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Right of Publicity

The right of publicity protects people's names, appearances, and other aspects of their personal identities from commercial exploitation. Why should there be such a right at all? One answer is grounded in a sense of *privacy*: to parade a person before the public eye without their consent is to work a dignitary harm. Another is *misappropriation*: if anyone is entitled to make money off of my image, it ought to be me. A third is that it creates *incentives* to develop one's public persona by filling in what would otherwise be a gap in IP systems. (Recall that people are not patentable or copyrightable.) And a fourth is *contracting*: without a right of publicity, it is much harder to make deals about people's fame, talent, and endorsement.

A 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. The history of the rise of the right of publicity in the twentieth century shows courts wrestling with both kinds of theories.

Origins

If there is a poster child for the right of publicity, it would have to be Abigail Roberson.¹ One day around the turn of the 20th century, she discovered her face on ads for Franklin Mills's flour. Some 25,000 posters were placed in stores and saloons. She alleged:

1. Roberson v. Rochester Folding Box Co., 64 N.E. 442 (N.Y. 1902).



Flour of the Family advertisement

that they have been recognized by friends of the plaintiff and other people, with the result that plaintiff has been greatly humiliated by the scoffs and jeers of persons who have recognized her face and picture on this advertisement, and her good name has been attacked, causing her great distress and suffering, both in body and mind; that she was made sick, and suffered a severe nervous shock, was confined to her bed, and compelled to employ a physician . . . noteroberson

Roberson sued Franklin Mills, but in *Roberson v. Rochester Folding Box Co.* New York's highest court held that her complaint did not fit within any existing tort box. There was no libel, because the picture was a "good portrait of her, and therefore one easily recognized"; it did not subject her "to contempt, ridicule, or obloquy."² And there was no invasion of privacy. Indeed, the court disparaged the idea that there could be a privacy right on these facts, because it saw no logical stopping point to the idea that "an individual has the right to prevent his features from becoming known to those outside of his circle of friends and acquaintances."³

The so-called 'right of privacy' is, as the phrase suggests, founded upon the claim that a man has the right to pass through this world, if he wills, without having his picture published, his busi-

2. *Id.*

3. *Id.*

THE CONSTITUTION: ATLANTA, GA., SUNDAY, NOVEMBER 15, 1903

**DO IT NOW.
THE MAN WHO DID.**



**DO IT WHILE YOU CAN.
THE MAN WHO DIDN'T.**



THESE TWO PICTURES TELL THEIR OWN STORY.

"In my healthy and productive period of life I bought insurance in the New England Mutual Life Insurance Co., of Boston, Mass., and today my family is protected and I am drawing an annual dividend on my paid-up policies."

"When I had health, vigor and strength I felt the time would never come when I would need insurance. But I see my mistake. If I could recall my life I would buy one of the New England Mutual's 18-Pay Annual Dividend-Policies."

**THOMAS B. LUMPKIN, General Agent,
1008-1009-1010 EMPIRE BUILDING.**

New England Mutual Life Insurance ad

ness enterprises discussed, his successful experiments written up for the benefit of others, or his eccentricities commented upon either in handbills, circulars, catalogues, periodicals, or newspapers; and, necessarily, that the things which may not be written and published of him must not be spoken of him by his neighbors, whether the comment be favorable or otherwise.⁴

But this reasoning is fallacious, as Georgia's highest court showed three years later in *Pavesich v. New England Life Ins. Co.*⁵ The basic configuration was the same: the plaintiff's picture was used without permission. This time, it was an ad for life insurance.

Above the likeness of the plaintiff were the words: "Do it now. The man who did." Above the likeness of the other person were the words: "Do it while you can. The man who didn't." Below the two pictures were the words: "These two pictures tell their own story." Under the plaintiff's picture the following appeared: "In my healthy and productive period of life I bought insurance in the New England Mutual Life Insurance Co., of Boston, Mass., and to-day my family is protected and I am drawing an annual dividend on my paid-up policies." Under the other person's picture

4. *Id.*

5. *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

was a statement to the effect that he had not taken insurance, and now realized his mistake.⁶

Pavesich, of course, had never bought insurance from New England Life.

Unlike the court in *Roberson*, the court in *Pavesich* saw that this could be conceptualized as a privacy violation without giving people a right over every possible use of their name and likeness. It started from the observations that "the body of a person cannot be put on exhibition at any time or at any place without his consent," but that a person can waive this right to "withdraw from the public gaze" – for example, by running for public office.⁷ The question, therefore, is whether the plaintiff has waived their claim of privacy as against the use made by the defendant.

The form and features of the plaintiff are his own. The defendant insurance company and its agent had no more authority to display them in public for the purpose of advertising the business in which they were engaged than they would have had to compel the plaintiff to place himself upon exhibition for this purpose. Nothing appears from which it is to be inferred that the plaintiff has waived his right to determine himself where his picture should be displayed in favor of the advertising right of the defendants. . . . The plaintiff was in no sense a public character, even if a different rule in regard to the publication of one's picture should be applied to such characters.⁸

Still, when push came to shove, the court fell back on the idea that there was something specifically both *false* and *damaging* about the ad.

It is now to be determined whether first count in the petition set forth a cause of action for libel. The publication did not mention the plaintiff's name, but it did contain a likeness of him that his friends and acquaintances would readily recognize as his, and the words of the publication printed under the likeness were put into the mouth of him whose likeness was published. These words are harmless in themselves. Standing alone, they contain nothing, and carry no inference of anything that is disgraceful, to be ashamed of, or calculated to bring one into reproach.

It is alleged that the plaintiff did not have, and never had had, a policy of insurance with the defendant company, and that this fact was known to his friends and acquaintances. In the light of these allegations, the words attributed to the plaintiff become absolutely false, and those who are acquainted with the facts, upon reading the statement, would naturally ask, "For what purpose

6. *Id.*

7. *Id.*

8. *Id.*

was this falsehood written?" It was either gratuitous, or it was for a consideration; and, whichever conclusion might be reached, the person to whom the words were attributed would become contemptible in the mind of the reader. He would become at once a self-confessed liar. If he lied gratuitously, he would receive and merit the contempt of all persons having a correct conception of moral principles. If he lied for a consideration, he would become odious to every decent individual. It seems clear to us that a jury could find from the facts alleged that the publication, in the light of the extrinsic facts, was libelous, and the plaintiff was entitled to have this question submitted to the jury.

In states like Georgia, the idea that a person had a privacy right against false endorsements developed through common-law judicial decisions expanding on cases like *Pavesich*. But in other states, like New York, the right is statutory. In 1903, the year after *Roberson*, New York's legislature enacted a new privacy law to reverse the outcome. It let "[a]ny person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without . . . written consent" sue for damages and an injunction.⁹ In these states, the right publicity of reaches only what the legislature includes. In a few states, like California, there are both common-law and statutory rights of publicity.

Privacy vs. Publicity

Lurking in cases like *Pavesich* – and in the arguments made by Abigail Roberson – is an assumption that the right of publicity exists to protect people's privacy, making it a right *against* publicity. If that is right, then the right will not protect celebrities and other figures who are already in the public eye, because they have waived their interest in privacy.

In *O'Brien v. Pabst Sales Co.*, for example, the plaintiff, Davey O'Brien, was "in physique as in prowess as a hurler, a modern David, a famous football player."¹⁰ He won the Heisman Trophy and was on the All American team for 1938. The defendant, a brewery, printed and distributed 35,000 calendars with the schedule for the 1939 college football season and pictures of the All American team. O'Brien's photograph appeared at the top directly next to a picture of a Pabst-branded glass and bottle of beer. He sued, claiming a violation of his right of publicity, but the court held that "publicity he got was only that which he had been constantly seeking and receiving."¹¹ In more detail:

The defenses were three. The first was that if the mere use of one's picture in truthful and respectable advertising would be an

9. N.Y. Civil Rights Law § 51.

10. *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941).

11. *Id.*

actionable invasion of privacy in the case of a private person, the use here was not, as to plaintiff, such an invasion, for as a result of his activities and prowess in football, his chosen field, and their nationwide and deliberate publicizing with his consent and in his interest, he was no longer, as to them, a private but a public person, and as to their additional publication he had no right of privacy. The second defense was that plaintiff, in his own interest and that of Texas Christian University, had posed for and had authorized the publicity department of T.C.U. to distribute his picture and biographical data to newspapers, magazines, sports journals and the public generally, and that the particular picture whose use is complained of had been in due course obtained from and payment for it had been made to the T.C.U. publicity department. Third, no injury to appellant's person, property or reputation had been or could be shown and there was therefore no basis for a recovery. The testimony fully supported these defenses.

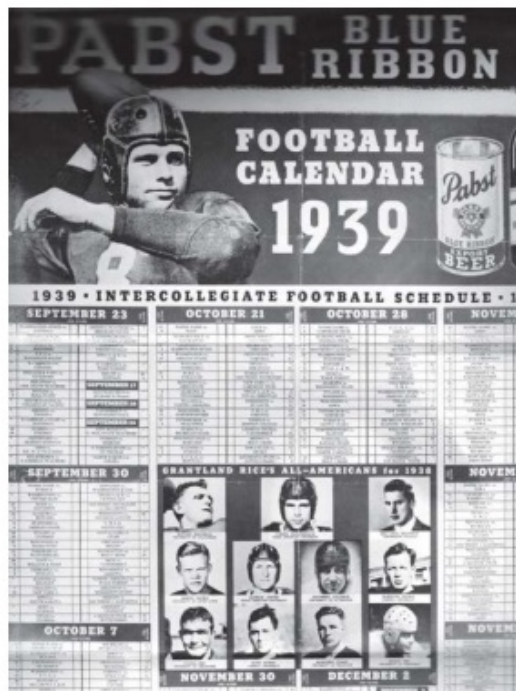
Most cases in which the right of privacy is commercially valuable are more like *O'Brien* than like *Roberson* or *Pavesich*. The people who have the most to gain by monetizing their identities are celebrities, but these are also the people whose identities advertisers are most eager to use. Franklin Mills could easily have negotiated a modest payment to Abigail Roberson, or if she refused, found another and more amenable model. It used her image without permission only because it didn't realize that putting a person's picture on flour ads is the kind of thing for which permission is required. But Davey O'Brien, as the preeminent college football player of 1938, had unique value to Pabst.

Thus, around the middle of the century, courts began to conceptualize a right of *publicity* as distinct from a right of *privacy*. A crucial breakthrough case was *Haelan Laboratories v. Topps Chewing Gum*, another athlete case.¹² Wes Westrum, a catcher for the Giants, signed a contract to let Haelan put his picture on baseball cards; he promised not to sign a similar contract with any other baseball-card company. In exchange, he received a Longines wristwatch. A few days later, despite his promise of exclusivity, he signed a similar contract with Topps for \$150.

Haelan sued, and Topps defended on the *O'Brien* rationale that Westrum as a professional athlete in the public eye *had no right of privacy* under New York law that could prevent the use of his photograph on baseball cards.¹³ According to Topps, all that Westrum had was "a personal and non-assignable right not to have his feelings hurt by such a

12. *Haelan Lab'ys v. Topps Chewing Gum*, 202 F.2d 866 (1953).

13. If Topps really believed this, why did it agree to pay Westrum \$150?



The Pabst calendar. O'Brien is the player at the top throwing a football.

publication.”¹⁴ But the court disagreed:

We think that, in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph . . . This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

There are two moves here. First, the court reasons that the *commercial value* of a person’s identity is a valid basis to protect a right of publicity, and distinct from a *Pavesich*-style privacy basis. Second, it recognizes that *the need to contract over this value* justifies recognizing an exclusive right. Wes Westrum has a right of publicity so that he can get a shiny new watch in exchange for putting his picture on Haelan baseball cards – and also

14. *O'Brien*, 124 F.2d 167.



Wes Westrum baseball card

so he can meaningfully promise Haelan that Topps will not also put out Wes Westrum cards. Of course, these two rationales are intertwined. Unless no one can use his picture, everyone will, so unless everyone has to pay, no one will.

But *Haelan Laboratories*'s commercial theory of the right of publicity has its own limits. Just as the privacy theory works for everyday people but not for celebrities, a commercial theory works for celebrities but not for everyday people. If it is the commercial value of one's identity that is the basis for a right of publicity, only a person who has already commercialized their identity has a right to protect. Under *Haelan Laboratories*, even Abigail Roberson might still be out of luck, precisely because she took no steps to sell her face for use in advertising. The result is that the two theories of the right of publicity – privacy and commercial value – have coexisted, with different states recognizing one, the other, or both.

The modern trend, however, is toward a reunification. The courts have increasingly expanded the commercial-value rationale for the right of publicity by dropping the prerequisite that the plaintiff have commercialized their identity. As long as the *defendant* is exploiting the value of the plaintiff's identity, it does not matter whether the *plaintiff* is.

Consider *Fraleigh v. Facebook, Inc.*:

At issue here is one of Facebook's advertising practices, "Sponsored Stories," which appear on a member's Facebook page, and which typically consist of another member's name, profile picture, and an assertion that the person "likes" the advertiser, coupled with the advertiser's logo. Sponsored Stories are generated

when a member interacts with the Facebook website or affiliated sites in certain ways, such as by clicking on the “Like” button on a company’s Facebook page.¹⁵

The plaintiffs were a class of individuals who “allege not that they suffered mental anguish as a result of Defendant’s actions, but rather that they suffered economic injury because they were not compensated for Facebook’s commercial use of their names and likenesses in targeted advertisements to their Facebook Friends.”¹⁶ Facebook defended on the ground that the plaintiffs “must demonstrate some preexisting commercial value to their names and likenesses,” but the court disagreed, emphasizing that the “right of publicity exists for celebrity and non-celebrity plaintiffs alike.”¹⁷ A plaintiff’s celebrity status goes to the measure of damages, not to the existence of the right:

Although generally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered, the appropriation of the identity of a relatively unknown person may result in economic injury or may itself create economic value in what was previously valueless. Thus, courts have long recognized that a person’s name, likeness, or other attribute of identity can have commercial value, even if the individual is relatively obscure. In¹⁸, the Ninth Circuit sustained the § 3344 claim of a surfer alleging that a clothing retailer had unlawfully used a photograph of him surfing for advertising purposes. . . .

Admittedly, these previous non-celebrity plaintiffs have typically been models, entertainers, or other professionals who have cultivated some commercially exploitable value through their own endeavors. Nevertheless, the Court finds nothing requiring that a plaintiff’s commercially exploitable value be a result of his own talents or efforts in order to state a claim for damages under § 3344. In a society dominated by reality television shows, YouTube, Twitter, and online social networking sites, the distinction between a “celebrity” and a “non-celebrity” seems to be an increasingly arbitrary one.

And then, in an important twist, the court noted that people’s identities are valuable to Facebook in Sponsored Stories precisely because they have commercial influence over their friends:

Plaintiffs quote Facebook CEO Mark Zuckerberg stating that

15. *Fraley v. Facebook, Inc.*, 830 F.Supp.2d 785 (N.D. Cal. 2011).

16. *Id.*

17. *Id.*

18. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

“nothing influences people more than a recommendation from a trusted friend. A trusted referral influences people more than the best broadcast message. A trusted referral is the Holy Grail of advertising.”

Thus, Plaintiffs have alleged that, in the same way that celebrities enjoy commercially exploitable opportunities among consumers at large, they enjoy commercially exploitable opportunities to advertise among their immediate friends and associates because in essence, Plaintiffs are celebrities – to their friends. While traditionally, advertisers had little incentive to exploit a non-celebrity’s likeness because such endorsement would carry little weight in the economy at large, Plaintiffs’ allegations suggest that advertisers’ ability to conduct targeted marketing has now made friend endorsements a valuable marketing tool, just as celebrity endorsements have always been so considered.¹⁹

At this point, the modern view is probably that everyone has a right of publicity.

B Subject Matter

Typically the right of publicity covers at least one’s name and “likeness” (i.e. one’s photograph or image). How much further it extends is more controversial. One question is whether it covers distinctive non-visual personal attributes like one’s voice. In *Midler v. Ford Motor Co.*, Ford wanted to advertise the Mercury Sable to “yuppies” (short for “young urban professionals”) by reminding them of their college days with songs from the 1970s.²⁰ Ford’s advertising agency, Young & Rubicam, selected Midler’s “Do You Want To Dance” as one of the songs to feature.

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.”²¹

Not willing to take “no” for an answer, Young & Rubicam hired one of Midler’s backup singers, Ula Hedwig, to record a sound-alike version of “Do You Want to Dance?” for the commercial.²² Note that there was no copyright issue; Midler’s version was itself a cover of a Bobby Freeman

19. *Fraley*, 830 F.Supp.2d 785.

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

21. *Id.*

22. There seem not to have been lingering hard feelings between the two. Hedwig worked again with Midler on later albums.



Ula Hedwig (left) singing backup for Bette Midler (right) in 1980



The Mercury Sable ad featuring “Do You Want to Dance?”

song, and Young & Rubicam properly licensed the musical work from the copyright owner.²³

Ford argued that one’s voice is not protected under the right of publicity, but the court soundly disagreed. The key was that the voice in the commercial was *recognizable* as Midler’s (even though it was actually Hedwig signing). People told Midler that the commercial sounded like her; Hedwig’s friends didn’t know it was her. As the court explained (with echoes of *Bleistein v. Donaldson Lithographing Co.*):

A voice is as distinctive 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. . . . The singer manifests herself in the song. To impersonate her voice is to pirate her identity.²⁴

Indeed, the fact that the defendants *deliberately imitated* Midler’s voice is crucial here.

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.²⁵

It is precisely because the public watching the commercial was intended to *think that the singer was Midler* that the right of publicity was in play.

A harder question is posed where the ad merely *reminds* viewers of the celebrity. One early case was *Motschenbacher v. R.J. Reynolds Tobacco Co.*, where a television commercial for Winston cigarettes used a stock photo-

23. Why couldn’t Midler sue for copyright infringement for imitating her recorded version?

24. *Midler*, 849 F.2d 460.

25. *Id.*



Motschenbacher's car



The Winston ad

graph of a race including the car driven by Lothar Motschenbacher.²⁶ He was not visible in the photograph, and the number on the car had been altered, but the car's red-and-white design was recognizable. The court held for Motschenbacher on a false-endorsement theory. Here, there was a plausible argument that viewers would (correctly) believe that he was in the car, so the idea of the car as an extension of his physical likeness has some weight to it.

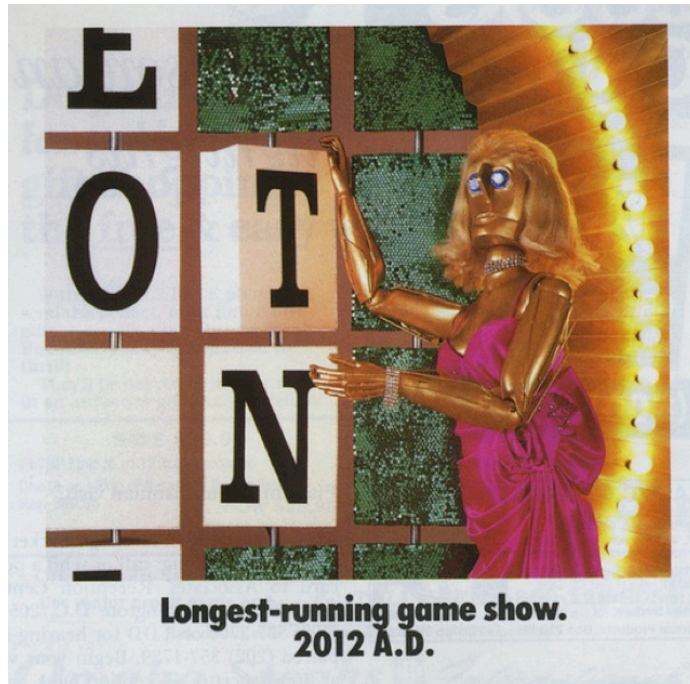
A further extension of this idea was *Carson v. Here's Johnny Portable Toilets, Inc.*, where the defendant was in the portable-toilet business under the brand name "Here's Johnny," the phrase by which Johnny Carson was introduced nightly as the host of *The Tonight Show*. This was held to violate his right of publicity. "Johnny" was certainly recognizable as Carson: that's the whole point of the joke. But it didn't literally depict him (indeed, his sidekick Ed McMahon was the one to say the phrase, not Carson himself). If there was a false endorsement here, it was only because of a 43(a)-style circularity that people would expect "Here's Johnny" toilets to be endorsed by Johnny Carson.

The real breaking point – at least for some judges – was *White v. Samsung Electronics America, Inc.*²⁷ Vanna White has been the hostess of *Wheel of Fortune* since 1982. Although she has filled in as the show's MC, her most important duty has been flipping letters on the show's game board as they light up. Samsung ran a series of ads for its electronics:

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: "Re-

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

27. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).



Samsung game show ad

vealed 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 [the advertising agency] 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 celebrities used in the campaign, White neither consented to the ads nor was she paid.²⁸

The court held that this did not violate California's right of publicity statute, which referred to one's "name, voice, signature, photograph, or likeness," because the robot was none of these."²⁹ But it did hold that

28. *Id.* Read the last sentence closely. Has the court prejudged the issue in White's favor by saying "other celebrities used in the campaign?" On the other hand, isn't this an absolutely damning fact for Samsung?

29. Cal. Civ. Code. § 3344.

her common-law right of publicity could be violated "without resorting to obvious means such as name, likeness, or voice."³⁰ It explained:

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.³¹

Judge Alarcon dissented on this point:

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. . . . [T]he majority confuses Vanna White, the person, with the role she has assumed as the current hostess on the "Wheel of Fortune" television game show. . . .

The majority appears to argue that because Samsung created a robot with the physical proportions of an attractive woman, posed it gracefully, dressed it in a blond wig, an evening gown, and jewelry, and placed it on a set that resembles the Wheel of Fortune layout, it thereby appropriated Vanna White's identity. But an attractive appearance, a graceful pose, blond hair, an evening gown, and jewelry are attributes shared by many women, especially in Southern California. These common attributes are particularly evident among game-show hostesses, models, actresses, singers, and other women in the entertainment field. They are not unique attributes of Vanna White's identity. . . .

The only characteristic in the commercial advertisement that is not common to many female performers or celebrities is the imitation of the "Wheel of Fortune" set. This set is the only thing which might possibly lead a viewer to think of Vanna White. The Wheel of Fortune set, however, is not an attribute of Vanna

30. *White*, 971 F.2d 1395.

31. *Id.*

White's identity. It is an identifying characteristic of a television game show, a prop with which Vanna White interacts in her role as the current hostess. To say that Vanna White may bring an action when another blond female performer or robot appears on such a set as a hostess will, I am sure, be a surprise to the owners of the show.

In dissenting from denial of rehearing *en banc*, Judge Kozinski³² was even more forceful about what he saw as a slippery slope:

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. Once 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.

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. If 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. That's a whole lot more than White and the robot had in common.³³

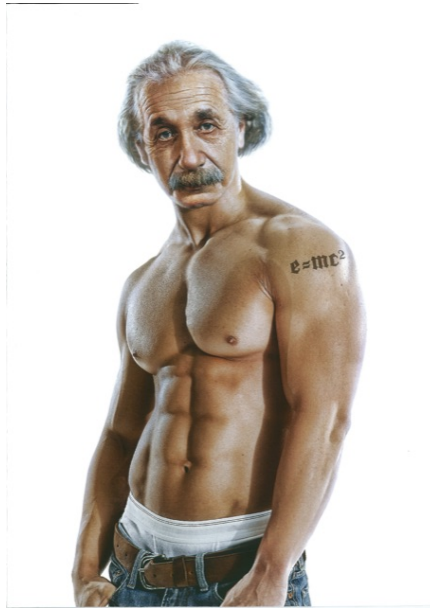
Persuasive?

C Procedures

There are no procedural prerequisites to owning a right of publicity, other perhaps than the vestigial suggestion (rejected in *Fraley*) that one must have commercially exploited one's likeness to sue for its appropriation. The most interesting procedural issue raised by the right of publicity is its duration.

32. Judge Kozinski resigned in disgrace in 2017 after being accused of sexual harassment and abusive behavior by numerous former clerks and staffers.

33. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing *en banc*).



GM Terrain ad

There is no serious dispute that one's right of publicity lasts as least as long as one's lifetime. The difficult question is how much longer than that it should last, if at all. In states that have adopted a postmortem right of publicity by statute, the legislature can simply pick a length; lengths range from 20 years (Virginia) to 100 years (Indiana), or even indefinitely (Tennessee). In states that have adopted one via common-law decision-making, it is a bit of an embarrassment for the court to have to pick a length essentially out of a hat. Consider the following analogies to the right of publicity:

- It is a personal privacy right that should endure perpetually, like the attorney-client privilege.³⁴
- It is a valuable property right that should endure perpetually.
- It is akin to a trademark and should endure as long as it is being commercially exploited.
- It is akin to a copyright and should endure for exactly as long as a copyright after death.
- It is akin to a copyright and should endure for a specific period after death.
- It is a personal autonomy right and should terminate on death.

Which of these rationales are persuasive?

For an example of a court doing the best it can, consider *Hebrew*

34. See *Swidler & Berlin v. United States*, 524 U.S. 399 (1998).

University of Jerusalem v. General Motors.³⁵ As the court summarized the facts:

Defendant General Motors LLC ("GM") used an image of Albert Einstein in a November 2009 advertisement for its 2010 Terrain vehicle. The ad depicted Einstein's face digitally pasted onto a muscled physique, accompanied by the written message "Ideas are sexy too." The ad ran in only one issue of *People* magazine. Plaintiff Hebrew University of Jerusalem ("HUJ"), which claims to own Einstein's right of publicity as a beneficiary under Einstein's will and thus exclusive control of the exploitation of his name and likeness, brought suit against GM for this unauthorized use of Einstein's image.³⁶

Einstein died in April 1955, some 54 years before the ad in question. The court ran through possible analogies, and then summarized other states' laws. In the end, the court drew on public policy considerations to limit the postmortem right to 50 years or less:

One of the overarching policy concerns in enforcing intellectual property rights is the balance that must be struck between protecting an individual's right to reap the benefits of his creative endeavors and the public's freedom of expression. This policy concern extends to the right of publicity.

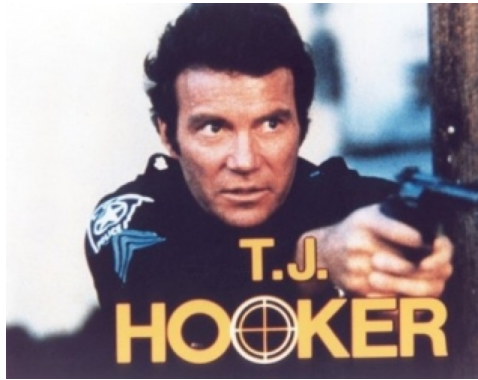
An open-ended right of publicity, or even a postmortem duration longer than 50 years, raises considerable First Amendment concerns and creates a potentially infinite curb on expression. Additionally, an extended right of publicity may interfere with or decrease the value of copyrighted works, such as photographs, thereby pitting one form of protected property against another.

In addition to First Amendment implications, there is another consideration. In the 57 years since Albert Einstein died, the means of communication have increased and so has the proclivity of people to use them frequently. Journalists, academics and politicians frequently issue pronouncements about the impact on society, both in the United States and around the globe, of the dizzying explosion in the tools of communication. New devices and platforms have been developed, including smart phones, personal computers, social networks, email, Twitter, blogs, etc. These technologies have caused a swift and dramatic, but still developing, impact on ordinary life. . . .

The Court does not profess to have answers to these questions, but what is clear is that since the full impact of these rapid

35. *Hebrew Univ. of Jerusalem v. Gen. Motors*, 903 F. Supp. 2d 932 (C.D. Cal. 2012).

36. *Id.*



William Shatner in *T.J. Hooker*

changes remains uncertain, it would be imprudent to issue any ruling that strengthens (or at least lengthens) one right – that of the right of publicity – to the potentially significant detriment of these other rights.

D 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. As the Restatement of Torts puts it:

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.

This is a trademark-influenced test. It emphasizes that the right of publicity is about using the plaintiff's identity because of its value *as the plaintiff's identity*.

Consider *Hooker v. Columbia Pictures Industries, Inc.*, where the plaintiff, T.J. Hooker, was a successful professional woodcarver who specialized in duck decoys.³⁷ He sued the producers of *T.J. Hooker*, a crime drama starring William Shatner that ran for 91 episodes on ABC and CBS between 1982 and 1986.³⁸

By his own admission, the commercial value of plaintiff's name

37. *Hooker v. Columbia Pictures Indus., Inc.*, 551 F. Supp. 1060 (N.D. Ill. 1982).

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

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.³⁹

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

It is also worth looking back at the subject matter cases through an identifiability lens. *Motschenbacher*, *Carson*, *Midler*, and *White* are all cases in which it was clear that the plaintiff was identifiable in the defendant's advertising. Perhaps the courts there conflated similarity with subject matter. Or perhaps that is precisely the point. Once identifiability is shown, there is no need for limiting subject-matter doctrines.

E Prohibited Conduct

As Eric E. Johnson observes, the standard blackletter descriptions of right of publicity are too broad to be taken literally.⁴⁰ A cause of action that truly protected against any "commercial use of their name, image, likeness, or other indicia of identity" would lead to incredibly broad liability.

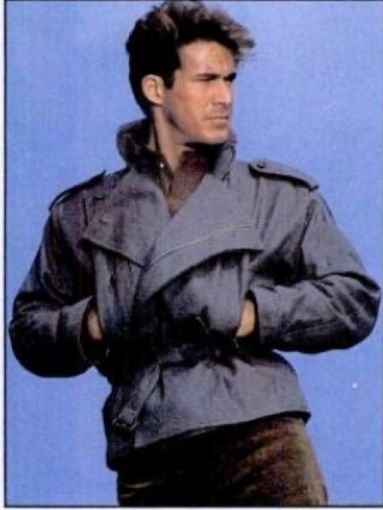
Imagine what would happen if people really could recover just because their names are being exploited commercially. Every credit reporting agency would shutter instantly. Every celebrity gossip magazine would be drowned in liability. And every company that sells customer lists to direct mailers and telemarketers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

In Johnson's view, the right of publicity is mostly kept in check by defenses (discussed below). As a result, there are only three kinds of conduct that the right of publicity really covers:

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

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

Yes, Giorgio
 From Giorgio Armani. Based on his now classic turn on the 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



The "Best Bets" item featuring Stephano

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 *merchandising 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 Commercial and Advertising Uses

The usual threshold rule is that the right of publicity only applies to commercial and advertising uses. There are some difficult boundary cases.

Consider *Stephano v. News Group Publications, Inc.*⁴¹ Tony Stephano, a professional model, posed for a photoshoot for an article in *New York* magazine on men's fall fashions. But the magazine also used one of the photographs from the session to illustrate its "Best Bets" column.

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 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."⁴²

The New York right of publicity statute covers only uses "for advertising purposes or for the purposes of trade."⁴³ The usual contrast is to "newsworthy" coverage. *New York* could have published a photograph of Stephano running for office, or winning a sporting event, or participating in a demonstration.⁴⁴ Stephano argued that the photo of him was not newsworthy because it was "a posed picture of a professional model taken at a photographic session staged by the defendant." But this misunderstood the test. What was newsworthy here was not *Stephano* but the *jacket he was wearing*.

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 was. 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, 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.⁴⁵

To be sure, *New York* included Stephano's picture to increase its circula-

41. *Stephano v. News Grp. Publ'ns, Inc.*, 64 N.Y.2d 174 (1984).

42. *Id.* Why wasn't this covered by a model release, you might ask? Stephano was injured at the photoshoot, and refused to sign a release. He sued only over the "Best Bets" article. Any thoughts?

43. N.Y. Civil Rights Law § 51

44. We will return to the newsworthiness exception in the Defenses section.

45. *Stephano*, 64 N.Y.2d 174.

tion and sell magazines. But that is true of everything between its covers, and not everything in a magazine is subject to the right of publicity. Only the ads are.⁴⁶

In other words, the trade-or-advertising threshold for the right of publicity tracks the publishing-world distinction between *editorial* content and *advertising* content. The magazine is a commercial enterprise, but only its advertising is commercial for right of publicity purposes.

Stephano also alleged that the "Best Bets" feature was "an advertisement in disguise."⁴⁷ But this was entirely speculative. There was no evidence that Armani, Barney's, Bergdorf Goodman, or Bloomingdale's paid *New York* to run this specific feature, even though they were regular advertisers.⁴⁸ And as the court noted, to impose liability for this kind of use would inhibit many common magazine features:

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.⁴⁹

2 Mental States

The caselaw is thin on whether violations need to be intentional to be actionable, but the (very slight) weight of the cases is probably that they do. In *Flake v. Greensboro News Co.*, for example, 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.⁵⁰ The court noted 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"⁵¹ and awarded only nominal damages.

For a more modern example, consider *Washington v. Brown & Williamson Tobacco Corp.*⁵² Brown and Williamson ran a music-themed ad campaign for its Kool cigarettes brand, with studio photographs of pro-

46. Where does this leave models like Stephano? If they have no right of publicity against editorial uses, how can they make a living?

47. *Stephano*, 64 N.Y.2d 174.

48. Can you think of a more cynical explanation?

49. *Stephano*, 64 N.Y.2d 174.

50. *Flake v. Greensboro News Co.*, 195 S.E. 55 (N.C. 1938).

51. *Id.*

52. *Washington v. Brown & Williamson Tobacco Corp.*, 223 U.S.P.Q. 1116 (E.D. Pa. 1984).

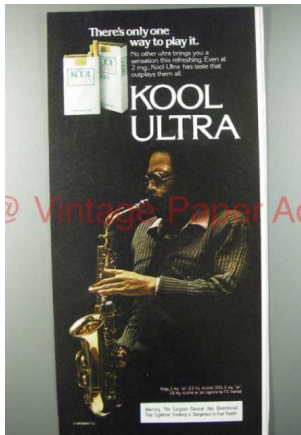


Greensboro Daily News ad misidentifying Nancy Flake as Sally Payne

fessional musicians playing their instruments. Two of the photographs featured Ronald L. Brown playing the saxophone; he was selected because he looked "appropriate."⁵³ Grover Washington, Jr., a significantly more famous jazz saxophonist, alleged that Brown looked sufficiently like him that the ads violated his right of publicity.

Brown and Williamson's defense was that any resemblance was entirely coincidental. The three employees who developed the ad campaign gave depositions in which they claimed they had never seen Washington or any photographs of him. Only one of them admitted having heard of him before he sued. Washington – who understandably could not produce direct evidence of their state of mind – responded with circumstantial evidence that he had been asked to perform in the Kool Jazz Festival and that the ads had run primarily in cities where he performed.

53. Discuss.



Kool ad featuring Ronald L. Brown



Grover Washington, Jr.

The important part for us is now who was right, but that the court treated this fundamentally factual question *as being relevant at all*. That is, it regarded the defendants' argument that the resemblance was coincidental as a viable defense.⁵⁴ Washington had a right of publicity claim if and only if Brown and Williamson intentionally evoked his identity.

F 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. Reflecting the origins of the right of publicity in the privacy torts, courts tend to draw on general tort principles as well as on IP-specific doctrines. In *Perfect 10, Inc. v. Cybernet Ventures, Inc.*, for example, the court adopted a joint-liability test from the Restatement (Second) of Torts:

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.⁵⁵

54. Big, if true.

55. Restatement (Second) of Torts § 876.

The attentive reader will recognize (b) as stating bog-standard contributory and inducement tests. Indeed, the court specifically looked to copyright and trademark law in understanding how to apply the contributory inducement standard to Cybernet, which provided age-verification services for pornographic websites, some of which displayed images for which the models had assigned their rights of publicity to the plaintiff, Perfect 10.

Along the way, the court discussed the fact that California's right-of-publicity statute contains an actual-knowledge threshold for "the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads."⁵⁶ This heightened protection for the media should be familiar from trademark law. Cybernet, as an age-verification provider, was not one of the protected media.

G Defenses

The most common defenses to the right of publicity should be familiar by now. But pay attention to the details; things may be different here than elsewhere.

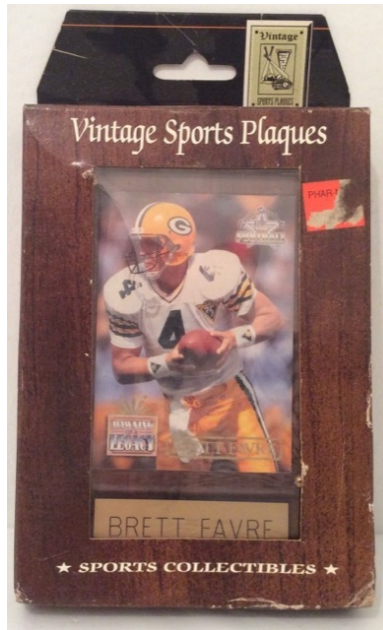
1 First Sale

There is a first-sale defense to the right of publicity, as there is to every other area of IP. As in trademark, first sale is not an absolute defense because it is easy to buy an item to which first sale applies and then use it in an infringing way. Suppose, for example, that a restaurant owner buys an autographed photograph of a famous singer on eBay and hangs the photograph by the host stand. The clear – and clearly false – implication is that the singer dined there and signed the photograph as an endorsement. The sale of the photograph is protected by first sale, but not hanging it up in the restaurant *in this way*. If the owner hung the photograph in her office instead, it would almost certainly be fine. This is essentially the same test as in the "explicitly misleading" prong of the nominative-fair-use test in trademark: the defendant cannot use the plaintiff's image to falsely claim endorsement.

Another important limitation can be seen in *Allison v. Vintage Sports Plaques*:

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.

56. Cal. Civil Code. § 3344(f).



Vintage Sports Plaque

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."⁵⁷

The court reasoned that Vintage's repackagings were protected because Vintage did not transform the cards into different goods.

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 "Hershiser Clock" or an "Allison Clock."⁵⁸

To see why the court thought this qualification was necessary, imagine a *Lee v. A.R.T. Co.*-style laminated remounting of a stock photograph of Elvis on a wall clock.

57. *Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998). The case was brought by baseball player Orel Hershiser and by the widow of race-car driver Clifford Allison.

58. *Id.*

Allison also contains a cogent explanation of the policy reasons why a first sale defense makes sense:

Indeed, a decision by this court not to apply the first-sale doctrine to right of publicity actions would render 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.⁵⁹

If the court thinks your proposed rule of law would make it illegal for children to trade baseball cards, you have lost.

2 Newsworthiness

Very, very, very loosely, newsworthiness incorporates some of the same concerns as nominative fair uses. The Restatement (Third) of Unfair Competition treats newsworthiness as defeating the "for purposes of trade" element of infringement.⁶⁰ Courts also describe newsworthiness as reflecting First Amendment concerns, which of course it does. The Restatement in particular says that newsworthy uses include "news reporting, commentary . . . works of . . . nonfiction, or in advertising that is incidental to such uses,"⁶¹ which include "the dissemination of an unauthorized print or broadcast biography."⁶²

For example, consider *Rosa & Raymond Parks Institute for Self Development v. Target Corp.*⁶³ Rosa Parks (1913–2005) was a civil-rights activist whose iconic refusal to move to the back of a racially segregated city bus started the Montgomery bus boycott in 1955. In 1987, she co-founded the Rosa and Raymond Parks Institute for Self Development to carry on her work, and after her death it held her posthumous right of publicity.

The Parks Institute sued the retail chain Target for selling a variety of Rosa Parks-themed items, but the court held that all of them were suf-

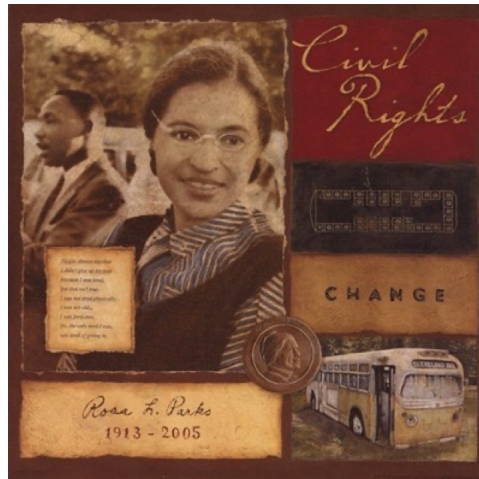
59. *Id.*

60. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995).

61. *Id.*

62. *Id.* § 47 cmt c.

63. *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.*, 90 F. Supp. 3d 1256 (M.D. Ala. 2015).



Rosa Parks plaque

ficiently newsworthy to protect Target from liability. The most obviously newsworthy were several biographies, such as *Who Was Rosa Parks?* (an illustrated book aimed at children) and *The Rebellious Life of Mrs. Rosa Parks* (a scholarly biography aimed at adults).⁶⁴ Biographies are categorically outside the right of publicity, regardless of whether they are authorized or unauthorized. As the court put it:

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.⁶⁵

A more interest case was presented by a plaque created by artist Stephanie Workman featuring images and phrases related to Parks and the bus boycott. This was not "news" as such, but the Restatement (Second) of Torts takes a broader view of the public interest:

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

64. Parks's own co-authored autobiography, *Rosa Parks: My Story*, perhaps belongs in a different category entirely. Can you think of any other defenses Target could raise to a suit for selling this one?

65. *Rosa & Raymond Parks Inst. for Self Dev.*, 90 F. Supp. 3d 1256.

to have a legitimate interest in what is published.⁶⁶

The court agreed:

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.⁶⁷

This has to be right, but can you do better at explaining why than the court did?

A related point is that when it is legal under the right of publicity to sell an item concerning the plaintiff, it is typically also legal to use the plaintiff's name and likeness to advertise the item. For example, in *Armstrong v. Eagle Rock Entm't, Inc.*, the defendant sold a DVD of a jazz concert at which the musician Ralph Armstrong performed.⁶⁸ The sale of the DVD was protected by copyright preemption (a topic for the Federalism chapter), but Armstrong also sued over the use of his picture on the back cover of the DVD package and in the liner notes. But given that the sale of the DVDs was legitimate, so was the accurate illustration of the contents of the DVD, and the historical contextualizing of the significance of the concert.⁶⁹

3 Expressive Uses

There is clearly breathing room in the right of publicity for expressive uses. If nothing else, the First Amendment requires it. But the Protean nature of the right means that it can be hard to pin down exactly what shape the expressive-use defense should take. It is tempting to borrow from copyright and trademark's expressive defenses – perhaps a little too tempting.

One of the leading jurisdictions in outlining an expressive-use defense has been California. In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the California Supreme Court took inspiration from the transformative-use test for fair use in copyright.⁷⁰ It held that a defen-

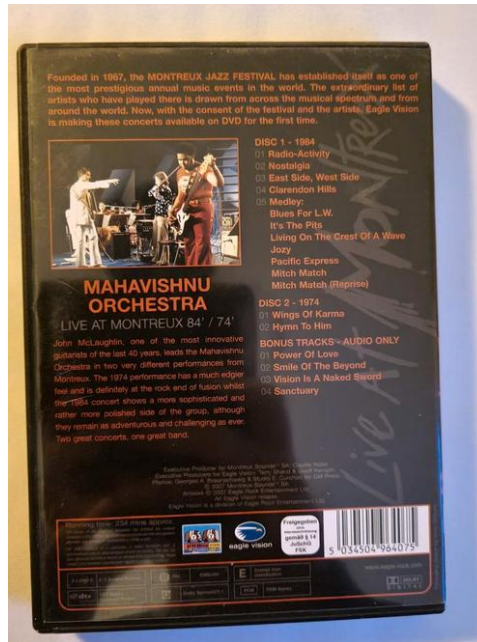
66. Restatement (Second) of Torts § 652D, cmt. j

67. *Rosa & Raymond Parks Inst. for Self Dev.*, 90 F. Supp. 3d 1256.

68. *Armstrong v. Eagle Rock Entm't, Inc.*, 655 F. Supp. 2d 779 (E.D. Mich. 2009).

69. Do you see why matters might have been different if Armstrong's picture had been used to illustrate a completely unrelated DVD?

70. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (2001).



The back cover of the *Mahavishnu Orchestra Live at Montreux 1984 / 1974* DVD. Armstrong is the bassist in red.

dant's use of a person's image is allowed when "the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."⁷¹ It contrasted "a literal depiction or imitation of a celebrity for commercial gain" in "conventional, more or less fungible, images," which the celebrity would be entitled to control, with one that is "primarily the defendant's own expression rather than the celebrity's likeness."⁷²

As an example of protected transformations, *Comedy III Productions* cited Andy Warhol's silkscreen portraits of celebrities like Marilyn Monroe 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 dehumanization of celebrity itself.⁷³

By contrast, Gary Saderup's lithographs and T-shirts with charcoal drawings of the Three Stooges were non-transformative.

In *Winter v. DC Comics*, the California Court held that an issue of the comic book *Jonah Hex* featuring characters inspired by the musicians

71. *Id.*

72. *Id.*

73. *Id.*



Andy Warhol silkscreen of Marilyn Monroe



Saderup's Three Stooges drawing

Johnny and Edgar Winter was protected.⁷⁴ The characters, Johnny and Edgar Autumn, were half-worm half-human villains who shared the Winter brothers' long white hair and pale features. The court explained:

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.⁷⁵

These "fanciful, creative characters" were different in kind from the "pictures of The Three Stooges" in *Comedy III Productions*.

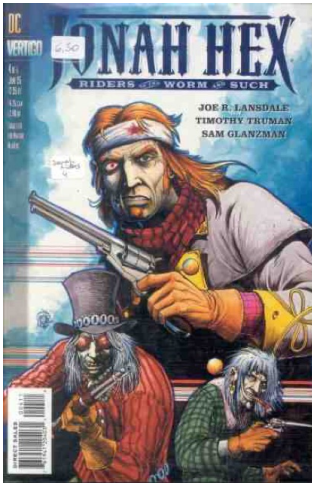
Then, in *Kirby v. Sega of America, Inc.*, a California appeals court dealt with a rhythm video game, *Space Channel 5*, in which the lead character, Ulala, is a reporter who must defeat aliens by matching their dance moves.⁷⁶ Ulala was allegedly inspired by Kieren Kirby a/k/a Lady Miss Kier, the lead singer of Deee-Lite. Ulala's retro-futurist wardrobe and hairstyle was the same as Kirby's, and even her name is a play on "ooh la la," a phrase Kirby sings in multiple Deee-Lite songs. Again transformative, said the court:

Ulala is more than a mere likeness or literal depiction of Kirby. . . . First, Ulala is not a literal depiction of Kirby. As discussed above, the two share similarities. However, they also differ quite a bit: Ulala's extremely tall, slender computer-generated

74. *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

75. *Id.*

76. *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Ct. App. 2006).



Jonah Hex cover

Ulala from *Space Channel 5*

physique is dissimilar from Kirby's. Evidence also indicated Ulala was based, at least in part, on the Japanese style of "anime." Ulala's typical hairstyle and primary costume differ from those worn by Kirby who varied her costumes and outfits, and wore her hair in several styles. 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. Finally, we agree with the trial court that the dance moves performed by Ulala – typically short, quick movements of the arms, legs and head – are unlike Kirby's movements in any of her music videos. Taken together, these differences demonstrate Ulala is "transformative," and respondents added creative elements to create a new expression.⁷⁷

A few other cases are interesting data points. In *ETW Corp. v. Jireh Publishing, Inc.*, the court held that a painting featuring images of the golfer Tiger Woods, with the Augusta National Clubhouse in the background, and images of other famous golfing champions looking down at him, was protected. In the court's view, it was a "panorama" and conveyed the message that Woods's accomplishments would make him an all-time golf legend like the other pictured golfers.⁷⁸

On the other hand, in *Hilton v. Hallmark Cards* a Hallmark card featuring Paris Hilton's head on a cartoon waitress's body was non-transformative because 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."⁷⁹

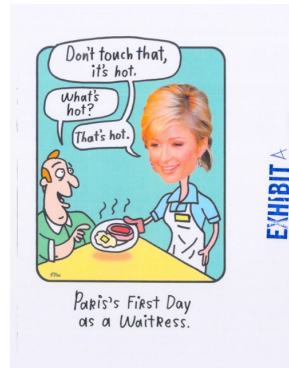
77. *Id.*

78. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

79. *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010).



Rick Rush portrait of Tiger Woods



Hallmark card featuring Paris Hilton



Band Hero screenshot

Problems

No Doubt

You work for the video-game publisher Activision. One of your successful franchises is the *Guitar Hero* series. Players use a guitar-shaped controller to play notes in time with animations on the screen. Several games in the series, including the forthcoming *Band Hero* include animated version of well-known musicians playing the songs of theirs that are included in the game. These animated version are produced by filming the actual bands in a motion-capture studio as the basis for their in-game avatars. The bands are compensated for their time, and have all signed off to approve the appearances of their avatars.

You have learned that *Band Hero*, which is scheduled to be released in two weeks, includes an "unlock" mode, in which players can use any band's avatars playing any of the songs included in the game. One of the bands included in *Band Hero*, No Doubt, has recently learned about un-



Arnold Schwarzenegger bobblehead doll

lock mode and strongly objects to it. The band's representatives claim that the contract they signed does not allow for the use of their avatars for non-No Doubt songs. You disagree that this is the proper interpretation of the contract, but you privately recognize that the contract is potentially ambiguous.

The engineering team reports that it will not be possible to remove unlock mode without causing the release date to slip by at least four weeks. The marketing team notes that unlock mode has already been heavily featured in the game's advertising. What is your advice?

Governator

You represent Arnold Schwarzenegger, the action-movie star who went into politics and served as governor of California from 2003 to 2011. What do you recommend doing about this bobblehead doll?

Tony Twist

Anthony Rory Twist is a retired hockey player. During his career with 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 Todd McFarlane's *Spawn* comic book series. MacFarlane is a hockey fan, who has sometimes given away copies of *Spawn* comic books as promotions at hockey games. He has a forthcoming appearance and signing scheduled at a New York Rangers game. You work for the Rangers' front-office operations and have just received a cease-and-desist letter from Twist, who alleges that the Twistarelli issues of



Spawn comic-book page

Spawn violate his right of publicity and demanding that you cancel the signing. What is your advice?