

PREEMPTION, THE RIGHT OF PUBLICITY, AND A NEW FEDERAL STATUTE

RICHARD S. ROBINSON*

I. INTRODUCTION

The process by which a new legal concept gains acceptance is painstaking and fraught with obstacles. The right of publicity provides one illustration of an emergent doctrine's struggle for survival. Today, this right, which was first articulated some forty-four years ago,¹ and is currently recognized by statute or common law in at least twenty-five states,² faces the continued threat of preemption on at least two fronts.³ This Article will first trace the development of state law doctrine regarding the right of publicity. Next, important Supreme Court cases dealing with preemption of state intellectual property laws will be reviewed. Finally, after examining the impact of those cases on the right of publicity doctrine, the need for a federal "right of public identity" statute will be discussed, with special attention given to the new possibilities posed by the Internet.

* The author is an associate with the firm of Ravin, Sarasohn, Cook, Baumgarden, Fisch & Rosen, and practices litigation, intellectual property law, and entertainment law in both New York and New Jersey. His professional experiences as a musician include touring, recording, songwriting, and production.

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¹ In *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), Judge Jerome N. Frank said:

We think that in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross', i.e., without an accompanying grant of business or anything else. . . . This right might be called a "right of publicity."

Id. at 868. Earlier case law refused to recognize such a right. See, e.g., *Roberson v. Rochester Folding-Box Co.*, 64 N.E. 442 (1902) (holding that no right existed to protect a woman from unauthorized use of her portrait to promote flour sales).

² J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 6.1[B] (1st ed. 1987 & Supp. 1997).

³ State law rights of publicity have faced preemption on First Amendment grounds. See *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (use of Ginger Rogers' name in the movie *Ginger and Fred* not an infringement of her right of publicity when balanced against defendants' right to freedom of expression under the First Amendment). On the basis of federal copyright statute see *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986) (baseball players' right of publicity in their own performances preempted by copyright law).

I. WHAT IS THE RIGHT OF PUBLICITY?

The right of publicity gives a person control over the commercial use of his or her identity.⁴ A person has the right to own, protect, and profit from the commercial value of his or her name, likeness, activities, and identity.⁵ Most of the twenty-five states which recognize a statutory or common law right of publicity consider it to be a fully transferable and descendible property right.⁶ Some states have also recognized by statute a post-mortem right of publicity.⁷

The right of publicity was conceived as a solution to the problems caused when celebrities attempted to use the right of privacy, and/or the tort of appropriation, to protect pecuniary interests.⁸ An article by Samuel Warren and Louis Brandeis is often considered the birthplace of the right of privacy.⁹ The right of privacy gradually developed into a personal tort, and was often used to protect publicity interests.¹⁰

While the common law right of privacy recognized a property interest in a person's name or likeness, which could be protected if appropriated by another, problems arose because of the personal tort nature of right of privacy actions.¹¹ Previously, in order to prevail in a right of privacy action, plaintiffs had to show that the unauthorized commercial use of their names or likenesses caused them embarrassment or humiliation.¹² Embarrassment or humiliation was often difficult to demonstrate where the celebrities had suffered no mental anguish when subjected to publicity. By definition, the right of privacy was a personal, non-assignable right that

⁴ See *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1353 (D.N.J. 1981); see also MCCARTHY, *supra* note 2, § 1.1[B][2].

⁵ See Peter Felcher & Edward Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1588-89 (1979); see also Radar, *The "Right of Publicity"—A New Dimension*, 61 J. PAT. OFF. SOC'Y 228 (1979).

⁶ See MCCARTHY, *supra* note 2, §§ 6.1[B]-[C].

⁷ See *id.*

⁸ Some courts have found that the right of publicity differs from the law of privacy in that it protects an individual's commercial interest in his or her identity, rather than non-commercial interests, such as freedom from public embarrassment or the right to be let alone. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (although derived from the law of privacy, the right of publicity is a business right to control the use of one's identity in commerce rather than the personal right to be let alone); WILLIAM PROSSER, *LAW OF TORTS* 802, 804 (4th ed. 1971) (the right of publicity differs from the law of privacy, from which it is derived).

⁹ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

¹⁰ David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 678 (1983).

¹¹ See *id.*

¹² Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

did not sound in property.¹³ Many plaintiffs were defeated through this rationale.¹⁴

William Prosser's seminal article on the right of privacy,¹⁵ which divided the right of privacy into the four separate torts: (1) intrusion; (2) appropriation; (3) disclosure; and (4) false light, did little to advance the right of publicity. However, Prosser did mention a right of publicity under his discussion of the tort of appropriation. While Prosser did not clearly separate a tort of appropriation based on mental anguish from one based on property rights, the wholesale adoption of his right of privacy framework into the *Restatement (Second) of Torts* spurred discussion of the creation of a separate right of publicity.¹⁶ That discussion culminated in the inclusion of the right of publicity in the American Law Institute's *Restatement (Third) of the Law of Unfair Competition*.¹⁷

II. DEVELOPMENT OF THE STATE LAW DOCTRINE OF THE RIGHT OF PUBLICITY

The modern era right of publicity doctrine is generally traced to *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*¹⁸ In *Haelan*, the plaintiff, a chewing gum company, alleged that its rival, Topps, had intentionally interfered with exclusive contracts between the plaintiff and various baseball players to portray their likenesses on baseball cards.¹⁹ Where written contracts existed with the players, the court found for the plaintiff on the grounds of tortious interference with the contract.²⁰ However, some of the agreements were oral guarantees obtained from the players by an agent, and then assigned to the plaintiff.²¹ The defendant argued that the plaintiff's oral agreements only waived the players' rights to sue for invasion of privacy.²² Since the commercial use of the players' likenesses by the defendant did not hurt the players' feelings, the defendant claimed that the plaintiff had no cause of action.²³

¹³ See *id.*; see also RESTATEMENT (SECOND) OF TORTS § 652I cmt. a (1977).

¹⁴ See, e.g., *Miller v. Madison Square Garden*, 28 N.Y.S.2d 811 (Sup. Ct. 1941) (public figure awarded six cents for a technical violation of right of privacy statute, where a bicycle race program used his name and picture without his consent).

¹⁵ William Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

¹⁶ RESTATEMENT (SECOND) OF TORTS, *supra* note 13, at §§ 652A-652I.

¹⁷ See *id.* §§ 46, 48.

¹⁸ 202 F.2d 866 (2d Cir. 1953).

¹⁹ *Id.* at 867.

²⁰ *Id.* at 868.

²¹ *Id.*

²² *Id.*

²³ *Id.*

Under right of privacy laws, the defendant's argument was not without merit. The players' privacy was a personal right, rather than an enforceable property interest. In rejecting the defendant's argument, Judge Frank used the term "right of publicity" to denote the plaintiff's enforceable right to prevent use of the players' likenesses for commercial purpose.²⁴ Judge Frank also recognized that the players could grant exclusive right of publicity privileges to one firm, for purposes of commercial exploitation.²⁵

As other jurisdictions recognized the utility of Judge Frank's formulation, new right of publicity applications developed. Unauthorized commercial exploitation of the plaintiff's actual name,²⁶ nicknames and professional names,²⁷ and group names²⁸ came to be considered property interests under the right of publicity. General and photographic likenesses,²⁹ recognizable drawings of the plaintiff,³⁰ "live" impersonations or imitations,³¹ and impersona-

²⁴ The court said a person's legal interest in publication of his photograph is *not* limited to a personal and non-assignable right not to have his feelings hurt by such publication. See *id.* at 868-69. In his article, Nimmer, *supra* note 12, at 216, stated that "[t]he right of publicity must be recognized as a property (not a personal) right, and as such capable of assignment and subsequent enforcement by the assignee." Following Nimmer's lead, most jurisdictions recognizing a right of publicity currently consider it to be a property right. See MCCARTHY, *supra* note 2, § 10.2[A].

²⁵ See *Haelen Labs.*, 202 F.2d at 869.

²⁶ See *Palmer v. Schonhorn Enters., Inc.*, 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967) (right of publicity protection afforded to names of famous golf pros); see also *Lerman v. Chuckleberry Publ'g, Inc.*, 521 F. Supp. 228 (S.D.N.Y. 1981) (novelist/screenwriter Jackie Collins granted summary judgment on right of publicity claim where a caption, with her name, accompanied a photograph of an orgy scene from a film in which she did not appear).

²⁷ See *Hirsch v. S.C. Johnson & Son*, 280 N.W.2d 129 (Wis. 1979) (in case establishing the right of publicity in Wisconsin, football celebrity was found to have a protectable interest in his nickname "Crazylegs"); see also *McFarland v. E & K Corp.*, 18 U.S.P.Q.2d (BNA) 1246 (D. Minn. 1991) (common law right of publicity of actor who portrayed Spanky in the *Little Rascals* infringed by unauthorized use of his stage name by "Spanky's Saloon" in Saint Paul, Minnesota).

²⁸ See *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201 (N.D. Ill. 1981), *modified*, 735 F.2d 257 (7th Cir. 1984), *aff'd per curiam*, 830 F.2d 195 (7th Cir. 1987) (concessioner licensed by various rock groups to sell t-shirts with group logos awarded injunctive relief against bootleg T-shirt distributors based on the right of publicity).

²⁹ See *Haelen Labs.*, 202 F.2d at 866; see also *Groucho Marx Prods., Inc. v. Playboy Enters.*, No. 77-1782 (S.D.N.Y. Dec. 30, 1977) (granting partial summary judgment on right of publicity claim, where model impersonated entertainer in a magazine photo essay).

³⁰ See *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (the court granted injunctive relief where defendant distributed a "representational" drawing of a nude black male which bore an unmistakable likeness to plaintiff boxer, and recognized Ali's "proprietary interest in the profitability of his public reputation or 'persona.'" *Id.* at 728).

³¹ See *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982). Groucho Marx Productions and Harpo's daughter, Susan, as trustee of his estate, sued the producers of the Broadway musical, *A Day in Hollywood/A Night in the Ukraine*, for appropriating the rights of publicity in the names and likenesses of the Marx Brothers. See *id.* at 486. The court found that the production of the play, which infringed the plaintiffs' right of publicity in the Marx Brothers

tion or imitation through a fixed form model³² were also drawn into the right of publicity web. Other cases found publicity rights in biographical facts,³³ the plaintiff's voice,³⁴ and nonrecognizable representations that merely suggested the plaintiff's identity.³⁵

The U.S. Supreme Court first recognized the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*,³⁶ the "human cannonball" case. While performing his act at a county fair in Ohio, Zacchini was confronted by a television reporter with a movie camera.³⁷ Zacchini requested that the reporter not photograph his performance.³⁸ The reporter complied, but the producer of respondent's daily newscast sent him back the next day to film the entire act.³⁹

Under Ohio right of publicity laws, Zacchini alleged that the filming constituted an "unlawful appropriation of [his] professional property."⁴⁰ The defendant newspaper argued that the First and Fourteenth Amendments protected its right to broadcast Zacchini's entire performance without compensation.⁴¹ The Court, by a five-four margin, agreed with Zacchini.⁴² The decision was historic, because the Court recognized the right of publicity as

characters, was not biographical or educational, and thus a First Amendment fair use defense failed. *See id.* at 494.

³² *See Price v. Worldvision Enters., Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd per curiam*, 603 F.2d 214 (2d Cir. 1979) (television production *Stan 'n Ollie*, where actors portrayed Laurel and Hardy, restrained by the court).

³³ *See Uhlaender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970) (baseball players' association prevailed against makers of a board game who utilized player statistics without obtaining a licensing agreement).

³⁴ *See Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), *on remand*, *Midler v. Young & Rubicam*, 22 U.S.P.Q.2d (BNA) 1478 (9th Cir. 1991) (carmaker ran a television ad campaign featuring a singer who was instructed to sound as much like Bette Midler as possible. Midler prevailed on a common law right of publicity claim).

³⁵ *See Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (internationally-famous race car driver prevailed on misappropriation of likeness claim, where the defendant used a visual representation of the plaintiff's distinctive race car design in its ad).

³⁶ 433 U.S. 562 (1977).

³⁷ *See id.* at 563-64.

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *Id.* at 564.

⁴¹ *Id.* at 565.

⁴² Justice White wrote for the majority:

Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent. The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner, or to film and broadcast a prize fight, or a baseball game, where the promoters or the participants had other plans for publicizing the event.

Id. at 574-75.

an established cause of action with significant rational and economic underpinnings. However, the appropriation of the plaintiff's entire act was not a typical right of publicity scenario. The Court's narrowly-tailored holding leaves open the possible preemption of state publicity right laws, based on either federal copyright or First Amendment grounds.

III. THE ELEMENTS OF THE RIGHT OF PUBLICITY

The modern right of publicity has been described as a blend of personal rights, property rights, and rights under the laws of unfair competition.⁴³ The similarities and differences between the right of publicity and other causes of action are important, because they determine both the usefulness of publicity rights and the potential grounds on which those rights might be preempted.

A. *Publicity Rights Compared to the Tort of Appropriation*

The tort of appropriation is one of four torts that make up the right of privacy.⁴⁴ The right of publicity has its origins in the right of privacy.⁴⁵ Historically, the privacy tort of appropriation was often used to protect what we today consider publicity rights.

An action for the privacy tort of appropriation can be brought where a defendant makes unauthorized use of a plaintiff's identity for commercial purpose or private gain.⁴⁶ In this respect, appropriation and the right of publicity are identical. Two key differences, however, weaken appropriation's usefulness as a publicity rights defense. According to William Prosser, the privacy tort of appropriation requires both the unauthorized use of the plaintiff's identity and injury to the plaintiff's dignity or self esteem.⁴⁷ As seen in *Haelan*, where the harm is strictly economic, the absence of emotional or physical distress makes it impossible to prevail on an appropriation claim.

A second critical difference can be found in appropriation's function as a branch of privacy law. Privacy rights are traditionally defined as personal rights, rather than property rights. This definition serves to weaken appropriation's utility as a publicity rights defense in two ways: (1) as stated above, emotional distress or some physical harm *must* be shown to prevail on an appropriation

⁴³ Steven Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 111-12 (1980).

⁴⁴ See PROSSER, *supra* note 8, at 804.

⁴⁵ See *supra* note 8.

⁴⁶ See PROSSER, *supra* note 8, at 804-07.

⁴⁷ *Id.*

claim; and (2) the personal rights nature of appropriation does not allow for adequate recognition of the property rights inherent in identity. Personal rights, by definition, are not freely alienable, transferable, or descendible.

The right of publicity solves this quandary by splitting off the appropriation requirement of emotional distress. The plaintiff need only show appropriation of some aspect of his identity for unauthorized commercial use or private gain. The right of publicity has one other distinct advantage over the tort of appropriation. Since it is a property right where recognized, the right of publicity can be sold, licensed, willed to an heir,⁴⁸ or even divided up as marital property in a divorce settlement.⁴⁹

B. *Publicity Rights Compared to Federal Copyright Protection*

Many courts have recognized the similarities between federal copyright protection and state right of publicity.⁵⁰ Publicity rights and federal copyright statutes share the common goal of encouraging production of works that benefit the public, through the grant of valuable and enforceable (property) rights.⁵¹ Publicity rights survive the death of their holder, just as copyright protection survives the author. Copyright statutes and state right of publicity laws treat ideas in the same way. An idea cannot be copyrighted,⁵² and an idea cannot be protected through the right of publicity. Originality of expression is required for both copyright protection⁵³ and the right of publicity.

⁴⁸ See, e.g., *Robyn Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

⁴⁹ See, e.g., *Piscapo v. Piscapo*, 557 A.2d 1040 (N.J. Super. Ct. App. Div. 1989) (the "celebrity goodwill" generated by comedian Joe Piscapo was capable of valuation and equitable distribution upon his divorce).

⁵⁰ See, e.g., *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979):

The tie-ups of one's name, face, and/or likeness with a business, product, or service creates a tangible and saleable product in much the same way as property may be created by one who organizes under his name a business to build and/or sell houses according to a fixed plan or who writes a book, paints a picture, or creates an invention.

Id. at 428 (emphasis added); see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1977), where the Court states: "[t]he Constitution no more prevents a State from requiring [the television station] to compensate [Zacchini] for broadcasting his act on television than it would privilege [the station] to film and broadcast a copyrighted dramatic work without liability to the copyright owner. . . ."

⁵¹ See *Zacchini*, 433 U.S. at 577; *Washington Publ'g Co. v. Pearson*, 306 U.S. 30, 36 (1939).

⁵² See, e.g., *Baker v. Selden*, 101 U.S. 99 (1879); see also *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) (the idea-expression dichotomy accommodates the competing interests of copyright and the First Amendment); *FASA Corp. v. Playmate Toys, Inc.*, 912 F. Supp. 1124 (N.D. Ill. 1996) (protection afforded by copyright laws is not absolute, because copyright protects only expression of ideas, not ideas themselves).

⁵³ See, e.g., *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991) (the

Important differences between federal copyright protection and state law publicity rights also exist. To qualify for a copyright, an author's expression must be fixed in a tangible form.⁵⁴ Unlike copyright, the right of publicity offers protection to "unfixed" forms of expression such as a voice⁵⁵ or a live sporting event.⁵⁶ Copyright protection is offered for specific classes of recorded creative expression.⁵⁷ In contrast, the right of publicity protects the identity/persona of a human being, alive or dead. The federal copyright statutes enumerate all of the permissible exceptions to an author's grant of exclusive rights, and offer the author predictable protection.⁵⁸ The right of publicity varies from state to state, and exceptions to the protection it offers have not been codified. Each case in which a plaintiff seeks to enforce publicity rights is a new adventure, with an uncertain outcome.

While the right of publicity is similar to copyright protection in purpose and in some specific elements, the two offer protection of different subject matters. The human persona or identity cannot be considered a "writing" of an "author" under the copyright clause of the Constitution.⁵⁹ Indeed, much of the subject matter covered by the right of publicity cannot be copyrighted, and federal copyright laws preempt state publicity right laws where the two overlap.

C. *Publicity Rights Compared to Federal Trademark Protection*

State right of publicity laws are analogous to some aspects of federal trademark and service mark protection. Both the right of publicity and trademark statutes are concerned with unfair compe-

two fundamental criteria of copyright protection are originality and fixation in tangible form).

⁵⁴ See *id.*; see also 17 U.S.C. § 102(a) (1996).

⁵⁵ See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 ("A voice is not copyrightable. The sounds are not 'fixed.'").

⁵⁶ See 1 MELVILLE B. NIMMER & DAVID NIMMER, COPYRIGHT § 108[C] (1997).

⁵⁷ 17 U.S.C. § 102(a) (1997) offers protection for: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. In addition, the Semiconductor Chip Production Act provides protection for mask works fixed in semiconductor chips. See 17 U.S.C. § 902 (1996).

⁵⁸ Sections of the Copyright Act create exceptions to an author's exclusive rights where "fair use" is made of a copyrighted work for educational, non-profit, religious, or news reporting purposes. See generally 17 U.S.C. §§ 107-120 (1996). Non-simultaneous secondary transmissions of covered works are also exempted under certain circumstances. See *id.* Private, non-commercial copying of records, tapes, and compact disks is also exempt from sanction, under the Audio Home Recording Act of 1992. See 17 U.S.C. §§ 1001-1010 (1996).

⁵⁹ See NIMMER, *supra* note 56, § 1.01[B][1].

tition. Much of the common ground between the two causes of action is contained in § 1125(a) of the Federal Lanham Act.⁶⁰

(a) civil action

(1) *Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which-*

(A) *is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or*

(B) *in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.*

The italicized portions of the statute illustrate the common elements shared by trademark protection and the right of publicity. Both are concerned with commercial activities that would likely confuse consumers. Both address concerns that consumers might be misled about whether a particular person endorses, or is associated with, certain goods, services, or activities. Both are concerned that the characteristics or qualities of a person's services or activities might be detrimentally misrepresented. In both areas, standing to sue is predicated upon a showing of actual or probable economic damages.

However, the differences between trademark protection and publicity rights are even more significant.⁶¹ Trademark traditionally serves to protect the identity of a single commercial source, while publicity rights protect the identity of a single person.⁶² While a person's identity may serve as a commercial source, as with service marks,⁶³ trademark statutes do not protect against the unauthorized appropriation of a person's identity in other instances. Trademark laws mandate that the trademark must have been previously used in commerce to be protected.⁶⁴ Previous commercial

⁶⁰ Trademarks-The Principal Register, 15 U.S.C. § 1125 (1988) (emphasis added).

⁶¹ See MCCARTHY, *supra* note 2, at § 5.2[A]-[C].

⁶² See *id.*

⁶³ As defined in § 1127 of the Lanham Act, the term "service mark" means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. See 15 U.S.C. § 1127 (1997).

⁶⁴ Federal registration of a mark provides procedural rights in the mark, including pre-

use of a person's identity is not a prerequisite for publicity rights protection.⁶⁵ Unlike the false advertising provision of the trademark statute, the state law right of publicity does not require falsity to prove infringement.

Proof of trademark infringement requires a showing of likelihood of confusion, mistake, or deception.⁶⁶ None of these elements are required in a publicity rights action. A person need only show that his identity has been commercially exploited without permission.⁶⁷ Trademarks, like publicity rights, can be transferred or licensed. However, trademark assignments must be accompanied by their attached goodwill value, and trademark licenses can only be transferred with their accompanying quality control.⁶⁸ These requirements do not exist for assignment or licensing of publicity rights.⁶⁹

While federal trademark protection and the right of publicity share common elements, their differences are sufficient to prevent the use of trademark law as a protection for publicity rights in many instances. To date, trademark protection has only provided an effective defense of publicity rights in cases of false endorsement, or where a person's identity is tied to a service mark.⁷⁰

IV. A SUMMARY OF MAJOR CASES INVOLVING PREEMPTION OF STATE INTELLECTUAL PROPERTY LAWS

A state intellectual property law, whether common law or statute, will be preempted where it frustrates the underlying congressional objectives of the Copyright Act,⁷¹ the Patent Act,⁷² or the

assumptions of validity, ownership, and registrant's exclusive right to use the registered mark and access to federal courts. See 15 U.S.C. § 1115 (1997).

⁶⁵ See *supra* note 59. Under the Trademark Revision Act of 1988, rights can be acquired based on a bona fide intent to use the mark, although actual registration does not take place until the mark has actually been used. See 15 U.S.C. § 1115.

⁶⁶ 15 U.S.C. § 1125(a)(1) (1988).

⁶⁷ *Id.*

⁶⁸ 15 U.S.C. § 1055 (1988).

⁶⁹ See Nimmer, *supra* note 12, at 209.

⁷⁰ See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106 (9th Cir. 1992) (finding that false endorsement claims for unauthorized imitation of plaintiffs' distinctive attributes amount to infringement of unregistered commercial "trademark" under Lanham Act); see also *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (recognizing claim under Lanham Act § 1125(a) where uniform worn by porno film star was confusingly similar to plaintiffs' trademark uniforms and, thus, created a false impression that plaintiffs approved the use of the uniforms); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 368 (S.D.N.Y. 1988) (finding trademark infringement where advertisement containing Woody Allen look-alike falsely represented that the advertised products were associated with the famous comedian); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985) (finding a celebrity's commercial investment in his name and face comparable to interests of a trademark holder in a distinctive mark).

⁷¹ Copyright Act, 17 U.S.C. §§ 101-810 (1996).

Trademark Act.⁷³ A state law which facially conflicts with a federal statute will also be preempted.⁷⁴ Because congressional intent concerning the right of publicity is unclear, state right of publicity laws have been afforded some breathing room. However, lack of clear congressional intent has led to several instances where the right of publicity faced preemption because of judicial decisions in related areas of intellectual property.

On March 9, 1964, the Supreme Court decided two cases of first impression, each of which presented the question of whether state unfair competition laws could prohibit the copying of an article that was not protected by patent or copyright.⁷⁵ In *Sears, Roebuck & Co. v. Stiffel Co.*, the District Court for the Northern District of Illinois declared the patents Stiffel held on its commercially successful tube lamps invalid for want of invention.⁷⁶ Under an Illinois unfair competition statute which prohibited firms from confusing the public by "palming off" a competitor's goods, the court held that Sears could not copy Stiffel's unpatented tube lamps.⁷⁷ The court of appeals affirmed.

The Supreme Court reversal, authored by Justice Black, declared that patent protection was clearly the province of the federal government.⁷⁸ Justice Black reasoned that an unpatented article is in the public domain and may be copied with impunity. Since articles in the public domain can be sold by whomever wishes to do so, state unfair competition laws, which prohibit copying of unpatented goods, are preempted by the Patent Act.⁷⁹

*Compco Corp. v. Day-Brite Lighting, Inc.*⁸⁰ also involved an unpat-

⁷² Patent Act, 35 U.S.C. §§ 1-376 (1984 & Supp. 1997).

⁷³ Trademarks-The Principal Register, 15 U.S.C. §§ 1051-1127 (1976 & Supp. 1997).

⁷⁴ The general power to preempt state law is derived from the Constitution's Supremacy Clause:

This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

U.S. CONST. art. VI, cl. 2. Since the Constitution also gives Congress authority to create copyright and patent laws, the preemption doctrine extends to intellectual property laws as well. U.S. CONST. art. I, § 8, cl. 8.

⁷⁵ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

⁷⁶ *Sears*, 376 U.S. at 226.

⁷⁷ *Id.* at 227.

⁷⁸ *See id.* at 228 (the states "cannot separately make effectual provision[s]" for copyright or trademark protection) (citing THE FEDERALIST No. 43 (James Madison)).

⁷⁹ *Id.* at 231-32. "But mere inability of the public to tell two identical articles apart is not enough to support an injunction against copying or an award of damages for copying that which the federal patent laws permit to be copied." *Id.* at 232.

⁸⁰ 376 U.S. at 234.

ented light fixture copied by a competitor. The same Illinois unfair competition statute was utilized by the lower courts, and the Supreme Court, per Justice Black, reached a conclusion identical to *Sears*.⁸¹ The light fixtures in *Sears/Compco* were denied patent protection because they lacked novelty. Since novelty is not an element required for copyright protection, one might think that *Sears/Compco* would not preempt a state right of publicity, which is more analogous to copyright than patent protection. *Sears/Compco* had an impact on copyright cases because the rationales behind federal interest in controlling patents and copyrights are similar.⁸²

Beginning in 1969, the potentially wide scope of *Sears/Compco* was slowly scaled back by the Court.⁸³ In *Lear, Inc. v. Adkins*, the Court implied, in dicta, that a state law which compelled the payment of royalties for an unpatentable invention while the patent was still pending, was not preempted by federal patent law.⁸⁴ Four years later, state intellectual property laws gained further recognition in *Goldstein v. California*.⁸⁵

The *Goldstein* petitioners first argued that section 653 of the California Penal Code, which criminalizes record piracy,⁸⁶ was preempted by the Copyright Act.⁸⁷ At that time, sound recordings were not covered under the Copyright Act, but federal protection was available under the 1971 Sound Recording Act. Since section 653 only prohibits the copying of works not protected under federal law, the petitioners contended that the section should be preempted because Congress intended to occupy the entire copyright field.⁸⁸ The petitioners also claimed that a state copyright of unlimited duration was preempted by the Constitution.⁸⁹

In rejecting the petitioners' arguments, the *Goldstein* Court utilized a historic, three-part test for defining when states relinquish their lawmaking powers to the federal government:

⁸¹ See *id.* at 237 (holding that when an article is not protected by patent or copyright, state law may not forbid others to copy it).

⁸² See Shipley, *supra* note 10, at 688 nn.98 & 100. See also *CBS, Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967) (plaintiff had no right to exclusive use of his performance name/character concept "Paladin"/"Have Gun Will Travel"). The *CBS* Court said, "if a 'writing' [business card] is within the scope of the constitutional clause, and Congress has not protected it, whether deliberately or by unexplained omission, it can be freely copied." *Id.* at 319.

⁸³ See *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969).

⁸⁴ *Id.* at 674-75.

⁸⁵ 412 U.S. 546 (1973).

⁸⁶ Record piracy is the making of bootleg sound recordings.

⁸⁷ *Goldstein*, 412 U.S. at 548-49.

⁸⁸ *Id.* at 551.

⁸⁹ U.S. CONST. art. I, § 8, cl. 8 grants Congress the power to issue copyrights for "limited times."

[T]his alienation, of State sovereignty, would only exist in three cases: where the Constitution in express terms granted an exclusive authority to the Union; where it granted in one instance an authority to the Union, and in another prohibited the States from exercising the like authority; and where it granted an authority to the Union to which a similar authority in the States would be absolutely and totally contradictory and repugnant.⁹⁰

The Court held that the "first two instances present no barrier to a State's enactment of copyright statutes."⁹¹ With regard to the third part of the test, the Court observed that the Copyright Clause does not indicate that all writings are of national interest or that state legislation is, in all cases, unnecessary or precluded.⁹²

The Court also dismissed the argument that state copyright protection for an unlimited duration conflicts with the constitutional authority granted to Congress, which states that "Section 8 enumerates those powers which have been granted to Congress; whatever limitations have been appended to such powers can only be understood as a limit on congressional, and not state action."⁹³

During the next six years, the Court held that federal patent law did not preempt a state trade secret law,⁹⁴ or a state statute which enforced a royalty agreement concerning an invention for which a patent was sought but not obtained.⁹⁵ In concert with *Goldstein*, these cases boded well for state right of publicity laws.

In 1989, the Supreme Court's decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*⁹⁶ clouded the picture considerably. In *Bonito Boats*, the plaintiff sued a competitor under a Florida statute which prohibited the use of molds to duplicate boat hulls.⁹⁷ The trial court in Florida ruled that the anti-molding statute was preempted by federal patent law, and dismissed the action. Both the

⁹⁰ *Goldstein*, 412 U.S. at 553 (quoting THE FEDERALIST NO. 32 (Alexander Hamilton)).

⁹¹ *Id.*

⁹² *Id.* at 555-58. The Court further opined:

Since the subject matter to which the Copyright Clause is addressed may thus be of purely local importance and not worthy of national attention or protection, we cannot discern such an unyielding national interest as to require an inference that state power to grant copyrights has been relinquished to exclusive federal control.

Id. at 558.

⁹³ *Id.* at 560.

⁹⁴ See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479 (1974) (holding that states could regulate trade secrets, and other intellectual property, in any manner not inconsistent with federal law).

⁹⁵ *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979) (a commercial transaction, in which a company agreed to a royalty arrangement for an invention which might prove unpatentable, is a matter of state law, and does not conflict with federal patent law).

⁹⁶ 489 U.S. 141 (1989).

⁹⁷ *Id.* at 144-45.

appellate division and the Florida Supreme Court affirmed.⁹⁸

The Supreme Court, affirming, held that the Florida statute was preempted by federal patent law.⁹⁹ Justice O'Connor, writing for the majority, adopted the earlier *Sears/Compco* framework in analyzing the patent law preemption issue.¹⁰⁰ The Court also found that the statute stifled innovation by curtailing reverse engineering.¹⁰¹

While purporting to reconcile its decision with *Goldstein*, *Aronson*, and *Kewanee*, the Court sounded an ominous note for state intellectual property laws. Justice O'Connor wrote, "[t]he federal standards for patentability, at a minimum, express the congressional determination that patent-like protection is unwarranted as to certain classes of intellectual property. The States are simply not free in this regard to offer equivalent protections to ideas which Congress has determined to belong to all."¹⁰² Since Congress has not determined whether publicity rights belong to all, a broad reading of *Bonito Boats* could result in preemption of the state right of publicity. Although preemption of publicity rights on the basis of *Bonito Boats* was recently attempted without success, the possibility of preemption remains.¹⁰³

V. THE OVERLAP OF FEDERAL LAWS AND STATE PUBLICITY RIGHT LAWS

Because state right of publicity laws are analogous in many respects to both federal copyright and trademark protection, they have faced preemption challenges, mainly from the Copyright Act. The right of publicity has also been challenged where defendants claimed that the subject matter of the action was protected by the First Amendment. The copyright and First Amendment preemption threats present different problems for the right of publicity.

A. Preemption by Copyright

Section 301(a) of the amended 1976 Copyright Act explicitly preempts state intellectual property laws if a three-part test is met: (1) The state right must be equivalent to one of the exclusive rights enumerated in § 106.¹⁰⁴

⁹⁸ *Id.* at 145.

⁹⁹ *Id.* at 168.

¹⁰⁰ The boat hulls were not patented; therefore, they were in the public domain, and could be copied at will. *See id.*

¹⁰¹ *Id.* at 160.

¹⁰² *Id.* at 164-65.

¹⁰³ *See* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

¹⁰⁴ 17 U.S.C. § 106 gives the copyright owner exclusive rights to: (1) reproduce the copy-

- (2) The work under examination is fixed in a tangible medium.
- (3) The work under examination falls within the subject matter protected by §§ 102-103.¹⁰⁵

In *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, the publicity right of the players in their performance was preempted by § 301, because broadcasting the games fixed them in a tangible, copyrightable form.¹⁰⁶ This line of reasoning presents a problem for state publicity right laws. While the broadcast of the game is copyrightable, the unfixed performance of the players in the field is not copyrightable.¹⁰⁷ State laws which protect uncopyrightable expressions should not be preempted on the basis of copyright.¹⁰⁸ The *Baltimore Orioles* decision, coupled with the Supreme Court holding in *Bonito Boats*, leaves open the possibility that unfixed publicity rights, contained within an unrelated tangible medium, can be preempted by copyright. More recently, both a California state court and the Ninth Circuit have grappled with this issue.¹⁰⁹

B. Preemption by the First Amendment

*Zacchini*¹¹⁰ was the first and only case in which the Supreme Court balanced the right of publicity against the First Amendment. The right of publicity prevailed. The narrowness of the *Zacchini* holding, however, is illustrated by more recent cases such as *Rogers v. Grimaldi*,¹¹¹ where the lower court found the right of publicity to be preempted when balanced against First Amendment freedom of expression.

Justice White's majority opinion in *Zacchini* focused upon the fact that *Zacchini's* entire act had been appropriated.¹¹² Justice White missed the chance, deliberately or otherwise, to establish a

righted work; (2) prepare derivative works; (3) distribute copies of the work for sale, transfer ownership, rent, lease, or lend; (4) publicly perform the work; and (5) display the work. These rights are subject to the exceptions listed in 17 U.S.C. §§ 107-120. *Id.* (1994).

¹⁰⁵ See *supra* note 57.

¹⁰⁶ 805 F.2d 663 (7th Cir. 1986).

¹⁰⁷ By way of analogy, a broadcast performance by singer Bette Midler, which is both fixed in a tangible medium and includes songs protected by copyright, should not deprive Midler of the publicity rights inherent in that performance. To hold otherwise would deprive all publicity right holders of protection whenever they attempted to exploit an electronic medium.

¹⁰⁸ See David E. Shipley, *Three Strikes and They're out at the Old Ball Game: Preemption of Performers' Rights of Publicity under the Copyright Act of 1976*, 20 ARIZ. ST. L.J. 369 (1988) for further discussion of why § 301(a) should not preempt state publicity right laws.

¹⁰⁹ See *Fleet v. CBS*, 50 Cal. App. 1911 (Cal. Ct. App. 1996); *Wendt v. Host Int'l*, 44 U.S.P.Q.2d (BNA) 1189 (9th Cir. 1997).

¹¹⁰ 433 U.S. 562 (1977).

¹¹¹ 875 F.2d 994 (2d Cir. 1989).

¹¹² *Zacchini*, 433 U.S. at 570-71, 574-75.

general test balancing the right of publicity against First Amendment freedoms. The absence of a balancing test or general rule has left Justice Powell's dissent unanswered:

When a film is used, as here, for a routine portion of a regular news program, I would hold that the First Amendment protects the station from a "right of publicity" or "appropriation" suit, absent a strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation.¹¹³

Justice Powell would essentially create a presumption of First Amendment immunity for the news media against right of publicity infringement.¹¹⁴ To assert infringement in such a case, the plaintiff would have to meet a high standard of proof in order to rebut the presumption of First Amendment protection.¹¹⁵ While one could argue that the news media in this country is based on commercial exploitation, to date that argument has not been made.

Justice White's reluctance to commit on the issue is understandable. Weighing First Amendment principles against the right of publicity is a difficult task. The right of publicity might be potentially infringed by news, fiction, commercial speech, or some combination of the three. Each category represents a different level of First Amendment protection. Justice Powell would certainly not grant a presumption of First Amendment protection to commercial speech, and probably would not extend protection to fiction either.

Does this mean that the right of publicity must be balanced against the First Amendment on a case by case basis? Perhaps it does. Does balancing on a case by case basis, in the absence of a federal statute, increase the possibilities for preemption? Recent case law suggests the answer is an unqualified yes. Within the last year, the Tenth Circuit held that the First Amendment preempted Oklahoma's right of publicity statute in a case which arguably involved commercial speech,¹¹⁶ a New York district court held that the First Amendment preempted a public figure's right of publicity

¹¹³ *Id.* at 581 (Powell, J., dissenting).

¹¹⁴ *Id.*

¹¹⁵ Justice Powell would have the plaintiff make a strong showing "that the news broadcast was a subterfuge or cover for private or commercial exploitation." *Id.*

¹¹⁶ See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996) (where parody baseball cards making fun of high priced baseball stars were commercially sold, the Tenth Circuit held that the First Amendment preempted Oklahoma's right of publicity statute, which closely parallels sections 990 and 3344 of the California Civil Code).

in a case which clearly involved commercial speech,¹¹⁷ and a district court in Pennsylvania held that the First Amendment preempted that state's common-law right of publicity.¹¹⁸

VI. THE GAP BETWEEN CIRCUITS CONTINUES TO WIDEN IN THE ABSENCE OF A FEDERAL STATUTE

Four recent cases from around the country illustrate the ongoing, unresolved conflicts created by different circuit courts addressing right of publicity issues under varying schemes involving state statutes, common law, privacy based statutes, and no statutes or common law.

First, in Kentucky, which only recognizes the common law right of publicity as an offshoot of privacy rights, a district court judge permitted a fashion designer plaintiff, whose photographed derriere was subsequently published in a magazine and printed on t-shirts without her permission, to assert a right of privacy action based on appropriation of her "likeness."¹¹⁹ However, in citing the Ninth Circuit, the court continued a source of confusion dating back to *Haelen*, and held that the plaintiff would only have a cause of action if her friends and customers recognized the distinctive fishnet design of the jeans she was wearing.¹²⁰ The court thereby partially framed the issue in terms of the emotional distress of the plaintiff, rather than the unauthorized commercial exploitation of her fashion designs.

¹¹⁷ See *New York Magazine v. Metro. Transit Auth.*, No. 97 Civ. 8792, 1997 U.S. Dist. LEXIS 19060 (S.D.N.Y. Dec. 1, 1997) (invoking First Amendment and judicial exceptions to New York's right of privacy/publicity statute to deny New York City Mayor Rudolph W. Giuliani's attempt to enjoin the commercial exploitation of his name).

¹¹⁸ See *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (where former Black Panther leader Bobby Seale unsuccessfully sought to invoke his common-law right of publicity against the makers of the docudrama *Panther*).

¹¹⁹ See *Cheatham v. Pisano Publications, Inc.*, 891 F. Supp. 381, (W.D. Ky. 1995).

¹²⁰ *Id.* at 387. In so ruling, the court cited *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), in which a jury awarded well known recording artist Tom Waits, damages for violation of California's voice misappropriation statute, where Frito-Lay used a sound-alike vocalist in an ad without Waits' permission. However, the court permitted a jury award of \$200,000 for injury to Waits' peace, happiness, and feelings to stand, in a case primarily involving unauthorized commercial exploitation of a celebrity's vocal identity.

Waits highlights two major problems with the state law right of publicity system:

(1) In a venue well versed on publicity rights, the Ninth Circuit tied the right of publicity to emotional distress. Though emotional distress was not a prerequisite for bringing the action, its presence in the damage award only serves to further widespread confusion about the role of publicity rights. This confusion seems to have affected the jury, which awarded Waits twice as much for psychic injury as it awarded him for the fair market value of his professional services.

(2) While Waits recouped attorney's fees under the Lanham Act, he could not have recouped the fees on a state action for voice appropriation alone. Waits had to piggy-back his state publicity rights claim onto the federal claim in order to be reimbursed for attorney's fees. These problems, among others, point to the need for a uniform federal statute.

Second, under a dual common-law/statutory scheme, the Ninth Circuit permitted George Wendt and John Ratzenberger, famous for their portrayals of the characters Norm Peterson and Clifford Clavin in the television show *Cheers*, to maintain common-law and statutory right of publicity claims based on the defendants' use of robotic caricatures of their television personas in airport bars throughout the country.¹²¹ In the face of factual issues as to whether the robots looked like, or even evoked, the *Cheers* characters, the court broadened the scope of California's right of publicity law in the context of mechanical reproductions of celebrity likenesses.¹²²

Third, under a New York privacy statute, in a state which does not recognize a common law right of publicity, the Southern District of New York refused to permit plaintiff Astrud Gilberto, who sang the original recorded version of *The Girl From Ipanema*, to maintain a right of privacy action against Frito Lay for unauthorized use of her voice in an advertisement.¹²³ Here, a Frito-Lay ad portrayed "Miss Piggy" lip-synching and gorging herself on potato chips, while Ms. Gilberto's recording of "Girl From Ipanema" was used without authorization as musical background. Because New York has no common law right of publicity, and has no right of publicity statute, the plaintiff was forced to bring what amounted to a right of publicity claim under privacy statutes.¹²⁴ Since New York case law has specifically excluded voice misappropriation under these statutes, the plaintiff's erstwhile right of publicity action was dismissed.¹²⁵

A final, slightly older case comes from the Western District of Louisiana, a state which previously had no right of publicity statute or common law right of publicity. In *Prudhomme v. Proctor & Gamble Co.*,¹²⁶ chef Paul Prudhomme brought suit against companies who used a look-alike actor in their coffee commercials. Along with trademark infringement and various Louisiana common law

¹²¹ See *Wendt v. Host Int'l, Inc.*, 44 U.S.P.Q.2d (BNA) 1189 (9th Cir. 1997).

¹²² The Ninth Circuit dealt with robotic portrayals of celebrities in *White v. Samsung Electric America, Inc.*, 971 F.2d 1395 (9th Cir. 1992). Vanna White was denied the opportunity to pursue a common law right of publicity claim in that case, because of the lack of similarity between herself and the robot in question. However, White was permitted to maintain a statutory right of publicity claim in the same case.

¹²³ See *Oliveira v. Frito-Lay, Inc.*, 43 U.S.P.Q.2d (BNA) 1455 (S.D.N.Y. 1997).

¹²⁴ N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 1997).

¹²⁵ While New York Civil Rights Law section 51 was amended to include unauthorized use of a natural person's voice in November 1996, the court still dismissed plaintiff's claim under the statute. See *Oliveira*, 43 U.S.P.Q.2d (BNA) at 1455.

¹²⁶ 800 F. Supp. 390 (E.D. La. 1992).

causes of action, Prudhomme alleged violation of his common law privacy and publicity rights.

The court denied the defendants' motions to dismiss and their request for a more definite statement. While recognizing that Louisiana had not adopted the common law publicity rights doctrine, the court determined that Prudhomme had made a good faith argument for extension of the doctrine in Louisiana.¹²⁷

Taken as a whole, these decisions graphically underscore the inevitable, ever widening conflict between the circuits regarding the right of publicity, and the threats this conflict pose for holders of publicity rights:

- (1) The decision of the Southern District of New York, however proper under existing state law, permitted Frito-Lay, which was forced to pay Tom Waits over \$2 million dollars for using an unauthorized sound-alike in California,¹²⁸ to use Astrud Gilberto's actual voice without authorization in New York with impunity, but ruled in favor of Astrud Gilberto's causes of action under other federal statutes;
- (2) The decision of the Western District of Kentucky in *Cheatham* relied, in part, on the plaintiff's emotional distress or embarrassment, in what arguably should have been a straightforward case of unauthorized commercial exploitation;
- (3) The decision of the Ninth Circuit in *Wendt*, however farsighted and thoughtful, would not have been reached under existing law in most other states; and
- (4) The *Prudhomme* case highlights the plight of publicity rights owners or licensees who reside in jurisdictions that do not recognize the right of publicity. They must, in cases of first impression, convince courts to adopt new law. This legal predicament encourages forum shopping, and discourages publicity rights owners and creators from residing in certain jurisdictions.

VII. WHY A FEDERAL "RIGHT OF PUBLIC IDENTITY" STATUTE IS NEEDED

A federal right of public identity statute¹²⁹ would benefit the public, the judiciary, and those who invest time, effort, and money

¹²⁷ *Id.* at 395-96.

¹²⁸ *See* Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).

¹²⁹ The concept of the "right of public identity" is offered as a new, perhaps more accurate title for the right of publicity. It is the appropriation of those elements of identity which define the public perception of an individual that constitute infringement. A person's public identity might have absolutely no overlap with his or her personal, private identity.

in their personal identities. A preamble to the statute should express goals similar to those inferred from the copyright clause.¹³⁰

The statute might begin by defining infringement of the right of public identity as the unauthorized appropriation or commercial exploitation of identity/persona for personal or commercial gain.¹³¹ Those elements of identity which have been accepted by the courts could be enumerated, and form a basis for infringement of identity rights.¹³² Future embodiments of identity, potentially

¹³⁰ Congressional authority to offer a right of public identity would derive, as in the case of trademark protection, from the Commerce Clause. A possible format for this section might be:

CHAPTER 1-CONGRESSIONAL DECLARATION OF POLICY

§ 101. Purpose.

The public is informed, entertained, and enriched by the creative talents of those persons engaged in all aspects of the creative, performing, athletic, political, scientific, and media arts. To the extent that persons who invest time, energy, and money in such areas achieve a public image or identity, the economic protection of said identity is deemed beneficial to all.

This Act is intended to provide economic incentive to creators of, and investors in, identity. The purpose of such economic incentive is to encourage the creation of identities which are useful or enjoyable to the public. The Act is also intended to regularize the protection offered to holders of public identity rights throughout the fifty states.

¹³¹ The definition section might read as follows:

CHAPTER 2- SUBJECT MATTER AND SCOPE OF PUBLIC IDENTITY RIGHTS

§ 201. Definitions.

As used in this title, the following terms and their variant forms mean the following:

"Commercial exploitation" means use for profit, whether the use is private or public in nature. Commercial exploitation does not mean use in a play, book, magazine, newspaper, computer program or software, computerized bulletin board of any type, e-mail or other computer generated message, musical composition, film, radio or television program, other than an advertisement or commercial announcement, for purposes of news, general information, education, criticism, or parody. Use of a person's public identity, without express consent or authorization of the license holder, to the extent necessary to convey the intended news, general information, educational, critical, or parody message, shall not be a violation of this statute. Use of one's public identity in a parody where the primary purpose is to sell or offer for sale goods or service, shall be deemed commercial exploitation.

"Express consent" means a written agreement, signed by the public identity rights holder and the prospective licensee(s), which indicates how the rights will be used, the term of the agreement, and which includes consideration. The adequacy of consideration in individual cases shall be a matter to be resolved by negotiation between parties.

"Post-mortem rights" are those public identity rights which survive the owner, and are transferred by deed, will, license, or contractual agreement to another.

The "right of public identity" is a property right that every natural person has in his or her identity. It consists of those elements of identity which define the public perception of an individual.

"Unauthorized appropriation" means the commercial exploitation of public identity rights without the express consent of the holder of those rights.

¹³² The section listing subject matter to be protected might read as follows:

§ 202. Subject matter of public identity rights: In general.

(a) Those elements of the right of public identity which are protected under this title include the following:

- (1) Legal names, nicknames, professional names, or group names;
- (2) Recognizable likenesses, whether in photographic, holographic, or other form or medium of expression;
- (3) Mannerisms, gestures, or likenesses, to the extent that imitation, whether reduced

made possible by future technology, could be accounted for by an additional, open ended provision. Attorney's fees might be provided for prevailing plaintiffs, as an incentive to encourage respect for the right of identity, and as a double edged sword to prevent the bringing of frivolous claims.¹³³

The statute should indicate that emotional distress is not required to bring an action.¹³⁴ Additionally, emotional distress cannot form the basis for damages. The right of public identity, while based on the identity of a real person, is primarily a property right. The harm caused by infringement of that property right is economic in nature. Residual damage to the psyche of the person whose identity has been appropriated can best be addressed by privacy laws. Finally, the right of public identity statute should also contain an express provision of post-mortem rights, to underscore the property nature of identity rights.¹³⁵

Far from presenting a novelty in the law, the statute would sim-

to a fixed medium or performed "live," evokes public recognition of the subject of the imitation;

(4) Non-recognizable representations, whether fixed in a tangible medium or otherwise, which evoke public recognition of the subject of the representation;

(5) Biographical or personal facts, history, or statistics;

(6) The sound of a person's voice, or the voice of a popular fictional character, when voice alone is sufficiently distinctive to evoke public recognition of that person or fictional character; and

(7) Any technologically created manifestation of identity, not listed above, which evokes general public recognition of the creator of public identity rights in such identity.

¹³³ The infringement and remedies section might read:

CHAPTER 5-PUBLIC IDENTITY RIGHTS INFRINGEMENT AND REMEDIES

§ 501. Public identity rights infringement.

The unauthorized commercial exploitation of any of the subject matter listed in § 202, whether that subject matter is owned by the creator, an investor, a transferee, or a holder of post-mortem rights, shall constitute infringement under this chapter. Emotional distress is not an element of infringement.

§ 502. Remedies.

Remedies for violations of § 501 shall include full or partial injunctions against the infringer, seizure of the offending articles of commerce, damages to the extent of the infringer's profits, or damages to extent of harm suffered by the owner, which must be proved by a preponderance of the evidence. Attorney's fees may be awarded to public identity rights owner upon proof by a preponderance of the evidence that the infringement was accomplished knowingly, intentionally, or maliciously. Attorney's fees may also be awarded against anyone who files a frivolous suit under this title. Emotional distress is not a basis for any injunction or damage award under this section.

¹³⁴ See *supra* note 132.

¹³⁵ The proposed statutory section follows:

CHAPTER 3-PUBLIC IDENTITY RIGHTS OWNERSHIP AND TRANSFER

§ 301. Ownership and transfer.

(a) Ownership of public identity rights initially vests with the creator or creators of the public identity. The owners of such rights may, through mutually acceptable agreement, share ownership with other investors as they see fit.

(b) Transfer of public identity rights, in whole or part, may be accomplished by any conveyance or operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

(c) Involuntary transfer of public identity rights by their owner to another shall nullify

ply constitute an acceptance of the inherent value of identity, a concept reinforced by forty years of case law. Like the Lanham Act, a right of public identity statute would serve to uniformly codify common law and state law approaches.¹³⁶ All told, there are at least four reasons why the creation of a federal right of public identity statute is urgently needed, as discussed below.

A. *A Federal Statute Would Solve Copyright Based Preemption Questions, and Would Assist in the Resolution of First Amendment Preemption Issues*

Enumeration of the elements of public identity in a federal statute would solve copyright preemption problems like those encountered in *Baltimore Orioles*.¹³⁷ Courts would not have to ponder the legislative history of § 301(a) of the Copyright Act in order to make a determination; they could simply refer to the list of identity elements in the public identity statute. Holders of public identity rights would not be at the mercy of Supreme Court decisions in other areas of intellectual property, such as in *Bonito Boats*. In addition, while the First Amendment preemption issue evades simple solutions, a public identity statute would more clearly delineate the problem areas to be addressed by the Supreme Court.

B. *A Federal Statute Would Provide Regular, Predictable Protection*

Investors and owners of public identity rights are entitled to as much certainty and regularity of protection as owners of copyrights, patents, and trademarks.¹³⁸ A federal statute, coupled with a registration scheme akin to copyright and trademark, would reg-

any subsequent action by any governmental body, official, or organization purporting to seize such rights, except those actions provided for under Title 11.

¹³⁶ Uniformity would be achieved via preemption as follows:

CHAPTER 7-PREEMPTION OF STATE STATUTES AND SEVERABILITY
§ 701. Preemption.

This title is intended to regularize protection of public identity rights nationwide. Any statute of any State which covers publicity rights concerning any of the subject matter listed in § 202 is expressly preempted by this title. To the extent that any statute of any State offers privacy rights protection to the subject matter listed in § 202, and is not based on emotional distress, such statute shall also be preempted by this title.

§ 702. Severability.

A finding that any portion of this title violates the United States Constitution shall not invalidate any other portion of this title.

¹³⁷ 805 F.2d 663 (7th Cir. 1986).

¹³⁸ The duration of public identity rights would be codified as follows:

CHAPTER 4-DURATION OF PUBLIC IDENTITY RIGHTS

§ 401. Duration.

The public identity rights created herein shall last for the life(s) of the creator(s), plus either an additional fifty years, or until such time as the identity rights have not been commercially exploited for two consecutive years, whichever is longer.

ularize identity rights protection, thereby encouraging greater investment in those rights, and hopefully producing greater public benefits.¹³⁹ The enumeration of identity rights would also result in greater economy of judicial resources through the reduction of grounds for appeal. If the court of appeals for the federal circuit were vested with sole jurisdiction over appeals, splits among the circuits would be totally eliminated, while litigants could readily gauge their chances for success based on the decisions of a single court.¹⁴⁰

C. A Federal Statute Would Solve Conflicts Between State And Circuit Laws

A federal statute would reduce forum shopping by solving conflicts between the publicity rights of different state laws. The statute would also prevent further splits in circuit opinions, such as those described above.

¹³⁹ Registration and procedural requirements would be as follows:

CHAPTER 6-PROCEDURAL AND JURISDICTIONAL REQUIREMENTS FOR BRINGING AN ACTION

§ 601. Procedure for bringing an action.

(a) Anyone bringing an action under § 501 may file for arbitration. The arbitrator shall be selected from a list compiled by both parties to the action, and shall be acceptable to both parties. The decision of the arbitrator shall not be appealable pending final judgment.

(b) In the alternative, any person seeking a jury trial under a § 501 action may bring suit in district court which covers either the place of residence or business of the plaintiff or the defendant. Any person bringing a § 501 action in district court shall not have the right to trial without a jury.

(c) Holders of public identity rights, or their successors in interest, must register with the appropriate federal agency in order to proceed under (a) or (b) of this section. Registration must be recorded within five years of actual notice of infringement. Except in cases of willful or egregious infringement, the alleged infringer(s) shall be given a six month grace period, to allow for the reaching of a licensing agreement with the registrant. All parties shall exercise good faith and best efforts to reach a suitable licensing agreement during the six month grace period. If, by a preponderance of evidence, the registrant(s) show(s) that the alleged infringement was willful or egregious, the six month grace period will be waived. Where an agreement cannot be reached because the registrant believes that commercial exploitation would cause irreparable damage to the public identity in question, the burden of proof shall rest with the registrant. Except in cases of willful or egregious infringement, the registrant(s) shall be barred from any action under (a) or (b) of this section during the six month grace period. If the registrant(s) fail to exercise good faith and best efforts in reaching a licensing agreement, they may be barred from any future action under (a) or (b) of this section.

§ 602. Appeals.

The Court of Appeals for the Federal Circuit shall hear all appeals taken from actions under § 601(a) or (b). The United States Supreme Court may accept appeals of decisions from the Court of Appeals for the Federal Circuit, upon granting of certiorari.

¹⁴⁰ See *supra* note 138.

D. *Potential Solution to Conflict of Laws Problems Posed Internationally by the Internet*

While the Internet and other emerging information exchange systems offer new business opportunities for holders of intellectual property rights, the ability of end users to download, copy, modify, and exploit protected works without detection poses a serious monetary threat.¹⁴¹ Holders of publicity or public identity rights are especially vulnerable. Because the sound of a person's voice, a person's physical features, and other items typically protected as public identity rights are not fixed in a tangible medium, they can be easily appropriated, manipulated, and exploited without authorization, and without regard to international borders, through currently existing computer technology.

The potential for economic loss to American holders of public identity rights has vastly increased with expanded Internet use. However, while representatives of industrialized nations regularly meet in efforts to harmonize copyright, trademark, and patent protection worldwide, the United States does not even have a national policy concerning the right of public identity.

State courts in California, Indiana, and New York have already been presented with several matters involving alleged right of publicity violations perpetrated via the Internet.¹⁴² All three cases dealt with famous natural persons, and the same conflict of laws and preemption questions raised by previous right of publicity cases arose again.

But these cases, perplexing as they are, only scratch the surface of possible conflict of law problems for American public identity rights holders posed by the Internet. How would our courts resolve a conflict between an American state law right of publicity

¹⁴¹ One way to gauge the economic potential of public identity rights is to look at the growth of copyright industries, whose products frequently engender public identity rights. In 1989, American copyright industries generated \$302.7 billion, accounting for 5.8% of the total gross national product, and employed about 5.4 million workers. See Stephen E. Siwek & Harold W. Furchtgott-Roth, *Copyright Industries in the U.S. Economy*, ECONOMISTS, INC., Nov. 1990, at viii-ix. Since then, copyright industries' share of the GNP has at least doubled to 12%.

¹⁴² See *Crowder Starks v. CompuServe, Inc.*, No. BC153274 (Cal. App. Dep't Super. Ct., L.A. County July 5, 1996) (class action by models alleging that defendant made their likenesses available to 4.7 million CompuServe subscribers worldwide without authorization); see also *Curtis Management Group Worldwide, Inc. v. American Legends*, No. 49D109607-CP-0995 (Marin County Super. Ct., July 17, 1996); see also *Stern v. Delphi Internet Servs. Corp.*, 626 N.Y.S.2d 694 (N.Y. Sup. Ct., N.Y. Co. 1995) (disc jockey Howard Stern's bid, under sections 50 and 51 New York Civil Rights Laws to prevent computer server from using his name and photograph of his buttocks on its Website, was rejected by the court under a First Amendment preemption analysis, based on the premise that Stern's announced candidacy for governor made him "newsworthy").

and the French legal doctrine of protection for authors known as *droit moral*?¹⁴³ How would our courts respond to a case involving the alleged appropriation by a U.S. based Internet server of the likeness of a beloved Scandinavian cartoon character hitherto unknown in the United States?

The future promises many such conflicts, with dire economic consequences, if the United States is not prepared to address international public identity rights questions with one voice. Setting aside the problems facing domestic rights holders under our presently conflicting laws, we cannot possibly negotiate a favorable public identity rights treaty with other nations if we do not agree among ourselves as to the elements of such rights, or whether they even exist.

The need for a federal right of public identity statute is clear. The case law, the Constitution, and public policy can all be mustered in support of the new statute. The question is not whether the statute is needed, but when it will be introduced.

¹⁴³ See, e.g., *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (exemplifying the problems which can arise when the statutory interests of a descendant of a publicity rights holder conflict with licenses granted to third parties during the lifetime of the rights holder).