

THE RIGHT OF PUBLICITY, SECTION 43(a) OF THE LANHAM ACT AND COPYRIGHT PREEMPTION: PREVENTING THE UNAUTHORIZED COMMERCIAL EXPLOITATION OF UNCOPYRIGHTED WORKS OF ART*

I. INTRODUCTION

The control artists should have over their works has long been the subject of extensive debate. Numerous comparisons have been made between the European concept of *droit moral* and the elusive rights artists enjoy in the United States.¹ While many courts and commentators argue that an artist's rights are limited to the economic rights granted by federal copyright law,² others have found personal rights in diverse legal theories.³ Spurred by this controversy, which often

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¹ Moral rights include the right of integrity, which allows an artist to prevent his work from being distorted, and his name from being dishonored; and, the right of paternity, which grants an artist the right to claim his work as his creation. For general discussions of moral rights, see Strauss, *The Moral Right of the Author*, in 1 OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 109 (1960) (Copyright Law Revision Study No. 4 prepared for the Subcommittee on Patents, Trademarks, and Copyrights of Senate Committee on the Judiciary); Diamond, *Legal Protection for the "Moral Rights" of Authors and Other Creators*, 68 TRADE-MARK REP. 244 (1978); Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023 (1976); Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors, and Creators*, 53 HARV. L. REV. 554 (1940).

² See, e.g., *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-18 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971); Goldberg, *Commentary: The Illusion of "Moral Right" in American Law*, 43 BROOKLYN L. REV. 1043 (1977).

³ "The doctrine of moral right is not part of the law in the United States, . . . except insofar as parts of that doctrine exist in our law as specific rights—such as copyright, libel, privacy and unfair competition." *Geisel v. Poynter Products*, 295 F. Supp. 331, 340 n.5 (S.D.N.Y. 1968). Rights have been found under the following legal theories: False designation of origin as set forth in section 43(a) of the Lanham Act, *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976); *Benson v. Paul Winley Record Sales*, 452 F. Supp. 516 (S.D.N.Y. 1978); right to privacy, *Neyland v. Home Pattern Co.*, 65 F.2d 363 (2d Cir. 1933), cert. denied, 290 U.S. 661 (1933); *Gieseking v. Urania Records*, 17 Misc. 2d 1034, 155 N.Y.S.2d 171 (N.Y. Sup. Ct. 1956); contract theory, *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); libel, *Gershwin v. Ethical Publishing*, 166 Misc. 39, 1 N.Y.S.2d 904 (Sup. Ct. 1937); unfair competition, *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939); and, "a right analogous to 'moral right,'" *Seroff v. Simon & Schuster*, 6 Misc. 2d. 383, 387, 162 N.Y.S.2d 770, 774 (N.Y. Sup. Ct.

concludes that artists have no "moral rights" in this country,⁴ legislation, both federal and state, is being proposed to supplement the rights artists are granted under federal copyright law.⁵ Some proposals have gained enough support to become law,⁶ but most have not.⁷

This note will neither attempt to study moral rights as they exist in other countries nor provide a macrocosmic proposal for artists' rights in the United States. Instead, it will address a particular problem faced by visual artists in this country: the unauthorized commercial exploitation of uncopyrighted works of art. Copyright law would easily solve this problem were it not for artists' reluctance to copyright their creations. However, this note will show that an artist's failure to copyright his work has not left him without remedy to deal with the unauthorized commercial exploitation of his work. It will analyze federal copyright preemption and discuss the right of publicity and section 43(a) of the Lanham Act⁸ as alternative legal theories available to artists to prevent and redress the exploitation of their uncopyrighted works.

II. THE UNAUTHORIZED COMMERCIAL EXPLOITATION OF UNCOPYRIGHTED WORKS OF ART

Consumers often choose a particular product because it is endorsed by a celebrity whom they hold in high regard.⁹ They believe that the product must be reputable; otherwise a person who has achieved a high level of recognition and respect would not risk his

1957), *aff'd*, 12 A.D.2d 475, (1960) 210 N.Y.S.2d 479. See generally Roeder, *supra* note 1; and, Diamond, *supra* note 1.

⁴ See *Miller v. Commissioner*, 299 F.2d 706, 709 n.5 (2d. Cir. 1962), *cert. denied*, 370 U.S. 923 (1962); *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947).

⁵ Copyright law is currently codified in 17 U.S.C. 101-810 (1982) [hereinafter cited as the 1976 Act]. The predecessor to this act was the 1909 Copyright Act, ch. 320, 35 Stat. § 1075 (1909) [hereinafter cited as the 1909 Act].

⁶ CAL. CIV. CODE § 986 (West 1982 & Supp. 1983) (Resale Royalties Act); CAL. CIV. CODE § 987 (West 1982 & Supp. 1983) (Art Preservation Act); N.Y. GEN. BUS. LAW § 228 (McKinney 1983), *reprinted in* 7A Session Law News of New York 1933-35 (Sept. 1983). The New York Law, entitled Artists' Authorship Rights Act, may be subject to copyright preemption because it grants artists the right to prevent the unauthorized reproduction of "altered, defaced, mutilated, or modified" works of art, which is equivalent to the right to prevent derivative works. See *infra* notes 28-29 and accompanying text.

⁷ H.R. 2908, 97th Cong., 1st Sess., 127 CONG. REC. 1217 (1981); H.R. 288, 96th Cong., 1st Sess. (1979); H.R. 8261, 95th Cong., 1st Sess., 123 CONG. REC. 22773 (1977).

⁸ The Lanham Act is codified at 15 U.S.C. §§ 1051-1127 (1982) [15 U.S.C. § 1125 hereinafter cited as section 43(a) of the Lanham Act].

⁹ *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970); Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 644-646 (1973).

“goodwill”¹⁰ by endorsing it.¹¹ Equally as important, consumers view the product as a reflection of the celebrity’s outstanding characteristics.¹² Hence, they buy decaffeinated coffee associated with the fatherly Robert Young; Wesson Oil used by Florence Henderson, who cooked for her six children on *The Brady Bunch*; roach traps that are tough like Muhammad Ali; and cosmetics made from the spectrum of colors that Henri Matisse employed in his paintings.

Celebrities who sell products usually enter into a contract whereby they endorse the goods of their choice for “a piece of the pie.”¹³ Unlike Robert Young, Florence Henderson, and Muhammad Ali, Henri Matisse, were he alive, would not¹⁴ get the chance to choose what products, if any, to endorse, nor would he share in everybody’s favorite pie. Matisse’s paintings, like the works of most fine artists, living and dead, are in the public domain¹⁵ and are not protected by

¹⁰ “Goodwill may be defined as the favorable consideration shown by the purchasing public to goods known to emanate from a particular source.” *White Tower System v. White Castle System of Eating Houses*, 90 F.2d 67, 69 (6th Cir. 1937), *cert. denied*, 302 U.S. 720 (1937).

¹¹ Treece, *supra* note 9, at 645, 647.

¹² See generally *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 834-35, 603 P.2d 425, 438, 160 Cal. Rptr. 323, 336 (Sup. Ct. 1979) (Bird, C.J., dissenting).

¹³ See *Haelan Laboratories v. Topp’s Chewing Gum*, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

¹⁴ Although Matisse is dead, his heirs should be entitled to the economic benefits and the control of the commercial exploitation of his reputation. See *infra* note 69.

¹⁵ There are different requirements for obtaining copyright protection under the 1909 Act and the 1976 Act. There are also different circumstances under which a work of art covered by each act will fall into the public domain. Section 10 of the 1909 Copyright Act states that published works need only include proper copyright notice in order to obtain copyright protection. If the work is “published” without notice of copyright it will fall into the public domain. Publication occurs:

when, by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.

1 M. NIMMER, *NIMMER ON COPYRIGHT* § 4.04, at 4-19 (1983) (emphasis and footnotes omitted) [hereinafter cited as M. NIMMER].

A work can also be thrust into the public domain if it is publicly displayed without notice of copyright, and no restrictions are placed on copying it, or no safeguards are taken to enforce the restrictions. See *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Letter Edged in Black Press, Inc. v. Public Bldg. Comm’n of Chicago*, 320 F. Supp. 1303 (N.D. Ill. 1970). Due to these harsh standards, most works of art that fall under the 1909 Act are subject to divestitive publication. See *infra* note 21. (Under section 301 of the 1976 Act, unpublished works created before the effective date of the 1976 Act that have neither been copyrighted nor fallen into the public domain are covered by the 1976 Act, and subject to its requirements for obtaining copyright protection.) The Copyright Act of 1976 has made it easier to obtain copyright protection. A work is protected by federal copyright law upon creation. *Id.* § 302(a). All authorized copies must contain copyright notice. *Id.* § 401. The failure to put notice on reproductions does not result in loss of copyright protection if the notice has been omitted from a relatively small number of copies, or if registration is made before publication or within five

copyright law.¹⁶ Advertisers, therefore, feel free to commercially exploit his reputation as a master of color by using reproductions of his work, either by themselves or coupled with his name, to promote products.¹⁷ These unauthorized uses can damage the artist's reputation, decreasing the value of his future endorsement and the price his paintings will command.¹⁸

An artist can prevent the unauthorized commercial exploitation of his work if he copyrights it.¹⁹ However, many works of art are not protected by copyright.²⁰ The 1976 Copyright Act preempts other legal theories which protect rights in copyrightable works equivalent to those within the federal scheme.²¹ Unless prevented on other grounds, uncopyrighted works of art can be freely reproduced for any purpose. The unauthorized commercial exploitation of a public domain work, therefore, can be prevented and redressed only if there are legal theories that escape the bite of federal copyright preemption.

Section 301 of the 1976 Act delineates the boundaries for determining which rights will be preempted and which will not. It explicitly exempts federal legislation from preemption.²² Section 301 also allows common law rights under state law to exist if the law either protects a right that does not fall within the subject matter of copyright,²³ or provides rights that are not "equivalent" to the rights granted under the 1976 Act.²⁴

For a legal theory to succeed in preventing and redressing the unauthorized commercial exploitation of an artist's work without being crushed by the jaws of copyright preemption, two basic premises must be proven: first, that the artist's work is valuable for commercial exploitation because the work embodies the reputation and

years thereafter and a reasonable effort is made to attach notice to all copies that have been distributed in the United States, or if notice has been omitted in violation of an express written agreement. *Id.* § 405.

¹⁶ See 17 U.S.C. § 101-810 (1982).

¹⁷ See *infra* note 128.

¹⁸ The reputation of an artist is directly related to the economic value of his name and works. See *infra* notes 35-40 and accompanying text.

¹⁹ Section 106, reproduced *infra* note 33, grants artists the exclusive right to make reproductions of their work and derivative works from their copyrighted work.

²⁰ According to a 1973 study, most artists do not even know that copyright can protect their works. See generally Sheehan, *Why Don't Fine Artists Use Statutory Copyright? An Empirical and Legal Survey*, 22 BULL. COPYRIGHT SOC'Y 242 (1975).

²¹ 17 U.S.C. § 301 (1982), reproduced *infra* note 28, is the preemption provision of the 1976 Act.

²² 17 U.S.C. § 301(d) (1982).

²³ *Id.* § 301(b)(1). Copyrightable subject matter is specified in sections 102-103 of the 1976 Act.

²⁴ *Id.* § 301(b)(3).

goodwill of the artist;²⁵ and second, that in seeking to enjoin the unauthorized commercial exploitation of his work, the artist is not preventing the “mere” reproduction of his work, but the trading off of his reputation.²⁶ These premises allow for the conclusion that artists can prevent their uncopyrighted work from being commercially exploited by invoking federal trademark law or the common law right of publicity. Federal trademark law can aid the artist because the exploiter is using the work of art as a trademark or certification mark.²⁷ The right of publicity can be used because the value being exploited is not the work itself, but rather, the reputation of the artist as manifest in his creation.

III. FEDERAL COPYRIGHT PREEMPTION

Federal copyright preemption is set forth in section 301 of the 1976 Copyright Act.²⁸ Section 301(a) provides that any state law that is “equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106”²⁹ is preempted. Conversely,

²⁵ See *infra* notes 62-63 and accompanying text.

²⁶ See *infra* notes 88-111 and accompanying text.

²⁷ See *infra* notes 115-117 and accompanying text.

²⁸ 17 U.S.C. § 301 (1982) provides:

(a) On and after January 1, 1978, all 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, whether created before or after that date and whether published or unpublished, 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.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or (2) any cause of action arising from undertakings commenced before January 1, 1978; or (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

(c) With respect to sound recordings fixed before February 15, 1972, any rights or remedies under the common law or statutes of any State shall not be annulled or limited by this title until February 15, 2047. The preemptive provisions of subsection (a) shall apply to any such rights and remedies pertaining to any cause of action arising from undertakings commenced on and after February 15, 2047. Notwithstanding the provisions of section 303, no sound recording fixed before February 15, 1972, shall be subject to copyright under this title before, on, or after February 15, 2047.

(d) Nothing in this title annuls or limits any rights or remedies under any other Federal statute.

²⁹ 17 U.S.C. §§ 102, 103 (1982).

section 301(b)(3) provides that "activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106" are not preempted. Other federally created rights are also exempt from preemption.³⁰

To be preempted by section 301, a state right must protect a work of authorship, i.e., a work that is "original" and "fixed in any tangible medium of expression."³¹ The 1976 Act specifies pictorial, graphic, and sculptural works, as well as derivative works based on a copyrighted work, as forms of expression subject to its coverage.³² In addition to protecting a work of authorship, a state law is preempted if it protects rights which are equivalent to the rights protected by copyright, as specified by section 106. The exclusive rights granted by section 106 include the right to reproduce the copyrighted work and to prepare derivative works based on the copyrighted work.³³ Thus, the mere reproduction of a copyrightable work or the mere making of a derivative work based on a copyrightable work could not be prevented under state law.

Not all uses of a copyrightable work fall neatly into the categories of rights set forth in section 106, however. The determination of which state-asserted rights are equivalent to section 106 rights has provoked much litigation and commentary, despite Congressional intent to use "the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation."³⁴ The controversy has centered around the type of test that should be used to determine

³⁰ *Id.* § 301 (d).

³¹ *Id.* § 102(a).

³² *Id.* §§ 102, 103.

³³ Section 106 provides as follows:

Subject to sections 107 through 118, the 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.

³⁴ H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 130, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5745-46 (notes on the Committee on the Judiciary) [hereinafter cited as HOUSE REPORT].

whether a state-created right is or is not equivalent to a right protected by section 106 of the 1976 Act.

One test for determining equivalency is based on the premise that copyright law protects economic rights only. This position is best exemplified in the Supreme Court's *Mazer v. Stein* decision.³⁵ In *Mazer* the Court found that:

[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts."³⁶

In the spirit of *Mazer v. Stein*, courts and commentators have interpreted copyright law as only protecting an artist's economic right to profit from his creations.³⁷ According to this conclusion, copyright does not protect an artist's non-economic right to protect his reputation and the integrity of his work. The application of this mechanical test to section 301's preemption provisions provides for an easily defined preemption standard: state protection of economic rights in a copyrightable work is equivalent to the rights protected by copyright and is therefore preempted, while state protection of non-economic rights is not preempted since copyright does not explicitly protect them.³⁸

Non-economic and economic rights are, however, too intertwined to be distinguished in determining whether a state law is preempted by federal copyright law. Although the 1976 Act grants artists the right to control their economic interests in their work,³⁹ artists can control their reputation as well. The 1976 Act allows an artist to control the reproduction, performance, distribution and display of his work,⁴⁰ thereby enabling him to protect his immediate

³⁵ 347 U.S. 201 (1954).

³⁶ 347 U.S. at 219.

³⁷ *Goldstein v. California*, 412 U.S. 546, 555 (1973); *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14, 24 (2d Cir. 1976); DaSilva, *Droit Moral and the Amoral Copyright: A Comparison of Artists' Rights in France and the United States*, 28 BULL. COPYRIGHT SOC'Y 1, 3 (1981); Katz, *Copyright Preemption Under the Copyright Act of 1976: The Case of Droit de Suite*, 47 GEO. WASH. L. REV. 200, 211 (1978); Merryman, *supra* note 1, at 1025; Roeder, *supra* note 1, at 557.

³⁸ See Katz, *supra* note 37, at 213; Note, *An Artist's Personal Rights in His Creative Works: Beyond the Human Cannonball and the Flying Circus*, 9 PAC. L.J. 855, 867, 868 (1978).

³⁹ See 17 U.S.C. § 106 (1982).

⁴⁰ 17 U.S.C. § 106 (1982). In addition, section 203 allows a copyright owner to terminate a license after 35 years. An artist, thereby, may receive economic benefits he might not have been able to command 35 years earlier, when he was less well known.

economic interest in his work, as well as his reputation.⁴¹ By choosing which reproductions and derivative works to permit, the artist can, with certain narrowly drawn limitations,⁴² control the manner in which the public views his work. Copyright law thus enables the artist to insure that reproductions and derivative works which might damage his reputation will neither be made nor enter the market, regardless of the economic rewards associated with such uses. Conversely, by protecting his reputation, an artist also protects his economic value. The greater an artist's reputation, the more money he can earn making endorsements and selling his works. Economic and non-economic rights are therefore so intertwined that a clear-cut distinction cannot be made. Thus, the distinction between these two rights cannot serve as a basis for determining whether a state right is preempted.

Professor Nimmer has suggested another test, which has been widely accepted by courts and commentators,⁴³ for determining whether a state right is equivalent to a right protected by copyright. He suggests that,

⁴¹ See generally Note, *An Author's Artistic Reputation under the Copyright Act of 1976*, 92 HARV. L. REV. 1490 (1979).

⁴² Section 107 of the 1976 Act allows for the "fair use" of copyrighted works. The use of a copyrighted work for purposes "such as criticism, comment, news reporting, teaching scholarship or research" is often allowed. Section 107 sets forth four factors to be considered in determining whether a use is fair use:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107(1)-(4) (1982).

These factors are not exclusive. Section 107 is an attempt to codify case law. HOUSE REPORT, *supra* note 34, at 66, reprinted in U.S. Code Cong. & Ad. News 5659, 5679-80.

Section 108 allows libraries and archives to make one copy of a copyrighted work for non-commercial purposes. Although the owner of a copyrighted work does not, under section 202, receive any rights in the work beyond ownership of the particular work, he can, under section 109, transfer and publicly display the work. Section 110 permits the display of a copyrighted work in "the course of face-to-face teaching activities of a nonprofit educational institution." And Section 113(c) allows for advertisement and comment of lawfully reproduced useful articles that contain reproductions of the copyrighted work. For a discussion on the exceptions to exclusive use, see generally M. NIMMER, *supra* note 13.

⁴³ See *John H. Harland Co. v. Clarke Checks, Inc.*, 207 U.S.P.Q. 664 (N.D. Ga. 1980); *DC Comics, Inc. v. Filmation Assocs.* 486 F. Supp. 1273, 1278 (S.D.N.Y. 1980); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981) *cert. denied*, 102 S. Ct. 1973 (1982); *Allied Artists Pictures v. Rhodes*, 496 F. Supp. 408 (S.D. Ohio), *modified*, 679 F.2d 656 (6th Cir. 1980); *Orth-O-Vision, Inc. v. Home Box Office*, 474 F. Supp. 672 (S.D.N.Y. 1979). See also, Gantz, *Protecting Artists' Moral Rights: A*

If under state law the act of reproduction, performance, distribution or display, no matter whether the law includes all such acts or only some, will *in itself* infringe the state created right, then such right is preempted. But if other elements are required, in addition to or instead of, the acts of reproduction, performance, distribution or display, in order to constitute a state created cause of action, then . . . there is no preemption.⁴⁴

Copyright infringement requires the unauthorized reproduction, distribution, display or performance of a copyrightable work.⁴⁵ Under Professor Nimmer's "different elements test," if elements other than, or in addition to, those required to constitute copyright infringement are required to create a state cause of action, then the state right being protected is "different in nature"⁴⁶ from the rights protected by copyright and not subject to preemption. In other words, the state right would not be preempted because the different or additional elements required to prove the infringement transform the questioned act from a "mere" reproduction to a cause of action that is different in nature from a copyright infringement suit. The different elements test meets section 301's requirement that state rights not be equivalent to the rights granted in section 106, thus satisfying Congressional intent in defining the scope of copyright preemption under section 301.

While the different elements test is an accurate method for determining which state rights are preempted by copyright, not all state causes of action come under section 301's preemptive power. The 1976 Act only applies to causes of action commencing after January 1, 1978.⁴⁷ Causes of action commencing before that date fall under the 1909 Copyright Act, which left the courts free to define a common law preemption standard.⁴⁸ Since most works created after January 1,

Critique of the California Art Preservation Act as a Model for Statutory Reform, 49 GEO. WASH. L. REV. 873, 896 (1981); Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 720-21 (1981); Katz, *supra* note 37, at 211-213. *But see* Note, *supra* note 41, at 1506-13.

⁴⁴ 1 M. NIMMER, *supra* note 15, § 1.01[B], at 1-11 (1983) (footnotes omitted) (emphasis in original).

⁴⁵ 17 U.S.C. § 501(a) (1982).

⁴⁶ HOUSE REPORT, *supra* note 34, at 132.

⁴⁷ 17 U.S.C. § 301(a) (1982).

⁴⁸ The only preemption section in the 1909 Act was section 2, which stated that there was no preemption for unpublished works. Thus, a state court action for the infringement of unregistered, unpublished works on the theory of common law copyright was available. Courts, otherwise, were left to apply the supremacy clause to copyright preemption, U.S. CONST., art. VI. *See* *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974); *Goldstein v. California*, 412 U.S. 546, *reh'g denied*, 414 U.S. 883 (1973); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). *See infra* text accompanying notes 50-57. *See generally* Gorman, *An Overview of the Copyright Act of 1976*, 126 U. PA. L. REV. 856 (1978).

1978 will be protected by copyright,⁴⁹ it is essential to determine what type of preemption test applies to works of art covered by the 1909 Act.

Causes of action falling under the pre-1978 common law preemption test will not have to meet a different preemption standard than those falling under the 1976 Act. Although common law copyright preemption, at first glance, appears to have a different premise than preemption under the 1976 Act, closer examination proves the two tests indistinguishable.

The common law standard, as set forth in *Sears, Roebuck & Co. v. Stiffel Co.*⁵⁰ and *Compco Corp. V. Day Brite Lighting, Inc.*,⁵¹ required the preemption of any state law that gave protection to works that were unprotected by federal patent or copyright law.⁵² The Supreme Court, in *Goldstein v. California*,⁵³ interpreted *Sears* and *Compco* as mandating the preemption of state laws only if they afforded protection within the scope of patent or copyright protection.⁵⁴ In *Kewanee Oil Co. v. Bicron Corp.*,⁵⁵ the Supreme Court modified *Goldstein*, *sub silencio*, and concluded that while states could protect works that were within the scope of patent and copyright law, if the state law "clashes with the objectives of the federal patent [and copyright] laws ... the state law must fall."⁵⁶

Goldstein and *Kewanee* requires a two-prong test for common law copyright preemption: Is the allegedly infringed work within the scope of patent or copyright law? If it is, does the state-created right clash with the objectives of federal patent or copyright law? The first part of this test is the same as the first part of the 1976 Act's preemption test which asks whether the "work of authorship ... [falls] within the subject matter of copyright." The second part of the common law "clash of objectives" test, as developed from *Goldstein* and *Kewanee*, raises the same questions as the 1976 Act's equivalency test.⁵⁷

By determining whether a state law protects a right that is equivalent to a right protected by copyright, the equivalency test questions whether the state law clashes with the objectives of copyright law.

⁴⁹ See *supra* note 15.

⁵⁰ 376 U.S. 225 (1964).

⁵¹ 376 U.S. 234 (1964).

⁵² *Sears*, 376 U.S. at 231; *Compco*, 376 U.S. at 237.

⁵³ 412 U.S. 546, *reh'g denied*, 414 U.S. 883 (1973).

⁵⁴ *Id.* at 569-70.

⁵⁵ 416 U.S. 470 (1974).

⁵⁶ *Id.* at 480.

⁵⁷ 17 U.S.C. § 301(a) (1982). See M. NIMMER, *supra* note 15, § 1.01[B], at 1-7 (1983).

The underlying objective of copyright law is to give artists an incentive to create works of art that "advance public welfare."⁵⁸ Sections 102 and 103 of the 1976 Act set forth the types of "original works of authorship" that Congress deems worthy of copyright protection.⁵⁹ Section 106, in turn, sets forth the exclusive uses of such types of authorship that Congress believes beneficial to society. Under this section, a visual artist may control the reproduction, distribution and display of his copyrighted works.⁶⁰

Section 106 contains all of the ways in which a work can be commercially exploited. If copyright formalities are not met or if copyright has expired, the section 106-type rights in a work of art that fall into the public domain are those that are concerned with the work itself. Since all ways of exploiting the work for its own value are included in section 106, causes of action that only incorporate section 106 rights are necessarily challenging a type of use that Congress has granted to the artist, if the work is copyrighted, or dedicated to the public, if it is not copyrighted. Causes of action that assert conduct other than the unauthorized reproduction, distribution or display of the work of art are based on the infringement of a right apart from the work itself, a right with which Congress has not dealt. The protection of such a tangential right does not clash with the objectives of copyright law. When, for example, a work of art is used to promote a product,⁶¹ the promoter is using it in order that consumers recognize it and thereby associate the artist with the product being promoted.⁶²

⁵⁸ *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

⁵⁹ HOUSE REPORT, *supra* note 34, at 51, *reprinted in* U.S. Code Cong. & Ad. News 5659, 5664. Sections 102 and 103 of the 1976 Act are similar to sections 4 and 5 of the 1909 Act. For a comparison of the two acts, *see generally* Gorman, *supra* note 48.

⁶⁰ Section 106 is reproduced *supra* note 33. Section 106 of the 1976 Act provides for the same rights as section 1 of the 1909 Act, except that the 1909 Act does not grant the right to display. *See generally*, Gorman, *supra* note 48.

⁶¹ When exploiting an artist's reputation through the use of his art, a work that is easily identifiable as being created by the particular artist must be used. Three types of work can be used to convey an artist's reputation: A famous piece that is known as being created by the artist; a work that "looks" like one of his creations; or, a work where the artist's signature is clearly visible.

⁶² A factual determination must be made as to how the public perceives the association made between the artist and the product being promoted. The public's view is especially important since the artist's reputation depends upon it. Such a determination would be similar to that made in false designation of origin suits under section 43(a) of the Lanham Act. *See infra* notes 123-132 and accompanying text. *But see* *Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 70, 80 N.Y.S.2d 575, 578 (Sup. Ct. 1948), *aff'd*, 275 A.D. 692, 87 N.Y.S.2d 430 (1949), where the court stated that the public will not make an association between an unauthorized use of a work and its composer when the work is in the public domain.

Since the marketability of the product is increased by the artist's goodwill, and not by the intrinsic beauty of the art, the wrong is not the infringement of the "original work of authorship." Rather, it is the exploitation of a tangential right—the artist's reputation as manifest in his work.⁶³ Professor Nimmer's different elements analysis of section 301's equivalency test takes cognizance of this difference by distinguishing between uses which exploit the work and those which exploit a tangential value. This test can thus be used to determine whether a state right is preempted under the 1909 Act's "clash of objectives test," as well as under the 1976 Act's "equivalency test."

By applying the different elements test to the unauthorized commercial exploitation of an artist's reputation through the use of his work, it is seen that the prevention of such exploitation is not equivalent to the forms of infringement prevented by the 1976 Act and does not clash with the objectives of copyright law.⁶⁴ It can thus be prevented by alternative legal theories to copyright.

IV. THEORIES OF PROTECTION

A. *The Right of Publicity*

The right of publicity can prevent the unauthorized commercial exploitation of an artist's work without being preempted by copyright law. The right of publicity⁶⁵ is a newly emerging⁶⁶ common law doctrine that "protects [the] proprietary interest in the profitability of [a celebrity's] public reputation or 'persona'."⁶⁷ Publicity value is based on the public's recognition of the celebrity and the goodwill it

⁶³ An artist's reputation inheres in his work. See *Gilliam*, 538 F.2d 14 at 24-5; *Benson*, 452 F. Supp. at 517; *CBS v. Springboard Int'l Records*, 429 F. Supp. 563, 568 (S.D.N.Y. 1976); 1 R. CALLMAN, *UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 1.23, at 107 (4th Ed. 1982).

⁶⁴ Courts have used the different elements test in cases falling under the 1909 Act. See, e.g., *Factors*, 496 F. Supp. at 1091.

⁶⁵ The right of publicity is distinguished from the right of privacy in that the plaintiff in a right of privacy suit desires "to be let alone," Warren & Brandeis, *The Right To Privacy*, 4 HARV. L. REV. 193, 195 (1890), while the celebrity plaintiff in a right of publicity suit welcomes public exposure, but desires to control and profit from the commercial exploitation of his reputation. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204 (1954). See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977); *Factors*, 579 F.2d at 220.

⁶⁶ The right of publicity was first judicially recognized in *Haelan Laboratories v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), cert. denied, 346 U.S. 816 (1953). It has since been recognized by the Supreme Court in *Zacchini*, 433 U.S. 562 (1977).

⁶⁷ *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978). See also *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 880 (S.D.N.Y. 1973).

associates with him.⁶⁸ The celebrity⁶⁹ is allowed, under the right of publicity, to control and profit from his reputation for several reasons.

⁶⁸ See, e.g., *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970). It is goodwill that determines the value of a celebrity's reputation for making endorsements. See *id.* at 1283; *Haelan Laboratories*, 202 F.2d at 868; *Nimmer*, *supra* note 65, at 215; *Treece*, *supra* note 9, at 644.

⁶⁹ Courts are divided as to whether the right of publicity is descendible. Those which hold that it is not claim that it is a personal right and analogize it to the right of privacy, which does not survive death. See *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979). See also *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), *cert. denied* 449 U.S. 953 (1980). This position is based on the erroneous characterization of the right of publicity as a personal right. A personal right deals with hurt feelings, not with economic rights. See *supra* note 65. The right of publicity should be characterized as a property right, akin to copyright. See *Zacchini*, 433 U.S. 562. See also Felcher & Rubin, *The Descendibility of The Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125 (1980); Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U.L. REV. 553 (1960); Note, *Lugosi v. Universal Pictures: Descent of the Right of Publicity*, 29 HASTINGS L.J. 751 (1978); Note, *The Right of Publicity—Protection for Public Figures and Celebrities*, 42 BROOKLYN L. REV. 527 (1976); Comment, *Transfer of The Right of Publicity: Dracula's Progeny and Privacy's Stepchild*, 22 U.C.L.A. L. REV. 1103 (1975). When the right to publicity is recognized as being a property right, courts hold that it is descendible. See *Martin Luther King, Jr., Center for Social Change v. American Heritage Prods.*, 694 F.2d 674 (11th Cir. 1983); *Groucho Marx Productions v. Day and Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982); *Factors*, 496 F. Supp. 1090; *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975). Some courts and commentators, however, require that a celebrity commercially exploit his right of publicity during his lifetime in order for it to be descendible. See *Factors*, 496 F. Supp. at 1099-1100; Felcher & Rubin, *supra*, at 1131. Their reasoning is two-fold. First, if a celebrity has not exploited his right of publicity, then it was not a motivating force for his becoming a celebrity and should, therefore, not be protected. See *id.* This reasoning does not take into consideration other rationales for the right of publicity, such as allowing the author to profit from his own labor, preventing unjust enrichment, protecting the artist's reputation, and preventing consumer deception. See *infra* text accompanying notes 70-74. The second ground for requiring exploitation during the lifetime of the celebrity is that the right is intangible, hence, undevisable until exercised. See *Factors*, 496 F. Supp. at 1100. This reasoning fails to recognize that a celebrity may acknowledge his right of publicity, but not want to exercise it, either because to do so would damage his reputation, *King*, 694 F.2d at 683, or as stated in the dissent in *Lugosi*, 25 Cal. 3d at 848, 603 P.2d at 447, 160 Cal. Rptr. at 345 (Bird, C.J. dissenting), "[a] person may not have commercially exploited his name or likeness during his lifetime due to the absence of the appropriate medium or an early death. Perhaps the individual chose not to exercise the right to retain its full value as a legacy for his heirs."

Many courts and commentators have totally rejected the lifetime exploitation requirement. See *King*, 694 F.2d 674; *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975); T. SELZ & M. SIMENSKY, ENTERTAINMENT LAW, § 19.33 (1983); Gordon, *supra*; Note, *supra*, 29 HASTINGS L.J. 751; Note, *supra*, 42 BROOKLYN L. REV. 527; Note, *supra*, 22 U.C.L.A. L. REV. 1103. Other courts, by reasoning that the celebrity's activity which made him famous in itself constitutes lifetime exploitation, have essentially done away with the exploitation requirement. See *Groucho Marx*, 523 F. Supp. at 491-92; *Lerman v. Chuckleberry Publ.*, 521 F. Supp. 228, 232 (S.D.N.Y. 1981); *Hicks v. Casablanca Records*, 464 F. Supp. 426, 429-30 (S.D.N.Y. 1978).

Once it is decided that the right of publicity is descendible, it must be determined for how long it should be protected. Courts and commentators have analogized the right of publicity to federal copyright law and suggest that it descend for the life of the author plus fifty years, the

First, the right of publicity provides an economic incentive for creation, similar to copyright protection;⁷⁰ second, it allows him to profit from the fruits of his labor;⁷¹ third, it prevents unjust enrichment by an infringer, who, without investment, could otherwise reap the benefits of the celebrity's effort to create a valuable reputation;⁷² fourth, it prevents unauthorized exploitations which could damage the reputation of the celebrity and lessen his future earning capacity;⁷³ and fifth, it prevents consumer confusion that would result if the public erroneously believed that a product was endorsed by a celebrity.⁷⁴

Courts have not determined how far to extend a celebrity's right of publicity in his reputation.⁷⁵ Thus far, recognition has been given to a proprietary interest in a celebrity's name,⁷⁶ likeness,⁷⁷ nickname,⁷⁸ voice,⁷⁹ professional act,⁸⁰ character portrayal,⁸¹ slogan,⁸² and posses-

same period specified by section 302 of the 1976 Copyright Act. *Lugosi*, 25 Cal. 3d at 847, 603 P.2d at 446-47, 160 Cal. Rptr. at 344-45 (Bird, C.J. dissenting); Felcher & Rubin, *supra*, at 1131; Note, *supra*, 42 BROOKLYN L. REV. at 548; Note, *supra*, 22 U.C.L.A. L. REV. at 1126.

⁷⁰ *Zacchini*, 433 U.S. at 576.

⁷¹ *Lugosi*, 25 Cal. 3d at 839, 603 P.2d at 441, 160 Cal. Rptr. at 339 (Bird, C.J. dissenting); Nimmer, *supra* note 65, at 216.

⁷² *Zacchini*, 433 U.S. at 576 (citing Kalven, *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

⁷³ Treece, *supra*, note 9, at 644-46. Although the underlying interest behind a celebrity's protection of his right of publicity is economic, the celebrity is interested in protecting his reputation for the simple reason that his publicity value depends entirely upon his reputation. See *supra* notes 35-42 and accompanying text; *Uhlaender*, 316 F. Supp. at 1282; *Ali*, 447 F. Supp. at 728; *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 879 (S.D.N.Y. 1973); 2 T. SELZ & M. SIMENSKY, *supra* note 69, § 19.01; Treece, *supra* note 9, at 642-43.

⁷⁴ *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (Kennedy, J. dissenting); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d, 661, 664 (App. Div. 1977); Treece, *supra* note 9, at 647. Although consumer deception is one of the harms the right of publicity prevents, it is not a prerequisite for a right of publicity action, as it is for a false designation of origin suit under section 43(a) of the Lanham Act. See *infra* note 129 and accompanying text.

⁷⁵ See Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1590 (1979).

⁷⁶ *Lerman v. Chuckleberry Publishing*, 521 F. Supp. 228 (S.D.N.Y. 1981) (writer's name used to erroneously identify nude woman in magazine).

⁷⁷ *Haelan Laboratories, v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (picture and name of famous baseball player used for baseball cards).

⁷⁸ *Hirsh v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W. 2d 129 (1979) (nickname "Crazylegs" of famous football player used for women's shaving cream).

⁷⁹ *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962) (imitation of voice of comedian Bert Lahr used to promote bathroom cleanser). But see *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973); *Sinatra v. Goodyear Tire & Rubber*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971). *Sinatra* is distinguished from *Lahr* in that the defendant in *Sinatra* did not imitate Nancy Sinatra's voice, just her singing style.

⁸⁰ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (videotape of man being shot from cannon shown on news); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (App. Div. 1977) (imitation of Guy Lombardo's New Year's Eve party).

sions associated with him.⁸³ The extension of the right of publicity to protect an artist's reputation, as manifest in his name and work, depends upon recognition by courts that an artist's publicity value inheres in his works, and that the right of publicity can be invoked to protect a copyrightable work without being preempted by federal copyright law.

A visual artist can have celebrity status, hence, a right of publicity. A celebrity has been defined as one who has "attained national or international recognition in a particular field of art, science, business or other extraordinary ability."⁸⁴ In determining that Martin Luther King, Jr. had the requisite celebrity status to be entitled to have a right of publicity, the Eleventh Circuit stated that "[we] know of no reason why a public figure prominent in religion and civil rights should be entitled to less protection than an exotic dancer or movie actress."⁸⁵ It follows that an artist, such as Andy Warhol, Pablo Picasso or Henri Matisse, who has attained recognition and fame, should, like Martin Luther King, Jr., be considered a "celebrity" and possess a right of publicity.

It has been widely acknowledged that the reputation of a celebrity inheres in his name and likeness and that the right of publicity should prevent the unauthorized use of a celebrity's name⁸⁶ or likeness⁸⁷ to promote a product. As with all celebrities, however, the publicity value of an artist's reputation is not confined to his name and likeness. Since his reputation is also embodied in his work,⁸⁸ an artist's right of publicity can be exploited through the use of his works.

Courts have given credence to the view that a celebrity's publicity value can be exploited in ways other than through his name or likeness.⁸⁹ They have allowed celebrities to prevent and redress the unauthorized exploitation of their reputation on the theory that "[if]

⁸¹ *Groucho Marx Productions, v. Day and Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981) (imitation of Marx Brothers in stage production), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

⁸² *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983) (portable toilets bearing slogan "Here's Johnny"); *see infra* text accompanying notes 95-96.

⁸³ *Motschenbacher v. R.J. Reynolds Tobacco, Co.*, 498 F.2d 821 (9th Cir. 1974) (race car driver's unique car); *see infra* text accompanying notes 96-97.

⁸⁴ *Martin Luther King, Jr., Center for Social Change v. American Heritage Prods.*, 694 F.2d 674, 679 (11th Cir. 1983); *see infra* text accompanying note 84-85.

⁸⁵ *Id.* at 680.

⁸⁶ *See, e.g., Lerman v. Chuckleberry Publ.*, 521 F. Supp. 228 (S.D.N.Y. 1981).

⁸⁷ *See, e.g., Haelan Laboratories, v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2nd Cir.), *cert. denied*, 346 U.S. 816 (1953).

⁸⁸ *See supra* note 63 and accompanying text.

⁸⁹ *See supra* notes 76-83.

there is value in it, sufficient to excite the cupidity of another, [it should be] the property of him who gives it the value and from whom the value springs."⁹⁰ For example, in *Lahr v. Adell Chemical Co.*,⁹¹ comedian Bert Lahr sued to prevent the defendant from using an imitation of his voice to promote a product, claiming that the use of the imitation enhanced the value of the commercial. Acknowledging the uniqueness of Lahr's voice and the secondary meaning⁹² it carried, the court held that the unauthorized use of Lahr's voice could have diluted the value of his unique style.⁹³

In *Motschenbacher v. R.J. Reynolds Tobacco Co.*,⁹⁴ a famous race car driver prevented a cigarette company from using a picture of his uniquely designed car in its advertisements. Although the driver himself was not identifiable in the advertisement, the court reasoned that this was unnecessary because the car was identified with the plaintiff and one could presume that the plaintiff was behind the wheel. Although the court based its decision on the likelihood that the consumer would presume that the plaintiff was driving the car, this case is significant because it holds that the reputation of a celebrity can be misappropriated without the use of his name or likeness. The identifying factor in *Motschenbacher* was not the plaintiff; it was a material object.

The Sixth Circuit, in *Carson v. Here's Johnny Portable Toilets, Inc.*,⁹⁵ endorsed the *Motschenbacher* case by granting Johnny Carson an injunction against a company that called its portable toilets "Here's Johnny." The court held that the fact that the defendant did not use Carson's name or likeness was not fatal to his claim, because the use of a phrase associated with Carson sufficiently identified him. The court reasoned that there is an actionable wrong whenever a celebrity's identity is misappropriated for commercial use, regardless of how his identity is conveyed.⁹⁶ Similarly, the court in *Lombardo v. Doyle, Dane & Bernbach, Inc.*,⁹⁷ citing *Motschenbacher*, stated that an ad-

⁹⁰ *Munden v. Harris*, 153 Mo. App. 652, 659 134 S.W. 1076, 1078 (1911).

⁹¹ 300 F.2d 256 (1st Cir. 1962). Although this case was brought under the rubric of unfair competition, the court's holding that a celebrity's reputation can be exploited through his voice, applies to the right of publicity, as well as to unfair competition.

⁹² Secondary meaning has been defined as "[t]he power of a name or other configuration to symbolize a particular business, product or company." *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema*, 604 F.2d 200, 203 n.5 (2d Cir. 1979) (quoting *Ideal Toy Corp. v. Kenner Prods. Div. of General Mills Fun Group*, 443 F. Supp., 291, 305 n.14 (S.D.N.Y. 1977)).

⁹³ 300 F.2d at 259.

⁹⁴ 498 F.2d 821 (9th Cir. 1974).

⁹⁵ 698 F.2d 831 (6th Cir. 1983).

⁹⁶ *Id.* at 835-37.

⁹⁷ 58 A.D.2d 620, 396 N.Y.S.2d 661 (App. Div. 1977).

vertiser's depiction of an actor imitating Guy Lombardo conducting an orchestra performing "Auld Lang Syne," an act with which Lombardo is associated in the public mind, could be an infringement of Lombardo's right of publicity despite the fact that Lombardo's name was not used and the actor did not physically resemble Lombardo.⁹⁸

Lahr, Motschenbacher, Carson and Lombardo stand for the proposition that the right of publicity extends to any unauthorized use of a celebrity's reputation, whether it is conveyed by the celebrity's name or likeness, identifiable characteristics, slogans or possessions. Similarly, an artist's reputation can be exploited by the unauthorized use of his creations and, barring copyright preemption, can be prevented by the right of publicity.

The right of publicity is not preempted by copyright law because it protects rights different than those protected by copyright. The original intent of Congress, in drafting section 301 of the 1976 Copyright Act was to provide examples of common law doctrines that would not be preempted by federal copyright law.⁹⁹ That intent is demonstrated in an earlier draft of section 301 which states that "the common law right of . . . 'publicity' . . . would remain unaffected as long as the causes of action contain elements . . . that are different in kind from copyright infringement."¹⁰⁰ Courts and commentators have taken this statement, although deleted from the final bill,¹⁰¹ to mean that Congress did not intend that the Copyright Act would preempt the right of publicity.¹⁰²

The application of the different elements test supports the conclusion that the right of publicity is not preempted by copyright law. In *Factors Etc., Inc. v. Pro Arts, Inc.*,¹⁰³ the heirs and assignee of Elvis Presley's publicity rights sued to prevent the publication and sale by defendant of a memorial poster made from a copyrighted photograph of Presley. Applying the different elements test, the court held

⁹⁸ *Id.* at 662, 396 N.Y.S.2d at 664.

⁹⁹ 17 U.S.C. § 301(b)(3) (1982); H.R. 4347, 89th Cong., 2d Sess. (1966). See HOUSE REPORT, *supra* note 34, at 131-33.

¹⁰⁰ HOUSE REPORT, *supra* note 34, at 132.

¹⁰¹ Although there is some confusion as to why the examples were deleted, Nimmer suggests that they were deleted because the Justice Department feared that the doctrine of misappropriation would nullify the effect of preemption. 1 M. NIMMER, *supra* note 15, §§ 1.01[B], at 1-14.3 to 14.4 & n.52 (1983).

¹⁰² See *Allied Artists Picture Corp. v. Rhodes*, 496 F. Supp. 408, 444 (S.D. Ohio 1980); *Factors*, 496 F. Supp. 1090, 1097; 1 M. NIMMER, *supra* note 15, § 1.01[B], at 1-12 to 1-13 (1983); Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 U.C.L.A. L. REV. 1107, 1117-18 (1977); Gorman, *supra* note 45, at 866-67.

¹⁰³ 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981).

that the right of publicity is not preempted by federal copyright law because a successful right of publicity suit requires that the celebrity had commercially exploited his reputation during his lifetime,¹⁰⁴ an act not required to be proven in an action for copyright infringement.¹⁰⁵ However, the court did not have to rely on this requirement to satisfy the different elements test.¹⁰⁶ The basis for the right of publicity is that there is value in a celebrity's reputation. In exploiting a celebrity's reputation through a copyrightable work, an infringer does more than merely reproduce the work; he misappropriates the value of the celebrity's reputation to enhance the value of his product. Thus, in addition to the reproduction of a copyrightable work, a right of publicity suit requires that an infringer be trading off of the reputation of the celebrity.¹⁰⁷ Since this requirement is an element different than the elements required to prove copyright infringement, the right of publicity is not preempted by copyright law.¹⁰⁸

B. Federal Trademark Law

Federal trademark law is an alternative legal theory that an artist can utilize to prevent the unauthorized commercial exploitation of his reputation as embodied in his uncopyrighted works. Since federal trademark law is explicitly exempt from copyright preemption¹⁰⁹ and co-exists with copyright law,¹¹⁰ a work of art that is in the public domain under copyright law can be protected under federal trademark provisions.¹¹¹

An artist can invoke federal trademark law if his work is being commercially exploited as a trademark or as a certification mark.¹¹² A trademark represents the source of manufacture of an object,¹¹³ while

¹⁰⁴ See *supra* note 69.

¹⁰⁵ See *supra* note 45 and accompanying text.

¹⁰⁶ The lifetime exploitation requirement is being debated in most states recognizing the right of publicity. See *supra* note 69.

¹⁰⁷ Kalodner & Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1101 (1959); Shipley, *supra* note 43, at 720-21.

¹⁰⁸ See 1 M. NIMMER, *supra* note 15, § 1.01[B], 1-11 to 1-12 (1983).

In a right of publicity suit, a court can grant a celebrity plaintiff either an injunction, see, e.g., *Groucho Marx*, 523 F. Supp. 485, or monetary damages, see, e.g., *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975).

¹⁰⁹ 17 U.S.C. § 301(d) (1982).

¹¹⁰ A work of art can be protected by both copyright and trademark. See, e.g., *Frederick Warne & Co. v. Book Sales*, 481 F. Supp. 1191, 1196-97 (S.D.N.Y. 1979).

¹¹¹ See Borchard, *Trademark and the Arts*, 7 ART & THE LAW 1, 16-17 (1982).

¹¹² See *Frederick Warne*, 481 F. Supp. at 1195 (uncopyrighted cartoon character entitled to protection under section 43(a) of the Lanham Act.)

¹¹³ 15 U.S.C. § 1127 (1982).

a certification mark signifies that a particular source approves of a product.¹¹⁴ An artist's work functions as a trademark if the consumer believes that the artist produced the product being promoted by his work. Similarly, an artist's work functions as a certification mark if a consumer believes that the artist approves of the product. If a work of art is registered as a trademark or as a certification mark, an artist can prevent others from using it in a manner that leads the public to believe that the artist is connected with its use.¹¹⁵

Artists will not, however, avail themselves of federal trademark protection. As seen earlier, artists rarely take advantage of copyright law to protect their work.¹¹⁶ They do not copyright their creations primarily because they do not know that copyright is available and because they adhere to the myth that a copyright notice connotes a crass commercialism damaging to the aesthetic of the work.¹¹⁷ Given the obscure use of trademark law in protecting works of art and the complexities of trademark registration,¹¹⁸ it is unlikely that artists would register their creations. While artists cannot gain copyright protection without taking affirmative steps, trademark protection is available without the need for any prior action by the artist. If a work of art has entered interstate commerce,¹¹⁹ it can be protected by Section 43(a) of the Lanham Act even if it has not been registered.¹²⁰ Section 43(a) provides that,

any person who shall affix, apply or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or

¹¹⁴ *Id.*

¹¹⁵ 15 U.S.C. § 1114(1) (1982).

¹¹⁶ *See supra* note 20.

¹¹⁷ *Id.*

¹¹⁸ The procedure for registering a trademark, as set out in 15 U.S.C. § 1051 (1982), requires that an application include: The date of the mark's first use; the mark's first use in commerce; the goods to which the mark is attached; the mode and manner in which the mark is used in connection with such goods; a verification stating that the applicant believes himself to be the owner of the mark, and that nobody else has a right to use the mark in any form that is likely to cause confusion with the applicant's mark; and, compliance with other rules and procedures prescribed by the Commissioner of the Patent and Trademark Office.

¹¹⁹ Interstate advertising has been held to satisfy this requirement. *National Dynamics Corp. v. John Surrey Ltd.*, 238 F. Supp. 423 (S.D.N.Y. 1964).

¹²⁰ Registration is not required under 15 U.S.C. § 1125(a). *See Metric & Multi-standard Components Corp. v. Metric's, Inc.*, 635 F.2d 710 (8th Cir. 1980); *Mortellito v. Nina of Cal., Inc.*, 335 F. Supp. 1288, 1294 (S.D.N.Y. 1972); *Matter of Emergency Beacon Corp.*, 13 Bankr. 773 (Bankr. S.D.N.Y. 1981).

services to enter into commerce . . . shall be liable to a civil action . . . by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

In order to succeed in a 43(a) action, the artist must show that the buying public recognizes that the work that is being used to connote source or endorsement is his creation.¹²¹ This requirement is based on the rationale that there cannot be confusion of origin or damage to the artist if the public does not think that the association of the work with the product means that the particular artist made or approves of the product. However, when an artist is erroneously associated with a product, the artist can suffer a loss of goodwill as well as a decrease in the value of his future endorsements.

Section 43(a) can redress this injury¹²² since "false representation, whether express or implied, that a product was authorized or approved by a particular person is actionable under 43(a)."¹²³ When an infringement has taken place, courts have either granted injunctive relief¹²⁴ or ordered the modification of the infringing use so as to make it a truthful disclosure.¹²⁵ Modification by a truthful disclosure is sufficient because the artist will not suffer any economic loss or damage to reputation if the public¹²⁶ is not deceived as to the source or endorsement of the product. However, truthful disclosure will not always suffice in dispelling the association the public makes between the artist's mark or reputation and the product the infringer associates

¹²¹ See *Ciba-Geigy Corp. v. Bolar Pharmaceutical Co.*, 547 F. Supp. 1095 (D.N.J. 1982); *Harlequin Enterprises v. Gulf and Western Corp.*, 503 F. Supp. 647 (S.D.N.Y. 1980), *aff'd*, 644 F.2d 946 (2d Cir. 1981); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602 (S.D.N.Y. 1979); *Mortellito*, 335 F. Supp. 1288.

¹²² See *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976); *Benson v. Paul Winley Record Sales*, 452 F. Supp. 516, 517 (S.D.N.Y. 1978); *CBS v. Springboard Int'l Records*, 429 F. Supp. 563, 567 (S.D.N.Y. 1971); *CBS v. Gusto Records*, 403 F. Supp. 447, 449 (M.D. Tenn. 1974).

Section 43(a) of the Lanham Act and the common law right of publicity are often asserted alternatively. In *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983), the court denied Johnny Carson's 43(a) claim because it found that there was no likelihood of confusion. Carson was, however, successful in his right of publicity claim.

¹²³ *Geisel v. Poynter Prods.*, 295 F. Supp. 331, 344 (S.D.N.Y. 1968).

¹²⁴ See, e.g., *Gilliam*, 538 F.2d 14; *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); *Benson*, 452 F. Supp. 516; *CBS*, 429 F. Supp. 563. Likelihood of deception is the test for determining whether an injunction should be granted. In order to receive damages, a plaintiff must show actual consumer deception. *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981).

¹²⁵ See, e.g., *CBS v. Gusto Records*, 403 F. Supp. 447 (M.D. Tenn. 1974); *Geisel*, 295 F. Supp. 331.

¹²⁶ Whether the public is likely to be deceived is the test for a 43(a) infringement. See *American Home Prods. v. Johnson & Johnson*, 577 F.2d 160, 165 (2d Cir. 1978).

with it.¹²⁷ For example, a manufacturer of cosmetics recently advertised its mascara, lipstick and nail polish by using a famous Matisse painting alongside a legend that reads, "Merci, Henri Matisse. Your palette has inspired a fresh new fashion collection for eyes, lips, and nails."¹²⁸ Although the manufacturer did not state outright that Matisse or his estate endorsed, approved, or authorized the use of "Matisse colors" for cosmetics, consumers undoubtedly associate a Matisse work, hence Matisse, with the product. Assumedly, the manufacturer is counting on this association to sell his product. A truthful disclosure that the Matisse estate does not endorse the product will not necessarily cause the public to disassociate Matisse from the cosmetics. After consumers see the advertisement they might remember Matisse and the cosmetics but forget the disclosure. Even if they remember the disclosure, the association may be so strong that it cannot be put aside. This was the case in *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,¹²⁹ where uniforms similar to those worn by the Dallas Cowboy Cheerleaders were worn in the "sexually depraved"¹³⁰ film, "Debbie Does Dallas." The court reasoned that no person who had seen the film could disassociate it from the real cheerleaders.¹³¹ This example points to the power of visual association and to the inadequacies of a disclaimer. Unless a disassociation can be assured, the artist's injury will be aggravated and injunctive relief should be available.¹³²

As is evident from the foregoing discussion, section 43(a) of the Lanham Act can prevent damage to the artist's goodwill and the dilution of his endorsement, and can be a useful tool for the visual artist to control his reputation and the economic rewards commensurate with it.

¹²⁷ See, e.g., *Dallas Cheerleaders*, 604 F.2d 200; *Gilliam*, 538 F.2d 14.

¹²⁸ This example is taken from an actual advertisement for L'Oreal cosmetics appearing nationwide in mid-1982. Under threat of suit by the heirs of Matisse, L'Oreal stopped running the ad. The appeal of using Matisse's name and work in connection with cosmetics is widespread. Christian Dior is presently promoting a new line of cosmetics entitled "Colour Matisse." As a promotion, Dior had a former certified copiest for the Louvre use the Colour Matisse cosmetics to paint a copy of a Matisse painting on a sidewalk in front of a major department store. See *Women's Wear Daily*, July 1, 1983, at 8.

Matisse was dead by the time these cosmetic lines were introduced. For a discussion as to whether the right to prevent such uses of a celebrity's reputation is descendable, see *supra* note 69.

¹²⁹ *Dallas Cheerleaders*, 604 F.2d 200.

¹³⁰ *Id.* at 205.

¹³¹ *Id.*

¹³² Injunctions are granted when there is likelihood of confusion or deception as to source or sponsorship. *Warner Bros.*, 658 F.2d at 79.

V. CONCLUSION

This note has attempted to provide a solution for a problem that exists primarily because visual artists fail to protect their original works of authorship under federal copyright law. Despite strong preemption requirements, both under the 1976 and 1909 Acts, it has been suggested that an artist's uncopyrighted work, although in the public domain, may not be used for unlimited purposes. When a work of art is being used in order to exploit an artist's reputation, the exploiter is misappropriating a value tangential to the work of art. This element of wrongdoing transforms the exploitation from one that is permissible under copyright law to one which an artist can prevent by evoking either the common law right of publicity, which protects the value of a celebrity's reputation, or section 43(a) of the Lanham Act, which prevents the unauthorized use of an unregistered trademark or certification mark when confusion as to sponsorship or endorsement arises.

The right of publicity and section 43(a) of the Lanham Act are constantly being applied in new areas. The use of these two legal theories to provide additional rights to artists is relatively novel. Their use in this manner demonstrates an increased awareness of artists' need for additional rights to supplement those granted by federal copyright law.

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