RIGHTS OF PUBLICITY: AN IN-DEPTH ANALYSIS OF THE NEW LEGISLATIVE PROPOSALS TO CONGRESS*

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[After brief introductory remarks, Professor Hamilton introduced Steven M. Getzoff.]

STEVEN M. GETZOFF:

Thank you very much. I'd just like to take a couple of minutes to bring you up to date as far as the American Bar Association section on Patents, Trademarks, and Copyrights process is concerned, with regard to the right of publicity and federalizing that right. And my vantage point from speaking on that topic is that I am the Chair of the ABA Joint Task Force on federalizing the right of publicity, which has combined elements from our committees 205 and 201, for those of you who are into such things.

During the 1995-96 year, our committees proposed a resolution which was subsequently passed by the full section of the PTC section of the ABA, following in principle a uniform statute governing the right to privacy. Although such a uniform statute obviously could take the form of federal legislation, neither the committee nor the full section has addressed that before.

At this point, we have decided to address the issue of Federal action in the right of publicity area. Our original purpose, in that

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the International Trademark Assessment ("INTA") had taken a vigorous point position with regard to a federal statute, was to consider and report to the ABA as a body, upon the draft federal statute for right of publicity then being considered by the INTA.

However, we are advised, since the formation of our Task Force, that within the INTA, there has been discussion which precludes the releasing of a draft piece of legislation at this time. Because of that, our Task Force has considered its focus and purpose, and has initiated discussion aimed at producing its own federal right of publicity statute, consistent with its predecessors. The subcommittee generally believes that a uniform body of law is desirable in this area, compared to the patchwork quilt with which the people of the United States are now afflicted.

Although such a body of law might take the form of a uniform state statute, along the lines of the U.C.C., the often disparate versions of the Model Trademark Act now in effect in varying states bear witness to the difficulty of uniform legislation surviving passage by state general assemblies. Indeed, this difficulty might even be more pronounced in the right of publicity area in which many states would be asked affirmatively to repeal existing statutes that have already been enacted after considerable debate.

Consequently, the subcommittee believes, generally, that a Federal, rather than state law approach is likely to provide the best route to uniformity. Our subcommittee generally agrees with its predecessors on the state level that the following issues warrant consideration in any right of publicity legislation at the Federal level:

(1) Whether any such statute should pre-empt existing state right of publicity laws. (2) Whether a person's right of publicity can be transferred. (3) Whether the federal right of publicity should extend beyond the person's lifetime, and additionally, whether such an extension should be conditioned on a person's exploitation of the right of publicity during his or her lifetime. (4) Whether there should be a Federal registry for a person to register a claim for ownership of right of publicity. (5) The extent of appropriate remedies for violations of an individual's right of publicity. (6) Whether there should be some sort of explicit standard of fair use for a person's identity, for example, parody, news reporting, which would be exempt from a right of publicity claim. (7) Whether a post-mortem right of publicity should be transferable.

In light of the scope of these inquiries, the subcommittee, our Task Force, has not yet reached a point where it is ready to propose a resolution for the full section's consideration on the form a fed-

eral right of publicity statute should take. It nevertheless is continuing to address these issues with an eye toward the possible introduction of a resolution on this subject in the near future.

That pretty much brings you up to date, as far as where the ABA Task Force is. I'm advised by the highest levels of the International Trademark Association that they are very concerned to ensure that all vantage points, all points of view, all concerns are taken into account before they release to the public even a draft federal statute for consideration. That is a position our Task Force at the ABA supports. I see no point in simple churning for churning's sake.

My own personal viewpoint with regard to right of publicity is that it belongs in the Lanham Act,[1] if anywhere. It belongs in the Federal Trademark Statute. There are a number of practical reasons for that.

I would refer you to a number of articles from the *Trademark Reporter* of September-October 1995[2] [as well as] *Joe Camel and The First Amendment: The Dark Side of Copyrighted and Trademark Protected Icons,* an article by Dorean Koenig.[3] These articles illustrate that what we have here is overreach. We have considerable overreach on even creative personas, such as Joe Camel, because to the best of my knowledge there is no real Joe Camel, at least outside of the imagination of some very, very imaginative twelve to seventeen year olds, which is part of the reason for the problem.

My personal belief, as well, is that concerns such as descent, survivability, post-mortem rights to a right of publicity, and how one determines whether a right of publicity should or should not be protected and by what parameters, are all clarified if you take the right of publicity as a trademark right with the attendant responsibilities on the trademark owner. And not only on the trademark owner, in terms of her or his activities to ensure that his mark is used with a consistent quality provision, but also, that he acts upon his licensees in such a way as to ensure that he is not, in fact, granting a bare or naked license.

Some of you may remember that about a year ago, there was something of a very large hoopla in the garment industry concerning a certain garment manufacturer. Specifically, I believe, Nike

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[1] 15 U.S.C. § 1051 (1988).

[2] *See* Julie Arthur Garcia, *Trademark Dilution: Eliminating Confusion,* 85 TRADEMARK REP. 489 (1995); Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?,* 85 TRADEMARK REP. 525 (1995).

[3] Dorean M. Koenig, *Joe Camel and the First Amendment: The Dark Side of Copyrighted and Trademark Protected Icons,* 11 T.M. COOLEY L. REV. 803 (1994).

shoes came into the discussion at that time. There was concern because very, very important sports figures and other people in the media, such as Kathie Lee Gifford and Michael Jordan, had their names and personas associated with this organization.

I would like to point out to you the contrast in behaviors. Michael Jordan's comment, when questioned by the press was, "Not my problem. Not my problem. Talk to the corporate attorneys. It's not an issue with my contract." Kathie Lee Gifford used her position as a licensor, and indeed her responsibility to the public as a licensor and a trademark owner, to force certain changes in that situation.

As if to bring us to full closure, we indeed have Nike being reported as being responsible for certain brutalities in its factory in Vietnam. I maintain, by my personal standard, that Michael Jordan has engaged, if you were to use my matrix, in a license in gross, or a naked or a bare license, because he has not maintained quality control over the activities of his licensee. I would maintain that Kathie Lee Gifford does, in fact, have an enforceable right of publicity.

[Professor Hamilton introduced Barbara Kolsun.]

BARBARA KOLSUN:

The comments about Kathie Lee and the sweatshops are a perfect segue to what I was going to talk about. I've been representing garment companies and designers for several years. And one of the ways that I spend most of my day is assisting the police in criminal seizures of T-shirts and sweat shirts and other items.

The first thing that occurred to me when I thought about this topic is, what really is the difference between a trademark and someone's face. Although McCarthy says right of publicity law is not trademark law,[4] the issues are very much the same. Let's use civil and criminal seizures as an example. In Chinatown, we seize T-shirts with Polo, Nike, Donna Karan, and Calvin Klein on them. But there are also shirts with the faces of Mike Tyson, Michael Jordan, and KISS. Most manufacturers of counterfeit goods are sweatshops, with no respect for labor issues conditions, fire code violations, and other issues like that.

And why shouldn't a face be registerable and seizable?

Under New York Criminal Law, Penal Law 165,[5] unless a trade-

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[4] *See* J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture - The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129,131 (1995).

[5] N.Y. PENAL LAW § 165.70(1)(a) (McKinney Supp. 1997).

mark is registered, either in the state or federally, the police cannot seize counterfeit products. I mean, if a prosecutor is particularly interested in the case, there are schemes to defraud laws and criminal simulation laws. But for the most part, if the trademark is not registered, they're not going to take it. The jurisdiction issue also comes to mind. Although, as a practical matter, most of the major cases on right of publicity are brought in federal court, because good lawyers will throw in a 43A[6] claim to bring the case into federal court, under New York Civil Rights Law sections 50 and 51, if you're bringing a pure right of publicity case, you've got to bring it in state court, which is simply not as nice a place to practice. There's no other way to say it. The case will sit around. The quality of the judges is different. The case does not move through the system as quickly. The one case that I recently handled in practice involving right of publicity, which had to do with a Tommy Hilfiger model who had gone to Polo and was suing Hilfiger for using his image on posters after their agreement had come to an end, was brought in state court. As a practical matter, we settled it very quickly, because otherwise we would have been litigating for two or three years. So that's another issue in favor of a federal law on right of publicity.

There are also different points of view about uniformity, but I think the whole forum shopping thing really is a problem. I mean, as you probably know, in California, the right of publicity extends beyond a person's life. In New York, it doesn't. And so, if somebody is going to bring a right of publicity case on behalf of a celebrity who has died, you've got to do it in California. Also, advertisers who want to run a potentially national ad with a right of publicity problem would have to run it in fifty states. A federal law would eliminate uniformity issues.

I think another interesting related issue is that of parody and how that crosses over with right of publicity. I represented Hilfiger in an action against a T-shirt manufacturer that had produced the "Tommy Pull My Finger" T-shirts, which I'm sure most of you have seen. Is that a parody or a right of publicity issue? There's actually two: the Tommy Hilfiger flag, which is a trademark, and the Tommy Hilfiger name, which is a trademark. There's also the Beavis and Butthead images.

[Professor Hamilton introduced William M. Hart.]

WILLIAM M. HART:

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[6] Lanham Act, 15 U.S.C. § 1125(a)(1994).

Thanks. I'm surprised that it's taken this long for us to sit down and talk about this thing. Because, you know, I go to these speeches on IP all the time, and I hear all about how software is one of our leading exports and entertainment products are universally known to emanate from the United States, for music and motion pictures, and these are our most valuable commodities. But, to me, those are merely reflections of something else the United States exports every day, whether it's for dollars or, by osmosis. And that's our pop culture, which is what this right of publicity stuff is all about. And if you've ever spent any time abroad, you know as well as I do the number of young men that are sporting bad pompadours, long sideburns, and wish they were Elvis. I mean, it's made an indelible impression.

Is it worth protecting? That's a value judgment that I'm not going to pass on. Let's put it this way. If we don't do it, somebody's going to. So far, the states have seen fit to do it. And I don't know if any of you have ever tried to clear a right of publicity, but let me tell you something. Take an international client, one who comes from the U.K. They don't have what we call a right of publicity over there. And they say, "What do you mean, right of publicity?" And then you begin to explain that we have fifty different ones, maybe. You haven't checked Utah lately. And they think we're insane. We are insane. I mean, need for uniformity? Come on. There's got to be something that you can look at and say, "This is the right." We have things in the copyright called "mass works." They don't have anything to do with copyright. You know, stick it on an immigration bill. Who cares?

I disagree that it's so analogous to trademark that it should be governed by trademark. A trademark test leads to a likelihood of confusion. Right of publicity is strict liability. This proposed bill has a couple of parts to the rights that are defined, one of which talks about the rights of an individual's likeness or identity, which is defined very broadly as being used in a manner that associates it with a product or to an endorsement. That's trademark stuff, really.

J.T. McCarthy, who spoke on this at Columbia a couple of years ago, takes a hard core view.[7] There's no such thing as commercial parody. You're always using the selling power of someone's name or likeness to sell a product. There are no jokes when it comes to advertising. It's all sell, sell, sell. So you know, I'm touching on two things. Why should we look at a trademark bottle

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[7] *See* McCarthy, *supra* note 4.

strictly? Because it's more indifferent than trademark. Tack it on the Lanham Act, if you will. And should we have some benchmark for fair use? Good luck. We've got one in the Copyright Act after 148 years.[8] Tell me that that's clarified things. The one thing that concerns me is that there's an implication that there might be a right of parody for commercial use. I'm not going to say I go as far as McCarthy does, but it's certainly something to think about. Should it be transferable? Should it be descendable? Absolutely.

In terms of whether the right gets lost if it hasn't been exploited within a certain time, why would we do that to people? We go back to the California Supreme Court's sort of angst over whether Bela Lugosi had a right.[9] Remember that case? And they came up with four different reasons why he might, but didn't. And one of them was this touchstone of, "He had to have exploited it during his lifetime." Well, I know that if I saw my uncle's picture on T-shirts, God rest his soul, I'd be mad. I'd want money. And isn't that what this is all about? I don't mean to sound glib or facetious about it. It's important stuff.

One of the things that I don't know how we'll address is the international realm. I've been dealing in the last year and a half with the Internet in a large way. And if it's up somewhere, it's up everywhere. Most countries have copyright laws. Most countries have something analogous to trademark. Usually, it's driven by registration. What about right of publicity? I don't even know where that fits in the matrix of the General Agreement on Tariffs and Trade ("GATT") protective rights these days. And I'd love to hear from some of the experts we have in this room.

Let me just leave you with one other concept, and that is this. This notion of having different state laws which are uniform, like the Uniform Commercial Code, is so bizarre. I mean, for example, state registries. Well, which state are we going to register in? Is it the place where the person lived? Is it the place where the person died? Is it the place where they exploited the rights during their lifetime? And what if they didn't exploit them? Do I still have to search 50 state registries? I don't think it'll work that way. With all due respect to the people that deal with Federal registration, we've got to deal with it in a truly unified way. I mean, that's federal, not state.

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[8] 17 U.S.C. § 107 (1995).

[9] Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979).

[Professor Hamilton introduced Diane L. Zimmerman.]

DIANE L. ZIMMERMAN:

I'm sitting here listening to everyone, and I have this awful feeling that by the time I get done, I'm going to feel like the priest who got invited to the bachelor party, at which somebody forgot that they were going to have a nude woman jump out of the cake. Because I'm afraid that I'm something less than an enthusiast of the approach that we have been given for a national right of publicity. I think that it's easy to overstate the benefits of a uniform national law in an area like this. I think we run the risk of freezing the law in a form that I, for one, am not particularly happy. I would also say that having gone through some of the wars with the Uniform Defamation Act, I am also somewhat dubious about the ability of large numbers of people with various axes to grind to get together on any complex proposal. By the time that defamation act was finished, we were left with a little bit of stuff on clarification and retraction, and not much else. And so I don't know exactly whether a national law that needs to satisfy lots of people who speak a lot and speak well and don't agree with each other has a chance of making it.

At any rate, if we are going to have a national law, I thought I would just pick up on a couple of things that I thought were actually pretty good about the draft that we have been given in the state thus far. I like the fact that it obviates vicarious liability, that people have to know that they're publishing something that violates somebody's right of publicity in order to be liable. I like the fact that there is a proposal for a system of keeping track of these rights. It seems to me that one of the things that we have done wrong in copyright is perhaps to give up on as many avenues as we have to force people to register their rights in some centralized place, so that everybody can find out who has them and who they need to deal with. And I personally like the attempt to provide a fair use provision that's explicitly in this legislation, even though from my point of view, it's not a terribly generous one.

But now, let me tell you a little bit about what I think is problematic in this area. First, I'd like to go back and just make a couple of comments about the right of publicity, which will show you that I probably shouldn't have been asked to sit on this panel. I am extremely troubled by what I view as the trend in intellectual property law, as well as in a lot of other areas, toward universal commodification. I don't know of any justification for the claim

that a person who creates social value is entitled to exploit it in its entirety. Nor am I, frankly, at all convinced by the argument that people who claim the right of publicity are indeed the sole creators of the social value that adheres in their names, faces, and other indicia of identity. I think that this body of law, and much else about the general area of intellectual property today, ignores, I think, to all our sorrow in the future, the benefits of a rich public domain. And I think that the right of publicity, as it is developing, has many troublesome aspects in relationship to the First Amendment. I'm not opposed to people getting money when others need their cooperation and are willing to enter into a contract with them to get it. That's fine. I am also not concerned about protecting as a trademark, that which is genuinely used as a trademark. And I must say that I think it's worth spending some time in the near future thinking a little bit about the implications of the ability of computer experts to simulate us doing a variety of things and saying a lot of things that we never actually said, and about what we ought to do with a law in that area. I am concerned about misrepresentation and false endorsements.

But having said all of that, it doesn't mean that I think we need the kind of broad right of publicity that's being discussed here. And the idea of enshrining it in a federal law that affects all fifty states and gives us relatively less ability than we now enjoy at least to backtrack from some of the more offensive developments in this area seems to me too bad. It isn't that I think individual states are going in the right direction, it's just that I hope if we don't have a federal law, we may be able to back off in a few places.

Also, I don't think it's an answer to say that creating these rights does not cause speech problems because they involve purely commercial kinds of ventures that you can regulate. It seems to me that anybody who reads the Supreme Court's commercial speech cases, particularly recent cases like *Rubin v. Coors Brewing Co.* [10] and *44 Liquormart, Inc. v. Rhode Island,*[11] has got to see that there is a strong possibility that the Court is finally going to conclude that at least truthful commercial speech is entitled to full First Amendment protection.

That will raise a problem for people who believe that if one wants to say that Rudolph Giuliani eats Cheerios every morning for breakfast in an ad for Cheerios, and it happens to be truth, that the statement can nevertheless be enjoined to protect the Mayor's

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10 514 U.S. 476 (1995).

11 116 S. Ct. 1495 (1996).

right of publicity. Maybe we will conclude that we should do that, but I think we ought to think carefully about it.

I don't think that the word "commercial" has been thought through carefully enough. We've been talking here about T-shirts, posters, mugs, and busts of Martin Luther King. Celebrities get to enjoy their status and increase the value of their performances, I think, in part by the lucky fact that for some reason or another, the rest of us find something interesting or enticing about them. It may not necessarily have much to do with anything that they have done to deserve it. They become, sometimes for wholly extraneous reasons, a cultural artifact, a cultural icon.

People trade in other people's images. They invest in them a variety of kinds of meanings. And it seems to me that the notion that we are going to label those kinds of uses "commercial," and hence, just lift them out of the public domain, strikes me as not a terrifically good idea. I realize that the states are going in that direction, but as I say, I'm not eager to run out and promote a national law that says that's really terrific.

What about things like Warhol's use of Marilyn Monroe's image? Do we want to limit artists, for example, in the exploitation of people's images on the ground that they are making a commercial use if they plan on selling those paintings?

Finally, I am extraordinarily dismayed by the notion that New York is slowly but surely finding itself in the minority among states in not recognizing survivability of the rights. It is one thing to say that while somebody's alive, we want to give them control over how their names and faces get used in association, at least with selling products. But I frankly do not see any valid interest that is served by allowing them to have that right after they are dead. They aren't going to produce any more celebrity once they are six feet under. It is not even clear to me that anybody who invests in becoming famous has invested in becoming famous so that they can enjoy a right of publicity while they are alive. A lot of people who might enjoy a right of publicity never invested anything in getting famous and may not even like the fact that they are. I just can't see the value of all this. I'm having enough trouble, frankly, with dealing with moving from fifty to seventy years on the tail on copyright. I certainly can't imagine why I should love the notion of a life plus fifty year right of protection for somebody's portrait or a possibly indefinite protection of other aspects of their personality. I was also unclear, about whether the proposed law would cover imitations. Is this a law that covers Vanna White robots? And does it

cover Betty Grable's legs? Does it cover Marilyn Monroe's bust? I'm not quite sure.

I would be in love with this proposal if in fact it were a much more modest effort than it is, but since it seems to me to extend the law in a variety of ways, beyond where the states are now, I would like us to just deep six this whole thing and go home and take an aspirin.

MARCI A. HAMILTON:

That's someone else who was told not to express her opinion. And now, do the panelists have anything to say in response?

STEVEN M. GETZOFF:

Just a couple of remarks. I think, to clarify, first, I share your concerns, Professor, very much so, on possible risk to the First Amendment. A number of scholars, including Professor Felix Kent, have written extensively on this and express the same concerns.[12]

My personal view is that the genie is out of the bottle with regard to twenty-five of the fifty states. I would like it if your hope could be a viable one, namely that we could put the genie back in the bottle. Given the monies that are involved here, I don't think that you can do that.

What you can do, and why I for one think placing this in the trademark law is a good thing to do, is limit the mischief that it can do to the First Amendment, because in my view, (and this is the way that we would craft the statute), only a right of publicity that lived up to the standards that Congress has demanded of a trademark owner, would be entitled to have that right. And only a user, a junior user, of such a right of publicity, using it in a trademark rather than a fair use or rather than in a constitutionally protected way, would be enjoined for doing what they're doing any further.

And I think that we would also address the issue of descendability in a reasonable way, that we could all buy into. Namely, to the extent that the original Mr. Macy has gone to his eternal reward, at a discount, I hope, the question is, should that name be protectable? It functions as a trademark. People hear "Macy's," and they believe they will get a certain consistent quality of retail service.

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[12] *See* Felix H. Kent, *An Overview of the Right of Publicity*, N.Y.L.J., Sept. 20, 1996, at 3; Felix H. Kent, *Vanna Keeps Her Fortune*, N.Y.L.J. June 18, 1993, at 3.

WILLIAM M. HART:

Yes, but you're ducking the question in saying that. Because then it is a trademark right that's recognizable.

STEVEN M. GETZOFF:

Yes. But what I'm trying to say is, the right of publicity has fallen, to a certain extent, and it is considered not a trademark. To the extent that the right of publicity is not a trademark, I believe that it is possibly a dangerous doctrine to the First Amendment. I think it should be carefully couched within the trademark law, therefore disallowing the chance for overreach by moneyed interests who do not necessarily have the First Amendment or the public good at heart.

MARCI A. HAMILTON:

Steve, who are the moneyed interests? Who's pushing for this in the twenty-five states, soon to be fifty?

STEVEN M. GETZOFF:

Well, if you look carefully, you see, for example, in certain of the coverages, situations where people have been arrested for disparaging or could be arrested for disparaging Joe Camel, or other famous personality trademarks.

I don't think, for example, that we in New York City, who have seen some of the anti-smoking campaigns on top of some of the cabs, which are clearly, if you want to be a purist about it, violating among other things the models or celebrities' right of publicity, would want to enforce it. I think that in that context, to enforce it that way would be pernicious. Because in this context, it is not a trademark use. It is a clear fair use, as we define it for the purposes of the Federal Dilution Act. I think it would be clearly a fair use from the point of view of the First Amendment. Although you may have a trademark in this particular case, you could not enforce it in a situation like this. And the history of trademark jurisprudence going back would protect the public against overreaching trademark owners and interests such as, unfortunately, poor grandsons of Elvis Presley or granddaughters who would try to prevent people from engaging in erotic behavior.

MARCI A. HAMILTON:

But who are the special interests that want this law?

STEVEN M. GETZOFF:

I think if you're careful, you can see that there are trademark owners, who have, well, let me rephrase.

Trademark law places a burden on the trademark owner. To paraphrase, unto whom much is given, much will be expected. It is an extraordinary remedy. It should only be available when it is in the public interest to do so, and it should be done with great, great caution.

And I think that if we craft a federal right of publicity statute carefully, it will go toward protecting the First Amendment. I think if you're talking about specifics, obviously there are people who use the letter of the law against the spirit of the law. And I think that has to be carefully looked into.

MARCI A. HAMILTON:

Barbara, did you have something to add, at this point?

BARBARA KOLSUN:

I was curious to ask you what you thought of the Vanna White[13] and Tom Waits[14] cases. What's to be registered if there's a registration requirement? Do we register Tom Waits' voice? Do we register Bette Midler's voice? Do you think those cases have gone too far?

DIANE L. ZIMMERMAN:

Well, I don't have a clue what you would register at this point. It seems to me you throw the whole person into the hopper and say, "Anything that looks like me, sounds like me or smells like me is covered!"

When I was growing up, there was a cult of the supermodels. I think it still exists. Naomi Campbell is a supermodel, but somehow they don't seem to have quite the same prominence that they once had. Anyway, as soon as you had a supermodel, then you had lots of other people who looked like that supermodel. And if the supermodel was on the cover of *Vogue*, then on the cover of *Harper's Bazaar* would be the supermodel lookalike.

It never struck me as a terrible idea. It had something to do with what the public was interested in seeing at that time. Does this approach mean that we are now going to give whoever is the supermodel of the moment, a right that means people who look

[13] White v. Samsung Elecs. Am., Inc. 971 F.2d 1395 (9th Cir. 1992).
[14] Waits v. Frito-Lay, Inc. 978 F.2d 1093 (9th Cir. 1992).

like her can't exploit that similarity? I'm not quite sure I understand why.

So if you're asking me, "What would you register?" I would say, given the way the law in California is going, virtually everything. If you are asking me, "Do I think that's a good idea?" I have to say no. I mean, I certainly can understand that you might want to make it clear that the voice you hear was not Bette Midler,[15] it was not Tom Waits.[16] But I certainly don't understand why you would have a right of publicity that would flatly keep others from using voices that sounded similar. And I have to tell you, I don't see any possible basis on which you can say that Vanna White has a right to object to a little brass robot with a blonde wig. I am totally and completely puzzled.

STEVEN M. GETZOFF:

Can I address that? Because my thinking on the matter has been in transition on the Vanna White case.[17] Having come from a large corporate practice, of course, I was always for plaintiffs, right or wrong. My views have matured somewhat.

The concern I had about the Vanna White case was that it was much too broadly construed. But if I recall the facts, I think that on the facts there are some very troubling issues. If recollection serves, there were several celebrities to whom the defendant went to request permission for them to sign a license which would give them the right to use their right of publicity.

One was, and as you know, "celebrity" was loosely defined, Morton Downey, Jr.,[18] I recall. There were a couple of others. And one was Miss White. They got signed agreements from the others. Miss White declined to do so.

Now, where I come from—given that I spent two decades in a corporation—if you ask me to sign an agreement, it sort of implies that I have a right not to. And it's also something of an admission against interest that they asked the others to sign the agreement. There's also somewhat of an admission that they needed to get one.

WILLIAM M. HART:

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15 See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Midler v. Young & Rubican Inc.*, 944 F.2d 909 (9th Cir. 1991), in which singer Bette Midler brought an action against the car company and its advertising agency for using a "sound alike" to perform instead of Ms. Midler, thus exploiting the plaintiff's right of publicity.

16 *See Waits*, 978 F.2d at 1093.

17 *See supra* note 11.

18 *See White*, 971 F.2d at 1396.

Yes and no. I mean, the Supreme Court said *Two Live Crew*,[19] "Yo, guys, ain't so. Ain't the law."

BARBARA KOLSUN:

Well, in the *Waits* case,[20] I think the facts are very clear that Waits did not like publicity.

He was asked, I don't recall if they actually asked him, but I think they did, he said no. He said, "No, absolutely no," outright, which he had said about all publicity. And they went ahead and did it. And on several levels, as I recall.

WILLIAM M. HART:

But look, folks, if it were easy, we wouldn't all be sitting here, right? I mean, I agree with what you said, and that is, the genie is out of the bottle. We can't pretend that this doesn't exist.

DIANE L. ZIMMERMAN:

We can't, I agree.

WILLIAM M. HART:

Why should we place value judgments on whether someone is entitled, just because they look good. I mean, there's that old joke about Marilyn Monroe and Albert Einstein. You know, to each whatever their attributes or virtues are; why should the right of authorship stop or why shouldn't it stop after the author's dead? The author ain't gonna create any more. Why should we have a copyright law that extends beyond that?

DIANE L. ZIMMERMAN:

You can talk me into that.

WILLIAM M. HART:

No, and you know, this notion, "Oh, my God, we're going to kill the First Amendment." Man, I've been in so many infringement cases where that's the first thing you hear the defendant say. And you know, I have every faith in the judiciary, because every time I've had to go to court, I've had to deal with a First Amend-

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[19] *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994) (holding that the mere fact that rap group *2 Live Crew's* version of *Pretty Woman* was commercial in nature did not create a presumption against fair use).

[20] *Waits*, 978 F.2d at 1093.

ment defense. If it doesn't come from the defendant, it comes from the judge. I'm not that worried.

DIANE L. ZIMMERMAN:

Can I ask a question? Don't we need to justify the intervention of the law to give people these economic protections? In other words, why in the name of heaven is Vanna White entitled, in your view, not to have a robot imitate her?

WILLIAM M. HART:

The Vanna White case is a tough case.

DIANE L. ZIMMERMAN:

Good! Glad to hear that!

WILLIAM M. HART:

I'll cop to that. Voice cases are tough cases.

I don't know how many of you know that Luther Vandross made a lot more money selling McDonald's theme songs before he became a well known artist under his own name. People didn't necessarily know that that was Luther singing the McDonald's tune. But let's not take the hard cases and say that that addresses the whole landscape, okay? For one, why are these people entitled to it? Let's go back to the original perception of this right. I'm sure all of you have read the history much more recently than I have, but if I remember, it was the baseball playing card cases in this country.

And somebody was making money from likenesses from people who had no cognizable right. And you could call it unfair competition, but they really weren't in competition. Did they have a right? You said, "Gee, what's wrong with having Rudy Giuliani appear, or his name, at least, if not his image, appear on the back of Cheerios, if it's true that Rudy does really get up every morning and eat Cheerios and in his case I believe it, Your Honor."

But if I were Rudy or Rudy's lawyer, I'd say, "Wait a minute, you're selling off of my identity. You're not allowed to do that." I mean, the fact that I have a thinkpad brand evidence pad here does not entitle that company to say I endorse this thing, even though it's true that I'm writing on one of them right now. Who are we to sit here and judge that this one is more deserving? I mean, the notion from copyright, anyway, is that we're not supposed to make those judgments.

DIANE L. ZIMMERMAN:

We hear all the time, "This is not a copyright."

WILLIAM M. HART:

It isn't.

DIANE L. ZIMMERMAN:

No, it isn't, thank goodness.

WILLIAM M. HART:

But, on a moral basis, you could say, "Oh, a copyright author is more deserving than someone who just got born looking good." But, if this man's image appears on a box of wheat flakes, I ask you, sir, whether you wouldn't say, "Wait a minute. I want a piece of that."

MARCI A. HAMILTON:

The problem that we're addressing is two fold. One, are we done discussing whether or not we're going to do it? Is the genie out of the bottle? Now, as two academics sit at this end of the table, we couldn't care less if the genie's out of the bottle. We're paid to ask the question of whether or not they did it right, whether it's out of the bottle or not. My question is, can we stuff those twenty-five states back into the bottle? I mean, I would be inclined to say that that's more appropriate not only for First Amendment reasons, but for structural, constitutional reasons.

But even if you can't stuff them back into the bottle, then doesn't that mean this is a wonderful opportunity to draft a statute that has no bite. So wouldn't it be better, instead of trying to find certain arenas where it really would work, to find a federal statute that, one, doesn't necessarily pre-empt state law, and two, is just a thin layer at the top that won't provide the kind of invasive protections that I think Diane is alluding to.

But before we get back into it up here, I think we should see if the audience has questions.

AUDIENCE MEMBER:

I have two questions. First, has anyone determined whether the right of publicity protection is precluded by the Lanham Act?

What is the difference between the right of publicity and the right of privacy?

STEVEN M. GETZOFF:

I'd like to address the first part of that question, if I may. The Lanham Act, as it stands, for those of you who are into citations, 15 USC § 1052,

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register, on account of its nature, unless it . . . [c]onsists of or comprises a name, portrait, or signature or other aspects of persona, "identifying a particular living or deceased natural person, except by written consent of the person or persons set forth in section 244, if such written consent is not required because of termination of persona rights, pursuant to section 55. Or the applicant is a prior use of person. . .[21]

Anyway, the point is, it's very much like the situation we had with color, having been involved with the litigation between Master Card, Visa and my company at the time, American Express, which was a gold card.[22] There was nothing in the Lanham Act that precluded a color from being a trademark.

Yet it was somewhat frivolously decided, in my view, by the courts, citing the *Red Seal* case from 1943.[23] If we had litigated that, several years later, after *Qualitex*,[24] we would have been home free. I think that Qualitex served in lieu of a growing snowball in the trademark legal community, a need for a statute clarifying the chance to have a color trademark.

I think that's the same situation we have here. Suddenly, the Lanham Act, as you say, sir, does allow for a persona which is a trademark to be just that. I think that what is necessary is a clarification act, which takes the ambiguity and the question out of the realm of the courts and gives it to the people's representatives, where it belongs.

WILLIAM M. HART:

Now, go back to those early baseball player card cases. And before 43A existed and was expanded by the courts in the seventies and eighties, to deal with misattribution issues, which is what you're talking about. That's trademark.

Was a baseball player, who was well known as a baseball player,

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21 15 U.S.C. § 1052 (1988).

22 *See* American Express Co. v. Mastercard Int'l Inc., 685 F. Supp 76 (S.D.N.Y. 1988).

23 *See* Radio Corp. of Am. v. Decca Records, Inc., 51 F. Supp. 493 (S.D.N.Y. 1943). "Red Seal" was a name given to old RCA records.

24 *See* Qualitex Co. v. Jacobson Prod. Co., Inc., 514 U.S. 159 (1995) (holding that nothing in the law prohibits a color alone from serving as a valid trademark).

a trademark owner of his persona, at that time? I don't think so. I think you have to think of where it started. That also answers the question of what the added extra plus is.

But what prior rights as a trademark owner did he have at the time of the infringement? Today, that question could be answered under 43A, as an implied endorsement. But if you go back to the early cases, and before 43A was really as vital as it is today, in an old trademark law view about competition, was that the first user on the particular goods, or channels of trade—there was a real problem there.

I think that also answers your question about where does all this fit in. I wish we could put it all back in the bottle, because typically, I'm on the other side. Believe it or not, even though I sound like a proponent of it, I'm more often on the other side of having to clear it. And it's an impossible mess.

BARBARA KOLSUN:

Also, right of publicity applies to any person.

STEVEN M. GETZOFF:

Not just a famous person.

BARBARA KOLSUN:

That's right.

STEVEN M. GETZOFF:

I mean, McCarthy dropped a real bombshell with that, because traditionally, the right of publicity was considered only available to famous people. And when Professor McCarthy gave his speech at the U.S. Trademark Association annual meeting, just a few months before his seminal work[25] came out on the subject, he blew all of us away by asserting that everyone has a right of publicity, irrespective of whether they were famous. That's a certain democratic leveling point that has to be made.

DIANE L. ZIMMERMAN:

Well, I think that the difference is survivability. Privacy is generally a personal right. It dies with you. It's not something that's transferable. Once you call something a right of publicity, then essentially it becomes a commodity for trade, and a commodity sur-

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[25] *See* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY (1987).

vives its creator. It's somewhat of an artificial commodity, so we have to tell you how long it's going to live, because it isn't going to die on its own without something to kill it off.

BARBARA KOLSUN:

McCarthy says "[p]rivacy rights are personal rights. Damage is to human dignity."[26] On the other hand, the right of publicity is a property right. Damages for infringement of the right of publicity could include the fair market value of the plaintiff's identity, unjust enrichment, and the infringer's profits.

WILLIAM M. HART:

But go back to the inception of these rights. If someone's privacy were really intruded upon, you have a claim for trespass on the right of privacy. But take someone who is exploiting their persona, the baseball player, for example, in the early cases. Is that person someone who could say, "Oh, you interfere with my privacy by taking the image of me wearing my baseball uniform out on the field?" Of course not. It's no longer a privacy concern, as such. I mean, that's been blown out by the very use that establishes the right.

STEVEN M. GETZOFF:

But you see, there's another issue, too, which is that it's debatable whether or not, according to the findings of the court, that the picture of that athlete on a card is in fact a trademark use. Is it an endorsement of the quality of the product—not necessarily.

You could argue, as a number of people have, that such use would be under the heading of what we call "ornamental use."

WILLIAM M. HART:

But it doesn't have to be used as a trademark by an infringer in order to infringe on someone else's rights.

STEVEN M. GETZOFF:

Yes. I'm not exactly certain that in that particular context, especially at that time, whether or not there would be in fact a trademark in her or his persona. I want to keep this right, perhaps not back in the bottle, but shall we say, as close to the bottle stopper as I can get it.

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[26] McCarthy, supra note 4, at 134.

AUDIENCE MEMBER:

I am a film historian. Most of us have heard of the commercial where Fred Astaire dances with a vacuum cleaner. That commercial uses one of the most magnificent scenes in history. It seems that the film company or widow gave them permission to use that scene, and it has caused a lot of outrage in the film community. It seems that the public should have some right to be protected from the appropriation of such a scene.

STEVEN M. GETZOFF:

I think your point is well taken. But I think one must note that the highest court in the land, with numerous conservatives and Republican presidential appointees on the bench and likely to be there for quite some time, the Supreme Court, has opined that the burning of the American flag, which is about as high ranking a public icon as you can get, is protectable free speech.[27] Now, flag companies' rights notwithstanding, I think that we have to concede that we're getting a little ahead of ourselves in terms of worrying about Tony the Tiger and Smokey the Bear in that context. But you're raising another point which has been addressed in Europe and is beyond the parameters of our discussion here, which is more rights *droit morale*, which we don't have in the United States, at least not yet. It's being talked about.

But, it goes to the issue of whether or not the right of free speech protects the right of bad taste. And I think the courts have clarified. I remember a comment that Clarence Darrow once made in defending the Communist Workers' party. He said that we must be prepared to protect speech which we hate, if we are to be a country which will live by its First Amendment.

Another clarifying point, in terms of *droit morale*, in the *New York Times* OpEd page of January 27, there was some concern in terms of the various interests that were spoken of before. The OpEd by Seymour Chwast.[28]

Seymour was concerned as a graphics designer. He was concerned about the trivialization of logos. "A brand used to be what cattle carried on their backs to deter rustlers. Then came distinctive lettering that marked bottles. Noting the merchandising opportunity, marketers have branded our consciousness with corporate emblems for everything, dolls, rock groups, baseball

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[27] *See* Texas v. Johnson, 491 U.S. 397 (1989); United States v. Eichman, 496 U.S. 310 (1990).

[28] Seymour Chwast, *Street Signs*, N.Y. TIMES, January 27, 1997, at A17.

teams, even American Natural— Museum of Natural History."[29] And then it goes on, "I'll never forget the Gulf War logo that decorated the news on CNN."[30] And I think that it goes to, in that sense, there is a lot of money here. And I don't think there is any moneyed interest, perhaps the phrase is unfortunate, along the lines that certain elements on the paranoid right wing might concern.

I think basically what we have here, is we have an opportunity here for people to make a cheap buck, trivializing certain elements of our shared culture. That is unfortunate. It is not necessarily appropriate to bring the matter to court. It certainly is not a matter of freezing the First Amendment. I think that we have to keep our priorities straight.

And I think in a case like yours, I think that the answer is very simple. Ted Turner stopped colorizing the old movies when people stopped watching the Ted Turner Classic station in protest. If that's what you want to do, then that's what you want to address.

DIANE L. ZIMMERMAN:

Well, as you aren't going to be surprised to know, I would have a great deal of trouble coming up with a plausible way to justify that broad of right. I started out, by saying that I don't have any sympathy for this trend toward commodification.

In the copyright area, the notion is that if you don't give somebody some limited protection for their expression, you're going to have somebody who may spend ten years writing a book and who, if he or she can't control the distribution of copies of that book, isn't going to be able to get compensated at all for the effort that went into it, even though it has public value.

But, I find it very difficult to believe that Babe Ruth would not have played baseball if Babe Ruth couldn't sell Babe Ruth T-shirts. There's no hint in anything I know about Babe Ruth to suggest that that was true. I think that these publicity values are things that people develop, if they are developing them intentionally, for other career goals. And that they will continue to do it because it is to their advantage to do it, whether they get to sell mugs and T-shirts or they don't get to sell mugs and T-shirts.

It seems to me that if this kind of national law were going to be of any real use, it would identify those areas where there is some clear public justification for giving people limited rights to prevent certain uses of their name and face. I think such justifications ex-

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[29] *Id.*
[30] *Id.*

ist, for example, to prevent false endorsement. The public benefit is quite clear there.

But generally, it seems to me that there is very little I can come up with to justify such a broad right. A few years ago I was visiting in Virginia, and in the student lounge, there was a lamp. The base of the lamp was a statue in pottery of Elvis Presley and he had a lampshade on his head. And I thought to myself, "My God, how appropriate."

It strikes me as very odd that Elvis Presley's estate, or Elvis Presley himself, for that matter, should be able to claim that the public interest would suffer if Presley didn't get paid or Presley's successors didn't get paid some little extra amount as a royalty on that tacky, wretched looking lamp that the students were so in love with.

WILLIAM M. HART:

You know what, you're basing all of this on a fallacy. Start with the proposition that authors create under the constitutional imperative, because they do it for money. I mean, ironically, the statuette that's also a lamp base, is the case *Mazer v. Stein*,[31] which articulates that principle. And I think a lot of us who have been around the copyright campus know it's nonsense.

People don't write just for the money.

DIANE L. ZIMMERMAN:

No, they don't.

WILLIAM M. HART:

Who knows why they write?

DIANE L. ZIMMERMAN:

That's true.

WILLIAM M. HART:

I mean, I can't sit here and make a moral judgment whether we're better off because Elvis shampoo is protected or not. But I don't think you should be making those judgments either.

STEVEN M. GETZOFF:

I think you can clarify something, though, in terms of the right of publicity on the Babe Ruth point, to both of your points. Babe

[31] 347 U.S. 201 (1954).

Ruth was enjoined by Curtis Candy during his lifetime, from using his name, Babe, as an endorsement for candies, on the grounds that they had the Baby Ruth candy bar. The term, historically, was referencing President Theodore Roosevelt's daughter, whose nickname at the time that TR was in the White House was "Baby Ruth."

What happened thereafter was that this trademark right disallowed the Babe from using his own name, his own persona for the purpose of endorsing a product. I maintain that a narrow and very carefully crafted statute, addressing federal right of publicity would have allowed Babe Ruth to have the rights that he should have had.

One of the things that I find, going to your point particularly, Professor, that is so reprehensible in terms of these issues of people's estates, is that recently, I believe you can find Babe Ruth's persona being used to endorse Baby Ruth candy bars. And the fact that he would have choked at the thought during his lifetime, because of what that particular group of people put him through, I think shows you why clarifying the issue is important, in terms of simple justice.

MARCI A. HAMILTON:

Other questions?

AUDIENCE MEMBER:

I don't find Professor McCarthy's statement that a person who's not famous can have a right of publicity [persuasive]. As memory serves me well, it's been a long time now, I think of a case from 1916. I believe it's called *Roberson v. Folding Box Company*,[32] when it was the genesis, really for the New York State Civil Rights Law, which as we all know, is in reality a right of publicity and not privacy law.

If I remember the facts correctly, an unknown woman's face was used on a bag of flour. And she certainly was not a celebrity. She had not exercised her rights before. But for whatever reason, the company believed that that face had value. And it therefore chose to put it on a product that it was designed to sell. And that then caused the first legislative, to the best of my knowledge, right of publicity law.

Now, there was a person who was not a celebrity. But she had something that was of value to somebody. And as a result of that, she could have the right to say, "I don't want my picture on that flour. I don't want it. I don't want to be associated with that

[32] 64 N.E. 442 (N.Y. 1902).

flour." Now, did people buy it because they thought she was endorsing the flour? Probably not. Probably most people had no idea who it was. But for whatever reason, her face was attractive enough to this company to put her face on it.

So this is eighty years ago, and now we are questioning the premise, as some people appear to be, as to why that person should not have a remedy under law?

I'm thrown by another aspect that was touched on earlier. In terms of the underlying rationale for right of publicity, that of paying people. It seems to me, that in many cases you have public figures who are celebrities. Maybe that celebrity is not the appropriate person to pay.

I'm not sure whether Colonel Tom Parker should not be getting royalties for the exploitation of Elvis Presley. Most people would agree that Colonel Tom Parker, to a large extent created Elvis. Maybe Merv Griffin Productions, who created the quiz show, you know, *Wheel of Fortune,* and created a character to spin the wheel, should be the one collecting the royalties for Vanna White.

And maybe some other business, somebody named John Singer, if that was your name. Maybe that person should be collecting royalties for the use of that name.

BARBARA KOLSUN:

Well, in the copyright context, the Paramount "Cheers" case[33]comes to mind. In that case involving two characters at the bar at "Cheers," Paramount argued, "Wait a minute, we get the money because we own the copyright," and the characters said, "But we're the guys who are associated with those characters. We get the money."

WILLIAM M. HART:

Well, it goes back to the same conundrum the Bela Lugosi Court[34] was faced with, how many years ago?

I mean, who owns that right? Is it the motion picture company or Bela?

But when you think about it, we've got a good practice tip, and that is, when you're representing somebody from California, make sure that they get their plastic surgeons to assign all rights.

DIANE L. ZIMMERMAN:

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[33] *See* Wendt v. Host Int'l, Inc., 44 U.S.P.Q.2d (BNA) 1189 (9th Cir. 1997).
[34] Lugosi v. Universal Pictures, 25 Cal.3d 813 (1979).

Could I just add something to this? In copyright, there has been a lot of speculation, as many of you know, about what would happen if we radically cut back on protection. Would we really have any dramatic change in the production of copyrightable works?

Some people, including Justice Breyer, have suggested that we could in fact do with a great deal less copyright than we now have. But basically, I think we have had copyright almost as long as we've had printing presses—and pace to the people who are suggesting that the Internet will change the world—I suspect that we aren't likely to try to the experiment.

The interesting thing about the right of publicity is that we have had celebrities without a right of publicity. Other countries seem to manage to have famous people who find it quite worth their while to cultivate their fame without this right. And it seems to me that that really does raise a question about public justification for adding on this very broad kind of a right.

We are not talking about a remedy for very specific problems, like misattributions and so on, but one that says, "You know, if you want a T-shirt with my face on it, you're gonna have to pay me a little something." I'm not sure why that isn't just naked greed?

WILLIAM M. HART:

What's wrong with that?

MARCI A. HAMILTON:

No, no, wait a minute. As moderator, it can't keep me away from the microphone. It seems to me your questions are actually two sides of the same coin, and they're both asking the question, can we find a way to articulate a reason to justify publicity? It certainly can't be sufficient that there was a case in 1916, because that certainly wasn't a federal one.

It seems to me what we're talking about tonight is whether or not we ought to enforce a rule that has been apparent in some jurisdictions across the board. And that's the perfect opportunity for the ABA and for everyone else to start asking the question of, "Well, is it a good idea?" If you can't figure out if it's a good idea in every circumstance, then maybe federalizing is not a great idea, right? It seems to me that the discussion indicates that federalizing may not be a wonderful idea.

But my question for each of the members on the panel is, I have yet to hear any justification for the federalizing aspect of this

new development, except for uniformity. And it seems to me, with all due respect to the ABA, that they're not well situated, when the only circumstance that you would vote for it is uniformity, because what we are really saying is we want to make this easier for lawyers prosecuting claims. And as an academic, my answer is, who cares?

WILLIAM M. HART:

It's not just easier to prosecute, it's also easier to clear it. And if the notion is that you want a "rich public domain," you're serving both sides of the equation.

Secondly, why do we have to justify whether it incentivizes someone to do something that's societally beneficial? I mean, as I said a moment ago, the copyright law is based on that premise, and it's basically a fallacy. We don't know that that's the case. I mean, I'll get real mushy for a second and say, "Well, what about moral rights? What's fair about selling cereal using somebody else's image without compensating them? That's a good enough justification for me."

MARCI A. HAMILTON:

Well, wait. I still don't understand. I'm still grasping at what you're saying is the reason for it. Moral rights are not consistent with the American system, so I don't think they're a good example. Why? There are lots of reasons—

WILLIAM M. HART:

Well, wait a second. Just because we don't recognize moral rights in this country doesn't mean that it's not a good precedent.

MARCI A. HAMILTON:

No. But my question is, there are lots of reasons to give money to people. One of them is, "I like them." But there's no law that says that everybody I like gets money.

WILLIAM M. HART:

Then don't use their image.

MARCI A. HAMILTON:

Well, no. But how do you know what neutral principle you would apply, for determining when a right of publicity ought to be a federal, a uniform law.

WILLIAM M. HART:

Well, I was trying to help you by suggesting that it wasn't just to help the bad guys who are prosecuting the cases. It's also to help the good guys, under this tableau, in clearing the rights—

MARCI A. HAMILTON:

Well, you wouldn't have to help the good guys if you put the genie back in the bottle, right?

WILLIAM M. HART:

But that's impossible. That's an *academic* observation. Put it back in the bottle.

How are you going to do that?

MARCI A. HAMILTON:

Speak to the ABA.

STEVEN M. GETZOFF:

Well, there's also another point, which is that if we keep right of publicity as part of the trademark law, one of the remedies that somebody would have is that if somebody uses their trademark in a way, if there's trademark misuse, that trademark can be attacked on that ground, the trademark that is abused. Unfairly restrained trade can likewise be attacked.

So it is precisely the fact that you have a limited monopoly, which if you use to violate public policy, you can find yourself without anything at all. I think that is a very good argument for, why would uniformity be in the public interest? Not simply pure uniformity, but also because there are certain established remedies to abuse and misuse of these rights, which have been codified and put into our laws over the years.

We have many historical instances of violent abuse by trademark owners, going back to the last century and even recently. It is appropriate that what we have learned in this area, which is to keep these things limited monopolies, be applied to the right of publicity.

WILLIAM M. HART:

I'm sorry. When you use words like "violent" and I think about what we're talking about here, which is intellectual property rights, it just doesn't compute. I mean, it's money. This is money that we're talking about. And it's money on both sides of the table.

It's the people that have the rights exploiting it, and it's the people who want to take that stuff to make money from it, whether they have permission or not.

BARBARA KOLSUN:

Well, that's exactly it. I think we have to look.

STEVEN M. GETZOFF:

And people whose rights are abused, like these poor sweatshop victims, and these people who were being abused with physical violence in this Nike factory in Vietnam, and because there was money involved.

WILLIAM M. HART:

But those are trademark owners. Those aren't right of publicity owners!

STEVEN M. GETZOFF:

Excuse me, Michael Jordan licenses this company. Michael Jordan has an enforceable right. I maintain that to the extent that Michael Jordan has publicly expressed, to the extent that this is true and not a misattribution to him, but to the extent that it is true, but he says that "This has got nothing to do with me."[35]

I maintain that what we have here is a license in gross and a bare license and thus, an unviable trademark claim going forward.

I think that there are certain remedies to the public good in trademark law, in situations like this which have to be looked at. And I think that in that very recently afforded instance, we're talking about violence.

WILLIAM M. HART:

But it's nonsense. It has nothing to do with the intellectual property rights. I mean, unclean hands principles say it has to relate in some way to the rights. Misuse principles in copyright, which most of the people here who litigated copyright cases have addressed, are a little far fetched. I mean, but you can accept it.

But saying, "Gee, because someone harasses the opposite sex," or something, then they shouldn't enforce a trademark right or a right of publicity is absolute insanity. I mean, what are we talking

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35 *See* Chet Whye, *The Saga of Kathie, Nike, Spike, and the Rest of Us*, DENVER POST, June 27, 1996, at B7.

about here? Again, I'm trying to make this practical. We are dealing with business. This is what America sells. It is Elvises.

BARBARA KOLSUN:

Exactly. It is all about money. I hear this all the time, when I lecture on anti-counterfeiting. People or law enforcement ask, "Why should I care about Gucci purses?" Well, you should care. Because this is America. If you design something, everybody wants it. And I think any of you in this room who has a child who likes sports who spends a zillion dollars a week like I do on licensed merchandise knows how important this is to people.

This is what you started by saying in your presentation, by talking about Europe. You go to France, you go to Vietnam, everybody wants this stuff. And it's not just trademark. It's not just trademark, it's faces. It's voices. It's pop culture. It's everything; this is what we sell.

And it is all about money. That is the truth. It's who's going to get the money. Is it going to be the bad guys, who rip off the trademark holders and the famous faces, or is it going to be the people who own the trademarks and faces? I think that for any of us who have worked in this area, this is one of the things that makes this area particularly attractive. It really isn't about life and death or jail or anything, it's just about money.

DIANE L. ZIMMERMAN:

It isn't about money. It's about who gets the money.

It seems to me that there are lots of things one could say about who should get the money. For example, why shouldn't people who want a product with a face on it, get it for less because they won't have to pay an extra increment to the person whose face it is. In fact, that person's face only has value because people would like to see it once in a while.

It just isn't self evident to me why, if we're allocating the funds out there, we should necessarily allocate a piece of the action to the person whose face it is if we can't come up with a clear public benefit from doing so.

MARCI A. HAMILTON:

Let's go to the audience.

AUDIENCE MEMBER:

What about Indiana and its laws that extend the right of pub-

licity for 100 years after the death of the subject?[36] We've got twenty-five other states here who don't recognize it at all.

WILLIAM M. HART:

In other words, for the sake of uniformity, am I willing to cut back on the right? I don't know. I mean, it depends on whether the right should endure for 100 years as opposed to twenty years. I don't know. We have states that don't have a right. We have states that do have a right, but it's in the common law. We have states that have statutes, and it's all over the place.

Where I personally come out in terms of the substantive law, I don't know, make it parallel with, God forbid, life plus fifty, at a minimum. But don't make it contingent upon exploitation during life. I don't know. If they can convert it into a trademark usage, terrific, make it trademark. And you know what? I'm making this up as I go, because I have no idea.

If I were King? Let's see. Some of the rights like voices are tough. And some of the issues, like parody and commercial, what I found remarkable at J.T. McCarthy wasn't the notion that unknowns can have a right of publicity, but simply that it was an automatic that there was no parody in any commercial context.

Those are things that would have to be sorted out before this legislation. I guess, in hearing all this, I'm still for having a single one, simply from a practical standpoint. And that is, the idea of having, you know, this patchwork of a whole bunch of different registries would be the same nightmare as what we have now.

AUDIENCE MEMBER:

I submit that it's not just about money, it's about control. Einstein's family should be able to say "we don't want the image with his tongue sticking out on a T-shirt."

BARBARA KOLSUN:

No, I said that earlier in the counterfeiting context. The police bust a counterfeiter manufacturing T-shirts with Mike Tyson and Nike and everybody else. Licensing is all about control, quality, standards, and labor. That's a part of this that maybe has some meaning beyond who gets the money . . .for example, the sweatshop working conditions.

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[36] *See* Ind. Code Ann.§§ 32-13-1, *et seq.* (Michie 1995). The Indiana Statute is the broadest right of publicity statute in the country. *See* Felix H. Kent, *An Overview of the Right of Publicity,* N.Y.L.J., Sept. 20, 1996, at 3.

Well, what's going to happen when J.D. Salinger dies and they put his face on a T-shirt?

AUDIENCE MEMBER:

No one ever talks about this when it concerns real property, only when it's intellectual property.

DIANE L. ZIMMERMAN:

I think one of the things that you always need to ask is why we have property rights in the first place. We ordinarily have property rights to allocate and permit the transfer of scarce resources that cannot be used by multiple people at the same time without a great deal of waste occurring.

And so, we have divided up tangible property and we allow people to exercise some exclusive control over it, although not as much as the property rights people would like to claim. They would like to claim that there is absolutely nothing that you could do to regulate the use of private property that is legitimate. In fact, we have zoning and lots of other things that express the public's interest in tangibles.

But, what we're talking about here is not how to allocate a scarce resource, but rather, whether we ought to be creating exlusive rights in a resource, that absent an allocation scheme, could be used by virtually everybody.

My point is that intellectual property deals with a very different kind of problem. And, therefore, I don't think you can jump from the way that we treat tangible property or real property to how we shoul deal with intellectual property.

I don't think that there are any universal principles here. And it seems to me that what we're talking about is having you justify what you do.

MARCI A. HAMILTON:

Well, you might well be able to. But first, you'd have to say why you have it.

AUDIENCE MEMBER:

Professor Zimmerman, you seem to be advocating the removal of right of publicity protection . . . What makes one position better than the other?

DIANE L. ZIMMERMAN:

I would start out with a very different premise. And that is that information is a public good. Unless a good case can be made for a different result, it ought to remain one. That public domain is the most important thing that I think we have as a society. It is our intellectual, our social, our cultural context. And it ought to be presumptively available for all of us to use and manipulate and create from.

If you're going to take information out of the public domain and give someone exclusive rights to control it, it seems to me that the burden of justification is on the person who wants to commodify the information, not on the person who says it ought to be part of the public domain.

WILLIAM M. HART:

Point of clarification. Are you referring, as information's context, to the robotized Vanna, or given your position, even Vanna's actual likeness?

DIANE L. ZIMMERMAN:

I think Vanna's actual likeness. . . I would go that far.

WILLIAM M. HART:

That's information in a freedom of information sense?

DIANE L. ZIMMERMAN:

Yes. All of us create and think and work in a world where we use one another's identities, the information that other people generate, constantly. It's like air. We need it to think.

WILLIAM M. HART:

Did Samsung need it to sell VCRs, informationally speaking? And would she have had a cause of action under the trademark law in your view, if it wasn't a right of publicity, or should she not have that also?

DIANE L. ZIMMERMAN:

First of all, I don't really see the trademark implications in the Vanna White situation. I frankly think that there is room for humor in advertising. I don't think of advertising as some separate sphere of speech, completely removed from the rules that govern every other kind of speech.

STEVEN M. GETZOFF:

But Professor, you have to concede that the advertising agency was interested in nothing else but making money. They were not interested in making a comedic statement. I mean, that would be under the realm of *Saturday Night Live*!

DIANE L. ZIMMERMAN:

So why is it wrong for them to want to make money and right for her?

WILLIAM M. HART:

Yeah, but doesn't she get a piece? That's the only question.

DIANE L. ZIMMERMAN:

I mean, they're selling this product. She's not a "product."

STEVEN M. GETZOFF:

For a very simple reason, because to some extent the commoditization of our popular culture may lead, in my view, may very well lead, to a complete erosion of the integrity of trademarks, as we understand it today, with all this total dilution of the actual equity in the brands, which stand for quality endorsement.

You start using them, Coca-Cola T-shirts, Coca-Cola women's dress shoulder pads, which I have actually seen sold at Macy's. I mean, at a certain point, where does it mean that this is a particular beverage which has a certain historical association, a certain quality association, a certain source association. It begins to be lost.

The point about right of publicity and the point about it being a trademark is very simple. To the extent that trademarks are recognized both individually and collectively, as commitments by their owners, whoever that owner may be. To assure quality. To the extent that that is true, they are entitled to certain levels of protection. And to the extent that there would have been a chance for a misimpression or a mistake by somebody watching that commercial that Vanna White had looked at these products and had been satisfied that the quality was good enough for her to endorse, to the extent that that was not true and that they were getting commercial advantage from implying that it was true, these people have to be stopped. To the extent that this sort of thing has gone too far in the marketplace, well, it remains to be seen.

WILLIAM M. HART:

Let me just stop you right there, because I think what you pose is a good illustration. Forget it being a robot face, let's say it was Vanna's real face. And let's say, it would be very tough for her to prove in a comedic context that she had actually endorsed the product. That's where the trademark law wouldn't protect it, and we come back to "Why does Vanna deserve to get compensated?"

Well, I pose the question again, "Why does Samsung deserve to sell VCRs using her image?"

DIANE L. ZIMMERMAN:

Because they make them.

WILLIAM M. HART:

I got it. But why, in the world of information— because as a copyright scholar, you will admit that part of the notion of idea expression dichotomy is that the information is freely available for all as opposed to particular expression. Why Vanna's face?

DIANE L. ZIMMERMAN

Because they liked it and because it was funny. So what's wrong with that?

STEVEN M. GETZOFF:

They also liked Morton Downey's face enough to pay him and to sign a contract with him.

WILLIAM M. HART:

I like J.D. Salinger's writing, by the way, and I usually like to incorporate it in my prose, when I'm selling, you know, other literature. I mean, it's intrinsically interesting. The ultimate irony is that we are concerned with the bastardization of American culture by selling the bastardized culture that we are talking about!

MARCI A. HAMILTON:

Okay. I'm glad finally the word "culture" came up. The answer to all of this discussion is not money, it's culture. And the question is, how we're going to regulate our culture. It has almost nothing to do with money. And those who have been to Europe, as most everybody in the room probably has, knows that the question is whether or not you're going to have a schlocky culture or not. We've chosen to have a schlocky culture. And Diane is defending the First Amendment right to have that, right? As usual, we've had

a very lively discussion here. Thanks very much. Let's give a hand to the panel.