

Personality Rights

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Personality Rights

One body of intellectual property law – the right of publicity – squarely protects people’s names, appearances, and other aspects of their personal identities. The policies underlying the right of publicity overlap substantially with those of copyright, trademark, and false advertising. It is helpful, therefore, to compare how these other bodies of law deal with personal identity. In addition, the law of naming and name changes sheds light both on right of publicity and trademark, and the tort law of defamation also bears on the issues.

A Right of Publicity

Two closely related theories of the right of publicity should be familiar. One is that it facilitates contracting over a type of information – people’s fame, talent, and ability to make endorsements – that has significant commercial value. The other is that it incentivizes the creation of these valuable personas in the first place. But the right of publicity is also closely linked to privacy. Historically, it grew out of privacy torts, and it helps to protect people’s interest in not being involuntarily exposed to the public eye.

The leading treatise on the right of publicity is J. Thomas McCarthy, *The Rights of Publicity & Privacy, McCarthy on Publicity*. Another valuable resource is the website Rothman's Roadmap to the Right of Publicity, which includes state-by-state information on statutes and caselaw.

Eric E. Johnson, *Disentangling the Right of Publicity*
111 Nw. U. L. Rev. 891 (2017)

According to blackletter law, the right of publicity provides persons with a cause of action against anyone who makes a commercial use of their name, image, likeness, or other indicia of identity. This account, with slight variations in language, is recited by countless courts, but a moment’s reflection demonstrates that it is not true.

Imagine what would happen if people really could recover just because their names are being exploited commercially. Every credit reporting agency would shutter instantly. Every celebrity gossip magazine would be drowned in liability. And every company that sells customer lists to direct mailers and telemarketers would have to

run for the hills. The right of publicity, by its own blackletter terms, should stop all these commercial uses of identity. Yet it does not. One thing is certain: the right of publicity is not what it says it is.

Unlike most legal doctrines, the right of publicity is currently defined negatively. That is, the law lacks a good positive description of what the right of publicity *is*. Instead, the cases are constantly working on the question of what the right of publicity *is not*. Much of the theoretical and practical trouble with the right of publicity can be traced to this doctrinal inversion.

The scope of the right of publicity is mostly defined extra-doctrinally. That is, instead of being self-limiting, the right of publicity, by its own letter, expands far beyond its permissible scope. It is up to other doctrines from other fields – notably the First Amendment and preemption by federal copyright law – to lop off the right of publicity’s doctrinal excess and force it back within intuitive limits.

What courts and commentators have been calling “the right of publicity” is really multiple rights: the endorsement right, the merchandizing entitlement, and the right against virtual impressment. The *endorsement right* is the right to not be featured in advertising in a way that implies an endorsement of a commercial enterprise – featuring a celebrity wearing a brand of shoes in an ad for those shoes would infringe. The *merchandizing entitlement* provides a right to not have one’s name, image, or identity marketed on coffee mugs, lunch boxes, or other merchandise. And the *right against virtual impressment* – which can be perceived only in a limited number of jurisdictions – protects one’s image and identity from being employed, marionette-like, as a virtual actor in a film or video game.

1 Ownership

Who has publicity rights? Conceptually, the answer depends on the reason(s) to recognize them. If publicity rights are privacy rights, then arguably ordinary citizens have them but celebrities who have voluntarily stepped out upon the public stage don’t. But if publicity rights are property rights, then arguably celebrities have them but ordinary citizens who have done nothing to monetize their identities don’t. Today, the answer is “both.” So a person comes to own a right of publicity in their own identity simply by existing as a person.

2 Subject Matter

Typically the right of publicity covers at least one’s name and likeness. How much further it extends is more controversial.

Midler v. Ford Motor Co.
849 F.2d 460 (2d Cir. 1988)

This case centers on the protectibility of the voice of a celebrated chanteuse from commercial exploitation without her consent. Ford Motor Company and its advertising agency, Young & Rubicam, Inc., in 1985 advertised the Ford Lincoln Mercury with a series of nineteen 30 or 60 second television commercials in what the agency called "The Yuppie Campaign." The aim was to make an emotional connection with Yuppies, bringing back memories of when they were in college. Different popular songs of the seventies were sung on each commercial. The agency tried to get "the original people," that is, the singers who had popularized the songs, to sing them. Failing in that endeavor in ten cases the agency had the songs sung by "sound alike." Bette Midler, the plaintiff and appellant here, was done by a sound alike.

Midler is a nationally known actress and singer. She won a Grammy as early as 1973 as the Best New Artist of that year. Records made by her since then have gone Platinum and Gold. She was nominated in 1979 for an Academy award for Best Female Actress in *The Rose*, in which she portrayed a pop singer. Newsweek in its June 30, 1986 issue described her as an "outrageously original singer/comedian." Time hailed her in its March 2, 1987 issue as "a legend" and "the most dynamic and poignant singer-actress of her time."

When Young & Rubicam was preparing the Yuppie Campaign it presented the commercial to its client by playing an edited version of Midler singing "Do You Want To Dance," taken from the 1973 Midler album, "The Divine Miss M." After the client accepted the idea and form of the commercial, the agency contacted Midler's manager, Jerry Edelstein. The conversation went as follows: "Hello, I am Craig Hazen from Young and Rubicam. I am calling you to find out if Bette Midler would be interested in doing ...? Edelstein: "Is it a commercial?" "Yes." "We are not interested."

Undeterred, Young & Rubicam sought out Ula Hedwig whom it knew to have been one of "the Harlettes" a backup singer for Midler for ten years. Hedwig was told by Young & Rubicam that "they wanted someone who could sound like Bette Midler's recording of [Do You Want To Dance]." She was asked to make a "demo" tape of the song if she was interested. She made an a capella demo and got the job.

At the direction of Young & Rubicam, Hedwig then made a record for the commercial. The Midler record of "Do You Want To Dance" was first played to her. She was told to "sound as much as possible like the Bette Midler record," leaving out only a few "aahs" unsuitable for the commercial. Hedwig imitated Midler to the best of her ability.

After the commercial was aired Midler was told by "a number of

people” that it “sounded exactly” like her record of “Do You Want To Dance.” Hedwig was told by “many personal friends” that they thought it was Midler singing the commercial. Ken Fritz, a personal manager in the entertainment business not associated with Midler, declares by affidavit that he heard the commercial on more than one occasion and thought Midler was doing the singing.

Why couldn't Midler sue for copyright infringement for imitating her recorded version?

Neither the name nor the picture of Midler was used in the commercial; Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler’s voice. The district court described the defendants’ conduct as that “of the average thief.” They decided, “If we can’t buy it, we’ll take it.” The court nonetheless believed there was no legal principle preventing imitation of Midler’s voice and so gave summary judgment for the defendants. Midler appeals.

If these two cases are indication, Young & Rubicam seems to have had a steady line of business making commercials with sound-alikes of famous female singers.

Nancy Sinatra once sued Goodyear Tire and Rubber Company on the basis of an advertising campaign by Young & Rubicam featuring “These Boots Are Made For Walkin’,” a song closely identified with her; the female singers of the commercial were alleged to have imitated her voice and style and to have dressed and looked like her. The basis of Nancy Sinatra’s complaint was unfair competition; she claimed that the song and the arrangement had acquired a secondary meaning which, under California law, was protectible. This court noted that the defendants “had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements.” To give Sinatra damages for their use of the song would clash with federal copyright law. Summary judgment for the defendants was affirmed. *Sinatra v. Goodyear Tire & Rubber Co.* If Midler were claiming a secondary meaning to “Do You Want To Dance” or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford’s use of “Do You Want To Dance,” and thus her claim is not preempted by federal copyright law. Copyright protects original works of authorship fixed in any tangible medium of expression. A voice is not copyrightable. The sounds are not fixed. What is put forward as protectible here is more personal than any work of authorship.

Sinatra: 435 F.2d 711 (9th Cir. 1970)

Bert Lahr once sued Adell Chemical Co. for selling Lestoil by means of a commercial in which an imitation of Lahr’s voice accompanied a cartoon of a duck. Lahr alleged that his style of vocal delivery was distinctive in pitch, accent, inflection, and sounds. The First Circuit held that Lahr had stated a cause of action for unfair competition, that it could be found “that defendant’s conduct saturated plaintiff’s audience, curtailing his market.” *Lahr v. Adell Chemical Co.* That case is more like this one. But we do not find unfair competition here. One-minute commercials of the sort the defendants put on would not

Lahr: 300 F.2d 256 (1st Cir. 1962)

have saturated Midler's audience and curtailed her market. Midler did not do television commercials. The defendants were not in competition with her.

California Civil Code section 3344 is also of no aid to Midler. The statute affords damages to a person injured by another who uses the person's "name, voice, signature, photograph or likeness, in any manner." The defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was Hedwig's, not hers. The term "likeness" refers to a visual image not a vocal imitation. The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law.

The companion statute protecting the use of a deceased person's name, voice, signature, photograph or likeness states that the rights it recognizes are "property rights." By analogy the common law rights are also property rights. Appropriation of such common law rights is a tort in California. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, what the defendants used in their television commercial for Winston cigarettes was a photograph of a famous professional racing driver's racing car. The number of the car was changed and a wing-like device known as a "spoiler" was attached to the car; the car's features of white pinpointing, an oval medallion, and solid red coloring were retained. The driver, Lothar Motschenbacher, was in the car but his features were not visible. Some persons, viewing the commercial, correctly inferred that the car was his and that he was in the car and was therefore endorsing the product. The defendants were held to have invaded a "proprietary interest" of Motschenbacher in his own identity.

Cal. Civ. Code. § 990(b)

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

Midler's case is different from *Motschenbacher's*. He and his car were physically used by the tobacco company's ad; he made part of his living out of giving commercial endorsements. But, as Judge Koelsch expressed it in *Motschenbacher*, California will recognize an injury from "an appropriation of the attributes of one's identity." It was irrelevant that *Motschenbacher* could not be identified in the ad. The ad suggested that it was he. The ad did so by emphasizing signs or symbols associated with him. In the same way the defendants here used an imitation to convey the impression that Midler was singing for them.

Why did the defendants ask Midler to sing if her voice was not of value to them? Why did they studiously acquire the services of a sound-alike and instruct her to imitate Midler if Midler's voice was not of value to them? What they sought was an attribute of Midler's identity. Its value was what the market would have paid for Midler to have sung the commercial in person.

A voice is more distinctive and more personal than the automobile accouterments protected in *Motschenbacher*. A voice is as distinctive

D. Ihde, *Listening and Voice* 77 (1976)

and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, “the other stands before me.” A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.

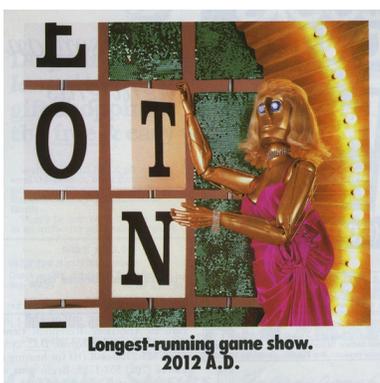
We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California. Midler has made a showing, sufficient to defeat summary judgment, that the defendants here for their own profit in selling their product did appropriate part of her identity.

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

Plaintiff Vanna White is the hostess of “Wheel of Fortune,” one of the most popular game shows in television history. An estimated forty million people watch the program daily. Capitalizing on the fame which her participation in the show has bestowed on her, White markets her identity to various advertisers.

The dispute in this case arose out of a series of advertisements prepared for Samsung by Deutsch. The series ran in at least half a dozen publications with widespread, and in some cases national, circulation. Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by depicting a raw steak with the caption: “Revealed to be health food. 2010 A.D.” Another depicted irreverent “news”-show host Morton Downey Jr. in front of an American flag with the caption: “Presidential candidate. 2008 A.D.”

The advertisement which prompted the current dispute was for Samsung videocassette recorders (VCRs). The ad depicted a robot, dressed in a wig, gown, and jewelry which Deutsch consciously selected to resemble White’s hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: “Longest-running game show. 2012 A.D.” Defendants referred to the ad as the “Vanna White” ad. Unlike the other



Samsung game show ad

celebrities used in the campaign, White neither consented to the ads nor was she paid.

Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under: (1) California Civil Code S 3344; (2) the California common law right of publicity; and (3) S 43(a) of the Lanham Act.

I. SECTION 3344

White first argues that the district court erred in rejecting her claim under section 3344. Section 3344(a) provides, in pertinent part, that “[a]ny 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.”

White argues that the Samsung advertisement used her “likeness” in contravention of section 3344. In *Midler*, this court rejected Bette Midler’s section 3344 claim concerning a Ford television commercial in which a Midler “sound-alike” sang a song which Midler had made famous. In rejecting Midler’s claim, this court noted that “the defendants did not use Midler’s name or anything else whose use is prohibited by the statute. The voice they used was another person’s, not hers. The term ‘likeness’ refers to a visual image not a vocal imitation.”

In this case, Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White’s precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a “likeness,” we agree with the district court that the robot at issue here was not White’s “likeness” within the meaning of section 3344. Accordingly, we affirm the court’s dismissal of White’s section 3344 claim.

II. RIGHT OF PUBLICITY

In *Carson v. Here’s Johnny Portable Toilets, Inc.*, the defendant had marketed portable toilets under the brand name “Here’s Johnny” – Johnny Carson’s signature “Tonight Show” introduction – without Carson’s permission. The sixth circuit held that the right was implicated because the defendant had appropriated Carson’s identity by using the phrase “Here’s Johnny.”

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

It is not important how the defendant has appropriated the plaintiff’s identity, but whether the defendant has done so. *Motschenbacher*, *Midler*, and *Carson* 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 appro-

priating identity merely challenges the clever advertising strategist to come up with the tenth.

Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. The right would fail to protect those plaintiffs most in need of its protection. Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

Consider a hypothetical advertisement which depicts 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. Now envision that this ad is run on television during professional basketball games. 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.

Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one. Indeed, defendants themselves referred to their ad as the "Vanna White" ad. We are not surprised.

Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof. We decline Samsung and Deutch's invitation to permit the evisceration of the common law right of publicity through means as facile as those in this case. Because White has alleged facts

showing that Samsung and Deutsch had appropriated her identity, the district court erred by rejecting, on summary judgment, White's common law right of publicity claim.

Alcaron, Circuit Judge, concurring in part, dissenting in part

The common theme in these federal cases is that identifying characteristics unique to the plaintiffs were used in a context in which they were the only information as to the identity of the individual. The commercial advertisements in each case showed attributes of the plaintiff's identities which made it appear that the plaintiff was the person identified in the commercial. No effort was made to dispel the impression that the plaintiffs were the source of the personal attributes at issue. The commercials affirmatively represented that the plaintiffs were involved. 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 as been appropriated.

The case before this court is distinguishable from the factual showing made in *Motschenbacher*, *Midler*, and *Carson*. 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.

White v. Samsung Electronics America, Inc.
989 F.2d 1512 (9th Cir. 1993)

Kozinski, Circuit Judge, dissenting from the order rejecting the suggestion for rehearing en banc

The majority isn't, in fact, preventing the "evisceration" of Vanna White's existing rights; it's creating a new and much broader property right, a right unknown in California law. It's replacing the existing balance between the interests of the celebrity and those of the public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her. After all, that's all Samsung did: It used an inanimate object to remind people of White, to "evoke [her identity]."¹⁷

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It's not the robot's wig, clothes or jewelry; there must be ten million blond women (many of them

¹⁷Some viewers might have inferred White was endorsing the product, but that's a different story. The right of publicity isn't aimed at or limited to false endorsements; that's what the Lanham Act is for.

quasi-famous) who wear dresses and jewelry like White's. It's that the robot is posed near the "Wheel of Fortune" game board. Remove the game board from the ad, and no one would think of Vanna White. But once you include the game board, anybody standing beside it – a brunette woman, a man wearing women's clothes, a monkey in a wig and gown – would evoke White's image, precisely the way the robot did. It's the "Wheel of Fortune" set, not the robot's face or dress or jewelry that evokes White's image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.¹⁸

This is entirely the wrong place to strike the balance. Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.

Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own.²¹

¹⁸Once the right of publicity is extended beyond specific physical characteristics, this will become a recurring problem: Outside name, likeness and voice, the things that most reliably remind the public of celebrities are the actions or roles they're famous for. A commercial with an astronaut setting foot on the moon would evoke the image of Neil Armstrong. Any masked man on horseback would remind people (over a certain age) of Clayton Moore. And any number of songs – "My Way," "Yellow Submarine," "Like a Virgin," "Beat It," "Michael, Row the Boat Ashore," to name only a few – instantly evoke an image of the person or group who made them famous, regardless of who is singing.

See also Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial*, L.A. Times, Jan. 18, 1990, at B3 (Adam West sues over Batmanlike character in commercial); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775, 1989 WL 407484 (C.D. Cal. 1989) (1950s TV movie hostess "Vampira" sues 1980s TV hostess "Elvira"); text accompanying notes 7-8 (lawsuits brought by Guy Lombardo, claiming big bands playing at New Year's Eve parties remind people of him, and by Uri Geller, claiming psychics who can bend metal remind people of him). Cf. *Motschenbacher*, where the claim was that viewers would think plaintiff was actually in the commercial, and not merely that the commercial reminded people of him.

²¹If Christian Slater, star of "Heathers," "Pump up the Volume," "Kuffs," and "Untamed Heart" – and alleged Jack Nicholson clone – appears in a commercial, can Nicholson sue? Of 54 stories on LEXIS that talk about Christian Slater, 26 talk about Slater's alleged similarities to Nicholson. Apparently it's his nasal wisecracks and killer smiles, St. Petersburg Times, Jan. 10, 1992, at 13, his eyebrows, Ottawa Citizen, Jan. 10, 1992, at E2, his sneers, Boston Globe, July 26, 1991, at 37, his menacing presence, USA Today, June 26, 1991, at 1D, and his sing-song voice, Gannett News Service, Aug. 27, 1990 (or, some say, his insinuating drawl, L.A. Times, Aug.

3 Procedures

The most interesting procedural issue raised by the right of publicity is its duration. The states agree that it lasts at least for the life of the person concerned. Some states recognize no postmortem right of publicity at all, while others have recognized one for terms of 20 years (Virginia) to 100 years (Oklahoma). Tennessee's is indefinite. *Hebrew University of Jerusalem v. General Motors* surveyed the states and discussed the policy issues in detail before settling on a term of life plus 50 years.

Hebrew University: 903 F. Supp. 2d 932 (C.D. Cal. 2012)

4 Infringement: Similarity

For a use to infringe, the plaintiff must be identifiable. This is effectively a similarity test between the defendant's use and the plaintiff's persona. Also, look back at the subject matter cases and the cases they discuss, especially *Motschenbacher*, which illustrate some variations on identifiability. Have the courts there conflated similarity with subject matter? Or is that precisely the point, that once identifiability is shown, there is no need for limiting subject-matter doctrines?

Hooker v. Columbia Pictures Industries, Inc.

551 F. Supp. 1060 (N.D. Ill. 1982)

Plaintiff is a professional woodcarver from Woodstock, Illinois. Examining the host of exhibits appended to the affidavit which he has submitted, it appears that while plaintiff does carve other birds, he specializes in ducks. Plaintiff's ducks are of the highest quality. Some of them are described as "exquisite" and sell for a great deal of money. Plaintiff's name is T.J. Hooker.

The defendants produce and broadcast a television series about a fictional policeman in California. Never having heard of plaintiff or his celebrated ducks, the defendants happened to name their imaginary policeman "T.J. Hooker." Not surprisingly, the series is also entitled "T.J. Hooker."

Count I of the complaint is based upon the common law tort of appropriation of the plaintiff's name or likeness for the defendants' benefit or advantage. In order to state a claim for relief based on this theory, it is vital that some "appropriation" be alleged. See W. Prosser, *Law of Torts* § 117 (4th ed. 1971). "Appropriation" in this context means more than the mere coincidental use of a name that happens to be the same as that of the plaintiff. Dean Prosser explained this as follows:

It is the plaintiff's name as a symbol of his identity that is involved here, and not as a mere name. Unless there

22, 1990, at F5). That's a whole lot more than White and the robot had in common.

Not to be confused with the *T.J. Hooper*



William Shatner in *T.J. Hooker*

is some tortious use made of it, there is no such thing as an exclusive right to the use of a name; and any one can be given or assume any name he likes. It is only when he makes use of the name to pirate the plaintiff's identity for some advantage of his own, as by impersonation to obtain credit or secret information, or by posing as the plaintiff's wife, or providing a father for a child on a birth certificate, that he becomes liable. It is in this sense that "appropriation" must be understood. It is therefore not enough that a name which is the same as the plaintiff's is used in a novel, or the title of a corporation, unless the context or the circumstances indicate that the name is that of the plaintiff.... Nor is there any liability when the plaintiff's character, occupation, and the general outline of his career, with many real incidents in his life, are used as the basis for a figure in a novel who is still clearly a fictional one.

Similarly, the Restatement of Torts makes it clear that it is not the use of the plaintiff's name which constitutes a tort but rather the appropriation of the value of his name and reputation:

It is not enough that the defendant has adopted for himself a name that is the same as that of the plaintiff, so long as he does not pass himself off as the plaintiff or otherwise seek to obtain for himself the values or benefits of the plaintiff's name or identity. Unless there is such an appropriation, the defendant is free to call himself by any name he likes, whether there is only one person or a thousand others of the same name. *Until the value of the name has in some way been appropriated, there is no tort.*

Examining Count I in light of the foregoing principles, it is apparent that plaintiff has failed to allege a tortious appropriation of his name. Plaintiff does allege that "[d]efendants' ... use of plaintiff's name appropriates the right of publicity in plaintiff's celebrated name." But this broad, conclusory allegation cannot substitute for allegations of facts showing that the defendants used the name "T.J. Hooker" as a means of pirating plaintiff's identity. By his own admission, the commercial value of plaintiff's name is in the field of wildlife art. Hunters, sportsmen, and collectors identify plaintiff's name with fine carvings of ducks and other fowl. There is nothing in the complaint which can be construed as an allegation that the defendants adopted the name "T.J. Hooker" in order to avail themselves of plaintiff's reputation as an extraordinary woodcarver.

Plaintiff admits that the fictional television series at issue here is a "police drama." It is difficult to imagine a subject further removed

Suppose that the plaintiff were the star of a long-running top-rated reality show about woodcarving. Same result?

for the life of T.J. Hooker the artisan. The facts and circumstances alleged by plaintiff provide no basis upon which it can be found that the name “T.J. Hooker,” as used in the defendants’ fictional television series, in any way refers to the real T.J. Hooker.

There being no well-pleaded allegation of appropriation of the value of plaintiff’s name, plaintiff has failed to state a claim upon which relief can be granted.

5 Infringement: Prohibited Conduct

a Direct Infringement

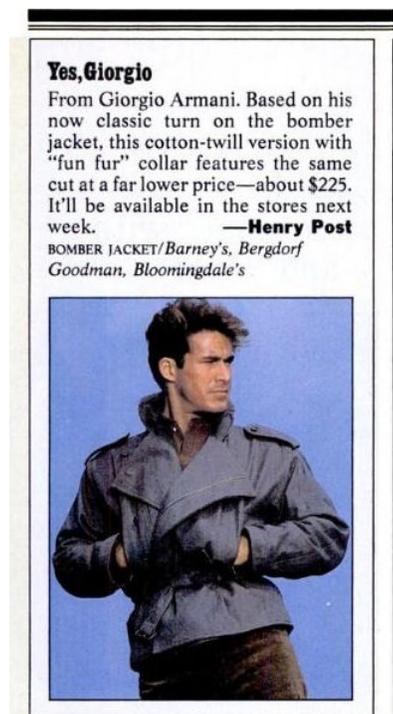
The usual threshold rule is that the right of publicity only applies to commercial and advertising uses. The caselaw is thin on whether violations need to be intentional.

Stephano v. News Group Publications, Inc.

64 N.Y.2d 174 (1984)

The plaintiff, a professional model, claims that the defendant used his picture for trade or advertising purposes without his consent, and thus violated his statutory right to privacy (Civil Rights Law, § 51), by publishing a picture of him modeling a “bomber jacket” in a magazine article containing information regarding the approximate price of the jacket, the name of the designer, and the names of three stores where the jacket might be purchased. Plaintiff also claims that the defendant’s conduct violated a common-law right of publicity. The trial court granted summary judgment to the defendant concluding that the article reported a newsworthy event of fashion news, and was not published for trade or advertising purposes. A divided Appellate Division reversed and denied summary judgment finding that factual questions were presented as to whether the defendant had used the plaintiff’s picture for trade purposes and whether the article constituted an advertisement in disguise.

In the summer of 1981 the plaintiff agreed to model for an article on men’s fall fashions. The photographic session took place on August 11, 1981. The defendant used two of the photographs taken during that session to illustrate an article entitled “Classic Mixes”, which appeared under the heading “Fall Fashions” in the September 7, 1981 issue of New York magazine. Another photograph taken during the session was used, a week earlier, in the August 31, 1981 issue of New York magazine, in a column entitled “Best Bets”. That column, a regular feature in the magazine, contains information about new and unusual products and services available in the metropolitan area. One of the items included in the August 31 column was a bomber jacket modeled by the plaintiff. The text above the picture states: “Yes Giorgio — From Giorgio Armani. Based on his now classic turn on the



The “Best Bets” item featuring Stephano

bomber jacket, this cotton-twill version with 'fun fur' collar features the same cut at a far lower price — about \$225. It'll be available in the stores next week. — Henry Post Bomber Jacket/Barney's, Bergdorf Goodman, Bloomingdale's."

It is the plaintiff's contention that he agreed to model for one article only – the September 7, 1981 article on Fall Fashions – and that the defendant violated his rights by publishing his photograph in the August 31 "Best Bets" column.¹ The complaint alleges two causes of action. First the plaintiff claims that the defendant violated his civil rights by using his photograph for trade or advertising purposes without his consent. In his second cause of action the plaintiff claims that the defendant's conduct "invaded plaintiff's right of publicity". On each cause of action the plaintiff seeks \$350,000 in compensatory damages and an equal amount in exemplary damages.

The only question is whether the defendant used the plaintiff's picture for trade or advertising purposes within the meaning of the statute when it published his picture in the "Best Bets" column without his consent.

The statute does not define trade or advertising purposes. However, the courts have consistently held, from the time of its enactment, that these terms should not be construed to apply to publications concerning newsworthy events or matters of public interest. The exception reflects Federal and State constitutional concerns for free dissemination of news and other matters of interest to the public, but essentially requires an interpretation of the statute to give effect to the legislative intent. We have recently noted that this exception should be liberally applied.

The newsworthiness exception applies not only to reports of political happenings and social trends but also to news stories and articles of consumer interest including developments in the fashion world. Nevertheless, the plaintiff contends that the photograph in this case did not depict a newsworthy event because it is a posed picture of a professional model taken at a photographic session staged by the defendant. However, the event or matter of public interest which the defendant seeks to convey is not the model's performance, but the availability of the clothing item displayed. A fashion display is,

¹In his brief to this court the plaintiff claims that the defendant's use of his photographs in both articles is in issue because the plaintiff did not give his written consent to use them in either article. It appears that the plaintiff was injured at the photographic session and subsequently refused to sign a release in order to avoid compromising the unrelated action for physical injuries. Nevertheless, in his complaint, he only objected to the August 31 "Best Bets" article. Similarly, in his papers in opposition to the motion for summary judgment, the plaintiff identified that publication alone as the basis for the complaint. Thus the only question properly before us concerns the defendant's liability for publishing the plaintiff's photograph in the "Best Bets" article of August 31, 1981.

of necessity, posed and arranged. Obviously the picture of the jacket does not lose its newsworthiness simply because the defendant chose to employ a person to model it in a controlled or contrived setting.

The fact that the defendant may have included this item in its column solely or primarily to increase the circulation of its magazine and therefore its profits, as the Appellate Division suggested, does not mean that the defendant has used the plaintiff's picture for trade purposes within the meaning of the statute. Indeed, most publications seek to increase their circulation and also their profits. It is the content of the article and not the defendant's motive or primary motive to increase circulation which determines whether it is a newsworthy item, as opposed to a trade usage, under the Civil Rights Law. It is settled that a picture illustrating an article on a matter of public interest is not considered used for the purposes of trade or advertising within the prohibition of the statute unless it has no real relationship to the article or unless the article is an advertisement in disguise. A contrary rule would unreasonably and unrealistically limit the exception to nonprofit or purely altruistic organizations which are not the only, or even the primary, source of information concerning newsworthy events and matters of public interest.

The plaintiff's primary contention is that his picture was used for advertising purposes within the meaning of the statute. Although the article was not presented to the public as an advertisement, and was published in a column generally devoted to newsworthy items, the plaintiff claims that it is in fact an advertisement in disguise.

The facts on which the plaintiff relies are entirely circumstantial. He does not claim to have personal knowledge, or direct proof, that this particular article was actually published by the defendant for advertisement purposes. The circumstances on which he bases his claim are (1) the fact that the news column contains information normally included in an advertisement identifying the designer of the jacket, the approximate price, and three places where the jacket may be purchased, and (2) the fact that some or all of those stores mentioned in the article had previously advertised products in the magazine. Those circumstances are not enough to raise a jury question as to whether the article was published for advertising purposes.

The plaintiff does not dispute the fact that the information provided in the article is of legitimate reader interest. Indeed, similar information is frequently provided in reviews or news announcements of books, movies, shows or other new products including fashions. Nor does the plaintiff contend that it is uncommon for commercial publishers to print legitimate news items or reviews concerning products by persons or firms who have previously advertised in the publisher's newspaper or magazine. In short, the plaintiff has not presented any facts which would set this particular article apart from

the numerous other legitimate news items concerning new products. He offers only his speculative belief that in this case the information on the jacket was included in the defendant's column for advertising purposes or perhaps, more vaguely, to promote additional advertising. That, in our view, is insufficient to defeat the defendant's motion for summary judgment. The rule exempting articles of public interest from the operation of the Civil Rights Law would, as a practical matter, lose much of its force if publishers of articles which are at least prima facie newsworthy were required to incur the expense of a trial to meet such general and insubstantial accusations of disguised advertising. ...

Finally, it should be emphasized that we do not mean to suggest that a publisher who has employed a professional model to pose for pictures to be used in an article may avoid the agreed fee, or otherwise ignore contractual arrangements, if the model's pictures are used to illustrate a newsworthy article or one involving matters of public interest. Although the complaint alludes to an agreement between the parties, the plaintiff has not sought to enforce a contract or recover damages for a breach. Since the plaintiff chose to frame his complaint entirely in terms of rights covered by the Civil Rights Law, which we have concluded is not applicable in this case, the complaint should be dismissed.

Washington v. Brown & Williamson Tobacco Corp.

1984 WL 63629223, U.S.P.Q. 1116 (E.D. Pa. 1984)

Grover Washington, Jr., a well-known jazz saxophonist, alleges an advertising campaign invaded his right of publicity and contains false representation of sponsorship. The advertisements at issue were prepared as part of a "Kool" cigarette campaign and include photographs of an individual whom plaintiff claims looks like him. As a result of this alleged resemblance, it is asserted that the defendants have falsely represented to the public that the plaintiff endorses Kools and have appropriated for themselves the commercial value of plaintiff's image and likeness. Plaintiff has asserted claims for false representation and designation of sponsorship under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and has also asserted pendent state claims for violation of his right of publicity, unjust enrichment, and quantum meruit.

The gist of the campaign was to display various musicians photographed playing instruments with the Kool logo and advertising copy superimposed upon the photographs. The music theme was selected because of the perception that music conveyed a positive image that would appeal to a broad selection of consumers. In particular, jazz was believed to offer the broadest possible appeal because it allowed the most personal interpretation for the viewer. (Dearth dep.



Grover Washington, Jr.

at 33).

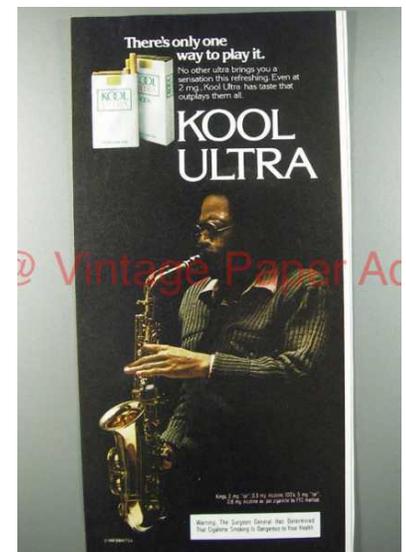
After the theme had been decided upon, studio photographs were taken of various musicians playing their instruments. Actual musicians were used, rather than models, because it was believed that musicians would enhance the realism of the advertisements.

Among those picked was Ronald L. Brown, the individual whose photograph the plaintiff alleges bears a likeness to him. Brown is a professional musician who is accomplished in playing the saxophone, among other instruments. He was selected to appear in the advertisements because he looked "appropriate." [Three employees,] Lewis, Dearth, and Vail, had the primary responsibility for the creation and development of the campaign. None had ever seen Grover Washington or his photographs. In fact, of these three individuals only Lewis had ever heard of the plaintiff prior to the commencement of this litigation.

In January, 1982, the defendants began their music campaign nationwide, with advertisements appearing in newspapers, magazines, and on bill boards. The two advertisements at issue were among those initially circulated. These advertisements show a black male, with short hair and a beard playing the saxophone. In one, Brown is photographed from the side and is standing relatively erect in an open collar white shirt. In the other, he is again photographed from the side, but is bent forward and is wearing a tweed coat. After viewing these advertisements, plaintiff commenced this action.

Defendants have premised their motion for summary judgment upon their assertion that it is undisputed the resemblance between the photograph of Ronald Brown and plaintiff was wholly coincidental because the individuals responsible for the creation and development of the campaign had never seen the plaintiff or his picture prior to the commencement of this litigation. Therefore, they argue, there was no intent to either confuse the public as to the plaintiff's sponsorship of their product or invade plaintiff's right of publicity.

Admittedly, the case at bar presents a close question. In their depositions, Vail, Dearth, and Lewis stated that they had never seen plaintiff or his photograph at the time they were developing the Kool advertising campaign. Not surprisingly, plaintiff has been unable to rebut this assertion directly since information relating to an individual's state of mind is generally within that person's exclusive knowledge. Instead, plaintiff relies upon circumstantial evidence which he contends demonstrates that in fact the defendants intentionally chose Ronald Brown's photograph to lead the public to believe that plaintiff endorsed the advertised products. Specifically, plaintiff points to his solicitation by agents of Brown & Williamson to perform in the Kool Jazz Festival, an alleged pattern of displaying the disputed advertisement in cities in which plaintiff performed during the summer



Kool ad featuring Ronald L. Brown

Compare *Flake v. Greensboro News Co.*, 195 S.E. 55 (N.C. 1938), where the defendant published an ad reading "Keep that Sylph-Like Figure by eating more of Melt's Rye and Whole Wheat Bread, says Mlle. Sally Payne, exotic red haired Venus" but by mistake used a photograph of Nancy Flake rather than one of Sally Payne. The court held, "Upon the present record, from which it appears that said photograph was used by mistake and without malice and that the defendants immediately desisted from the use thereof upon the discovery of the mistake and made due apology therefor, the plaintiff would be entitled to a judgment for nominal damages only."



Greensboro Daily News ad misidentifying Nancy Flake as Sally Payne

of 1982, and the use of Milt Jackson, another renowned jazz musician, as a model for the advertising campaign, as well as a host of other relatively minor factual issues. However speculative they may be, the inferences to be drawn from such facts are not questions for the court to resolve. The task of making factual inferences must be done by the jury. Moreover, because the issue of intent is a material fact, the jury must be given an opportunity to observe the demeanor of Vail, Dearth, and Lewis to evaluate the credibility of each.

One final issue must be addressed. Defendants argue that the first amendment protects against liability where the cause of action is based on a coincidental, unintended resemblance. Obviously, this begs the question of whether the resemblance is in fact coincidental. If it is ultimately determined that the defendants intentionally chose the photographs of Ronald Brown in an effort to avail themselves of the commercial value of plaintiff's likeness, the first amendment would not provide the absolute protection defendants seek. False or misleading advertising is not within the ambit of absolute first amendment protection.

b Secondary Liability

As with false advertising, there's not a thick body of caselaw on secondary liability for right of publicity violations, but there is enough to sketch its contours.

Perfect 10, Inc. v. Cybernet Ventures, Inc.

213 F.Supp.2d 1146 (C.D. Cal. 2002)

[Perfect 10 sold "'classy' pictures of nude women without breast implants, cosmetic surgery, or the like" in a magazine and website. Cybernet provided age-verification services for more than 300,000 pornographic websites. According to Perfect 10, approximately 900 of those sites displayed Perfect 10's images without permission. Many of the models in those photographs had assigned their rights of publicity to Perfect 10.

On copyright, the court held that Cybernet did not directly infringe Perfect 10's copyrights but could potentially be liable as a contributory or a vicarious infringer, and that it was unlikely that Cybernet qualified for the § 512(c) safe harbor for various reasons, including that it had failed to reasonably implement a policy to terminate repeat infringers.]

Neither party contests that third parties operating under the Adult Check name have infringed the rights of publicity assigned to Perfect 10 by a number of models. . Nor does either party suggest that direct liability would not be appropriate against those third-parties under either theory. Similarly, Perfect 10 does not assert any direct

liability theory against Cybernet. The likelihood of success thus boils down to a question of “aiding and abetting.”

California has adopted the joint liability principle laid out in the Restatement (Second) of Torts § 876. Under the Restatement,

For harm resulting to a third person from the tortious conduct of another, one is subject to liability if he:

- a) does a tortious act in concert with the other in pursuit to a common design with him, or
- b) knows that the other’s conduct constitutes a breach of duty and gives substantial assistance or encouragement so to conduct himself, or
- c) gives substantial assistance to the other in accomplishing a tortious result and his own conduct, separately considered, constitutes a breach of duty to the third person.

Cybernet argues that there is no case directly recognizing the applicability of this doctrine to the right of publicity torts. The Court finds this argument unpersuasive, as the Restatement provides a background principle for all tort liability in the state of California.

Nor does the Court find convincing Cybernet’s argument that the right of publicity itself contains an actual knowledge requirement. Cybernet’s citations refer to the requirement that broadcasters of advertisements must have actual knowledge before they can be held liable. Cybernet does not claim to be a medium used for advertising, and the Court only focuses on rights of publicity infringements located on the websites, not infringements associated with webmaster banner ads. Rather, Cybernet argues that the knowledge requirement of section 3344(f) is a requirement for “aider and abettor” liability under the statute.

The Court concludes otherwise. Although section 3344(f) provides clear evidence that secondary liability can be imposed for violations of publicity rights, it also provides evidence that the California legislature created a heightened knowledge requirement limited to broadcasters of advertisements. The California legislature has not extended this requirement to defendants like Cybernet. The Court therefore defaults to the background assumption that secondary liability applies to right of publicity claims and it is to be found in conformance with the requirements established in the Restatement.

Perfect 10 has primarily focused its secondary theory of liability on the second branch of the Restatement, requiring actual knowledge of the tortious conduct and substantial participation. The Court agrees with Perfect 10 that there is a serious question on the merits of the substantial participation prong. As it stands, in the absence of ar-

gument to the contrary, the Court looks to the contributory infringement framework of copyright trademark law, where it has already found just such participation, thus leading the Court to conclude Perfect 10 has established a strong likelihood of success with regard to Cybernet's substantial participation.

The Court recognizes that application of secondary liability principles is particularly applicable for claims of unfair competition, as the California Supreme Court recognized as far back as 1935: "When a scheme is evolved which on its face violates the fundamental rules of honesty and fair dealing, a court of equity is not impotent to frustrate the consummation because the scheme is an original one." *American Philatelic Soc'y v. Claibourne*

American Philatelic: 46 P.2d 135 (1935)

In *American Philatelic*, a purveyor of stamps altered his normal stamps to resemble rare perforated stamps. He then sold these stamps to stamp dealers with clear notice that the stamps were not of the rare variety. Nevertheless, his sales brochures and pricing established that he both anticipated and effectively encouraged these dealers to sell the stamps to the public as rare stamps. The California Supreme Court had no problem finding these claims stated a claim under the unfair competition law. *American Philatelic's* equity language reinforce the Court's conclusion that Perfect 10's theory of aiding and abetting liability for Cybernet based on third-party violations of various rights of publicity has a strong likelihood of success.

6 Defenses

The types of defenses to the right of publicity should be familiar by now. First sale applies, but pay attention to the details. And there are also defenses for newsworthy uses and for creative ones. Very, very, very loosely, newsworthiness incorporates some of the same concerns as descriptive and nominative fair uses. Again, pay attention to the details; things may be different here than elsewhere.

Allison v. Vintage Sports Plaques

136 F.3d 1443 (11th Cir. 1998)

The issue presented in this case is whether the "first-sale doctrine," a well-established limitation on intellectual property rights, applies to the common-law right of publicity. We hold that it does. Accordingly, we affirm the district court, which granted summary judgment to the defendant.

Elisa Allison is the widow of Clifford Allison, a well-known race-car driver. Orel Hershisher is a well-known professional baseball player. [Both Clifford Allison and Hershisher had licensing contacts for trading cards.]

Vintage Sports Plaques ("Vintage") purchases trading cards from

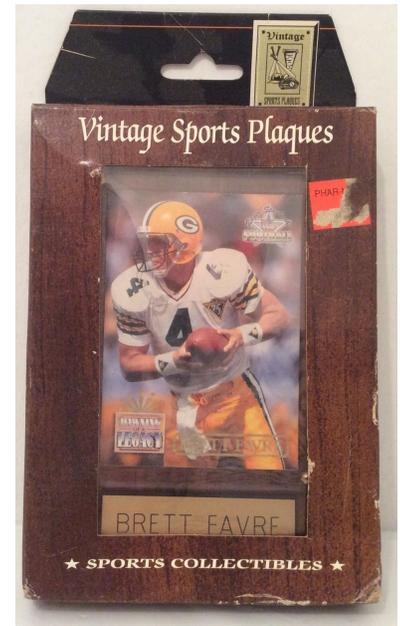
licensed card manufacturers and distributors and, without altering the cards in any way, frames them by mounting individual cards between a transparent acrylic sheet and a wood board. Vintage then labels each plaque with an identification plate bearing the name of the player or team represented. In addition to the mounted trading card, some of the plaques feature a clock with a sports motif. Vintage markets each plaque as a "Limited Edition" and an "Authentic Collectible." Vintage is not a party to any licensing agreement that grants it the right to use the appellants' names or likenesses for commercial purposes and has never paid a royalty or commission to the appellants for its use of their names or images. Appellants presumably have received, however, pursuant to their respective licensing agreements, royalties from the card manufacturers and distributors for the *initial* sale of the cards to Vintage.

Appellants argue that we should not apply the first-sale doctrine to common-law actions to enforce the right of publicity. There is virtually no case law in any state addressing the application of the first-sale doctrine to the right of publicity, perhaps because the applicability of the doctrine is taken for granted.⁸

Appellants argue that the right of publicity differs from other forms of intellectual property because the former protects "identity," whereas the latter protect "a particular photograph or product." The first-sale doctrine should not apply, they reason, because a celebrity's identity continues to travel with the tangible property in which it is embodied after the first sale. We find two significant problems with appellants' argument. First, the distinction that appellants draw between what is protected by the right of publicity and what is protected by other forms of intellectual property rights, such as copyright, is not sound. Copyright law, for example, does not exist merely to protect the tangible items, such as books and paintings, in which the underlying expressive material is embodied; rather, it protects as well the author's or artist's *particular* expression that is included in the tangible item. The copyright law thus would be violated not only by directly photocopying a protected work, but also by publishing language or images that are substantially similar to that contained in the copyrighted work.

Second, and more important in our view, accepting appellants' argument would have profoundly negative effects on numerous industries and would grant a monopoly to celebrities over their identities that would upset the delicate balance between the interests of the celebrity and those of the public. Indeed, a decision by this court not to apply the first-sale doctrine to right of publicity actions would ren-

⁸We note that some states that statutorily have recognized a right of publicity have codified the first-sale doctrine.



Vintage Sports Plaque

der tortious the resale of sports trading cards and memorabilia and thus would have a profound effect on the market for trading cards, which now supports a multi-billion dollar industry. Such a holding presumably also would prevent, for example, framing a magazine advertisement that bears the image of a celebrity and reselling it as a collector's item, reselling an empty cereal box that bears a celebrity's endorsement, or even reselling a used poster promoting a professional sports team. Refusing to apply the first-sale doctrine to the right of publicity also presumably would prevent a child from selling to his friend a baseball card that he had purchased, a consequence that undoubtedly would be contrary to the policies supporting that right.

A holding that the first-sale doctrine does limit the right of publicity, on the other hand, would not eliminate completely a celebrity's control over the use of her name or image; the right of publicity protects against unauthorized use of an image, and a celebrity would continue to enjoy the right to license the use of her image *in the first instance* – and thus enjoy the power to determine when, or if, her image will be distributed.

The issue before us, then, is whether the district court properly resolved as a matter of law that Vintage's plaques merely are the cards themselves repackaged, rather than products separate and distinct from the trading cards they incorporate. If they are the latter, as appellants contend that they are, then arguably Vintage is selling a product by commercially exploiting the likenesses of appellants intending to engender profits to their enterprise, a practice against which the right of publicity seems clearly to protect.

We conclude that the district court properly determined that, as a matter of law, Vintage merely resells cards that it lawfully obtains. We think it unlikely that anyone would purchase one of Vintage's plaques for any reason other than to obtain a display of the mounted cards themselves. Although we recognize that the plaques that include a clock pose a closer case, we conclude that it is unlikely that anyone would purchase one of the clock plaques simply to obtain a means of telling time, believing the clock to be, for example, a "Her-shisher Clock" or an "Allison Clock."

Rosa and Raymond Parks Institute for Self Development v. Target Corp.
90 F. Supp. 3d 1256 (M.D. Ala. 2015)

The Parks Institute is a Michigan 501(c)(3) corporation that owns the name and likeness of the late Rosa Parks. Rosa Parks, who was African-American, became an icon of the Civil Rights movement when she refused to surrender her seat to a white passenger on a racially segregated Montgomery, Alabama bus. Her actions ignited the Montgomery Bus Boycott. Target is a national retail corporation headquartered in Minneapolis, Minnesota. Target operates

more than 1,800 retail stores across the United States, as well as an e-commerce website.

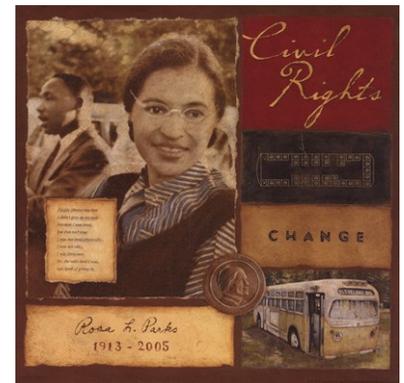
Beginning in 2009, Target offered for sale a collage-styled plaque in a limited number of its retail stores. The plaque contained the following images, as described by its creator Stephanie Workman Marrott: (1) a stylized rendering of the phrase "Civil Rights"; (2) an illustrated exhibit submitted in *Browder v. Gayle*, depicting where Rosa Parks was sitting on the bus prior to her arrest; (3) a stylized rendering of the word "Change"; (4) an illustration of the Cleveland Avenue bus; (5) a stylized rendering of Rosa Parks's name and dates of birth and death; (6) a picture of Rosa Parks's Congressional Gold Medal; (7) a photograph of Rosa Parks and Martin Luther King, Jr.; and (8) an inspirational statement made by Rosa Parks. It was this plaque that Elaine Steele, co-founder of the Parks Institute, and Anita Peek, Executive Director of the Parks Institute, discovered when they visited a number of Target retail stores located in the state of Michigan.

Upon realizing that Target was selling a plaque adorned with images of and related to Rosa Parks, the Parks Institute filed this lawsuit on November 6, 2013. Following a period of discovery, it became clear that the lawsuit challenged Target's sale of eight items in addition to the plaque: 1) the book *Rosa Parks: My Story*, by authors Rosa Parks and Jim Haskins; 2) the book *Who Was Rosa Parks?*, by author Yona Zeldis McDonough and illustrator Nancy Harrison; 3) the book *Rosa Parks (Childhood of Famous Americans)*, by author Kathleen Kudlinkski and illustrator Maryl Henderson; 4) the book *Rosa Parks*, by author Eloise Greenfield and illustrator Gil Ashby; 5) the book *A Picture Book of Rosa Parks*, by author David A. Adler and illustrator Robert Casilla; 6) the book, *The Rebellious Life of Mrs. Rosa Parks*, by author Jeanne Theoharis; 7) the book *The Story of Rosa Parks*, by author Patricia A. Pingry and illustrator Steven Walker; and 8) the American television movie *The Rosa Parks Story*, written by Paris Qualles and directed by Julie Dash.

Target argues that under Michigan law – and Alabama law – summary judgment is proper as to all of the Parks Institute's claims because the plaque and biographical works are protected fully by the First Amendment as biographical works that concern matters of legitimate public interest. In opposition, the Parks Institute argues that Target's "reliance on the First Amendment as protection for its action in this case is misplaced." Specifically, the Parks Institute avers that there is no legal precedent that would allow Target to exploit Rosa Parks's image or likeness for its own commercial purposes.

Michigan law is fairly limited with regard to actions alleging the unlawful commercial exploitation of a celebrity or public figure's identity. See *Ruffin-Steinback v. dePasse* (discerning how Michigan courts would address a claim for unlawfully depicting a public fig-

Browder: 142 F. Supp. 707 (M.D. Ala. 1956)



Rosa Parks plaque

Ruffin-Steinback: 82 F. Supp. 2d 723 (E.D. Mich. 2000)

ure's life story without consent by looking to "all available sources" because the Michigan Supreme Court had not spoken to the issue). In 2000, however, the Michigan federal district court in *Ruffin-Steinback* addressed "state law tort claims for violation of the right of publicity, unjust enrichment, negligence, conspiracy, invasion of privacy, defamation and intentional infliction of emotional distress" brought by the heirs and personal representatives of members of the Temptations music group and associated individuals. In that case, the plaintiffs challenged the National Broadcasting Company's airing of a two-night mini-series covering the story of the Temptations. The mini-series was told from the perspective of Otis Williams, one of the group's founding members, but covered the lives of each of the group's members in detail.

[The *Ruffin-Steinback* court referred to Restatement (Third) of Unfair Competition § 47]:

The name, likeness, and other indicia of a person's identity are used for the purposes of trade under the rule stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use for the purposes of trade does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.

The court also noted that comment c to S 47 states that "the right of publicity is not infringed by the dissemination of an unauthorized print or broadcast biography."

After looking to the Restatement, the court surveyed case law and confirmed that courts in various jurisdictions treated unlicensed works of biography similarly. Across jurisdictions, courts had been reluctant "to extend the right of publicity to depictions of life-stories based on First Amendment considerations." *Id.* Accordingly, the court concluded that "Michigan courts would not extend [the] right of publicity tort" to prohibit biographical works and, ultimately, dismissed all of the derivative claims – unjust enrichment, conspiracy, and negligence – finding that they were dependent on the plaintiffs' right of publicity claims.

In this case, the Parks Institute is challenging Target's sale of eight biographical works, the majority of which are simplified accounts of Rosa Parks's life and accomplishments written to educate children about the Civil Rights movement and to demonstrate how one courageous individual can bring about significant change. The Parks Institute does not claim that any of the biographical works cast Rosa

Parks in a false or defamatory light – separate causes of action for the dissemination of inaccurate information. Rather, it bases the entirety of its lawsuit on the idea that the First Amendment does not extend to protect the unapproved commercial sale of items that depict the name, likeness, story, or image of Rosa Parks.

For the reasons discussed at length in *Ruffin-Steinback*, however, the Parks Institute is mistaken. The depiction of Rosa Parks's life story without the Parks Institute's consent does not violate the Parks Institute's ownership rights to Rosa Parks's name or likeness. To quote from one of the biographical works at issue, Rosa Parks is perhaps the most iconic heroine of the civil rights movement. And, as both parties agree, one cannot talk about the Civil Rights movement without including Rosa Parks. The importance of her story serves as an apt reminder of why First Amendment protection for biographical works is so vital.

Target's sale of the seven books and one movie does not violate the Parks Institute's ownership rights in Rosa Parks's name or likeness because they are biographical works. Accordingly, summary judgment is due to be entered in favor of Target as to those eight items on the Parks Institute's right of publicity claim, as well as the unjust enrichment and misappropriation claims since they are derivative causes of action.

Because the collage-styled plaque is less of a biographical work and more akin to a work of art, the legality of Target's sale of the plaque requires a separate analysis. The Michigan Supreme Court has recognized that a plaintiff may bring suit for the misappropriation of his or her name or likeness under its invasion of privacy tort. This cause of action is founded upon the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or to others. Because the tort has the potential to offer a troublingly broad swath of protection, however, courts that have recognized the appropriation tort have also uniformly held that the First Amendment bars appropriation liability for the use of a name or likeness in a publication that concerns matters that are newsworthy or of legitimate public concern.

The question whether a publication is sufficiently a matter of public interest to be protected by the privilege is ordinarily decided by the court as a question of law. To make the decision, a court must examine the nature of the appropriation. For while a defendant can be liable for the tort of misappropriation of likeness if defendant's use of plaintiff's likeness was for a predominately commercial purpose, the First Amendment will protect the appropriation if it has a redeeming public interest, news, or historical value.

No doubt Target's sale of the plaque served a commercial purpose.

Battaglieri: 680 N.W.2d 915 (Mich. Ct. App. 2004)

Michigan courts, however, have applied the legitimate public interest privilege to instances where the misappropriation occurred for the purposes of making a profit. *See, e.g., Battaglieri v. Mackinac Center For Public Policy* (finding that a fundraising letter was within the privilege when it used quotes from the plaintiff without his consent because the quotes spoke to important policy issues). Additionally, the legitimate public interest exception does not merely extend to cover current events, as matters related to education and information are within the scope of legitimate concern. As provided by the Restatement (Second) of Torts:

Restatement (Second) Torts S 652D, comment j

The scope of a matter of legitimate concern to the public is not limited to "news," in the sense of current events or activities. It extends also to the use of names, likenesses or fact in giving information to the public for purposes of education, amusement or enlightenment, when the public may reasonably be expected to have a legitimate interest in what is published.

Armstrong: 655 F. Supp. 2d 779 (E.D. Mich. 2009)

Expanding on this idea, a federal district court applying Michigan law explained that the "First Amendment privilege does not only extend to news in the sense of current events, but extends far beyond to include all types of factual, educational, and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general." *Armstrong v. Eagle Rock Entm't, Inc.*

Applying these principles, the court found that Eagle Rock Entertainment's decision to use Louis Armstrong's picture on the cover liner of its DVD entitled, "Mahavishnu Orchestra, Live at Montreux, 1984, 1974," without consent was protected by the First Amendment. Specifically, under Michigan law, the court concluded that the DVD and its packaging had an historical and entertainment value for jazz fans everywhere. Michigan law and the First Amendment require a similar determination in this case.

The collage-styled plaque contains several elements reminiscent of the historic Civil Rights movement. In fact, by including a picture of Rosa Parks and Martin Luther King, Jr., alongside stylized renderings of the words "Civil Rights" and "Change," Stephanie Workman Marrott, the plaque's creator, sought to inspire viewers to "stand up for what they believe is right" while telling the important story of Rosa Parks's courage during the Civil Rights movement. There can be no doubt that Rosa Parks and her involvement in the Civil Rights movement are matters of utmost importance, both historically and educationally. Accordingly, just as Louis Armstrong's image is significant to the history of jazz, Rosa Parks's name and image are historically significant to the fight for equality in the South. Because Target's sale of the collage-style plaque is protected by the First Amend-

ment, Target is entitled to summary judgment on all of the Parks Institute's claims regarding the plaque, in addition to the biographical works.

No Doubt v. Activision Publishing, Inc.

122 Cal. Rptr. 3d 397 (Ct. App. 2011)

The rock band No Doubt brought suit against the video game publisher Activision Publishing, Inc. (Activision), based on Activision's release of the Band Hero video game featuring computer-generated images of the members of No Doubt. Applying the transformative use test first adopted in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, we conclude that the creative elements of the Band Hero video game do not transform the images of No Doubt's band members into anything more than literal, fungible reproductions of their likenesses. Therefore, we reject Activision's contention that No Doubt's right of publicity claim is barred by the First Amendment. In addition, we disagree with Activision's contention that No Doubt must demonstrate that Activision used the likenesses of the band members in an "explicitly misleading" way in order to prevail on its unfair competition claim.

Comedy III: 21 P.3d 797 (2001)

FACTUAL AND PROCEDURAL BACKGROUND

Defendant Activision is a leading international video game distributor and the creator and owner of the interactive Band Hero video game. The game allows players to simulate performing in a rock band in time with popular songs. By choosing from a number of playable characters, known as "avatars," players can "be" a guitarist, a singer, or a drummer. Some of the available avatars are fictional characters created and designed by Activision while others are digital representations of real-life rock stars. Players can also design their own unique fictional avatars. Represented by the avatars of their choosing, players "perform" in various settings, such as venues in Paris and Madrid, a rock show at a shopping mall, and even outer space.

In addition to allowing players to perform over 60 popular songs, Band Hero permits players to create their own music and then play their compositions using an avatar. As with all the Guitar Hero video games, as players advance in the Band Hero game, they can "unlock" characters and use them to play songs of the players' choosing, including songs the players have composed as well as songs made famous by other artists.

Plaintiff No Doubt is an internationally recognized rock band featuring Gwen Stefani as its lead singer. No Doubt entered into a professional services and character licensing agreement (Agreement) with Activision permitting Activision to include No Doubt as one of the



Band Hero screenshot

rock bands featured in Band Hero.

As part of the Agreement, Activision agreed to license no more than three No Doubt songs for use in Band Hero, subject to No Doubt's approval over the song choice. (Ultimately, the game included two No Doubt songs.)

Pursuant to the Agreement, the members of No Doubt participated in a full-day motion capture photography session at Activision's studios so that the band members' Band Hero avatars would accurately reflect their appearances, movements, and sounds. No Doubt then closely reviewed the motion capture photography and the details related to the appearance and features of their avatars to ensure the representations would meet their approval.

Approximately two weeks prior to the release of Band Hero, No Doubt became aware of the "unlocking" feature of the game that would permit players to use No Doubt's avatars to perform any of the songs included in the game, including songs that No Doubt maintains it never would have performed. The band also learned that female lead singer Gwen Stefani's avatar could be made to sing in a male voice, and the male band members' avatars could be manipulated to sing songs in female voices. The individual band member avatars could be made to perform solo, without their band members, as well as with members of other groups. No Doubt contends that in the numerous communications with No Doubt, Activision never communicated its intention to permit such manipulations of the No Doubt avatars. Rather, No Doubt insists, Activision represented that No Doubt's likenesses within Band Hero would be used only in conjunction with the selected No Doubt songs.

When No Doubt complained about the additional exploitation of their likenesses, Activision admitted that it had hired actors to impersonate No Doubt in order to create the representations of the band members' performances of the additional musical works other than the No Doubt songs licensed for the game. No Doubt demanded that Activision remove the "unlocking" feature for No Doubt's avatars, but Activision refused. Activision contends that No Doubt's request came only after the programming had been finalized and the manufacturers had approved the game for manufacture.

No Doubt filed a complaint against Activision in superior court, seeking injunctive relief and damages for Activision's allegedly unauthorized exploitation of No Doubt's name, performances and likenesses. No Doubt alleged six causes of action: (1) fraudulent inducement; (2) violation of statutory and common law right of publicity; (3) breach of contract; (4) unfair business practices in violation of Business and Professions Code section 17200; (5) injunctive relief; and (6) rescission.

II. NO DOUBT'S CLAIMS AROSE FROM PROTECTED ACTIVITY

Video games generally are considered “expressive works” subject to First Amendment protections. Further, Activision’s use of No Doubt’s likenesses in *Band Hero* is a matter of public interest because of the widespread fame No Doubt has achieved; there is a public interest which attaches to people who, by their accomplishments, mode of living, professional standing or calling, create a legitimate and widespread attention to their activities. Accordingly, the use of No Doubt’s likenesses in the *Band Hero* video game meets the first requirement of the anti-SLAPP statute.

“Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world). That suffices to confer First Amendment protection.” *Brown v. Entertainment Merchant’s Ass’n*, 131 S. Ct. 2729 (2011)

III. NO DOUBT'S PROBABILITY OF SUCCESS ON THE MERITS OF THE Claims

A. *Right of Publicity Claim*

No Doubt has alleged a claim for violation of the right of publicity under Civil Code section 3344 as well as under common law. Section 3344 provides in pertinent part: “Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.” The common law claim for misappropriation of the right of publicity is similar, except there is no requirement that the misappropriation have been done knowingly.

1. “*Transformative Use*” Defense

Activision contends that its use of No Doubt’s likenesses in *Band Hero* constitutes “protected First Amendment activity involving an artistic work,” and thus No Doubt’s right of publicity claim is completely barred. However, Activision’s First Amendment right of free expression is in tension with the rights of No Doubt to control the commercial exploitation of its members’ likenesses.

In *Comedy III*, our Supreme Court directly confronted this tension. The court articulated

what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.

[Thus,] when artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without

adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

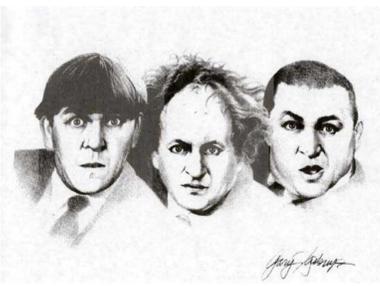
[A celebrity may enforce] the right to monopolize the production of conventional, more or less fungible, images of that celebrity. On the other hand, a work claimed to violate a celebrity's right of publicity is entitled to First Amendment protection where added creative elements significantly transform the celebrity depiction.

Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. [The inquiry boils down to] whether the literal and imitative or the creative elements predominate in the work.

The court then applied its newly minted "transformative use" test to the facts before it. The plaintiff was the owner of the rights to the comedy act known as The Three Stooges. The defendant was an artist who sold lithographs and T-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing the artist had created. The owner sued for violation of the right of publicity under Civil Code section 3344.1, the companion statute to section 3344 that extends the right of publicity to the heirs and assignees of deceased personalities.⁵

The court rejected the artist's contention that the plaintiff's claim was barred by the First Amendment. The court could "discern no significant transformative or creative contribution" in the artist's literal reproduction of the likenesses of The Three Stooges in its charcoal drawing. The artist's "undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame."

The court was careful to note that, in some circumstances, literal reproductions of celebrity portraits may be protected by the First Amendment. The court used the example of silk screens created by artist Andy Warhol using images of celebrities such as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. "Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehuman-



Saderup's Three Stooges drawing



Andy Warhol silkscreen of Marilyn Monroe

⁵The test developed in *Comedy III* applies equally to claims under section 3344.

ization of celebrity itself.”

The Supreme Court again addressed the balance between the First Amendment and celebrities’ rights of publicity in *Winter v. DC Comics* in which the defendant was sued for misappropriation under section 3344 after publishing a series of comic books featuring two villainous half-worm, half-human characters named the “Autumn brothers.” The characters were quite obviously based on the musician brothers Edgar and Johnny Winter, sharing their same long white hair and albino features.

Applying the “transformative use” test set forth in *Comedy III*, the court held that the Winter brothers’ claim was barred by the First Amendment as a matter of law. The court found that the comic depictions at issue were

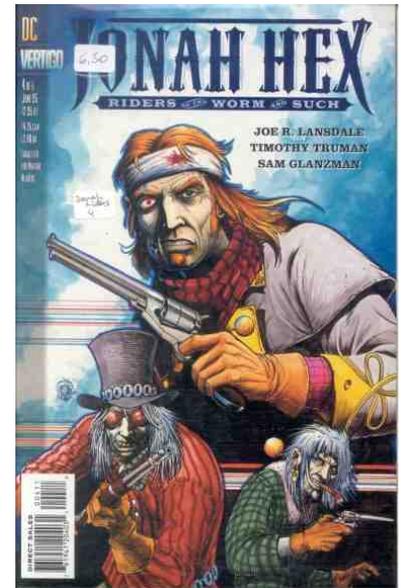
not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs’ mere likenesses. Although the fictional characters Johnny and Edgar Autumn are less-than-subtle evocations of Johnny and Edgar Winter, the books do not depict plaintiffs literally. Instead, plaintiffs are merely part of the raw materials from which the comic books were synthesized. To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature. And the Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.

The comic books featured “fanciful, creative characters, not pictures of the Winter brothers,” in stark contrast to *Comedy III*, where the artist “essentially sold, and devoted fans bought, pictures of The Three Stooges, not transformed expressive works by the artist.”

In *Kirby v. Sega of America, Inc.*, the Court of Appeal applied the “transformative use” test in a case involving the alleged use of a celebrity’s likeness in a video game. The plaintiff, Kierin Kirby, achieved fame as the lead singer of the musical group Deee-Lite which was popular in the early 1990’s. Kirby alleged that video game distributor Sega violated her common law and statutory rights of publicity when it released the video game *Space Channel 5* that included as its main character a computer-generated woman named “Ulala” allegedly based on Kirby.

SC5 is set in outer space, in the 25th century, and Ulala is a reporter who is sent to “investigate an invasion of Earth by dance-loving aliens who shoot earthlings with ray guns, causing them to dance uncontrollably.” To advance in the game, players attempt to have Ulala match the dance moves of various aliens and competitor reporters. A Japanese choreographer and dancer created Ulala’s six main dance

Winter: 69 P.3d 473 (Cal. 2003)



Jonah Hex cover from *Winter*

Kirby: 50 Cal. Rptr. 3d 607 (Ct. App. 2006)



Ulala from *Space Channel 5*

moves.

Kirby contended that Sega misappropriated her likeness by giving Ulala similar facial features to her own as well as by borrowing her distinctive look that combines retro and futuristic elements, including red or pink hair, platform shoes, brightly colored formfitting clothes, and short skirts. In addition, Ulala's name is a phonetic variation of "ooh la la," which Kirby alleged was her "signature" lyrical expression included in three of her songs.

The Court of Appeal concluded that there was a question of fact as to whether Sega had misappropriated Kirby's likeness in creating the character Ulala. However, the court found that even assuming Sega used Kirby's likeness, the First Amendment provided a complete defense. "Notwithstanding certain similarities, Ulala is more than a mere likeness or literal depiction of Kirby," as Ulala's physique, primary hairstyle and costumes, and dance moves differed from Kirby's. "Moreover, the setting for the game that features Ulala—as a space-age reporter in the 25th century—is unlike any public depiction of Kirby. . . . Taken together, these differences demonstrate Ulala is 'transformative,' and respondents added creative elements to create a new expression" such that the First Amendment barred Kirby's claim. Ulala was not merely "an imitative character contrived of minor digital enhancements and manipulations", and unlike the use of the likenesses of The Three Stooges in *Comedy III*, any imitation of Kirby's likeness was not "the sum and substance" of Ulala's character. Rather, like the "Autumn brothers" comic book characters in *Winter*, "Ulala is a "fanciful, creative character" who exists in the context of a unique and expressive video game."

2. Use of No Doubt's Likenesses in *Band Hero* Is Not "Transformative"

Activision does not dispute that the avatars of No Doubt are computer-generated recreations of the real band members, painstakingly designed to mimic their likenesses. Indeed, as part of the licensing agreement between Activision and No Doubt, No Doubt posed for motion-capture photography to enable Activision to reproduce their likenesses, movements, and sounds with precision. Activision intentionally used these literal reproductions so that players could choose to "be" the No Doubt rock stars. The game does not permit players to alter the No Doubt avatars in any respect; they remain at all times immutable images of the real celebrity musicians, in stark contrast to the fanciful, creative characters in *Winter* and *Kirby*.

No Doubt asserts that such realistic depictions categorically disqualify their *Band Hero* avatars from First Amendment protection. However, as *Comedy III* held, even literal reproductions of celebrities can be "transformed" into expressive works based on the context into which the celebrity image is placed (noting, for instance, the Warhol

silk screens featuring celebrity portraits, through “careful manipulation of context,” convey an ironic message about the “dehumanization of celebrity” through reproductions of celebrity images); *see also* *ETW Corp. v. Jireh Publishing, Inc.* [a painting featuring three literal likenesses of Tiger Woods in different poses in the foreground, with the Augusta National Clubhouse behind him and the likenesses of other famous golfing champions looking down on him, found worthy of First Amendment protection because it was a “panorama” of Woods’s historic 1997 victory at the world-famous Masters Tournament and conveyed a message about the significance of Woods’s achievement through images suggesting that Woods would eventually join the ranks of the world’s best golfers].) Thus, when the context into which a literal celebrity depiction is placed creates something new, with a further purpose or different character, altering the first likeness with new expression, meaning, or message, the depiction is protected by the First Amendment.

Nonetheless, although context may create protected expression in the use of a celebrity’s literal likeness, the context in which Activision uses the literal likenesses of No Doubt’s members does not qualify the use of the likenesses for First Amendment protection. Activision contends that as in *Kirby*, where Sega used Kirby’s likeness in a unique and expressive video game, Activision’s use of No Doubt’s likenesses in *Band Hero* is transformative because the video game shows the No Doubt avatars “surrounded by unique, creative elements, including in fanciful venues such as outer space . . . and performing songs that No Doubt avowedly would never perform in real life.” Indeed, according to Activision, No Doubt’s objection that the band can be made to perform songs it would never perform demonstrates that the use of the No Doubt avatars is transformative.

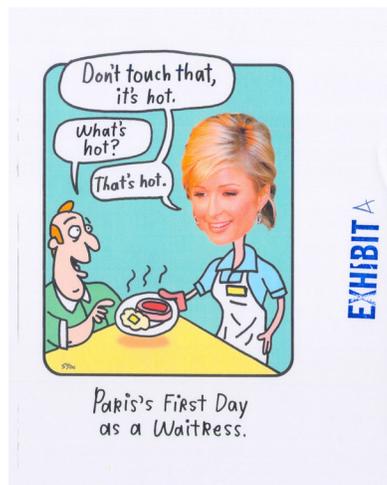
However, that the members of No Doubt object to being shown performing certain songs is irrelevant to whether that element of *Band Hero* combined with others transforms the literal depictions of No Doubt’s members into expression that is more Activision’s than pure mimicry. In that inquiry, it is the differences between *Kirby* and the instant case, not the similarities, which are determinative. In *Kirby*, the pop singer was portrayed as an entirely new character—the space-age news reporter Ulala. In *Band Hero*, by contrast, no matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame. Moreover, the avatars perform those songs as literal recreations of the band members. That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a video game that contains many other creative elements, does not transform the avatars into

ETW: 332 F.3d 915 (6th Cir. 2003)



Rick Rush portrait of Tiger Woods from *ETW*

Hilton: 599 F.3d 894 (9th Cir. 2010)



Hallmark card from Hilton



L.A. Magazine article from Hoffman

anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities. *Hilton v. Hallmark Cards* [Hallmark card featuring Paris Hilton's head on a cartoon waitress's body was not a "transformative use" as in *Kirby* because, despite some differences, the "basic setting" was the same as an episode of Hilton's television show in which she is depicted as "born to privilege, working as a waitress"];⁶

Moreover, Activision's use of lifelike depictions of No Doubt performing songs is motivated by the commercial interest in using the band's fame to market *Band Hero*, because it encourages the band's sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt. Thus, insofar as the depiction of No Doubt is concerned, the graphics and other background content of the game are secondary, and the expressive elements of the game remain manifestly subordinated to the overall goal of creating a conventional portrait of No Doubt so as to commercially exploit its fame. In other words, nothing in the creative elements of *Band Hero* elevates the depictions of No Doubt to something more than "conventional, more or less fungible, images" of its members that No Doubt should have the right to control and exploit. Thus, the trial court did not err in denying Activision's motion to strike the right of publicity claim based on Activision's assertion of a First Amendment defense.

B. Unfair Competition Claim

To state a claim for unfair competition under Business and Professions Code section 17200, a plaintiff must show that members of the public are likely to be deceived" by a particular business practice. No Doubt alleges that Activision violated section 17200 by deceiving the public into believing that No Doubt authorized the use of its name

⁶ An earlier Ninth Circuit decision, *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), arguably reached a different conclusion on facts somewhat similar to those in *Hilton*. In *Hoffman*, the court found that the First Amendment barred Dustin Hoffman's claim that Los Angeles Magazine had violated his right of publicity when it published an article that included a photographic image of the head of Hoffman in his "Tootsie" character superimposed on the body of a cartoon male who was wearing an evening gown and high heels. The court only briefly addressed the transformative use defense, finding that "even if we were to consider LAM an 'artist' and the altered 'Tootsie' photograph 'artistic expression' subject to the *Comedy III* decision, there is no question that LAM's publication of the 'Tootsie' photograph contained 'significant transformative elements'" because "Hoffman's body was eliminated and a new, differently clothed body was substituted in its place." In *Hilton*, the Ninth Circuit noted that *Hoffman* had not addressed the transformative use defense in great depth because the Supreme Court decided *Comedy III* only after oral argument in the Hoffman case had taken place. Thus, *Hilton* concluded that *Hoffman* was not controlling Ninth Circuit authority on the issue of the transformative use defense. We similarly do not find *Hoffman's* brief discussion or application of the transformative use defense compelling.

and likeness for the unlocking feature of Band Hero and that “No Doubt approves and endorses the appearance of its members individually performing songs that are wholly inappropriate and out of character for No Doubt.”

When the challenged use of a trademark appears in an artistic work that implicates First Amendment protections, some courts have concluded that the standard “likelihood of confusion” test under the Lanham Act is inadequate to address First Amendment concerns. The seminal case is *Rogers*, in which the Second Circuit developed an alternative to the “likelihood of confusion” test to be used for titles of artistic works that borrow names protected by trademark.

Activision contends that we should construe section 17200 to incorporate the *Rogers* standard as an element of No Doubt’s unfair competition claim, because the claim is “substantially congruent” to a trademark infringement claim under the Lanham Act, given that for both the “ultimate test” is whether the public is likely to be deceived or confused by the similarity of the marks.

Even if the *Rogers* “explicitly misleading” test might be applied to some section 17200 claims involving the unauthorized use of a celebrity’s likeness (a conclusion we do not reach),⁸ the test does not apply to No Doubt’s section 17200 claim. Activision overlooks the overarching conclusion in *Rogers* that the public interest in avoiding consumer confusion must be balanced against the public interest in free expression. The “explicitly misleading” standard comes into play only after a determination has been made that a challenged use of a trademark is worthy of heightened First Amendment protection.

Here, we have already concluded that Activision’s use of No Doubt’s avatars is not “transformative” because the avatars are simply precise computer-generated reproductions of the band members that do not meld with the other elements of Band Hero to become, in essence, Activision’s own artistic expression. In the case of such a “nontransformative” use of celebrity likenesses, the public interest in avoiding consumer confusion outweighs the public interest in free expression, and it would make little sense to require No Doubt to make the almost impossible showing that Activision’s nontransformative use of the No Doubt avatars was “explicitly misleading.” Of course, to prevail on its section 17200 claim, No Doubt will still have to demonstrate that members of the public are likely to be deceived by Activision’s use of the likenesses.

In sum, the trial court did not err in denying Activision’s motion to strike No Doubt’s section 17200 claim based on Activision’s con-

⁸Although the “explicitly misleading” requirement of the *Rogers* test makes obvious sense when the title of an artistic work is at issue, and thus conventional “speech” is involved, we question whether it should apply when the actionable wrong is the misappropriation of a celebrity’s likeness in a video game.

tention that its challenged use of the No Doubt avatars was not explicitly misleading.

7 Problems

Governator Problem

Does this bobblehead doll violate Arnold Schwarzenegger's right of publicity? (As a reminder, following his action-movie acting career, Schwarzenegger went into politics and served as Governor of California from 2003 to 2011.)



Tony Twist Problem

Anthony Rory Twist was a hockey player who played for the St. Louis Blues and the Quebec Nordiques. He was known as an “enforcer” who would pummel players from the opposing team if they disrespected or acted too aggressively toward his teammates.

Antonio Carlo Twistarelli a/k/a Tony Twist is a villain who appears in thirty-six issues of the Spawn comic book series by Todd McFarlane. MacFarlane has sometimes given away copies of Spawn comic books as promotions at hockey games.

Does Anthony Twist have a right of publicity case against McFarlane?



B Moral Rights

Moral rights give authors strong and often inalienable rights against uses of their works that could be harmful to their reputations that of-

defend their artistic visions. Moral rights are usually described as a part of copyright. In some respects, so they are. But the underlying theory of moral rights derives more from natural-law considerations about personal dignity than from any utilitarian balancing of incentives.

Some countries have well-developed moral rights traditions. The United States does not. The clearest instantiation of something resembling moral rights is in the federal Visual Artists Rights Act and state analogues.

Peter Baldwin

The Copyright Wars: Three Centuries of Trans-Atlantic Battle (2014)

The laws governing how artists, writers, musicians, choreographers, directors, and other authors relate to their works are usually called "copyright." But this one word covers two very different approaches. The very terms used to designate the European "authors' rights" alternative – *Urheberrecht* in German and *droit d'auteur* in French – voice a more encompassing approach.

Seen historically over its long development, copyright has focused on the audience and its hopes for an expansive public domain. Authors' rights, in contrast, have targeted creators and their claims to ensure the authenticity of their works. For its detractors, copyright is philistine and commercial, treating noble creation as a mere commodity. It regards the creator as an entrepreneur and the work as a product. The authors' rights tradition, in turn, valiantly protects the creators vision from commercialization and exploitation.

Authors' rights derive from natural rights. The Continental approach defends creators and their work. In a sense, it seeks no other interest – public or otherwise. Authors' rights, says a distinguished French jurist, seek to protect the author, not society. Because it sets the author before all, writes a French law professor, balancing interests, on the model of the copyright system, is foreign to the French tradition. The author, in the words of a standard French legal textbook, "owes society nothing. He has no more obligations in this respect than the mason who builds or the farmer who ploughs. Quite the contrary, society owes him."

Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*

38 Vand. L. Rev. 1 (1985)

The moral right doctrine generally is said to encompass three major components: the right of disclosure, the right of paternity, and the right of integrity. Some formulations of the moral right doctrine also include the right of withdrawal, the right to prevent excessive criticism, and the right to prevent assaults upon one's personality. For purposes of illustration, these components will be explored briefly in

the context of the following hypothetical. A playwright, enthralled with the idea of writing a piece poking fun at the evangelical segment of society, suddenly envisions a story line through which she can communicate her ideas. In one day she outlines the plot and sketches some dialogue so that she will have a rough draft which she can develop further when inspiration strikes again. At this point, the playwright's interest in her work would be protected by an aspect of the moral right doctrine known as the right of disclosure or divulgation. Underlying this component of the moral right is the idea that the creator, as the sole judge of when a work is ready for public dissemination, is the only one who can possess any rights in an uncompleted work. Prior to the time the playwright places her work into circulation, therefore, she retains the same right to determine both the form of her play before it is distributed and the timing of public circulation.

Suppose that a few days after the playwright had finished her rough draft, she entered into an agreement with a publisher in which she promised to produce the final publication version of the play within six months. Subsequently, a personal crisis in the playwright's life triggers a deep sense of religious conviction and she no longer wishes to finish the play. In these circumstances her refusal to complete the play would be supported by her right to refuse to disclose, a corollary to the right of disclosure. Application of this right would preclude a judgment ordering the playwright to complete the play, although a court might award the publisher damages for breach of contract.

Some scholars believe that a second component of the moral right doctrine, known as the right of withdrawal, would allow the play in our hypothetical situation to recall all existing copies of her work if, following actual publication, she experienced a radical change of the convictions that originally provided the impetus for the play. Other commentators, however, have expressed doubts regarding the viability of the moral right of withdrawal because of the practical inconsistency in assuming that the public will forget works to which it has already been exposed.

To continue the illustration, now assume that the playwright completes her work and subsequently visits a publisher with her manuscript in hand and offers it to the publisher for \$1500. The publisher conditionally agrees to this arrangement, providing the playwright makes certain revisions. When the playwright tenders the revised manuscript to the publisher, the publisher refuses to publish it with the playwright's name, notwithstanding the appearance of the playwright's name on the original manuscript. In these circumstances the playwright would be protected by another component of the moral right, the right of paternity. As its name suggests, the right of paternity safeguards a creator's right to compel recognition for his

work and prevents others from naming anyone else as the creator. Therefore, the playwright would be able to force publication of the work under her name. Additionally, the right of paternity protects a creator in the event that someone falsely attributes to him a work that is not his creation.

Two other aspects of the moral right doctrine are the creator's right to prevent excessive criticism and the creator's right to relief from other assaults on his personality. To appreciate fully the theoretical basis for these two rights, one must recall that the moral right doctrine safeguards rights of personality rather than pecuniary rights. The creator projects his personality into his work, and thus is entitled to be free from vexatious or malicious criticism and from unwanted assaults upon his honor and professional standing. By virtue of the prohibition against attacks on the creator's personality, the creator also is protected against misuse of his name and work. In the context of our hypothetical situation, such misuse would occur if an antireligious organization claimed that the playwright subscribed to antireligious views solely by virtue of her authorship of the play.

In the hypothetical situation, now suppose the playwright enters into an agreement with a movie producer authorizing the producer to write a screenplay based upon her play. The final version of the screenplay, however, distorts considerably the playwright's theme and mutilates her story line. The component of the moral right doctrine that would grant relief to the playwright in this situation is called the right of integrity. This right lies at the heart of the moral right doctrine. In our hypothetical case the adaptation process naturally would require certain modifications in the playwright's manuscript, but the right of integrity prevents those who make such alterations from destroying the spirit and character of the author's work. Although adaptations of a work from one medium to another present the most obvious potential for violations of a creator's right of integrity, in reality, any modification of a work can be problematic from an integrity standpoint. Any distortion that misrepresents an artist's expression constitutes a violation of the creator's right of integrity.

There is, however, one rather incongruous aspect of the right of integrity. If the artist in our hypothetical situation was a painter rather than a playwright, the right of integrity probably would not allow her to prevent the destruction of one of her paintings by its owner. Perhaps the underlying rationale for this exception is that a work which has been destroyed completely cannot reflect adversely upon the creator's honor or reputation. Nevertheless, some commentators have criticized the destruction exception on the ground that it negates the creator's right of paternity and frustrates the public's interest in enjoying the artist's work.

All nations that have adopted the moral right doctrine statutorily

include at least some of the above protections, but the contours of the doctrine vary among the adhering countries.

Berne Convention for the Protection of Literary and Artistic Works (1979)

- (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.
- (2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed.

Art. 6bis
Moral Rights

Copyright Act

- (a) *Rights of Attribution and Integrity.* – Subject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—
 - (1) shall have the right—
 - (A) to claim authorship of that work, and
 - (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;
 - (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and
 - (3) subject to the limitations set forth in section 113 (d), shall have the right—
 - (A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and
 - (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right. ...
- (c) *Exceptions.* –

17 U.S.C. § 106A
**Rights of certain authors to attribution
and integrity**

- (1) The modification of a work of visual art which is a result of the passage of time or the inherent nature of the materials is not a distortion, mutilation, or other modification described in subsection (a)(3)(A).
- (2) The modification of a work of visual art which is the result of conservation, or of the public presentation, including lighting and placement, of the work is not a destruction, distortion, mutilation, or other modification described in subsection (a)(3) unless the modification is caused by gross negligence.
- (3) The rights described in paragraphs (1) and (2) of subsection (a) shall not apply to any reproduction, depiction, portrayal, or other use of a work in, upon, or in any connection with any item described in subparagraph (A) or (B) of the definition of “work of visual art” in section 101, and any such reproduction, depiction, portrayal, or other use of a work is not a destruction, distortion, mutilation, or other modification described in paragraph (3) of subsection (a).

...

(e) *Transfer and Waiver.* –

- (1) The rights conferred by subsection (a) may not be transferred, but those rights may be waived if the author expressly agrees to such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver. ...
- (2) Ownership of the rights conferred by subsection (a) with respect to a work of visual art is distinct from ownership of any copy of that work, or of a copyright or any exclusive right under a copyright in that work. Transfer of ownership of any copy of a work of visual art, or of a copyright or any exclusive right under a copyright, shall not constitute a waiver of the rights conferred by subsection (a).

17 U.S.C. § 101
Definitions

A “work of visual art” is—

- (1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or
- (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or

in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include—

- (A) (i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;
- (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;
- (iii) any portion or part of any item described in clause (i) or (ii);
- (B) any work made for hire; or
- (C) any work not subject to copyright protection under this title.

C People as Trademarks

Trademark law has a few rules that explicitly apply to names and other attributes of personal identity. Are these special rules for special subject matter, or just the predictable application of trademark's usual principles?

Lanham Act

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

- (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
- (e) Consists of a mark which ... (4) is primarily merely a surname

35 U.S.C. § 1052 [Lanham Act § 2]
Trademarks registrable on principal register; concurrent registration

Peaceable Planet, Inc. v. Ty, Inc. 362 F.3d 986 (7th Cir. 2004)

Although cases and treatises commonly describe personal names as a subset of descriptive marks, it is apparent that the rationale for denying trademark protection to personal names without proof of secondary meaning can't be the same as the rationale just sketched for

Both companies sold plush camel toys named "Niles." Trademark litigation ensued, giving Judge Posner an opportunity to discuss the considerations applicable to personal names as trademarks

marks that are “descriptive” in the normal sense of the word. Names, as distinct from nicknames like “Red” or “Shorty,” are rarely descriptive. “Niles” may evoke but it certainly does not describe a camel, any more than “Pluto” describes a dog, “Bambi” a fawn, “Garfield” a cat, or “Charlotte” a spider. (In the Tom and Jerry comics, “Tom,” the name of the cat, could be thought descriptive, but “Jerry,” the name of the mouse, could not be.) So anyone who wanted to market a toy camel, dog, fawn, cat, or spider would not be impeded in doing so by having to choose another name.

The reluctance to allow personal names to be used as trademarks reflects valid concerns (three such concerns, to be precise), but they are distinct from the concern that powers the rule that descriptive marks are not protected until they acquire secondary meaning. One of the concerns is a reluctance to forbid a person to use his own name in his own business. Supposing a man named Brooks opened a clothing store under his name, should this prevent a second Brooks from opening a clothing store under his own (identical) name even though consumers did not yet associate the name with the first Brooks’s store? It should not.

Another and closely related concern behind the personal-name rule is that some names are so common — such as “Smith,” “Jones,” “Schwartz,” “Wood,” and “Jackson” — that consumers will not assume that two products having the same name therefore have the same source, and so they will not be confused by their bearing the same name. If there are two bars in a city that are named “Steve’s,” people will not infer that they are owned by the same Steve.

The third concern, which is again related but brings us closest to the rule regarding descriptive marks, is that preventing a person from using his name to denote his business may deprive consumers of useful information. Maybe “Steve” is a well-known neighborhood figure. If he can’t call his bar “Steve’s” because there is an existing bar of that name, he is prevented from communicating useful information to the consuming public.

David B. Findlay, Inc. v. Findlay
218 N.E.2d 531 (N.Y. 1966)

When should a man’s right to use his own name in his business be limited? This is the question before us.

The individual plaintiff David B. Findlay (“David”) and the individual defendant Walstein C. Findlay (“Wally”) are brothers. The Findlay art business was founded in 1870 by their grandfather in Kansas City. Their father continued and expanded the business with a Chicago branch managed by Wally and a New York branch established and managed by David on East 57th Street. In 1936 the Kansas City gallery was closed and in 1938, after a dispute, the brothers sep-

arated. By agreement David, as president of Findlay Galleries, Inc., and owner of nearly all of the stock of the original Missouri corporation, sold to Wally individually the Chicago gallery and allowed Wally to use the name "Findlay Galleries, Inc." in the conduct of his business in Chicago. Wally organized an Illinois corporation under the name "Findlay Galleries, Inc." in 1938 and has since operated his Chicago gallery. He also opened, in 1961, a Palm Beach, Florida, gallery.

David, since the separation, has operated his gallery on East 57th Street in Manhattan. For many years he has conducted his business on the second floor of 11-13 East 57th Street.

In October, 1963, Wally purchased the premises at 17 East 57th Street and informed David of his plans to open an art gallery. David objected to Wally's use of the name "Findlay" on 57th Street and by letter announced he would "resist any appropriation by you in New York of the name Findlay in connection with a gallery * * * any funds spent by you to establish a gallery at 17 East 57th Street under the name Findlay Galleries, Inc. (or any variation thereof using the name Findlay) are spent at your peril." David also, in self-defense and in an effort to survive, rented additional space at 15 East 57th Street so as to have a street level entrance.

David's objections and pleas seemed to have some effect on Wally. As renovation on the building was carried on from October, 1963 to September, 1964, a large sign proclaimed the coming opening of "W.C.F. Galleries, Inc." There was also a display and listing in the New York Telephone directory under the same name and similar advertisements in other publications. However, in September, 1964 the sign was suddenly changed to announce the imminent opening of "Wally Findlay Galleries" affiliated with "Findlay Galleries, Inc." David immediately sought an injunction. Wally went ahead with his opening and erected a sidewalk canopy from the curb to the building displaying the name "Wally Findlay Galleries."

The trial court made very detailed findings and, based on them, enjoined defendant from using the names "Wally Findlay Galleries", "Findlay Galleries" and any other designation including the name "Findlay" in the conduct of an art gallery on East 57th Street. The Appellate Division has affirmed on the trial court's findings and we find evidence to sustain them.

In his quarter of a century on East 57th Street David has established a valuable good will and reputation as an art dealer. Through hard work, business ability and expenditure of large sums of money, David has reached the level where a significant portion of his business comes from people who have been referred to him by others and told to go to "Findlay's on 57th St."

The effect of Wally's new gallery, with its long canopy, can only be

that those looking for "Findlay's on 57th St." will be easily confused and find their way into Wally's rather than David's gallery. Though Wally perhaps did not deliberately set out to exploit David's good will and reputation, the trial court found, and we agree, that such a result would follow if Wally were permitted to operate a gallery under the name "Wally Findlay Galleries" next door to David.

There were numerous instances of people telephoning or asking at David's for personnel of Wally's or for art work exhibited at Wally's. Many regular customers congratulated David on the opening of "his" new gallery next door. Moreover, advertisements frequently appeared on the same pages of the local press for "Findlay Galleries", "Findlay's", or "Wally Findlay Galleries" thus making it very difficult to tell whose advertisement it was. Even the art editors and reporters referred to Wally as "Findlay Galleries" – the name used for many years by David – or as "the new Findlay Gallery."

It is apparent that confusion has and must result from Wally's opening next to David. This is compounded by the fact that both brothers have for years specialized in French impressionist and post-impressionist painters. Therefore, quite naturally, both brothers have in the past dealt in the works of such famous deceased painters as Modigliani, Degas, Renoir, Gauguin, Bonnard, Braque, Monet and many others.

Although someone seeking a Renoir from David is unlikely to purchase a Degas from Wally, it is likely that with respect to some of the lesser-known impressionists such diversion might happen. More important, someone wishing to own a nude by Modigliani, a dancer by Degas or a portrait of a girl by Renoir would not necessarily have a particular painting in mind and would likely purchase any of these species, whether it be in Wally's or David's. The items sold by the two brothers are not unique, nonsubstitutional works.

Moreover, art, particularly modern art, is sold only to those who see it. Works of art are sold to those who cross the threshold of the art gallery and the more people you get into your gallery, the more art you will sell. To this end David has worked hard to develop the name "Findlay's on 57th St." and bring in customers. Many people who have the finances to purchase art do not necessarily have the knowledge to distinguish between the works of all the various painters represented by galleries such as Wally's or David's. For this reason they rely on the reputation of the gallery. David has spent over 25 years in developing satisfied customers who will tell others to go to "Findlay's on 57th St." This good will brings in customers who look for a work of art that suits their fancy and, if Wally were to continue to use the name Findlay, it is inevitable that some would walk into Wally's by mistake and would have their tastes satisfied there, to David's great harm.

The so-called "sacred right" theory that every man may employ his own name in his business is not unlimited. Moreover, fraud or deliberate intention to deceive or mislead the public are not necessary ingredients to a cause of action.

The present trend of the law is to enjoin the use even of a family name when such use tends or threatens to produce confusion in the public mind. Whether this confusion should be satisfied by misplaced phone calls or confusing advertisements alone we do not decide because there has been a finding that diversion, as well as confusion, will exist if Wally is not enjoined. Thus it is clear that the "confusion" with which we are dealing includes impairment of good will of a business.

In *Meneely v. Meneely* this court noted that one can use his own name provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead the public.

Thirty-five years later, we noted that, as a general principle of law, one's name is his property and he is entitled to its use. However, it was equally a principle of law that no man can sell his goods as those of another. "He may not through unfairness, artifice, misrepresentation or fraud injure the business of another or induce the public to believe his product is the product of that other." *World's Dispensary Med. Assn. v. Pierce*

Ryan & Son v. Lancaster Homes is distinguishable from the present case because there was lacking the crucial finding that in the absence of relief plaintiff would be damaged by confusion and diversion. There was no real competition between the two businesses. Again, unlike the instant case where "Findlay's on 57th St." is synonymous in New York City with quality art galleries, "Homes by Ryan" had not become a trade name with a secondary meaning. The court reviewed the law and cited the rule in *Meneely*. "This rule has been qualified, as we have said, only to the extent that use of a family name will be restricted where such use tends or threatens to induce confusion in the public mind".

In the present case Wally knew that David had conducted his business and built a reputation under the names "Findlay Galleries" and "Findlay's on 57th St." and that many years of effort and expenses had gone into promoting the name of "Findlay" in the art business on 57th Street. He also knew that people would come into his gallery looking for "Findlay Galleries" and even instructed his employees on this matter before he opened. Nonetheless he opened his gallery next door to David dealing in substantially similar works and using the name Findlay. The bona fides of Wally's intentions do not change the applicable principles. The objective facts of this unfair competition and injury to plaintiff's business are determinative, not the de-

Meneely: 62 N.Y. 427 (1875)

World's Dispensary: 96 N.E. 738 (N.Y. 1911)

Ryan & Son: 205 N.E.2d 859 (N.Y. 1965)

fendant's subjective state of mind. Wally's conduct constituted unfair competition and an unfair trade practice, and it is most inequitable to permit Wally to profit from his brother's many years of effort in promoting the name of "Findlay" on 57th Street. Wally should use any name other than "Findlay" in the operation of his business next door to his brother.

In framing its injunction the trial court went no farther than was necessary to avoid the harm threatened. It prevented the use of the name Findlay but limited this to the particular area in which its use would cause confusion and diversion – East 57th Street. It resolved the conflict with as little injury as possible to Wally. The proof showed and the trial court found that many, if not most of the leading art galleries, are now located on Madison Avenue and in the area of the 60's, 70's and 80's in New York City. Wally could probably have found an appropriate place for his New York gallery other than at 17 East 57th Street and can now either find such another location or remain where he is under some name such as "W.C.F. Galleries".

The decision in this case is in accord with the directions of our court: "The defendant has the right to use his name. The plaintiff has the right to have the defendant use it in such a way as will not injure his business or mislead the public. Where there is such a conflict of rights, it is the duty of the court so to regulate the use of his name by the defendant that, due protection to the plaintiff being afforded, there will be as little injury to him as possible." *World's Dispensary*

Melting Bad Problem, Re-Redux

Walter Blanco from Blancorp is back again with yet more ideas for possible trademarks for his clumpless ice-melter. Give your opinion on the following potential trademarks:

- JONES
- BETTE MIDLER
- JAY Z
- WALTER BLANCO
- ROBIN HOOD
- CALVIN COOL EDGE
- BLANCO'S BLUE

Today, the "Wally Findlay Gallery" and the "David Findlay Jr. Gallery" are under combined ownership and operate from the same address at 724 Fifth Avenue, between 56th and 57th Streets. The business is owned by James Borynack, who bought Wally's gallery after Wally's death in 1996, and bought David Jr.'s gallery from David Jr.'s daughter in 2016.