THE RIGHT OF PUBLICITY GONE WRONG: A CASE FOR PRIVILEGED APPROPRIATION OF IDENTITY*

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I. INTRODUCTION

The right of publicity is the right of each individual to control and profit from the value of his or her name, image, likeness, and other indicia of identity.[1] Courts have long protected the pecuniary worth of a person's identity,[2] albeit under a number of legal theories.[3] In 1953, however, the Second Circuit explicitly recognized a proprietary interest in one's name and likeness, dubbing this interest a "right of publicity."[4] Doctrinally, the right of publicity has evolved from a type of privacy interest into an enigmatic mixture of the tort of misappropriation,[5] unfair competition law,[6]

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

2 *See, e.g.*, Brown Chem. Co. v. Meyer, 139 U.S. 540, 544 (1891) ("A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property."); *accord* Edison v. Edison Polyform Mfg., 67 A. 392 (N.J. Ch. 1907).

3 *E.g.*, Miller v. Madison Square Garden Corp., 28 N.Y.S.2d 811 (Sup. Ct. 1941) (privacy); Burton v. Cromwell Pub. Co., 82 F.2d 154 (2d Cir. 1936) (defamation); Chaplin v. Amador, 269 P. 544 (Cal. 1928) (unfair competition), *see infra* note 6 and accompanying text; or trademark infringement (Societe Anonyme du Filtre Chamberland Systeme Pasteur v. Pasteur Chamberland Filter Co., 8 TRADEMARK REP. 298 (S.D. Ohio 1918)).

4 Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

5 Misappropriation is the conversion of the investment, labor, or skill of another for use as one's own. International News Serv. v. Associated Press, 248 U.S. 215, 236 (1918). In *International News Service*, the seminal misappropriation case, International News Service (INS) was prohibited from using cables that wired news of World War I from Europe to the United States, so it copied news stories from the bulletin boards of the Associated Press (AP) and AP newspapers on the east coast and wired the news to INS newspapers on the west coast, where INS and AP competed. *Id.* at 231. The Supreme Court recognized a cause of action for misappropriation. *Id.* at 236. INS, the court stated, had taken marketable (albeit uncopyrightable) material that AP had acquired and had, "in appropriating it and selling it as its own . . . endeavor[ed] to reap where it ha[d] not sown . . . ." *Id.* at 239. The tort of misappropriation "recognizes that individuals . . . have enforceable proprietary interests in trade values they create and that invasion of these values occurs when an unauthorized person converts them for personal use and profit." David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 685-86 (1981).

6 State unfair competition law prevents deceptive trade practices such as "palming/passing off," whereby one person represents as his or her own another's goods or business. *See, e.g., International News Serv.*, 248 U.S. at 241; Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 714 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); Booth v. Colgate-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973); Chaplin v. Amador, 269 P. 544, 546 (Cal. 1928). An action for unfair competition may involve trademark infringement, use of simi-

and property jurisprudence.[7] After forty years of erratic judicial development, the right of publicity today affords the celebrity[8] a state cause of action against the unauthorized commercial exploitation of his persona. Infringing acts may involve the use of celebrity "look-alikes"[9] or "sound alikes"[10] in advertisements, use of the plaintiff's identity to imply endorsement of goods,[11] or appropriation of the plaintiff's name and likeness for selling merchandise.[12]

In 1903, New York enacted a privacy statute prohibiting the use of any person's "name, portrait, or picture" for "advertising purposes," or for "purposes of trade," without that person's written consent.[13] This statute became the model for "name-and-likeness" statutes subsequently enacted in thirteen other states.[14] Today, several states that have codified the right of publicity in such statutes also recognize an independent common-law right of publicity,[15] while other states lack statutory protection yet recognize the publicity right at common law.[16] To compound the confusion, those jurisdictions recognizing either a statutory or common-law right of publicity disagree as to the inheritability[17] of the right.

In the past four decades, state courts have expanded publicity protection beyond name and likeness to include other indicia of

lar corporate names, or trade dress similarities; false representations and false advertising often fall under unfair competition law as well.

The federal counterpart to state unfair competition law is § 43(a) of the Lanham Act, which forbids commercial use of "any word, term, name, symbol, or device, or any combination thereof" that is "likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of [a person's] goods, services or commercial activities . . . ." 15 U.S.C. § 1125(a)(1)(A) (West Supp. 1994). Since the unauthorized commercial use of an individual's identity might confuse consumers as to that individual's sponsorship or approval of the product, the plaintiff alleging infringement of his right of publicity may bring a claim under section 43(a) of the Lanham Act in the same action.

7 *See* Christopher Pesce, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 792 (1990) (right of publicity is "a hybrid of privacy's tort of appropriation, the law of unfair competition, and the law of property"); *see also* Steven J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112 (1980-81) ("It is more accurate to think of [the right of publicity] as a *sui generis* mixture of personal rights, property rights, and rights under the law of unfair competition than to attempt, Procrustean-like, to fit it precisely into one of those categories.").

8 Though the right of publicity is available to all individuals, right of publicity actions invariably involve celebrities, since there is little pecuniary gain in appropriating the name and likeness of an unknown individual.

9 *See* Onassis v. Christian Dior-New York, Inc., 472 N.Y.S.2d 254 (Sup. Ct. 1984) (Jacqueline Onassis), *aff'd*, 110 A.D.2d 1095 (App. Div. 1985); Allen v. National Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985) (Woody Allen); Allen v. Men's World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988) (Woody Allen).

10 Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (Bette Midler); Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992) (Tom Waits).

11 Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974).

12 *See, e.g.*, Memphis Dev. Found. v. Factors, Etc., Inc., 616 F.2d 956 (6th Cir.) (statuettes), *cert. denied*, 449 U.S. 953 (1980); Factors, Etc., Inc. v. Pro Arts, Inc. 579 F.2d 215 (2d Cir. 1978) (posters), *cert. denied*, 440 U.S. 908 (1979); Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866 (2d Cir.) (bubble-gum cards), *cert. denied*, 346 U.S. 816 (1953); O'Brien v. Pabst Sales Co., 124 F.2d 167 (5th Cir. 1941) (calendars); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970) (board games); Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (toys and novelty items); Rosemont Enter. v. Choppy Prods., Inc., 374 N.Y.S.2d 83 (Sup. Ct. 1972) (T-shirts).

13 1903 N.Y. Laws 132 §§ 1-2, codified as amended at N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1988).

14 Fourteen states currently have name-and-likeness statutes: California, Florida, Kentucky, Massachussetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Texas, Utah, Virginia, and Wisconsin. CAL. CIV. CODE §§ 990, 3344 (West Supp. 1994); FLA. STAT. ANN. § 540.08 (West 1988); KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984); MASS. GEN. LAWS ANN. ch. 214 § 3A (West 1989); NEB. REV. STAT. §§ 20-202, 20-208 (1991); NEV. REV. STAT. §§ 597.770-.810 (1991); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992); OKLA. STAT. ANN. tit. 12, § 1448 (West 1986); R.I. GEN. LAWS § 9-1-28 (1993); TENN. CODE ANN. §§ 47-25-1101 to 1107 (1988); TEX. PROP. CODE ANN. §§ 26.001-26.012 (West 1987); UTAH CODE ANN. §§ 45-3-1 to 6 (Michie 1992 & Supp. 1993); VA. CODE ANN. §§ 8.01 to 8.40 (Michie 1988); WIS. STAT. ANN. § 895.50 (West 1983 & Supp. 1993).

Massachussetts, New York, Rhode Island, Virginia, and Wisconsin protect "name, portrait, or picture"; Tennessee protects "name, photograph, or likeness." Other states offer broader protection. For example, Oklahoma and California's statute includes "name, voice, signature, photograph, or likeness"; Kentucky's statute covers "some element of an individual's personality." Utah's statute is entitled "Abuse of Personal Identity."

15 *See, e.g.*, Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (California); Zim v. West Publishing Co., 573 F.2d 1318 (5th Cir. 1978) (Florida); Memphis Dev. Found. v. Factors, Etc., Inc., 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980); Loeb v. Turner, 257 S.W.2d 800 (Tex. 1953); *Hirsch*, 280 N.W.2d 129; *see also Lugosi*, 603 P.2d 434 (Bird, C.J., dissenting) (right to exploit name and likeness, though transferable property interest, is personal and must be exercised by individual during his lifetime); Stephano v. News Group Publications, Inc., 474 N.E.2d 580 (N.Y. 1984) (refusing to recognize common-law right of publicity; publicity right subsumed under New York's privacy statute); Carson v. National Bank of Commerce Trust & Sav., 356 F. Supp. 811 (D. Neb. 1973).

16 *See, e.g.*, Martin Luther King Ctr. for Social Change v. American Heritage Prods., 296 S.E.2d 697 (Ga. 1982); Maritote v. Desilu Productions, 345 F.2d 418 (7th Cir.); *cert. denied*, 382 U.S. 883 (1965) (Illinois); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (Michigan); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970); Cepeda v. Swift & Co., 415 F.2d 1205 (8th Cir. 1969) (Missouri); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458 (N.J. 1967); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Zacchini v. Scripps-Howard Broadcasting Co., 351 N.E.2d 454 (Ohio 1976), *rev'd on other grounds*, 433 U.S. 562 (1977); Ettore v. Philco Television Broadcasting Corp., 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956) and Hogan v. A.S. Barnes & Co., 114 U.S.P.Q. 314 (Pa. C.P. 1957) (Pennsylvania).

17 The right of publicity is inheritable in Florida, Georgia, Kentucky, Nebraska, New Jersey, Nevada, Oklahoma, Tennessee, Texas, and Virginia; it is not inheritable in Illinois, Massachussetts, New York, Ohio, or Wisconsin. In California, the statutory right is inheritable, CAL. CIV. CODE § 990 (West Supp. 1990) (limited to 50 years after death), while the common-law right is not, Lugosi v. Universal Pictures, 603 P.2d 425, 428 (Cal. 1979) (Bird, C.J., dissenting). *See* FLA. STAT. ANN. § 540.08 (West 1988) (40-year limit); *Center for Social Change*, 296 S.E.2d at 705; Maritote v. Desilu Prods., 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965) (Illinois); KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984) (50-year limit); MASS. GEN. LAWS ch. 214 § 3A (West 1989); NEB. REV. STAT. §§ 20-202, 20-208 (1991); NEV. REV. STAT. §§ 597.790 (1991) (50-year limit); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Gleason v. Hustler, 7 MEDIA L. REP. (BNA) 2183 (D.N.J. 1981) (right descendible if exploited during lifetime); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1988); Reeves v. United Artists, 572 F. Supp. 1231 (N.D. Ohio), *aff'd*, 765 F.2d 79 (6th Cir. 1985) (Ohio); OKLA. STAT. ANN. tit. 12, § 1448(g) (West 1986) (100-year limit); TENN. CODE ANN. §§ 47-25-1101 - 47-25-1107 (1988) (10-year term, then of unlimited duration so long as right is continuously exercised); TEX. PROP. CODE ANN. §§ 26.012(d) (West 1987) (50-year limit); VA. CODE ANN. § 8.01-40(B) (Michie 1988) (20-year limit); WIS. STAT. ANN. § 895.50 (West 1983).

identity, such as a performer's style[18] or act,[19] a catchphrase,[20] characters created[21] or popularized[22] by a celebrity, and even a race car.[23] Recent expansion of the right of publicity is not *ipso facto* inconsistent with its rationales of preventing unjust enrichment, promoting creative endeavor, and—particularly in the case of imitations—avoiding consumer confusion.[24] Forbidding the commercial use of any words, images, and sounds that indirectly evoke one's persona, however, may conflict with the proprietary interests of others and with the First Amendment, particularly when the line between nondeceptive imitation and misappropriation of identity is unclear.

In 1992, Vanna White, the hostess of the television game show "Wheel of Fortune," brought a right of publicity action against Samsung Electronics.[25] The subject of the suit was a humorous advertisement depicting a robot dressed to resemble White and posed alongside the "Wheel of Fortune" game board.[26] The Ninth Circuit reversed the district court's grant of summary judgment for Samsung,[27] holding that a triable issue of fact existed as to whether White's identity had been misappropriated.[28] The circuit court stated that *how* Samsung had appropriated White's identity was not as important as *whether* it had done so.[29] So long as the robot in the ad made viewers think of Vanna White, regardless of whether they believed that White was endorsing the advertised product, a jury could decide whether Samsung had infringed her right of publicity.[30] White subsequently recovered $403,000 in damages.[31] The Ninth Circuit's decision—and more importantly, the evocation-of-

[18] Lombardo v. Doyle, Dane & Bernbach, Inc., 396 N.Y.S.2d 661 (App. Div. 1977) (public personality as "Mr. New Year's Eve"); Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962) (Lahr's voice and comic delivery).

[19] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (human cannonball act). *See* discussion *infra* part II.B.1.

[20] Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) ("Here's Johnny").

[21] Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y. 1975) (Laurel and Hardy characters); Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982) (Marx Brothers characters).

[22] *Lugosi*, 603 P.2d at 434 (Bird, C.J., dissenting) (Bela Lugosi's portrayal of Dracula).

[23] *Motschenbacher*, 498 F.2d 821.

[24] *See* discussion *infra* part II.C.

[25] White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

[26] *Id.* at 1396.

[27] *Id.* at 1402.

[28] *Id.*

[29] *Id.* at 1398.

[30] *Id.* at 1399.

[31] *See* White v. Samsung Electronics America, Inc., No. CV-886499 (C.D. Cal. filed January 20, 1994); *see also* Michael C. Lasky and Howard Weingrad, *Is Permission Needed to Make his Day?; Right of Publicity Often Implicated by New Systems*, N.Y.L.J., Mar. 7, 1994, at S-1.

identity test the court proposed—"erects a property right of remarkable and dangerous breadth"[32] and threatens free-speech values otherwise accommodated by intellectual property law.

This Note will argue how the right of publicity, as reformulated by the Ninth Circuit[33] in *White v. Samsung*, grants the celebrity a common-law monopoly much broader than is necessary to adequately safeguard the economic value of a celebrity's identity. The danger this Note addresses is that courts will apply the Ninth Circuit's evocation-of-identity standard without scrutinizing the purpose of a particular commercial appropriation—in effect, treating nondeceptive imitations and celebrity parodies as inherently wrongful. Part II presents the origin and scope of the right of publicity, tracing its historical development, examining its rationales, and outlining its relationship to copyright law. Part III parses the *White v. Samsung* decision and discusses its evocation-of-identity standard. Part IV analyzes the troublesomely expansive effect of the *White* decision on the right of publicity vis-a-vis the First Amendment and proposes privileged appropriation of identity as a means of offsetting an "all-or-nothing" approach to identity misappropriation.

II. Origin and Scope of the Right of Publicity

A. *Privacy Roots and* Haelan Laboratories v. Topps Chewing Gum[34]

The right of publicity originated as part of the right to privacy, the right "to be let alone."[35] In a landmark 1960 article,[36] Dean Prosser characterized the right to privacy as consisting of four separate "invasions": 1) intrusion upon the plaintiff's seclusion or soli-

[32] White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1514 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

[33] The Ninth Circuit decision, applying California law, will have no effect on New York law: *in New York, the right to publicity is preempted by the state privacy statute, N.Y. Civ.* Rights Law §§ 50-51. *See Stephano*, 474 N.E.2d 580. This statute affords only a narrow basis of protection by prohibiting use of a living person's name, portrait, or picture for purposes of advertising or trade. Nonetheless, given the strong presence of the entertainment industry in California and the persuasive authority of Ninth Circuit decisions in intellectual property cases, the effect of the Ninth Circuit's gloss on publicity rights cannot be underestimated.

[34] 202 F.2d 866 (2d Cir. 1953).

[35] William Prosser, Law of Torts § 117, at 802 (4th ed. 1971); *see also* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193, 195 (1890); William L. Prosser, *Privacy*, 48 Cal. L. Rev. 383, 401 (1960) [hereinafter Prosser, *Privacy*]. The phrase "right to be let alone" was first coined by Judge Thomas Cooley, Law of Torts § 29 (2d ed. 1888); Warren and Brandeis' law review article fully developed the notion of privacy theory.

[36] Prosser, *Privacy*, *supra* note 35, at 389-403.

tude, or into his private affairs; 2) public disclosure of embarrassing private facts about the plaintiff; 3) publicity which places the plaintiff in a false light in the public eye; and 4) appropriation of the plaintiff's name and likeness for the defendant's advantage.[37] It is this fourth element[38] that has evolved into the right of publicity.

The right of publicity, even as originally formulated by Prosser, differs from the right of privacy by safeguarding a commercial, rather than a dignitary, interest.[39] The unlawful appropriation of one's name or likeness involves economic injury, whereas the right of privacy protects against the defamation-like harms of humiliation, embarassment, and outrage.[40] This is not to suggest that the two are mutually exclusive: misappropriation of one's identity may injure the victim financially and emotionally,[41] and the plaintiff's prayer for damages in a right of publicity action may include damages for mental suffering.[42]

The development of publicity protection as a legal mechanism

[37] *Id.* at 401; *see also* RESTATEMENT (SECOND) OF TORTS § 652A (1976). "While Warren and Brandeis created the idea of a right of privacy, Prosser was the major influence on its current formulation." Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1582-83 n.35 (1979) (citing Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 926, 963-64 (1964)).

[38] While Prosser specified name and likeness as subjects of misappropriation here, he noted—rather presciently—the possibility that "there might [in some future case] be appropriation of the plaintiff's *identity*, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy. Prosser, *Privacy*, *supra* note 35, at 401 n.155 (emphasis added).

[39] "[T]he gravamen of the harm flowing from an unauthorized commercial use of a prominent individual's likeness in most cases is the loss of potential financial gain, not mental anguish. . . . The fundamental objection is not that the commercial use is offensive, but that the individual has not been compensated." Lugosi v. Universal Pictures, 603 P.2d 425, 438-39 (Cal. 1979) (Bird, C.J., dissenting) (citations and footnotes omitted); *see also* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 573 (1977); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 (9th Cir. 1974); Hoffman, *supra* note 7, at 116 ("[p]reventing economic injury to the celebrity . . . is the very *raison d'etre* for the existence of the right of publicity as distinct from the right of privacy").

[40] *See* PROSSER, LAW OF TORTS § 117, at 802-04 (4th ed. 1971).

[41] Commercial exploitation of celebrity identity may inflict emotional harm in at least three ways. First, the celebrity may find *any* unauthorized advertising use offensive, as is the case for those famous persons unqualifiedly opposed to endorsing products. *See, e.g.*, Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992) (plaintiff shocked, angry, and embarrassed by soundalike in corn-chip advertisement). Second, a celebrity willing to sponsor certain goods may nonetheless find a particular unauthorized use distressing, as when his name or likeness is associated with a shoddy or disreputable product. Third, other individuals unaware that an advertising use is unauthorized may disparage the celebrity for "selling out," such that the celebrity's goodwill is impaired. *See Lugosi*, 603 P.2d at 439 n.11. (Bird, C.J., dissenting).

[42] *See, e.g.*, National Bank of Commerce v. Shaklee Corp., 503 F. Supp. 533 (W.D. Tex. 1980) (on holding that the unauthorized commercial use of the name of famous columnist "Heloise" represented an invasion of privacy, the court awarded $75,000 for the endorsement value of the name and $25,000 for emotional harm).

distinct from privacy theory was no historical accident. Rather, as the cult of celebrity arose during the twentieth century, invasion of privacy proved inadequate as a basis for protecting famous persons from misuses of their names or likenesses.[43] First, for the celebrity, public exposure is his livelihood; rather than wishing to "hide his light under a bushel of privacy,"[44] the celebrity welcomes public attention.[45] Second, while most jurisdictions considered the privacy right personal and inalienable,[46] the burgeoning endorsement business[47]—and the increasingly popular practice of authorizing merchandisers to use one's name and/or likeness in advertising and promoting products—suggested *a priori* that one's name and likeness had property-like characteristics.[48] With the rapid growth of the entertainment industry and mass advertising in the 1930s and 1940s, courts could hardly deny the social reality that the names and likenesses of famous persons were becoming commodities exchangeable on the open market.[49]

[43] "The right of publicity was created not so much from the right of privacy as from frustration with it." Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 167 (1993).

[44] Nimmer, *supra* note 1, at 204.

[45] *See, e.g.*, Hogan v. A.S. Barnes, 114 U.S.P.Q. 314 (Pa. C.P. 1957) (because professional golfer was seeking payment for use of his name and likeness rather than avoidance of publicity altogether, plaintiff's privacy claim fails); *see also* James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 641 ("[T]he injury to sensibilities concept does not normally meaningfully apply when a person routinely permits advertising uses of his name or picture. . . . The harm resides not in the use of his likeness, but in the user's failure to pay."); Nimmer, *supra* note 1, at 207 ("[I]n most situations, one who has achieved such prominence as to give a publicity value to the use of his name, photograph, and likeness cannot honestly claim that he is humiliated or offended by their use before the public.")

[46] PROSSER, LAW OF TORTS § 117, at 814-15 (4th ed. 1971); RESTATEMENT (SECOND) OF TORTS, § 625I (1977). *See, e.g.*, Mau v. Rio Grande Oil, Inc., 28 F. Supp. 845 (N.D. Cal. 1939); Metter v. Examiner, 95 P.2d 491 (Cal. 1939); Hanna Mfg. Co. v. Hillerich & Bradsby Co., 78 F.2d 763 (5th Cir.), *cert. denied*, 296 U.S. 645 (1935); Wyatt v. Hall's Portrait Studio, 128 N.Y.S. 247 (Sup. Ct. 1911); Murray v. Gast Lithographic & Engraving Co., 28 N.Y.S. 271 (N.Y. C.P. Equity Term), *aff'd sub nom.*, Murray v. Babbitt, 31 N.Y.S. 17 (N.Y. C.P. Gen. Term 1894); Rhodes v. Sperry & Hutchinson Co., 85 N.E. 1097 (1908), *aff'd*, 220 U.S. 502 (1911); *cf.* Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866, 869 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

[47] In 1924, the advertising agency J. Walter Thompson ("JWT") persuaded a series of "great ladies"—including Mrs. Reginald Vanderbilt, Queen Marie of Rumania, and the Duchess de Richilieu—to extol the virtues of Pond's cold cream. The endorsement industry was born; JWT and other advertising agencies were soon using names and faces of movie stars and professional athletes to sell soap, cigarettes, sporting equipment, cosmetics, and other consumer goods. Madow, *supra* note 43, at 165.

[48] Even before endorsements became big business, several courts had inferred a property dimension to the publicity value of one's name. *See* Pavesich v. New England Life Ins. Co., 50 S.E. 68 (Ga. 1905); Munden v. Harris, 134 S.W. 1076 (Mo. 1911); Uproar Co. v. NBC, 8 F. Supp. 358 (D. Mass. 1934); Madison Square Garden Corp. v. Universal Pictures Co., 7 N.Y.S.2d 845 (App. Div. 1938); O'Brien v. Pabst Sales Co., 124 F.2d 167 (5th Cir. 1941) (Holmes, J., dissenting). *But see* Hanna Mfg. Co. v. Hillerich & Bradsby Co., 78 F.2d 763 (5th Cir.), *cert. denied*, 296 U.S. 645 (1935).

[49] As radio, motion pictures, and later television transformed American society and

Haelan Laboratories v. Topps Chewing Gum[50] judicially legitimized Prosser's tort of identity misappropriation as an independent cause of action and acknowledged the marketability of celebrity name and likeness. *Haelan* involved a contract between a professional baseball player and a chewing-gum manufacturer for the exclusive use of the ballplayer's photograph in connection with sales of the gum.[51] The defendant, a rival chewing-gum manufacturer, induced the ballplayer to breach his contract by allowing the rival company to use his photograph to promote its own product.[52] When the first manufacturer sued the second, the court had to decide whether the ballplayer's original contract constituted an assignment of a property right.[53] The defendant claimed that the ballplayer's only legal interest in the reproduction of his picture was his personal and nonassignable right not to have his feelings hurt: at most, in the original contract, the ballplayer had waived future action against the plaintiff for an invasion of privacy.[54] The Second Circuit rejected this argument, stating that

> in addition to and independent of [a] 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. . . . Whether it be labelled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth.[55]
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> . . . [I]t is common knowledge that many prominent persons . . . far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses [sic], trains and subways.[56]

Shortly after *Haelan*, copyright authority Melville Nimmer

created the cultural apparatus by which an individual could essentially become famous simply for being famous, "the public personality [had] found that the use of his name, photograph, and likeness had taken on a pecuniary value undreamed of at the turn of the century." Nimmer, *supra* note 1, at 204. For a detailed discussion of the early days of celebrity endorsement, see Madow, *supra* note 43, at 148-67.

50 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

51 *Id.* at 867.

52 *Id.*

53 *Id.* at 868.

54 *Id.* at 867.

55 *Cf.* WILLIAM PROSSER, LAW OF TORTS § 117 at 807 (4th ed. 1971) ("It seems quite pointless to dispute over whether such a right is to be classified as 'property'; it is at least clearly proprietary in nature."). *See also* Lugosi v. Universal Pictures, 603 P.2d 425, 431 (Cal. 1979) (Bird, C.J., dissenting) (debate over whether right of publicity sounds in tort or property is pointless).

56 202 F.2d at 868.

wrote a seminal article entitled *The Right of Publicity*[57]—which, in the words of one commentator, "did for the right of publicity what Warren and Brandeis did sixty-four years earlier for the right of privacy."[58] Nimmer faulted legal theories such as privacy, unfair competition, contract, and defamation as ineffective in vindicating the celebrity's commercial interest in his identity, arguing for recognition of publicity-right-*qua*-property.[59] Though the legal community did not immediately seize upon the doctrine announced in *Haelan* and advanced by Nimmer, the right of publicity gradually won judicial acceptance in a number of jurisdictions.[60]

B. *Further Developments: The Cannonball, The Count, and Mr. New Year's Eve*

1. *Zacchini v. Scripps-Howard Broadcasting Co.* (1977)

It was only a matter of time before the proprietary interest in one's identity would, like Warren and Brandeis' privacy right, raise First Amendment concerns. Could the same privilege to report matters of public interest that shields the press from liability for privacy invasions[61] allow the media to infringe a publicity right? In

57 *See* Nimmer, *supra* note 1.

58 Hoffman, *supra* note 7, at 111.

59 *Id.*

60 *See, e.g.*, Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (California); Zim v. West Publishing Co., 573 F.2d 1318 (5th Cir. 1978) (Florida); Martin Luther King, Jr., Ctr. for Social Change, Inc. v. American Heritage Prods., 296 S.E.2d 697 (Ga. 1982); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (Michigan); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970); Cepeda v. Swift & Co., 415 F.2d 1205 (8th Cir. 1969) (Missouri); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458 (N.J. 1967), Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (New Jersey); Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (New York); Lombardo v. Doyle, Dane & Bernbach, Inc., 396 N.Y.S.2d 661 (App. Div. 1977) (New York); Zacchini v. Scripps-Howard Broadcasting Co., 351 N.E.2d 454 (Ohio 1976), *rev'd on other grounds*, 433 U.S. 562 (1977) (Ohio); Ettore v. Philco Television Broadcasting Corp., 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956); Hogan v. A.S. Barnes & Co., 114 U.S.P.Q. 314 (Pa. C.P. 1957) (Pennsylvania); Memphis Dev. Found. v. Factors, Etc., Inc., 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980); Loeb v. Turner, 257 S.W.2d 800 (Tex. Civ. App. 1956); Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979). *But see* Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (Bird, C.J., dissenting) (right to exploit name and likeness, though transferable property interest, is personal and must be exercised by individual during his lifetime); Stephano v. News Group Publications, Inc., 474 N.E.2d 580 (N.Y. 1984) (refusing to recognize common-law right of publicity; publicity right subsumed under New York's privacy statute); Carson v. National Bank of Commerce Trust & Sav., 356 F. Supp. 811 (D. Neb. 1973).

61 *Cf.* Time, Inc. v. Hill, 385 U.S. 374 (1967). Hill brought a claim under New York's name-and-likeness statute that *Life* magazine, in describing a Broadway play based on a real-life incident involving the Hill family, made several nondefamatory falsehoods concerning the incident. The Hills had been held hostage in their home by escaped convicts; the ordeal inspired a novel and thereafter a play, *The Desperate Hours*. *Id.* at 378. The Hills alleged that *Life*'s misrepresentations invaded their privacy, causing humiliation and suffer-

Zacchini v. Scripps-Howard Broadcasting Co.,[62] the Supreme Court's only right of publicity case, the Court held that the First Amendment does not immunize the news media when they broadcast a performer's entire act without his consent.[63] More importantly, the Court, working within a misappropriation framework, identified two justifications for the right of publicity: providing an economic incentive that promotes creative endeavor, and preventing unjust enrichment.[64]

Hugo Zacchini performed a fifteen-second "human cannonball" act at county fairs.[65] Against Zacchini's wishes, a television news reporter filmed his act; the station then broadcast the fifteen-second film clip on its evening news program.[66] Zacchini sued for damages, alleging "unlawful appropriation of [his] professional property."[67] The Ohio Supreme Court found that Zacchini had a publicity right that gave him "personal control over commercial display and exploitation of his personality and the exercise of his talents."[68] Nonetheless, the state court, relying heavily on *Time, Inc. v. Hill*,[69] held that the news station was privileged under the First Amendment to broadcast matters of public interest otherwise protected by the right of publicity.[70]

The Supreme Court reversed the Ohio court's decision by holding that the First Amendment does not allow the media to appropriate a performer's entire act and thereby threaten the economic value of the performance.[71] The Court began by distinguishing the right of publicity from the right of privacy, stating that the former "focus[es] on the right of the individual to reap the reward of his endeavors and [has] little to do with protecting feelings or reputation."[72] The pecuniary value of Zacchini's act lay in his ability to control the publicity given to his performance since, the Court reasoned, the public would be less willing to pay

ing. *Id.* at 379. Building upon its decision in New York Times v. Sullivan, 376 U.S. 254 (1964), the Supreme Court held that the opening of a new play was a matter of public interest and that Hill could not prevail without showing that *Life*'s review was knowingly false or was published with reckless disregard for the truth. *Id.* at 387-88.

62 433 U.S. 562 (1977).

63 *Id.* at 575.

64 *Id.* at 576.

65 *Id.* at 563.

66 *Id.* at 564.

67 *Id.*

68 *Id.* at 569 (citing Housh v. Peth, 133 N.E.2d 340, 341 (1956)).

69 385 U.S. 374 (1967). *See supra* note 61.

70 433 U.S. at 570.

71 *Id.* at 575.

72 *Id.* at 573. *See supra* note 45 and accompanying text.

admission to see the act if it could see the act free on television.[73] Under these circumstances, the First Amendment

> no more prevents a State from requiring [the news station] to compensate [Zacchini] for broadcasting his act on television than it would privilege [the news station] to film and broadcast a copyrighted dramatic work without liability to the copyright owner.[74]

The Court elaborated on this analogy to copyright law with an economic-incentive argument: by guaranteeing the celebrity a financial return on the investment of human capital necessary to develop his persona, the right of publicity promotes creative endeavor and enriches society as a whole.[75] In this sense, the right of publicity shares the federal policy behind copyright and patent law, that "encourag[ing] . . . individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors."[76] The Court also supported Ohio's interest in preventing unjust enrichment by the theft of goodwill, noting that "[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."[77]

Though often cited by courts for its articulation of the right of publicity's rationales, *Zacchini* is an unsatisfactory right of publicity case in two respects. First, the Court never makes clear the scope of First Amendment constraints on the right of publicity. As Justice Powell's dissenting opinion notes,[78] the majority opinion intones the phrase "a performer's entire act" like a mantra,[79] leaving open the possibility that lesser appropriations—for example, the broad-

73 *Zacchini*, 433 U.S. at 575.

74 *Id.*

75 *Id.* at 573.

76 *Id.* at 576 (quoting Mazer v. Stein, 347 U.S. 201, 219 (1954)); *see, e.g.*, Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984); Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). Copyright protection "exists primarily not to benefit the *artist*, but rather to benefit the public by offering artists economic incentives to create." Note, *Human Cannonballs and the First Amendment*: Zacchini v. Scripps-Howard Broadcasting Co., 30 STAN. L. REV. 1185, 1192 (1978).

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

78 *Id.* at 579.

79 One commentator has rejected a narrow reading of *Zacchini*—that when an "entire act" is appropriated, the First Amendment is no defense—as "mistak[ing] the tree for the forest," urging a broader view that *Zacchini* "restricts [F]irst [A]mendment protection when substantial property interests of the plaintiff have been interfered with or appropriated." Pamela Samuelson, *Reviving* Zacchini: *Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 877-78 (1983) (footnote omitted). The challenge after *Zacchini*, then, is "to identify what takings other than 'entire acts' are substantial to overcome the [F]irst [A]mendment interests asserted by defendants." *Id.* at 877.

cast of five seconds of the fifteen-second act—might pass constitutional muster.[80] The Court's emphasis on "entire act" obviates a more useful analysis that would weigh a state-created right against the First Amendment's news-reporting privilege.[81] Second, the facts of *Zacchini* render the case of little precedential value for cases involving commercial exploitation of identity, since the subject matter of protection is a performance right rather than a publicity right.[82] By sating the public demand that would have generated Zacchini's income, the defendant's broadcast undoubtedly jeopardized the performer's livelihood. In contrast, the harm threatened in most right of publicity cases is not to the celebrity's ability to earn a living or the market for her primary talents, but rather to her ability to exploit the value of what has *resulted* from her fame.

2. *Lugosi v. Universal Pictures* (1979)

In *Lugosi v. Universal Pictures*,[83] California's highest court considered Bela Lugosi's proprietary interest in his likeness as Count Dracula. Lugosi played the title role in Universal's classic 1931 film, *Dracula*.[84] Though a number of actors, including Lon Chaney, Jr., Christopher Lee, and John Carradine subsequently portrayed Dracula on stage or screen, Lugosi's much-caricatured portrayal of the Transylvanian count is perhaps the best-known.[85] Four years after Lugosi's death, in the midst of a horror-film revival during the 1960s, Universal entered into licensing agreements with merchandisers authorizing use of the Count Dracula image.[86] Before long, Lugosi's likeness as Dracula appeared on plastic toy pencil sharpeners, T-shirts, picture puzzles, soap and detergent products, and beverage stirring rods.[87] Lugosi's surviving son and

80 *Zacchini* "illustrates that the [F]irst [A]mendment provides no clear standard for determining which appropriations are protected and which are not." Pesce, *supra* note 7, at 807.

81 One commentator calls the "entire act" standard a "mechanical and poorly conceived test." Note, *State "Copyright" Protection for Performers: The First Amendment Question*, 1978 DUKE L. J. 1198, 1199 (1978). The test, for example, may fail whenever "public interest may be better served by the infringement of an entire performance" rather than a portion of it. *Id.* at 1224.

82 The Court acknowledged that the case differed from the typical right of publicity scenario because it involved "not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place." *Zacchini*, 433 U.S. at 576.

83 603 P.2d 425 (Cal. 1979) (Bird, C.J., dissenting).

84 *Id.* at 434.

85 *Id.* at 427.

86 *Id.* at 435.

87 *Id.*

widow sought injunctive relief on the ground that Universal had, by licensing Lugosi's likeness, infringed a valuable property right belonging to the deceased actor's estate.[88] Universal countered that Lugosi's interest was a personal privacy right that had terminated at the actor's death.[89] Here was the by-now-familiar property/privacy debate, to be played out against the backdrop of descendibility.[90]

The California Supreme Court began by declaiming that "[t]he tie-up of one's name, face and/or likeness with a business, product or service creates a tangible and saleable product in much the same way as property may be created by one who . . . writes a book, paints a picture or creates an invention."[91] So long as Lugosi had made such a tie-up during his lifetime, the association would generate goodwill and impress the business, product, or service with secondary meaning protectable under the law of unfair competition.[92] However, the court deemed the right thus created as embraced by the law of privacy: Lugosi could prevent the commercial exploitation of his name and likeness only while alive.[93] Considering the debate over whether the publicity right sounded in tort or

88 *Id.*

89 *Id.* Universal also argued that copyright law preempted the publicity claim of Lugosi's heirs. For a discussion of copyright preemption and the right of publicity, see discussion *infra* part II.D.1.

90 The descendibility of the right of publicity is perhaps the most contested aspect of the right. Justice Mosk's concurring opinion in *Lugosi*, framed the issue provocatively:

> May the descendants of George Washington sue the Secretary of the Treasury for placing his likeness on the dollar bill? May the descendants of Abraham Lincoln obtain damages for the commercial exploitation of his name and likeness by the . . . Lincoln division of the Ford Motor Company? May the descendants of . . . Dolly Madison recover for the commercialization of Dolly Madison confections?

Lugosi, 603 P.2d at 433. The descendibility controversy swirls about three distinct conceptions in the case law: 1) the right of publicity is a property right and thus inheritable; 2) the right of publicity is a personal privacy right, and thus may only be asserted by the individual during his or her lifetime; and 3) the right of publicity should be descendible only if the individual has attempted to commercially exploit his persona during his lifetime. One commentator has suggested three possible solutions to limit the theoretically perpetual duration of the right of publicity: 1) a term of publicity protection, as per copyright law, of the life of the individual plus fifty years; 2) a survivable right of publicity if the individual assigned the right to exploit his identity or contracted for its use during his lifetime; and 3) a publicity right that is either personal (i.e., nontransferable and noninheritable) or transferable but not inheritable. Shipley, *supra* note 5, at 726-27; *see also* Hoffman, *supra* note 7, at 133-39.

91 *Lugosi*, 603 P.2d at 428 (citations omitted). Interestingly, the court's examples of products—a book, a painting, an invention—call to mind *Zacchini*'s parallel between copyright/patent law and the right of publicity. *Zacchini*, 433 U.S. 562, 573 (1977). Nonetheless, as this Note argues, see discussion *infra* part II.C.1., the celebrity's development of his persona is not akin to creating a book, painting, or invention.

92 *Lugosi*, 603 P.2d at 428.

93 *Id.*

property "pointless,"[94] the court crafted a right that melded the property attribute of assignability[95] with the privacy feature of nonsurvivability.[96]

Justice Mosk's concurring opinion characterized Lugosi's Count Dracula as a work for hire and thus the property of Lugosi's employer, Universal.[97] In determining whether an actor's publicity interest in his likeness would extend to the character the actor portrays, Mosk noted that "[m]erely playing a role . . . creates no inheritable property right in an actor, absent a contract so providing."[98] Lugosi had been hired to memorize lines and play a part; the resulting performance, as skillful as it might have been, gave Lugosi "no more claim on Dracula than that of countless actors on Hamlet who have portrayed the Dane in a unique manner."[99] Otherwise, to choose more modern examples, Sean Connery could have enjoined Roger Moore from playing James Bond; Adam West, television's Batman, could have prevented Michael Keaton from playing Batman in the *Batman* films. This distinction between the performer and the role resurfaces in the dissenting opinion of *White v. Samsung*.[100]

Chief Justice Bird's dissenting opinion in *Lugosi* hews to a property paradigm, describing "the ability of a person's name or likeness to attract the attention and evoke a desired response in a particular consumer audience" as a "marketable product."[101] Such likeness, moreover, would extend beyond "natural" likeness to an actor's likeness in portraying a fictional character.[102] The Chief Justice reiterated themes sounded in *Zacchini*—the prevention of unjust enrichment and the copyright-like encouragement of creative enterprise—as valid justifications for the right of publicity.[103] As for descendibility, Chief Justice Bird proposed a fifty-year limitation on a post-mortem right of publicity,[104] reasoning that "with the passage of time, an individual's identity is woven into the fabric of history . . . [such that] the events and measure of his life are in the public domain . . . ."[105]

94 *Id.* at 431. *See supra* note 55 and accompanying text.

95 Lugosi had, in fact, contractually authorized Universal to exploit his name and likeness in connection with the *Dracula* film. *Lugosi*, 603 P.2d at 426 n.2.

96 *Id.* at 431.

97 *Id.* at 433.

98 *Id.* at 432.

99 *Id.* Justice Mosk did, however, make an exception for actors who create stage or screen personas wholly as vehicles for their own talents, such as Groucho Marx, Abbott & Costello, and Laurel & Hardy.

In her dissenting opinion, Justice Bird noted that publicity protection should not extend to the idea of a character or the character per se. *Id.* at 445 n.26. "Nothing in Lugosi's right of publicity precludes others from portraying Count Dracula and exploiting or filming such characterizations." *Id.* at 448 n.35. This view is consistent with an aside in *Zacchini* that Zacchini's publicity right would not prevent the news station from staging or filming its own human cannonball act. *Zacchini*, 433 U.S. at 577-78 n.13.

100 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1405 (9th Cir. 1992) ("[T]he fact that an actor or actress has become famous for playing a particular role has, until now, never been sufficient to give the performer a proprietary interest in it."), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

101 *Lugosi*, 603 P.2d at 438.

102 *Id.* at 445.

In the narrowest sense, *Lugosi* reveals a leading jurisdiction grappling with the issue of descendibility. Read more broadly, however, *Lugosi* depicts the California Supreme Court struggling to define the contours of the property right minted by *Haelan* and endorsed by *Zacchini*, while concurrently affirming that the right of publicity protects something of marketable value as opposed to solely a dignitary interest.

3. *Lombardo v. Doyle, Dane & Bernbach, Inc.* (1977)

In the New York case of *Lombardo v. Doyle, Dane & Bernbach*,[106] Guy Lombardo brought suit against an advertising agency for commercially exploiting his "public personality" as Mr. New Year's Eve. The advertiser had planned to feature the legendary bandleader in a television commercial that would depict Lombardo and his orchestra in New Year's Eve party hats, playing "Auld Lang Syne" as the cars being advertised rotated in the foreground.[107] When negotiations with Lombardo fell through, the agency hired an actor to imitate Lombardo in the commercial.[108] Though the actor did not physically resemble Lombardo, the commercial showed the actor conducting a band "with the same gestures, musical beat and choice of music ["Auld Lang Syne"] with which [Lombardo] had been associated in the public's mind for several decades."[109] Lombardo alleged, among other claims, infringement of his right of publicity.[110]

The court affirmed the lower court's dismissal of Lombardo's claim under New York's name-and-likeness statute[111] because the

103 *Id.* at 441.

104 *Id.* at 447.

105 *Id.* at 446. The California Legislature later heeded this suggestion by enacting California Civil Code section 990, which amended the state's name-and-likeness statute to create a post-mortem right expiring fifty years after the death of the celebrity. CAL. CIV. CODE § 990 (West Supp. 1990). California's common-law right of publicity, however, remains nondescendible.

106 396 N.Y.S.2d 661 (App. Div. 1977).

107 *Id.* at 665.

108 *Id.*

109 *Id.*

110 *Id.* at 663.

111 N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 1988).

defendant had not used Lombardo's name, portrait, or picture for advertising purposes.[112] The court rejected the bandleader's argument that the word "name" in New York's statute be broadly construed to include "reputation," and that the word "picture" be equated with "mental image or likeness":[113] "[T]he Civil Rights Law is . . . not to be applied to prohibit the portrayal of an individual's *personality* or *style of performance*."[114] However, the court allowed Lombardo's common-law right of publicity claim to proceed to trial, noting the celebrity's proprietary interest in his persona.

> Guy Lombardo had invested 40 years in developing his public personality as Mr. New Year's Eve, an identity that has some marketable status. The combination of New Year's Eve, balloons, party hats, and "Auld Lang Syne" in this context might amount to an exploitation of that carefully and painstakingly built public personality. As such, it may be entitled to protection.[115]

The court distinguished this case from an earlier New York case involving imitation of performance by chiding the advertiser's use of Lombardo's identity as "completely unfair" and "amount[ing] to a deception of the public."[116]

Lombardo dramatizes that the line between nonactionable imitation and actionable misappropriation is often difficult to draw.[117] In *Zacchini*, the Supreme Court stated in passing that the right of publicity did not bar the defendant from staging and filming its own human cannonball act;[118] nor could Bela Lugosi, according to Justices Mosk and Bird, prevent other actors from portraying Count Dracula.[119] *Zacchini* suggests that the First Amendment is no defense to misappropriating a substantial portion of the celebrity's act. In contrast, the use of Lombardo's performing style in a car commercial would hardly satiate public demand for the bandleader's annual appearances.

Lombardo introduces a third justification for the right of publicity: the prevention of consumer deception by advertisers. Though the court never elaborates on why the defendant's imitation of Lombardo's style was "completely unfair,"[120] a television viewer could conceivably infer that Lombardo himself was appearing in the commercial. The concern for consumer deception is most pronounced in cases involving celebrity lookalikes and soundalikes in commercials. Such cases have involved Jacqueline Onassis,[121] Woody Allen,[122] Elvis Presley,[123] Bette Midler,[124] and Tom Waits.[125] The fact that, as in *Lombardo*, the ad agency hired an imitator once it could not secure the services of the "real item" prefigures in other right of publicity cases as well,[126] and probably played no small role in those courts' decisions.

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112 *Lombardo*, 396 N.Y.S.2d at 663. The court pointed out that though a cause of action under sections 50 and 51 was nonassignable and nondescendible, the common-law right "is under no such inhibition." *Id. But see* Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 (N.Y. 1984) (common-law right of publicity is encompassed by New York's privacy statute); *accord* Pirone v. MacMillan, Inc., 894 F.2d 579, 585-86 (2d Cir. 1990).

Earlier New York cases appeared to support an assignable and presumably descendible right of publicity independent of the privacy interest protected under sections 50 and 51. However, these cases were decided by federal courts, which, absent authority from New York's own courts, were forced to define New York law. *See, e.g.*, Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953); Price v. Hal Roach Studios, 400 F. Supp. 836 (S.D.N.Y. 1975); Factors, Etc. Inc. v. Pro Arts, Inc., 444 F. Supp. 288 (S.D.N.Y. 1977), *aff'd*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978); Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

The New York legislature is currently considering Assembly Bill 681 and Senate Bill 285, which would create a descendible right of publicity with a term of fifty years after death. *Cf.* CAL. CIV. CODE § 990 (West Supp. 1990).

113 In Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978), the former heavyweight champion sued *Playgirl* magazine for publishing a drawing of a nude, black male sitting in the corner of a boxing ring; an accompanying verse identified the figure as "The Greatest." The district court held the drawing constituted a "likeness" for purposes of sections 50 and 51 of the Civil Rights Law. *Id.* at 726; *see also* Onassis v. Christian Dior-New York, Inc., 472 N.Y.S.2d 254 (Sup. Ct. 1984), *aff'd*, 110 A.D.2d 1095 (App. Div. 1985) ("[A] 'portrait or picture' [as used in sections 50, 51] gives [wide] scope, to encompass a representation which conveys the essence and likeness of an individual, not only actuality, but the close and purposeful resemblance to reality. . . .").

114 *Lombardo*, 396 N.Y.S.2d at 664 (emphasis added).

115 *Id.*

116 *Id.* at 665.

117 In a more recent case, the Southern District reached a result opposite that of *Lombardo*. Uri Geller v. Fallon McElligott, No. 90 Civ. 2839, N.Y. L.J., Oct. 30, 1992, at 3. Uri Geller, an alleged psychic whose well-known act includes bending silverware with his mental powers, brought suit over a commercial featuring a psychic who could bend forks and keys, but could not stop a Timex watch from running. The court dismissed Geller's claim under sections 50 and 51 of New York's Civil Rights Law, finding no use of name or likeness. The court also rejected Geller's argument that he had a property right in the idea of psychic powers being used to bend objects, since "New York law does not protect a performer from imitators." *Id.* at 37. *But see* White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

118 *Zacchini*, 433 U.S. at 577-78 n.13.

119 *Lugosi*, 603 P.2d at 448.

120 *Lombardo*, 396 N.Y.S.2d at 665.

121 *Onassis*, 472 N.Y.S.2d 254.

122 Allen v. National Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985); Allen v. Men's World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988).

123 Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981).

124 Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988).

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

126 *See, e.g.*, *Midler*, 849 F.2d at 462 (noting the lower court's description of the defendants' conduct as "that of the average thief." Midler would not rerecord one of her hits for use in a television commercial. "[The defendants] decided, 'If we can't buy it, we'll take it.' "); Sinatra v. Goodyear Tire & Rubber, 435 F.2d 711, 713 (9th Cir. 1970); *see also Onassis*, 472 N.Y.S.2d at 261 ("If a person is unwilling to give his or her endorsement to help sell a product, either at an offered price or at any price, no matter—hire a double and the same effect is achieved. . . . Let the word go forth—there is no free ride.").

To the extent that the *Lombardo* court protected the bandleader's "public personality," the television commercial appropriated this personality indirectly. It did not, after all, use Lombardo's name, film footage of his performance from a previous New Year's Eve, or a lookalike. Instead, the commercial created a certain context with visual and auditory cues—the party hats, balloons, and "Auld Lang Syne"—that cumulatively suggested Lombardo. Suppose that the commercial depicted an orchestra playing "Auld Lang Syne," but showed a conductor positioned with his back to the camera. Could Lombardo still claim that the advertiser had misappropriated his identity? If so, might Lombardo be asserting a type of proprietary interest in "Auld Lang Syne"? These are the types of questions raised whenever a court sees fit to protect interests as indeterminate as one's "public personality."[127]

C. *Rationales for the Right of Publicity*

Courts and commentators have identified three separate but occasionally overlapping justifications for the right of publicity. First is the labor-desert notion underlying property law, and a corollary concern with unjust enrichment.[128] Second is the economic-incentive theory that protecting the value of one's persona benefits society as a whole.[129] Third is the prevention of unfair business practices that lead to consumer deception.[130] While these rationales are in theory sound, they falter—or, in the case of consumer deception, prove redundant—when applied to appropriations of celebrity identity.

1. Labor-Desert and Unjust Enrichment

The labor-desert rationale is that the famous person has expended time, money, and energy in developing a commercially valuable persona; that identity is the fruit of the celebrity's labors and entitles him to reap the rewards of his efforts.[131] This moral argument, which one commentator has sardonically dubbed "John Locke goes to Hollywood,"[132] dates back to Melville Nimmer's 1954 article *The Right of Publicity*.[133] Professor Nimmer considered it axiomatic of Anglo-American jurisprudence that a person who has "long and laboriously nurtured the fruit of publicity values" should enjoy the benefit of those values himself.[134] Right of publicity case law abounds with references to the plaintiff who "carefully and painstakingly"[135] crafts his or her image, "assiduously cultivat[ing]"[136] a persona until it reaches marketable status.[137] The celebrity plaintiff, in the view of several commentators, attains stardom through either sheer will power or "some combination of talent, effort, intelligence, pluck and grit."[138]

As appealing as this theory appears on its face, it is at best oversimplistic, and at worst, inaccurate. First, celebrities do not always work hard for their fame; sometimes they become well-known as a result of dumb luck, serendipitous involvement in public affairs, or even criminal conduct.[139] Second, fame is not the consequence of singlehanded creation, but rather something that depends upon the public's participation.[140] One commentator

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127 In Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454 (Cal. 1979) (Bird, C.J., concurring), the nephew of deceased matinee idol Rudolph Valentino objected to the use of Valentino's name, likeness, and "personality" in a fictionalized television movie. Addressing the alleged misappropriation of Valentino's "personality," Chief Justice Bird admitted that, "I find it difficult to discern . . . any easily applied definition for this amorphous term." *Id.* at 457 n.5.

128 *See* Nimmer, *supra* note 1, at 215; *see generally* Madow, *supra* note 43, at 182-205.

129 *See* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977); Lugosi v. Universal Pictures, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting); Randall T.E. Coyne, *Toward a Modified Fair Use in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 813 (1988).

130 *See* Hoffman, *supra* note 7, at 119; Treece, *supra* note 45, at 647; Madow, *supra* note 43, at 229-34.

131 *See, e.g., Zacchini*, 433 U.S. at 576 (1977); *Lugosi*, 603 P.2d at 438; Uhlaender v. Henricksen, 316 F. Supp. 1277, 1282 (D. Minn. 1970); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458, 462 (N.J. 1967); *see also* Madow, *supra* note 43, at 182-83; Coyne, *supra* note 129, at 488.

132 Madow, *supra* note 43, at 175. Under Locke's theory of natural law, everyone has "a property [right] in his person" and thus in the "labor of his body." JOHN LOCKE, THE SECOND TREATISE OF GOVERNMENT 100 (Peter Laslett ed., 2d ed. 1967) (1698).

133 *See* Nimmer, *supra* note 1.

134 *Id.* at 216.

135 Lombardo v. Doyle, Dane & Bernbach, Inc., 396 N.Y.S.2d 661, 664 (App. Div. 1977).

136 Hirsch v. S.C. Johnson & Sons, Inc., 280 N.W.2d 129, 134-35 (Wis. 1979).

137 Uhlaender v. Henricksen, 316 F. Supp. 1277, 1282 (D. Minn. 1970). Even the Hollywood studios propagated the myth of their hard-working stars: "However luxuriously they might disport themselves in the Sunday rotogravure, however carefree they might look in the snaps from Ciro's and the Mocambo, it was constantly put about that, for all the ostensible glamour of their occupations, the stars worked farmer's hours in factory-like conditions." RICHARD SCHICKEL, INTIMATE STRANGERS, THE CULTURE OF CELEBRITY, WHERE WE CAME IN 77 (1985).

138 Madow, *supra* note 43, at 183; *see* Coyne, *supra* note 129, at 788 ("Because celebrities often invest substantial time and money to achieve uncertain success, fairness would seem to dictate that they be entitled to whatever value derives from their efforts."); *see also* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 2.1[D], at 2-8 (1992).

139 *See* Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 341 n.220 (1988) ("[I]t is difficult to fit personas into both the labor . . . [theory] of intellectual property" since they are "quite often . . . creations of pure chance, perhaps the only intellectual property without intentionality.").

140 Memphis Dev. Found. v. Factors, Etc., Inc., 616 F.2d 956, 959 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980). "A person can, alone, make a chair or build a house. A person can, alone, write a book or design a machine. But a person cannot, alone, make herself famous." Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97, 107 (1993). "[A] celebrity's public image is *always* the product of a complex *social* . . . process in which the 'labor' (time, money, effort) of the celebrity herself . . . is but one ingredient, but not always the main one." Madow, *supra* note 43, at 195.

finds the Lockean approach unpersuasive because "celebrities generally do not create commercially marketable images in anything like the way carpenters make chairs."[141] The sad truth about fame is that it may bear no relationship to one's talents or accomplishments; the celebrity is frequently, in the words of Daniel Boorstin, simply "known for his well-knownness."[142] Third, even presuming that one's fame results from hard work, awarding a property right in one's persona for this reason *alone* is inconsistent with the *quid pro quo* requirement of intellectual property law that the celebrity also contribute something of value to society.[143]

The unjust enrichment argument for the right of publicity flows naturally from Nimmer's labor-desert concept. Quite simply, the advertiser who, unauthorizedly appropriates a persona that the celebrity has constructed "reap[s] where another has sown" by getting something for nothing.[144] Just as often as the right of publicity cases emphasize the plaintiff's entitlement to the fruits of his labor, the cases describe the defendants as "poachers," "parasites," "pirates," or "free riders."[145] With advertising uses, such conduct also implicates unfair competition; since the advertiser acquires the celebrity's publicity value at no cost, he can compete unfairly with authorized licensees.[146]

The problem with an unjust enrichment rationale for the right of publicity is threefold. First, federal policy tends to favor appropriation of subject matter unprotected by copyright, trademark, and patent law.[147] Second, the law tolerates commercial free-rid-

141 Madow, *supra* note 43, at 184.

142 DANIEL J. BOORSTIN, THE IMAGE: A GUIDE TO PSEUDO-EVENTS IN AMERICA 57 (1957). *See* Madow, *supra* note 43, at 160 (noting that the advent of motion pictures and radio in the early twentieth century "abruptly uncoupled fame from greatness of achievement" and enabled persons to become famous "without doing anything particularly remarkable or admirable. . . .").

143 *See, e.g.*, Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (rejecting "sweat of the brow" doctrine in copyright law); *see also supra* note 76 and accompanying text.

144 Hirsch v. S.C. Johnson & Sons, Inc., 280 N.W.2d 129, 135 (Wis. 1979) (quoting Mercury Record Prods. v. Economic Consultants, 218 N.W.2d 705, 711 (Wis. 1974)); *see also* International News Serv. v. Associated Press, 248 U.S. 215 (1918); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 837 (6th Cir. 1983); Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215, 221 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188, 1198 (S.D.N.Y.) (finding liability for interference with right to publicity), *supp. op.*, 578 F. Supp. 59 (S.D.N.Y. 1983) (assessing damages); Harry Kalven, Jr., *Privacy in Tort Law: Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966).

145 Madow, *supra* note 43, at 196. "The contest between the celebrity and the unauthorized appropriator of his image is . . . framed starkly as *Sower v. Reaper*." *Id.*

146 *See* Hoffman, *supra* note 7, at 118-19.

147 Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231, *reh'g denied*, 376 U.S. 973 (1964); Compco Corp. v. Day-Bright Lighting, Inc., 376 U.S. 234, *reh'g denied*, 377 U.S. 913 (1964); *cf.* Judge Kennedy's dissent in Carson v. Here's Johnny Portable Toilets, Inc, 698 F.2d 831, 841 (6th Cir. 1983).

ing to the extent that short of "passing off" or similarly deceptive practices, one may imitate or copy a successful good or product with immunity.[148] Third, and most broadly, the celebrity may have done some free-riding herself, drawing upon the earlier labors of others to fabricate a distinctive persona. American popular culture is an orgy of borrowing; Bruce Springsteen built upon the work of Bob Dylan, who in turn owes no small musical debt to Woody Guthrie.[149] As noted above in the discussion of *Lombardo*, the challenge is where the state should draw the line between actionable appropriation and nonactionable imitation.

2. Economic Incentive

The second justification offered for the right of publicity is that protection of the economic value of the celebrity's identity, like copyright and patent laws, encourages the celebrity to create performances that enrich our culture.[150]

Even if empirical evidence should support this carrot-and-stick conception of the publicity right, more than one commentator has noted the analytical shortcomings of a copyright/patent model for the right of publicity.[151] Society already rewards successful athletes, actors, and entertainers for their contributions with sizeable sums of money, amply compensating them for the "sweat equity" they have invested in developing their identities.[152] If one views the celebrity's commercially exploitable persona as primarily a *by-product* of the activities that made him famous in the first place, then "[r]ewards accruing from collateral uses of . . . name and likenesses may be more like the proverbial icing on the cake than a necessary inducement."[153]

Since the right of publicity is a type of intellectual property right, the celebrity's private monopoly should be counterbalanced

148 Madow, *supra* note 43, at 196; *see also*, PETER B. KUTNER & OSBORNE N. REYNOLDS, JR., ADVANCED TORTS 354 (1989) (discussing product imitation cases).

149 "Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before." White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

150 Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977); Lugosi v. Universal Pictures, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting); Factors, Etc., 579 F.2d at 221; Martin Luther King, Jr., Ctr. for Social Change Inc. v. American Heritage Prods., 296 S.E.2d 697 (Ga. 1982); *see also* Hoffman, *supra* note 7, at 118; Shipley, *supra* note 5, at 681.

151 *See, e.g.*, Madow, *supra* note 43, at 208-15; Hoffman, *supra* note 8, at 119-21.

152 Hoffman, *supra* note 7, at 119-20.

153 *Id.* at 120.

by a benefit that inures to the public good whenever publicity interests are protected. The economic-incentive argument, however, fails to distinguish between the entertainment value generated by celebrities and the value of what is secured by a right of publicity. As one commentator quips, "Joe Namath may have enriched society with his glorious athletic feats, but the same cannot be said of his endorsements of deodorants and popcorn makers."[154]

3. Unfair Business Practices and Consumer Protection

The third rationale for the right of publicity draws from unfair competition, a body of federal and state law that prohibits the use of another's service mark or trademark to mislead consumers as to the origin of goods and services.[155] In an advertising setting, unauthorized use of celebrity identity may create a false impression that the celebrity approves or sponsors the products advertised, thus impairing the goodwill value of that identity.[156] Plaintiffs in early right of publicity cases often brought suit on unfair-competition grounds to vindicate an interest that slipped between the common-law cracks of privacy theory and a property right in one's persona.[157] Here, the focus of protection is not the celebrity's economic interest, but rather the possible deception of the advertisement's viewers.[158] Of particular concern is the celebrity lookalike or soundalike, the use of which is a misrepresentation and thus a type of false advertising.

The right of publicity and unfair competition differ in one important respect: whereas the standard of liability for right of publicity infringement is identifiability,[159] unfair competition requires a showing of likelihood of confusion.[160] To return to *Lombardo*, a television viewer seeing the imitation bandleader might be certain that he is not watching Lombardo. This has no bearing on a right

154 *Id.* at 121. Hoffman argues that celebrity endorsements may, in fact, have "net social disutility" by 1) leading to economically irrational product differentiation, 2) influencing consumers to make purchasing decisions on grounds other than price and quality, and 3) unduly favoring businesses large enough to afford the endorsement fees demanded by celebrities. *Id.* at 120-21.

155 *See supra* note 6.

156 *See, e.g.*, Booth v. Colgate Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973); Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); Chaplin v. Amador, 269 P. 544 (Cal. 1928); *supra* note 6 and accompanying text. For a detailed discussion of *Sinatra* and *Booth*, *see* Shipley, *supra* note 5, at 694-96.

157 *See, e.g.*, *Booth*, 362 F. Supp. 343 (S.D.N.Y. 1973); *Sinatra*, 435 F.2d 711 (9th Cir. 1970); Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962); *Chaplin*, 269 P. 544 (1928).

158 "Viewers," of course, include "hearers." Most soundalike claims center on background music or voiceovers in television commercials, rather than radio uses.

159 MCCARTHY, *supra* note 138, § 8.14[B], at 8-96 (1992).

160 MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 30.18 (1973); GILSON, TRADEMARK PROTECTION AND PRACTICE § 5.01 (1982).

of publicity claim, however, because the right of publicity has no built-in likelihood-of-confusion element.[161] Consequently, an on-screen disclaimer—stating, for example, that "This is not Guy Lombardo, but a Guy Lombardo imitator; the real Guy Lombardo doesn't even know about this product"—would not rebut a publicity claim.[162]

Because the publicity plaintiff may bring a separate claim for false endorsement under the federal Lanham Act,[163] the consumer-protection rationale for the right of publicity is, today, perhaps the least necessary of the three. Several commentators suggest that the availability of relief under the Lanham Act is sufficiently protective of the celebrity's identity to obviate a right of publicity altogether;[164] one commentator recommends that courts either use the Lanham Act as a type of federal publicity right or incorporate the Act's likelihood-of-confusion requirement into the right of publicity.[165]

D. *Copyright Issues*

In *Zacchini*, the Supreme Court compared the right of publicity to a copyright interest.[166] Though the two bodies of law share the premise that protecting the economic value of one's labors will lead to the creation of culturally enriching works,[167] there are some crucial differences. The Copyright Act[168] (the "Act") rewards authors with a statutory monopoly on their original expressions; the right of publicity gives individuals a common-law monopoly in

161 *See, e.g.*, Rogers v. Grimaldi, 875 F.2d 994, 1004 (2d Cir. 1989); *see also* Nimmer, *supra* note 1, at 212 ("Publicity values of a person . . . may be profitably appropriated and exploited without the necessity of any imputation that such person . . . is connected with the exploitation undertaken by the appropriator.").

162 " 'If someone impersonates Bill Cosby's voice for 29 seconds of an advertisement, and then says, "It's not Bill Cosby," . . . he has still violated Bill Cosby's rights." Jonathan L. Kirsch, *"Look What They've Done to My Song,"* CAL. LAW., July 1989 (quoting Daniel L. Brenner of the UCLA School of Law).

163 15 U.S.C. § 1125(a) (1988). For the pertinent text, *see supra* note 6.

164 Pesce, *supra* note 7, at 824; Patrick J. Heneghan & Herbert C. Wamsley, *The Service Mark Alternative to the Right of Publicity:* Estate of Presley v. Russen, 14 PACIFIC L.J. 181 (1983).

165 Pesce, *supra* note 7, at 824.

166 433 U.S. at 576 (1977).

167 *Id.*; Lugosi v. Universal Pictures, 603 P.2d 425, 446-47 (Cal. 1979) (Bird, C.J., dissenting). The Constitution's Copyright Clause empowers Congress "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries." U.S. CONST., art. I, § 8. The Supreme Court has stated that the sole interest "in conferring the [copyright] monopoly . . . lie[s] in the general benefits derived from the public from the labors of authors." Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (quoting Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932)); *see also* Mazer v. Stein, 347 U.S. 201, 219 (1954); Sony Corp. of Am. v. Universal City Studios, Inc, 464 U.S. 417, 429 (1984).

168 17 U.S.C. §§ 101-801 (1988).

their names, likenesses, and personal attributes.[169] Copyright law grants exclusive rights in writings of an author that are fixed in a tangible medium of expression;[170] the right of publicity grants exclusive rights in one's persona, which need not be fixed in a tangible medium of expression in order to be protected.[171] The copyright proprietor's exclusive rights are of limited duration, typically the life of the author plus fifty years;[172] in contrast, the right of publicity may, in some jurisdictions, last in perpetuity either at common law or by statute, and may be asserted by the heirs of the celebrity more than fifty years after the celebrity's death.[173]

In distinguishing a publicity right from a copyright interest, one must draw a bright line between the *subject* of the right of publicity—the persona—and the *form* in which that persona may be fixed.[174] The right of publicity and a copyright interest may exist side-by-side in the same work. For example, suppose that photographer Richard Avedon takes a portrait of Madonna for use in *The New Yorker* magazine. From the moment he takes the photograph, Avedon has a copyright in the photograph as his original expression, and can prevent Madonna or a third party from reproducing the photograph without his permission. Concurrently, Madonna has control over her likeness as captured in Avedon's photograph, and can prevent Avedon from licensing the photograph to an advertiser or to a third party wishing to use the photograph for merchandising purposes.[175]

169 Coyne, *supra* note 129, at 803.

170 17 U.S.C. § 102 (1988).

171 Shipley, *supra* note 5, at 684.

172 17 U.S.C. §§ 302-305 (1988).

173 Georgia, Nebraska, New Jersey, and Tennessee recognize a descendible right of publicity with no durational limitation. New Jersey conditions descendibility upon the celebrity's exploitation or assignment of his publicity right during his lifetime; Tennessee grants protection for ten years after the death of the celebrity, and thereafter in perpetuity, provided that the right is continuously exercised. Martin Luther King, Jr., Ctr. for Social Change, Inc. v. American Heritage Prods., Inc., 296 S.E.2d 697 (Ga. 1982); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981), Gleason v. Hustler, 7 MEDIA L. REP. (BNA) 2183 (D.N.J. 1981); NEB. REV. STAT. § 20-208 (1991); TENN. CODE ANN. § 47-25-1104 (1988).

174 GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW & PRACTICE, § 15.22.1, at 623 (1989). This fundamental distinction was misunderstood by the Seventh Circuit. *See* Baltimore Orioles v. Major League Baseball Players Ass'n, 805 F.2d 663, 675 (7th Cir.) (fixation of baseball players' performances in broadcasts constitutes fixation of their publicity interests), *cert. denied*, 480 U.S. 941 (1986); *cf.* NIMMER ON COPYRIGHT, § 101[B][1][c], at 1-22 (1993) [hereinafter NIMMER].

175 The parties may, naturally, order their respective proprietary interests via contract. The contract between Bela Lugosi and Universal Pictures at issue in *Lugosi*, for example, read in part as follows: "The producer shall have the right to . . . reproduce, transmit, exhibit, distribute, and *exploit in connection with* the . . . photoplay any and all of the artist's acts, poses, . . . and appearances . . . and . . . shall likewise have the right to use and give publicity to the artist's *name and likeness . . . in connection with* the advertising and exploitation of said photoplay." *Lugosi*, 603 P.2d at 426 n.2 (emphasis in original).

1. Preemption

The form/persona distinction is more than an academic one, since in some cases copyright law will federally preempt a state right of publicity action.[176] Section 301 of the Copyright Act provides that any state law, whether based on common law or statute, is subject to federal preemption 1) if it creates legal or equitable rights equivalent to one or more rights granted under § 106 of the Act, *and* 2) if the work protected by state law is fixed in a tangible medium of expression and comes within the subject matter of copyright.[177]

The first requirement for preemption under § 301 is met when the publicity claim in a particular case involves rights "equivalent" to the reproduction, adaptation, distribution, performance, or display rights granted under § 106[178] of the Act to the copyright holder.[179] Though the meaning of "equivalent" is unclear from the Act itself, the House Report accompanying § 301 states that "common law rights of 'privacy,' 'publicity,' and trade secrets . . . remain unaffected [by § 301(a)] as long as the [state] causes of action contain elements, such as invasion of personal rights . . . that are different in kind from copyright infringement."[180] A publicity claim will escape federal preemption, then, if the appropriative act involves more than the mere act of reproducing, distributing, or displaying the celebrity's persona.[181] Such ex-

176 The source of copyright's preemptive power is the Supremacy Clause, which provides in part that all laws made under the authority of the United States shall be the "supreme law of the land" and take precedence over conflicting state laws. U.S. CONST., art. VI; *cf.* 17 U.S.C. § 301 (1988). Preemption analysis, then, concerns whether a particular state cause of action conflicts with the Copyright Act.

177 17 U.S.C. § 301.

178 The copyright owner's exclusive rights under § 106 are to do and to authorize the following: reproduction of the copyrighted work in copies, preparation of derivative works (i.e. adaptations) based upon the work, public distribution of copies of the work, public performance of the work, and public display of the work. 17 U.S.C. § 106 (1988).

179 17 U.S.C. § 301(a) (1988); *see* Factors, Etc., Inc. v. Pro Arts, Inc. 496 F. Supp. 1090, 1097 (S.D.N.Y. 1980) (right of publicity is not legal or equitable right equivalent to exclusive rights granted by copyright law); *Lugosi*, 603 P.2d at 448 (Bird, C.J., dissenting). *But see* Hoffman, *supra* note 7, at 132 ("If the right of publicity is first and foremost a proprietary right in the fruits of one's intellectual and creative endeavors, to be treated like any other intangible property right and giving rise to a cause of action against nondeceptive copying, an argument can be made that it *is* equivalent to the exclusive rights under copyright.").

180 H.R. REP. No. 1476, 94th Cong., 2d Sess. 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748.

181 Shipley, *supra* note 5, at 704. *See also* NIMMER, *supra* note 174, § 1.01[B][1], at 1-15.

One commentator notes how the "something extra" requirement would allow state actions for misappropriation of copyrighted works to escape preemption. Suppose the plaintiff proves that he has invested considerable time, effort, and expense in creating the copyrighted work, and that the defendant is unjustly enriched by the unauthorized copy-

tra elements might include emotional distress[182] and deceptive trade practices.[183] An early draft of § 301 listed "misappropriation" as one of a list of state rights which would *not* be preempted by the 1976 Act;[184] however, this list was deleted on the floor of the House before passage of the 1976 Act.[185]

The second condition for federal preemption is two-pronged: the work must be fixed in a tangible medium of expression, and fall within the scope of copyright protection.[186] The fixation requirement[187] means that states may protect such unfixed works as live jazz improvisations and conversations by creating rights doctrinally equivalent to copyright, such as a reproduction right.[188] As for the scope-of-copyright requirement, several courts have determined that one's persona, even if embodied in a copyrightable work, is not a work of authorship for copyright-protection purposes.[189] Consequently, even if a publicity claim risks preemption under the first condition of § 301 by involving pure copying, it will surely avoid preemption under this second condition because of the nature of one's persona.[190]

ing thereof—typical elements for a state misappropriation claim. Copyright infringement, however, does not require the plaintiff to show either that he has made such an investment or that the defendant reaped any profits from the appropriative act. Thus, under the "something extra" test, copyright law would not preempt the state claim. Robert A. Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. COPYRIGHT SOC'Y 560, 608-10 (1982); *cf.* Mayer v. Josiah Wedgwood & Sons, Ltd., 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985) (extra element "must be one which changes the nature of the [state] action so that it is *qualitatively* different from a copyright infringement claim").

182 *See, e.g.*, Allied Artists Pictures Corp. v. Rhodes, 496 F. Supp. 408 (S.D. Ohio 1980) (no preemption of state privacy law), *aff'd*, 679 F.2d 656 (6th Cir. 1982).

183 Since the element of misrepresentation in a false endorsement claim is no part of a cause of action for copyright infringement, "there is no preemption of the state law of fraud, nor of the state law of unfair competition of the 'passing off' variety." NIMMER, *supra* note 174, § 1.01[B][1], at 1-20 (1993) (footnotes omitted).

184 S. 22, 94th Cong., 2d Sess. §§ 301(b)(3), *reprinted in* NIMMER, *supra* note 174, § 1.01[B][1][f][i], at 1-26 n.114.

185 NIMMER, *supra* note 174, § 1.01[B][1], at 1-24 to 1-27. "It seems best to look simply to [§ 301] as finally enacted, ignoring the significance of the earlier explicit mention—and later deletion—of the word 'misappropriation.' " *Id.* § 1.01[B][1][f][ii], at 1-29.

186 17 U.S.C. § 301(a) (1988).

187 *Cf.* 17 U.S.C. § 101 ("fixed" defined), § 102.

188 Shipley, *supra* note 5, at 704.

189 *See, e.g., Factors, Etc.*, 496 F. Supp. at 1100 (right to a persona and right to a work of authorship are qualifiedly different); Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188 (S.D.N.Y. 1983); Lugosi v. Universal Pictures, 603 P.2d 425, 448 (Cal. 1979) (Bird, C.J., dissenting) ("[t]he intangible property interest protected by the right of publicity simply does not constitute a writing"); Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988) (voice is not a work of authorship); NIMMER, *supra* note 174, § 1.01[B][1], at 1-21 (1993). *But see* Shipley, *supra* note 5, at 718 (celebrity's style—if it results from her intellectual labors and is a unique artistic expression—may, if fixed, constitute a "writing" protectable by copyright law); GOLDSTEIN, *supra* note 174, § 15.22.1.2, at 624 (1989) (embodiment of one's persona in a characterization or performance may be sufficiently expressive to come within the scope of copyright as an audiovisual work).

190 "All courts presented with the issue of possible federal preemption of the Right of

One policy reason for deeming the right of publicity generally nonpreemptable is to prevent manipulating copyright law to eviscerate the right altogether. Returning to the Madonna-Avedon example above, suppose that I were to sneak into Avedon's studio while he is photographing Madonna and take my own photograph of her. I copyright the photograph, then use it to create Madonna posters, T-shirts, and figurines. When Madonna sues me for misappropriating her likeness, I would argue that her claim is based on reproduction of her likeness in derivative works, which is equivalent to my exclusive rights as the owner of copyright in my picture.[191] Clearly, "[i]t would be anomalous to allow a person to circumvent the right of publicity merely by obtaining a copyright in a work containing a person's likeness."[192] Otherwise, the news station in *Zacchini* could have used a copyright in its film footage of the human cannonball act as grounds for preemption of Zacchini's publicity claim.

2. Conflicts Between Copyright and Publicity Interests

Even where preemption is not an issue, publicity claims in copyrighted works may severely restrict the ability of the copyright holder to exploit his rights in the work.[193] The Ninth Circuit expressly recognized this possibility more than two decades ago in the soundalike case of *Sinatra v. Goodyear Tire & Rubber*.[194] In *Sinatra*, singer Nancy Sinatra brought a right of publicity action on unfair-competition grounds over television commercials that used as background music "These Boots Are Made for Walkin'," one of her hit songs.[195] Sinatra argued that "These Boots . . . " had become so identified with her that the advertiser's use of the song deceptively implied to the public that she had participated in the commercials.[196] Sinatra herself had no copyright interest in either the mu-

Publicity, including the U.S. Supreme Court, have unanimously held, for various reasons, that there is no such preemption." MCCARTHY, *supra* note 138, § 11.13[C], at 11-68.

191 *Cf.* 17 U.S.C. § 106(1),(2) (1988).

192 Michael J. McLane, *The Right of Publicity: Dispelling Survivability, Preemption and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W. L. REV. 415, 424 (1984). However, the Seventh Circuit impliedly endorsed such circumvention in the oft-criticized Baltimore Orioles v. Major League Baseball Players Ass'n, 805 F.2d 663 (7th Cir.), *cert. denied*, 480 U.S. 941 (1986). In this case, baseball players contended that the unauthorized broadcast of games in which they played infringed the publicity interests in their performances. *Id.* at 677. The court equated the players' publicity rights with the performance right of the copyright holders of the broadcasts; since the broadcasts had "fixed" performances that came within the subject matter of copyright, the court reasoned, any publicity claims in those performances were preempted. *Id.*

193 *See generally* Hoffman, *supra* note 7, at 128-30.

194 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

195 *Id.* at 712.

196 *Id.*

sic or lyrics of the song; the advertiser had properly licensed "These Boots . . . " from the copyright holder.[197] In dismissing her claim, the court noted the clash between copyright law and the proprietary right that Sinatra was asserting.[198] In particular, it feared a compulsory-licensing regime whereby potential licensees of "These Boots . . . " would have to "pay each artist who has played or sung the composition and who might therefore claim unfair competition-performer's protection."[199] Affording Sinatra relief would, in the court's view, be tantamount to "granting state copyright benefits without the federal limitations of time to permit definite public domain use."[200]

The Ninth Circuit took a different approach in another soundalike case, *Midler v. Ford Motor Co.*[201] For a television commercial, an advertising agency had licensed the oldie "Do You Want To Dance" and wished to have singer Bette Midler rerecord her 1973 hit version of the song.[202] When Midler refused, the agency hired a soundalike who fooled a number of television viewers into believing that Midler herself was singing in the commercial.[203] Midler succeeded in pleading a cause of action for "voice appropriation";[204] this time, the Ninth Circuit appeared unconcerned about the effect of its decision on the value of the copyright in "Do You Want To Dance." After *Midler*, the copyright holder of the song presumably would have to tell prospective licensees, "You can use the song, but your version better not sound like Bette Midler's."

197 *Id.* at 713.

198 *Id.* at 717.

199 *Id.* at 718.

200 *Id.* Publicity rights have prevailed, however, in other cases involving copyrighted works. *See, e.g.*, Price v. Hal Roach Studios, 400 F. Supp. 836 (S.D.N.Y. 1975) (copyright owner of films featuring Laurel & Hardy enjoined from licensing derivative works using the comedy team's likenesses); Factors, Etc. v. Pro Arts, 579 F.2d 215 (2d Cir. 1978) (owners of copyright in Elvis Presley photograph restrained from marketing Elvis poster), *cert. denied*, 440 U.S. 908 (1979).

201 849 F.2d 460 (9th Cir. 1988).

202 *Id.* at 461.

203 *Id.* at 461-62.

204 The *Midler* court did not frame its holding in terms of a "right of publicity" per se, nor did it "go so far as to hold that every imitation of a voice to advertise merchandise actionable." *Midler*, 849 F.2d at 463. Rather, declaring that "[t]o impersonate [a singer's] voice is to pirate her identity," the court held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." *Id.*; *accord* Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).

To date, New York does not recognize voice misappropriation as an independent cause of action. Tin Pan Apple v. Miller Brewing Co., 737 F. Supp. 826, 836-37 (S.D.N.Y. 1990). In an earlier sound-alike case, the First Circuit—applying New York law—refused to interpret the New York name-and-likeness statute's "name, portrait, or picture" language to apply to vocal imitations, though it held that the plaintiff had sufficiently alleged a cause of action in unfair competition. Lahr v. Adell Chem. Co., 300 F.2d 256, 259 (1st Cir. 1962).

Not only does Midler's publicity right thus compromise the ability of the copyright holder to exploit the song,[205] but this result is inconsistent with copyright law itself, which permits even note-for-note imitations of sound recordings.[206]

The relative durations of copyright law and the right of publicity may also raise problems. For example, suppose that copyright has expired on a Laurel & Hardy film, such that the film is now in the public domain. Anyone may now reproduce and distribute scenes from the film for any purpose whatsoever. However, the actors featured in the film—or, if the actors are deceased and the jurisdiction recognizes a descendible publicity right, then the actors' heirs or assignees—may assert publicity claims in the actors' likenesses. These parties might not only prevent advertisers from using scenes from the film to advertise certain products, but also restrain merchandisers from marketing Laurel & Hardy T-shirts, posters, or coffee mugs.[207] If the purpose underlying a limited term of copyright is to assure eventual public access to the works of authors,[208] the ability to control uses of one's likeness as incorporated in a work that has fallen into the public domain creates a

205 *See* Hoffman, *supra* note 7. Hoffman points out that the copyright-publicity right conflict affects not only assignee/licensees, but the author himself, "who would find the potential market for subsequent uses of his work diminished if prospective licensees had to contract with and pay royalties to celebrities who have obtained publicity rights by performing or appearing in the work." *Id.* at 130.

Moreover, in the music business the songwriter has an ongoing proprietary interest of his own. In contracting with a music publisher, the songwriter typically assigns his copyright in the words and/or music to the publisher, who in turn licenses derivative works by authorizing "cover versions" of the song. Each time a cover-version recording is sold in the form of records or played on the radio, the songwriter receives royalties. MICHAEL FINK, INSIDE THE MUSIC BUSINESS 35-36 (1989). Consequently, any legal mechanism which discourages "cover versions" by requiring payment to everyone who ever sang the song impairs the flow of royalties to the songwriter as well as the publisher.

206 17 U.S.C. § 114(b) (1988). "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." NOTES OF COMMITTEE ON THE JUDICIARY, 17 U.S.C. § 114(b), H.R. REP. No. 1476, 94th Cong., 2d Sess. 106-11, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5721-26.

207 Computer technology that incorporates the images of actors from old films into newer media may also be affected. Coca-Cola, for example, produced television commercials in which Elton John performed before an audience that included Humphrey Bogart, James Cagney, and Louis Armstrong; the sequel featured Paula Abdul interacting with Cary Grant, Groucho Marx, and Gene Kelly. The first ad isolated images by rotoscoping film clips of Bogart in ALL THROUGH THE NIGHT, Armstrong in HIGH SOCIETY, and Cagney in PUBLIC ENEMY and THE ROARING TWENTIES. Michael Quinn, *Ghosts in the Commercial*, TIME, Dec. 23, 1991, at 56. Query whether once the copyrights in these films fall into the public domain, the celebrity's estate can enjoin such use of a celebrity's likeness. *See generally* Joseph J. Beard, *Casting Call at Forest Lawn: The Digital Resurrection of Deceased Entertainers*, 8 HIGH TECH. L.J. 101 (1993).

208 "[T]he duration of copyright represents a compromise between encouraging new artistic expression and providing public access to this expression." Coyne, *supra* note 129, at 814.

"perpetual monopoly . . . incompatible with the policy underlying the federal copyright law."[209]

III. *WHITE V. SAMSUNG* AND THE EVOCATION-OF-IDENTITY TEST

If infringement of the right of publicity results from direct use of a celebrity's name or likeness, the resourceful advertiser unwilling to pay an endorsement fee might be tempted to secure the benefit of the celebrity's identity in a more oblique manner. In 1992, the Ninth Circuit addressed this possibility in *White v. Samsung Electronics America, Inc.*,[210] finding an appropriation of identity even where the advertiser's depiction of the celebrity did not constitute a "likeness" for the purpose of California's name-and-likeness statute.[211] The Ninth Circuit's decision was widely criticized[212] and prompted a spirited exchange between a Ninth Circuit judge[213] and the author of a well-known treatise on the right of publicity.[214]

The first part of this section parses *White*'s majority and dissenting opinions. The second part of this section critiques *White* and, more particularly, the evocation-of-identity test propounded by the court.

A. *The Case*

Samsung Electronics America, Inc. ("Samsung") ran a series of print advertisements promoting its electronic products in several publications with widespread circulation.[215] Each advertisement depicted a current item from popular culture and a Samsung product; each was set in the twenty-first century, and made humorous predictions about the cultural items.[216] One advertisement showed a raw steak with the caption, "Revealed to be health food. 2010 A.D."[217] Another showed flamboyant talk-show host Morton Downey, Jr. in front of an American flag with the caption, "Presidential candidate. 2008 A.D."[218]

One of the advertisements for Samsung videocassette recorders depicted a robot with mechanical features, dressed in a wig, gown, and jewelry to resemble Vanna White, hostess of the television game show *Wheel of Fortune*.[219] The robot was posed beside letter blocks that resembled the *Wheel of Fortune* game board.[220] The advertisement's caption read, "Longest-running game show. 2012 A.D."[221] Vanna White neither consented to the ad nor was paid.[222]

White brought suit against Samsung in federal district court[223] under California's name-and-likeness statute, California Civil Code, section 3344;[224] California's common-law right of publicity; and section 43(a) of the federal Lanham Act.[225] The district court granted summary judgment against White on all of her claims.[226] On appeal, the Ninth Circuit affirmed summary judgment on White's section 3344 claim,[227] but reversed summary judgment on her right of publicity[228] and Lanham Act claims.[229]

1. The Majority Opinion

a) Statutory Claim Under Section 3344

The majority opinion dispatched with White's claim that Samsung had used her "likeness" within the meaning of California's name-and-likeness statute.[230] The court construed the statute nar-

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209 Shipley, *supra* note 5, at 731.
210 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 133 S. Ct. 2443 (1993).
211 *Id.* at 1399.
212 *See, e.g.*, Stephen R. Barnett, *In Hollywood's Wheel of Fortune, Free Speech Loses a Turn*, WALL ST. J., Sept. 28, 1992, at A14; Stephen R. Barnett, *Wheel of Misfortune for Advertisers: Ninth Circuit Misreads the Law to Protect Vanna White's Image*, L.A. DAILY J., Oct. 5, 1992, at 6; Felix H. Kent, *California Court Expands Celebrities' Rights*, N.Y.L.J., Oct. 30, 1992, at 3; Note, White v. Samsung Electronics America, Inc.: *The Wheels of Justice Take an Unfortunate Turn*, 23 GOLDEN GATE U. L. REV. 299 (1993).
213 White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).
214 J. Thomas McCarthy, *Is Vanna White Right and Judge Kozinski Wrong?*, ENT. L. REP., Sept. 1993, at 9.
215 *White*, 971 F.2d at 1396.
216 *Id.*
217 *Id.*
218 *Id.*
219 *Id.*
220 *Id.*
221 *Id.*
222 *Id.*
223 *Id.*
224 The statute reads, in part: "Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, . . . for purposes of advertising or selling, . . . without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof." CAL. CIV. CODE § 3344(a) (West Supp. 1990).
225 15 U.S.C. § 1125(a) (1988). This Note omits the court's discussion of White's Lanham Act claim. Applying an eight-factor test derived from AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979) to determine likelihood of viewer confusion as to whether White was endorsing Samsung's VCRs, the court found that five of the factors weighed in favor of White, two weighed against, and one weighed both for and against her. *White*, 971 F.2d at 1400-01.
226 *White*, 971 F.2d at 1396-97.
227 *Id.* at 1396.
228 *Id.* at 1399.
229 *Id.* at 1401.
230 *Id.* at 1397.

rowly, noting that Samsung had used a robot with mechanical features rather than a mannequin "molded to White's precise features."[231] Without ruling on whether a caricature or "impressionistic resemblance" might be a likeness for purposes of the statute, the court affirmed the district court's finding that the robot was not White's likeness.[232]

b) Right of Publicity Claim

The court began its analysis of White's publicity claim by declaring that although Samsung had not used White's name or likeness, "the common law right of publicity is not so confined."[233] The court then briefly reviewed three cases—*Motschenbacher v. R.J. Reynolds Tobacco Co.*,[234] *Midler v. Ford Motor Co.*,[235] and *Carson v. Here's Johnny Portable Toilets, Inc.*[236]—to illustrate how the advertiser who avoids blatantly appropriating a publicity plaintiff's identity may nonetheless implicate the commercial interests that the right of publicity seeks to protect.[237] Since the identities of popular celebrities are "the easiest to evoke without resorting to obvious means such as name, likeness, or voice,"[238] the court stated, the *method* by which an advertiser appropriates a celebrity's identity is not as dispositive as *whether* the advertiser does so.[239]

> [Prior cases] teach the impossibility of treating the right of publicity as guarding only against a laundry list of specific means of appropriating identity. A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.[240]

231 *Id.*

232 *Id. But see* Ali v. Playgirl, Inc., 447 F. Supp. 723, 726 (S.D.N.Y. 1978) (drawing of black boxer identifiable as Mohammed Ali is "likeness" of Ali for purposes of New York's name-and-likeness statute).

233 *Id.*

234 498 F.2d 821 (9th Cir. 1974). In *Motschenbacher*, the advertiser used a photograph of the plaintiff's race car in a television commercial. Although Motschenbacher appeared to be driving the car in the photograph, his features were not visible. The court held that the peculiar markings on the race car could cause viewers of the commercial to reasonably infer that Motschenbacher was driving the car and endorsing the advertised product. In the absence of authority from the state's courts, the Ninth Circuit concluded that California would "afford legal protection to an individual's proprietary interest in his own identity." *Id.* at 825. Echoing Prosser, the court found it unnecessary to decide whether to do so "under the rubric of 'privacy,' 'property,' or 'publicity.' " *Id.* at 826.

235 849 F.2d 460 (9th Cir. 1988). *See* discussion *supra* part II.D.2.

236 698 F.2d 831 (6th Cir. 1983). *See* discussion *infra* part III.B.1.

237 *White*, 971 F.2d at 1398.

238 *Id.* at 1399.

239 *Id.* at 1398.

240 *Id.*

Samsung's advertisement had evoked White's identity, reasoned the court, by way of a cumulation of pictorial details within the advertisement: the robot's feminine shape, blonde wig, attire, and position on a "Wheel of Fortune"-type set.[241] The court analogized Samsung's advertisement to a hypothetical one depicting

> a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. . . . Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.[242]

Samsung had argued that the advertisement parodied White and thus was speech protected under the First Amendment.[243] The court rejected the parody defense:

> The ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: "buy Samsung VCRs." Defendants' parody arguments are better addressed to non-commercial parodies. The difference between a "parody" and a "knock-off" is the difference between fun and profit.[244]

Refusing to "permit the evisceration of the common-law right of publicity" through Samsung's "facile" means, the court ruled that a jury could decide whether Samsung had appropriated White's identity.[245] A jury subsequently found for White, awarding her $403,000 in damages.[246]

2. The Dissenting Opinion

Judge Alarcon dissented from the majority's treatment of White's publicity claim on several grounds.[247] First, he noted that

241 *Id.* at 1399.

242 *Id.*

243 *Id.* at 1401.

244 *Id.*

245 *Id.* at 1399.

246 White v. Samsung Electronics America, Inc., No. CV-886499 (C.D. Cal. filed January 20, 1994).

247 *White*, 971 F.2d at 1402-05, 1407-08. Judge Alarcon also dissented from the majority's

"the courts of California have never found an infringement on the right to publicity without the use of the plaintiff's name or likeness."[248] Second, *White* was distinguishable on its facts from the cases relied upon by the majority.[249] In *Motschenbacher*,[250] *Midler*,[251] and *Carson*,[252] the advertiser had represented that the person depicted in the advertisement was in fact the plaintiff, and had made "[n]o effort . . . to dispel the impression that the . . . [celebrity] was involved" in the advertisement. In *White*, however, the robot was obviously not White herself.[253]

> The proper interpretation of *Motschenbacher*, *Midler*, and *Carson* is that where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an ad, a triable issue of fact has been raised as to whether his or her identity has been appropriated.
>
> . . . [In the instant case, it] is patently clear to anyone viewing the commercial advertisement that Vanna White was not being depicted. No reasonable juror could confuse a metal robot with Vanna White.[254]

Judge Alarcon accused the majority of confusing Vanna White, the person, with the role she plays on "Wheel of Fortune."[255] Traits such as blonde hair, an evening gown, and jewelry are shared by many women; the only characteristic that would lead the viewer of the advertisement to think of Vanna White was the imitation "Wheel of Fortune" game board.[256] The "Wheel of Fortune" set, however, was not an attribute of White's identity, but rather "an identifying characteristic of a television game show, a prop with which Vanna White interacts in her role as the current hostess."[257] Distinguishing between the performer and the part she plays[258] was essential to analyzing the facts of *White*. In support of his argument, Judge Alarcon cited *Nurmi v. Peterson*,[259] a case that conflicts with *White* in holding that the use of props, clothes, or mannerisms to nondeceptively imitate a character is not actionable under California's common law right of publicity.[260] Conceding that "anyone seeing [Samsung's] commercial would be reminded of Vanna White," Judge Alarcon observed that *any* performance by another female celebrity as a game-show hostess would remind viewers of White because "Vanna White's celebrity is so closely associated with the role."[261]

finding that a triable issue of material fact remained as to White's Lanham Act claim, pointing to White's failure to produce evidence of actual confusion. *Id.*

248 *Id.* at 1403.

249 *Id.* at 1404.

250 498 F.2d 821 (9th Cir. 1974).

251 849 F.2d 460 (9th Cir. 1988).

252 698 F.2d 831 (6th Cir. 1983).

253 *White*, 971 F.2d at 1404.

254 *Id.*

255 *Id.*

256 *Id.* at 1405.

257 *Id.*

258 *Cf.* Judge Mosk's concurring opinion in Lugosi v. Universal Pictures, 603 P.2d 425, 432 (Cal. 1979). Recall that in *Lugosi*, Chief Justice Bird stated that publicity protection should not extend to the idea of a character, *id.* at 445 n.26 (Bird, C.J., dissenting), and that "[n]othing in . . . [the] right of publicity precludes others from portraying Count Dracula and exploiting or filming such characterizations." *Id.* at 448 n.35.

Judge Alarcon also disagreed with the majority's preemptory dismissal of Samsung's First Amendment defense, finding it "difficult to estimate" the effect of the majority's holding on expressive conduct.[262]

> Under the majority's view of the law, Gene Autry could have brought an action for damages against all other singing cowboys. Clint Eastwood would be able to sue anyone who plays a tall, soft-spoken cowboy, unless, of course, Jimmy Stewart had not previously enjoined Clint Eastwood. . . . Sylvester Stallone could sue actors who play blue-collar boxers.[263]

Courts hearing publicity claims, Judge Alarcon concluded, had to protect the work of those who create intellectual property without fashioning "a monopoly that would inhibit the creative expressions of others."[264]

B. *Critique of* White

In the *White* court's view, the critical issue is not *how* the publicity plaintiff's identity has been appropriated, but *whether* it has been appropriated. In other words, if the advertiser uses visual or auditory cues that indirectly evoke a celebrity's persona, then the advertiser has infringed that celebrity's right of publicity.[265] The

259 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989). In *Nurmi*, the plaintiff was a 1950s television movie hostess who created and performed the character of "Vampira," which consisted of a dark dress, horror-movie props, and nefarious personality. The defendant was "Elvira," a horror-movie hostess whose character relied upon similar attributes. The court found that absent a fraudulent attempt to deceive the public into believing that Elvira was Vampira, "a person's use of a character that bears a mere resemblance to another is [not] actionable under the common-law right of publicity." *Id.* at 1778. Interestingly, *Nurmi* and the *White* trial-court decisions originated from the same court, the United States District Court for the Central District of California.

260 *White*, 971 F.2d at 1404.

261 *Id.* at 1405.

262 *Id.* at 1407.

263 *Id.*

264 *Id.* at 1408.

265 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1398-99 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

notion that identifiability triggers liability[266] is elegantly simple. In addition, given the legal truism that one should not be able to accomplish indirectly what would be wrongful to accomplish directly, an evocation-of-identity test for publicity liability seems consonant with traditional protection against unauthorized use of name and likeness. *White's* evocation-of-identity test, however, is dangerous in two respects. First, it effectively grants the celebrity property rights in attributes that merely remind the public of him, as opposed to a property right in his persona per se. Second, the test ignores the possibility that celebrity identity as evoked within a particular advertisement may serve an entertainment function or form part of a parody, such that the appropriative portion of the advertisement merits First Amendment protection.

1. Property Rights in Identity Attributes

In order to understand the absurd outcome that might result from an evocation-of-identity standard, suppose that Samsung's advertisement featured a chimpanzee next to the "Wheel of Fortune" game board. The chimpanzee wears neither a blonde wig nor jewelry. Viewers of the advertisement would surely be reminded of Vanna White, thinking that the chimpanzee is "supposed to be" White for humorous purposes. Because White has been "identified," Samsung has commercially exploited her identity and thus infringed her right of publicity. In this case, what helps the viewing public identify White is someone—or something—posed next to the "Wheel of Fortune" game board. Yet in finding misappropriation under these circumstances, a court is empowering White to enjoin an advertiser from depicting *anything* next to the "Wheel of Fortune" game board.[267] Granting White such a monopoly right is markedly different from judicially recognizing that a celebrity should be able to control unauthorized uses of her persona.

In *Carson v. Here's Johnny Portable Toilets*,[268] Johnny Carson successfully enjoined a portable-toilet manufacturer from marketing portable toilets under the brand name of "Here's Johnny." The Sixth Circuit, applying Michigan law,[269] held that the manufac-

[266] McCarthy, *supra* note 138, § 8.14[B], at 8-96 (test of infringement is whether plaintiff is "identifiable" from defendant's advertising use).

[267] Madow, criticizes the right of publicity for giving the celebrity "power to deny others the use of her persona in the construction and communication of alternative or oppositional identities"—"power, ultimately, to limit the expressive and communicative opportunities for the rest of us." Madow, *supra* note 43, at 145-46.

[268] 698 F.2d 831 (6th Cir. 1983).

[269] 698 F.2d at 834 n.1. The Sixth Circuit court noted that Michigan courts had not yet clearly recognized the right of publicity. However, Michigan's recognition of a privacy right, coupled with widespread acceptance of the right of publicity, suggested to the court that Michigan would adopt the right. *Id.*

turer's use of "Here's Johnny" appropriated Carson's identity for commercial purposes.[270] Judge Kennedy's vigorous dissent in *Carson* questioned the assertion of a property right in a phrase that Carson neither created nor spoke himself,[271] and raised the possibility that Ed McMahon—who introduced Carson each night with "Here's Johnny"—might have a publicity interest of his own in the phrase.[272] More importantly, Judge Kennedy noted that granting Carson the right to prevent others from using "Here's Johnny" would result in unjust enrichment, since Carson could remove a phrase from public discourse without having to contribute anything to the public in return.[273] The prospect of celebrities being unjustly enriched in this manner is ironic indeed, considering that the prevention of unjust enrichment is one of the publicity right's primary justifications.[274]

The *Midler*[275] sound-alike case furnishes another example of the property rights that may arise from a mechanical application of *White's* evocation-of-identity test. Suppose that the advertising agency in *Midler*, rather than hiring a singer and instructing her to "sound as much as possible like . . . Bette Midler,"[276] has a male singer who sounds nothing like Midler croon "Do You Want To Dance" in the background of a television commercial. Bette Midler argues that because she is linked in the public mind with her 1973 hit recording of the song, viewers are reminded of her whenever they see the commercial; relying on *White*, the court finds an infringement of Midler's right of publicity. Midler's publicity claim now precludes an advertiser from using *any* rendition of the song in a commercial without first securing Midler's permission. Licensing a "cover version" of the song[277] becomes an expensive proposition because Midler can demand a royalty from each potential licensee—all for a song that she had no part in creating. The in-

[270] *Id.* at 837.

[271] *Id.* at 839 (Kennedy, J., dissenting).

[272] *Id.* at 839 n.5.

[273] *Id.* George Lucas, director of the Star Wars films, at one time sought to prevent public interest groups from referring in television commercials to the Reagan Administration's Strategic Defense Initiative as "Star Wars." Lucasfilm Ltd. v. High Frontier, 622 F. Supp. 931 (D.D.C. 1985); *see also* Madow, *supra* note 43, at 232-33 ("The precise reach of *Carson* is uncertain. Would 'Make My Day' Vitamins infringe Clint Eastwood's right of publicity? What about 'Read My Lips' Lipstick?").

[274] *See* discussion *supra* part II.C.1.

[275] Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988); *see* discussion *supra* part II.D.2.

[276] 849 F.2d at 461.

[277] *See supra* note 205 and accompanying text.

come stream that flows to the copyright proprietor of the song, as well as the songwriter who licenses cover versions of the composition,[278] is thus impaired—a result that the Ninth Circuit in *Sinatra*[279] consciously sought to avoid.[280]

2. Possible Conflict with the First Amendment

While the right of publicity centers on misappropriation for commercial ends, the use of celebrity identity in connection with the dissemination of news[281] or information of public interest[282] is generally privileged under the First Amendment.[283] Several name-and-likeness statutes create exceptions that address free-speech concerns.[284] The California Civil Code, for example, provides that "use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute use for which consent is required. . . ."[285] In news stories as well as historical and biographical accounts, the public's right to be informed[286] usually outweighs the celebrity's private interest in controlling uses of his identity.[287]

The media's First Amendment privilege to appropriate celebrity identity is not, however, limited to informative uses: as the Supreme Court declared in *Zacchini*, "[t]here is no doubt that entertainment, as well as news, enjoys First Amendment protec-

278 *Id.*

279 Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

280 *Id.* at 718; *see* discussion *supra* part II.D.2.

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

282 *See* Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501 (Sup. Ct. 1968) (poster of mock Presidential candidate Pat Paulsen protected by First Amendment as newsworthy use because candidacy was of public interest). *But see* Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (Elvis Presley poster captioned "In Memory" and marketed after Presley's death not protected as commemorating a newsworthy event).

283 *See* Nimmer, *supra* note 1, at 216-17; SELZ, ENTERTAINMENT LAW § 19-06; James Barr Haines, *First Amendment II: Developments in the Right of Publicity*, 1989 ANNUAL SURVEY OF AMERICAN LAW 211, 226 nn.101-02 (1989).

284 *See, e.g.*, CAL. CIV. CODE § 3344(d) (West Supp. 1990); NEB. REV. STAT. § 20-202(1) (1987); TENN. CODE ANN. § 47-25-1107(a) (1988).

285 CAL. CIV. CODE § 3344(d) (West Supp. 1990).

286 *See* Virginia Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc., 425 U.S. 748, 756-57 (1976); Donahue v. Warner Bros. Pictures Distrib. Corp., 272 P.2d 177, 183 (Utah 1954).

287 *See, e.g.*, Frosch v. Grosset & Dunlap, Inc., 427 N.Y.S.2d 828 (App. Div. 1980); Factors, Etc., Inc. v. Creative Card Co., 444 F. Supp. 279, 284 (S.D.N.Y. 1977), *aff'd sub nom.* Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); Rosemont Enters., Inc. v. Random House, Inc., 294 N.Y.S.2d 122 (Sup. Ct. 1968), *aff'd*, 301 N.Y.S.2d 948 (App. Div. 1969); *Donahue*, 272 P.2d 177; Koussevitzky v. Allen, Towne & Heath, 68 N.Y.S.2d 779 (Sup. Ct. 1947), *aff'd*, 69 N.Y.S.2d 432 (App. Div. 1947).

tion."[288] The Court has deemed informative and entertaining expression worthy of equal free-speech treatment because "[t]he line between the informing and the entertaining is too elusive for the protection of the basic right. . . . What is one man's amusement, teaches another's doctrine."[289] Fictional characters modeled on real-life individuals present no publicity problems so long as the fictional element is clear to the public.[290] As one California court noted, "the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction."[291]

The argument that enforcing the right of publicity may conflict with artistic expression and the communication of ideas is least persuasive in cases involving merchandising uses of celebrity identity. After all, plastic pencil sharpeners,[292] bubble gum cards,[293] and board games[294] are hardly vehicles through which ideas and opinions are traditionally disseminated.[295] In terms of information or entertainment value, a Howard Hughes T-shirt[296] and a fictionalized autobiography of Hughes[297] are quite distinguishable. Appropriation of name and likeness to sell a product rather than tell a story or inform the public seems intuitively wrongful, perhaps because speech that proposes a transaction between seller and

288 433 U.S. at 578 (1977); *accord* Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982); *see also* Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 458-59 (Cal. 1979) (Bird, C.J., concurring) ("entertainment is entitled to the same constitutional protection as the exposition of ideas").

289 Winters v. New York, 333 U.S. 507, 510 (1948).

290 Hicks v. Casablanca Records, 464 F. Supp. 426, 433 (S.D.N.Y. 1978) (First Amendment protects film fictionalizing event in Agatha Christie's life); Rosemont Enters., Inc. v. McGraw-Hill Book Co., 380 N.Y.S.2d 839 (Sup. Ct. 1975); Rogers v. Grimaldi, 695 F. Supp. 112 (S.D.N.Y. 1988), *aff'd on other grounds*, 875 F. Supp. 994 (2d Cir. 1989) (First Amendment protects fictional account of an Italian dance team that emulates Fred Astaire and Ginger Rogers).

291 *Guglielmi*, 603 P.2d at 460 (Cal. 1979) (Bird, C.J., concurring).

292 Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (Bird, C.J., dissenting).

293 Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

294 Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970).

295 *See Guglielmi*, 603 P.2d at 463 (Cal. 1979) (Bird, C.J., concurring); *accord Hicks*, 464 F. Supp. at 430 (S.D.N.Y. 1978). Even in the "mere merchandise" cases, the courts seem unclear as to the scope of First Amendment protection. In *Paulsen v. Personality Posters, Inc.*, the defendant was allowed to sell posters of comedian Pat Paulsen over the latter's objections because Paulsen's mock Presidential candidacy was a newsworthy event. 299 N.Y.S.2d 501 (Sup. Ct. 1968). Yet in *Factors, Etc.*, the defendant was enjoined from selling Elvis Presley posters bearing the legend "In Memory . . . " after Presley's death because the posters did not commemorate a newsworthy event. Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). Though arguably the same commercially exploitative motives underlay both appropriative acts, the Second Circuit distinguished *Paulsen* on the ground that "Paulsen's choice of the political arena for satire made him 'newsworthy' in the First Amendment sense." *Id.* at 222.

296 Rosemont Enters., Inc. v. Choppy Prods., Inc., 347 N.Y.S.2d 83 (Sup. Ct. 1972).

297 *McGraw-Hill Book Co.*, 380 N.Y.S.2d 839.

buyer[298] in theory contributes little to the Holmesian marketplace of ideas.[299]

a) Cultural Enrichment vs. Commercial Exploitation

Fifteen years ago, Peter Felcher and Edward Rubin proposed an analytical framework for balancing the First Amendment with the right of publicity in media portrayals of real people.[300] They distinguish between uses of celebrity identity that inform or entertain—thus either furthering public debate on social issues or enriching our cultural experience—and those identity uses designed only to sell a product.[301] In deciding publicity claims, Felcher and Rubin urge that courts focus on the purpose of a particular use: "if it serves an informative or cultural function, it will be immune from liability; if it serves no such function but merely exploits the individual portrayed, immunity will not be granted."[302] One right of publicity case from the 1980s that relied in part on the Felcher and Rubin approach is *Estate of Presley v. Russen.*[303]

Russen involved an Elvis Presley impersonator who performed in "The Big El Show," a ninety-minute stage production designed to re-create an actual Presley concert.[304] The Presley estate sought a preliminary injunction to restrain production of "The Big El Show," alleging infringement of Presley's right of publicity.[305] In discussing whether the First Amendment allowed Russen to appropriate Presley's identity, the New Jersey district court applied Felcher and Rubin's distinction between media portrayals that served informative or cultural-enrichment purposes and those that

298 Speech that proposes such a transaction—"I will sell you X for Y price"—is protected under the First Amendment as commercial speech, albeit to a lesser degree than is noncommercial speech. *See* Central Hudson Gas & Electric Corp. v. Public Serv. Comm'n, 447 U.S. 557 (1980).

299 The First Amendment concept of the marketplace of ideas is traceable to Justice Holmes' dissent in *Abrams v. United States.* 250 U.S. 616 (1919). In the landmark case on commercial speech, *Virginia Pharmacy Board. v. Virginia Consumer Council,* Justice Rehnquist's dissent contrasted what he viewed as the noble purposes of political speech with the trifling communicative ends of commercial advertising. 425 U.S. 748, 781-90 (1976). Faulting the majority opinion for "elevat[ing] commercial intercourse between a seller hawking his wares and a buyer seeking to strike a bargain to the same plane as has been previously reserved for the free marketplace of ideas," *id.* at 781, Justice Rehnquist believed that the First Amendment goal of enlightening the public in a democracy "relate[d] to public decisionmaking as to political, social, and other public issues, rather than the decision as to whether to purchase one or another kind of shampoo." *Id.* at 787.

300 Peter Felcher & Edward Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media,* 88 YALE L.J. 1577 (1979). *See generally* Samuelson, *supra* note 79, at 869-76.

301 Felcher & Rubin, *supra* note 300, at 1597.

302 *Id.* at 1596.

303 513 F. Supp. 1339 (D.N.J. 1981).

304 *Id.* at 1348.

305 *Id.* at 1344.

were primarily commercially exploitative.[306] The court found that although "The Big El Show" featured both informational and entertainment elements, its primary purpose was "to commercially exploit the likeness of Elvis Presley without contributing anything of substantial value to society."[307] Because "The Big El Show" lacked any creative component and thus had no "significant value as pure entertainment,"[308] the court held that the show did not warrant sufficient First Amendment protection to defeat the Presley estate's right of publicity claim.[309]

Although the *Russen* court's conclusion that "The Big El Show" made no cultural contribution at all is questionable,[310] the important point is that under the Felcher-Rubin thesis as applied in *Russen,* Samsung's appropriation of White's identity in its advertisement should have been considered privileged by the First Amendment. Did Samsung's ad, to use the language of *Russen,* "commercially exploit the likeness of [Vanna White] without contributing anything of substantial value to society"[311] or lack sufficient creativity to offer "significant value as pure entertainment"?[312] Certainly not. Broadly speaking, Samsung appropriated White's identity in order to sell a product. It did so, however, not by posing a likeness of White beside the product, but by using her likeness as the raw material for a visual joke. The *White* court stated that "[t]he ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: 'buy Samsung VCRs.' "[313] Yet granting that the spoof of White is "only tangentially related" to Samsung's commercial message, the visual joke, which involves some creativity beyond a pure reproduction of White's likeness, may have entertainment value and thus merit First Amendment protection. Not every element of an advertisement screams "buy." Advertising includes both a commercial proposal—a statement that the product is for

306 *Id.* at 1359.

307 *Id.*

308 *Id.*

309 *Id.* at 1361.

310 Addressing the court's determination that "The Big El Show" had no value as entertainment, one commentator speculates that "[s]urvey evidence from Elvis fans or perhaps an audit of [the show's] ticket sales might have suggested a different conclusion." H. Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity,* 17 COLUM.-VLA J.L. & ARTS 1, 24 (1992). Another commentator notes, "To avid Elvis fans—and there are millions of them—no greater cultural achievement would be possible" than "a live 'Elvis' performance that could no longer be supplied by the originator of the style because of his death." Samuelson, *supra* note 79, at 873.

311 513 F. Supp. at 1359.

312 *Id.*

313 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1401 (9th Cir. 1992).

sale—as well as rhetorical material (such as the visual joke of White as robot) that attracts attention to the commercial proposal.[314] As one commentator notes:

> This rhetorical matter may include . . . entertainment. . . . Assuming the rhetorical matter does not amount to [defamation, obscenity, or fighting words], it is entitled to full constitutional protection because it does not make claims about a product, which is the sole province of the commercial speech doctrine and its limited protection. Arguably, the rhetorical matter *should receive the same [F]irst [A]mendment protection that social commentary, . . . news, other information or entertainment receive when they occur in forms other than commercial advertisements.*[315]

b) Parody and the Right of Publicity

Another respect in which the appropriation of White's identity should be privileged under the First Amendment is that Samsung's advertisement was a parody.[316] The Supreme Court recently affirmed the social value of parody,[317] which may constitute a fair use under copyright law,[318] provided the parody takes no more than necessary to "conjure up" the original[319] and "builds upon the original, using the original as a known element of modern culture and

314 Theodore F. Haas, *Storehouse of Starlight: The First Amendment Privilege to Use Names and Likenesses in Commercial Advertising*, 19 U.C. DAVIS L. REV. 539, 542 (1986).

315 *Id.* at 550-51 (emphasis added). In his dissent on denial of rehearing of *White*, Judge Kozinski defends First Amendment protection for commercial speech on the following ground: "Commercial speech has a profound effect on our culture and our attitudes. Neutral-seeming ads influence people's social and political attitudes, and themselves arouse political controversy." White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1520 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

In *Central Hudson Gas & Electric Corp. v. Public Service Commission*, the Supreme Court enunciated a four-part balancing test for commercial speech cases. 447 U.S. 557 (1980). First, the court determines whether the commercial speech concerns lawful activity and is not misleading. Second, it determines whether the asserted governmental interest is substantial. If the answers to the first two inquiries are positive, the court evaluates, third, whether the speech regulation directly advances the governmental interest asserted, and, fourth, whether the regulation is only as extensive as necessary to further that interest. *Id.* at 564; *see also* Zauderer v. Office of Disciplinary Counsel, 471 U.S. 626 (1985).

316 *See, e.g.*, Cliffs Notes v. Doubleday Dell Publishing Group, 886 F.2d 490, 493 (2d Cir. 1989) ("parody is a form of artistic expression" protected by the First Amendment); *accord* L.L. Bean v. Drake Publishers, 811 F.2d 26, 32 (1st Cir. 1987) (parody that expresses an idea or point of view protected by the First Amendment); Groucho Marx Prods. v. Day & Night Co., 689 F.2d 317, 319 n.2 (2d Cir. 1982) (acknowledging "the broad scope permitted parody in First Amendment law"); *see generally* Charles C. Goetsch, *Parody as Free Speech—The Replacement of the Fair Use Doctrine by First Amendment Protection*, 3 W. NEW ENG. L. REV. 39 (1980).

317 Campbell v. Acuff-Rose Music, Inc., 114 S. Ct. 1164 (1994).

318 *Cf.* 17 U.S.C. § 107 (1988).

319 Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 756 (9th Cir. 1978); Elsmere Music, Inc. v. NBC, 623 F.2d 252, 253 n.1 (2d Cir. 1980); Berlin v. E.C. Publications, Inc., 329 F.2d 541, 545 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964).

contribut[es] something new for humorous effect."[320] The California Supreme Court has stated that "[t]he right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire,"[321] and in two right of publicity cases, the courts intimated that parodists would be immune from liability for infringing a celebrity's publicity right.[322]

The *White* court considered a parody defense inapplicable to an advertisement because "[t]he difference between a 'parody' and a 'knock-off' is the difference between fun and profit."[323] It is unclear, however, why a parody within the context of an advertisement should be treated any differently than a parody in a news or entertainment medium.[324] One commentator offers the following example:

> Suppose . . . that a widely known humorist and entertainer appears on a television news program as a panelist. She expresses her critique of a particular celebrity symbol, Madonna for example, in humorous jibes, ridicule, and commentary. . . . Now move the humorist from the news panel to . . . an infomercial or television commercial. She ridicules or parodies the same famous personality, partly to amuse her audience and partly to criticize the celebrity symbol. Is she any less a critic and less entitled to the wide latitude afforded the critics on news programs?[325]

Under *White*'s evocation-of-identity test, the celebrity parody would no longer survive in commercial contexts, since parody's effectiveness "necessarily springs from recognizable allusion to its object through distorted imitation."[326] For a parody to succeed, it must remind the viewer of the celebrity being mocked. After all, "[m]imicry and impersonation are humorous and entertaining only if the audience is aware of the target of the satire."[327] The *White*

320 *Elsmere Music*, 623 F.2d at 253 n.1.

321 Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 460 (Cal. 1979) (Bird, C.J., concurring).

322 Estate of Presley v. Russen, 513 F. Supp. 1339, 1359 n.21 (D.N.J. 1981); Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485, 492-93 (S.D.N.Y.), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

323 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1398, 1401 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

324 "Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a celebrity's identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. . . . Both add something . . . to our culture." White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1520 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

325 Pemberton, *supra* note 140, at 127 n.107.

326 *Campbell*, 114 S. Ct. 1164.

327 MCCARTHY, *supra* note 138, § 8.15[B], at 8-101.

court's refusal to allow a parody exception to publicity infringements in advertising has far-reaching consequences, as three Ninth Circuit judges recognized:

> The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture. Parody, humor, irreverence are all vital components of the marketplace of ideas. The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them or from 'evok[ing]' their images in the mind of the public.[328]

In addition, the justifications traditionally offered for a right of publicity—vouchsafing the fruit of one's labors and promoting creative endeavor[329]—should apply equally to the celebrity and her parodist. Samsung's visual joke may ultimately contribute as much to our culture, and warrant as much protection, as do Vanna White's performances as hostess of "Wheel of Fortune."[330]

IV. Limiting the Scope of the Publicity Right After *White*

The right of publicity serves a legitimate function in securing the financial worth of a celebrity's identity. If Joe Promoter takes a photograph of Madonna in concert and produces Madonna T-shirts and posters from the photograph, he inflicts economic harm in several ways. First, he deprives Madonna of the ability to personally profit from licensing her likeness to marketers. Second, he unfairly competes with those licensees who had to pay for the privilege of using Madonna's likeness. Third, since celebrity persona is usually exploitable for only a finite period, Joe Promoter's action risks overexposing Madonna's likeness to the public and so shortening the useful life of her asset.

It is clear from this example what the right of publicity should protect. What remains unclear, forty years after *Haelan*[331] and Nimmer's *The Right of Publicity*,[332] is just how far this protection should extend. Since the publicity right is a state right analogous to copyright and patent laws,[333] some courts[334] have urged that

[328] White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1519 (9th Cir. 1993) (citation omitted) (denial of rehearing).

[329] *See* discussion *supra* part II.C.

[330] *See* Pemberton, *supra* note 140, at 107 ("We cannot say that what the parodist is doing is less important, or less creative, or less meaningful than what the celebrity did to become famous.").

[331] 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

[332] Nimmer, *supra* note 1, at 203.

[333] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977); Lugosi v. Universal Pictures, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting); Factors, Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215, 221 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); Martin Luther King, Jr., Ctr. for Social Change v. American Heritage Prods., 296 S.E.2d 697 (Ga. 1982); *see also* Hoffman, *supra* note 7, at 118; Shipley, *supra* note 5, at 681.

[334] Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 841 (6th Cir. 1983); White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

what is not covered by these federal statutory monopolies should be "free as the air to common use."[335] This argument is an outgrowth of two 1964 Supreme Court cases that articulated a federal policy encouraging commercial imitation.[336] Congress' decision to protect the creations of authors and inventors, however, does not necessarily imply that states are powerless to protect intellectual property that falls outside the purview of federal protection.[337] Moreover, the issue is moot with regard to the right of publicity: in *Zacchini*,[338] the Supreme Court held that a state may protect subject matter otherwise unprotected by federal copyright, patent, or trademark laws.[339]

Zacchini's ratification of a state's right to prohibit misappropriations of identity should not suggest that copyright, patent, and trademark laws are irrelevant to considering the proper scope of the publicity right. The right of publicity is an intellectual property right, and intellectual property law generally reconciles private property rights with the need for public access to the works of authors and inventors. Copyright law, for example, features the

[335] International News Serv. v. Associated Press, 248 U.S. 215, 250 (1918).

[336] Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231-32 (1964); Compco Corp. v. Day-Brite Lighting, 376 U.S. 234, 237-38 (1964). Since *Sears* and *Compco*, the Supreme Court has undercut preemption of intellectual property actions based on state law. *See, e.g.*, Goldstein v. California, 412 U.S. 546, 571 (1973) (copyright law does not preempt state law prohibiting record piracy); Aronson v. Quick Point Pencil Co., 440 U.S. 257, 263 (1979) (state law governing contract between licensee and rejected patent applicant does not clash with federal policy encouraging imitation).

[337] In the case of the Copyright Act, for example, it is unclear from § 301 whether Congress intended that subject matter unprotected by copyright be freely available to the public, or, more narrowly, whether Congress meant to leave to the states the power to regulate such subject matter themselves. 17 U.S.C. § 301 (1988). Subject matter unprotected by copyright is "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b) (as amended by Pub. L. No. 101-650, 104 Stat. 5133 (1990)).

Federal preemption doctrine requires that a particular state law not obstruct the aims of federal law. Hines v. Davidowitz, 312 U.S. 52, 66-67 (1941). Suppose that Ohio passed a statute granting copyright-like protection to an author's ideas. Since ideas are not within the scope of copyright, copyright law would not federally preempt Ohio's statute under a literal reading of § 301 of the Copyright Act. 17 U.S.C. § 301(a)-(b)(1988). Yet since neither the Copyright Act nor the First Amendment countenances monopoly rights in ideas, Ohio's law clashes with federal aims and should be preempted. One commentator notes that this paradoxical result makes § 301 "of dubious utility in determining whether state action is preempted in cases where Congress's intent is unclear." Pesce, *supra* note 7, at 811-12.

[338] 433 U.S. 562 (1977).

[339] *Id.* at 575.

idea/expression dichotomy,[340] the uncopyrightability of facts,[341] the fair-use doctrine,[342] the right to make sound-alike recordings,[343] and a limited duration.[344] Patents have a relatively short life.[345] The nominative use of a trademark to describe goods or services rather than to suggest sponsorship or endorsement by the trademark holder is a type of fair use under trademark law.[346] As "careful balances between what's set aside for the owner and what's left in the public domain for the rest of us[,]" such safeguards "maintain a free environment in which creative genius can flourish."[347] The *White* decision, however, tips whatever balance the right of publicity had previously attained between the celebrity and the public in favor of the celebrity.[348] The advertiser who reminds viewers of a celebrity within a commercial is strictly liable for publicity infringement, and cannot benefit from the fair-use defense[349] or parody defense.[350]

The *White* court declines to furnish advertisers with a "laundry list" of how identity may be appropriated.[351] Indeed, if one concedes that the right of publicity protects identity-as-commodity, the *White* court correctly describes the threshold issue in each publicity case as not how, but whether, a celebrity's identity has been appropriated.[352] Yet judicial inquiry should not end, nor should liability unfailingly ensue, solely upon a determination that viewers of an advertisement can identify a celebrity from certain clues. Felcher and Rubin draw a line between identity uses that inform or entertain and those that commercially exploit celebrity identity.[353] Short of *Zacchini*-like appropriations that supplant the market for a celebrity's act, courts applying the First Amendment to publicity claims[354] might classify a particular identity use as either culturally enriching or blatantly commercial. When an identity use partakes of both elements, like the Elvis Presley concert simulation in *Russen*,[355] courts might take into account whether the defendant has added a modicum of creativity to the appropriated matter[356] in deciding whether the defendant has infringed the plaintiff's publicity right.

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340 There is a distinction between expression, which is protectable by copyright law, and the idea underlying the expression, which is not. 17 U.S.C. § 102(b) (1988); *See* Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 203 (2d Cir. 1983) (idea/expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression"), *rev'd*, 471 U.S. 359 (1985); *accord* New York Times Co. v. United States, 403 U.S. 713, 726 (1971) (Stewart, J., concurring) (copyright laws are not restrictions on freedom of speech since copyright protects only form of expression and not the ideas expressed).

341 Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

342 17 U.S.C. § 107 (1988). Broadly speaking, fair use is an affirmative defense to copyright infringement—"the privilege of using copyrighted material in a reasonable manner without the copyright owner's consent." Public Affairs Assocs., Inc. v. Rickover, 268 F. Supp. 444, 450 (D.D.C. 1967). In determining whether a particular use of copyrighted material is a fair use, courts rely on four illustrative factors provided by § 107: 1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; 2) the nature of the copyrighted work; 3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and 4) the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107.

Fair use is a notoriously nebulous area of copyright law; it has been described as "the most troublesome in the whole law of copyright," Dellar v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (2d Cir. 1939), and as "so flexible as to virtually defy definition," Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 144 (S.D.N.Y. 1968). As Professor Nimmer has noted, neither the case law nor section 107 itself "offer[s] any firm guide as to when . . . the defense of fair use *should* be invoked." NIMMER, *supra* note 174, § 1305[A].

The application of fair-use analysis to the facts of *White* and to publicity claims in general is beyond the scope of this Note. However, privileged appropriation of identity as proposed in this Note does draw upon the fourth fair-use factor in considering the effect of a particular identity appropriation upon the potential market for the associative value of the celebrity's persona.

343 17 U.S.C. § 114(b) (1988).

344 17 U.S.C. §§ 302-305 (1988). Speaking on the duration of copyright before the House of Commons in 1841, Lord Macaulay noted:

> It is good that authors should be remunerated; and the least exceptionable way of remunerating them is by a monopoly. Yet monopoly is an evil. For the sake of the good we must submit to the evil; but the evil ought not to last a day longer than is necessary for the purpose of securing the good.

T.B. MACAULAY, MACAULAY'S SPEECHES AND POEMS 285 (A.C. Armstrong & Son 1874), *quoted in* JOYCE ET AL., COPYRIGHT LAW (2d ed. 1991).

345 35 U.S.C. § 154 (1988) (17 years).

346 15 U.S.C. § 1115(b)(4) (1988). "The 'fair use' defense . . . forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods." Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1185 (5th Cir. 1980); *see also* New Kids on the Block v. New Am. Pub., Inc., 971 F.2d 302, 306-08 (9th Cir. 1992).

347 White v. Samsung Electronics America Inc., 989 F.2d 1512, 1516 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

348 *Id.* at 1515.

349 *See supra* note 342. A number of commentators have suggested fair-use analysis, or a modification thereof, as a means of incorporating First Amendment policies into the right of publicity. *See, e.g.*, Coyne, *supra* note 129; Hoffman, *supra* note 7, at 139-45; Roberta Rosenthal Kwall, *Is Independence Day Dawning for the Right of Publicity?*, 17 U.C. DAVIS L. REV. 191, 232 (1983); Samuelson, *supra* note 79, at 915-29; Note, *Human Cannonballs and the First Amendment:* Zacchini v. Scripps-Howard Broadcasting Co., 30 STAN. L. REV. 1185, 1206 (1978). *But see* MCCARTHY, *supra* note 138, § 8.6[D], at 8-36 (cautioning that fair use "should be invoked only as a last resort after all other solutions have been tried and found wanting") Hetherington, *supra* note 310, at 29 (application of § 107's four factors is "an impractical process when superimposed on the business environment populated by advertisers, entertainment concerns, celebrities and their attorneys").

350 *See* Pemberton, *supra* note 140, at 130-40.

351 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1398 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

352 *Id.*

353 Felcher & Rubin, *supra* note 300, at 1597.

354 *E.g.*, Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

355 513 F. Supp. at 1339.

356 *Id.* at 1359.

Drawing upon Felcher and Rubin's approach, this Note proposes a right of publicity standard that draws certain distinctions within the confines of advertising uses of celebrity identity. Such a standard accounts for the fact that reminding the public of a famous person does not inevitably damage the economic value of that person's image. Only if an identity use within a particular advertisement compromises the celebrity's ability to profit from her persona should the advertiser be liable for infringing a publicity right under the evocation-of-identity test. This, in turn, means that the court deciding a publicity claim should narrow its focus to the following types of advertising uses: 1) uses that physically incorporate the celebrity's name, likeness, or identifying attributes into a product or its packaging; 2) uses that directly depict or indirectly suggest that the celebrity endorses or approves of an advertised product or service; and 3) uses that rely on the "associative" value[357] of a celebrity—that is, uses that transfer the feelings engendered in the public mind by the celebrity to the advertised product or service. Any advertising use that performs none of these three functions should be considered a privileged appropriation of identity.

The first category includes merchandising uses such as Joe Promoter's Madonna T-shirts, Elvis Presley posters, and Count Dracula pencil sharpeners. Here, the principal economic harm to the celebrity, as discussed above in the Joe Promoter example, is impairment of the celebrity's ability to profit from her own likeness. There is neither a speech element of critical commentary nor an entertainment/information context involved in items that physically merge the identity of a famous person with the goods themselves.[358] The consumer simply purchases such products to own a "part" of the celebrity.

The second and third categories represent different ends of a continuum. At one end would be a direct pitch by the celebrity: a photograph of Vanna White holding up a VCR and smiling into the camera, accompanied by the caption, "I buy Samsung because it's the most reliable brand." At the other end of the spectrum would be an uncaptioned photograph of Vanna White relaxing at home on her sofa, with a Samsung VCR prominently displayed behind her. Both uses of White's identity rely upon her "glamour quotient" to convey the same message: Vanna White owns a Samsung VCR, and if you like her, you should own one, too.[359] The economic harm that flows from this type of unauthorized use is not limited to White's foregone endorsement fee. The public misperception of endorsement—which can also be created by deploying a celebrity look-alike or sound-alike—may lower White's asking price for subsequent endorsements.[360] VCR manufacturers such as Sony or Panasonic may be reluctant to have White endorse their products if she appears to be endorsing Samsung VCRs. In addition, if Samsung's electronic products have a poor reputation, connecting them to White without her approval may materially affect her future credibility as a spokesperson or endorser.

A particular advertising use of celebrity identity might generate none of these deleterious effects. For example, in *White*, the defendant evoked White's identity to humorously convey the message that its VCRs would last well into the future. Samsung did not represent that White endorsed the product. Even if viewers of the commercial were misled into believing that White had participated in the commercial, White's Lanham Act[361] claim should adequately protect her interests on this count. Nor did Samsung exploit White's pleasant appearance to enhance the attractiveness of its product, as is obvious from its use of a robot rather than the real White.

Privileged appropriation of identity presumes that evoking a celebrity persona within an advertisement is not wrongful per se. Rather, advertisers should be able to remind the public of a celebrity, so long as the advertiser does not link the celebrity to the product in order to make the product more desirable. One could argue that since the evocation of a celebrity's identity for humorous purposes draws the attention of viewers, ergo the product becomes more attractive; there should be no "joke defense" to publicity infringement. The response to this argument is that entertainment and social commentary are protected under the First Amendment, such that celebrity parodies appearing within an advertisement should at least be treated as commercial speech.[362]

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357 *See* Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199 (1986).

358 *See supra* note 295 and accompanying text.

359 Hetherington, *supra* note 310, at 34.

360 *See, e.g.*, Waits v. Frito Lay, Inc., 978 F.2d 1093, 1104 (9th Cir. 1992) (expert testimony established that voice misappropriation reduced endorsement fee that plaintiff could have commanded for commercials by $50,000-$150,000).

361 15 U.S.C. § 1125(a) (1988); *see supra* note 6. For discussion of the *White* court's disposition of White's Lanham Act claim, see *supra* note 223.

362 White v. Samsung Electronics America, Inc., 989 F.2d 1512, 1519-21 (9th Cir. 1993) (denial of rehearing) (Kozinski, J., dissenting).

V. Conclusion

The need for the celebrity to control unauthorized uses of his identity will exist so long as celebrity sells; "the initial phase of questioning what the right of publicity is, and whether it should exist at all, has passed into history."[363] Advertisers pay millions of dollars for the right to associate their goods and services with famous persons whose credibility, glamour, or attention-grabbing quality can influence the purchasing decisions of consumers.[364] Indeed, fame is "a marketable commodity that the celebrity may sell to the highest bidder."[365]

Legal recognition of the celebrity's identity as private property, however justified as it may be by these social realities, rests upon a shaky theoretical foundation. First, the very fame that makes celebrities desirable is not an individual achievement, nor necessarily the result of hard work. Second, the celebrity crying "unjust enrichment" might, after *White*, be enriched himself so long as he can freely prohibit others from using certain traits or catchphrases associated with him. Third, the incentive effect of the publicity right on the pursuit of fame is debatable—most probable in the case of the athlete fueled by dreams of multimillion-dollar endorsement contracts, less so in the case of the struggling actor. Coupled with these doctrinal weaknesses are clashes with the rights of copyright owners whenever a publicity claim involves a copyrighted work; except in the rare case of preemption, the publicity right may well devalue the interests of the copyright holder.

For a property right of ill-defined scope, the *White* decision introduces a dangerous degree of uncertainty. If other jurisdictions adopt the Ninth Circuit's theory that misappropriation consists of reminding the public of a certain celebrity, the right of publicity will be "lost in a sea of reminders and vague similarities."[366] By limiting advertiser liability for publicity infringements

363 McCarthy, *supra* note 138, § 1.10[C].

364 Hetherington, *supra* note 310, at 19. Prior to his retirement in 1993, basketball star Michael Jordan earned $36 million from endorsements; from 1983 to 1993, Pepsi paid singer Michael Jackson $20 million in endorsement fees and sponsored three tours. According to a telephone poll of 3,000 consumers, America's favorite entertainer-endorsers in 1993 were Candice Bergen (Sprint), Bill Cosby (Jell-O, Coke), Cher (Equal), Cindy Crawford (Pepsi, Revlon), and Burt Reynolds (Florida orange juice). Bruce Horovitz, *Wishing on a Star: Celebrity Endorsements Draw Big Bucks—But Do They Work?*, L.A. Times, Nov. 7, 1993, at D1. In early 1994, Olympic figure skater and silver medalist Nancy Kerrigan signed endorsement contracts worth an estimated $20 million with companies such as Walt Disney, Revlon, Reebok, Campbell Soup, and Ray-Ban. Judith Schoolman, *Athletes Spell Risky Endorsements When They Start Talking*, Reuter Business Report, Mar. 3, 1994.

365 Pemberton, *supra* note 140, at 102.

366 Note, White v. Samsung Electronics America, Inc.: *The Wheels of Fortune Take an Unfortunate Turn*, 23 Golden Gate U. L. Rev. 299, 335 (1993).

to intentionally associative uses, however, privileged appropriation of identity counters the "all-or-nothing" effect of *White*. It acknowledges that although nondeceptive imitations and parodies remind the public of a particular celebrity, such uses—in advertising as well as nonadvertising contexts—are necessary to promote creativity and ensure a vital popular culture.

Before *White*, "no satisfactory test [had] been devised to strike an equitable balance between private sector commercial interests and the First Amendment policy of ensuring public access to the cult of celebrity . . . ."[367] Privileged appropriation of identity is such a test. It recognizes that "[i]n some cases of media use of human identity, there is indeed a conflict with the [F]irst [A]mendment. It is real. It will not go away. . . . The [proper] balance must be laboriously hacked out case by case."[368]

367 Hetherington, *supra* note 310, at 48.

368 McCarthy, *supra* note 138, § 8.6[E], at 8-38.