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The Federalism Case against a Federal Right to Publicity

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Krishan Thakker

Introduction

The goal of this paper is to discuss the tensions between the right to publicity, Intellectual Property law and the First Amendment, while also providing a brief background on the development and evolution of the right to publicity. I will also advocate an argument that a federal statutory right to publicity is not warranted given the significant disparities between state laws and the novelty of such a property right. Both reasons for and against adoption of a federal right to publicity will be debated and discussed, and an examination of the common justifications for the right shall be undertaken.

This paper will proceed in two sections. Section A will discuss an overview of the development of the right to publicity from its foundation in the common law tort of privacy. The State of California shall be the main focus of this essay because of the state's historical underpinning, large pop culture, and unique entertainment industry. It should be noted here that California is not typical among the states. In some respects it has the broadest rights in comparison to all other states. This section will also define the right, its scope and limitations, and ultimately illustrate the breadth given to the right to publicity in the United States.

Section B will go on to reflect on the proposed federalization of the right to publicity dilemma. As a result of the divergence on right to publicity issues in numerous jurisdictions, many commentators have argued that the best solution would be for Congress to enact a federal statute comparable to that of trademark

and copyright law.¹ This would furnish much needed clarity to a gray area of the law, especially in light of new technological advances. However, this thesis argues against such a proposition. Since only half of the states have adopted such a right, enacting a federal statute governing the same seems to be a rash and premature decision. Hence, this section will address the main objections to the right of publicity, and offer support for the right of states to choose such a right. For instance, using choice of law conflicts, whereby state courts are more likely to compensate their own residents than out-of-state residents injured within their borders, will ultimately delimit the right geographically by using a plaintiff's situs or domicile as a guide. Section B will finally discuss how a state-based system, where rights of publicity are not universal, can be functional, particularly since the right to publicity is a property right, which is a state-created right. A significant part of this discussion will be premised upon the issue of how rights of publicity in one state can potentially affect another state. I will also discuss whether the states with the strongest rights can effectively be controlling, and thus alleviate the need for a federal right of publicity.

Section A – The Evolution of the Common Law Right of Publicity

The right of publicity has its foundation in the right to privacy.² Privacy has been defined as "the right of a person and his or her property to be free from unwarranted public scrutiny or exposure."³ In broad terms, the right to publicity

¹ See Stacey Dogan & Mark Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161; Usha Rodrigues, *Race to the Stars: A Federalism Argument for Leaving the Right of Publicity in the Hands of the States*, 87 VA. L. REV. 1201, 1218, 1224-27 (2001) (hereinafter Rodrigues); J. Thomas McCarthy, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C. L. REV. 863 (2003).

² *Lugosi v Universal Pictures*, 25 Cal. 3d. 813, 819 (1979).

³ BLACK'S LAW DICTIONARY 1325 (7th ed. 1999).

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protects a celebrity from having various aspects of his persona used for commercial gain without his authorization. Protection of this public persona was given substance in the 1950's in *Haelan Laboratories v. Topps Chewing Gum*.⁴ The Second Circuit Court of Appeals held that "a man has a right in the publicity value of his photograph, that is, the right to grant the exclusive privilege of publishing his picture."⁵ The court went on to say "that many prominent persons (especially actors and ballplayers), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements."⁶ The court, realizing this potentially powerful economic right existed independent of the right of privacy, suggested calling it a "right of publicity."⁷

The Supreme Court discussed the right to publicity in 1977 in *Zacchini v. Scripps-Howard Broadcasting Co.*⁸ The Court recognized the need to protect the commercial value of an entertainer's reputation. *Zacchini* used as its rationale the same economic philosophy that underlies copyright law.⁹ The Court held "that the protection provides an economic incentive for him [the performer] to make the investment required to produce a performance of interest to the public."¹⁰

California

In California, the right of publicity is governed by legislation and common law. Both causes of action, as is true elsewhere across the nation, trace their

⁴ 202 F.2d 866, 868 (2d. Cir. 1953).

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

⁸ 433 U.S. 562 (1977).

⁹ *Id.* at 576.

¹⁰ *Id.*

origins to the right to privacy.¹¹ In 1931, a common law right to privacy was recognized in the well-known case of *Melvin v. Reid*.¹² In *Melvin*, the plaintiff sought damages from a producer who had made a movie, "The Red Kimono," based on the plaintiff's past life. The Court held the plaintiff's complaint stated facts that were sufficient to establish a cause of action. Due to a lack of uniformity in the early privacy cases, the Court reasoned the label put on the right, which the cause of action was based upon, was immaterial.

The Court emphasized that California law recognized "the right to pursue and obtain safety and happiness without improper infringements thereon by others."¹³ Later, Dean Prosser detailed the four distinct torts that gave rise to a cause of action under the privacy rubric.¹⁴ The four tort causes of action are: "(1) intrusion upon the plaintiff's seclusion or solitude; (2) public disclosure of private facts; (3) placing the plaintiff in a false light in the public eye; and (4) appropriation, for defendant's advantage, of plaintiff's name or likeness."¹⁵ It was from Prosser's fourth tort classification, appropriation of plaintiff's name or likeness for use or benefit by the defendant from which the right of publicity developed.¹⁶ Controversy has existed as to which aspects of persona identify individuals, since a right of publicity has been recognized as a separate right.

¹¹ *Wendt v. Host Int'l*, 125 F.3d 806, 811 (9th Cir. 1997).

¹² 112 Cal. App. 285 (1931).

¹³ *Id.* at 292.

¹⁴ William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960) (hereinafter Prosser).

¹⁵ *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d. 821, 824 (citing Prosser, *supra* note 14.).

¹⁶ RESTATEMENT (THIRD) OF UNFAIR COMPETITION, APPROPRIATION OF TRADE VALUES: RIGHT OF PUBLICITY 46 (1995).

The codified version of California's appropriation statute is contained in its Civil Code.¹⁷ Voice and signature were not in the statute as originally codified, but were added in the 1984 amendment.¹⁸ By choosing to plead a cause of action pursuant to Section 3344, a plaintiff does not forfeit his right to also plead the tort under common law, and hence the statute does not preempt use and development of a common law cause of action.

Decisions stemming from this statute have not generated the controversy that has resulted from its common law counterpart. In 1983, the California Court of Appeals in *Eastwood v. Superior Court* stated the elements needed to plead a right of publicity under common law.¹⁹ The elements are "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury."²⁰ The court further explained the distinction between the statutory and common law actions.²¹ Furthermore, "remedies are cumulative and in addition to any provided by law."²² In the court's list of differences, there was no mention of other means of appropriating one's identity that would be available in one cause of action over the other.

¹⁷ CAL. CIV. CODE § 3344 (1984) ("Any person who knowingly used another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, shall be liable for any damages sustained by the person or persons.").

¹⁸ *Id.* § (e).

¹⁹ 149 Cal. App. 3d 409, 417 (1983).

²⁰ *Id.*

²¹ *Id.* (Section 3344(a) "requires a knowing use, whereas under case law, mistake and inadvertence are not a defense against commercial appropriation.").

²² CAL. CIV. CODE § 3344(g) (1984).

Generally, a federal court, in deciding a case based on state law, applies the law as it believes the highest court in the state would apply it.²³ However, the California Supreme Court has not had the opportunity to decide a right of publicity case since 1979.²⁴ As a result, the Ninth Circuit has become the "voice" for California in this area. It seems to have not been content with the California court's narrow and restrictive interpretations of its own state laws, and has proceeded to overrule their cases and rewrite the common law tort with expansive interpretations. In *Midler v. Ford Motor Co.*, a former back-up singer to Bette Midler was hired to record a song made famous by Midler, and to imitate her as closely as possible for a radio commercial.²⁵ The ad agency had properly acquired the rights to the song from the copyright holder, and neither Midler's name nor picture was used in the advertisement. The district court held that there was "no legal principle preventing imitation of Midler's voice" and granted summary judgment for Ford.²⁶ The Ninth Circuit, however, disagreed, holding that Midler had a cause of action under common law. The court explained that to impersonate Midler's voice was akin to pirating her identity.²⁷ The court also ignored the fact that Midler had failed to satisfy the second prong needed for a common law right of publicity claim as stated earlier in *Eastwood*, i.e., appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise.

²³ *Erie R.R. v. Tompkins*, 304 U.S. 64, 78 (1938).

²⁴ *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860 (1979).

²⁵ 849 F.2d. 460, 461 (9th Cir.1988).

²⁶ *Id.* at 462.

²⁷ *Id.* at 463.

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With this decision, the court contradicted one of its own earlier decisions. In *Sinatra v. Goodyear Tire & Rubber Co.*,²⁸ faced with essentially the same facts as in *Midler*, the Ninth Circuit reasoned that the defendant “paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all its arrangements.”²⁹ In essence, the court was stating that it creates an impermissible burden to have the proprietor obtain permission from every artist who sang the chosen song. The *Midler* court suggested Ford and its advertising agency needed a license because (i) Midler sang the song, and (ii) because they imitated her voice so closely that people thought she was singing in the advertisement. Nonetheless, Midler’s common law right to publicity seemed to have trumped any license right to use the song. The *Midler* decision started a trend by this court of giving very little deference to federal copyright law.

*Waits v. Frito-Lay*³⁰ followed closely on the heels of *Midler*. In *Waits*, an ad agency hired a singer to record a song in the style of the gravelly-voiced Tom Waits. The ad agency, like the one in *Midler*, had properly acquired the rights to the song. Like *Midler*, this fact had little importance in the trial. Waits, like Ms. Midler, was successful in his voice misappropriation and right of publicity claim under common law. Once again the second prong of the common law tort as set forth in *Eastwood* was disregarded by this Court.

The ultimate expansion of this law came in *White v. Samsung Electronics America, Inc.*,³¹ which involved an advertisement for Samsung's videocassette recorders. The particular ad, which prompted the controversy, depicted a game

²⁸ 435 F.2d 711, 717-18 (9th Cir. 1970).

²⁹ *Id.* at 717.

³⁰ 978 F.2d. 1093 (9th Cir. 1992).

³¹ 971 F.2d 1395 (9th Cir. 1992).

board which, according to the court, instantly called to mind “The Wheel of Fortune” television game show. A robot, adorned in an evening gown, jewelry and a blonde wig on top, was posed next to the board. The caption contained in the ad read, “Longest running game show.” Vanna White, a well-known hostess of the “The Wheel of Fortune” game show, sued Samsung and their ad agency. Nowhere in the ad was White's name or picture. The district court rejected White's right of publicity claim under both Section 3344 and common law. In rejecting the common law claim, the court specifically stated that White had failed to satisfy the second prong stated in *Eastwood*.³² However, the Ninth Circuit held White did have a claim under common law. The Court reconciled the name and likeness issue by explaining that the specific means of appropriation are not confined to those articulated in previous case law.³³ This holding suggests that anything that brings to mind a celebrity may be actionable under the identity prong.

Kozinski’s Dissent

After the court's decision, the Ninth Circuit was notified of a petition for rehearing en banc, which was subsequently denied. In Judge Kozinski's dissent, he argued that the court's "broad application of the right of publicity put state law on a collision course with the federal rights of the copyright holder." This situation in *White* was still hypothetical at the time. It is against this backdrop that *Wendt v. Host International, Inc.* made its way into the Ninth Circuit. At

³² *Id.* at 1397.

³³ *Id.* at 1398.

issue in this case, however, was the copyright issue touched upon in *Midler*, *Waits*, and Kozinski's dissent.

Judge Kozinski, joined by Judges O'Scannlain and Kleinfeld, issued a vigorous dissent in *White* in which he attacked the panel's holding on several grounds. Much of the dissent focused on the need to balance publicity rights against free speech rights granted by the First Amendment, and argued that the panel had not properly done so here.³⁴ It also suggested that such a broad right of publicity offends more of the Constitution than just the First Amendment.³⁵ Invoking the dormant Copyright Clause, Kozinski noted that the Supreme Court has held that "state intellectual property laws can stand only so long as they do not 'prejudice the interests of other States.'"³⁶ Kozinski asserted that an out-of-state advertiser would be subject to the publicity law of a plaintiff's domicile state even if the advertiser took care not to display the complained-of advertisement there because "[a] right of publicity created by one state applies to conduct everywhere."³⁷ Kozinski continued:

The broader and more ill-defined one state's right of publicity, the more it interferes with the legitimate interests of other states. A limited right that applies to unauthorized use of name and likeness probably does not run afoul of the Copyright Clause, but the majority's protection of "identity" is quite another story.³⁸

He also complained that the panel failed to analyze whether the restriction it was defining from the common law was "unconstitutionally vague," suggesting it may

³⁴ 989 F.2d. at 1512–17, 1519–21 (Kozinski, J., dissenting).

³⁵ *Id.* at 1517–19 (Kozinski, J., dissenting)

³⁶ *Id.* at 1518 (quoting *Goldstein v. California*, 412 U.S. 546, 558 (1973)).

³⁷ *Id.*

³⁸ *Id.* at 1519.

not have sufficiently defined “identity” so as to satisfy the requirements of due process.³⁹

In the early 1990's, *Wendt* made its way into federal court in California. At issue was a celebrity's right to control the use of his likeness in the commercial marketplace. Host International acquired from Paramount Pictures Corporation the right to replicate the tavern setting in “Cheers,” familiar to viewers of the long running series, in a chain of airport bars across the country. At each location, Host placed two animatronic robots on seats around the bar. These robots, “Hank” and “Bob,” were based on two characters usually found at the popular TV show bar. They also were copyrightable components of the show and were properly attained by Host. It is important to note that Host changed the robots’ appearances so that they did not look like the actors, and changed their names to Hank and Bob in a half-hearted way to avoid litigation. As a result, the actors who portrayed the original “Norm” and “Cliff” characters, George Wendt and John Ratzenberger, respectively, sued Host for the misappropriation of their respective identities in the design of the robots.

The district court granted summary judgment in favor of the Host. The Court compared photographs of the robots to Wendt and Ratzenberger, finding as a matter of law, that their likenesses were insufficient to state a cause of action under both the California statute and common law. The Ninth Circuit reversed

³⁹ *Id.* at 1519–20 (citing *Posada de P.R. Assocs. v. Tourism Co.*, 478 U.S. 328, 347 (1986)). The Supreme Court has repeatedly applied the void-for-vagueness doctrine with stricter scrutiny to laws that threaten First Amendment freedoms. *See, e.g.*, *Coates v. Cincinnati*, 402 U.S. 611, 614 (1971) (ordinance was “unconstitutionally vague because it subjects the exercise of the right of assembly to an unascertainable standard”); *Smith v. California*, 361 U.S. 147, 151 (1959) (“[S]tricter standards of permissible statutory vagueness may be applied to a statute having a potentially inhibiting effect on speech; a man may the less be required to act at his peril here, because the free dissemination of ideas may be the loser.”).

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and remanded.⁴⁰ On remand, the robots were viewed in court, and again summary judgment was granted. The Court held that it could not “find . . . any similarity [between the robots and the actors] at all except that one of the robots, like one of the plaintiffs, is heavier than the other. The facial features are totally different [from those of the plaintiff’s].”⁴¹ The actors appealed the second grant of summary judgment, and the court once again remanded the case to the district court. In this trial, Host based its defense on the rights guaranteed to them by federal copyright law. Each time the case was before the Ninth Circuit, the Court rejected Host's assertion that the actors' claims were pre-empted by federal copyright law. The Court stated as long as their claims "contain elements, such as the invasion of personal rights that are different in kind from copyright infringement," they are not pre-empted.⁴²

Federal Copyright Pre-emption

Judge Kozinski, joined by Judges Kleinfeld and Tashima, issued a dissent in *Wendt* after the court failed to rehear the case en banc.⁴³ The dissent criticized the majority's favored treatment of the common law right of publicity in regard to federal copyright law.⁴⁴ Kozinski reiterated many of the concerns he expressed in *White*, although he seemed even more disturbed by this case, because Host had acquired a license to use the *Cheers* copyrights.⁴⁵ Kozinski argued that these rights, granted by the federal Copyright Act, should preempt whatever publicity

⁴⁰ *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir.1997).

⁴¹ *Id.* at 809.

⁴² *Id.* (quoting *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992)).

⁴³ *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284.

⁴⁴ *Id.* at 1285.

⁴⁵ *Id.*

rights the plaintiffs have under the facts of that case.⁴⁶ He also pointed out the court's decision put it in conflict with the Seventh Circuit, which had held the Copyright Act preempts the right of publicity when the latter would prevent ordinary use of the copyrighted work.⁴⁷ Kozinski then elaborated on his dormant Copyright Clause concern expressed in *White*, which preempts state intellectual property laws to the extent they "prejudice the interests of other States," asserting that permitting California's expansive publicity right to set the national standard for permissible use of a licensed derivative work creates a "constitutional conundrum."⁴⁸ He also took the panel to task for applying California's publicity laws to Host's out-of-state activities. Kozinski suggested a potential Commerce Clause violation might exist when a state applies its anomalous laws extraterritorially.⁴⁹ By analogy, in *Kassel v. Consolidated Freightways Corp.* the Court held that a state law that regulated the length of trucks was invalid under the dormant Commerce Clause if it substantially interfered and/or posed an undue burden on interstate commerce.⁵⁰ Kozinski argued that California's right of publicity should be held invalid, in the same way as the state law in *Kassel*, if it "substantially interferes with federal copyright law, even absent preemptive legislation."⁵¹

It is the author's opinion that Judge Kozinski's preemption analysis was more persuasive than that of the majority's. Although not mentioned in Kozinski's opinion, the preemption doctrine stems from the Supremacy Clause of

⁴⁶ *Id.* at 1285–87.

⁴⁷ *Id.* at 1287.

⁴⁸ *Id.* at 1288.

⁴⁹ *Id.*

⁵⁰ 450 U.S. 662 (1981).

⁵¹ *Wendt*, 197 F.3d at 1288.

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the United States Constitution.⁵² Under the Supremacy Clause, when Congress acts under one of their enumerated powers, any state regulation that conflicts with the resulting federal law is pre-empted. Congress, in enacting the various components of the Copyright Act, derives its power from the Copyright Clause of the Constitution.⁵³ Title 17, Section 301 of the U.S. Code states the basis for the two-prong preemption test. The relevant part provides:

[A]ll legal or equitable rights that are the 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.⁵⁴

In *Wendt*, the subject matter of the claim was two robots Hank and Bob.

Original works of authorship fixed in any tangible medium of expression as defined in Section 102 include dramatic works when embodied in a copy sufficiently permanent or stable to permit it to be perceived.⁵⁵ Once “Cheers” was put on television the dramatic work was fixed in a tangible medium of expression and fell under copyright protection. Section 106 provides the copyright holder with the exclusive right to create derivative works.⁵⁶ Hank and Bob are based on the show's characters with the same name. Therefore, the first prong is satisfied. The second prong, however, depends on whether the state-created right encompasses elements personal to the actor that are different in nature from those

⁵² U.S. CONST. art. VI, Cl. 2.

⁵³ U.S. CONST. art. I, § 8, cl. 8.

⁵⁴ 17 U.S.C. § 301(f)(1) (1990).

⁵⁵ See 17 U.S.C §102 (1990).

⁵⁶ 17 U.S.C. §106 (2002).

contained in copyright. The subject matter litigated is fictional: robots, based on fictional television characters, do not possess any personal attributes. Therefore, the state right is void of any extra elements, such as defamation, and accordingly should be preempted by the Copyright Act.

Judge Kozinski asserted the copyright held by the defendants preempted whatever state law rights the plaintiffs claimed, insofar as state law would prevent ordinary use of the copyrighted work. He argued the plaintiffs' right to control the use of their likeness should be preempted by Paramount's right to exploit the Norm and Cliff characters, and if the plaintiffs wished to control how the characters were portrayed on the show then they should have negotiated previously. Further, Kozinski argued that a copyright licensee should be able to exercise rights that are intrinsically federal without the concern that fifty other states will burden them.⁵⁷ He went on to say that this is precisely what the majority approved of here; that is, by allowing plaintiffs to use California law to prevent Host from displaying a copyrighted work in Kansas City/Cleveland, and ultimately, in effect enforcing California's right of publicity beyond its own state borders.⁵⁸

Conclusion

Since its decisions, the Ninth Circuit has expanded California's common law right of publicity without any real basis for doing so. Its rationale seems to be the common-law right of publicity, in light of growing pop culture and unfair competition concerns, should protect indicia, such as the celebrity's name,

⁵⁷ Wendt, 197 F.3d at 1288.

⁵⁸ *Id.*

persona, voice, likeness, image, and evocation-of-identity. The court seems to have attached more importance to whether a defendant, for instance, actually appropriated a celebrity's identity rather than to how the identity was itself appropriated.

Nonetheless, the court has proceeded in this manner even in the absence of California case law supporting as liberal an interpretation as that taken by the Ninth Circuit. The actions of the California Legislature do not provide support for the Ninth Circuit's expansion of the common law right. During this same fifteen-year period, the legislature has not made any amendments to the statutory counterpart indicating a desire to limit the scope of the law, though it could have amended the law if it was unhappy with either the *White* or *Wendt* decisions. The Ninth Circuit, with this expansion of the common law right, has put more and more hurdles before those who attempt to use copyrights. The exclusivity of ownership that is inherent to a copyright becomes compromised if actors acquire similar legal rights to a character simply by portraying it. This potential situation also threatens the holder's right to benefit financially from derivative works. If the actor refuses to consent to how the character is used, the derivative work ultimately becomes jeopardized. For many, derivative works are the avenue taken to recover the monetary expenditure invested in the copyright. Since the cases are not coming before California state courts, but rather before federal courts, one could argue that now seems an appropriate time for the legislature to step in and provide clarity on the subject matter.

Recently, the right of publicity received recognition in the American Law Institute's Restatement (Third) of Unfair Competition.⁵⁹ For the first time, the Restatement incorporates a right of publicity as an independent component of unfair competition law and intellectual property law expressly recognizing the commercial dimensions of the right of publicity. The protected interest is characterized as “the commercial value of a person's identity.”⁶⁰ Because this interest is protected, unauthorized advertising or merchandising using an individual's identity is actionable. Even today, however, *Wendt* has not been explicitly overruled and remains to be good law in this area. Henceforth, it is from such a point where we formulate the basis for our next section.

Section B – The Federalization Debate of the Common Law Right of Publicity

The right of publicity at the present time varies widely from state to state. It is indeed a right crafted by states, either through statute or common law. Twenty-seven states presently have some form of the right.⁶¹ Others do not recognize the right at all. Among states that recognize the right, its boundaries dramatically differ. For example, in Florida, publicity rights last forty years after the death of a celebrity.⁶² Kentucky, Texas and Nevada provide rights that will lapse after fifty years, whereas California's right lapses after seventy years.⁶³ The

⁵⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION, §§46-49 (1993).

⁶⁰ *Id.* The text of section 46 states “[o]ne who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.”

⁶¹ Bruce P. Keller & David H. Bernstein, *The Right of Publicity: Towards a Federal Statute?*, 532 PLI/PAT 413, 418 (1998) (hereinafter Keller & Bernsetin).

⁶² Bruce P. Keller, *The Right of Publicity: Past, Present and Future*, 808 PLI/COMM 159, 181 (2000) (hereinafter Keller).

⁶³ *Id.*

right in both Indiana and Oklahoma survives 100 years after the death of a celebrity.⁶⁴ Tennessee and Nebraska allow the right to continue indefinitely, though in the former the rights will terminate if they are not used for two consecutive years.⁶⁵ There are also differences in terms of the aspects of persona that are protected (e.g., voice) and whether the right is assignable or descendible. As a result of such differences, a federal right to publicity, for example, would reduce costs to potential defendants, who would otherwise have to investigate the laws of each state in which they wished to market or advertise.⁶⁶ It would also reduce the confusion occasioned by state differences as to whether the commercial value of the persona must be exercised, unless it be deemed waived.⁶⁷

One might suggest that, given the enforcement and choice-of-law difficulties, limiting plaintiffs to state causes of action diminishes the essence of the right of publicity. However, there is no requirement that national law be changed to maximize state causes of action. Property is traditionally an area reserved to the states, and the state-varied property regime of community property has existed since time immemorial. The fact that the law in the area of the right of publicity is not clearly settled does not lead to the conclusion that the federal government must step in to resolve the disputed issues. An equally plausible reading of the current situation is that the states are still trying to work out the proper contours of a relatively young right, and the federal government should wait until state law has matured. Most states have rarely addressed cases of

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ Rodrigues, *supra* note 1.

⁶⁷ *Id.*

commercial appropriation of identity, if at all.⁶⁸ Some examples are Alaska, Minnesota, and New Hampshire.⁶⁹ Although twenty-seven states have recognized a form of the right of publicity, “only about a dozen have taken unambiguous steps to create a true property right.”⁷⁰

The Case for Federalizing the Right to Publicity

I. Confusion Among States

Considering over forty years have passed since *Haelan*, the time may have come for a federal authority to take a second look at the issue of divergence. It has been argued by a multitude of legal academic commentators that the best solution is a federal statute comparable to trademark and copyright law. Such a law, often discussed but not implemented, might be beneficial in regard to the large differential on right of publicity issues in the numerous jurisdictions that recognize the right. Choice-of-law issues may become crucial as the exploitation of identity can occur much more easily and quickly at the national level, for example, via the Internet). A consensus in this gray area of law would ultimately promote certainty and, consequently, reduce forum shopping. The federal statute obviously would have to be drafted so it is sensitive to technological advances and takes into account free speech concerns. Even if the right of publicity is a significant proprietary right, it must always defer to the constitutionally protected right of First Amendment freedom of speech. This contention is strengthened by virtue of the fact that it is the free market forum which is sustained by the free

⁶⁸ Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?* 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 35, 40 (1998).

⁶⁹ *Id.*

⁷⁰ *Id.* at 41; Zimmerman only lists California, Florida, Georgia, Indiana, Kentucky, Nevada, Oklahoma, Tennessee, and Texas, however.

exchange of ideas and speeches which created the foundation from which all celebrities emerged in the first place, and still continue to do so today.

II. Confusion Among Federal and State Laws

The majority of justifications for federalizing a right to publicity come from justifications actually having the requisite right, namely that of labor, unjust enrichment, personal autonomy, incentive, efficiency, and consumer confusion.⁷¹ For instance, if one agrees that both personal autonomy and economic concerns outweigh freedom of expression, one would indeed accept the idea of federalizing the right of publicity. Having a First Amendment exception in this case could then protect images used in the media.⁷² Another reason for federalization lies in the demarcation line between state and federal law. There is a confusing boundary which potential litigants face when bringing suit. Many plaintiffs usually tend to include federal claims in their causes of action, based on Section 43(a) of the Lanham Act, so as to get their cases heard before a federal court. Therefore, the majority of state law in this disputed area actually stems from federal courts hypothesizing about how a state court would rule upon such an issue.⁷³

There are additionally potential conflicts between state rights of publicity, federal copyright law, and the Lanham Act. As discussed above, Section 301 of the Copyright Act preempts state created rights that are equivalent to those created by the Copyright Act and which cover the same subject matter as the

⁷¹ Rodrigues, *supra* note 1.

⁷² *Id.*

⁷³ *Id.*

Act.⁷⁴ While some commentators believe that the Act preempts state rights of publicity, others disagree either because a persona is not a writing or because the right protects an interest different from that of a copyright. Any preemption analysis would conceivably depend on the scope of the state right of publicity. In any case, if the rights of publicity were to be federalized, other federal laws would not preempt it; though, it still would be limited by the First Amendment.

The Lanham Act is another area of potential conflict for right of publicity causes of action. A federal right of publicity may be required if plaintiffs cannot rely on the Lanham Act for full protection.⁷⁵ The Act requires the involvement of goods and services, an effect on interstate commerce, and false designation of origin or description.⁷⁶ The Lanham Act, however, does not always apply to publicity cases, because its application “is limited . . . to potential deception which threatens economic interests analogous to those protected by trademark law.”⁷⁷ In *Carson v. Here's Johnny Portable Toilets*,⁷⁸ the Sixth Circuit denied relief under the Lanham Act because there was no likelihood of confusion, but granted relief under the right of publicity theory. The Lanham Act does not focus on injuries to persons that occur as a result of the misappropriation of that person's name, likeness, or identifying characteristics. The Act’s “purpose is ‘the protection of consumers and competitors from a wide variety of misrepresentations of products and services in commerce.’”⁷⁹ If forced to solely

⁷⁴ 17 U.S.C. § 301 (1990).

⁷⁵ See 15 U.S.C. § 1125 (2006).

⁷⁶ *Id.*

⁷⁷ *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985).

⁷⁸ 698 F.2d 831 (6th Cir. 1983).

⁷⁹ *Allen*, 610 F. Supp. at 625 (quoting *C.B.S. v. Springboard Int'l Records*, 429 F. Supp. 563, 566 (S.D.N.Y. 1976)).

rely on this Act, individuals with legitimate publicity claims may go uncompensated. Thus, those expropriated cannot always rely on the Lanham Act to vindicate their rights. However, to the extent deception is used in advertising by expropriating personas, Lanham Act values are important. Because the right of publicity is such a unique combination of varying rights, including trademark, the Lanham Act should be used only to protect what it was designed to protect. The Act's features, which are relevant to a publicity right claim, can be incorporated into the proposed publicity statute. In this way all the varying policies can be accommodated.

III. Certainty in Litigation

The chief attraction of a uniform federal law of publicity is that it would solve the problems of uncertainty that both plaintiffs and defendants face in this area, as mentioned earlier. The uncertainty occasioned by choice of forum and choice of law is also a major concern in these cases. The burden of nationwide enforcement is considerable if state court remedies are limited to 'in-state' infringement. Thus, a federal right of publicity would give celebrities the incentive to create more novel and innovative works of authorship that are distributed nationally, by lowering the cost of enforcement related to protecting one's image. Those plaintiffs who still thought the right of publicity was a questionable development in the law could potentially still rely on either the Lanham Act and/or Copyright Act to protect the most egregious, false-endorsement-type behavior, and conflicts with these federal statutes would no longer pose such a problem since individual plaintiffs would have a choice of which federal statute and cause of action to bring a claim upon.

IV. Forum-Shopping and Choice of Law issues

Finally, courts are often more inclined to apply their own state's law even if other states have an interest in the outcome of a particular decision.⁸⁰

California, Kentucky, Florida, Oklahoma, Utah, and Virginia have statutes that either do not require the defendant or plaintiff to reside in the state, or require that the commercial exploitation/use take place in the state. Therefore, the defendant, theoretically, can be brought in with a long-arm statute by selling products or even showing advertisements within the state, and states could have a large scope of permissible power over actions in other states. As a result of this dilemma, many defendants unfortunately have no way to predict when they will be liable.

Nonetheless, the courts have overcome forum-shopping for plaintiffs by imposing a requirement that there exist a real connection to the state. In *Cairns v. Franklin Mint Co.*, a federal court denied a claim under California law because the claimant sued on behalf of Princess Diana, who, at the time of her death, was domiciled in Britain, which does not recognize the right of publicity. Applying California law, the Ninth Circuit affirmed the finding that this claim failed because Great Britain did not recognize a post-mortem right. While this was not an Internet case, it illustrates the complexities of jurisdictional and choice-of-law issues that are commonly faced in cases involving Internet usage. Even when a court decides which state's law applies, it usually struggles over the scope of the

⁸⁰ See *Groucho Marx Productions v. Day and Night Co.* 689 F.2d 317 (2d Cir. 1982). This case involved a Broadway musical called *A Day in Hollywood, A Night in the Ukraine* and three performers who reproduced the comic style of Groucho, Chico, and Harpo Marx. The District Court for the Southern District of New York ruled that New York law governed, since the play ran longest there, and the Marx Brothers characters were originally developed in New York. The Second Circuit reversed, ruling that a New York court would apply California law, since the Marx Brothers were California residents at their deaths, and the plaintiff was a California corporation. Further, before his death Groucho assigned his right of publicity to the plaintiff with a contract executed in California. Finally, Chico's estate did the same eighteen years after his death.

injunction. Even within the same circuit, courts have differed about the scope of injunctions in right of publicity cases.⁸¹

This brings us to the obstacle concerning remedies. Theoretically, according to the current state-based system, plaintiffs may have to bring fifty suits, so as to prevent commercial exploitation of their personas across the country. In the alternative, damages could be reduced to those within the state declaring judgment, or defendants might be able to convince a court to limit damages to the amount available in states where the plaintiff has won or could potentially win. Even still, such an analysis would consist of a very burdensome examination of the law of all fifty states.⁸² If an injunction was sought and granted in one state, what would be the jurisdictional reach of it in other states?

As noted by Eric J. Goodman:

An injunction may easily be obtained in Tennessee, but it is not clear how far that injunction will reach. In New York, for example, courts have held that the state's publicity law does not extend to violations involving out-of-state sales. Lawyers cannot give their clients anything even resembling an unqualified opinion under the current scheme of various state laws.⁸³

Goodman further explains that “[i]t has become very difficult for lawyers to properly advise their clients on right of publicity matters because parties tend to forum shop.”⁸⁴ Overall, the disparity in state law impacts potential defendants as much as potential plaintiffs. With national advertising and the Internet, the rights

⁸¹ Compare *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (nationwide injunction), and *Herman Miller v. Palazzetti Imports and Exports*, 270 F.3d 298 (6th Cir. 2001) (injunction limited to certain states because of disparities in their laws).

⁸² Keller, *supra* note 62.

⁸³ Eric J. Goodman, *A National Identity Crisis: The Need For a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. LAW 227, 244 (1999).

⁸⁴ *Id.*

of publicity laws of all states come into play. For example, consider a firm preparing a national marketing campaign. Not only must that firm review potential liability along the "axis" of states that do and do not recognize the right, but it also must consider how the variation in the contours of the right from state to state impacts that potential liability, and then consider how states' different conflict of laws rules further complicate the matter.

Given such complexity, companies and advertising firms face unpredictable outcomes in potential litigation over the use of names, photographs, voices, or other indicators of an individual's identity, when they have not sought the individual's consent. This is especially true when identities are used on the Internet, where it is often unclear what state's laws apply. This confusion above buttresses the idea of having a national right, especially if states are extending their reach beyond their borders. This notion plays heavily against letting states innovate their own rights to publicity since there is a risk of allowing them to overstep their constitutional and jurisdictional boundaries and limits. To some extent, the use of any single state's law to govern a controversy with significant multistate consequences will inherently be arbitrary.⁸⁵ It has been argued that this could be solved by discerning the state of greatest infringement.⁸⁶ In this scenario, the law of the state of greatest infringement would apply to the right of publicity controversy, which may be less arbitrary than applying law selected via a choice of law factors, which do not focus on the situs of the alleged injury.⁸⁷

⁸⁵ Richard Cameron Cray, *Comment, Choice of Law in Right of Publicity*, 31 UCLA L. REV. 640, 665-66 (1984) (hereinafter Cray).

⁸⁶ *Id.*

⁸⁷ *Id.* at 663.

Currently, however, the dominant U.S. choice-of-law rule is that right of publicity cases are decided using the law of the jurisdiction in which the plaintiff lives, or was living upon death. For example, if John Ashcroft moves back to Missouri, and someone writes a novel or produces a movie in which one of the characters is named John Ashcroft, and consequently Ashcroft sues, even outside Missouri, then a majority of courts would apply Missouri law. Therefore, Ashcroft might win if the jury decides that the novel or movie used his name primarily for “commercial” purposes, rather than “expressive” or “artistic” purposes. Even if Ashcroft had to sue in Missouri court, he could still probably get jurisdiction over defendants, regardless of whether defendants had any personal connection to Missouri. Ashcroft could certainly get jurisdiction over, for example, United States media companies that published and distributed alleged infringing work. Thus, Missouri law ultimately would affect anyone who could create commercially distributed books, movies, etc., whether in Missouri or not.⁸⁸

THE CASE AGAINST FEDERALIZING THE RIGHT TO PUBLICITY

I. Flexibility with State-Based System Leading to Competition

Since half of the states do not recognize the right of publicity, there is no clarity that protection of the right would be a clear benefit. Different states currently have the flexibility to experiment with a variety of forms of the right and can enact one that meets their present needs. Another criticism of federalization in this contested area is that states would be discouraged from competing for

⁸⁸ See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) (applying California right of publicity law when Hawaiian plaintiffs sued in federal court sitting in California).

celebrities as they do for corporations.⁸⁹ A response to this is that a state might engage in competition, despite tax revenues, by having a significant celebrity population, thereby increasing its tourism and exposure. Furthermore, if celebrity domicile is a matter of indifference, then states would not compete for celebrity domicile but would in other areas. However, the current variation in state law suggests some competition might in fact exist.

Some suggest the problem of a multistate publicity action could be solved by adopting a similar method to one applied in defamation and privacy actions.⁹⁰ In such cases where there was, for instance, publication in several states, courts adopted out of practical necessity only a single cause of action governed by the law of one state; that is, the law of the plaintiff's domicile.⁹¹ This strategy, if adopted in the right of publicity context, may drive states to compete with each other for celebrity residency as they do for banks and corporations. In federalism terms, this would allow states to vary the protection celebrities receive within their borders. It might well be in a state's interest to encourage in-state individual enterprise and creativity by vigorously enforcing celebrities' rights of publicity.

II. Prematurity of Right to Publicity

Given the various criticisms of a national federal right to publicity, and the varying definitions of the same, it is premature to choose one state's system over another's and enact it as a national law. Another factor to consider is the precise form the federal right should take. State regimes today differ enormously as to

⁸⁹ Rodrigues, *supra* note 1.

⁹⁰ Cray, *supra* note 85.

⁹¹ *Id.* at 666.

assignability, protected features, and survivorship.⁹² An analogy can be drawn here to corporate law in the United States, because every state has its own corporate law. Delaware is deemed to be the best and most favored state in which to incorporate, since it features such a sophisticated judiciary and well-developed case law, which led to a level of shareholder protection optimal for wealth maximization. Relatedly, federalism is significant in the right to publicity context, because through competition the best form of right to publicity can emerge. One could argue that states would never compete for celebrities in the way they would for corporations. The choice of domicile for celebrities is likely driven by factors such as convenience, personal preferences, career concerns, and ambitions, rather than by the perceived urgency of protecting one's own persona and image. Hence, it is unlikely a celebrity would use their right of exit as readily as a corporation would. Notwithstanding this, it is true that film stars live in California not only because that is where the majority of Hollywood studios, movie producers, screenwriters and entertainment industry professionals are based, but also because it has broad publicity rights.

Judge Mansfield in his dissent in *Factors Etc. v. Pro Arts* has asserted this practical reality, “[I]t would be rational for the Tennessee courts to adopt a policy enhancing the continued growth of Nashville and Memphis as centers for the lives and activities of music industry personalities.”⁹³ Such a comment is important because it recognizes the protection of stars in order to encourage a state entertainment industry as a legitimate state goal. According to conventional

⁹² Keller & Bernstein, *supra* note 61.

⁹³ *Factors Etc. v. Pro Arts*, 652 F.2d 278, 288 (2d Cir. 1981) (Mansfield, J., dissenting).

notions of federalism, state experimentation can also be beneficial to the nation as a whole. Judge Brandeis viewed states as laboratories that experiment and discover the best national solution.⁹⁴ In our context, the “best” would conceivably mean an ideal balance of free speech protection and celebrity protection that does not significantly increase the price of the relevant goods, namely the price a celebrity demands. Realizing that different situations and jurisdictions might have in mind different solutions to the same problem, the federalism argument allows different approaches to be taken by different states.⁹⁵ Because no firm consensus has, to date, come about on what makes the most effective right to publicity system, such a federalism model, as advocated here, would keep the issue within state hands. The Supreme Court in *Board of Regents of State Colleges v. Roth* stated,

Property interests, of course, are not created by the Constitution. Rather they are created and their dimensions are defined by existing rules or understandings that stem from an independent source such as state law.⁹⁶

In the end, there is no agreement on the level of protection celebrities should be granted. Until a general consensus is reached, it would be premature to enact one version of the right to publicity as a federal law. Instead, we should let the several states experiment with rights of publicity models. The fact that half of the states have adopted some kind of the right leads one to believe it is likely the right will exist in the future and there may lead to nationalization. The problem in recognizing such a right, however, lies in defining the contours and limitations.

⁹⁴ See *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting).

⁹⁵ David L. Shapiro, *Federalism: A Dialogue* 81 (1995) (citing Richard Revesz, *Rehabilitating Interstate Competition: Rethinking the “Race-to-the-Bottom” Rationale for Federal Environmental Regulation*, 67 N.Y.U. L. REV. 1210, 1234 (1992)).

⁹⁶ *Bd. of Regents of State Colls. v. Roth*, 408 U.S. 564, 577 (1972).

In order to achieve this, states should take into account the justifications for having the right, and their counterarguments, when it comes to deciding how broad or narrow to make the right.⁹⁷ For example, if the state's rationale for the right is one of personal autonomy, then the right should terminate upon death, when individual autonomy no longer needs protection.⁹⁸ If such a justification is incentive-based, then states should the decreasing marginal utility of extending the rights for decades after a celebrity's death.⁹⁹ On the other hand, if a state decides to support the right with a labor theory, then the fruit of the celebrity's hard work could have a degree of continuity post-mortem, possibly in perpetuity.¹⁰⁰

One possible solution courts have used is the domicile factor, on the basis that states are more likely to compensate their own residents than foreigners injured within their borders.¹⁰¹ This approach may be criticized as artificial, given the intangible nature of the property in question here. Though if a state makes the right of publicity a property right, the next step is to try to limit it geographically and use its situs as a guide in choice-of-law queries. Also problematic is the fact that this approach is more akin to privacy actions, where the cause of action is

⁹⁷ California has a state law regime that many think is expansive. See, e.g., *White v. Samsung Electronics America*, 989 F.2d 1512 (9th Cir. 1993). Professor Arlen W. Langvardt, rejects the idea that the "Wheel of Fortune" set pictured in the advertisement was a personal attribute of Ms. White. If anyone should sue, he argues, it should be the show's copyright holder. One of the dangers he sees in the White decision is the prospect of an "Orwellian" world where attenuated reference is enough to trigger liability. Another danger is that it creates a property right without limits. This enhances copyright conflicts and threatens freedom of expression. Potential defendants may also have no notice that they are infringing. Professor Langvardt suggests instead that the right be limited to personal and unique attributes, that the law require proof of the likelihood of confusion, and that there be more of an effort to accommodate First Amendment interests.

⁹⁸ Rodrigues, *supra* note 1.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

necessarily related to the celebrity in right of publicity. The attraction of this approach is that it would allow states to compete with each other to attract celebrities to reside within their borders, so long as the benefits outweigh the costs, and to custom-tailor their own regimes so that they are most likely to meet their constituents' needs. The downside to this approach is that it would allow celebrities to shop for the most protection, or to strike a balance between other factors determining domicile and degree of publicity protection.¹⁰²

Conclusion

The notion of federalism of incrementally solving a problem in piecemeal fashion until a workable model emerges is one that is highly relevant in the rapidly changing media exploitation markets. Property remains an area of the law traditionally dominated by the states. Given the right of publicity's debatable labor and incentive justifications, it is wise to avoid enacting on the federal level a legal right of persona protection for the reasons outlined above. The increasing use of the marketing of famous figures' personas led to the re-thinking of rights of privacy. The earlier legal protections no longer seemed adequate to protect apparent "public" figures. The solution of granting property rights in the marketing of one's persona gives celebrities power over their images. However, that power is limited by state law and choice-of-law provisions. The strongest case against a federal right of publicity is that property rights are state-created rights. Hence, for the reason these rights of publicity are relatively novel in the

¹⁰² Rodrigues, *supra* note 1, at 1224.

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community property law context, and to formulate a federal law out of them would indeed be a premature notion.