

ROONEY v. COLUMBIA PICTURES: A PERFORMER'S RIGHT OF PUBLICITY WITH A TOUCH OF CLASS*

I. INTRODUCTION

In 1981, Mickey Rooney brought an action in federal district court naming as defendants eight major film production companies.¹ *Rooney v. Columbia Pictures Industries, Inc.*² was brought as a class action, with Rooney acting as the representative of all actors and actresses who had received a screen credit for films in which the principal photography had been completed prior to February 1, 1960.³ Rooney's primary assertion was that the class had a state law property right or right of publicity in films produced before 1960.⁴ He

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¹ *Rooney v. Columbia Pictures Indus.*, 538 F. Supp. 211 (S.D.N.Y.), *aff'd*, 714 F.2d 117 (2d Cir. 1982), *cert. denied*, 103 S. Ct. 1174 (1983). The defendant motion picture companies were Columbia Pictures Industries, Inc., Metro-Goldwyn-Mayer, Inc., Paramount Pictures Corp., R.K.O. General, Inc., Twentieth Century-Fox Film Corp., United Artists Corp., Universal City Studios, Inc., and Warner Bros., Inc.

² *Id.*

³ Plaintiff's Reply Brief in Support of Class Certification at 4, *Rooney*, 538 F. Supp. 211 (S.D.N.Y. 1982). Initially, Rooney's complaint defined the class as "all performers in motion picture films produced by defendants . . . the principal photography of which was completed prior to February 1, 1960 . . ." Plaintiff's Complaint at 6, *Rooney*. Subsequently, Rooney proposed to limit the class to those with screen credits. Plaintiff's Reply Brief in Support of Class Certification at 4, *Rooney*.

Rooney's claim was limited to films made before 1960 because in 1960, the Screen Actors Guild [SAG], Rooney's exclusive bargaining representative, and the movie producers settled a month-long strike by agreeing that the producers had the complete rights to exhibit and televise films made before February 1, 1960. Unless an individual contract with an actor provided for profit participation, an actor in a film made before February 1, 1960 would receive only his salary for that film. It was agreed that actors would not share in any of the future revenues from movie theatres or from any form of televised performance of that film. The producers agreed that actors in films made after February 1, 1960 would receive a percentage of the television revenues ("residuals") from those films.

This 1960 agreement additionally provided that the producers would pay \$2,625,000 to set up a pension plan and a health and welfare plan for the actors. The \$2,625,000 was regarded to be a past service credit for actors' services from 1953 to 1960. Also, the producers agreed to pay into the plans an amount equal to five percent of any compensation thereafter paid to actors. Producer-Screen Actors Guild, Inc. Memorandum Agreement of 1960, at 1 (April 18, 1960).

⁴ Plaintiff's Complaint at 17-18, *Rooney*. Rooney did not contest the payments he received for his post-1960 films, nor did he claim entitlement to more than he collects for the home television use of those films. As to the films made prior to 1960, Rooney claimed that he and all

demanded compensation for showings of pre-1960 films on television, videocassette, videodisc, cable television, or any other non-theatrical medium ("supplemental markets")⁵ in which he or a member of his class appeared.

members of the named class "own valuable property rights in the commercial exploitation of the publicity value of their names, likenesses, images, pictures, and reputations, which have commercial value and which give value to the [pre-1960 films]. . . ." *Id.* at 9.

⁵ The Screen Actors Guild has defined "supplemental markets" as:

the exhibition of theatrical motion pictures by means of cassettes (to the limited extent provided in paragraph (1) . . . , pay-type CATV, or Pay Television, as those terms are hereafter defined in this subsection. . . .

"(1) Cassettes: For the purposes of this Agreement, a cassette is any audio-visual device, including without limitation, cassette, cartridge phonogram or other similar audio-visual device now known or hereafter devised, containing a theatrical motion picture (recorded on film, disc, tapes or other material) and designed for replay on a home-type television screen. The sale or rental of cassettes for replay on a home-type television screen in the home constitutes the 'Supplemental Market' for the purposes of this Agreement, insofar [as] cassettes are concerned.

"(2) Pay-Type CATV: Exhibition of theatrical motion pictures on home-type television screens by means of transmission by a community antenna television system (CATV) where, in addition to the obligatory general cable charge to the subscriber for the CATV service: (i) a further charge is made for programs selected by the subscriber, or (ii) the subscriber has the option, by making payment, in addition to the standard subscription charge, to receive special programming over one or more channels which are not available to the subscriber without such additional payment.

"(3) Pay Television: Exhibition of theatrical motion pictures on a home-type television screen by means of telecast, cable or closed circuit in which the viewing audience pays to receive the program by making a separate payment for such specific program. Exhibitions in theatres or comparable places by means of telecast or cable is theatrical exhibition and shall not be considered Pay Television.

"The term 'Supplemental Markets' does not include the exhibition of a theatrical motion picture by cassette or otherwise over a television broadcast station or in theatrical exhibition, and for this purpose 'theatrical exhibition' includes the educational market, the exhibition of theatrical motion pictures on any commercial carrier (referred to herein as 'In-Flight'), such as commercial airlines, trains, ships and buses, and other uses which have been traditionally considered theatrical exhibition of theatrical motion pictures, other than the specific home use hereinabove defined as the 'Supplemental Market' for cassettes. . . .

"The Producers have agreed to the inclusion of pay-type CATV and Pay Television in the 'Supplemental Markets' because under the present pattern of distribution of theatrical motion pictures, pay-type CATV and Pay Television are supplemental to the primary theatrical market. The Producers reserve the right in future negotiations to contend that the pattern of release has changed so that pay-type CATV and/or Pay Television are no longer a Supplemental Market but constitute or are a part of the primary market of distribution of theatrical motion pictures, and that therefore no additional payment should be made with respect to the release of theatrical motion pictures (including those covered by this Agreement) in said markets. Nothing herein shall limit the scope of negotiations on said subject.

Rooney, 538 F. Supp. at 221-22 (quoting Producer-Screen Actors Guild Codified Basic Agreement of 1977, at 12-13 (1977)).

Rooney's complaint asserted four counts, two federal claims and two state claims. The federal claims were based upon the Sherman⁶ and Lanham⁷ Acts. Rooney charged the motion picture companies with violating the Sherman Act by refusing to negotiate with film performers with respect to compensation for their state law rights of publicity. He maintained that the motion picture companies had conspired to deny compensation to performers for the commercial use of their property rights in supplemental markets.⁸ Rooney also asserted that, in violation of the Lanham Act, the defendants falsely represented that Rooney and the class had authorized, sponsored, endorsed or approved supplemental market use of films created prior to 1960.⁹

The state law claims were based upon the state law right of publicity¹⁰ and the common law theory of misappropriation.¹¹ Rooney claimed that the defendants violated his and the class' right of publicity by wrongfully receiving profits from the commercial use of the plaintiffs' property rights.¹² He also alleged that the defendants had misappropriated valuable property rights in their names, likenesses, images, pictures, goodwill and reputations without compensation.¹³ He claimed unjust enrichment to the motion picture companies and irreparable harm to the entire class that he purported to represent.

Novel legal issues were raised by *Rooney* that neither the district nor the circuit court addressed. The first of these issues, which this

⁶ 15 U.S.C. § 1 (1982).

⁷ 15 U.S.C. § 1125(a) (1982).

⁸ Brief for Plaintiff at 12-13, *Rooney*. Rooney claimed that the motion picture companies did this to exploit the rights of performers in commercial television, pay-television and audio-visual device markets. He claimed that they refused to pay compensation for that commercial exploitation.

The district court found the contracts facially valid and enforceable, and that even if Rooney were able to prove that such clauses resulted from a conspiracy among defendants in restraint of trade, the contracts would be enforceable. It reasoned that antitrust laws do not permit a party to raise conspiracy as a means of avoiding facially legal contracts. *Rooney*, 538 F. Supp. at 229 (citing *Kelly v. Kosuga*, 358 U.S. 516 (1959)).

⁹ Brief for Plaintiff at 15, *Rooney*. Rooney claimed that the motion picture companies represented to him and to members of the class that the films were made only for exhibition in movie theatres.

The district court held that the contract clauses "clearly and unambiguously granted to defendants all rights in connection with the pre-1960 films in which Rooney appeared, including the right to use such films in the [supplemental] markets." *Rooney*, 538 F. Supp. at 224.

¹⁰ See generally *infra* notes 14-71 and accompanying text.

¹¹ Plaintiff's Complaint at 15-16, *Rooney*. Common law misappropriation provides that, even in the absence of fraud or deception, one may not use another's property right for commercial gain without giving credit to the creator. *International News Serv. v. Associated Press*, 248 U.S. 215 (1918).

¹² Plaintiff's Complaint at 14, *Rooney*.

¹³ *Id.* at 16. Rooney implied that the defendants misappropriated the property right in his performance.

Comment addresses, is Rooney's claim that the right of publicity¹⁴ extends to protect a property interest in the exhibition of an artistic performance¹⁵ embodied within a film created by another¹⁶ and undertaken as a "work made for hire."¹⁷ This Comment next explores whether any one performer can serve as the representative of a class asserting the right of publicity. Although extensive briefing on the subject was undertaken by the litigants, the *Rooney* district court did

¹⁴ The right of publicity is a state defined right of an individual to control the context and manner in which his "persona" is utilized. See Pilpel, *The Right of Publicity*, 27 BULL. COPYRIGHT SOC'Y 249, 252-53 (1980).

In *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), cert. denied, 346 U.S. 816 (1953), the right of publicity was introduced as an independent doctrine. Until *Haelen*, the right of publicity had been mistakenly encompassed within the right of privacy as appropriation of plaintiff's name or likeness by and for defendant's commercial use. See RESTATEMENT (SECOND) OF TORTS § 652A (1977); P. GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 134 (1973). The court in *Haelen* stated:

We think that, in addition to and independent of that right of privacy . . . , 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'. . . . This right might be called a 'right of publicity.' For it is common knowledge that many prominent persons . . . would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

Haelen, 202 F.2d at 868.

¹⁵ See generally *infra* notes 19-71 and accompanying text.

It has been suggested that the right of publicity may protect the celebrity's actual performance. See Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 114 (1980) (citing *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) and *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), cert. denied, 351 U.S. 926 (1956)).

¹⁶ In *Rooney*, the district court expressed "no opinion as to the claim that an actor who performs in a role created by another has a 'right of publicity' in such performance." *Rooney*, 538 F. Supp. at 230 n.9.

¹⁷ See 17 U.S.C. § 201(b) (1982). Pursuant to the federal copyright act:

In . . . a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

Id.

The basis of Rooney's claim was that his performances in the pre-1960 films added some value to the films and that the added value was his property, not his employer's. Because this was his property, Rooney claimed that he should be paid whenever the films were shown. Plaintiff's Complaint at 9, 11, *Rooney*. Rooney admitted that he was hired for the express purpose of appearing in movies which were to be shown for a profit. *Id.* at 8-9. Since Rooney was an employee who was hired to help create a work, the results of his services, the films, became the property of his employers regardless of how much value he may have added to them. See 17 U.S.C. § 201(b) (1982).

not reach the certification issue.¹⁸ Consequently, the feasibility of such a class action remains unresolved.

II. THE RIGHT OF PUBLICITY IN A PERFORMANCE

The right of publicity allows a person to control the context and manner in which his or her name or likeness is utilized and to be compensated for those uses.¹⁹ Typically, publicity rights protect the

In *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P. 2d 425, 160 Cal. Rptr. 323 (1979), the court applied California Labor Code's work-for-hire provision (CAL. LAB. CODE § 2860 (West 1971)) to an employee's claim of publicity rights in films. The court stated:

Lugosi, the employee, was hired and paid—handsomely, circa 1931—by Universal, the employer, to create a version of Count Dracula in a motion picture. The product of that employment and all the residuals flowing therefrom belong, under the legislative enactment, to the employer. Had the employee desired to withhold any effects of the employment from exploitation by the employer, he could have so provided in the agreement.

Id. at 827, 603 P.2d at 433, 160 Cal. Rptr. at 331.

¹⁸ The *Rooney* district court noted: "The granting of the motion for summary judgment dismissing Rooney's claims precludes certification of a class represented by Rooney, since he is an inadequate representative of any performers with valid claims." 538 F. Supp. at 213 n.1.

¹⁹ "[The] 'right of publicity' recognizes the pecuniary value which attaches to the names and pictures of public figures, particularly athletes and entertainers, and the right of such people to this financial benefit." *Chaplin v. National Broadcasting Co.*, 15 F.R.D. 134, 139-40 (S.D.N.Y. 1953).

This right can be contrasted with the right of privacy. The right of privacy "recognizes the legal right to protection against the injury to feelings, which results from the commercial appropriation of elements of personality." *Id.* at 139. The RESTATEMENT (SECOND) OF TORTS § 652(A) (1977) states:

- (1) One who invades the right of privacy of another is subject to liability for the resulting harm to the interests of the other,
- (2) The right of privacy is invaded by
 - (a) unreasonable intrusion upon the seclusion of another, . . . or
 - (b) appropriation of the other's name or likeness, . . . or
 - (c) unreasonable publicity given to the other's private life, . . . or
 - (d) publicity that unreasonably places the other in a false light before the public. . . .

Id.; see also *Pilpel*, *supra* note 14, at 251.

There is a conflict among scholars as to whether the right of publicity is just another aspect of privacy or a distinct common law right that is entirely independent of the right of privacy. One commentator finds the right of publicity to be "a common law property right that does not owe its existence to . . . any . . . privacy statute." *Id.* at 253. Support for this view appeared in *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 283 (S.D.N.Y. 1977), *aff'd*, *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979):

It is evident that courts address intrusions on feelings, reputation and privacy only when an individual has elected not to engage in personal commercialization. By contrast, when a "persona" is in effect a product, and when that product has already been marketed to good advantage, the appropriation by another of that valuable property has more to do with unfair competition than it does with the right to be left alone.

444 F. Supp. at 283.

name, likeness or identifying characteristics of a celebrity.²⁰ Although an actual live performance is protected by the right of publicity,²¹ Rooney's contentions—that the motion picture companies had not acquired the rights to exhibit pre-1960 films in supplemental markets²² and that the actors deserved compensation for such exhibitions under the right of publicity—would have extended the protection afforded by the right of publicity to the performance of a role by one individual embodied within a film created by another.²³

Relying on strict contractual interpretation, however, the district court found that the contracts signed by Rooney and the motion picture companies expressly provided that "all rights" became the property of the producers²⁴ and that Rooney's common law publicity rights were "assigned or waived by the contracts granting defendants all rights in the pre-1960 films."²⁵ The Second Circuit affirmed the district court's grant of the defendants' motion for summary judgment, holding that the contracts' clear and unambiguous language did not entitle Rooney to payment for the exhibition of pre-1960 films in supplemental markets.²⁶ In coming to this decision, the *Rooney* courts failed to address the right of publicity issue.²⁷ Had they done so, they would have confronted the question of whether Rooney's right of

Another commentator supports the theory that "[t]he right evolved out of early common law and statutory *privacy* actions for unauthorized advertising or other commercial use of one's name or likeness. . . ." Goldstein, *PUBLICITY: The New Property?* 17 *STAN. LAW. J.* 8, 10 (1982-83) (emphasis in original). He explains the evolution of the right of publicity as follows:

When the privacy action was brought by someone who had never before been in the public limelight, and whose feelings had been offended by the use of his or her name in an advertisement, it was accurate enough to say a right of privacy had been invaded. But when the cause of action was brought by a sports or entertainment celebrity — whose interest was not so much in maintaining privacy as in cashing in on his celebrity — the privacy label no longer fit. Thus, the term 'right of publicity' took its place for this class of cases for which injunctive and monetary relief was aimed at securing a proprietary, rather than a strictly personal, reputational interest.

Id.

If the right of publicity is derived from the right of privacy, then it is a personal right and like privacy dies with the person. But, if the right of publicity is a property right, distinct from privacy, then it is descendible at death as is any other property right. *Id.* at 12.

²⁰ See *supra* note 14 and accompanying text.

²¹ See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

²² See *supra* note 17.

²³ *Rooney*, 538 F. Supp. at 213.

²⁴ *Id.* at 224, 230.

²⁵ *Id.* at 230.

²⁶ *Rooney*, No. 82-7403, slip op. at 2 (2d Cir. Nov. 17, 1982).

²⁷ *Rooney*, 538 F. Supp. at 230 n.9.

publicity claim is preempted²⁸ by the copyright holders' right in the performances²⁹ for which Rooney had already been paid.

The right of publicity seeks to "[vindicate] the economic interests of celebrities, enabling those whose achievements have imbued their identities with pecuniary value to profit from their fame."³⁰ The primary justification for recognizing a property interest in a person's name or likeness is to prevent economic injury to celebrities and to allow such persons to profit from their personal efforts in order to encourage individual enterprise and creativity.³¹ Publicity rights, however, must be limited in areas where other social policies prevail (i.e. to benefit people other than celebrities). The "underlying assumption is that the greater the possibilities for personal profit, the more likely people are to pursue creative activities."³² One commentator has noted:

While the right of publicity responds to the needs of the celebrities it protects, and in doing so serves valid social goals, countervailing interests—those of other individuals and of society—mandate cautious enforcement of the right, lest it impact too adversely on free expression, free enterprise, and federal supremacy in the area of copyright. One man's right is another man's restraint, and to set levels of protection in the intellectual property and unfair competition fields only in response to the needs of one group (such as

²⁸ See *infra* notes 61-71 and accompanying text.

²⁹ Section 106 of the 1976 Copyright Act enumerates the exclusive rights to which a copyright holder is entitled:

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

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

17 U.S.C. § 106 (1982) (emphasis added).

³⁰ Hoffman, *supra* note 15, at 116. See also *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977); *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

³¹ *Zacchini*, 433 U.S. at 573, 576.

³² Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1601 (1979).

celebrities) distorts the function of these laws, whose ultimate goals are to encourage creative endeavors and to promote competition.³³

Although there is no consistent test for determining how far the right of publicity reaches, it has thus far protected against the unauthorized commercial appropriation of a person's name,³⁴ stage name,³⁵ nickname,³⁶ likeness,³⁷ achievements,³⁸ personality,³⁹ unique voice,⁴⁰ distinctly decorated racing car⁴¹ and live performance.⁴² Each of these protected interests was "clearly central to the person's career"⁴³ as a source of income, and when misappropriated, was the source of actual economic damage to the celebrity.

Rooney's assertion that the right of publicity extends protection to an actor's performance embodied within a film is a novel one⁴⁴ despite the Supreme Court's holding in *Zacchini v. Scripps-Howard Broadcasting Co.*,⁴⁵ which affirmed an award of damages to the performer, a human cannonball, for the appropriation of his act based on his right to the publicity value of his performance.⁴⁶ In *Zacchini*, a television news crew taped Zacchini's live human cannonball act without authorization and televised it in its entirety on a news program. Although Zacchini's 'entire act' lasted a mere thirty seconds, he claimed that the defendant's broadcast violated his right of publicity and sought compensation for the publicity value of the performance he would otherwise have been paid to perform.⁴⁷

³³ Hoffman, *supra* note 15, at 112 (noting U.S. CONST. art. I, § 8 and *Zacchini*, 433 U.S. 562).

³⁴ Lerman v. Chuckleberry Publ., Inc., 544 F. Supp. 966 (S.D.N.Y. 1982); Cepeda v. Swift and Co., 415 F.2d 1205 (8th Cir. 1969).

³⁵ See, e.g., Cardella v. Log Cabin Prods. Co., 89 F.2d 891 (2d Cir. 1937).

³⁶ See, e.g., Hirsch v. S. C. Johnson & Son, Inc., 90 Wis. 2d 379, 280 N.W.2d 129 (1979).

³⁷ See, e.g., Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973).

³⁸ See, e.g., Palmer v. Schonhorn Enters., Inc., 96 N.J. Super. 72, 232 A.2d 458 (Ch. Div. 1967).

³⁹ See Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S.2d 661, (1977).

⁴⁰ See Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962).

⁴¹ See Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974).

⁴² See *Zacchini*, 433 U.S. 562.

⁴³ See Felcher & Rubin, *supra* note 32, at 1614.

⁴⁴ This is not the first time an artist has claimed a right of publicity in an actual live performance. Cf. *Zacchini*, 433 U.S. 562. This is, however, the first time an artist has claimed a right of publicity in a performance which is within a larger work of authorship and is fixed in a tangible medium of expression.

⁴⁵ 433 U.S. 562 (1977).

⁴⁶ *Id.* at 573.

⁴⁷ Had newsworthy facts about Zacchini's act been reported instead of the full "performance" itself, such activity would probably not have been prevented. *Id.* at 574. See generally W. PROSSER, LAW OF TORTS 806-07 (4th ed. 1971).

In *Zacchini*, the Supreme Court extended the right of publicity to protect a celebrity's entire performance. The Court recognized that "the appropriation of the very activity by which the entertainer acquired his reputation in the first place . . . may be the strongest case for a 'right of publicity.'"⁴⁸ The rationale for protecting Zacchini's interest was that the economic value of the plaintiff's act depended upon his exclusive control of its presentation. Viewing his act on television, the public would have been less likely to pay money to see it in person. The Court sought to encourage the creation of such entertainment,⁴⁹ reasoning that when the news station broadcast his entire act, its first amendment interest was outweighed by the interest in encouraging creative expression of performers like Zacchini. The Court equated Zacchini's interest with that of a copyright holder's⁵⁰ and analogized the news station's activity to the filming and broadcasting of a copyrighted dramatic work without regard for the rights of the copyright owner.⁵¹

Like Zacchini, Rooney sought compensation solely for the exhibition of his performance. However, unlike Zacchini, Rooney was compensated merely as a contributor to a larger work, involving the collective efforts of other actors, screenwriters, directors and production crews. This work, when copyrighted, became the exclusive property of the copyright owners, the motion picture companies.

Extending the protection afforded by the right of publicity to the performance of a role by one individual embodied within a film *created by another* would undoubtedly be in a celebrity's interest. "Celebrities, like everyone else, . . . would prefer to reap as much financial reward from their endeavors as possible, both from their creative efforts and from collateral enterprises with which they are associated."⁵² The countervailing interests at stake are those of the motion picture producers. Copyright laws protect films in order to encourage creative expression and entertainment. To attract private

The Court held that the news station's appropriation of Zacchini's act for its news program did not fall within the first amendment privilege of freedom of the press. "[T]he Constitution no more prevents a State from requiring respondent to compensate . . . [Zacchini] 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. . . ." *Zacchini*, 433 U.S. at 575.

⁴⁸ *Id.* at 576.

⁴⁹ *Id.* at 575.

⁵⁰ The Court did not address whether Zacchini could have copyrighted his act. Since copyright protection is available only to original works of authorship fixed in a tangible medium, Zacchini's live act could not have been copyrighted: See 17 U.S.C. § 102 (1982).

⁵¹ *Zacchini*, 433 U.S. at 575. See *supra* note 47.

⁵² Hoffman, *supra* note 15, at 119.

investment in the production of movies, property, in the form of movie rights, is offered.⁵³ The motion picture producer seeks "not merely the labor of the performer in his performance per se but rather the right to control that embodied performance unhampered by the claims of the performer."⁵⁴

Weighing the conflicting interests in the right to exploit the embodied performance, one must conclude that the motion picture producer has the predominant interest. The producer has purchased the performer's talents⁵⁵ and has incorporated them into a finished product, a film, from which he hopes to derive financial benefit. The most feasible way in which to fulfill this expectation is to allow the producer to deal with the film as he chooses. Indeed, the rights of the performer are relatively minimal when contrasted with those of the film producer.⁵⁶

Despite the prevailing interests of the motion picture producers, artists should be compensated for their performances. Contractual negotiation is the primary means of protecting the commercial value of a performer's rights.⁵⁷ The property status of publicity rights enables the performer to control the use of the performance through contract.⁵⁸ In fact, performers can and do bargain for and reserve by contract the same rights Rooney "assigned or waived" to the motion picture companies in his contracts with them.⁵⁹ Hence, a performer should not retain a state protected right of publicity in his performance embodied in a film because this right is outweighed by the interests of the motion picture producers and is easily protectible by contract.⁶⁰

⁵³ Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 UCLA L. REV. 1107, 1107 (1977).

⁵⁴ Comment, *The Twilight Zone: Meanderings in the Area of Performers' Rights*, 9 UCLA L. REV. 819, 828 (1962).

⁵⁵ The performer is an employee for hire. See *supra* note 17.

⁵⁶ Comment, *supra* note 54, at 859.

⁵⁷ *Id.* at 819.

⁵⁸ See *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 487, (3d. Cir.), *cert. denied*, 351 U.S. 926 (1956).

⁵⁹ "Unless the contract specifically indicates to the contrary, not only does the performer grant the studio the minimal right of capturing his performance but the concomitant right of absolute control over the captured performance." Comment, *supra* note 54, at 828.

⁶⁰ Most courts would conclude that unless a performer expressly reserved rights in a performance, he has relinquished all of his property rights. See *Autry v. Republic Prods., Inc.*, 213 F.2d 667 (9th Cir. 1954); *Republic Pictures Corp. v. Rogers*, 213 F.2d 662 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954). But see *Ettore*, 229 F.2d 481.

A. Copyright Preemption of Publicity Rights in a Performance

By acquiring copyright protection for the films in this case, the motion picture companies acquired the exclusive right to perform⁶¹ or license the public performances of the copyrighted works.⁶² Rooney insisted that it is the right of each and every performer in a film either to collect money for an exhibited performance in a motion picture when it is distributed for a profit to supplemental markets⁶³ or to block its commercial exploitation. However, Rooney's assertion is in direct conflict with the 1976 Copyright Act and is, therefore, subject to copyright preemption.

Section 301 of the 1976 Copyright Act⁶⁴ defines the scope of federal copyright protection. Its purpose is to create a single system of federal protection for all "original works of authorship,"⁶⁵ from the moment they are fixed in a tangible medium of expression.⁶⁶ It achieves this goal by preempting any rights under the common law or the statutes of any state that are equivalent to copyright and that extend to works, the subject matter of which is within the general scope of the Copyright Act.⁶⁷

The rights Rooney sought are equivalent to those granted to the defendant motion picture companies under the Copyright Act. The motion picture companies in *Rooney* own the films which were the

⁶¹ 17 U.S.C. § 106(4) (1982).

⁶² See *supra* note 29 & *infra* notes 64-71 and accompanying text.

⁶³ See *supra* note 5.

⁶⁴ Section 301 states, in pertinent part:

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

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

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; . . . or, . . .

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

17 U.S.C. § 301 (1982).

⁶⁵ This pertains to published or unpublished works. *Id.*

⁶⁶ *Id.*

⁶⁷ See Diamond, *Preemption of State Law*, 25 BULL. COPYRIGHT Soc'y 204, 207 (1977).

copyrighted works in issue. The companies' rights under section 106 of the Copyright Act include exclusive rights to do and to authorize others to reproduce the films, to prepare derivative works based on the films, to distribute copies of the films to the public by sale or by other transfer of ownership, and to publicly perform the films.⁶⁸

Despite clear statutory language providing that no person other than the copyright owner is entitled to these rights, Rooney demanded remuneration for a right granted to the film companies. He sought protection for performances embodied within films⁶⁹ copyrighted by the motion picture companies, and thus under their control.

A state law right of publicity claim will not conflict with the federal copyright law unless the publicity interest becomes fixed in a tangible medium of expression. If it does, the interest falls within the purview of copyright protection.⁷⁰ Rooney's alleged publicity interest involved his performances which are embodied in works of authorship—movies—containing ideas and their expressions that are fixed in tangible mediums. The publicity interest is thus capable of being protected through federal copyright law which is the first part of the preemption requirement. The second part is that the right being protected cannot be equivalent to a right protected by the 1976 Copyright Act. The conduct which Rooney claimed to be actionable was the receipt of profits by the motion picture companies from the commercial use of the films containing performances which he claimed belonged to him. This conduct is equivalent to the right to perform granted to the motion picture companies under section 106(4) of the Copyright Act.

Thus, there is a direct conflict between the state protected publicity right Rooney sought and the federally protected copyright the motion picture companies hold in Rooney's performances. Since state law is preempted when such a conflict arises, Rooney's claim must fail.

One need not go to such lengths to prove that Rooney's claim is preempted by federal copyright law. Professor Nimmer has observed that:

⁶⁸ See *supra* note 29.

⁶⁹ These performances are fixed within a tangible means of expression and are capable of being copyrighted.

⁷⁰ See Felcher & Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125, 1129-32 (1980).

If under state law the act of reproduction, performance, distribution or display, no matter whether the law includes all such acts or only some, will *in itself* infringe the state created right, then such right is preempted. But if other elements are required, in addition to or instead of, the acts of reproduction, performance, distribution or display, in order to constitute a state created cause of action, then the right does not lie 'within the general scope of copyright,' and there is no preemption.⁷¹

This test determines whether an asserted right is equivalent to any of the exclusive rights within the scope of copyright. Under this theory, preemption of a publicity right occurs if the mere reproduction, performance, distribution or display of an item claimed to be protected under the right of publicity interferes with a plaintiff's asserted publicity rights in that item. Since the rights Rooney sought in the performances, which are embodied within films, are infringed upon by the motion picture companies mere performance of the films, they fall within the scope of federal copyright protection and are preempted.

III. A CLASS ACTION UNDER THE RIGHT OF PUBLICITY

The feasibility of a class action⁷² based on the right of publicity has never before been litigated and consequently raises novel issues. In

⁷¹ 1 M. NIMMER, NIMMER ON COPYRIGHT § 1.01 [B](1), at 1-12 (1979).

⁷² FED. R. CIV. P. 23 is the federal rule on class actions. The rule provides, in pertinent part:

(a) Prerequisites to a Class Action. One or more members of a class may sue or be sued as representative parties on behalf of all only if (1) the class is so numerous that joinder of all members is impracticable, (2) there are questions of law or fact common to the class, (3) the claims or defenses of the representative parties are typical of the claims or defenses of the class, and (4) the representative parties will fairly and adequately protect the interests of the class.

(b) *Class Actions Maintainable.* An action may be maintained as a class action if the prerequisites of subdivision (a) are satisfied, and in addition:

(1) the prosecution of separate actions by or against individual members of the class would create a risk of

(A) inconsistent or varying adjudication with respect to individual members of the class which would establish incompatible standards of conduct for the party opposing the class; or

(B) adjudications with respect to individual members of the class which would as a practical matter be dispositive of the interests of the other members not parties to the adjudications or substantially impair or impede their ability to protect their interests; or

(2) the party opposing the class has acted or refused to act on grounds generally applicable to the class, thereby making appropriate final injunctive relief or corresponding declaratory relief with respect to the class as a whole; or

granting summary judgment in favor of defendants, the district court precluded judicial discussion of the issues and, therefore, the certification of the class of actors in films completed prior to 1960. Had the *Rooney* district court looked beyond the 1960 contract terms and confronted the issues involved in certifying a class asserting a right of publicity, it would have undertaken an administratively impracticable task which would have destroyed the procedural advantages afforded by class certification. Finding a class of performers which adequately satisfies the criteria necessary under Rule 23 of the Federal Rules of Civil Procedure⁷³ to advance a class action is therefore unlikely, if not impossible.

A. *Rooney's Purpose in Litigating as a Class*

Rooney sought compensation for "[a]ll those who received a screen credit in motion pictures completed prior to 1960 which have been licensed for exhibition or use other than in a public movie theatre since July 1, 1977."⁷⁴ In his class action papers, he sought the certification of a class of "every individual who performed in a film produced by defendants prior to 1960 whose performance therein is identifiable from the defendants' records."⁷⁵

(3) the court finds that the questions of law or fact common to the members of the class predominate over any questions affecting only individual members, and that a class action is superior to other available methods for the fair and efficient adjudication of the controversy. The matters pertinent to the findings include: (A) the interest of the members of the class in individually controlling the prosecution or defense of separate actions; (B) the extent and nature of any litigation concerning the controversy already commenced by or against members of the class; (C) the desirability or undesirability of concentrating the litigation of the claims in the particular forum; (D) the difficulties likely to be encountered in the management of a class action.

Id.

The burden of persuasion on all disputed issues with respect to whether a case meets class action criteria falls on the proponents of class certification. *Feinstein v. Firestone Tire and Rubber Co.*, 535 F. Supp. 595, 600 (S.D.N.Y. 1982). The plaintiff class must satisfy the requirements of the first subsection of Rule 23 and at least one of the requirements of the second subsection. *Eisen v. Carlisle & Jacquelin*, 417 U.S. 156, 163 (1974); *Blake v. Arnett*, 663 F.2d 906, 912 (9th Cir. 1981); *see also* *Kendler v. Federated Dep't Stores, Inc.*, 88 F.R.D. 688, 691 (S.D.N.Y. 1981); *Greeley v. KLM Royal Dutch Airlines*, 85 F.R.D. 697, 700 (S.D.N.Y. 1980).

⁷³ *See supra* note 72.

⁷⁴ Initially, Rooney's complaint defined the class as "all performers in motion picture films produced by defendants . . . the principal photography of which was completed prior to February 1, 1960." Plaintiff's Complaint at 6, *Rooney*. Subsequently, Rooney proposed to limit the class to those with screen credits. Plaintiff's Reply Brief in Support of Class Certification at 4, *Rooney*.

⁷⁵ Plaintiff's Memorandum in support of Motion for Class Action Determination at 3, *Rooney*.

Rooney made an analogy to the antitrust laws in his argument for the necessity of a class action. The theory behind class actions for antitrust cases is to ensure the availability of an enforcement mechanism to redress the alleged violations.⁷⁶ Rooney argued:

Only through a class action can the many performers in the defendants' pre-1960 films hope to pursue a difficult and expensive legal battle against . . . well-financed and well-represented defendants. . . . Because of the expense of individual litigation, to deny class action treatment would, in effect, be to deny these individuals any opportunity to assert . . . their rights of publicity.⁷⁷

In theory, there is support for allowing such a class action since it would save judicial effort and provide an opportunity to assert claims which class members otherwise could not afford to bring. As the Supreme Court noted in *Deposit Guaranty National Bank v. Roper*:⁷⁸

A significant benefit to claimants who choose to litigate their individual claims in a class-action context is the prospect of reducing their costs of litigation, particularly attorney's fees, by allocating such costs among all members of the class who benefit from any recovery. . . . Where it is not economically feasible to obtain relief within the traditional framework of a multiplicity of small individual suits for damages, aggrieved persons may be without any effective redress unless they may employ the class-action device.⁷⁹

In terms of fulfilling the requirements of Rule 23,⁸⁰ however, it is less certain whether certification is appropriate for a class asserting a state law right of publicity claim.

B. Meeting the Requirements for Class Certification

Once an action is in federal court, the representative plaintiff has the burden of demonstrating, under Rule 23, that the action meets the four requirements necessary for class certification.⁸¹ The prerequisites

⁷⁶ *Shelter Realty Corp. v. Allied Maintenance Corp.*, 75 F.R.D. 34 (S.D.N.Y. 1977), appeal dismissed, 574 F.2d 656 (2d Cir. 1978).

⁷⁷ Plaintiff's Memorandum in Support of Motion for Class Action Determination at 8, Rooney.

⁷⁸ 445 U.S. 328, reh'g denied, 446 U.S. 947 (1980).

⁷⁹ *Id.* at 338 n.9.

⁸⁰ See *supra* note 72 and accompanying text.

⁸¹ See *supra* note 72. It is the court's obligation to examine the facts of a case and to determine if a class action is appropriate. 7A C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE § 1785, at 128 (1972) [hereinafter cited as WRIGHT & MILLER].

are: numerosity,⁸² commonality,⁸³ typicality⁸⁴ and adequacy of representation.⁸⁵

Numerosity is satisfied if the class is so large that it is impracticable to bring all of its members before the court. Commonality requires that there exist questions of law or fact common to the class. Typicality is met if the claims of the class representative arose out of the same general course of conduct by the defendants and are based on the same or similar legal theories as those of the class. The typicality requirement may be satisfied if the claims of the class representative are not in conflict with those of other class members. Additionally, the representative party must fairly and adequately protect the interests of the class.⁸⁶ He must show that he will vigorously prosecute his own claim and that there is a sufficient identity of interests between him and the alleged class members so that in advancing his own interests, the representative will necessarily advance those of the class as well.⁸⁷

The representative also must show that the action may be maintained as a class action by falling within one of the three categories of Rule 23(b). A class asserting the right of publicity would want to bring a Rule 23(b)(3) class action since Rule 23(b)(3) "authorizes a class action when the justification for doing so is the presence of common questions of law or fact."⁸⁸ Rule 23(b)(3) class actions are "especially popular . . . where individual persons allegedly injured are in a poor position to seek redress, either because they do not know enough or because the cost of suit is disproportionate to each individual claim."⁸⁹

⁸² 3B J. MOORE & J. KENNEDY, *MOORE'S FEDERAL PRACTICE* ¶ 23.05 [1] (3d ed. 1982) [hereinafter cited as *MOORE'S FEDERAL PRACTICE*].

⁸³ *Id.* ¶ 23.06-1.

⁸⁴ *Id.* ¶ 23.06-2.

⁸⁵ *Id.* ¶ 23.07[1].

⁸⁶ FED. R. CIV. P. 23(a)(4).

⁸⁷ See *supra* note 72; see also *Levine v. Berg*, 79 F.R.D. 95, 97 (S.D.N.Y. 1978).

Rooney would not have met this test. The *Rooney* court determined that he did not have a valid claim against the defendants because of the facially valid contracts. Thus, having no claim, he was an inappropriate representative of anyone with a valid claim. See *East Texas Motor Freight System, Inc. v. Rodriguez*, 431 U.S. 395, 403-04 (1977) (A class representative must be part of the class and suffer the same injury as the class members), cited in *Rooney*, 538 F. Supp. at 213 n.1; see also *infra* notes 97-117 and accompanying text.

⁸⁸ 7A WRIGHT & MILLER, *supra* note 81, § 1777, at 44. Rule 23(b)(1) and (b)(2) class actions are inappropriate for a right of publicity claim. Rule 23(b)(1) applies where it is necessary to avoid possible adverse effects on class opponents or on absent class members. *Id.* § 1772, at 4. Rule 23(b)(2) is intended primarily for civil rights cases when injunctive and declaratory relief is sought. *Id.* § 1775, at 18, 25; see also *MOORE'S FEDERAL PRACTICE*, *supra* note 82, ¶ 23.45[2].

⁸⁹ C. WRIGHT, *FEDERAL COURTS* § 72, at 480 (4th ed. 1983).

A Rule 23(b)(3) class action requires the named representative to show: (1) that common issues of law or fact to the members of the class will predominate over questions affecting only individual members, and (2) that a class action is a superior method for the fair and efficient adjudication of the controversy.⁹⁰

Though the complaint should assert the existence of the necessary facts showing that the prerequisites of subsection (a) are satisfied and that the action can be maintained under at least one of the three categories in subsection (b),⁹¹ basically, these requirements sift down to two general requirements:⁹² that the class is so numerous that it is impracticable to bring them all before the court and that the named representative will fairly and adequately represent the class. Since adequacy of representation is crucial and the representative's interests must not clash with those of the purported class, this Comment's analysis of a class asserting a right of publicity will focus on the problems concerning the numerosity of the class and the adequacy of any representative to represent such a class.⁹³

1. Numerosity

Numerosity is met if the class is too large to practicably bring all of its members before the court. There is no arbitrary number which determines whether a class is so large that it would be impracticable to join all the parties. Rather, it is dependent upon the circumstances of each case. "The substantive nature of the claim, the type of class suit, and the relief requested also bear on how expansive a definition of the class will be allowed and, accordingly, on the necessary showing of numerosity in relation to impracticability of joinder."⁹⁴

In *Rooney*, there was never any doubt that the class satisfied the numerosity prerequisite. The motion picture companies estimated that they had released more than 9,000 films prior to 1960. In 1955, the Screen Actors Guild had a reported membership of 9,500 and the

⁹⁰ FED. R. CIV. P. 23(b)(3). See generally 7A WRIGHT & MILLER, *supra* note 81, §§ 1777-79.

⁹¹ 3B MOORE'S FEDERAL PRACTICE, *supra* note 82, ¶ 23.02-2, at 23-89 to -92.

⁹² C. WRIGHT, *supra* note 89, § 72, at 473. The common question of law or fact requirement of Rule 23(a)(2) will always be met when the tests of Rule 23(b) are satisfied. See WRIGHT & MILLER, *supra* note 81, § 1763, at 609-10 (citing *Vernon J. Rockler & Co. v. Graphic Enters., Inc.*, 52 F.R.D. 335, 340 n.9 (D. Minn. 1971)). The typicality requirement of Rule 23(a)(3) will be met if the requirement that the named representative adequately represents the entire class is satisfied. See C. WRIGHT, *supra* note 89, § 72, at 473 n.14 (citing *General Tele. Co. v. Falcon*, 457 U.S. 147 (1982); Degnan, *Foreward: Adequacy of Representation in Class Actions*, 60 CAL. L. REV. 705, 712-16 (1972)).

⁹³ See *infra* notes 94-117 and accompanying text.

⁹⁴ 3B MOORE'S FEDERAL PRACTICE, *supra* note 82, ¶ 23.05[3], at 23-162 to -166.

Screen Extras Guild reported a membership of 3,000.⁹⁵ It was conceded that "the class of actors no matter how small the role, in films released from 1916—or earlier—until 1960 obviously meets the numerosity requirement of Rule 23(a)(1)."⁹⁶

2. *The Feasibility of Adequate Class Representation*

To determine whether the named representative adequately represents the class, a court must first decide if a state provides a right of publicity,⁹⁷ and then question whether each class member has a right

⁹⁵ Defendants' Joint Memorandum of Law in Opposition to Plaintiff's Motion for Class Action Determination at 18, n.*, *Rooney* (citing U.S. DEP'T OF LABOR, BULLETIN No. 1185, DIRECTORY OF NATIONAL AND INTERNATIONAL LABOR UNIONS IN THE UNITED STATES (1955)).

⁹⁶ *Id.*

⁹⁷ Since the right of publicity is a state-created right, the court first would need to look to state law in order to determine whether the right exists. Since the existence of this right varies from state to state, the court must perform a choice of law analysis for each class member using the choice of law principles of the forum state. See *Klaxon Co. v. Stentor Elec. Mfg. Co.*, 313 U.S. 487 (1941). For instance, to select which state's law determines if plaintiffs have a protectible publicity right, a New York court, applying its property choice of law rules, would look to the current residence of the plaintiffs or the residence at the time of death, where any relevant contracts were signed and where the alleged violations occurred. See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 280-81 (2d Cir. 1981) (The Second Circuit looked to (1) where the alleged violation occurred; (2) where the person claiming the right lived; and (3) where the contract conveying the right of publicity was made.), *petition for reh'g denied*, 701 F.2d 11 (2d Cir. 1983). It is uncertain whether a New York court will consider the location of the misconduct as a determinative factor. See *Groucho Marx Prods., Inc. v. Day and Night Co.*, 689 F.2d 317, 319-20 (2d Cir. 1982), where the Second Circuit placed less emphasis on the location of the alleged misconduct and focused on both the place of residence and the place of contract execution.

Although an extensive choice of law discussion is outside the scope of this Comment, it is important to recognize that in a right of publicity class action, each of the legal issues may require a different choice of law analysis. A state's interests may vary with regard to violations outside of its borders, contracts made within its borders, descendibility of publicity rights for its own residents and publicity rights for residents of another state. For example, if the estates of deceased performers are included as members of the class, an analysis will be necessary of whether the right of publicity is descendible under each appropriate state's law. In *Factors*, the Second Circuit reversed the district court, which held the late Elvis Presley's right of publicity descendible, by deferring to the Sixth Circuit which had decided, as a matter of Tennessee law, that publicity rights were not descendible. *Factors*, 652 F.2d at 280-81 (citing *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980)). There has been legislation such as California S.B. 613 introduced which would make the right of publicity survivable in California for 50 years. See Tusher, *Celebrity Rights Bill Amended*, DAILY VARIETY, March 15, 1984, at 1, col. 4. The right of publicity, however, is not survivable in California at this time. See *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979). Descendibility may be conditioned upon where the right was exploited during the performer's lifetime. For each performer in the class, a court would be required to determine: (1) which state's laws apply; (2) whether that state recognizes a right of publicity; (3) whether the right is descendible; and, (4) whether the conditions for descendibility have been satisfied. Local probate rules and laws of trusts and estates might be involved if the

of publicity. The right of publicity is so individual and each performer's talent is so unique that no one individual is an appropriate representative.

The right of publicity applies only to those persons who have attained "celebrity status"⁹⁸ and have created a commercial value for their reputations. Although the courts have not explained the degree of celebrity status needed to support the right of publicity, most right of publicity plaintiffs have been individuals who have sought and acquired celebrity status in the entertainment field, such as singers, actors, authors and professional athletes. The right has generally been intended to meet "the needs of Broadway and Hollywood."⁹⁹ Celebrities are able to profit from their names or likenesses "in the normal course of their activities in entertainment, politics, business, or whatever makes them famous."¹⁰⁰ Since these individuals' names, likenesses and other personal characteristics are worth marketing, they deserve protection under the right of publicity.¹⁰¹

Since Rooney is a well known celebrity, he possesses a right of publicity. The problem is in determining whether each member of the class being represented is a celebrity and possesses the same right.¹⁰² One commentator analogizes libel law's 'public figure' to create a test which would determine whether a person possesses the requisite celebrity status to be protected by the right of publicity.¹⁰³

court is required to decide which of the heirs of a particular performer is the proper beneficiary of the publicity rights.

These complex individual choice of law issues would predominate over common issues. See *supra* note 90 and accompanying text.

⁹⁸ See *supra* notes 14 & 20 and accompanying text. "[T]his right of publicity is usually asserted only if the plaintiff has achieved in some degree celebrated status." *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (quoting Gordon, *Right of Property in Name, Likeness, Personality & History*, 55 Nw. U.L. REV. 553, 607 (1960)). Celebrity status has been attributed to actors, authors, politicians, artists, models, athletes, musicians, industrialists, executives, playboys or any others who desire to be in the public arena. Dönenfeld, *Property or Other's Rights in the Names, Likenesses, or Personalities of Deceased Persons*, 16 BULL. COPYRIGHT SOC'Y 17, 20 (1968). In *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979), Chief Justice Bird, in her dissent, characterized the case as one involving "the commercial use of the likeness of a prominent person." *Id.* at 835 n.10, 603 P.2d at 438 n.10, 160 Cal. Rptr. at 336 n.10). The *Lugosi* court expressed no opinion on whether the publicity rights recognized apply to other individuals.

⁹⁹ Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203 (1954). The right of publicity should be available even to new celebrities who suddenly attain prominence, although it should be limited by the extent of the new celebrity's fame. Ropski, *The Right of Publicity—The Trend Towards Protecting a Celebrity's Celebrity*, 72 TRADE-MARK REP. 251, 254 (1982).

¹⁰⁰ Ropski, *supra* note 99, at 252.

¹⁰¹ *Id.* at 253.

¹⁰² The degree of fame required to establish celebrity status is also disputed. *Id.* at 252-54.

¹⁰³ *Id.*

The test for celebrity should focus upon the geographic or commercial area in which the defendant is operating, should consider whether the plaintiff has intended to place himself or herself in the general public view in that area to gain notoriety or commercial success, and should consider the extent to which the plaintiff has succeeded. Media exposure and income as a public figure may be evidence of celebrity, but newsworthiness is not dispositive.¹⁰⁴

Another commentator agrees that the definition should include "anyone who actively attempts to achieve or maintain celebrity status."¹⁰⁵

A person who intentionally and strategically places himself in the view of the public, and who vigorously attempts to achieve celebrity status may never gain fame. For this unsuccessful or unknown performer who is exploited commercially, emotions and feelings are involved rather than commercially valuable personal attributes. Under this theory, unknown artists, such as those in *Rooney*, are not entitled to bring an action under the right of publicity and thus cannot be a part of Rooney's class. However, they can maintain an action under the right of privacy. If the unknowns in Rooney's class were to bring such an action, Rooney, being a celebrity and hence, more interested in profiting from his publicity value than in being compensated for emotional harm,¹⁰⁶ would not be an adequate representative of the class.

Two cases which strongly oppose the likelihood of a court granting certification to a class asserting a right of publicity are *Chateau de Ville Productions, Inc. v. Tams Witmark Music Library*¹⁰⁷ and *Bernstein v. Universal Pictures, Inc.*,¹⁰⁸ both of which noted highly relevant criteria in determining the adequacy of the class and its representation. In *Chateau de Ville*,¹⁰⁹ the four named plaintiffs were owners and operators of theatres who contracted with the defendant, a licensor of stage rights to musical plays.¹¹⁰ Plaintiffs claimed to represent all dinner theatres, stock theatres and musical playhouses that had licensed any plays from defendant since 1972. The district court certified the class. Subsequently, the Second Circuit reversed the determi-

¹⁰⁴ *Id.* at 253 (citing *Wolston v. Reader's Digest Ass'n*, 443 U.S. 157, 167-68 (1979)).

¹⁰⁵ Hoffman, *The Right of Publicity—Heirs' Right, Advertisers' Windfall, or Courts' Nightmare*, 31 DEPAUL L. REV. 1, 3 (1981).

¹⁰⁶ T. SELZ & M. SIMENSKY, 2 ENTERTAINMENT LAW § 18.02, at 18-13 to -14 (1983).

¹⁰⁷ 586 F.2d 962 (2d Cir. 1978).

¹⁰⁸ 79 F.R.D. 59 (S.D.N.Y. 1978).

¹⁰⁹ *Chateau de Ville*, 586 F.2d at 963.

¹¹⁰ In an antitrust action, plaintiffs claimed that the defendant unlawfully acquired and monopolized licensing rights to copyrighted musical plays in violation of the Sherman and Clayton Acts. *Id.* at 963-64.

nation and remanded the case. Upon review, the court considered that "determination of antitrust liability to any theater necessarily depends on differing facts as to each play license and as to each theater in the plaintiff class."¹¹¹ This is because "musical plays differ in quality, style and popularity."¹¹² The court found that the representative firms' unique size and character and their differing economic interests distinguished them from the rest of the class. These elements were noted by the court as criteria "highly relevant to the question whether the named plaintiffs will fairly and adequately represent the class."¹¹³

The class Rooney sought to represent presents a problem similar to that in *Chateau de Ville*. The performers in Rooney's class, like the theatre operators in *Chateau de Ville*, differ in quality, style and popularity. Mickey Rooney is a uniquely celebrated artist who has acquired a degree of fame and celebrity distinguishable from the performers in the class that he sought to represent. Even if the class were made up entirely of "celebrities," the degree of celebrity status each actor possesses varies, thus precluding adequate representation.

*Bernstein v. Universal Pictures*¹¹⁴ was an attempted class action in which lyricists and composers brought suit against some of the same defendants as in *Rooney* as well as against the Composers and Lyricists Guild of America. The class was defined "as all composers and lyricists, and in the case of deceased composers and lyricists, their representatives, who have composed music and/or lyrics for any of the defendants for motion pictures and television shows."¹¹⁵ As in *Rooney*, the defendants in *Bernstein* had been assigned the production rights for the works and had become the registered copyright owners as the proprietors of "works for hire."¹¹⁶ The *Bernstein* court noted that the interrelationships between various class members and defendants were "so varied and complex" that no statement could be made with absolute certainty about all persons within the group.¹¹⁷

Similarly, in a right of publicity class such as Rooney's, the interrelationships between the defendants and the individual members of the diversified class are inevitably varied and complex. The performers are at different stages in their careers with dissimilar

¹¹¹ *Id.* at 964.

¹¹² *Id.*

¹¹³ *Id.* at 966.

¹¹⁴ 79 F.R.D. 59 (S.D.N.Y. 1978).

¹¹⁵ *Id.* at 62 n.3.

¹¹⁶ See *supra* note 17.

¹¹⁷ *Bernstein*, 79 F.R.D. at 64.

bargaining positions and contract terms. Thus, under *Chateau de Ville* and *Bernstein*, a class asserting the right of publicity should not be certified because it cannot be adequately represented.

C. Publicity Value for Purposes of Calculating Damages

After a court examines each performer's case to determine whether he possesses a right of publicity, the issue of damages¹¹⁸ may be addressed. The fact of injury must be proven as to each class member. Damages will vary depending upon the film, the performer, and the value of the latter's publicity rights. Identifying the members of the class through a list of names of those who received screen credits is in itself an insufficient method by which to allocate appropriate damage awards.

Since the existence of injury requires individual proof, it is likely to dominate the litigation. In *Irving Trust Co. v. Nationwide Leisure Corp.*,¹¹⁹ the Second Circuit determined that only in an unusual case in which the assessment of damages presents individual issues for each class member will a court refuse to certify a class.¹²⁰ A right of publicity class action may certainly be typecast as such an unusual case. Thus, the complex damages analysis may ultimately require a court to preclude class certification.

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"Damages are . . . difficult to obtain because they are difficult to prove, even though a celebrity obviously can prove more damages than an unknown. Sometimes 'general' damages will be awarded based on injury to feelings or on other hard-to-measure injury. For instance, when the celebrity did not exploit his name or likeness, or the defendant has not earned a profit from the plaintiff's commercially exploited name and likeness, general damages have been awarded."

Ropski, *supra* note 99, at 262 (citing *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 881 (S.D.N.Y. 1973) and *Cher v. Forum Int'l Ltd.*, 213 U.S.P.Q. (BNA) 96, 103 (C.D. Cal. 1982)).

If an individual is entitled to relief, a court may grant injunctive relief to prevent unauthorized commercial use of the person's name, likeness and identifying characteristics. See, e.g., *Price v. Worldvision Enters., Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd.*, 603 F.2d 214 (2d Cir. 1979). A careful balancing of first amendment interests is required when an injunction is sought to prohibit the exhibition of a form of artistic expression, such as a film. In *Rosemont Enters., Inc. v. Urban Systems, Inc.*, 72 Misc. 2d 788, 340 N.Y.S.2d 144, *modified on other grounds*, 42 A.D.2d 544, 345 N.Y.S.2d 17 (1973), the court stated:

Each case must be decided by weighing conflicting policies; the public interest in free dissemination of information, against the interest in the preservation of inviolate personality and property rights. Among the relevant factors in such decisions are the media used, the nature of the subject matter, and the extent of the actual invasion of privacy.

72 Misc. 2d at 790, 340 N.Y.S.2d at 147.

¹¹⁹ 93 F.R.D. 102 (S.D.N.Y. 1981).

¹²⁰ *Id.* at 109.

Determining the publicity value of each performer requires an evaluation of each film and each performer in that film. In the *Rooney* context, the issue arises whether moviegoers are drawn to the box office exclusively to see the star perform. Even if that were so, the star of a film is never acting in a vacuum. People enjoy a film for the interplay of the star with the entire cast of performers as well as the efforts of the technical crew, director, producer, cinematographer, etc.

Further, suppose a particular film is celebrated exclusively for its extraordinary cinematography or avant-garde scene and costume design. Reviewers only praise the effects and aesthetic appearance of the film. These factors might reduce the actual publicity value of any performer in the film because the performance was only incidental to the main attraction of the film. Thus, box office receipts and ratings may not be reliable or accurate indicators of any performer's grade of talent or publicity value.

Not only is a quantitative evaluation needed, but also a determination must be made by a court as to when in time publicity values apply. It is questionable whether the damages awarded should be calculated according to a performer's publicity value at the time of the contract's execution or at the time of the violation.¹²¹ It is more practical to refer back to the time of a contract's execution. Damages would represent a value that otherwise would have been, and arguably should have been, bargained for. This approach, however, is an inaccurate appraisal of publicity value because it fails to reflect the additional value that the performer has acquired since the execution of the original contract. It is from the artist's subsequent commercial success that the appropriator reaps profit. Therefore, the actor's publicity value at the time of the violation is the only reliable point in time at which to calculate a performer's publicity value.

¹²¹ There is no ambiguity if all performers are "employees for hire." Under this theory, uniqueness of talent is compensated through varied and sliding pay scales. The only administratively feasible method by which to calculate damages employing this approach, however, is to decide arbitrarily that publicity value is related to the employee's salary at the time of hire. The law would be recognizing performers as employees distinguished only by their bargained-for rate of pay. To compensate artists according to an earlier contract's salary would be to determine their publicity value inaccurately. The appropriator is typically interested in profiting on the increased commercial value of the performer subsequent to the signing of the contract. If the artist had in fact been worth more when he signed the contract, a higher value would probably have been bargained for at that time.

Successful exposure of a performer in one work enhances the value of his participation in future works. This hiring is of long-term value to performers as well as to employers.

Not only must each class member's publicity value be evaluated separately for each film, but also the defendants have a right to a jury trial on each individual's claim of damages against them.¹²² The issue of damages is overwhelmingly individual. Accordingly, it is appropriate for a court to deny class certification because the complex damages analyses required are likely to dominate the litigation, defeating the procedural advantages afforded by the class action device.¹²³

IV. CONCLUSION

The right of publicity protects a celebrity's right to control the context in which his or her name or likeness is used commercially. A celebrity should certainly be compensated for his or her performance in a film created by another. However, the right of publicity is an improper means by which to acquire such performance protection. In addition to the fact that the 1976 Copyright Act preempts a claim for publicity rights in such a performance, social policy dictates that motion picture producers should have free reign over the marketing of the films created by them limited only by the rights each individual performer carves out through contractual negotiations.¹²⁴

¹²² In *Eisen v. Carlisle & Jacquelin*, 479 F.2d 1005 (2d Cir. 1973), *vacated*, 417 U.S. 156 (1974), the Second Circuit noted that Rule 23 did not abrogate any substantive rights including a defendant's right to defend against each damage claim against that defendant. In *Ralston v. Volkswagenwerk A.G.*, 61 F.R.D. 427 (W.D. Mo. 1973), the court declared:

I can find nothing to indicate that Rule 23 has abrogated the traditional means of measuring individual damages. If damages were to be awarded in this action, they should not be based on speculation or a system of averaging. Rather, the compensation due each individual member of the class must necessarily reflect the damages actually suffered by that party.

Id. at 432-33.

¹²³ See, e.g., *Schaffner v. Chemical Bank*, 339 F. Supp. 329 (S.D.N.Y. 1972). The court wrote:

[T]he notion of utilizing a jury trial in a class suit containing the varied problems certain to abound herein, is enough to chill any further discussion of the required superiority of a class claim over other available methods for the fair and efficient adjudication of the controversy. Such a trial, whether one trial or the multiple mini-trials probably required, would withdraw from all other usefulness for years to come the federal judicial personnel involved. Where one could muster jurors willing to devote themselves so indefinitely in time from their accustomed tasks, is puzzling. And one might relevantly ask—what public interest would be served by devoting the public's facilities in this way and what just purpose requires such a colossal marshaling of judicial resources and their supporting personnel?

Id. at 337.

¹²⁴ Since "[i]nequality of bargaining power is an unavoidable consequence of the struggling artist syndrome," Rooney and his attorney, David Berger, created the American Society for the Protection of Artists and Creators [ASPAC] to "lead to a restructuring of the way film contracts

A right of publicity class action appears to seek one common resolution. On further analysis, however, highly complex issues such as whether each class member even possesses a right of publicity await determination by the court. Assertions in the complaint as to the numerosity of the class, the commonality of the claim, the typicality of surrounding circumstances and the adequacy of any artist representing the class only begin the inquiry. Each film or television program in which performers appear and each of their performances differs substantially. Not only do the performers' interests vary between publicity and privacy rights, but also the publicity value of a film, including the value of individual performances, fluctuates according to popular demand. Comparing and determining different grades of performances and popularity of a performer throughout his or her career in relation to all others within the class would involve subjective evaluations of each performer and create administrative difficulties for the court. Since virtually every element of each plaintiff's claim requires individual proof, a court, in the interest of judicial economy, should not certify a right of publicity class. Rather, publicity claims should be maintained as individual lawsuits in which each performer with an existing claim can be individually evaluated.

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are negotiated, with the artist becoming the master, not the victim, of his role in the negotiating process." *Soocher, Mickey Rooney Creates an Artist's Rights Organization—His Lawyer Explains How and Why*, 1 ENT. LEGAL NEWS 1, 6 (Nov. 1983). With the advent of new technologies, ASPAC will attempt to rewrite the contractual groundrules to give artists challenged with additional creative outlets the chance to reap the benefits of new sources of revenue. *Id.*