E. 442 (1902).

<sup>28</sup> *But see* Warren & Brandeis, *supra* note 18, at 195 n.7 (discussing the unreported New York case of *Manola v. Stevens* (1890), where the New York Supreme Court granted a preliminary injunction to an actress whose photograph was surreptitiously taken during one of her performances and was later used without her consent).

<sup>29</sup> *See* *Atkinson v. John E. Doherty & Co.*, 80 N.W. 285 (Mich. 1899). In that case, the widow of Col. John Atkinson, a well-known lawyer and politician, sued to enjoin the manufacture of a cigar dubbed “John Atkinson.” The court sympathized with the plaintiff for the wrong alleged, but nevertheless declared that, absent support in legal authority, no redress could be provided.

The court’s insistence on some legal precedent was indirectly criticized several years later in *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905). The *Pavesich*

authority, the court, in a four-to-three decision, felt compelled to deny the common-law existence of the right to privacy.<sup>30</sup> Although the majority denied the existence of the right to privacy, it did note that “[t]he legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes without his consent.”<sup>31</sup>

### B. *Birth of the Right of Publicity*

An outpouring of public outrage ensued from the *Roberson* court’s decision.<sup>32</sup> The New York legislature apparently took this outrage to heart,<sup>33</sup> for at its next session it enacted sections fifty<sup>34</sup> and fifty-one<sup>35</sup> of the New York Civil Rights Law. Under these two sections,<sup>36</sup> the unauthorized use of a person’s name, portrait or likeness for the purposes of trade or advertising is deemed a misdemeanor and is subject to the award of money damages and injunctive relief.<sup>37</sup> At first glance, this statute appears broad

---

court admitted that no express references to the right to privacy can be found in the works of Blackstone and other common law commentators. However, the court went on to note that the list of an individual’s absolute rights, as noted by these commentators, was not intended to be exhaustive. Rather, these rights should be read broadly to encompass all rights, including the right to privacy, that derive from natural law.

<sup>30</sup> Gray’s dissent from the majority’s opinion eloquently argued for recognition of this new right, noting that the law must change along with it. He found it reprehensible that the law could be so rigid as to deny a remedy to a wrong made possible by new social or commercial conditions.

<sup>31</sup> *Roberson*, 171 N.Y. at 545, 64 N.E. at 443.

<sup>32</sup> Prosser, *Privacy*, *supra* note 19, at 385. Indeed, one of the concurring judges in the *Roberson* case even went so far as to publish a law review article defending the decision. See Denis O’Brien, *The Right of Privacy*, 2 COLUM. L. REV. 437 (1902).

<sup>33</sup> See *Arrington v. New York Times Co.*, 55 N.Y.2d 433, 434 N.E.2d 1319, 449 N.Y.S.2d 941, *reh’g. denied*, 57 N.Y.2d 669, 439 N.E.2d 884, 454 N.Y.S.2d 75 (1982), *cert. denied*, 459 U.S. 1146 (1983).

<sup>34</sup> Section 50 provides in pertinent part: “A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person . . . is guilty of a misdemeanor.” N.Y. CIV. RIGHTS LAW § 50 (McKinney 1991).

<sup>35</sup> Section 51 provides in pertinent part:

Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person’s name, portrait or picture in such manner as is forbidden or declared to be unlawful [by section fifty of this article, the jury], in its discretion, may award exemplary damages.

*Id.* § 51.

<sup>36</sup> The constitutionality of these two sections was upheld in *Rhodes v. Sperry & Hutchinson Co.*, 193 N.Y. 223, 85 N.E. 1097 (1908), *aff’d*, 220 U.S. 502 (1911).

<sup>37</sup> For an historical summary of this law, see Prosser, *Privacy*, *supra* note 19, at 383.

enough to ensure not only that the individual enjoy the security of his solitude, but also that he reap the benefit of the economic exploitation of his personal assets.

By providing simplicity, uniformity and hence predictability, such an interpretation would have undoubtedly satisfied both the law and the celebrity. As will be discussed below, however, the courts, from the outset, refused to give the statute such a reading. As a result of this unfortunately narrow interpretation of the statute, the courts found it necessary to create a new common-law right to accommodate the growing demand for adequate protection of the commercial value of the celebrity persona.

### 1. Narrow Reading of the New York Civil Rights Act

The Warren and Brandeis article and the *Roberson* case caused the legal community to focus on privacy losses, such as “mental distress” and “disruption of solitude,” that could result from unscrupulous advertising campaigns and unauthorized uses of the relatively new art of photography.<sup>38</sup> Cases initially brought under sections fifty and fifty-one also emphasized the infringement of privacy suffered by the plaintiffs as a result of the unauthorized use of their photographs.<sup>39</sup> The language of these two sections does not necessarily require that they be exclusively applied to the plaintiff who complains that his privacy has been invaded by the unauthorized use of his personal attributes. Section fifty-one expressly permits a person whose “name, portrait or picture is used within this state for advertising purposes” to

---

*See also* Lerman v. Flynt Distributing Co., Inc., 745 F.2d 123 (2d Cir. 1984), *cert. denied*, 471 U.S. 1054 (1985). In *Lerman*, an action was brought for the misidentification of the plaintiff as the subject of nude photographs. The Second Circuit reversed the trial court’s award of \$10,000,000 on the ground that plaintiff could not prove actual malice sufficient to overcome the publisher’s First Amendment argument.

<sup>38</sup> *See* Kramer, *supra* note 19, at 703.

<sup>39</sup> *See, e.g.*, Redmond v. Columbia Pictures Corp., 277 N.Y. 707, 14 N.E.2d 636 (1938) (in an action brought under §§ 50 and 51 for the unauthorized use of films of the plaintiff golfer, the New York Court of Appeals affirmed the trial court’s award of six cents, based on a finding that there was no injury to the plaintiff’s feelings); Loftus v. Greenwich Lithographing Co., 192 A.D. 251, 182 N.Y.S. 428 (1st Dep’t 1920) (a successful action was maintained under §§ 50 and 51 by an actress whose altered photograph was used in a movie poster without her consent); Lane v. F.W. Woolworth Co., 171 Misc. 66, 11 N.Y.S.2d 199 (Sup. Ct. N.Y. County), *aff’d*, 256 A.D. 1065, 12 N.Y.S.2d 352 (1st Dep’t 1939) (an actress brought an action under § 51 for the unauthorized use of her photograph in a locket sold in a store); Semler v. Ultem Publications, Inc., 170 Misc. 551, 9 N.Y.S.2d 319 (Sup. Ct. Queens County 1938) (a model was permitted to recover under § 51 for the unauthorized use of her photograph in a magazine). Note, however, that some early actions brought under §§ 50 and 51 did not involve the unauthorized use of photographs. *See, e.g.*, Gardella v. Log Cabin Product Co., 89 F.2d 891 (2d Cir. 1937) (acknowledging that a performer might acquire privacy-like rights in a stage name deserving of protection under §§ 50 and 51).

maintain an action for damages.<sup>40</sup> Thus, sections fifty and fifty-one should theoretically be available to the individual who complains that his persona has been misappropriated without any compensation to him.<sup>41</sup>

The latter claim, based on the economic value that a celebrity may find in his persona,<sup>42</sup> was not unknown in the earlier part of the twentieth century. Rather, the law of that time clearly recognized the marketability of the celebrity's persona.<sup>43</sup> Despite this recognition, and despite the broad language of sections fifty and fifty-one, the courts consistently refused to read the New York Privacy Act as protecting the celebrity's exploitation of his persona.<sup>44</sup> Rather, the courts uniformly restricted the applica-

---

<sup>40</sup> See *supra* note 35.

<sup>41</sup> Indeed, many so-called "privacy" cases brought under § 51 arguably come closer to "misappropriation" claims than they do "invasion of solitude" claims. See, e.g., *Paulsen v. Personality Posters, Inc.*, 59 Misc. 2d 444, 299 N.Y.S.2d 501 (Sup. Ct. N.Y. County 1968).

In *Hogan v. A.S. Barnes & Co.*, 114 U.S.P.Q. (BNA) 314 (Pa. C.P. 1957), the court claimed that certain privacy cases, such as *Redmond*, 277 N.Y. at 707, 14 N.E.2d at 636 and *Lane*, 171 Misc. at 66, 11 N.Y.S.2d at 199, should actually have been maintained as publicity actions. A similar argument can be found in Chief Justice Bird's dissent in *Lugosi v. Universal Pictures*, 603 P.2d 425, 439 n.14 (Bird, C.J., dissenting).

<sup>42</sup> In *Paulsen*, 59 Misc. 2d at 450, 299 N.Y.S.2d at 508, the court explained that "[w]hat such a figure really seeks is a type of relief which will enable him to garner financial benefits from the pecuniary value which attaches to his name and picture."

<sup>43</sup> See, e.g., *Wood v. Lucy, Lady Duff-Gordon*, 222 N.Y. 88, 118 N.E. 214 (1917), *reh'g. denied*, 222 N.Y. 643, 118 N.E. 1082 (1918). The defendant in this case, whom Cardozo described as a person who "styles herself 'a creator of fashions,'" sold the plaintiff the exclusive right, subject to her approval, to place her endorsement on the designs of others. *Id.* at 90, 118 N.E. at 214. See also *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1942). The dissent in that case was convinced that football great Pat O'Brien had a valuable and protectable interest in the commercial exploitation of his name. In support of this position, the dissent referred to boxer Gene Tunney, who had recently been offered \$15,000 (a generous sum at that time) to endorse cigarettes. Tunney, a non-smoker, declined the offer. The advertiser immediately made a counter-offer: Tunney would be paid \$12,000 if he would allow his photograph to be used with the statement that "Stinkies must be good, because all my friends smoke them." Tunney also refused this offer. *Id.* at 171 n.6 (quoting *READER'S DIG.*, Dec. 1941, at 23). See also *Hanna Mfg. Co. v. Hillerich & Bradsby Co.*, 78 F.2d 763 (5th Cir.), *cert. denied*, 296 U.S. 645 (1935) (the court recognized the growing market for celebrity endorsements but questioned whether extending protection to these interests made legal or practical sense).

<sup>44</sup> See, e.g., *Paulsen*, 59 Misc. 2d at 444, 299 N.Y.S.2d at 501. But see *Sharkey v. National Broadcasting Co.*, 93 F. Supp. 986 (S.D.N.Y. 1950). In this case, heavyweight boxing champion Jack Sharkey brought an action against NBC under the Privacy Act. Without Sharkey's permission, NBC used film footage of Sharkey in a televised program called "Greatest Fights of the Century." Sharkey was then engaging in various professional entertainment and sports activities, which, according to the court, kept "his name and pictures in the public mind and eye, with consequent pecuniary value to him." *Id.* at 986. The basis of Sharkey's statutory complaint was that the defendants' unauthorized use made his name and likeness less valuable to him in his present professional entertainment and sports activities. The court agreed that Sharkey's complaint stated a cause of action under the Privacy Act. In retrospect, however, this complaint was clearly more aligned with the soon-to-be-identified right of publicity than it was with the right to privacy as it was then defined.

tion of the statute to the “injured feelings” that formed the basis for the complaint in *Roberson*.<sup>45</sup> As the New York Court of Appeals explained in *Flores v. Mosler Safe Co.*,<sup>46</sup> “[t]he primary purpose of this legislation was to protect the sentiments, thoughts and feelings of an individual.”<sup>47</sup>

## 2. Resultant Birth of the Common Law Right of Publicity

During the first half of the twentieth century, history and a basic distrust of the press caused the law to focus solely on injured feelings.<sup>48</sup> By the second half of the twentieth century, however, the courts began to consider claims of economic loss.<sup>49</sup>

---

<sup>45</sup> See *Paulsen*, 59 Misc. 2d at 450, 299 N.Y.S.2d at 508. The court in that case forcefully maintained that

[I]t has been made clear that the purpose of the statute is to redress injury for invasions of a “person’s right to be let alone”, with recovery being grounded on the mental strain, distress, humiliation and disturbance of the peace of mind suffered by such person . . . and that the statute was *not* enacted to fill gaps in the copyright law or to afford substitute relief for breaches of contract or violations of various other species of property rights.

*Id.* (citing *Gautier v. Pro-Football, Inc.*, 278 A.D. 431, 438 (1952)). See also *Young v. Greneker Studios, Inc.*, 175 Misc. 1027, 26 N.Y.S.2d 357 (Sup. Ct. Spec. Term N.Y. County 1941) (holding that a clothing store mannequin created in the likeness of a human model constitutes a “portrait” or “picture” within the meaning of § 51 which gives a person a cause of action if his “name, portrait, or picture” is used without written consent).

<sup>46</sup> 7 N.Y.2d 276, 196 N.Y.S.2d 975, 164 N.E.2d 853 (1959) (the Court of Appeals affirmed the plaintiff’s invasion of privacy claim under § 51 of the Civil Rights Law where the defendant republished the entire news coverage of a fire in an advertising circular which named the plaintiff and stated that he or another person started the fire).

<sup>47</sup> *Id.* at 280, 196 N.Y.S.2d at 978, 164 N.E.2d at 855. See also *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 358, 107 N.E.2d 485, 487 (1952) (determining that “the statute was born of the need to protect the individual from selfish, commercial exploitation of his personality”). *Id.* at 358, 107 N.E.2d at 487. See also Harold R. Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 Nw. U. L. Rev. 553, 565-66 (1960) (noting that the statute “provided the remedy for injury to feelings which had been denied in [the *Roberson*] decision”). For a recent, florid description of the purpose of the New York Privacy Act, see *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254 (Sup. Ct. Spec. Term 1984), *aff’d mem.*, 110 A.D.2d 1095 (1st Dep’t 1985). In explaining the purpose of the statute, the *Onassis* court stated:

If we truly value the right of privacy in a world of exploitation, where every mark of distinctiveness becomes grist for the mills of publicity, then we must give it more than lip service and grudging recognition. Let the word go forth—there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.

*Id.* at 612, 472 N.Y.S.2d at 261.

<sup>48</sup> See *supra* note 45 and accompanying text.

<sup>49</sup> See, e.g., *McQueen v. Wilson*, 161 S.E.2d 63, *rev’d on other grounds*, 162 S.E.2d 313 (1968), *overruled on other grounds*, *Austin v. Carter*, 285 S.E.2d 542 (Ga. 1982). The Georgia Court of Appeals noted that Butterfly McQueen’s livelihood depended in part on the public image that she created in “Gone with the Wind.” According to that court, McQueen “packaged [her] personality within the area of performance as a commodity for sale to the public.” 161 S.E.2d at 66. McQueen’s complaint was based upon the unauthorized commercial use of this valuable commodity. See also *Radio Corp. of Am. v. Premier Albums, Inc.*, 19 A.D.2d 62, 240 N.Y.S.2d 995 (1st Dep’t 1963) (RCA, as licensee

Since existing legislation had unfortunately been read too narrowly to accommodate this new complaint, New York and other celebrity meccas were forced to fashion a new common law right in their attempt to protect the exploitative value of the celebrity persona.

The celebrity's ability to recover for the unauthorized commercial use of his persona was first recognized in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>50</sup> In *Haelan*, the plaintiff, a chewing gum manufacturer, had obtained the exclusive right to use a baseball player's photograph to advertise its gum. The defendant, a rival chewing gum manufacturer, then induced the player to grant it the right to use his photograph to sell their gum. In their analysis of the plaintiff's complaint, the Second Circuit first recognized the right to privacy embodied in the New York Civil Rights Law.<sup>51</sup> The court, however, then determined that an individual has an additional, independent right to grant the exclusive privilege of publishing his picture. The court labeled this latter right the "right of publicity."<sup>52</sup> It found justification for this right in existing New York case law<sup>53</sup> and noted, in part, that "many prominent persons (especially actors and ballplayers), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways."<sup>54</sup>

---

of the production and marketing rights to certain Tommy Dorsey recordings, sought to prevent the unauthorized use of those recordings on the ground that unrestrained use would render RCA's right valueless.)

<sup>50</sup> 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

<sup>51</sup> Just one year earlier, several major league baseball players who were unhappy about the use of their photographs on bubble gum cards brought an action under § 51. *Jansen v. Hilo Packing Co.*, 202 Misc. 900, 118 N.Y.S.2d 162 (Sup. Ct. Spec. Term 1952), *aff'd*, 282 A.D. 935, 125 N.Y.S.2d 648 (1953). These players tailored their complaint to conform with the traditional confines of the New York Civil Rights Law by alleging that the uses in question had been "in violation of their rights of privacy for advertising and trade purposes, in contravention of said statute." *Id.* at 900, 118 N.Y.S.2d at 163. The court refused to dismiss that complaint.

<sup>52</sup> *Haelan*, 202 F.2d at 868.

<sup>53</sup> The court cited to *Wood v. Lucy, Lady Duff-Gordon*, 222 N.Y. 88, 118 N.E. 214 (1917), *reh'g denied*, 222 N.Y. 643, 118 N.E. 1082 (1918); *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 A.D. 459, 465, 7 N.Y.S.2d 845 (1st Dep't 1938). *But cf.* *Liebig's Extract of Meat Co. v. Liebig Extract Co.*, 180 F. 688 (2d Cir. 1910) (granting an injunction against defendant's unlicensed use of the word "Liebig," associated with a process perfected by plaintiff to sell his product).

<sup>54</sup> *Haelan*, 202 F.2d at 868. According to the *Haelan* court, the baseball player did have the right to transfer this right "in gross, i.e., without an accompanying transfer of a business or of anything else." Curiously, however, the court found it to be immaterial whether this right be labelled "property." *Id.* This growing recognition of the commercial value of a celebrity's name is underscored in another case involving a sports celeb-

### 3. Initial Second-Class Treatment of the Right of Publicity

During the next two decades, New York courts and federal courts applying New York law began to recognize the separate existence of the right of publicity.<sup>55</sup> During this period, the right of publicity was also endorsed by some courts outside of New York.<sup>56</sup> Most of these courts, however, continued to treat the unauthorized commercial use of the persona as an unlabeled subspecies of the right of privacy.<sup>57</sup>

---

riety that was decided under New York law shortly before the decision in *Haelan* was handed down. In *Sharkey v. National Broadcasting Co.*, 93 F. Supp. 986 (S.D.N.Y. 1950), the court recognized the plaintiff's pecuniary value in his name and likeness. For a discussion of the facts of *Sharkey*, see *supra* note 44.

<sup>55</sup> See, e.g., *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973). Actor Cary Grant brought suit against *Esquire* magazine for the unauthorized use of a photograph of his head on the torso of an unidentified model in an article concerning men's clothing trends. In recognizing the existence of a right of publicity under New York common law, the federal court likened it "to the exclusive right of a commercial enterprise to the benefits to be derived from the goodwill and secondary meaning [a person] has managed to build up in [his] name." *Id.* at 879. Although the *Grant* court expressly recognized the right of publicity, it also acknowledged the close relationship publicity then had with the statutory right of privacy. *Id.*

The right of publicity was similarly received by the New York federal court in *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975). The widows of Stan Laurel and Oliver Hardy claimed that the defendant studio had, without the widows' permission, entered into an agreement with a third party that purported to grant an exclusive license to use the names and likenesses of Laurel and Hardy. The court recognized the confusion then surrounding the right of publicity but, nevertheless, declared it to be separate and distinct from the right of privacy—privacy protected the individual from intrusion upon his solitude, whereas publicity protected him from appropriation of some element of his personality for commercial purposes. *Id.* at 843. See also *Chaplin v. National Broadcasting Co.*, 15 F.R.D. 134 (S.D.N.Y. 1953) (unauthorized use of broadcasts other than for trade purposes is not a violation of the statutory right to privacy); *Current Audio, Inc. v. RCA Corp.*, 71 Misc. 2d 831, 337 N.Y.S.2d 949 (Sup. Ct. Spec. Term, 1972) (holding a press conference does not violate the right of privacy); *Rosemont Enters., Inc. v. Random House, Inc.*, 58 Misc. 2d 1, 294 N.Y.S.2d 122 (Sup. Ct. Spec. Term N.Y. County 1968), *aff'd*, 32 A.D.2d 892, 301 N.Y.S.2d 948 (1st Dep't 1969) (recognizing the right of publicity but noting that it only extends to limit the commercial use of a person's name).

<sup>56</sup> See, e.g., *Uhlaender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970) (Minnesota federal court recognizing the right of a major league baseball player to file a right of publicity suit on behalf of himself and other major league players seeking to enjoin a manufacturer from making unauthorized use of players' names in a baseball table game); *Cepeda v. Swift & Co.*, 291 F. Supp. 242 (E.D. Mo. 1968), *aff'd*, 415 F.2d 1205 (8th Cir. 1969) (Missouri federal court recognizing the right of publicity in an action brought by baseball great Orlando Cepeda against a meat processor and sporting goods manufacturer); *Sharman v. C. Schmidt & Sons, Inc.*, 216 F. Supp. 401 (E.D. Pa. 1963) (acknowledging that the right of publicity was a recognized doctrine in Pennsylvania but finding it did not apply in this case); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 135 (Wis. 1979) (citation omitted) (relying on a theory of unjust enrichment, and declaring that "[i]t is a form of commercial immorality to 'reap where another has sown,'" the Wisconsin Supreme Court upheld a publicity action brought by football great Elroy "Crazylegs" Hirsch against a manufacturer that had, without his permission, used the nickname "Crazylegs" to market a moisturizing shaving gel for women); *Cabaniss v. Hipsley*, 151 S.E.2d 496 (Ga. Ct. App. 1966) (recognizing the right of publicity in an action brought by an exotic dancer against a magazine publisher and private club).

<sup>57</sup> See, e.g., *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.),

This second-class treatment was supported at least in part by Dean Prosser.<sup>58</sup> In his 1960 article entitled *Privacy*,<sup>59</sup> Prosser made only one passing reference to the right of publicity as defined by the *Haelan* court, which he described as a justifiable, but not yet tested decision. Instead of focusing on this newly identified right, Prosser chose to remain within the confines of the

---

*cert. denied*, 351 U.S. 926 (1956). In that case, a prize fighter brought an action to recover damages for an unauthorized television showing of a film of one of his fights. The court described the unauthorized commercial use of the persona as a gray area lying between the destruction of the veil of obscurity that usually surrounds the average person and the actual appropriation of a performer's act. Despite the fact that the *Ettore* court spoke solely in terms of privacy, many courts have cited to *Ettore* as an express recognition of the right of publicity. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

Courts in the West and the Midwest initially exhibited a similar hesitancy to give the right of publicity a life of its own. In *James v. Screen Gems, Inc.*, 344 P.2d 799 (Cal. Ct. App. 1959), the widow of Jesse James, Jr. sought compensation from a producer and a broadcaster that had made an unauthorized film portrayal of James' life. The court analyzed the widow's complaint under privacy law and ultimately decided that her cause would not lie because privacy cannot be asserted by anyone other than the party whose privacy has been invaded. *Id.* at 801. See also *Maritote v. Desilu Prods., Inc.*, 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965). In *Maritote*, the widow and son of Al Capone sought damages for unjust enrichment arising out of the use of Capone's "name, likeness, and personality" in "The Untouchables" television series. After categorizing the complaint as one based in privacy, the Seventh Circuit stated that, if an invasion of privacy had occurred here, the right belonged to the deceased Capone, not his survivors. See also *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974). In *Motschenbacher*, the Ninth Circuit was presented with an action brought by a professional race car driver against a cigarette manufacturer for the unauthorized use of his distinctively painted race car in a Winston cigarette advertisement. The court noted that some courts had been protecting the commercial aspect of the persona under the rubric of privacy, while others had been protecting it under the rubric of publicity. The court concluded that California courts would protect the proprietary interest of a plaintiff's own identity, but declined to decide whether such protection would be afforded under a privacy or a publicity theory. *Id.* at 825, 826.

Some courts initially attempted to categorize the unauthorized commercial use of the persona as a subspecies of other traditional causes of action, such as unfair competition or breach of contract. For an example of the unfair competition analogy, see *Hogan v. A.S. Barnes & Co., Inc.*, 114 U.S.P.Q. (BNA) 314 (Pa. C.P. 1957). For a comparison of the right of publicity and unfair competition, see *infra* note 145 and accompanying text. For an example of the contract analogy, see *Lawrence v. Ylla*, 184 Misc. 807, 55 N.Y.S.2d 343 (Sup. Ct. Spec. Term 1945) (dog owner unsuccessfully sought to enjoin the unauthorized commercial use of photos of her dog on the ground of breach of contract).

As the Third Circuit artfully maintained in *Ettore*:

The state of the law is still that of a haystack in a hurricane but certain words and phrases stick out. We read of the right of privacy, of invasion of property rights, of breach of contract, of equitable servitude, of unfair competition; and there are even suggestions of unjust enrichment.

*Ettore*, 229 F.2d at 485.

<sup>58</sup> One court has gone so far as to declare that "Dean Prosser's analysis [of the right of publicity] has been a source of some confusion in the law." *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987). For a similar comment on the effect of Prosser's analysis, see Howard I. Berkman, Note, *The Right of Publicity—Protection for Public Figures and Celebrities*, 42 BROOK. L. REV. 527, 531 (1976).

<sup>59</sup> Prosser, *Privacy*, *supra* note 19, at 383.

traditional privacy cause. Without further explanation, Prosser simply divided the right of privacy into four distinct torts, including “[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness.”<sup>60</sup>

#### 4. Revival of the Right of Publicity

Through the middle of the 1970s, the right of publicity seemed destined to live, and almost certainly to die, under the shadow of confusion cast by the right of privacy.<sup>61</sup> In 1977, however, the right of publicity was brought back into the spotlight by litigation touched off by two incongruous events.

The first of these two events was a “human cannonball” act performed by one Hugo Zacchini at an Ohio county fair during the summer of 1976. Zacchini’s act caught the attention of a free-lance reporter, who, without Zacchini’s knowledge or permission, taped the entire fifteen-second act. That videotape was later shown on a local television news program. Zacchini thereupon sued both the reporter and the broadcasting company for the misappropriation of his act in *Zacchini v. Scripps-Howard Broad-*

---

<sup>60</sup> *Id.* at 389. Prosser did note, however, that “[t]he interest protected is not so much a mental as a proprietary one.” *Id.* at 406. Prosser never did recognize the right of publicity as anything other than a subset of the right of privacy. Indeed, the fifth edition of Prosser’s classic hornbook on the law of torts, which was published after Prosser’s death under the editorial guidance of W. Page Keeton, still includes “appropriation” as one of the four types of privacy actions. W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 851-54 (5th ed. 1984).

A number of courts have found Prosser’s privacy approach to the unauthorized use of the persona attractive. *See, e.g.,* *Palmer v. Schonhorn Enters., Inc.*, 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967). In *Palmer*, a group of well-known professional golfers sought to enjoin the use of their names in connection with a commercially marketed board game. In granting the relief requested, the Superior Court of New Jersey recognized the claim as falling within the fourth of Prosser’s privacy categories. *See also* *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128 (7th Cir. 1985), *cert. denied*, 475 U.S. 1094 (1986) (actress claimed her right to privacy was violated by *Hustler* magazine when it published nude photographs of her that had been previously published in *Playboy* magazine); *Lerman v. Flynt Distributing Co.*, 745 F.2d 123 (2d Cir. 1984), *cert. denied*, 471 U.S. 1054 (1985) (publicity claim brought by pop novelist Jackie Collins, who complained of the distribution of a magazine that contained nude photographs mistakenly attributed to her); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983) (actor’s claim against newspaper for invasion of privacy for the unauthorized use of his name and photograph in the newspaper and related advertisements). The Rhode Island legislature has also perpetuated this treatment by phrasing its privacy statute in terms of Prosser’s four categories. R.I. GEN. LAWS § 9-1-28.1(2) (1957-1989). Wisconsin also treats publicity as a subset of privacy by statutorily recognizing three of Prosser’s four categories (intrusion on solitude, misappropriation, and publication of private facts). WIS. STAT. ANN. § 895.50 (West 1983 & Supp. 1990).

<sup>61</sup> The spectre of this confusion prompted two commentators to argue that the labels “right of privacy” and “right of publicity” should be abandoned in favor of “explicit recognition of the principles that courts actually use.” Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1578 (1979).

*casting Company*.<sup>62</sup>

The second of these events was the untimely death of Elvis Presley in August 1977. As he had throughout his performing career, Presley continued after death to loom larger than life. Indeed, his name seemed to take on an even greater commercial significance after his passing. As a result, a number of cases involving the unauthorized commercial use of his persona soon arose.<sup>63</sup> In particular, two companion cases, *Factors Etc., Inc. v. Creative Card Co.*,<sup>64</sup> ("Factors I") and *Factors Etc., Inc. v. Pro Arts, Inc.*,<sup>65</sup> ("Factors II") were heard by the district court for the Southern District of New York shortly after Presley's death. In both of these cases, Presley's survivors sought to prevent third parties from making unlicensed post-mortem use of Presley's name and likeness.<sup>66</sup>

---

<sup>62</sup> 433 U.S. 562 (1977). The state trial court granted summary judgment for the defendant. *Id.* at 564. The Ohio Court of Appeals reversed, holding that Zacchini had "stated a cause of action for conversion and for infringement of a common-law copyright." *Id.* One member of that three-judge panel concurred on the ground that Zacchini had "stated a cause of action for appropriation of [his] 'right of publicity.'" *Id.* All three judges agreed that the televised showing of the entire act was not protected by the First Amendment. *Id.* For an analysis of the effect of the First Amendment on the right of publicity, see *infra* note 76 and accompanying text.

On subsequent appeal, the Ohio Supreme Court held that Zacchini did not state a cause for conversion or for infringement of common law copyright. *Zacchini*, 351 N.E.2d 454, 457 (Ohio 1976). The court, however, did recognize that Zacchini might have a cause of action based upon his right of publicity. The court then exhibited shades of the confused view of publicity that then prevailed by describing it as "a well-recognized branch of the more general tort of interference with the right of privacy." *Id.* at 456. Ultimately, despite its recognition of Zacchini's right of publicity, the court reversed, holding that the television broadcast of Zacchini's act was privileged under the First Amendment. *Id.* at 462.

<sup>63</sup> See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F.Supp. 288 (S.D.N.Y. 1977), *aff'd & remanded*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), *on remand*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd*, 652 F.2d 278 (2d Cir. 1981); *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1977); *Memphis Dev. Found. v. Factors Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd and remanded*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

<sup>64</sup> 444 F. Supp. at 279.

<sup>65</sup> 444 F. Supp. at 288.

A third case was also filed. *Factors Etc., Inc. v. The Wild Side, Inc.*, 77 Civ. 4705 (S.D.N.Y. Oct. 14, 1977).

<sup>66</sup> Presley and his manager, Colonel Tom Parker, had entered into an exclusive merchandising agreement with Boxcar Enterprises, Inc. As a result of this arrangement, a substantial amount of Presley merchandise was manufactured and marketed during the singer's lifetime. For a discussion of the effect of this merchandising on the continued viability of the right of publicity after Presley's death, see *infra* text accompanying notes 113-14.

On August 18, 1977, two days after Presley's death, Boxcar granted Factors Etc., Inc., the exclusive right to use Presley's likeness in connection with all souvenir merchandise. Upon execution of this agreement, Factors paid Boxcar \$100,000 against a guarantee of \$150,000. This arrangement was made with the blessing of Presley's father and executor, Vernon.

Boxcar and Factors then together sued to enjoin Creative Card Company (*Factors I*)

In both *Zacchini* and *Factors I & II*, the respective courts determined that the unlicensed appropriation had been improper. In no case, however, could such a determination be supported by reliance on the right to privacy or any traditional branch thereof. *Zacchini* involved an appropriation for use in a televised news program. Under the traditional rule, such a use was entitled to complete exemption from a privacy claim under the First Amendment. Both *Factors* cases involved a claim brought after Presley's death by his survivors. Under the traditional rule, a cause of action in privacy did not survive the death of the injured party.

Therefore, in these cases the courts were forced to look to some other theory to justify the conclusions they wished to reach. They found this justification in the right of publicity. To ensure the validity of their decisions, the courts took pains to distinguish publicity from privacy.<sup>67</sup>

Because of the serious First Amendment issue presented in *Zacchini*, the United States Supreme Court focused its distinction on the public dissemination of information. According to the Court, the rights of publicity and privacy are affected differently upon public dissemination. The only way to protect the interest involved in a privacy claim is to minimize publication. By contrast, widespread publication is usually not problematic in a publicity claim, so long as the complainant receives the commercial benefit of that publication.<sup>68</sup> Thus, in the Court's view, publicity posed a lesser threat to speech than did privacy. The Court was therefore free to allow publicity to prevail over defendant's First Amendment claim.<sup>69</sup>

Because the plaintiffs in the *Factors* cases were making post-mortem assertions of Presley's rights, the district court focused upon the nature and durability of such rights.<sup>70</sup> In doing so, the

---

and Pro Arts, Inc. (*Factors II*), from manufacturing, distributing or selling posters bearing Presley's likeness.

<sup>67</sup> In *Zacchini*, the Court specifically referred to the "false light" facet of the right to privacy. *Zacchini*, 433 U.S. 562. For a discussion of the traditional tort of "false light," see Prosser, *Privacy*, *supra* note 19, at 398-401. The Court felt obliged to distinguish between privacy and publicity because, in denying *Zacchini*'s publicity claim, the Ohio Supreme Court had relied heavily on the privacy rationale laid down in *Time, Inc. v. Hill*, 385 U.S. 374 (1967).

<sup>68</sup> *Zacchini*, 433 U.S. at 573. The Court relied on the right of publicity since *Zacchini* had sought money damages rather than injunctive relief.

Ultimately, the Court was persuaded that the broadcast of *Zacchini*'s entire act posed a "substantial threat to the economic value of [his] performance" and thus violated his right of publicity. *Id.* at 575. For a discussion of the First Amendment exception to the right of publicity, see *infra* note 76.

<sup>69</sup> The Court was particularly disturbed that defendant's First Amendment claim here involved the appropriation of the plaintiff's entire—albeit short—act.

<sup>70</sup> In *Zacchini*, the Supreme Court also considered the nature of the right of publicity.

court tried to distinguish publicity from privacy by contrasting the proprietary nature of the former to the personal nature of the latter.<sup>71</sup> As the court explained, "when a 'persona' is in effect a product, and when that product has already been marketed to good advantage, the appropriation by another of that valuable property has more to do with unfair competition than it does with the right to be left alone."<sup>72</sup>

The *Zacchini* and *Factors I & II* courts were thus driven by the peculiar facts of the cases before them in both their adoption of the right of publicity and in their attempts to distinguish this "newfound"<sup>73</sup> right from the right of privacy. Nevertheless, the one-two punch delivered by both the *Zacchini* and *Factors I and II* decisions was finally enough to bring the right of publicity to maturity. Following the issuing of these decisions, courts and celebrities alike jumped on the publicity bandwagon. That bandwagon, however, was destined to follow a rocky and destructive path.

### III. THE LEGAL WEEDS OF DESTRUCTION

By the end of the 1970s, courts in many jurisdictions had at least temporarily rescued publicity from its path toward obscurity.<sup>74</sup> In addition, during the 1980s, a number of states attempted to codify the right of publicity.<sup>75</sup>

---

The Court recognized that privacy deals with reputation, with "overtones of mental distress." *Zacchini*, 433 U.S. at 573 (quoting Prosser, *Privacy*, *supra* note 19, at 400). Publicity, on the other hand, protects a person's proprietary interest in his act. The Court analogized this interest to the goals of patent and copyright law, which focus on a person's right to reap the awards of his creative efforts but which have little to do with hurt or injured feelings. *Id.* According to the Court, publicity, patent, and copyright alike provide an economic incentive for a person to create something of interest to the public. *Id.* at 576. For a discussion of the preemption argument to which this analogy has recently led, see *infra* text accompanying notes 171-205.

<sup>71</sup> In *Factors I*, the district court found "far the most interesting issue" in the case to be "whether Boxcar had anything to transfer to Factors" in the August 18, 1977, agreement. *Factors, Etc., Inc., v. Creative Card Co.*, 444 F. Supp. 279, 282 (S.D.N.Y. 1977). The court then proceeded to answer that question in the affirmative by recognizing that Presley possessed a right of publicity that was properly assigned by him during his lifetime.

<sup>72</sup> *Id.* at 283. This rationale was confirmed by the same court in *Factors II*. *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977). *But see infra* note 145 (discussing how the right of publicity differs from unfair competition).

<sup>73</sup> Both the United States Supreme Court in *Zacchini* and the district court in both *Factors* cases recognized, however, that the right of publicity had been around for some time. In *Zacchini*, the Court maintained that "[t]here is no doubt that . . . the right of publicity which petitioner was held to possess was a right arising under Ohio law." *Zacchini*, 433 U.S. at 566.

<sup>74</sup> See *supra* notes 63-72 and accompanying text.

<sup>75</sup> The following jurisdictions have enacted statutes that govern some or all of the aspects of the right of publicity: California (CAL. CIV. CODE §§ 990, 3344 (West 1991)); Florida (FLA. STAT. ch. 540.08 (1990)); Kentucky (KY. REV. STAT. ANN. § 391.170

Despite this move toward the legal recognition of the right of publicity, “[t]he state of the law is still that of a haystack in a hurricane.”<sup>76</sup> In particular, the law has continued to struggle with the transferability and survivability of the right of publicity. In an attempt to resolve the confusion that surrounds these two aspects of the right, the courts have unwittingly traveled down a path that seems destined to result in federal preemption of the right of publicity.

#### A. *Inter Vivos and Post Mortem Transferability of the Right of Publicity*

Perhaps the most important characteristic of the right of publicity is its ability to be transferred *inter vivos* and post

---

(Michie/Bobbs Merrill 1984)); Massachusetts (MASS. GEN. L. ch. 214, § 3A (1989)); Nevada (NEV. REV. STAT. §§ 598.980-988 (1986-1989)); Oklahoma (OKLA. STAT. tit. 12, §§ 839.1-2, 1448-9 (1990)); Rhode Island (R.I. GEN. LAWS § 9-1-28.1 (1985)); Tennessee (TENN. CODE ANN. § 47-25-1101 to -1108 (1955-1989)); Texas (TEX. PROP. CODE ANN. § 26.001-.015 (West Supp. 1991)); Virginia (VA. CODE ANN. § 8.01-40 (Michie 1984)); Wisconsin (WIS. STAT. § 895.50 (1988)). For a discussion of whether such state legislation preempts the common law right of publicity, see *infra* text accompanying notes 154-68.

<sup>76</sup> *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 485 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956). Chief Justice Bird has colorfully described the development of the right of publicity as “spasmodic.” *Lugosi v. Universal Pictures*, 603 P.2d 425, 439 n.14 (Cal. 1979)(Bird, C.J., dissenting).

Faced with overwhelming confusion, most courts and legislatures do at least agree upon how the right of publicity relates to the First Amendment. Various jurisdictions have long recognized that the right of publicity carries the potential to seriously infringe upon the First Amendment guarantees of freedom of expression. In recognition of this imminent threat to free speech, the courts have acknowledged the so-called “biography” exception to the right of publicity. *Rosemont Enters., Inc. v. Random House, Inc.*, 58 Misc.2d 1, 6, 294 N.Y.S.2d 122, 129 (Sup. Ct. N.Y. County 1968), *aff’d*, 32 A.D.2d 892, 301 N.Y.S.2d 948 (1st Dep’t 1969). Under this exception, First Amendment concerns prevail over the right of publicity when it conflicts with the free dissemination of public-interest information. *Id.*

Where the offending publication is a work of fiction, the court must engage in a balancing process. *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978). If the defendant has engaged in deliberate falsification, the balance should tip in favor of the right of publicity. *Id.* But if no deliberate falsifications have occurred, the First Amendment should prevail. *Id.* See also *Cher v. Forum Int’l, Ltd.*, 692 F.2d 634 (9th Cir. 1982), *cert. denied*, 462 U.S. 1120 (1983) (magazine not liable for publication of an interview with a public figure absent publisher’s knowledge of falsehood or reckless disregard of the truth).

Where the use is purely commercial, the First Amendment provides no protection for the defendant. *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201 (N.D. Ill. 1981), *aff’d in part and rev’d in part*, *Winterland Concessions Co. v. Trela*, 735 F.2d 257 (7th Cir. 1984); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981); *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973). Finally, where the defendant has engaged in wholesale appropriation, the defendant likewise loses his First Amendment shield. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

For statutory recognition of this traditional First Amendment exemption, see, e.g., NEV. REV. STAT. § 598.984 (1989); OKLA. STAT. tit. 12, § 1448J (1990); TEX. PROP. CODE ANN. § 26.012(a) (West 1991); WIS. STAT. § 895.50(3) (1988).

mortem.<sup>77</sup> The transferability of the celebrity's right to commercially exploit his persona depends upon the resolution of certain key issues. In particular, transferability depends on the following four factors: (1) the traditional legal nature of that right; (2) its ability to survive the celebrity's death; (3) what acts of exploitation, if any, the plaintiff is required to conduct in order to cause his right to mature into a transferable commodity; and (4) duration of the right. Unfortunately, the courts and legislatures of the various jurisdictions do not always agree on the proper resolution of these issues.

### 1. Traditional Legal Nature

In keeping with traditional common law notions that date back to the Middle Ages, courts have insisted on classifying the right of publicity as proprietary in nature.<sup>78</sup> The confusion concerning its nature may reach as far back as the right to privacy article that was published by Warren and Brandeis in 1890.<sup>79</sup> In their carefully crafted argument, these two authors first claimed that the right to an inviolate personality is not a principle of private property.<sup>80</sup> Later in their discussion, however, the authors refer to "[t]he right of property in its widest sense . . . embracing the right to an inviolate personality."<sup>81</sup>

After some initial hesitancy,<sup>82</sup> in 1979, the California courts chose to construe publicity as a personal right.<sup>83</sup> In *Lugosi v. Uni-*

---

<sup>77</sup> As the court explained in *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128, 1138 (7th Cir. 1985), *cert. denied*, 475 U.S. 1094 (1986), the celebrity must be able to control the place, time and number of his appearances, since "no celebrity sells his name or likeness for advertising purposes to all comers."

<sup>78</sup> Medieval English cases are replete with references to the "nature" of writs. See, e.g., *Bardolf v. Prioress of B.*, Y.B. 2 Edw. II, pl. 57 (1308-09), reprinted in 1 SELDEN SOCIETY YEAR BOOKS 115 (F.W. Maitland ed. 1903); Theodore F.T. Plucknett, A CONCISE HISTORY OF THE COMMON LAW 385 (5th ed. 1956). The real actions, which concerned rights in real property, were of a "higher" or "preferred" nature than were the personal actions, which concerned rights emanating from, *inter alia*, consensual transactions. Cf. S.F.C. MILSOM, THE HISTORICAL FOUNDATIONS OF THE COMMON LAW 287 (1981); S.F.C. MILSOM, LEGAL FRAMEWORK OF ENGLISH FEUDALISM 66-67 (1976).

<sup>79</sup> See *supra* notes 17-23 and accompanying text.

<sup>80</sup> Warren & Brandeis, *supra* note 18, at 205.

<sup>81</sup> *Id.* at 211. The property/personal right controversy has wreaked havoc upon both the descendibility of the right of publicity and the right's ability to survive federal pre-emption attacks. See *infra* notes 93-109 and 169-205 and accompanying text.

<sup>82</sup> In 1974 the Ninth Circuit determined that California courts would recognize an individual's interest in his own identity. *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974). The circuit court, however, dodged the question of whether such a recognition would be made "under the rubric of 'privacy,' 'property,' or 'publicity.'" *Id.* at 825-26 (citations omitted). For a discussion of the facts of *Motschenbacher*, see *supra* note 57.

<sup>83</sup> See also Bloustein, *supra* note 19 (early commentary arguing that publicity is a personal right).

*versal Pictures*,<sup>84</sup> the widow and surviving son of Bela Lugosi brought an action seeking to recover profits made by Universal on certain commercial licenses it executed to third parties for the use of the Count Dracula character. The court's majority opinion categorized the plaintiffs' complaint as one falling within the fourth of Prosser's privacy categories.<sup>85</sup> As a result of that categorization, the majority reasoned that the right claimed in this case was personal to Lugosi and therefore could not be asserted by his survivors.<sup>86</sup>

Chief Justice Bird strongly disagreed with the majority in this case. According to Justice Bird, the underlying issue of plaintiff's claim for damages was the economic windfall that Universal had reaped from the unauthorized commercial use of Lugosi's creative efforts. Such a use, Bird explained, "is intended to increase the value or sales of the product by fusing the celebrity's identity with the product and thereby siphoning some of the publicity value or goodwill in the celebrity's persona into the product."<sup>87</sup> Bird found the gravamen of the asserted harm to be the loss of potential financial gain—not mental anguish. Bird therefore concluded that the right of publicity is proprietary in nature.<sup>88</sup>

East Coast courts tended to agree with Chief Justice Bird's point of view.<sup>89</sup> In *Bi-Rite Enterprises v. Bruce Miner Poster*

<sup>84</sup> 603 P.2d 425 (Cal. 1979).

<sup>85</sup> For a discussion of Prosser's four categories, see *supra* notes 58-60 and accompanying text.

<sup>86</sup> According to the majority:

There is good reason for the rule. The very decision to exploit name and likeness is a personal one. It is not at all unlikely that Lugosi and others in his position did not during their respective lifetimes exercise their undoubted right to capitalize upon their personalities, and transfer the value thereof into some commercial venture, for reasons of taste or judgment or because the enterprise to be organized might be too demanding or simply because they did not want to be bothered.

*Lugosi*, 603 P.2d at 430.

<sup>87</sup> *Id.* at 438 (Bird, C.J., dissenting).

<sup>88</sup> In support of this conclusion, Bird cited, *inter alia*, to Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975).

<sup>89</sup> For early East Coast affirmations of publicity's proprietary nature, see *Price*, 400 F. Supp. at 844 (the federal court reasoned that the right of publicity is "purely commercial" in nature); *accord Price v. Worldvision Enters., Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd mem.*, 603 F.2d 214 (2d Cir. 1979); *cf. Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622, 396 N.Y.S.2d 661, 665 (2d Dep't 1977) (in upholding plaintiff's right of publicity claim, the court reasoned that the imitation "amount[ed] to a deception of the public.").

For early Midwest confirmations of the proprietary nature of the right of publicity, see *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), *aff'd*,

Co.,<sup>90</sup> the District Court for Massachusetts considered a complaint brought by three performing groups<sup>91</sup> and the manufacturers and distributors of pop music novelty merchandise who had obtained exclusive licenses to use the names of the groups. The plaintiffs alleged that the defendant had made and distributed unauthorized posters bearing the groups' names or likenesses. In issuing the requested injunction, the court explained that "[t]he right to control the use and exploitation of one's name and likeness through sale of merchandise is an extremely valuable asset to popular performers and groups."<sup>92</sup>

## 2. Survivability

Although some might still disagree, most jurisdictions now view publicity as a property right<sup>93</sup> with a clear value to the celebrity.<sup>94</sup> In the end, a definite resolution of this issue might not be important but for an increasing number of publicity actions brought by survivors of celebrities.<sup>95</sup> In order to determine whether these survivors had standing to sue, the courts were forced to determine whether the right of publicity was descendible and devisable, which, in turn, depended on whether the court considered publicity as personal or proprietary in nature.

The importance of the distinction in the context of survivor suits was well illustrated by the opposing opinions rendered by

---

810 F.2d 104 (6th Cir. 1987); *Uhlaender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970).

<sup>90</sup> 616 F. Supp. 71 (D. Mass. 1984), *aff'd*, 757 F.2d 440 (1st Cir. 1985).

<sup>91</sup> The named groups were Duran Duran, Judas Priest and Iron Maiden.

<sup>92</sup> *Bi-Rite Enters.*, 616 F. Supp. at 75. For a similar statement in *Factors I* referring to the value of Elvis Presley's name, see *supra* note 71 and accompanying text.

<sup>93</sup> See, e.g., *Price*, 400 F. Supp. at 836; *Uhlaender*, 316 F. Supp. at 1277; *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979); *Tennessee ex rel. Elvis Presley Int'l Memorial Found. v. Crowell*, 733 S.W.2d 89 (Tenn. Ct. App. 1987).

Indeed, legislation in several states expressly provides that the right of publicity is a property right. See, e.g., CAL. CIV. CODE § 990(b) (West 1990); KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984); NEV. REV. STAT. § 598.984 (1987); OKLA. STAT. tit. 12, § 1448B (1990); TENN. CODE ANN. § 47-25-1103(b) (1988).

For commentary urging the recognition of publicity as a property right, see, e.g., Gordon, *supra* note 47, at 605-7; Hoffman, *supra* note 1, at 5; Berkman, *supra* note 58, at 527.

<sup>94</sup> For examples of this value, see *supra* notes 11 and 12.

<sup>95</sup> See, e.g., *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317 (2d Cir. 1982); *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981); *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prod., Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981), *rev'd*, 694 F.2d 674 (11th Cir. 1983); *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977), *aff'd & remanded*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), *on remand*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd*, 652 F.2d 278 (2d Cir. 1981); *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1977); *Price*, 400 F. Supp. at 836; *Crowell*, 733 S.W.2d at 89; *Lugosi v. Universal Pictures*, 603 P.2d 425, (Cal. 1979).

the California Supreme Court in *Lugosi*.<sup>96</sup> The *Lugosi* majority was convinced that Bela Lugosi's right of publicity was protectable during his lifetime but terminated upon his death.<sup>97</sup> The majority believed that because the right of publicity is personal in nature such a result was unnecessary.<sup>98</sup>

Chief Justice Bird, on the other hand, insisted that Lugosi's right of publicity could be, and indeed was, passed on to his heirs. The right could descend to Lugosi's heirs because it was proprietary in nature.<sup>99</sup> Bird emphasized that to hold otherwise would be to permit the defendant to enjoy a windfall from the free use of Lugosi's persona, which Lugosi had labored to create during his life.<sup>100</sup> According to Bird, Lugosi's heirs, not Universal Pictures, should be the beneficiaries of that windfall.<sup>101</sup>

The pros and cons of survivability were then carefully explored by the Sixth Circuit in *Memphis Development Foundation v. Factors, Etc., Inc.*<sup>102</sup> This case was brought by a not-for-profit corporation that sought to prevent an inter vivos licensee of Elvis Presley's right of publicity from interfering with the distribution of Presley replica statues.<sup>103</sup> The court first acknowledged that

---

<sup>96</sup> *Lugosi*, 603 P.2d at 425. For a discussion of the facts of this case, see *supra* text accompanying notes 84-86.

<sup>97</sup> In support of this proposition, the majority cited, *inter alia*, to *Maritote v. Desilu Prods., Inc.*, 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965); *James v. Screen Gems, Inc.*, 344 P.2d 799 (Cal. App. 1959); *Schumann v. Loew's Inc.*, 135 N.Y.S.2d 361 (Sup. Ct. Spec. Term N.Y. County 1954). Note that all of these authorities chose to treat the unauthorized commercial use of the persona as an unlabeled sub-species of the right of privacy.

<sup>98</sup> See *supra* note 86 and accompanying text. Following the court's decision in *Lugosi*, the California legislature added a section to its civil code expressly providing for the survivability of a statutory right of publicity. See CAL. CIV. CODE § 3344 (West 1991).

Note further that in highlighting the voluntary aspect of the celebrity's decision to exploit his name and likeness, the *Lugosi* majority set the stage for the line of decisions that turn upon whether an individual had exercised his right of publicity before his death. See, e.g., *King*, 508 F. Supp. at 854; *Factors I*, 444 F. Supp. at 279. For a further discussion of this line of decisions see *infra* notes 110-27 and accompanying text.

<sup>99</sup> See *supra* notes 87-89 and accompanying text. As Bird explained in her dissent, "what is at issue is the *proprietary* interest in the value of one's name and likeness in commercial enterprises, not a personal right like the right of privacy." *Lugosi*, 603 P.2d at 445 (Bird, C.J., dissenting).

<sup>100</sup> See Berkman, *supra* note 58.

<sup>101</sup> *Lugosi*, 603 P.2d at 446-47. Bird further suggested that the right of publicity should last for the life of the person plus fifty years, in conformity with the duration of federal statutory copyrights. See 17 U.S.C. § 302(a) (1988). Although this analogy undoubtedly made sense at that time and within that context, the linking of the right of publicity to copyright law has ultimately been the cause of its current demise. See *infra* text accompanying notes 145-205.

<sup>102</sup> 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

<sup>103</sup> Shortly after the death of Elvis Presley, Memphis Development Foundation, a not-for-profit corporation, sought to honor the late singer by erecting a large bronze statue of him in downtown Memphis. In conjunction with this project, the foundation distributed eight-inch pewter replicas to donors to the project. The foundation brought suit

recognition of a post-mortem right of publicity would encourage creativity and would protect a valuable capital asset. It then noted, however, that the recognition of a post-mortem right would create a new set of practical problems, such as the duration and the taxability of the right and its relation to First Amendment principles. Furthermore, the court noted that the law had traditionally denied the survivability of "personal attributes" such as jobs, titles, or offices or of personal actions such as defamation. The court concluded that the nature of fame was too fortuitous and fleeting to survive the celebrity's death.<sup>104</sup>

As she had done earlier with the personal versus property right controversy,<sup>105</sup> Justice Bird likewise set forth what would ultimately be the majority view with regard to the descendibility of the right of publicity. The arguments in favor of the survivability of this right were forcefully presented in *Tennessee ex rel. Elvis Presley International Memorial Foundation v. Crowell*.<sup>106</sup> The *Crowell* court was convinced that the descendibility of the right of publicity would promote several important policies deeply ingrained in Tennessee jurisprudence. First, the court stressed that an individual's right to make a testamentary disposition permits him to dispose of, at death, those assets which he could have disposed of during his life. Second, the *Crowell* court argued, a basic tenet of our legal system is that " 'one may not reap where another has sown nor gather where another has strewn.' "<sup>107</sup> This principle of unjust enrichment should prevent an advertiser from availing himself of a windfall when he has no colorable claim to a celebrity's right of publicity. Third, the *Crowell* court found that recognizing the descendibility of the right of publicity

---

when Factors Etc., Inc., as the inter vivos licensee of Presley's publicity rights, attempted to interfere with the distribution of the replicas. *Id.* at 956-57.

<sup>104</sup> According to the court,

The intangible and shifting nature of fame and celebrity status, the presence of widespread public and press participation in its creation, the unusual psychic rewards and income that often flow from it during life and the fact that it may be created by bad as well as good conduct combine to create serious reservations about making fame the permanent right of a few individuals to the exclusion of the general public.

*Id.* at 959.

In 1981, when *Factors II* reached the Second Circuit for the second time, the court felt obliged under choice of law principles to follow the *Memphis Development* court's pronouncement against the descendibility of the right of publicity. *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981). As a result, the Second Circuit reversed the district court's initial decision in favor of Presley's heirs.

<sup>105</sup> See *supra* notes 87-88 and accompanying text.

<sup>106</sup> 733 S.W.2d 89 (Tenn. Ct. App. 1987).

<sup>107</sup> *Id.* at 98 (quoting *M.M. Newcomer Co. v. Newcomer's New Store*, 217 S.W. 822, 825 (Tenn. 1919)).

would be consistent with the celebrity's expectations that he has created a valuable capital asset during his life that will inure to the benefit of his heirs and assigns after his death.<sup>108</sup> The court believed that the creative investment made by the celebrity deserved as much recognition as other investments made by him, such as in stocks and other intangible assets. Fourth, the *Crowell* court maintained that recognizing the descendibility of the right of publicity would protect the contract rights of individuals who have acquired the right to use the celebrity's persona. Fifth, the court argued that such recognition would further the fight against deceptive advertising. Finally, the court declared that such recognition would help to prevent unfair competition caused by the use of deceptively similar corporate names.<sup>109</sup>

### 3. Exploitation by the Celebrity

Most jurisdictions now recognize the right of publicity as assignable *inter vivos*<sup>110</sup> and descendible and devisable *post-mortem*.<sup>111</sup> In some jurisdictions, however, one issue of survivability still remains in the path of free alienability of the

---

<sup>108</sup> For a similar argument, see Brian L. Smith, *Recent Developments, Torts—Right of Publicity—Descendibility of a Celebrity's Right to Benefit from Fame*, 47 TENN. L. REV. 886 (1980).

<sup>109</sup> *Crowell*, 733 S.W.2d at 98-99. The court further noted in a footnote that it did not need to address the question of *inter vivos* exploitation because Presley indisputably exploited his persona commercially during his lifetime. *Id.* at 99 n.11.

In 1984, the Tennessee legislature enacted a statute expressly providing for the survivability of the right of publicity, with or without *inter vivos* exploitation. See TENN. CODE ANN. § 47-25-1103(b) (1955-1990).

<sup>110</sup> See, e.g., *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y.), *supplemented*, 578 F. Supp. 59 (S.D.N.Y. 1983); *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982).

For statutory recognitions of the *inter vivos* assignability of the right of publicity, see, e.g., CAL. CIV. CODE § 990(b) (West Supp. 1991); FLA. STAT. ch. 540.08(1)(b) (1990); NEV. REV. STAT. § 598.986(1) (1989); OKLA. STAT. tit. 12, § 1448B (West Supp. 1991); TENN. CODE ANN. § 47-25-1103(b) (1988); VA. CODE ANN. § 8.01-40(A) (Michie 1984).

New York's legislature has also considered, but not yet adopted, a so-called "Celebrity Rights Act," which would create a freely transferable and descendible right of publicity. See Leonard M. Marks, *An End to Judicial Resistance Toward Vocal-Imitation Claims?*, NAT'L L.J., Feb. 20, 1989, at 20.

<sup>111</sup> See, e.g., *King*, 296 S.E.2d at 697. This court emphasized that the recognition of the survivability of the right of publicity would encourage creativity. Indeed, the court believed that a rule terminating the right with the celebrity's death would actually discourage creativity, particularly where the celebrity's death was untimely. Furthermore, the court maintained, the common law has traditionally recognized survivability, despite the legal problems that it may create.

For statutory recognitions of the survivability of the right of publicity, see, e.g., CAL. CIV. CODE § 990(b) (West 1991); FLA. STAT. ch. 540.08(1)(c) (1990); KY. REV. STAT. ANN. § 391.170(1) (Michie/Bobbs-Merrill 1984); NEV. REV. STAT. § 598.986(1) (1986-1989); OKLA. STAT. tit. 12, § 1448B (West 1990 & Supp. 1991); TENN. CODE ANN. § 47-25-

right of publicity. In *Guglielmi v. Spelling-Goldberg Productions*,<sup>112</sup> the court remarked that, unless an artist exploits his persona during his lifetime, that persona may be used after his death by anyone.

This dictum was then noted by the federal court in *Factors I*.<sup>113</sup> Yet, in permitting Presley's survivors to assert his right of publicity, the *Factors I* court believed that it was acting in harmony with the *Guglielmi* decision: Presley had, after all, widely exploited his persona throughout his performing career.<sup>114</sup>

The exploitation issue was not easily decided in the *King* case, which involved an action for damages and injunctive relief brought by the widow of Dr. Martin Luther King, Jr., against a manufacturer that was producing and distributing plastic statues of Dr. King.<sup>115</sup> The District Court for the Northern District of Georgia determined that Georgia law recognizes a person's property right in the commercial use of his identity during his lifetime. The court, however, maintained that the inter vivos recognition of this right did not automatically make it devisable. After reviewing authority from other jurisdictions, the court concluded that Georgia courts would require inter vivos exploitation in order for the right of publicity to survive. Although King did use his name and likeness to champion civil rights, he did not commercially exploit his right of publicity during his life.<sup>116</sup>

---

1103(b) (1988); TEX. PROP. CODE ANN. § 26.003(2) (West 1984 & Supp. 1991); VA. CODE § 8.01-40(A) (Michie 1950 & Supp. 1990).

For a commentary arguing in favor of the survivability of the right of publicity, see, e.g., Hoffman, *supra* note 1, at 26; Berkman, *supra* note 58.

<sup>112</sup> 603 P.2d 454 (Cal. 1979).

<sup>113</sup> 444 F. Supp. 279 (S.D.N.Y. 1977). For the facts of this case, see *supra* text accompanying notes 63-67.

<sup>114</sup> For a discussion of the Second Circuit's denial of the descendibility of the right of publicity in *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977), *aff'd & remanded*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), *on remand*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd*, 652 F.2d 278 (2d Cir. 1981), see *supra* note 104.

See also *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978). In that case, the court applied the *Factors I* exploitation requirement but found that Agatha Christie had exploited her name during her lifetime by assigning rights to her literary works to Agatha Christie, Ltd., and by bequeathing similar rights in her will.

<sup>115</sup> *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prods., Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981), *rev'd*, 694 F.2d 674 (11th Cir. 1983). Mrs. King sued as administratrix of Dr. King's estate. The Martin Luther King, Jr. Center for Social Change and Motown Record Corp. were also plaintiffs in the case.

<sup>116</sup> See also *Southeast Bank N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985). In that case, the New York Court of Appeals construed Florida's right of publicity statute to require a showing of exploitation when a post-mortem action is brought by someone other than the surviving spouse or children. See FLA. STAT. ANN. § 540.08(1)(c) (West 1988). The court dismissed a publicity-based action brought by the personal representative of Tennessee Williams because Williams had not issued a license during his lifetime and had died without a surviving spouse or children.

An opposite reading was ultimately reached when the Georgia Supreme Court heard certified questions from the *King* case.<sup>117</sup> The court saw no reason to limit post-mortem protection for the publicity rights to those celebrities who during their lives “contract for bubble gum cards, posters and tee shirts.”<sup>118</sup> Rather, the court maintained, an individual who avoids exploitation during his lifetime, for whatever reason, is no less entitled to have his image protected against exploitation after his death.<sup>119</sup>

Further debate (and resultant confusion) concerning the exploitation requirement occurred in *Groucho Marx Productions, Inc. v. Day & Night Co.*<sup>120</sup> The District Court for the Southern District of New York recognized the exploitation requirement set down by the lower court in *King*. The New York district court, however, chose to read the Georgia federal court’s decision in a light favorable to the celebrity. Thus, according to the *Marx* court, *King* simply required a showing of inter vivos claims demonstrating that the celebrity intended to capitalize on the commercial value of his persona.<sup>121</sup> Groucho Marx had clearly satisfied this

---

<sup>117</sup> 296 S.E.2d 697 (Ga. 1982). The Supreme Court received the following certified questions from the Eleventh Circuit, which had taken the case on appeal from the District Court for the Northern District of Florida:

(1) Is the “right of publicity” recognized in Georgia as a right distinct from the right of privacy?

(2) If the answer to question (1) is affirmative, does the “right to publicity” survive the death of its owner? Specifically, is the right inheritable and devisable?

(3) If the answer to question (2) is also affirmative, must the owner have commercially exploited the right before it can survive his death?

(4) Assuming the affirmative answers to questions (1), (2) and (3), what is the guideline to be followed in defining commercial exploitation and what are the evidentiary prerequisites to a showing of commercial exploitation?

*Id.* at 699.

<sup>118</sup> *Id.* at 706.

<sup>119</sup> As the court further explained, “Without doubt, Dr. King could have exploited his name and likeness during his lifetime. That this opportunity was not appealing to him does not mean that others have the right to use his name and likeness in ways he himself chose not to do.” *Id.*

The Eleventh Circuit remanded the case to the district court for further proceedings consistent with the Supreme Court’s directions. *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prods., Inc.*, 694 F.2d 674 (11th Cir. 1983).

<sup>120</sup> 523 F. Supp. 485 (S.D.N.Y. 1981), *rev’d*, 689 F.2d 317 (2d Cir. 1982).

<sup>121</sup> Good examples of such intent can be found in cases involving Joe Namath and Muhammad Ali, two former professional athletes who have enjoyed lucrative second careers as celebrity skills. In *Namath v. Sports Illustrated*, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1st Dep’t 1975), *aff’d*, 39 N.Y.2d 897, 352 N.E.2d 584, 386 N.Y.S.2d 397 (1976), football star Joe Namath brought privacy and publicity actions against the magazine *Sports Illustrated*, which had used a 1969 Super Bowl photograph of Namath in subscription advertisements. Namath alleged that “because he was in the business of endorsing products and selling the use of his name and likeness, it interfered with his . . . right of publicity.” *Id.* at 489, 371 N.Y.S.2d at 13.

See also *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (finding that Ali had

requirement by making an inter vivos transfer of his rights.<sup>122</sup>

The court's holding in *Marx* was later reversed by the Second Circuit, which felt compelled to apply California rather than New York law.<sup>123</sup> The Second Circuit was further convinced that the relevant California law was set forth in *Guglielmi v. Spelling-Goldberg Productions*<sup>124</sup> and *Lugosi v. Universal Pictures*.<sup>125</sup> The court believed that *Guglielmi* flatly denied the survivability of the right of publicity.<sup>126</sup> The Second Circuit further maintained that, even if the right does survive under California law, the facts of *Marx* did not satisfy the requirements for such survival as suggested in *Lugosi*. According to the *Marx* court, *Lugosi* held that the right of publicity cannot descend absent inter vivos exploitation. Furthermore, the *Marx* court reasoned, any right that would descend could extend no further than the parameters of use carved out by the celebrity during his lifetime. Thus, the *Marx* court concluded, since California law would only recognize a descendible right in connection with those particular products and services that the celebrity promoted during his lifetime, it would not recognize a descendible right of publicity to protect against an original play that uses the celebrity's likeness and comedic style.<sup>127</sup>

---

clearly established a valuable interest in his name and likeness through his various public and commercial exploits).

<sup>122</sup> The court also found it significant that Marx had devised his rights in his will.

<sup>123</sup> The district court had applied New York law because the defendant's offending conduct occurred in New York (law of the place of the wrong), or because the defendants were all New York residents, the play had its longest run in New York, and the Marx Brothers characters had all been originally created in New York (law of the place with the most significant contacts). *Marx*, 523 F. Supp. at 487 n.1. The Second Circuit, however, maintained that New York's property choice of law rules require an application of California law: the three Marx Brothers in question were California residents at the times of their deaths, the contractual exploitations of Groucho's and Chico's rights of publicity were executed in California, and Harpo's estate was probated in California. *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317, 319-20.

For an affirmation that the choice of law in right of publicity cases should be based upon property principles, see *Mathews v. ABC Television, Inc.*, No. 88 Civ. 6031 (S.D.N.Y. Sept. 11, 1989).

<sup>124</sup> 603 P.2d 454 (Cal. 1979).

<sup>125</sup> 603 P.2d 425 (Cal. 1979). For a summary of the facts of this case, see *supra* text accompanying notes 84-86.

<sup>126</sup> See *supra* text accompanying note 112.

<sup>127</sup> *Groucho Marx*, 689 F.2d at 323. See also *Lerman v. Chuckleberry Publishing, Inc.*, 521 F. Supp. 228 (S.D.N.Y. 1981). In that case, pop novelist Jackie Collins sued a magazine publisher and a distributor based upon an article that misidentified her in connection with certain nude photographs. The district court believed that exploitation is required even where the plaintiff is the celebrity herself and complains of an inter vivos appropriation of her persona. The district court was convinced, however, that Collins had sufficiently exploited her persona by permitting her name and likeness to appear on posters and novel jackets and by giving interviews connected with the marketing of her books and screenplays. The district court therefore granted Collins's motion for summary judgment on her publicity claim.

On appeal, however, the Second Circuit's Court of Appeals reversed the district

## 4. Duration

Despite the Second Circuit's holding in *Marx*, many jurisdictions seem to favor post-mortem alienability of the right of publicity, even without inter vivos exploitation.<sup>128</sup> Even where survivability of the right is the rule, however, one nagging question still remains: how long does the right survive? Early publicity cases generally did not consider this question, simply because they involved inter vivos claims brought by the celebrity holders themselves.<sup>129</sup> Privacy law provides no guidance here since the personal nature of the right of privacy requires that it terminate at the death of the holder.<sup>130</sup> Perhaps, because of this absence of authority, some courts have simply avoided the duration issue by determining the case before them on other grounds, such as requiring inter vivos exploitation.<sup>131</sup>

Several jurisdictions, however, have directly addressed the question through legislation. Following the lead of Chief Justice Bird, who in turn borrowed from copyright law,<sup>132</sup> the California legislature has declared that the duration of the right of publicity be the life of the celebrity plus fifty years.<sup>133</sup> Other jurisdictions,

---

court's grant of summary judgment. *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123 (2d Cir. 1984), *cert. denied*, 471 U.S. 1054 (1985). In a peculiar twist, the district court maintained that Collins had not sufficiently exploited her persona for the purpose of preventing the unauthorized commercial use of nude photographs of her. According to the court, "She has never exploited the value of her nude appearance and obviously cannot claim to have developed a property interest in the subject matter of this alleged infringement." *Id.* at 134.

*See also* *Nature's Way Prods., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp. 245 (D. Utah 1990) (Utah law requires inter vivos exploitation).

<sup>128</sup> For express statutory negation of the exploitation requirement, see, e.g., NEV. REV. STAT. § 598.984 (1986-1989); OKLA. STAT. tit. 12, § 1448H (1990). *But see* FLA. STAT. ANN. § 540.08(1)(c) (West 1990) (requiring inter vivos exploitation in the event that a post mortem suit is brought by someone other than the surviving spouse or surviving children).

<sup>129</sup> *See, e.g.*, *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953); *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973).

<sup>130</sup> *See, e.g.*, *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979). Note, however, that legislation in some states has now made a statutory right of privacy survivable. *See, e.g.*, OKLA. STAT. tit. 21, § 839.2 (1990).

<sup>131</sup> *See supra* notes 112-27 and accompanying text. *See, e.g.*, *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prods., Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981) (holding that Dr. King had failed to meet the exploitation requirement), *rev'd*, 694 F.2d 674 (11th Cir. 1983).

<sup>132</sup> *See supra* notes 99-101.

<sup>133</sup> *See* CAL. CIV. CODE § 990(g) (West Supp. 1991). Kentucky, Nevada, and Texas have also adopted this measure. *See* KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merill 1971-1989); NEV. REV. STAT. § 598.984(1) (1987); TEX. PROP. CODE ANN. § 26.012(d) (West 1989). A number of commentators have also come out in favor of extending the right of publicity to the life of the celebrity plus fifty years. *See, e.g.*, Peter L. Felcher & Edward L. Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?* 89 YALE L.J. 1125 (1979-80); David R. Ginsburg, Comment, *Transfer of the Right of*

however, have backed away from the copyright analogy in favor of a longer or shorter period of duration. For instance, Oklahoma has created a right that lasts for one hundred years after the death of the celebrity.<sup>134</sup> The Florida legislature, on the other hand, has declared the right of publicity to survive for life plus forty years.<sup>135</sup> Virginia has chosen life plus twenty years,<sup>136</sup> Tennessee has opted for life plus ten.<sup>137</sup> Despite the potential preemption problem caused by the use of the copyright analogy here,<sup>138</sup> California's choice of life plus fifty years is a reasonable compromise. Such a measure permits the celebrity's survivors to protect his persona for a reasonable period after his death, which is often when it has its greatest value.<sup>139</sup> Such a measure, however, does not encumber that persona past the collective memory of the viewing public, thus eventually allowing the more durable personae to pass into the public domain.<sup>140</sup>

The various jurisdictions have not, as yet, achieved total unanimity on either the basic nature or the survivability of the right of publicity. Most have, however, followed the notion that the right of publicity is proprietary in nature and therefore survives the celebrity's death for a reasonable period of time, so long as the celebrity in some way exploited his persona during his life-

---

*Publicity: Dracula's Progeny and Privacy's Stepchild*, 22 UCLA L. REV. 1103 (1975); Jeanne Ann McManus, Note, *Right of Publicity*, 14 SETON HALL L. REV. 190 (1983).

<sup>134</sup> OKLA. STAT. tit. 12, § 1448G (1990). At least one commentator has argued for a right of publicity of unlimited duration. See Berkman, *supra* note 58 at 549. According to that commentator, if unlimited duration is not acceptable, then the limitation should be set by reference to degrees of kinship or years elapsed after the celebrity's death. *Id.*

<sup>135</sup> FLA. STAT. ANN. § 540.08 (West 1990).

<sup>136</sup> VA. CODE ANN. § 8.01-40 (Michie 1984).

<sup>137</sup> TENN. CODE ANN. § 47-25-1104 (1988).

<sup>138</sup> See *infra* text accompanying notes 171-205.

<sup>139</sup> Proof of such value can be found in the incredible commercial value that currently attaches to the personas of Elvis Presley, Charlie Chaplin and Marilyn Monroe some years after their respective deaths. Monroe died on August 5, 1962. Richard Zoglin, *The Twinkle Hasn't Faded; TV Provides a Rare Glimpse of Marilyn Monroe's Last Film*, TIME, Dec. 17, 1990, at 96. Since her death, her estate has earned more money through international licensing agreements than Monroe earned during her entire Hollywood career. Emily Mitchell, *Golden Girl*, TIME, Aug. 13, 1990, at 65.

Chaplin, who created and portrayed the unforgettable character of "The Little Tramp," died on Christmas Day in 1977. One recent article, commenting on the enduring and enduring nature of Chaplin's legacy observed: "Yet the elfin figure with the grimy bowler hat, the threadbare suit, the bamboo cane and the tiny mustache left an indelible signature on comedy, one still deeply etched as the world marks the 100th anniversary of Chaplin's birth." Joseph L. Galloway et al., *Funny Man of the Century*, U.S. NEWS & WORLD REP., Apr. 24, 1989, at 16 (1989). In the years since Chaplin's death, "The Little Tramp" character has been featured in a wide variety of advertisements. During the 1980s, for example, IBM spent approximately \$40 million on a "Little Tramp" ad campaign that attempted to promote the ill-fated IBM PCjr. Deidre A. Depke, *Home Computers*, BUS. WK., Sept. 10, 1990, at 64, 65.

<sup>140</sup> Good examples of such durable personae are those of William Shakespeare and Henry VIII.

time.<sup>141</sup> The more “proprietary” and “transferable” the right of publicity becomes, however, the more it resembles the economic rights protected by federal copyright laws. The more the right of publicity resembles copyright, the more vulnerable it is to attack under principles of preemption.<sup>142</sup>

## B. *Preemption of the Right of Publicity*

### 1. Early Questions

During the first three decades that followed the birth of the right of publicity, most courts that even considered this right were either preoccupied with fleshing out its basic nature and scope<sup>143</sup> or with the manner in which publicity interfaces with the First Amendment.<sup>144</sup> Thus, little attention was paid to the relationship of this new right to the rights protected under the federal copyright scheme. A few courts did note in passing that the right of publicity bore some resemblance to copyright protection.<sup>145</sup> Yet even those courts that did recognize this similarity

---

<sup>141</sup> In the vast majority of post-mortem publicity cases, exploitation is not even an issue, since today most celebrities engage in some form of inter vivos exploitation at some point during their careers. *See, e.g.,* *Elvis Presley v. Int'l Memorial Found. v. Crowell*, 733 S.W.2d 89 (Tenn Ct. App. 1987).

<sup>142</sup> *See infra* text accompanying notes 171-205.

<sup>143</sup> *See supra* text accompanying notes 78-142.

<sup>144</sup> For a summary of the First Amendment exemption to the right of publicity, see *supra* note 76.

<sup>145</sup> *See, e.g.,* *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977); *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128 (7th Cir. 1985), *cert. denied*, 475 U.S. 1094 (1986); *Bi-Rite Enters., Inc. v. Button Master*, 578 F. Supp. 59 (S.D.N.Y.), *supplemented*, 578 F. Supp. 59 (S.D.N.Y. 1983). For similar analogies by commentators, see, e.g., *Felcher & Rubin, supra* note 133; Note, *Copyright and Right of Publicity: One Pea in Two Pods?* 71 GEO. L.J. 1567 (1983); *McManus, supra* note 133.

The right of publicity also bears a certain resemblance to the rights protected under the broad rubric of unfair competition which operates on both the federal and state levels. Federally, it operates through § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1988). The Lanham Act is designed to protect “consumers and competitors from a wide variety of misrepresentations of products and services in commerce.” *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (quoting *CBS, Inc. v. Springboard Int'l Records*, 429 F.Supp. 563, 566 (S.D.N.Y. 1976)). The Lanham Act thus embraces a wide variety of activities.

The sweeping law of unfair competition is likewise protected on a state level. Some states, such as California and Illinois, have enacted statutes to cover certain aspects of such competition. *See* CAL. BUS. & PROF. CODE §§ 3369, 17200-500; ILL. REV. STAT. ch. 121-1/2, ¶¶ 311-317 (Supp. 1991). These states generally recognize the traditional common law claims as well. *See, e.g.,* *Nash v. CBS, Inc.*, 704 F. Supp. 823 (N.D. Ill. 1989), *aff'd*, 899 F.2d 1537 (7th Cir. 1990). Other states, such as New York and Michigan, have continued to protect against such activity solely through the traditional common law causes of action. *See, e.g.,* *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987); *Universal City Studios, Inc. v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468 (S.D.N.Y. 1986).

At both federal and state levels, the law of unfair competition includes the traditional cause of action for the infringement of a trademark or a trade name. Trademarks and trade names are “‘not property in the ordinary sense,’ but only a word or symbol

seemed oblivious to the possibility that the federal scheme might

---

indicating the origin or source of a product." *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581 (2d Cir. 1990) (citation omitted). They are thus merchandising shortcuts intended to increase the sale of products or services. *Allen*, 610 F. Supp. at 612. Such marks or names exist solely as "a right appurtenant to an established business or trade in connection with which [they are] employed." *Pirone*, 894 F.2d at 581 (citation omitted).

A celebrity can acquire a trademark or trade name in a name or a specific likeness if he uses the name or likeness to promote goods or services. *Id.* at 583; *Allen*, 610 F. Supp. at 622; *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1355 (D.N.J. 1981). As owner of such a mark or name, the celebrity has a right to prevent his goods or services from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks or names. *Pirone*, 894 F.2d at 581.

Unfair competition protection under federal and state statutory and common law extends beyond trademark and trade name infringement to include any violation of a right arising from the operation of a business. *Presley*, 513 F. Supp. at 1365. Thus, the law of unfair competition includes such traditional common law torts as "palming" or "passing off" and misappropriation. Under palming or passing off, a celebrity can recover against a competitor who passes off the celebrity's products as the competitor's own. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Ippolito v. Ono-Lennon*, 150 A.D.2d 300, 542 N.Y.S.2d 3 (1st Dep't 1989). Misappropriation in the context of unfair competition tends to be very broad, providing the celebrity relief from such unauthorized use as the taking and use of the celebrity's property to compete against the celebrity. *Mayer v. Josiah Wedgwood & Sons*, 601 F. Supp. 1523 (S.D.N.Y. 1985). See also *Universal City Studios*, 634 F. Supp. at 1468 (court applies notion of misappropriation in a broad and flexible manner as the taking of one's property to compete with that of another). Misappropriation, however, is generally restricted to claims involving tangible products. See Randy Eder, *When Imitation is not the Sincerest Form of Flattery: The Search for a Standard for Performers' Rights*, 37 J. COPYRIGHT SOC'Y U.S.A. 407 (1990).

The various wrongs joined under the broad scope of unfair competition all require that in order to make a *prima facie* case on either the federal or the state level, the celebrity plaintiff must show that the defendant's actions created a "likelihood of confusion" in the marketplace concerning the origin of goods or services. *Allen*, 610 F. Supp. at 624. "Likelihood of confusion" is determined "through the eyes of the ordinary purchaser" by balancing a number of factors, including the similarity between the competing marks, names, products, or services; the intent of the competitor; the sophistication of the target market; and whether actual confusion occurred. *Carson*, 698 F.2d at 833 (citing *Frisch's Restaurants, Inc. v. Elby's Big Boy of Stevensville, Inc.*, 670 F.2d 642 (6th Cir. 1982)); *Presley*, 513 F. Supp. at 1365-66.

Both the right of publicity and unfair competition thus share the laudable goal of preventing a competitor from making an unauthorized use of a celebrity's persona. It is not surprising then, that many cases alleging a violation of the right of publicity also allege some form of unfair competition. See, e.g., *Pirone*, 894 F.2d at 579; *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Carson*, 698 F.2d at 831; *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634 (9th Cir. 1982), *cert. denied*, 462 U.S. 1120 (1983); *Brockum Co. v. Blaylock*, 729 F. Supp. 438 (E.D. Pa. 1990); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987); *Allen*, 610 F. Supp. at 612; *Eagle's Eye, Inc. v. Ambler Fashion Shop, Inc.*, 627 F. Supp. 856 (E.D. Pa. 1985); *Bi-Rite Enters.*, 555 F. Supp. at 1188; *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201 (N.D. Ill. 1981), *aff'd in part and rev'd in part*, *Winterland Concessions Co. v. Trela*, 735 F.2d 257 (7th Cir. 1984), *aff'd mem.*, *Winterland Concessions Co. v. Sileo*, 830 F.2d 195 (7th Cir. 1987); *Presley*, 513 F. Supp. at 1339; *Memphis Dev. Found. v. Factors Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd on other grounds*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980); *Ippolito*, 150 A.D.2d at 300; *Apple Corps Ltd. v. Adirondack Group*, 124 Misc. 2d 351, 476 N.Y.S.2d 716 (Sup. Ct. Spec. Term 1983); *Hogan v. A.S. Barnes & Co.*, 114 U.S.P.Q. (BNA) 314 (Pa. C.P. Phila. County 1957); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979).

The right of publicity and unfair competition differ markedly, however, with regard

preempt the state common law right of publicity.<sup>146</sup>

The issue of preemption was raised in various publicity cases during this time period.<sup>147</sup> In *Price v. Hal Roach Studios, Inc.*,<sup>148</sup> the defendant studio claimed, *inter alia*, that the widows of Stan Laurel and Oliver Hardy did not state a cause of action because their claim, based upon a violation of the right of publicity, was preempted under the Federal Copyright Act.<sup>149</sup> The District Court for the Southern District of New York rejected this defense on the ground that the right of publicity in no way conflicts with the federal claim.<sup>150</sup>

The issue of preemption resurfaced a few years later in Chief Justice Bird's forceful dissent in *Lugosi v. Universal Pictures*.<sup>151</sup> The defendant studio in that case also raised preemption as a defense to the publicity action brought by the widow and son of Bela Lugosi. Bird, however, argued that the intangible property interest protected by the right of publicity does not constitute a writing within the meaning of the Federal Copyright Act. As Bird explained it, the publicity value generated by an individual's crea-

---

to who is the intended prime beneficiary. While the right of publicity is designed to protect the celebrity, unfair competition protects the consuming public. Since the right of publicity does not focus on consumer protection, it provides an important avenue for the celebrity whose persona has been pirated but who cannot or does not wish to allege any confusion in the marketplace. *Carson*, 698 F.2d at 831; *Rosenfeld v. W.B. Saunders*, 728 F. Supp. 236 (S.D.N.Y.), *aff'd mem.*, 923 F.2d 845 (2d Cir. 1990); *Bi-Rite Enters.*, 555 F. Supp. at 1188. *See also* Melville Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 210-214 (1954) (even where courts allow recovery when plaintiff is not in direct competition with defendant, requirement that defendant is passing off goods as that of another must be met); *cf.* Richard Ausness, *The Right of Publicity: A "Haystack in a Hurricane,"* 55 TEMP. L.Q. 977, 987 (1982) (performance and recognition values considered assignable property interests). It would therefore be unfair to the celebrity to require that the "likelihood of confusion" standard be met in all right of publicity cases, as one commentator recently noted. *See Pesce, supra* note 8, at 782. Indeed, this approach may also seem unwise, since courts have begun to subject state unfair competition cases to preemption under the federal Copyright Act. *See infra* note 195.

<sup>146</sup> *See, e.g., Zacchini*, 433 U.S. at 562; *Douglass*, 769 F.2d at 1128; *Bi-Rite Enters.*, 578 F. Supp. at 59.

<sup>147</sup> *See, e.g., Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1985). (The court considered whether a claim of unfair competition, concerning the unauthorized commercial use of the plaintiff's persona, would be preempted by §§ 50 and 51 of the New York Civil Rights Law. The court decided that such a cause of action would not be preempted, since unfair competition deals with property rights, while privacy deals with personal rights.) For a discussion of the facts of this case, *see supra* note 57.

<sup>148</sup> 400 F. Supp. 836 (S.D.N.Y. 1975). For the facts of this case, *see supra* note 55.

<sup>149</sup> In support of this proposition, the defendant cited, *inter alia*, to *Goldstein v. California*, 412 U.S. 546, *reh'g denied*, 414 U.S. 883 (1973). In that case, the Supreme Court upheld the California phonograph copyright act against a preemption challenge. The *Price* court ultimately relied upon *Goldstein* in its finding that the right of publicity is not preempted by federal copyright law. *See infra* note 153.

<sup>150</sup> In support of this proposition, the court likewise cited to *Goldstein*, 412 U.S. at 546.

<sup>151</sup> 603 P.2d 425 (Cal. 1979). For a summary of the facts of this case, *see supra* text accompanying note 85.

tive efforts is not comprised in a "physical rendering."<sup>152</sup> Since federal law does not preclude a state from protecting an uncopyrighted performance, Bird reasoned that federal law cannot preclude state protection of a person's right of publicity.<sup>153</sup>

## 2. State Statutory Preemption

During the next few years preemption played a very small part in court analysis of the right of publicity. In fact, in the early- to mid-1980s, the New York courts were the only courts that focused on preemption.<sup>154</sup> These courts considered preemption on a state rather than federal level. When the right of publicity was first identified in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,<sup>155</sup> the court carefully defined it as being "in addition to and independent of"<sup>156</sup> New York's statutory right of privacy.<sup>157</sup> During the next several decades, New York courts and courts applying New York law uniformly agreed with the pronouncement in *Haelan*.<sup>158</sup>

The courts, however, began to rethink this position by the early 1980s.<sup>159</sup> The question of preemption on the state statutory level was carefully explored by the New York Court of Appeals in the 1984 case of *Stephano v. News Group Publications, Inc.*<sup>160</sup>

In *Stephano*, a professional model claimed that an unauthorized use of his photograph constituted both an invasion of his

---

<sup>152</sup> *Lugosi*, 603 P.2d at 448 (Bird, C.J., dissenting).

<sup>153</sup> Bird further noted that by recognizing the widow's and son's succession to Lugosi's right of publicity, Universal's copyright in the *Dracula* film would not be interfered with, since Universal only bargained for and was only granted the limited right to employ Lugosi to portray Count Dracula in the production of one film.

<sup>154</sup> In contrast, most West Coast courts ignored both federal and state preemption law. See, e.g., *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527 (9th Cir. 1984). (Plaintiff's complaint included claims based on federal copyright, state statutory privacy, common law privacy, and publicity. The *Brewer* court entertained all of the plaintiff's claims without even mentioning the issue of preemption.)

<sup>155</sup> 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). For a summary of the facts of this case, see *supra* text accompanying notes 50-51.

<sup>156</sup> *Haelan*, 202 F.2d at 868.

<sup>157</sup> N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1990).

<sup>158</sup> See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *on remand*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981).

<sup>159</sup> See, e.g., *Frosch v. Grosset & Dunlap, Inc.*, 75 A.D.2d 768, 427 N.Y.S.2d 828, 829 (1st Dep't 1980) (noting that the common law right of publicity had not been recognized by the New York courts). See also *Wojtowicz v. Delacorte Press*, 43 N.Y.2d 858, 374 N.E.2d 129, 403 N.Y.S.2d 218 (1978) (no independent right to relief from unreasonable publicity exists in New York, except under sections of New York Civil Rights Law); *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254 (Sup. Ct. Spec. Term 1984), *aff'd mem.*, 110 A.D. 2d 1095 (1st Dep't. 1985) (New York Civil Rights Law protects an individual's persona from misappropriation by another for commercial gain).

<sup>160</sup> 64 N.Y.2d 174, 474 N.E.2d 580, 485 N.Y.S.2d 220 (1984).

statutory right of privacy and a violation of his common law right of publicity. Regarding plaintiff's statutory right of privacy, the court acknowledged the "intrusion into seclusion" and "mental distress" origins of sections fifty and fifty-one, but also noted that the statute had recently been extended to cases in which the plaintiff had generally sought publicity but did not consent to a particular use.<sup>161</sup> The court reasoned that because the right vindicated in such an action could be described as a right of publicity, the statute and the common law overlapped in that respect. Thus, in the face of such an overlap, the exclusive remedy of the privacy statute must preempt the independent common law right of publicity.<sup>162</sup>

The opposite point of view was recently taken in *Nature's Way*

---

<sup>161</sup> *Id.* at 183. In support of this statement, the court cited to *Welch v. Mr. Christmas, Inc.*, 57 N.Y.2d 143, 440 N.E.2d 1317, 454 N.Y.S.2d 971 (1982).

<sup>162</sup> The *Stephano* decision was subsequently followed by New York's Southern District in *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985). According to the *Allen* court, pre-*Stephano* cases had identified only one element that distinguishes publicity from privacy: publicity requires that the plaintiff cultivated a valuable property interest in his public persona. The *Allen* court did not believe, however, that this distinction should prevent privacy and publicity from being treated together under the general rubric of privacy. In *Pirone v. MacMillan Inc.*, 894 F.2d 579 (2d Cir. 1990) and *James v. Delilah Films, Inc.*, 144 Misc. 2d 374, 544 N.Y.S.2d 447 (Sup. Ct. 1989), the Second Circuit and New York Supreme Court respectively affirmed that no independent common law right of publicity exists in New York; accord *Rosenfeld v. W.B. Saunders*, 728 F. Supp. 236 (S.D.N.Y. 1990), *aff'd mem.*, 923 F.2d 845 (2d Cir. 1990). The *James* court was reluctant to recognize an independent common law right of publicity when there was legislation pending that would create a statutory right of publicity. This legislation has yet to be enacted. See *Ippolito v. Ono-Lennon*, 139 Misc. 2d 230, 238, 526 N.Y.S.2d 877 (Sup. Ct. N.Y. County 1988) (New York Supreme Court citing *Stephano* for the proposition that the New York Privacy Act "creates a 'right of privacy' and a 'right of publicity.'"), *modified*, 150 A.D.2d 300, 542 N.Y.S.2d 3 (1st Dep't 1989). *Id.* at 238. Cf. *Mathews v. ABC Television, Inc.*, No. 88 Civ. 6031 (SWK) (S.D.N.Y. Sept. 11, 1990).

During the 1980s, however, the opposite conclusion was reached by California state and federal courts regarding the state statutory/state common law issue. In *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983), Clint Eastwood sued the *National Enquirer*, which had published an unflattering article and photographs about Eastwood's love life. Eastwood based his claim, *inter alia*, on both the common law right of publicity and California's statutory remedy for the unauthorized commercial use of the persona. The California Court of Appeals recognized Eastwood's right to maintain a common law publicity claim even in the face of the statutory remedy. As that court explained, the statute compliments rather than replaces the common law remedy.

Several years later, in *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), the Ninth Circuit heard a claim brought by Bette Midler against Ford Motor Company and its advertising agency, Young & Rubicam, for using a Midler sound-alike in a television commercial. The defendants had originally sought to engage Midler herself to perform in the commercial. When Midler refused, however, the defendants went to one of her former back-up singers, and told her to "sound as much as possible like . . . Bette Midler." *Id.* at 461. For a discussion of the Ninth Circuit's analysis of preemption in the *Midler* case, see *infra* text accompanying notes 196-99. The court recognized Midler's state common law publicity claim, although California provided a statutory right of privacy. See also *Genesis Publications, Inc. v. Goss*, 437 So. 2d 169 (1983) (permitting a plaintiff to sue for common law invasion of privacy despite a state statute that embodied the right of privacy), *reh'g. denied*, 449 So. 2d 264 (Fla. Dist. Ct. App. 1984).

*Products, Inc. v. Nature-Pharma, Inc.*<sup>163</sup> In that case, a natural herbs distributor sued a competitor alleging that his common law right of publicity had been violated. The defendant responded by claiming that the plaintiff's common law claim was preempted by Utah's privacy statute.<sup>164</sup> The court concluded that the Act, which specifically stated that it did not "limit or supersede any causes of action[,]," did not preclude plaintiff's common law publicity claim.<sup>165</sup>

State statutory preemption of the common law right of publicity has a certain appeal.<sup>166</sup> A clear, concise statement by the state legislature can dispel the uncertainty that continues to cloud the common law right of publicity.<sup>167</sup> Thus, preemption on a state level may actually improve the effectiveness of the right of publicity.<sup>168</sup>

### 3. Federal Preemption

Preemption on the federal level, compared to state preemption, presents a serious impediment to the continued viability of the right of publicity. Until the mid 1980s, very little attention was paid to this issue.<sup>169</sup> Yet, since the courts were focusing their application of the right of publicity in terms of proprietary or economic protection, it was only a matter of time before some court identified the potential conflict between the state and federal schemes.<sup>170</sup> The question of federal preemption was soon confronted in the 1986 case, *Baltimore Orioles Inc., v. Major League*

---

<sup>163</sup> 736 F. Supp. 245 (D. Utah 1990).

<sup>164</sup> See UTAH CODE ANN. § 45-3-1 to -6 (1988).

<sup>165</sup> See *Nature's Way*, 736 F. Supp. at 251 (quoting UTAH CODE ANN. § 45-3-6).

<sup>166</sup> Note, however, that statutes in some jurisdictions expressly preserve common law remedies. See OKLA. STAT. tit. 12, § 1448M (1990); UTAH CODE ANN. § 45-3-6.

<sup>167</sup> See *supra* text accompanying notes 78-142.

<sup>168</sup> This will certainly be true if states such as New York manage to enact an express, descendible statutory right of publicity.

<sup>169</sup> See, e.g., *Maheu v. CBS, Inc.*, 247 Cal. Rptr. 304 (Cal. Ct. App. 1988), where the court expressly found plaintiff's claims in conversion and "conversion-constructive trust" to be preempted by federal copyright law, but did not even consider applying the preemption analysis to plaintiff's claim for "commercial appropriation of the right of publicity." *But see Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987), where the dissenting judge cautioned that "the right to publicity may be subject to federal preemption where it conflicts with the provisions of the Copyright Act of 1976." *Id.* at 839-40 (Kennedy, J., dissenting). See also *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d at 278, 238 n.8 (2d Cir. 1981), where the court declined to address the possibility of preemption under the federal copyright scheme.

<sup>170</sup> See, e.g., *Ann-Margret v. High Soc'y Magazine, Inc.*, 498 F. Supp. 401, 407 n.14 (S.D.N.Y. 1980). In that case, the district court raised the question of federal preemption of New York's common law right of publicity. The court, however, declined to decide that issue.

*Baseball Players Ass'n.*<sup>171</sup> That case involved a long-standing dispute between major league baseball players and their clubs over the allocation of revenues derived from telecasts of ball games.<sup>172</sup> The Seventh Circuit first determined that the clubs owned the copyright to the telecasts. The court then proceeded to find the players' right of publicity preempted by that copyright.

In deciding the preemption question, the Seventh Circuit first turned to § 301(a) of the Copyright Act, which provides for the preemption of all equivalent claims concerning works that are fixed in a tangible form and that come within the subject matter of the Copyright Act.<sup>173</sup> The court then applied a two-pronged test. The first prong of the test concerned the status and subject matter of the claim, determined by sections 101<sup>174</sup> and 102<sup>175</sup> of the Copyright Act. The court considered the telecasts to be the

<sup>171</sup> 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987).

<sup>172</sup> *Id.* at 665-66. For many years, players and clubs negotiated the allocation of these revenues. In May 1982, the Major League Baseball Players Association, representing the players, notified the clubs and television and cable companies that the telecasts were being made without the players' permission, which constituted a misappropriation of the players' property rights in their performances. On June 14, 1982, the clubs filed suit in federal court seeking a declaratory judgment that the clubs possessed the exclusive rights to the telecasts. The district court granted the clubs' motion for summary judgment on the clubs' copyright and master-servant claims and an appeal followed.

<sup>173</sup> Section 301 provides, in relevant part:

(a) [A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in 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 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

17 U.S.C. § 301(a) (1988).

<sup>174</sup> Under § 101 of the Copyright Act, "[a] work is 'fixed' in a tangible medium of expression when its embodiment in a copy . . . by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101.

<sup>175</sup> Section 102 provides, in relevant part:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

17 U.S.C. § 102 (1988) (as amended Dec. 1, 1990, P.L. 101-650, Title VII, § 703, 104 Stat. 5133).

subject matter of the claim<sup>176</sup> which were clearly fixed in a tangible form. Thus, the court reasoned, the first prong of the preemption test was satisfied.

The court then turned to the second prong of its preemption test, which concerned the equivalency of the right claimed. According to the Seventh Circuit, a state law right is equivalent to copyright if it is violated by the exercise of any of the rights enumerated in section 106 of the Copyright Act,<sup>177</sup> including the right to "perform" a copyrighted work.<sup>178</sup> The *Baltimore Orioles* court declared that the right to perform an audiovisual work also included the right to broadcast it. Therefore, the state-law "right to broadcast" was "equivalent" to the right to perform enumerated in section 106. Since the players' publicity claim was based on this "right to broadcast,"<sup>179</sup> the court held that the players' right of publicity was preempted.

The *Baltimore Orioles* two-pronged test met with some measure of approval.<sup>180</sup> In *Motown Record Corp. v. George A. Hormel &*

---

<sup>176</sup> *Baltimore Orioles*, 805 F.2d at 674-76. The players claimed that the true subject matter of the claim was the players' performances, which were incapable of being fixed. The court, however, found that the players' performances were fixed under § 101 because the "performances [were] embodied in a copy, viz, the videotape of the telecast, from which the performances [could] be perceived." *Id.* at 675.

The court also rejected the players' claim that their performances were not copyrightable works as defined by § 301(a) because the performances lack sufficient creativity. The court reiterated that the subject matter of the claim was the telecasts, not the performances captured in those videos.

<sup>177</sup> Section 106 provides:

[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

17 U.S.C. § 106.

<sup>178</sup> In the case of an audiovisual work, "[t]o 'perform' a work means to . . . show its images in any sequence. *Id.* § 101.

<sup>179</sup> *Baltimore Orioles*, 805 F.2d at 677. The court noted the players' claim that the right of publicity and copyright serve two separate interests. According to the players, publicity protects an individual's pecuniary interests, while federal copyright secures a benefit to the public. *Id.* at 677-78. The Seventh Circuit, however, maintained that the purpose of both publicity and copyright is to promote performances that appeal to the public through economic incentives. *Id.* at 678.

<sup>180</sup> See, e.g., David E. Shipley, *Three Strikes and They're Out at the Old Ball Game: Preemption of Performers' Rights of Publicity Under the Copyright Act of 1976*, 20 ARIZ. ST. L.J. 369 (1988).

Co.,<sup>181</sup> a food manufacturer and its advertising agency created a beef stew commercial that featured a Supremes-like rendition of "Dinty Moore, My Dinty Moore," sung to the tune of "Baby Love." The plaintiffs, who owned the copyright to "Baby Love," alleged, *inter alia*, that the commercial amounted to unfair competition in the form of passing off,<sup>182</sup> and therefore violated the California Privacy Act.<sup>183</sup> The court applied the two-pronged test under § 301(a), which requires preemption of a state right that is (1) "within the subject matter of copyright," and (2) "equivalent" to any exclusive rights of a federal copyright."<sup>184</sup> The court then determined plaintiff's claim satisfied the first prong of the test, since the subject matter was the composition "Baby Love."

The court then proceeded to the more difficult question of whether the action was brought to vindicate rights equivalent to those encompassed in the federal scheme. To answer this question, the court cited Nimmer's famous treatise on copyright law, which found that a state claim is subject to preemption under the equivalency requirement if it "is infringed by the mere act of reproduction, performance, distribution or display."<sup>185</sup> A state claim, however, will not be preempted if it includes other elements that add to or are distinguished from the rights enumerated above.<sup>186</sup> The *Motown* court further refined this principle by stating that the additional element must be such as to make the cause "qualitatively different from a copyright infringement claim."<sup>187</sup> The court then proceeded to examine both the pass-

---

<sup>181</sup> 657 F. Supp. 1236 (C.D. Cal. 1987).

<sup>182</sup> The complaint alleged that the defendants "falsely impl[ied] that the Composition and said image of the Supremes were utilized with the permission of Motown and Jobete." *Id.* at 1239.

<sup>183</sup> CAL. CIV. CODE § 3344 (West 1991). The complaint alleged copyright infringement, trademark infringement, seven pendent state claims, and a claim for declaratory relief. *Motown*, 657 F. Supp. at 1237.

<sup>184</sup> *Motown*, 657 F. Supp. at 1238. In restating this test, the court lamented over the fact that Congress had ultimately chosen to delete from § 301 a list of state claims that would not be preempted. These claims included "rights against misappropriation not equivalent to any such exclusive rights, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation." S. 22, 94th Cong., 2d Sess. § 301(b)(3) (1976). The *Motown* court complained that "[t]he above list, however, was excluded . . . without a satisfactory explanation." *Motown*, 657 F. Supp. at 1239. As a result, the court stated, courts are left to grapple with the question of which state causes of action are equivalent to rights covered by the federal statutory scheme. *Id.*

<sup>185</sup> 1 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1], at 1-13.

<sup>186</sup> *Id.* at 1-14.

<sup>187</sup> *Motown*, 657 F. Supp. at 1239 (quoting *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523 (S.D.N.Y. 1985)).

ing off and the privacy claims brought by the plaintiffs in this case. According to the court, since the essence of the plaintiffs' claim was the unauthorized use of a copyrighted work, both the unfair competition and privacy claims were preempted.<sup>188</sup>

A similar application of the *Baltimore Orioles* two-pronged test approach was made by an Illinois court in *Nash v. CBS, Inc.*<sup>189</sup> In that case, the author of a book about the infamous criminal John Dillinger charged the producers of a television program based on Dillinger's story with unfair trade practices<sup>190</sup> and misappropriation. Initially, the court considered the first prong of the preemption test and found the subject matter of the plaintiff's claim to be his copyrighted book. The court then considered whether any additional elements in the plaintiff's claim saved it from preemption. The plaintiff alleged that the additional element of "likelihood of confusion"<sup>191</sup> saved his deceptive trade practices claim. The court agreed that the "confusion element" was additional, but continued its inquiry into whether the difference was qualitative. In its analysis, the court followed the decision in *Baltimore Orioles* and "compare[d] the goal of the state law with the purpose of the [federal] Copyright Act."<sup>192</sup> The court found "that the UDTPA [Deceptive Trade Practices Act] seeks both to prevent unfair competition between suppliers and to protect consumers in the marketplace." On the other hand, the main purpose of the Copyright Act, is to secure an author's intellectual property rights.<sup>193</sup> Thus, under the *Nash* court's analysis, because deceptive trade practice law directly protects consumers, it is qualitatively different from copyright law and is not preempted.<sup>194</sup>

The *Nash* court, however, took a different view of the common law tort of misappropriation. It held that both copyright

---

<sup>188</sup> The court did note, however, that the statutory privacy claim may not be federally preempted in all cases. *Id.* at 1240. Because the plaintiffs did not allege a right of publicity claim, the *Motown* court did not actually consider preemption of that right. The court's heavy-handed application of Nimmer's test, however, questions the continued viability of the right of publicity. This is ironic in light of Nimmer's earlier support of the right of publicity. Nimmer, *The Right of Publicity*, *supra* note 145, at 203.

<sup>189</sup> 704 F. Supp. 823 (N.D. Ill. 1989), *aff'd*, 899 F.2d 1537 (7th Cir. 1990). Note that the *Baltimore Orioles* case was decided by the Seventh Circuit, which includes Illinois. Therefore, it is not surprising that the *Nash* court closely followed the dictates of *Baltimore Orioles*.

<sup>190</sup> *Id.* at 932. The plaintiff brought this claim under the Uniform Deceptive Trade Practices Act, which Illinois had adopted. See ILL. REV. STAT. ch. 121-1/2, ¶¶ 311-317 (1991).

<sup>191</sup> ILL. REV. STAT. ch. 121-1/2, ¶ 312, § 2(3) (Smith-Hurd 1960 & Supp. 1991).

<sup>192</sup> *Nash*, 704 F. Supp. at 833.

<sup>193</sup> *Id.*

<sup>194</sup> The court noted, however, that case law is unclear on this point. *Id.*

and misappropriation employ similar means to achieve their ultimate goals. Both attempt to balance the need to provide economic incentives for authors, against the preservation of the right to imitate. After considering the House Judiciary Committee Report on the 1976 amendments to the Copyright Act, the court held that "all misappropriation claims, except those cited in the House Report, are preempted."<sup>195</sup> State-law claims, it seemed, were not surviving federal preemption.

In *Midler v. Ford Motor Co.*,<sup>196</sup> a different conclusion was reached by the Ninth Circuit when it considered the issue of preemption in the context of a publicity action. The court held that Midler's publicity claim was not preempted by the federal statute because the first prong of the preemption test was not satisfied. According to the court, Midler's claim was not based upon the use of a song she recorded entitled "Do You Want to Dance," but rather upon the defendants' imitation of her voice.<sup>197</sup> Her

---

<sup>195</sup> *Id.* at 835. Allegations of "commercial immorality" may not be enough to save a misappropriation claim from preemption under the Federal Copyright Act. *Mayer v. Josiah Wedgwood & Sons*, 601 F. Supp. 1523 (S.D.N.Y. 1985). See also *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971), where a California federal court noted that other forms of unfair competition might also conflict with federal copyright laws.

The *Nash* court noted that Congress did not intend the Copyright Act to preempt all misappropriation claims. H.R. REP. NO. 1476, 94th Cong., 2d Sess. (1976) *codified at* 17 U.S.C. § 301. Rather, the court acknowledged that claims involving "the 'systematic' appropriation of 'hot news' or valuable stored information" would still be actionable under state law. *Nash*, 704 F. Supp. at 835.

<sup>196</sup> 849 F.2d 460 (9th Cir. 1988). In 1985, Young & Rubicam, an advertising agency for Ford Motor Co., paid \$45,000 for the rights to "Do You Want to Dance," a song that had been featured on Bette Midler's 1973 record album, "The Divine Miss M." Harold W. Suckenick, *Midler Case Teaches PR Image Lesson*, O'DWYER'S PR SERVICES, March 1990, at 40. Ford subsequently used this song in its "Yuppie Campaign," which was composed of advertisements featuring songs of the seventies. Young & Rubicam asked Midler, through her manager, Jerry Edelstein, to sing in the ad; Edelstein refused. The agency then contracted with a backup singer who had toured with Midler for ten years and instructed her to "'sound as much as possible like the Bette Midler record.'" *Midler*, 849 F.2d at 461. After the commercial began to air, Midler sued both Young & Rubicam and Ford for \$10 million in damages, alleging that they had violated her right of publicity. Neil L. Shapiro & Karl Olson, *Encore Performances: 'Do You Want to Sue?'* *Climbs the Charts*, LEGAL TIMES, Jan. 15, 1990, at 27.

<sup>197</sup> The court noted that a different result would have been reached if Midler's claim was based upon the copying of the song or upon a secondary meaning that she had achieved with her rendition of it. In support of this conclusion, the court distinguished Midler's claim from that of Nancy Sinatra in *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971). In that case, Nancy Sinatra sued Goodyear and Young & Rubicam (the same agency sued in *Midler*) for unfair competition in connection with an advertising campaign that the defendants had run. The campaign featured performers, who looked and sounded like Sinatra, singing "These Boots Are Made for Walking." Sinatra sued for money damages, claiming a secondary meaning in her well-known rendition of that song. *Id.* at 713. The Ninth Circuit, however, found that her unfair competition claim conflicted with the federal copyright scheme. To hold otherwise, the court explained, would be to allow the plaintiff to recover damages from defendants who had already paid substantial sums to the copyright

voice was not copyrightable as an "original work of authorship" under the federal copyright scheme because sounds cannot be fixed in a tangible medium.<sup>198</sup> Instead, the court concluded that "[w]hat is put forward as protectible here is more personal than any work of authorship."<sup>199</sup>

Following these decisions, it is difficult to predict how far preemption will go towards destroying the right of publicity as a viable state vehicle for protecting the persona. The broad approach taken by the Seventh Circuit in *Baltimore Orioles* has a certain appeal, particularly in light of the growing trend towards classifying the right of publicity as a purely economic right. The *Baltimore Orioles* approach, however, is flawed, both in its logic and in its practical result. Specifically, that court is mistaken in its legal analysis of both the first (subject matter) and second (equivalency) prongs of the preemption test. By analyzing the subject matter of a given claim, the court is forced to focus on any tangible, and hence copyrightable work, in which a single manifestation of the celebrity's persona may appear. The subject matter requirement is thus easily satisfied in virtually all cases involving "tangible" work. The true basis for a right of publicity claim, however, is not the tangible work such as a film or a videotape but rather a celebrity's persona.<sup>200</sup> The persona is intangible and hence not within the subject matter of the Federal Copyright Act.<sup>201</sup> Therefore, the *Baltimore Orioles* approach errs

---

owner for the privilege of using the song and its arrangements. *Id.* at 717-18. The facts underlying Sinatra's unsuccessful claim bear an undeniable resemblance to those underlying Midler's victorious claim. This marked similarity moved two commentators to remark that "Midler's victory must make Nancy Sinatra feel a little bit ahead of her time." Shapiro & Olson, *supra* note 196, at 27. The same can be said of singer Tom Waits' recent \$2.475 million verdict against Frito-Lay. *See supra* note 12.

<sup>198</sup> *See* 17 U.S.C. § 102(a) (1988). The court did not even consider the rationale of the *Baltimore Orioles* case in its analysis, which made a distinction between the final product (the televised videotape) and the efforts (that is, the players' performances) embodied in that tangible, fixed work.

For a similar argument, see Hoffman, *supra* note 1, at 18 (footnote omitted), where the author argues that "[i]n contrast to the copyright author, however, a celebrity does not create a tangible writing or thing. Rather, the 'things' created are the intangible attributes which the celebrity either has or develops and by which he or she is known."

<sup>199</sup> *Midler*, 849 F.2d at 462. Following the decision in this case, Midler resumed her quest. On October 30, 1989, a jury awarded her \$400,000 against Young & Rubicam (the suit against Ford had been dismissed the week before). Young & Rubicam lamented that it had relied on the law as it stood in 1985. The agency ultimately labeled the verdict "unfortunate but bearable." Shapiro & Olson, *supra* note 196, at 27.

<sup>200</sup> *See, e.g.*, Shipley, *supra* note 180, at 369.

<sup>201</sup> *See supra* text accompanying note 200; Ausness, *supra* note 145, at 1022 (a celebrity's identity or "persona" does not qualify as a "work of authorship" within the meaning of the Copyright Act); Michael J. McLane, *The Right of Publicity: Dispelling Survivability, Preemption and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W.L. REV. 415, 424 (1983) (right of publicity differs from copyright in that one's

in its analysis by finding the first prong of the preemption test so easily satisfied.

Furthermore, under the *Baltimore Orioles* approach to the equivalency prong of the preemption test, the court is forced to determine whether the plaintiff's injury could be caused by the mere copying, performance, or display of the end product. Since most publicity claims now involve a showing or a reproduction of the end product in which the celebrity's persona has been captured, the equivalency prong of the preemption test is likewise easily satisfied. The true nature of a right of publicity claim, however, is not reproduction, but rather unauthorized commercial use of the plaintiff's persona. Such a claim is not equivalent to the reproduction, distribution, display and derivation rights protected by the Federal Copyright Act. Therefore, the *Baltimore Orioles* approach also errs in finding the second prong of the preemption test so easily satisfied.

The *Baltimore Orioles* approach to preemption achieves an undesirable end result because it literally nails the coffin shut on the right of publicity. Not only is the celebrity deprived of the recognized legal right of publicity, but he is also forced to rely in large part upon copyright law that fails to provide him with adequate protection. The typical celebrity does not own a copyright in either his persona or the work in which one manifestation of his persona happens to have been captured.<sup>202</sup>

No doubt the *Baltimore Orioles* approach to preemption is encouraging to manufacturers and advertisers who wish to obtain the broadest grant of rights possible with the payment of a single copyright license.<sup>203</sup> But this approach ignores both the labors and needs of the celebrity. The *Baltimore Orioles* approach thus errs critically by rewarding the commercial freeloader at the expense of the hardworking celebrity.

---

persona cannot be placed in a fixed medium and is therefore not protected or preempted by the Copyright Act).

<sup>202</sup> See, e.g., *Midler*, 849 F.2d at 460; *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971); *Ippolito v. Ono-Lennon*, 139 Misc. 2d 230, 526 N.Y.S.2d 877 (Sup. Ct. N.Y. County 1988), modified, 150 A.D.2d 300, 542 N.Y.S.2d 3 (1st Dep't 1989).

<sup>203</sup> As the court mused in *Midler*, Ford's advertising agency had obtained a copyright license to use "Do You Want to Dance." *Midler*, however, refused to participate in the commercial. So in the words of the Ninth Circuit, "They decided, '[i]f we can't buy it, we'll take it.'" *Midler*, 849 F.2d at 462. Interestingly, the trial court in that case had characterized the defendants as engaging in the conduct "'of the average thief.'" *Id.* Despite this sentiment, however, the trial court, perhaps in reliance on *Sinatra*, granted summary judgment for the defendants on the ground that there was no legal principal preventing imitation of a voice. *Id.*

From both a legal and a practical standpoint, the *Midler* approach provides a far better solution to the preemption problem. Particularly, it provides a more accurate legal analysis of both prongs of the preemption test. It properly focuses on the subject matter of the plaintiff's claim and recognizes that the basis of that claim is the persona, rather than a film or videotape. Thus, the *Midler* approach should result in far fewer cases satisfying the first prong of the preemption test.

Second, although the *Midler* court did not reach the equivalency prong of the preemption test, one can deduce from its discussion a similar willingness to look with greater scrutiny at the equivalency of the state claim. This should allow the court to see beyond the mere act of reproduction or display of the end product and to focus instead on the unauthorized commercial use of the persona that makes up the plaintiff's right of publicity claim. Thus, the *Midler* approach should also result in fewer cases satisfying the second prong of the preemption test. Finally, because application of the *Midler* approach should result in far fewer cases of preemption, it could go a long way towards protecting the celebrity's efforts from unwanted commercial freeloading.<sup>204</sup>

---

<sup>204</sup> As the Ninth Circuit explained in *Midler*, what Ford Motor Co. and its advertising agency sought was an attribute of Midler's identity, which was clearly of commercial value to them and to her. Indeed, the value of the attribute sought should be whatever the market would have paid to have Midler sing the commercial herself. *Id.* at 463.

A middle approach to the federal preemption question may be suggested by the somewhat cryptic opinion rendered by the New York Supreme Court in *Ippolito*, 139 Misc. 2d at 230, 526 N.Y.S.2d at 877. In 1972, John Lennon, accompanied by his wife, Yoko Ono, headlined two charity concerts at Madison Square Garden. During these two concerts, the plaintiff keyboard musician played an electric piano. With the plaintiff's consent, however, it was arranged so that the sounds that he produced appeared to the audience to be coming from a disconnected electric piano at which Ono sat. Without the plaintiff's permission, Ono later sold the rights to the concert tape for album and broadcast use. The plaintiff sued Ono for breach of his rights under §§ 50 and 51 of the New York Civil Rights Law, fraudulent misrepresentation, conversion, and common law unfair competition in the form of misappropriation and passing off. *Id.*, 526 N.Y.S.2d at 878.

The court considered whether the plaintiff's various causes were preempted under the Copyright Act. Despite the plaintiff's claim that the subject of his suit was his performance, the court followed the *Baltimore Orioles* approach and simply assumed that the "works" in question were a videotape, a film, and a record album, all of which were copyrightable. Hence, the court found the first prong of the preemption test to be satisfied. *Id.* at 235, 526 N.Y.S.2d at 881-82.

The court then considered the second prong of the test. According to the court, the conversion and common law misappropriation counts were based upon copying, which is a right equivalent to those protected by the Federal Copyright Act. Therefore, the court reasoned, the conversion and misappropriation counts were preempted. *Id.* at 237, 526 N.Y.S.2d at 883.

The court believed, however, that the privacy and publicity rights created under §§ 50 and 51, as well as the common law fraud and passing off counts, "involve something more than rights equivalent to those under the Federal Copyright Act." *Id.* at 237,

As will be discussed below,<sup>205</sup> the Federal Copyright Act should be amended to include a federal right of publicity. This would provide the best solution for the current controversies, including preemption, that currently plague the right of publicity. If such an amendment does not soon materialize, the courts should at least follow the careful approach to the preemption question suggested by *Midler*. To do otherwise would be to sound the death knell for the right of publicity.

#### IV. CONCLUSION: SOLVING THE PUBLICITY PROBLEM

The right of publicity is currently being strangled at nearly every step. In order to avoid the transferability and survivability problems that plague the traditional right to privacy, many jurisdictions have attempted to define the right of publicity as a property right. But by focusing attention on the proprietary nature of the right of publicity, these jurisdictions have ultimately brought it dangerously close to preemption under the equivalency standard of the Federal Copyright Act. As a result, the future of the right of publicity looks dim indeed.

The question thus becomes whether the right of publicity is worth saving. It is true that other legal theories, such as copyright, privacy and unfair competition, are available to the celebrity. These theories, however, do not provide an adequate mechanism for compensating a celebrity or his survivors for the unauthorized commercial use of his persona. Copyright does encourage creativity.<sup>206</sup> But copyright does not truly protect the persona, since the myriad of quirks and nuances that comprise the persona are not capable of being fixed in a tangible medium of expression.<sup>207</sup> The right to privacy does guard the individual's solitude from unwanted intrusion,<sup>208</sup> but does not encourage creativity,<sup>209</sup> and does not survive the celebrity's death.<sup>210</sup> Fi-

---

526 N.Y.S.2d at 882. Unfortunately, the court did not define "something more." This seems, however, to be a lesser standard than "qualitatively different." Under the "qualitatively different test" in *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987), the court found both privacy and passing off to be preempted, while under the test requiring "something more," the *Ippolito* court found no preemption of those two same claims. Note that, on appeal, the court in *Ippolito* declined to review the preemption question.

<sup>205</sup> See *infra* text accompanying notes 219-220.

<sup>206</sup> *Goldstein v. California*, 412 U.S. 546, 545 (1973), *reh'g denied*, 414 U.S. 883 (1973).

<sup>207</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (quoting 17 U.S.C. § 102(a) (1988)).

<sup>208</sup> *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254 (Sup. Ct. N.Y. County 1984), *aff'd mem.*, 110 A.D. 2d 1095 (1st Dep't. 1985).

<sup>209</sup> *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975).

<sup>210</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425, 428 (Cal. 1979).

nally, unfair competition regulations are designed to prevent confusion in the marketplace,<sup>211</sup> but do not help the individual whose sole complaint is commercial freeloading.<sup>212</sup>

The right of publicity fills the gaps left by copyright, privacy and unfair competition laws. It encourages creativity and thereby provides the public with entertainment and, hopefully, enlightenment.<sup>213</sup> It is capable of protecting nontraditional aspects of the persona<sup>214</sup> and of surviving the death of a celebrity.<sup>215</sup> Furthermore, it prevents the advertising freeloader from freely profiting from the labors of the celebrity.<sup>216</sup> The right of publicity, therefore, merits preservation.

The most obvious means for preserving the right of publicity would be through uniform legislation. The question then becomes where should this legislation be enacted. Adoption on a federal level would certainly provide for uniformity and appears to be desirable in this age of nationwide entertainment and advertising.<sup>217</sup> Yet, if Congress' persistent inability to enact moral rights legislation is any indication,<sup>218</sup> it is unrealistic to assume

<sup>211</sup> *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985).

<sup>212</sup> *Carson v. Here's Johnny Portable Toilets, Inc.* 698 F.2d 831 (6th Cir. 1983), *aff'd*, 810 F.2d 104 (6th Cir. 1987); *Rosenfeld v. W.B. Saunders*, 728 F. Supp. 236, 241 (S.D.N.Y.), *aff'd mem.*, 923 F.2d 845 (1990).

<sup>213</sup> See Hoffman, *supra* note 1, at 11.

<sup>214</sup> See, e.g., *Carson*, 698 F.2d at 831.

<sup>215</sup> *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982).

<sup>216</sup> See Hoffman, *supra* note 1, at 10-11.

<sup>217</sup> Several commentators have urged the adoption of such federal legislation. See, e.g., McManus, *supra* note 133, at 190 (suggesting that Congress should provide the judiciary with the ability to protect a celebrity's intangible property rights in his persona); Note, *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987) (federal legislation is important in order to avoid unfairness created by tension in choice of forum and choice of law schemes on both federal and state levels).

<sup>218</sup> See Comment, *Black and White (and Red All Over): Colorization in the Courts and in the Government*, 10 HAMLINE J. PUB. L. & POL'Y 59, 71 (1989) ("Attempts to legislate moral rights of artists have been slow in coming . . .").

However, in August 1987, Senator Edward Kennedy (D. Mass.) introduced the Visual Artists Rights Act of 1987, S. 1619, 100th Cong., 1st Sess. (1987), which would have expanded the traditional rights provided under the Federal Copyright Act of 1976. These expanded rights would have included the rights of paternity and integrity for "author[s] of a pictorial, graphic or sculptural work of fine art." Anne Marie Cook, Note, *The Colorization of Black and White Films: An Example of the Lack of Substantive Protection for Art in the United States*, 63 NOTRE DAME L. REV. 309, 329 (1988). This bill was not enacted into law. In early 1990, the prospect of moral rights legislation did resurface briefly, albeit unsuccessfully, in the Senate and the House. See *Postproduction Rights at Issue*, 10 COM. DAILY 4 (1990). See generally Patricia Klein Lerner, *Painter Going to The Mat Over Changes in Artwork for Hotel*, L.A. TIMES, Mar. 5, 1990, at B3.

In 1988, Congress enacted the Berne Convention Implementation Act of 1988, Pub. L. No. 100-569 §§ 1-13, 102 Stat. 2853 (1988). Note, *Motion Picture Colorization, Authenticity, and the Elusive Moral Rights*, 64 N.Y.U. L. REV. 628, 632-33 (1989). Through this legislation, the United States became a signatory of the Berne Convention which does provide a measure of protection for moral rights. *Id.* However, despite the enact-

that Congress will act to bring the right of publicity into the federal fold any time in the near future.

Uniform state statutory recognition of the right of publicity is the next choice. Such legislation should, at a minimum provide for the following:

- (1) Coverage should be extended to all actions brought by natural persons or corporate entities for losses caused by the unauthorized commercial use of a persona, in its broadest sense.
- (2) The individual's right to control the commercial exploitation of his persona should be freely alienable *inter vivos* and should be allowed to survive the individual's death for a period of fifty years. *Inter vivos* commercial exploitation should not be a pre-requisite to such survival.<sup>219</sup>

Legislation encompassing these terms would provide the celebrity with a strong weapon to use against the commercial freeloader, no matter how inventive the freeloader is in pirating even the most nontraditional aspect of the celebrity's persona. In addition, such legislation would give the individual, and his survivors, the unrestricted ability to control the use of his persona for a reasonable period of time. Furthermore, by focusing on the unauthorized commercial use of the persona rather than the mere reproduction of some copyrightable work, such legislation would help to eliminate the threat of preemption under the Federal Copyright Act.

Uniform state legislation may thus provide a workable solution for the publicity problem. Given the number of states that have already acted to provide some measure of protection for the right of publicity,<sup>220</sup> uniform state legislation may well be readily attainable. Absent such uniform state statutory recognition, celebrities, and indeed all individuals, will be forced to rely on the vagueness of state common and statutory law. Although this scheme did work in a haphazard fashion for some thirty years, it is unlikely that it will continue to exhibit lasting vitality. A uniform state statute is thus the apparent last hope for the right of publicity.

As the song aptly says, "Don't you know that you are a shooting

---

ment of the 1988 Implementation Act, moral rights have not been given protection in the United States because the provisions of the Berne Convention are not self-executing. *Id.* Thus, affirmative action by Congress is still required to bring moral rights squarely into the American legal system.

<sup>219</sup> In addition, such a statute should provide that where the First Amendment is raised as a defense to an action brought to enforce the rights described above, the individual's right to protect his persona should be balanced against society's legitimate need to know and to express.

<sup>220</sup> See supra note 75.

star?"<sup>221</sup> Despite many years of artistic and economic toil, a celebrity's fame is often painfully short.<sup>222</sup> But even a shooting star is entitled to enjoy its moment, however brief, in the artistic and the economic spotlight. The right of publicity plays a crucial role in permitting the celebrity to capitalize on the spotlight that he has earned. If Congress will not act to preserve the right of publicity, then the states must quickly move to rescue this invaluable right from its current path toward oblivion.

---

<sup>221</sup> BAD COMPANY, *Shooting Star*, on STRAIGHT SHOOTER (Swan Song Records 1975).

<sup>222</sup> The fleeting nature of fame was a favorite topic of the late Andy Warhol. This one-time high priest of pop art often maintained that in the future, everyone would be famous for fifteen minutes. *Andy Warhol, 59, Guru of Pop Art*, CHI. TRIB., Feb. 23, 1987, at C11.

