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The Wrong of Publicity

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The Wrong of Publicity

Abstract

The right of publicity has been, since at least 1977, a recognized concept. It was used, much like the other areas of intellectual property law to protect what a person had worked hard to create, in this case the concept of themselves. Their creativity in making themselves known and in having an "act" was worth protecting. However, the right of publicity has drastically changed since its conception. What is has become in the past almost forty years is a strange amalgamation of concepts, protected by laws that were never meant to be used to protect it in the first place. The time has come to take a hard look at the right of publicity, what it is meant to protect, and what we, as a country, should do with it. The right of publicity has long enjoyed protection under common law as a privacy Tort. Misappropriation of name or likeness has been the cause of action under which those whose right of publicity has been violated. Misappropriation has generally had three elements that must be satisfied to successfully bring a claim. One must show that 1. their name or likeness 2. has been appropriated, or used, 3. for another's benefit. These elements apply to anyone, not just to celebrities, and do not explicitly require a commercial benefit. However, the focus of most right of publicity cases is on celebrities and performers, and it is on these types of cases that this argument focuses. People lacking notoriety generally have remedies in common tort privacy law or in State privacy laws. It is from this basic tort framework that the body of right of publicity law has grown.

Keywords

right of publicity, privacy, First Amendment

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INTRODUCTION

The right of publicity has been, since at least 1977, a recognized concept. It was used, much like the other areas of intellectual property law to protect what a person had worked hard to create, in this case the concept of themselves. Their creativity in making themselves known and in having an "act" was worth protecting. However, the right of publicity has drastically changed since its conception. What is has become in the past almost forty years is a strange amalgamation of concepts, protected by laws that were never meant to be used to protect it in the first place. The time has

come to take a hard look at the right of publicity, what it is meant to protect, and what we, as a country, should do with it.

The right of publicity has long enjoyed protection under common law as a privacy Tort.¹ Misappropriation of name or likeness has been the cause of action under which those whose right of publicity has been violated.² Misappropriation has generally had three elements that must be satisfied to successfully bring a claim. One must show that 1. their name or likeness 2. has been appropriated, or used, 3. for another's benefit.³ These elements apply to anyone, not just to celebrities, and do not explicitly require a commercial benefit. However, the focus of most right of publicity cases is on celebrities and performers, and it is on these types of cases that this argument focuses. People lacking notoriety generally have remedies in common tort privacy law or in State privacy laws. It is from this basic tort framework that the body of right of publicity law has grown.

II. THE STATUTORY HISTORY OF THE RIGHT OF PUBLICITY AND ITS INCONSISTENCIES

Congress has declined to pass Federal laws governing misappropriation of likeness or the right of publicity. In the absence of a Federal scheme, about half of all States have codified the right of publicity as a distinct right or as part of the right of privacy. Unfortunately, even in those States where there are statutes regarding the right of publicity there is little consistency between these statutes. The scope of protection varies wildly between states. This leaves the right of publicity as an intellectual property right without any form of consistent national protection.

For purposes of illustration, this paper will discuss three prominent examples of statutes from New York, California, and Ohio. The New York statute creates a cause of action only for the use of the name, portrait or picture of a person for advertising or for purposes of trade *without written consent* [emphasis added].⁴ New York courts have stated this statute is designed to protect the right of publicity.⁵ New York does not recognize a posthumous right of publicity.⁶ New York courts have additionally limited

1. RESTATEMENT (SECOND) OF TORTS § 625C (Am. Law Inst. 1979).

2. *Id.*

3. *Id.*

4. N.Y. CIV. RIGHTS LAW § 51 (LexisNexis 2000).

5. *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 584 (N.Y. 1984).

6. *See, e.g., Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990).

the right of publicity to what is codified, eschewing any additional common law protection.⁷

California's right of publicity statute is much more expansive than New York's.⁸ California has chosen to protect a person's "name, voice, signature, photograph, or likeness".⁹ California also recognizes a posthumous right of publicity.¹⁰ California courts additionally recognize that common law protection beyond that which is codified is available.¹¹ The definition of "likeness" has been disputed in the courts many times, often to inconsistent results, as discussed below.

Ohio's statute prohibits the use of any aspect of one's *persona* without authorization.¹² Ohio defines a *persona* as "an individual's name, voice, signature, photograph, image, likeness, or distinctive appearance, *if any of these aspects have commercial value* [emphasis added]."¹³ Ohio additionally recognizes a limited posthumous right of publicity¹⁴ and explicitly defines the right of publicity as a transferable property right¹⁵.

These statutory differences create real issues for an individual seeking to protect their image. People, especially celebrities, generally have a national presence and are nationally recognizable. Celebrities work to create the exploitable goodwill in their image, much as businesses work to create goodwill in their brand. When a national business's brand becomes recognizable, the business can rely on certain national protections, while a celebrity's goodwill does not enjoy the same privileges.

III. FLAWS IN THE DEVELOPMENT OF CASE LAW IN THE RIGHT OF PRIVACY ARENA

Perhaps even more complicating than the inconsistencies in statutory law is the overarching Federal issue of freedom of speech. Many defendants in right of publicity cases raise the First Amendment as a defense to their use of a celebrity's image. In perhaps the most famous right of publicity case, *Zacchini v. Scripps-Howard Broadcasting Co.*, the United States Supreme Court held that a state *may*, but need not, privilege the press

7. *Id.*

8. CAL. CIV. CODE § 3344 (Deering 1995).

9. *Id.*

10. CAL. CIV. CODE § 3344.11.

11. *See e.g.*, *Lugosi v. Universal Pictures*, 603 P.2d 425, 448 (Cal. 1979).

12. OHIO REV. CODE ANN. § 2741.02 (LexisNexis 1999).

13. OHIO REV. CODE ANN. § 2741.01 (LexisNexis 2003).

14. *Supra* note 12.

15. *Supra* note 13; *Id.*

in using one's persona.¹⁶ However, since *Zacchini*, Courts have privileged uses of celebrity images, including those for commercial sale, stating that the uses were entitled to free speech protection.¹⁷

In order to understand the complications created by First Amendment issues, one must examine the development of the body of case law regarding the right of publicity. Right of publicity claims are rarely raised as the only cause of action in these types of cases, and that perhaps illustrates an issue with the right itself. It is hard to define the contours of the right, especially with the differences between state laws, so other claims, including unfair completion and trademark violation claims are usually raised alongside the violation of the right of publicity claims.

The United States Supreme Court has only addressed the Right of Publicity once, in *Zacchini*.¹⁸ Hugo Zacchini was a human cannonball who performed his act at a county fair.¹⁹ A reporter for the local news station filmed his performance over Zacchini's objections, and footage from his act was broadcast on the local news.²⁰ The Court recognized that "the broadcast of a film of petitioner's entire act poses a substantial threat to the economic value of that performance"²¹ and that the act is "the end result of much time, effort, and expense."²² The Court said that the broadcast of the "entire performance, *unlike the unauthorized use of another's name for purposes of trade...goes to the heart of petitioner's ability to earn a living as an entertainer [emphasis added].*"²³ The Court further stated that this was "the strongest case for a 'right of publicity'...the appropriation of the very activity by which the entertainer acquired his reputation in the first place."²⁴ The Court's analysis here makes it clear that it is not the use of Zacchini himself, but his act that should be protected from misappropriation. It is important to note again that despite the defendant's being a news station, the right of publicity *as to the act* outweighed the First Amendment defense raised by the station.²⁵ The *Zacchini* holding should have created a standard for further right of publicity claims, but it has not done so, to the detriment of the development of a consistent right.

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

17. See e.g., *ETW Corp. v. Jireh Pub. Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

18. *Zacchini*, 433 U.S. 562.

19. *Id.*

20. *Id.*

21. *Zacchini*, 433 U.S. 562.

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.*

The goal of the right of the publicity, according to the *Zacchini* court, is to protect the heart of the act of a performer. Celebrities and performers make their living off their “act”. Whether this act is a performance, as *Zacchini*’s was, or in any number of other ways by other celebrities, it is this protection that the right of publicity should be directed to. This approach, when applied, consistently protects the interests of celebrities. A few years after *Zacchini*, the District Court of New Jersey aptly applied the *Zacchini* theory in *Estate of Presley v. Russen*.²⁶ In *Russen*, an Elvis impersonator was sued by Elvis Presley’s estate for misappropriating his likeness in concert and on merchandise.²⁷ Russen put on a full act imitating Elvis Presley, singing his songs and acting like him.²⁸ Russen also produced merchandise featuring Presley’s likeness.²⁹ The *Russen* court held that despite an imitation of Presley being “in some measure, consistent with the goals of freedom of expression”³⁰, putting on an Elvis impersonation show without consent from the Estate was trading on the goodwill of Presley for commercial gain, and should be prevented.³¹ Elvis Presley, and then his estate, profited from his stage performances, music, and other aspects of his personality. Allowing someone to imitate this for commercial gain would go against the idea of protecting the commercial benefits generated by Presley’s act, just as allowing the broadcast of *Zacchini*’s human cannonball would harm his ability to profit from it.

Unfortunately, courts have strayed from this theory of protecting the act of a performer. In 1983, Johnny Carson, the famous late night host, brought an action against a portable toilet provider.³² The toilet provider used the name “Here’s Johnny Portable Toilets”.³³ Here’s Johnny used the name as a play on words for the colloquial term “john” for toilet and on the phrase used to introduce Carson on his late night show.³⁴ Carson brought claims under both trademark and right of publicity law, claiming that the phrase “Here’s Johnny” was part of his identity and that it was appropriated when it was used as the corporate name for the toilet provider.³⁵ The Sixth Circuit Court held that the trademark claims failed due to a lack of

26. Est. of Elvis Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981).

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.* at 1379.

31. *Id.*

32. Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983).

33. *Id.*

34. *Id.*

35. *Id.*

likelihood of confusion, and even that “Here's Johnny” was not such a strong mark that its use for other goods should be entirely foreclosed.”³⁶ Despite this finding, the court also found that “Here's Johnny” was a part of Johnny Carson's identity and that it was misappropriated in the naming of the company.³⁷ This finding goes far beyond the call of *Zacchini*, and broadens the Right of Publicity to an unacceptable level. “Here's Johnny” is not the heart of Carson's act. If the public is not confused as to Carson's association with the company, and “Here's Johnny” should not be foreclosed for uses outside of those that Carson himself uses, how the phrase could be an integral part of Carson's identity such that naming a company after it would be a violation of his right of publicity is puzzling. As Judge Kennedy in her dissent in *Carson* stated, this extension of the right of publicity allows celebrities, by associating themselves with words and phrases, “to remove those words from the public domain.”³⁸

The right of publicity was created to protect the goodwill which one has created in their fame, not to allow those who become famous to take away from the public what was already there. This goes against the theory behind all other forms of Intellectual Property. In creating the copyright and patent rights, the Constitution requires that the laws “further the progress of the Science and Useful Arts.”³⁹ The Lanham Act, even considering that it grants potentially perpetual rights to exclude competitors from using a mark associated with a business, forbids registration of marks that are merely descriptive or functional. This prohibits the acquisition of rights to words in the manner that the public already uses them.⁴⁰ Allowing the right of publicity to take away from the public is incongruous with the idea of protecting and giving to the public without any logical justification.

Cases continue to deviate, often times even further than *Carson*, from what the Supreme Court sought to protect in its holding in *Zacchini*. Courts have both brought in concepts from other areas of law to justify their decisions as well as unnecessarily implicated the right of publicity in cases where resolution of the claim did not require it.

In *Comedy III Productions Inc. v. Gary Saderup, Inc.*, the Supreme Court of California extended the right of publicity to cover drawings of celebrities.⁴¹ Gary Saderup drew realistic images of The Three Stooges,

36. *Id.* at 833-34.

37. *Carson*, 698 F.2d at 835.

38. *Id.* at 837.

39. U.S. CONST. art. I, § 8.

40. 15 U.S.C. § 1052 (1946).

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

copied the images onto shirts and sold the shirts.⁴² Comedy III Productions was the owner of the posthumous publicity rights of The Three Stooges and sued for violation of these publicity rights.⁴³ *Saderup* raised a free speech defense, claiming that the drawings were a creative work entitled to protection.⁴⁴ The *Saderup* court acknowledged that enforcing the right of publicity “has a potential for frustrating the fulfillment of [the purposes of the First Amendment].”⁴⁵ Following this acknowledgement, the Court adopted a modified version of the well-established transformative use test for fair use in *copyright law*.⁴⁶ In applying this test the Court declined to accept the argument that portraiture inherently has a creative element sufficient to constitute expression.⁴⁷ Instead the court, by comparing *Saderup*’s work to those of famous artist Andy Warhol, differentiated between accurate portraits and those that more obviously differ from a realistic portrayal.⁴⁸

The transformative use test, as described by the *Saderup* court, is “necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.”⁴⁹ This quote has spawned a myriad of cases applying the transformative use doctrine, but should never have been used. Bringing copyright law into the right of publicity arena simply does not fit. Copyright law, by its Constitutional directive, is meant to “promote the Progress of Science and useful Arts.”⁵⁰ The Copyright Law, after some time (political issues and extensions aside) gives what an author has created to the public, so that the knowledge and understanding of the general public increases. There is no progress associated with the right of publicity. What is protected by right of publicity law is generally a taking from the public of the right to create and use something, not a giving. There is too much of a difference in purpose between these areas of law to be so closely associating them as the body of case law has.

The argument that the First Amendment is implicated by necessity in a right of publicity case does not stand up to critique. The *Zacchini* Court deftly dealt with the First Amendment issues raised in the case without implicating additional tests from other bodies of law. The *Zacchini* Court noted that disallowing the broadcast of the human cannonball act did not

42. *Id.*

43. *Comedy III Prods., Inc.*, 21 P.3d 797 (Cal. 2001).

44. *Id.*

45. *Id.* at 397

46. *Id.* at 404-05.

47. *Id.* at 408.

48. *Id.* at 408-09.

49. *Id.* at 404.

50. U.S. CONST. art. I, § 8.

prevent the public from benefiting from it; it simply controlled who would profit from such broadcast.⁵¹ In the *Saderup* case, even assuming that the drawing was an accurate representation of The Three Stooges, the public would not have been deprived of the “appearance” of The Three Stooges by preventing Saderup from creating his shirts. There was no reason to reexamine the First Amendment issues already dealt with in *Zacchini*. By doing so, the *Saderup* Court started the right of publicity down a path that has created additional issues in understanding the limitations and reach of it. Further California cases have used this test extensively, and other jurisdictions have also adopted it.

Two years after *Saderup*, another right of publicity case reached the California Supreme Court. In *Winter v. DC Comics*, DC Comics created two villains named the Autumn Brothers for their “Jonah Hex” comic miniseries.⁵² The Autumn Brothers were half-worm, half-human creatures with features that clearly evoked the famous Winter Brothers musical group.⁵³ The claim was brought under the same California statute as that in *Saderup*, which as discussed earlier, protects a person’s “name, voice, signature, photograph, or likeness.”⁵⁴ The court followed logic parallel to that in *Saderup*, applied the transformative use test, and found that the Autumn Brothers here were “fanciful, creative characters.”⁵⁵ As such, the Winter Brothers’ right of publicity was not violated. Interestingly, the *Winter* Court cited cases that stood for the proposition that cases implicating the First Amendment, as right of publicity cases often if not always do, should be resolved quickly by summary judgment or demurrer, as lengthy litigation has a chilling effect on the exercise of free speech rights.⁵⁶ The Winter Brothers’ claim was raised in California tort law, which, in relevant part protects the likeness of a person. Here, rather than doing a lengthy analysis of whether the use was transformative, the case could have been easily resolved by showing that the Autumn Brothers were not a “likeness” of the Winter Brothers. The First Amendment was unnecessarily entangled here, as was the transformative use test.

California courts were faced with a similar issue in *Kirby v. Sega of America*⁵⁷, involved a dispute over a video game character. Sega created a

51. *Zacchini*, 433 U.S. 562, 578 (1977).

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

53. *Id.* at 476.

54. CAL. CIV. CODE § 3344 (Deering 1995).

55. *Winter*, 69 P.3d at 480.

56. *Id.*

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

character for their video game “Space Channel 5” named Ulala.⁵⁸ Ulala was a space reporter super hero.⁵⁹ Kierin Kirby was the lead singer of the band Dee-Lite and had a distinctive style of dress and dance when performing.⁶⁰ For purposes of the First Amendment discussion, the Court assumed that Ulala was based on Kirby, though there was significant evidence that she was not.⁶¹ The Court found that the potential use of Kirby’s likeness was transformative because of the significant differences in their dances, appearances, and setting.⁶² Here, again, such a test was not necessary. Had the Court stayed within the *Zacchini* framework, it would have been an easy resolution to the case; it is clear that Kirby’s act was not starring as a space reporter in a fanciful futuristic adventure, she was a singer.

Bringing in additional tests and bodies of law to right of publicity cases has become a recurring theme after *Saderup*, and *Winter*. In *ETW Corp. v. Jireh Publishing, Inc.*⁶³, the Sixth Circuit dealt with a mixed trademark and right of publicity claim. ETW, the corporation that owns the publicity rights of famous golfer Tiger Woods brought an action against Jireh Publishing for its creation of a painting depicting Tiger Woods winning The Masters while other golf champions looked on at him from the background.⁶⁴ The court fairly swiftly dismissed the trademark claims, but when addressing the right of publicity claims took two different approaches to the same argument. They first analyzed the case as to whether the painting got to the heart of Woods’ “act”, here his career as a professional golfer. The Court summarized this idea, saying “Woods, like most sports and entertainment celebrities with commercially valuable identities, engages in an activity, professional golf, that [sic] in itself generates a significant amount of income which is unrelated to his right of publicity.”⁶⁵ This statement shows an understanding that the right of publicity was, in *Zacchini*, meant to protect a celebrity doing *what they do*. The court even goes further, stating “It is not at all clear that the appearance of Woods’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.”⁶⁶ Had the court simply dismissed ETW Corp.’s claim on this basis, this case may have led to a refocusing of the right of publicity on what should be protected.

58. *Id.* at 610.

59. *Id.* at 616.

60. *Id.* at 609.

61. *Id.* at 609-17.

62. *Kirby*, 50 Cal. Rptr. 3d at 615-17.

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

64. *Id.*

65. *Id.* at 938.

66. *Id.*

Unfortunately, the Court felt obligated to address the transformative use test from *Saderup*.⁶⁷ While the *ETW* Court addressed the test for only a single paragraph and held that there was sufficient creativity to qualify for transformative use⁶⁸, addressing the test has caused the case to be cited in more recent right of publicity cases.⁶⁹

The transformative use test's extension reached the Third Circuit in *Hart v. Electronic Arts Inc.*⁷⁰ *Hart* and a nearly identical case from the same year in the Ninth Circuit, *Keller v. Electronic Arts Inc.*⁷¹, involved the use of the likenesses of college football players. Electronic Arts, in creating the teams featured in their annual *NCAA Football* games, modeled the rosters after the real-life rosters of the college teams featured.⁷² The players on each roster were designed to look like the real-life players on the rosters, including their physical appearance, jersey number, biographical facts, and vital statistics.⁷³ The names of the players were omitted, but players were readily identifiable by fans of the players or teams. In *Hart*, the Third Circuit Court of Appeals, citing *ETW v Jireh Publishing*⁷⁴, adopted the transformative use test and found that a realistic depiction of a college football player playing football, even without their names attached to their virtual representations, was not subject to First Amendment protection, as it failed the transformative use test.⁷⁵ The Ninth Circuit came to the same conclusion in *Keller*.⁷⁶ The Third and Ninth Circuits again unnecessarily entangled the transformative use test. These cases can easily be analogized to *Zacchini*. The college football players are famous for playing college football. The *NCAA College Football* games recreated them doing just that, playing college football. The football players' act was playing football, and without compensating them, Electronic Arts allowed those who played their games to see these athletes in the heart of their act, at the highest level of realism available to the video game medium.

While many cases regarding the right of publicity are resolved logically even when using the transformative use test, a pair of California cases similar to the college football cases illustrates a major issue with the

67. *Id.* at 939.

68. *Id.*

69. *See e.g.*, *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (6th Cir. 2013).

70. *Id.*

71. *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268 (9th Cir. 2013).

72. *Hart*, 717 F.3d 141; *Keller*, 724 F.3d 1268.

73. *Hart*, 717 F.3d 141; *Keller*, 724 F.3d 1268.

74. *Hart*, 717 F.3d at 153, 172.

75. *Id.* at 153.

76. *Keller*, 724 F.3d at 1271.

application of the transformative use test. Much like in the *NCAA Football* cases, Electronic Arts creates a series of *Madden NFL Football* games, which includes the names and likenesses of professional football players, and included the names and likenesses of historical great football players. In two separate suits, Jim Brown and another group of historic football players sued Electronic Arts over their inclusion in the games.⁷⁷ Brown sought relief under the Lanham Act, while the other group raised right of publicity, conversion, trespass to chattel, and unjust enrichment issues.⁷⁸ The factual situations are otherwise nearly indistinguishable. The Courts found that Electronic Arts was not liable to Brown, but would be to the other group.⁷⁹ By raising a Lanham Act claim, Brown had his right of publicity issues resolved under the *Rogers* trademark test⁸⁰, an analysis of which is tangential to this paper. The *Davis* Court performed the transformative use test for the other group of players.⁸¹ The *Davis* Court, like the *Hart* and *Keller* Courts, found that there were not enough transformative elements in the use of the players' likenesses.⁸² Once again though, had the Courts focused on the roots of the right of publicity and decided the case on whether the "act" of the players, i.e.: their endorsements and football play, was misappropriated, both cases would have been resolved the same way, instead of a different outcome for nearly identical cases. These cases illustrate the danger in mixing bodies of law when dealing with the right of publicity.

Perhaps no case better illustrates this danger, though, than a case involving the band No Doubt suing over their appearance in a video game.⁸³ No Doubt signed an agreement to appear, playing some of their songs, in the video game *Band Hero*.⁸⁴ The band performed extensive motion capture and modeling to appear as realistic avatars in the game.⁸⁵ The contract explicitly stated that the band was only to perform songs originally written by them.⁸⁶ However, when the game released, it was possible to use the No Doubt avatars to perform any of the songs in the game.⁸⁷ The court opted to

77. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013); *Davis v. Elec. Arts, Inc.*, No. 10-03328, 2012 WL 3860819 (N.D. Cal. March 29, 2012).

78. *Brown*, 724 F.3d 1235; *Davis*, 2012 WL 3860819.

79. *Brown*, 724 F.3d 1235; *Davis*, 2012 WL 3860819.

80. *Brown*, 724 F.3d at 1239.

81. *Davis*, 2012 WL 3860819.

82. *Davis*, 2012 WL 3860819, at *5.

83. *No Doubt v. Activision Pub., Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

84. *Id.* at 400.

85. *Id.* at 402.

86. *Id.* at 401-02.

87. *Band Hero* (Activision, 2009).

perform the transformative use analysis and implicate constitutional issues, finding that the use was not significantly transformative and the use of the avatars was not transformative and the right of publicity was violated.⁸⁸ While this was clearly the correct decision in light of the facts in this case, implicating the right of publicity at all was unnecessary and dilutes the body of right of publicity law. It is clear that No Doubt is a band that plays music, and going beyond the license to use realistic depictions of them playing music as they intended would violate their right of publicity, as this is analogous to the *Zacchini* situation. However, this was a clear breach of contract case; finding a breach of the contract, which the court did,⁸⁹ would have simply resolved this case properly. In fact, by going through the transformative use test and allowing Activision to raise a First Amendment defense here, the Court opened the door to allowing a clear violation of an intellectual property license to be defended in a scenario where the facts are slightly different. Muddying the waters of the case with additional unnecessary analysis was inefficient, unneeded, and harmful to a clear understanding of the right of publicity.

IV. UNNECESSARY CONSTITUTIONAL ENTANGLEMENTS WITH THE FIRST AMENDMENT

Much has been said about what a court should and should not decide, but it is perhaps most succinctly stated in American Jurisprudence, Second Edition: "Unnecessary decisions by a court are to be avoided"⁹⁰. When a case can be decided simply, it should be. There is no reasonable basis on which a Court must implicate complicated Constitutional issues where a controversy over the right of publicity can be resolved without doing so. As early as 1804, the United States Supreme Court held that "it is desirable to terminate every cause upon its real merits"⁹¹. None of the right of publicity cases, with perhaps the lone exception of *Saderup*, involving the First Amendment were, at their core, a matter of free speech.

Asking a court to go beyond the true call of the case to consider Constitutional issues has several potentially disastrous effects. First, a case may be decided incorrectly on its merits because the Court was forced to try to fit it into the First Amendment framework. The decision in *No Doubt*, though it was decided correctly, illustrates this possibility. Second, court

88. *No Doubt*, 122 Cal. Rptr. 3d at 410-11.

89. *Id.* at 405.

90. 20 AM. JUR. 2D *Courts* § 43 (2016).

91. *Church v. Hubbard*, 6 U.S. 187, 232 (1804).

time is valuable, and attorney time is expensive. Wasting so much time and money dealing with unnecessary constitutional debates violates every concept of judicial economy. Finally, the Constitutional entanglement encourages, if not requires, judges to create rules associated with the right of publicity. The creation of new criminal offenses by judges has long been prohibited⁹², but many judges in the right of publicity cases have found ways to extend the right to include new violations, as seen in the chain of cases discussed above.

V. NEW YORK'S RESOLUTION OF RIGHT OF PUBLICITY CASES

While several Circuits and State Courts have overcomplicated the right of publicity, New York's courts, using the relatively narrow statute in the State, have avoided unnecessary entanglements with other bodies of law. In *Brinkley v. Casablancas*, supermodel Christie Brinkley sued, amongst others, a poster distributor for violating her right of publicity.⁹³ Brinkley entered into an agreement to shoot photos for distribution on posters and to participate in a documentary on the process.⁹⁴ At some point in the process of producing the poster, Brinkley selected a photo for the poster, but at no point signed a written agreement that she agreed to its sale.⁹⁵ The poster was sold to distributors, and Brinkley sued.⁹⁶ The Court acknowledged that there were potentially issues with common law rights of publicity and potential defenses. However, it declined to reach these issues, as the court saw it unnecessary to go beyond the call of the case.⁹⁷ Sections 50 and 51 of the New York Civil Right Law explicitly require written consent to use a person's photograph in trade.⁹⁸ The defendants did not have written consent, and no further analysis was required.⁹⁹

It appears to be a trend in New York to quickly dispose of right of publicity claims according to strict statutory requirement, and only when necessary. In *Onassis v. Christian Dior-New York, Inc.*, the court declined to reach a right of publicity issue when a ruling as to the right to privacy

92. *Liparota v. United States*, 471 U.S. 419, 424 (1985).

93. *Brinkley v. Casablancas*, 438 N.Y.S.2d 1004 (N.Y. App. Div. 1981).

94. *Id.* at 1006.

95. *Id.*

96. *Id.*

97. *Id.*

98. NY CLS CIV. R. § 50-51 (2000).

99. *Brinkley*, 438 N.Y.S.2d at 1013.

accorded complete relief.¹⁰⁰ In *Jackson v. Odenat*, famous rapper 50 Cent sued the owner of a hip-hop website for posting pictures of him without consent in order to promote his site.¹⁰¹ Amongst his claims was a claim for the violation of his right of publicity. The court looked solely to the elements of the statute that comprise a violation of the right of publicity, and after finding that the pictures on the site were recognizable photos of 50 Cent, granted summary judgment on the matter.¹⁰² When members of the Sugar Hill Gang sued Snapple Beverage Company and Turner Broadcasting Company for violating their right of publicity, the court looked simply to whether there was written consent and whether their images and voices were actually used. After determining that there was no written consent and the images were used, the court granted summary judgment on the issue.¹⁰³

New York's volume of case law shows that it is possible to efficiently deal with right of publicity claims without extensive analysis and without the need to constantly implicate free speech issues. New York's statutory scheme is simple and straightforward, and New York Courts have declined to go beyond the call of the statute in protecting a right of publicity. That is not to say that the statute is perfectly designed. There are several issues, but it can serve as a starting point for resolution of the issues that have arisen in the law governing the right of publicity.

VI. A PROPOSAL

It is clear that a national standard is necessary. A celebrity's fame, image, likeness, and other attributes are not confined to one state, so it is hard to understand why what portions of the goodwill they have developed may vary depending on where they choose to live. The Lanham Act has long granted protection to brands for goods and services nationally, and it is hard to see how a likeness and a brand are significantly different enough that one should rely solely on state protections.

Federal right to publicity statutes have previously been proposed by several authors, including Susannah Rooney¹⁰⁴, Sarah Konsky¹⁰⁵, W.

100. *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984).

101. *Jackson v. Odenat*, 9 F. Supp. 3d 342 (S.D.N.Y. 2014).

102. *Id.* at 352.

103. *Robinson v. Snapple Beverage Corp.*, 55 U.S.P.Q.2D (BNA) 1501 (S.D.N.Y. 2000).

104. Susannah M. Rooney, Note, *Just Another Brown-Eyed Girl: Toward a Limited Federal Right of Publicity Under the Lanham Act in a Digital Age of Celebrity Dominance*, 86 S. CAL. L. REV. 921 (2013).

Woods Drinkwater¹⁰⁶, Kevin Vick and Jean-Paul Jassy in *Communications Lawyer*¹⁰⁷ magazine, and by the International Trademark Association¹⁰⁸, amongst many others. While many past proposals offer very solid statutory frameworks for a theoretical Federal statute, including rolling the right into the Lanham Act¹⁰⁹, borrowing concepts from trademark¹¹⁰ or copyright law¹¹¹ for a new statute, or drawing from current State law to harmonize them via an entirely new statute¹¹².

The proposal here is quite different. I contend that the right of publicity, as it is currently known, should be *entirely eliminated*. There need not be a replacement statute. The right of publicity does not need to be separately protected. Existing bodies of law, outside that of the right of publicity, exist to cover nearly every, if not every, protectable element of the right of publicity. This idea, understandably, likely just raised immediate concerns. Each of the immediate concerns that I anticipate will be addressed in turn.

VII. WHY THE RIGHT OF PUBLICITY IS NOT NECESSARY

The first concern I anticipate is that this is, in many ways, removing a property right from people who have invested in their persona. However, nothing is actually being taken away from anyone. To once again quote the *Jireh* court “[M]ost sports and entertainment celebrities with commercially valuable identities, [engage] in an activity...that in itself generates a significant amount of income which is unrelated to [their] right of publicity.”¹¹³ The removal of the right of publicity does not, in any way, prevent a celebrity, or any person, from profiting from their “act”. It is not the theoretical existence of a right of publicity that allows a celebrity to profit from the goodwill they accrue in themselves, it is the goodwill itself.

105. Sarah M. Konsky, *Publicity Dilution: A Proposal for Protecting Publicity Rights*, 21 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347 (2005).

106. W. Woods Drinkwater, Note, *Personality Beyond Borders: The Case for a Federal Right of Publicity*, 3 MISS. SPORTS L. REV. 115, 116 (2013).

107. Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Statute is Necessary*, 28 COMM. LAWYER, August (2011).

108. International Trademark Association, *Policy and Advocacy: Board Resolutions, U.S. Federal Right of Publicity*, (Mar. 3, 1998), <http://www.inta.org/Advocacy/Pages/USFederalRightofPublicity.aspx>.

109. Rooney, *supra* note 104.

110. Konsky, *supra* note 105.

111. Drinkwater, *supra* note 106.

112. Vick & Jassy, *supra* note 107; *Board Resolutions, U.S. Federal Right of Publicity*, *supra* note 108.

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

The celebrities can still be paid to endorse products, to appear at events, and to use their name and likeness in exactly the same ways they were before.

As mentioned above, many states do not have any statutory protection for the right of publicity. However, celebrities are still very much able to exploit their likeness in these states. In fact, in many cases, the states that do protect the publicity rights of celebrities have engaged in a "race to the bottom" not unlike the laws surrounding corporations and the resulting dominance of Delaware in that area. In 2008, after the death of Marilyn Monroe, California added a posthumous right of publicity to its statute, making it retroactive to a date prior to her death.¹¹⁴ Having states vying over the residency of celebrities can only lead to a broadening of the right of publicity, which has already become far too overbroad.

While holders of posthumous rights of publicity may feel like they are losing something, there are two simple solutions to this issue. The first is to come to the conclusion that the states that do not recognize posthumous rights of publicity are correct and simply eliminate them. The second, much less painful to those currently profiting from such rights, option, and the solution that seems more likely to gain any traction, is to phase out the posthumous rights. In states in which a posthumous right currently exists, the right will continue for the length of time the statute that created the right indicated, perhaps limited to 70 years at maximum (drawing the maximum length of a posthumous right of publicity to the posthumous limit imposed on copyrights¹¹⁵). With many states having already decided that the posthumous right of publicity should not exist, this issue is, if at all, only a short-term problem during, and immediately following, the elimination of the right of publicity, and even then only for the holders of the rights of those who were residents of some states at the time of their death.

Those without a valuable persona to protect are likely to feel like they are losing some aspect of their privacy. While this is technically a true statement, individual privacy rights would still be protected by the other three privacy torts recognized in the Restatement.¹¹⁶ Intrusion upon seclusion, publication of private facts, and publicity placing one in false light cover nearly every right that was covered before.

The strongest concern I anticipate being raised is that it will allow businesses, advertisers, and anyone else to use people's likenesses in any commercial way they choose. However, I argue that *this is already*

114. CAL. CIV. CODE § 3344.1 (Deering 1995).

115. 17 U.S.C. § 302 (1978).

116. RESTATEMENT (SECOND) OF TORTS § 652 (AM. LAW INST. 1965).

forbidden on the Federal level. The Lanham Act creates a Federal civil cause of action for anyone damaged by the use:

on or in connection with any goods or services, or any container for goods, uses in commerce *any* word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
(A) is likely to cause confusion, or to cause mistake, or to deceive as to *the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities* by another person...[emphases added].¹¹⁷

Any use of essentially anything that creates the impression of endorsement or association without approval is already forbidden by Federal trademark law. In fact, this statutory section has been described as the “the federal equivalent of the right of publicity”¹¹⁸, and was referred to as such in the now oft-cited *Jireh* case. This statute should already be preempting many of the right of publicity claims, but with the elimination of the right entirely, it will be clear that this will govern commercial uses of other’s image. Additionally the Federal Trade Commission has promulgated regulations handling the specific issues of endorsements of goods and services.¹¹⁹ States also have their own unfair competition statutes to supplement the Lanham Act where and when it may fall short of a local issue. There seems to be no reason to have any additional provision at all regarding the commercial use of one’s image or likeness without permission, as it is already covered by previously existing statutes and regulations.

Another major concern raised about eliminating the right of publicity is that it will outright invalidate a large body of case law and leave people uncertain about what could be protected. While one initial reaction to this may be that it is a positive thing that much of the messy, inconsistent case law will be outmoded, leaving those with personas they wish to protect without an understanding of what they have and what has been taken away is neither equitable nor intelligent. Fortunately, most, if not all, the right of

117. 15 U.S.C. § 1125(a) (1946).

118. *ETW Corp.*, 332 F.3d at 924 (referencing *Keller*, 724 F.3d 1268, the right of publicity).

119. 16 C.F.R. § 255 (2011).

publicity cases would be resolved the same, or for the better, even if the right of publicity was not a concept at the time of the case. While reanalyzing every case mentioned in this article would be too voluminous, discussing some of the more prominent cases should solidify this argument. The cases involving posthumous rights of publicity will not be discussed, as it seems likely to me that the right would be grandfathered in the cases where it already exists.

Carson v. Here's Johnny would certainly have been resolved against Carson, as his trademark claims failed for not having a strong enough connection to his brand, and he succeeded purely on the right of publicity claim.¹²⁰ This would certainly be to the public's benefit, as discussed above. Removing a common phrase from the public domain is never a positive result. *Winter v. DC*¹²¹ would have been resolved identically, but without the need for a lengthy discussion of the first amendment. The Autumn Brothers do not create any confusion as to any real association with the Winter Brothers, and the resolution of the claim is the same, but far more simple. *No Doubt*¹²², perhaps the most troubling of the right of publicity cases, would have quickly been disposed of as a breach of contract action.

There may be a few minor gaps in coverage regarding that which should be protected, but these gaps are a small price to pay for the consistency, order, and understanding that would be provided by the elimination of the right of publicity. The small town street performer may not be protected by the Lanham Act because he does not interact with interstate commerce, but if he so chooses, in today's age, crossing state lines to perform and market his show does not require a large budget or much effort. If any other major gaps do emerge after the elimination of the right of publicity, Congress can always act to close them. Congress has previously added collective and certification marks to the Lanham Act¹²³, so there is no reason that Congress could not add an additional specific protection if a gap is found to be exploited.

With most concerns about such a radical change in the law hopefully assuaged, discussing some of the positive results likely to occur if the right of publicity were to be eliminated. One clear benefit is that the majority of cases involving the misuse of images would be brought under the Lanham Act. While trademark law is not completely consistent and perfectly clear, it is certainly better handled than right of publicity issues. There are

120. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

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

122. *No Doubt v. Activision Pub., Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

123. 15 U.S.C. § 1125 (1946).

established tests for what qualifies as confusion in the trademark context¹²⁴, and they seem to function well in most cases. This would also allow for most cases to be handled in Federal court, where judges are often familiar with the Lanham Act and its implications.

Aside from judicial economy, there are real practical benefits to the elimination of the right of publicity. Parties entering into deals regarding a person's name or image will know that the terms of their contract dictates what uses they can make, as going outside or beyond those uses would likely constitute a Lanham Act unfair competition violation. Essentially, contract law would govern contracts, trademark law would govern trademarks and service marks, copyright law would govern copyrights, and constitutional entanglements, which are inherently undesirable, would be reduced. There would need to be little to no mixing of the intellectual property bodies of law in this area. Those wishing to use one's image for their own personal non-commercial use would not be stopped from doing so, indirectly promoting the arts. Most importantly, there would no confusion about what parts of one's personal goodwill would be protectable.

Ironically, it may seem that Zacchini would be out of luck without a right of publicity. On the contrary, he had a solution. He needed only to record his act, whether by videotape or by writing down the steps he would take during the show, just as one would copyright any other choreography¹²⁵, before performing! It would then be a copyrightable piece and he could sue for copyright infringement in a fairly straightforward case.

The right of publicity has become an out of control mess of differing statutes, judicially made law and Constitutional confusion. It is time to put an end to the unnecessary right and allow the statutes we already have to protect what they were created to protect.

124. See *e.g.*, *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

125. 17 U.S.C. §102 (1976).