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## The Celebrity Behind the Brand International Protection of the Right of Publicity

Eliana Torres

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# The Celebrity Behind the Brand International Protection of the Right of Publicity

## Abstract

Part I of the article provides an overview of the right of publicity and its history. It presents the importance of this right, particularly for celebrities, and it focuses on the influence of the entertainment and sports industries in a global economy. Then, it analyzes the major differences in level of protection, scope and length, starting with the United States. Then it uses the standard in the United States and compares it with the protection offered in 22 selected jurisdictions based on a survey report by Kenyon & Kenyon titled Getting the Deal Through. Then, it addresses potential challenges to the current approach and the issues that arise from having different standards in every jurisdiction. Part II of the article provides a solution to the current issue. It proposes adopting a provision into the TRIPs Agreement.<sup>15</sup> The last section of Part II analyzes the impact of this proposal in a global spectrum. Lastly, Part III addresses the potential criticisms of the proposal.

## Keywords

celebrity, right of publicity, privacy, TRIPs, international law

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## THE CELEBRITY BEHIND THE BRAND INTERNATIONAL PROTECTION OF THE RIGHT OF PUBLICITY

*Eliana Torres*

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## INTRODUCTION

Suppose, for example, that you were a famous pro-basketball player recognized worldwide. During an international trip abroad you see that a store is advertising underwear with your name and picture on it. After walking into the store, your image and name are in the underwear being sold. The manufacturer never secured rights for the use of your likeness. However, in bringing an action against the manufacturer, some jurisdictions like India, deny the right of publicity to non-citizens.<sup>1</sup> While others, like the United States, are divided over whether foreign individuals can claim this right, particularly, individuals from jurisdictions that do not recognize this right.<sup>2</sup> Thus, the potential for an individual from one country to have his identity used for commercial purposes in another country or in multiple ones is a vivid concern.<sup>3</sup>

Needless to say, the right of publicity plays a critical role in protecting the image of celebrities.<sup>4</sup> Generally, the right of publicity is recognized as the “right of an individual to control the use of his or her name, likeness or other personal attribute for commercial purposes.”<sup>5</sup> The above hypothetical is a clear example of the growing need for international protection of this right. For example, there are over 30,000 major international sporting events per year and numerous companies take advantage of the large audience attracted by these events. Several industries use the image of the participating athletes to advertise their goods without offering any compensation. Consequently, this scenario is mostly prevalent in the sports and entertainment industries.<sup>6</sup> Celebrities are the most vulnerable to exploitation because of “their considerable marketability.”<sup>7</sup> Thus, their identity can be used and abused by third parties in connection with advertising and commercial activities.<sup>8</sup>

Given the importance of the right of publicity, there must be legal standards set in place to protect the individuals most vulnerable to image exploitation. However, it is evident that there is a problem with the current

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1. Jonathan D. Reichman, Kenyon & Kenyon LLP, Right of Publicity in 21 Jurisdictions Worldwide, GETTING THE DEAL THROUGH 1, 3 (2014), <http://www.kenyon.com/NewsEvents/Publications/2013/11-13-Getting-the-Deal-Through-Right-of-Publicity-2014.aspx>.

2. *Id.* at 4.

3. *Id.* at 3.

4. *See infra* p.123-4.

5. *Id.* at 1.

6. *Global Sports Impact Project*, SPORTS MARKETING INTELLIGENCE, <http://www.sportcal.com/Impact/Default.aspx> (last visited Oct. 29, 2014).

7. Reshma Amin, *A Comparative Analysis of California's Right of Publicity and the United Kingdom's Approach to the Protection of Celebrities: Where Are They Better Protected?* 1 CASE W. RESERVE J.L. TECH. & INTERNET 92, 93 (2010).

8. *Id.* at 3.

approach. There are critical differences in protection of the right of publicity in the United States and around the world.<sup>9</sup> Some nations offer little to no protection, such as the United Kingdom, which does not even recognize the right.<sup>10</sup> Meanwhile, other countries offer a wide scope of protection, like Japan, which extends protection to individuals' signatures.<sup>11</sup> Most importantly, the right of publicity is not mentioned in any international treaty by the WTO such as The Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs"). Thus, nations are not required to offer protection to foreign citizens. The fundamental principle of the WTO is to encourage trade without discrimination, this is known as the national treatment principle.<sup>12</sup> Under this principle, nations must provide the same level of protection offered to their citizens to foreign individuals (citizens from nations signatory of the WTO).<sup>13</sup> Unlike other forms of Intellectual Property, the right of publicity remains excluded from this principle.

In response, this comment proposes the implementation of an international statute within TRIPs recognizing the right of publicity. The adoption of a statute is intended to result in a harmonized approach to protect the interests of WTO countries.

Part I of the article provides an overview of the right of publicity and its history. It presents the importance of this right, particularly for celebrities, and it focuses on the influence of the entertainment and sports industries in a global economy. Then, it analyzes the major differences in level of protection, scope and length, starting with the United States. Then it uses the standard in the United States and compares it with the protection offered in 22 selected jurisdictions based on a survey report by Kenyon & Kenyon titled *Getting the Deal Through*.<sup>14</sup> Then, it addresses potential challenges to the current approach and the issues that arise from having different standards in every jurisdiction. Part II of the article provides a solution to the current issue. It proposes adopting a provision into the TRIPs Agreement.<sup>15</sup> The last section of Part II analyzes the impact of this proposal in a global spectrum. Lastly, Part III addresses the potential criticisms of the proposal.

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9. *Id.* at 3.

10. Reichman, *supra* note 1, at 3.

11. *Id.*

12. Agreement on Trade Related Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 33 I.L.M. 1125 (1994) [hereinafter TRIPs Agreement or TRIPs], at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](http://www.wto.org/english/docs_e/legal_e/27-trips.pdf).

13. *Id.*

14. Reichman, *supra* note 1.

15. TRIPs, *supra* note 11, art. 3.

## I. WHY DO WE NEED AN INTERNATIONAL RIGHT OF PUBLICITY?

It was only 50 years ago that the right of publicity began evolving from being almost non-existent to being almost widely accepted today.<sup>16</sup> In recent years, technology advancement and the global rise of social media have opened the door for the commercial exploitation of one's name or likeness to become part of international transactions.<sup>17</sup> Currently, celebrity and sport-stars endorsements surpass national boundaries and both common law and civil law countries are beginning to reassess the lack of protection of the right of publicity.<sup>18</sup> As presented below, the right of publicity is an ever-expanding right but the critical differences in protection by jurisdictions around the world create a large disparity in treatment and protection.

### A. *The Right of Publicity Defined*

The right of publicity is defined by Black's Law Dictionary as "[t]he right of individual, especially public figure or celebrity, to control commercial value and exploitation of his name or picture or likeness or to prevent others from unfairly appropriating the value for their commercial benefit."<sup>19</sup> Most courts around the world did not recognize this right until the late 50's.<sup>20</sup> The United States first saw the court use this concept in 1953.<sup>21</sup> Korea's first time discussing the right of publicity was in 1992, in the case of actor James Dean.<sup>22</sup> Thus, the definition can vary depending on the source.<sup>23</sup>

In the United States, the right of publicity originated from privacy and property law.<sup>24</sup> It developed from situations in which individuals required protection from commercial exploitation but privacy law would not offer

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16. Marshall Leaffer, *The Right of Publicity: A Comparative Perspective*, 70 ALB. L. REV. 1357, 1358 (2007).

17. Emily Grant, *The Right of Publicity: Recovering Stolen Identities Under International Law*, 7 SAN DIEGO INT'L L.J. 559, 561 (2006).

18. *Id.*

19. BLACK'S LAW DICTIONARY, 1325 (6th ed. 1990) (citing *Presley's Estate v. Russen*, 513 F. Supp. 1339, 1353 (D.C.N.J. 1981)).

20. Grant, *supra* note 17.

21. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

22. Hyung Doo Nam, *The Emergence of Hollywood Ghosts on Korean Tvs: The Right of Publicity from the Global Market Perspective*, 19 PAC. RIM L. & POL'Y J. 487, 488 (2010) (Heirs of James Dean brought an action against an underwear manufacturing company for use of James' name and likeness to advertise their products).

23. Eric J. Goodman, *A National Identity Crisis: The Need for A Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. 227, 229 (1999).

24. *Id.* at 230.

adequate protection.<sup>25</sup> The right of publicity was first separated from privacy law in the seminal case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>26</sup> This case involved the use of photographs of baseball players in trading cards by manufacturers of chewing tobacco.<sup>27</sup> In *Haelan*, the Second Circuit held that individuals could license or assign their images, and licensees and assignees could enforce this right against infringement by third parties.<sup>28</sup> It was in the opinion by Judge Frank that the “the right of publicity” was coined:

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 . . . [and] to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made ‘in gross’ . . . This right might be called a ‘right of publicity.’<sup>29</sup>

Since *Haelan*, nineteen states in the United States have codified the right of publicity and twenty-eight more states recognize the right by means of common law.<sup>30</sup>

### B. Rationale

There are two leading arguments in the discussion on what justify the right of publicity. The first one is the Lockean “labor theory,” which professor Nimmer argues as the rationale for recognizing the right.<sup>31</sup> The second one is the economic theory based on utilitarian principles.<sup>32</sup>

Under the Lockean theory endorsed by Nimmer, a person is entitled to the fruits of his or her own labor.<sup>33</sup> In other words, the celebrities’ efforts merit legal protection. This theory was advanced in a Supreme Court decision recognizing the right of publicity, where the Court analogized the state’s interest in protecting the performance of the individual with the goals of copyright and patent law.<sup>34</sup> The Court stated:

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25. Alexander Margolies, *Sports Figures’ Right of Publicity*, 1 SPORTS LAW. J. 359 (1994).

26. *Haelan*, 202 F.2d 866.

27. *Id.*

28. *Id.*

29. *Id.* at 868.

30. *Statutes*, THE RIGHT OF PUBLICITY.COM, <http://rightofpublicity.com/statutes> [hereinafter *Statutes*] (last visited Nov. 1, 2014).

31. F. Jay Dougherty, *Foreword: The Right of Publicity-Towards A Comparative and International Perspective*, 18 LOY. L.A. ENT. L.J. 421, 441 (1998).

32. *Id.* at 443.

33. *Id.* at 441.

34. Margolies, *supra* at 360.

The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which [the defendant] would normally pay.<sup>35</sup>

Supporters of this theory argue that if a celebrity is not able to control the commercial exploitation of their image after it becomes valuable then the incentive to continue doing socially valuable things might diminish.<sup>36</sup> This theory was also advanced by the Supreme Court in *Mazer v. Stein*, 347 U.S. 201, 219, 74 S.Ct. 460, 471(1954). There, the Court analogized with the philosophy behind the protection granted to patents and copyrights. The Court has stated the “philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors. . . . Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”<sup>37</sup> Thus, both Lockean and Economic theories equally justify the right of publicity.

### C. *Economic Importance*

There are enormous economic stakes in the merchandising of celebrities, athletes and public figures, but there is no protection offered to prevent the misuse of their image.<sup>38</sup> Industries are widely interested in the growth of their market through the use of the cross-cultural influence of endorsement deals.<sup>39</sup> This is because celebrities as endorsers “confer a unique ability to transcend the traditional entertainment” market.<sup>40</sup> The use of endorsers results in brand awareness and higher potential sales.<sup>41</sup>

In addition to their strong influence on consumers, the growth of social media and technology has allowed companies and advertisers to break national barriers and reach international consumers.<sup>42</sup> The expanding economic landscape and globalization of cultural influencers make

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35. Margolies, *supra* at 360.

36. *Id.*

37. *Mazer v. Stein*, 347 U.S. 201, 219, 74 S. Ct. 460, 471, 98 L. Ed. 630 (1954).

38. Leaffeer, *supra* at 1357.

39. *Id.*

40. Emily Grant, *The Right of Publicity: Recovering Stolen Identities Under International Law*, 7 SAN DIEGO INT'L L.J. 559, 561 (2006).

41. *Id.*

42. Natasha T. Brison & Thomas A. Baker III, Kevin K. Byon, *Tweets and Crumpets: Examining U.K. and U.S. Regulation of Athlete Endorsements and Social Media Marketing*, 23 J. LEGAL ASPECTS SPORT 55, 56 (2013)

merchandising of celebrities a huge international business.<sup>43</sup> Endorsers have the power to reach millions of consumers through multiple sources of social media. Advertisements are distributed internationally and with the Internet in the front page of merchandising, there is no boundary for incorporating celebrities in both content and advertising.<sup>44</sup> Nevertheless, as the market and potential for endorsement expands, the opportunities for “unauthorized third parties to profit from the fame of these athletes” increase.<sup>45</sup> As a consequence, the right of publicity has become the “essential legal right in protecting the entertainment industry.”<sup>46</sup>

#### D. *The Lack of International Harmonization*

There is no unifying body of international law on the right of publicity.<sup>47</sup> Unlike the intellectual property right of trademark, copyright and patent law, there is no international treaty or convention to address the right of publicity.<sup>48</sup> Every jurisdiction treats the right of publicity differently. Thus, depending on the geographical location in which an individual resides, there are different levels of protection offered.

##### 1. The United States

The right of publicity is unique to the United States.<sup>49</sup> It grew out of an economic policy framework<sup>50</sup> and it was perceived from the natural right of privacy.<sup>51</sup> It became recognized as a property right after the decision in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>52</sup> Thereafter, Professor Nimmer explored the inadequacy of traditional privacy law to protect the right of publicity, which became the foundation for this concept.<sup>53</sup> Today, scholars characterize this right as “a combination of personal rights, intellectual property rights, and rights against unfair competition.”<sup>54</sup> They

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43. F. Jay Dougherty, *Foreword: The Right of Publicity-Towards A Comparative and International Perspective*, 18 LOY. L.A. ENT. L.J. 421 (1998).

44. *Id.*

45. Abib Tejan Conteh, *The Right of Publicity in Sports: Athletic and Economic Competition*, 3 DEPAUL J. SPORTS L. & CONTEMP. PROBS. 136, 137 (2006).

46. Nam, *supra* at 497.

47. Reichman, *supra* at 3.

48. *Id.*

49. Grant, *supra* at 562.

50. Grant, *supra* at 562.

51. Dougherty, *supra* at 424.

52. Haelan, 202 F.2d 866.

53. Margolies, *supra* at 360.

54. Grant, *supra* at 564.

also recognize the frequent overlap with trademark infringement and unfair competition claims and lack of protection under the Lanham Act.<sup>55</sup> Regardless, presently there is no federal right of publicity. It is a matter of state law.

As previously mentioned, there are nineteen states that have codified the right of publicity and twenty-eight more states that recognize the right by means of common law.<sup>56</sup> There are other states that have tried to codify the right but have not succeeded.<sup>57</sup> In 2009 North Carolina proposed legislation to address the right of publicity but did not enact it.<sup>58</sup> Most recently, in March 31, 2015 the Arkansas governor vetoed a bill that would establish the right of publicity in the state of Arkansas.<sup>59</sup> Moreover, of the states that recognize the right, the majority assert that only human persons possess it.<sup>60</sup> A minority view that expands this right to cover musical groups.<sup>61</sup> Furthermore, a majority of states does not require commercialization to offer protection.<sup>62</sup> All individuals including non-celebrities can have an enforceable right of publicity.

a. Scope

There is a broad range of protection among the states.<sup>63</sup> The states that recognize this right extend the protection only to the individual's name and either his or her likeness.<sup>64</sup> The only exceptions are New York and California. New York protects: name, portrait picture and voice.<sup>65</sup> California protects: any aspect or combination of aspects of an individual's persona that serves to identify him.<sup>66</sup> On the broader end of the spectrum is Indiana. Indiana extends protection to: name, voice, signature, photograph, image, likeness, distinctive

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55. See *Board Resolution Approving a U.S. Federal Right of Publicity*, INT. TRADEMARK ASSOC., [hereinafter INTA], <http://www.inta.org/Advocacy/Pages/USFederalRightofPublicity.aspx> (last visited Feb. 4, 2015).

56. Reichman, *supra* note 1, at 78.

57. Statutes, *supra* note 28.

58. *North Carolina Right of Publicity Law*, DIGITAL MEDIA LAW PROJECT (May 4, 2013), <http://www.dmlp.org/legal-guide/north-carolina-right-publicity-law>.

59. *Governor Hutchinson's Veto Letter to Senate Concerning SB79*, ARKANSAS GOVERNOR (Mar. 3, 2015), <http://governor.arkansas.gov/press-releases/detail/governor-hutchinsons-veto-letter-to-senate-concerning-sb79>.

60. Reichman, *supra* note 1, at 78.

61. *Id.* at 4.

62. *Id.* at 3.

63. Reichman, *supra* note 1, at 79.

64. *Id.*

65. *Id.* at 78.

66. *Id.* at 79.

appearance, gestures, or mannerisms.<sup>67</sup> There is even more controversy over the length of a postmortem right.<sup>68</sup> The scope of protection can also be limited after the individual's death.<sup>69</sup> The states are split over the recognition of a post mortem right.<sup>70</sup> It varies from 20 years under Virginia law to 100 years under the statute in Indiana and Oklahoma.<sup>71</sup> Adding to the disparity, Nebraska does not even specify the length of protection after death and New York and Wisconsin expressly reject the right post mortem.<sup>72</sup> The majority recognizes it but require some form of formalities in order to offer protection.<sup>73</sup> Utah requires the right to be commercialized during the lifetime of the individual.<sup>74</sup> Tennessee requires continuous exploitation even after death.<sup>75</sup>

b. Formalities

No state currently requires any registration of an individuals' right of publicity in order to receive protection.<sup>76</sup> However, a number of states require registration in order to offer protection post mortem.<sup>77</sup> Nevada, for example, is one of the states that allow registration of a deceased persons' postmortem right of publicity.<sup>78</sup> If registered, third parties must make a reasonable effort to discover the identity of a successor in interest of the deceased in order to use the right of publicity of the deceased person for commercial purposes.<sup>79</sup>

c. Transferring or Licensing

The right is freely alienable and transferable in gross.<sup>80</sup> It is also divisible; an individual can assign his or her right in his or her name to one party and his right or her likeness to another party.<sup>81</sup>

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67. *Id.* at 79.

68. Jeffrey A. Lindenbaum, *Fifteen Minutes of Fame can Generate Fifteen Decades of Royalties*, COLLEN IP 1, 9 (Jan. 31, 2009), <http://www.collenip.com/newsletter/publicityrights/>.

69. Reichman, *supra* note 1, at 3.

70. *Id.* at 78.

71. *Id.* at 80.

72. Lindenbaum, *supra* at 9.

73. Reichman, *supra* at 80.

74. *Id.*

75. *Id.*

76. *Id.* at 79.

77. *Id.*

78. NEV. REV. STAT. § 597.800(7).

79. NEV. REV. STAT. § 597.800(5).

80. Reichman, *supra* at 79.

81. *Id.*

d. Infringement

There is infringement when an individual has a valid enforceable right, a protected aspect of his or her persona is used without permission, in a commercial context, and the individual is injured as a result.<sup>82</sup> Some states require that the unauthorized use cause damage to the value of the person.<sup>83</sup>

e. Damages

Usually, compensatory and punitive damages are available in the states recognizing the right.<sup>84</sup> Injunctive relief is also available and some states allow the destruction of the material that infringed the right.<sup>85</sup> Some injunctions extend nationwide, even extending over states that do not recognize the right of publicity.<sup>86</sup> In determining compensatory damages, the court will try to determine the fair market value of the use of the image of the individual harmed.<sup>87</sup>

f. Protection for Foreign Nationals

In the United States, the States are split on whether to offer protection to foreign nationals.<sup>88</sup> This has been mostly controversial when dealing with individuals that reside in countries that do not offer protection at all like the United Kingdom.<sup>89</sup> The United States has dealt closely with this issue in California, where the successors of Princess Diana attempted to enforce her publicity rights against third parties in the United States.<sup>90</sup> There, the California court had to decide whether the post-mortem right of Diana, who died a domiciliary of Great Britain, was enforceable in the United States.<sup>91</sup> The court decided that there was nothing to pass on because the United Kingdom does not recognize the post-mortem right of publicity like California.<sup>92</sup>

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82. *Id.* at 80.

83. *Id.*

84. *Id.* at 81.

85. *Id.* at 82.

86. *Id.*

87. *Id.* at 78.

88. *Id.* at 4.

89. *Id.*

90. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002).

91. *Id.*

92. *Id.*

## 2. Elsewhere

Using the United States as a threshold standard, there are significant differences around the world in protection of the right of publicity. Some have argued that the differences are a result of the difference in culture, philosophies, and history.<sup>93</sup> For example, the United States views the right as a commercial property, while Italy views it as a fundamental personal right that cannot be detached from the individual.<sup>94</sup> Similarly, Spain and Portugal combine both approaches.<sup>95</sup> In 2014 Kenyon & Kenyon published *Getting the Deal Through-Right of Publicity*.<sup>96</sup> The publication surveyed 22 jurisdictions worldwide and analyzed the right of publicity within those jurisdictions from a practitioner's point of view. This Article will use the findings of this survey to compare the state of the right of publicity in the 22 jurisdictions mentioned and it will complement the findings with other independent law reviews to formulate and support the thesis presented.

### a. Scope

There are numerous differences in scope of protection. For example, Japan protects the individuals' signature,<sup>97</sup> meanwhile, only one state in the United States, Indiana, extends protection to this element of the person. Similarly, France extends protection to individuals' title, nobility and family motto.<sup>98</sup> Nevertheless, France has experienced controversy as to whether the right is solely a personal right or whether it should be considered a property right.<sup>99</sup> Thereby, France protects personality rights but limits the protection for known facts and images of public figures.<sup>100</sup> Germany protects the concepts of "an absolute person of contemporary history" which allows the protection of character or description of an individual part of history.<sup>101</sup> Portugal also protects a family's name.<sup>102</sup> Israel offers a broad and ambiguous protection.<sup>103</sup> It extends to any characteristic that uniquely belongs to a

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93. Dougherty, *supra* at 423.

94. *Id.* at 434.

95. Reichman, *supra* note 1, at 3.

96. *Id.*

97. *Id.*

98. Dougherty, *supra* at 434.

99. *Id.*

100. See *Right of Publicity*, PROJECT GUTENBERG, [http://self.gutenberg.org/articles/Right\\_of\\_Publicity#Guernsey](http://self.gutenberg.org/articles/Right_of_Publicity#Guernsey) (last visited Apr. 4, 2015).

101. *Id.*

102. Reichman, *supra* note 1, at 3.

103. *Id.*

person.<sup>104</sup> A number of jurisdictions, such as Greece, Austria, Argentina and Spain offer protection “for any element of a persona that serves to identify a person in the mind of the public.”<sup>105</sup> Hong Kong is currently dealing with an ongoing dispute between Cantopop singer Andy Lau and Hang Seng Bank over the use of the singer’s images on credit cards.<sup>106</sup> The United Kingdom does not recognize the right of publicity.<sup>107</sup> However, “passing off” is a possible cause of action but it is limited in application because it is based on the law of unfair competition.<sup>108</sup> The closest source of protection in the United Kingdom is the right of privacy, which has been introduced as a Human Rights Bill that would incorporate the European Convention on Human Rights into British law and directly mentions the right of privacy.<sup>109</sup> However, this bill is still pending in parliament.<sup>110</sup> Canada bases the right on unfair competition law.<sup>111</sup> It is the closest system to the United States because the Canadian provinces differ in protection offered and scope.<sup>112</sup> The Island of Guernsey offers one of the broadest scope of protection by allowing five categories: natural person, legal person, two or more natural persons or joint personalities, group or teams, and fictional characters of human or non-human being.<sup>113</sup> Namely, personalities such as Homer Simpson, a fictional cartoon character, would qualify for protection in Guernsey.<sup>114</sup>

Furthermore, jurisdictions offer the right during a persons’ life but only a small number offer the right post mortem such as Argentina, Brazil, France, Germany, Mexico, Spain and Russia.<sup>115</sup> The Island of Guernsey, with its most recent ordinance, allows humans to register up to 100 years after the date of death.<sup>116</sup>

## b. Formalities

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104. Reichman, *supra* note 1, at 3.

105. *Id.*

106. Jane Moir, *Andy Lau Takes Bank to Court Over Use of Name*, SOUTH CHINA MORNING POST (Mar. 11, 1999), <http://www.scmp.com/article/275142/andy-lau-takes-bank-court-over-use-name>.

107. Dougherty, *supra* at 433.

108. *Id.*

109. *Id.* at 434.

110. *Id.*

111. *Id.* at 436.

112. *Id.*

113. The Image Rights (Bailiwick of Guernsey) Ordinance, § 1(1) (2012) [hereinafter Guernsey], <http://www.guernseylegalresources.gg/article/104749/Image-Rights-Bailiwick-of-Guernsey-Ordinance-2012>.

114. Reichman, *supra* note 1, at 59.

115. Reichman, *supra* note 1, at 59.

116. Reichman, *supra* note 1, at 3.

Most jurisdictions do not use formalities as a condition to right of publicity protection. However, Russia requires that a person's name be registered at birth.<sup>117</sup> Other jurisdictions require registration for the protection of the post mortem right, like some states in the United States.<sup>118</sup> In addition, there is a requirement to prove economic value in some jurisdictions like Israel. Thus, individuals have a right of publicity but it is limited to those who can prove economic value in their image.<sup>119</sup> Similarly, Japan limits the right to "persons of distinction."<sup>120</sup>

Most notable is the case of the Island of Guernsey. In December 2012, the Guernsey enacted an Image Rights registry, which allows the registration of personality rights and associated image.<sup>121</sup> The requirement for registration is not based on commercial value like in the majority of states in United States that protect the right of publicity.<sup>122</sup> Instead, in order to bring a claim for infringement, the image must meet two elements; (1) it must be distinctive or recognized in association with the registered personality by a relevant part of the public anywhere in the world; (2) it must have actual or potential value, likely to be exploited because of its value.<sup>123</sup> Furthermore, a personality may register his or her image by presenting an application to the intellectual Property Office in Guernsey.<sup>124</sup>

c. Transferring or Licensing

Similar to the differences between states in the United States, jurisdictions are divided over the right to transfer or license someone's image. Greece, India and Japan allow the right to be freely transferred.<sup>125</sup> Whereas, the France and Mexico allow licensing but not transferring and Austria prevents both.<sup>126</sup> The Island of Guernsey allows the transfer of image rights to third parties by virtue of an assignment.<sup>127</sup> Similarly, Jamaica allows a personality right to be transferred by disposition.<sup>128</sup>

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117. Reichman, *supra* note 1, at 3.

118. *Id.*

119. *Id.*

120. *Id.*

121. Guernsey, *supra* at 1(1)(e)(5).

122. Reichman, *supra* note 1, at 3.

123. Guernsey, *supra* at 27(2)(b).

124. Guernsey, *supra* at 11.

125. Reichman, *supra* at 4.

126. Reichman, *supra* at 4.

127. Guernsey, *supra* at 58(8)(2)(d).

128. *Right of Publicity*, *supra* note 98.

d. Infringement and Damages

Infringement may be the only area where there are not as many differences. There is infringement when the right of publicity is misused or used with no compensation by another, which results in damage to the individual.<sup>129</sup> Similarly, the United States damages available are also offered in most jurisdictions, with the exception of Austria, France, Mexico and Spain, which provide for a publication of the judgment as part of the judgment. Only a few offer punitive damages, such as India.<sup>130</sup>

e. Protection for Foreign Nationals

Analogous to the United States dilemma, most other jurisdictions are split over the protection offered to foreign citizens. *Reichman* presents India as an example, where a foreign individual is not entitled to the protection of the right of privacy offered by the constitution.<sup>131</sup> However, he points out, individuals may still receive protection of some statutory rights.<sup>132</sup> France only applies French law to events occurring in France and if there is a publication outside of France, French Courts will not offer relief except to any harm occurred in France.<sup>133</sup> Italy, on the other hand, offers protection to citizens and noncitizens for violations of the “personality right.”<sup>134</sup> Brazil and Argentina offer similar protection for interest similar to the right of publicity.<sup>135</sup> However, it is unclear whether they would offer protection to a foreign national.<sup>136</sup> Guernsey offers protection under its Image Rights Registry to all individuals regardless of citizenship.<sup>137</sup> Likewise, Germany allows protection for foreign nationals but limits foreign verdicts for punitive damages as unenforceable.<sup>138</sup> Japan offers the same protection and limitations for foreign nationals and verdicts.<sup>139</sup>

*E. The Problems Caused by the Lack of International Standards*

There are two major problems with the lack of harmonization. First,

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129. *Right of Publicity*, *supra* note 98.

130. *Id.*

131. *Reichman*, *supra* at 4.

132. *Id.*

133. *Dougherty*, *supra* at 433.

134. *Id.*

135. *Id.*

136. *Id.*

137. *Guernsey*, *supra* at 7(7).

138. *Reichman*, *supra* at 41.

139. *Id.* at 69.

there are too many substantive differences between jurisdictions. Second, there is a major problem caused by the lack of national treatment.

#### 1. Problem Caused by Lack of Substantive Harmonization

The popularity of the image of individuals extends to the international market. There is now a single market for popular figures rather than a geographic limit as it was before. Everyone knows LeBron James and Miley Cyrus across nations. However, it is evident that there are critical differences in protection of the right of publicity by jurisdictions around the world. Thus, disputes are inevitable unless a harmonized standard is set in place. The globalization of celebrities and the growing technological landscape creates opportunity for more infringement worldwide. In form of analogy, the Anti-Counterfeiting Trade Agreement (“ACTA”) was established as a response to the similar issue, the lack of international harmonization of anti-counterfeiting measures.<sup>140</sup> The arguments made in favor of ACTA by the European Commission are similar to the arguments that can be made in favor of the harmonization of the right of publicity.<sup>141</sup> The European Commission stated:

The proliferation of intellectual property rights (IPR) infringements poses an ever-increasing threat to the sustainable development of the world economy. It is a problem with serious economic and social consequences. Today, we face a number of new challenges...the speed and ease of digital reproduction; the growing importance of the Internet as a means of distribution...[a]ll these factors have made the problem more pervasive and harder to tackle.<sup>142</sup>

This is a rationale that is also applicable to the right of publicity. Technological advances and modernization are generating more pervasive challenges faced by celebrities whose image is compromised. This becomes a bigger issue when Individuals cannot be protected at all by some jurisdictions and protected in others to extent of their signature.<sup>143</sup> For example, in Italy, one of the countries that recognize the right of publicity, the Court of First Instance of Milan decided in the case of actress Audrey Hepburn that this right extended to the use of elements that merely evoke the

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140. Council of the European Union, *Council Resolution on a Comprehensive European Anti-counterfeiting and Anti-piracy Plan*, OFFICIAL WEBSITE OF THE EUROPEAN UNION (last visited October 30, 2014), [http://www.consilium.europa.eu/ueDocs/cms\\_Data/docs/pressData/en/intm/103037.pdf](http://www.consilium.europa.eu/ueDocs/cms_Data/docs/pressData/en/intm/103037.pdf).

141. *Id.*

142. *Id.*

143. *See Reichman, supra note 1, at 3.*

celebrity involved.<sup>144</sup> There, elements of Audrey Hepburn's image were being used in advertisements with a cat that evoked her persona.<sup>145</sup> There are other recent controversies that have arisen from this same context. In February 2015, Bleacher Creatures, a company headquartered in the state of Pennsylvania, announced their newest product Pope Francis dolls.<sup>146</sup> However, there has been no statement made by the company in regards to the license used for the image of the Pope.<sup>147</sup> Given the wide range of popularity of the Pope, there would be multiple venues where this doll could be sold and liable for infringement of his image. The wide range of protection and limitations around the world would also make any possible claim a complex matter for both parties. The result would be disparate because of the lack of harmonization.

## 2. Problems Caused by Lack of National Treatment

Because of the fast globalization of commerce, it may be necessary to pursue claims in foreign courts. However, the lack of protection and over protection around the world results in disparate treatment and unfavorable consequences for individuals.<sup>148</sup> Scholars have noted that the inconsistent doctrines governing publicity rights have the potential effect to "harm litigants and the judicial system as a whole."<sup>149</sup> Intellectual property rights are harmonized by conventions such as the Paris Convention, Berne Convention and TRIPs. These important conventions apply the national treatment principle.<sup>150</sup> This principle operates by according nationals of other member states the same treatment afforded by treaty members' nationals.<sup>151</sup>

This principle of national treatment has been incorporated in most national and international laws. It derived from natural law, most specifically

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144. Eleonora Rosati, *Evoking Audrey Hepburn's Image in an Ad is Not Okay, Says Italian Court* (Feb. 9, 2015), <http://ipkitten.blogspot.com/2015/02/evoking-audrey-hepburns-image-in-ad-is.html>

145. *Id.*

146. *Pope Francis has Arrived... as a Plush Doll*, CNN MONEY (Feb. 16, 2015), <http://money.cnn.com/2015/02/16/smallbusiness/pope-francis-plush-doll/index.html>

147. *Id.*

148. Amin, *supra* at 93.

149. Kyle D. Simcox, *Selling Your Soul at the Crossroads: The Need for A Harmonized Standard Limiting the Publicity Rights of Professional Athletes*, 63 DEPAUL L. REV. 87, 103 (2013).

150. The Berne Convention for the Protection of Literary and Artistic Works, art. 5(2), (Sept. 9, 1886; revised July 24, 1971 and amended 1979; entered into force for U.S. Mar. 1, 1989 (Sen. Treaty Doc. 99-27)) 1986 U.S.T. Lexis 160 or 1 B.D.I.E.L. 715 [hereinafter Berne Convention]; TRIPs, *supra* note 11, art. 3.

151. George B. Delta & Jeffrey H. Matsuura, *Law of the Internet*, § 5.04 (3d ed. 2013).

from general fairness principles.<sup>152</sup> According to The World Intellectual Property Organization (“WIPO”) one of the reasons which lead to this principle was the understanding that “authors by nature should be able to benefit everywhere from their natural property” and therefore should be recognized as authors with given rights in foreign countries.”<sup>153</sup> This principle, however, is only applicable to the other intellectual property rights (copyright, trademark and patents) through the respective treaties protecting them. The right of publicity cannot be afforded national treatment principles under current law. The right of publicity is equally as important in the development of the world economy and should be afforded equal protection like the rest of the intellectual property rights. There are courts around the world that have dealt shed light to the issues that the lack of national treatment presents. The Princess Diana case mentioned earlier is notably one of these major cases. Along the same context, in the 1985 case of *Bi-Rite Enterprises Inc. v. Bruce Miner Co.*, members of the three different pop groups succeeded in bringing an injunction to prohibit the use of their image in posters that were being commercialized.<sup>154</sup> This is an example where foreign nationals were able to protect their right of publicity regardless of their residency. However, the same result may not be achieved if the same claim was brought in a country where there is no protection like the United Kingdom or where there is no protection for foreign nationals like in India. Furthermore, if the court deciding these cases were one where punitive damages are awarded, this award would not be enforceable in other jurisdictions, such as Germany and Japan, where foreign punitive damages are not enforceable. This scenario was presented in a recent case in the United Kingdom where United States resident Rihanna, a famous singer, sued Topshop, clothing company, for selling t-shirts with her image.<sup>155</sup> There, the court decided “[t]here is in English law no “image right” or “character right” which allows a celebrity to control the use of his or her name or image.”<sup>156</sup> However, the court allowed Rhianna to succeed on a passing off action.<sup>157</sup> If the elements of “passing off” would not have been met, Rhianna wouldn’t have any other course of action in the United Kingdom, where the shirts were being sold. This is a big issue

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152. Dr. Silke Von Lewinski, *Intellectual Property, Nationality, and Non-discrimination*, WORLD INTERNATIONAL PROPERTY ORGANIZATION (last visited October 30, 2014), [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_unhchr\\_ip\\_pnl\\_98/wipo\\_unhchr\\_ip\\_pnl\\_98\\_6.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_unhchr_ip_pnl_98/wipo_unhchr_ip_pnl_98_6.pdf).

153. *Id.* at 15.

154. *Bi-Rite Enterprises, Inc. v. Bruce Miner Co., Inc.*, 757 F.2d 440 (1st Cir. 1985).

155. Eleonora Rosati, *Rihanna T-Shirt: Court of Appeals says It’s Passing Off*, THE IPKAT (Jan. 22, 2015), <http://ipkitten.blogspot.com/2015/01/court-of-appeal-confirms-that-sale-of-t.html>.

156. *Id.*

157. *Id.*

for celebrities who are citizens of a different country where they reside and whom are likely to be exploited in the multiple countries where they are popular.

## II. PROPOSING A SOLUTION: INCORPORATING A STATUTE INTO THE TRIP'S AGREEMENT

This comment proposes adopting a provision into the TRIPs Agreement. A new provision under a current international treaty would set minimum standards to recognize the right of publicity in already WTO signatory countries to harmonize it. The provision sets clear standards defining the criteria for an individual to qualify for protection of the right of publicity. Additionally, it defines what the right of publicity is and what it protects. It also breaks down the provision into the major areas of issue outlined in Part I. The first part of the provision determines the scope of protection. It then presents the formalities to qualify for protection. Lastly, it would determine the length for protection.

### A. *Structure Under TRIPs*

The TRIPs Agreement is a treaty administered by the WTO to which 158 countries are signatory members.<sup>158</sup> This comment proposes the adoption of an additional article under TRIPs as the potential solution. The new provision under an already enacted and enforceable international treaty would set minimum standards to recognize the right of publicity in already WTO signatory countries. Under this scheme, the scope of protection would extend to celebrities resulting in a harmonized system of enforcement.

#### 1. Structure of the Statute

An additional obligation to protect the right of publicity under TRIPs would fit under Part II, Section 1 Titled: Copyright and Related Rights, after Article 14.<sup>159</sup> The additional provision emulates the same objective behind the inclusion of Article 14 into TRIPs.<sup>160</sup> Under Article 14, TRIPs protects the rights of performers, producers of phonograms, and broadcasting organizations.<sup>161</sup> It protects these individuals and entities from having the

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158. Alain J. Lapter, Esq., *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford A Global Perspective on the Right of Publicity*, 15 TEX. INTELL. PROP. L.J. 239, 310 (2007).

159. TRIPs, *supra* note 11, art. 14.

160. *Id.*

161. TRIPs, *supra* note 11, art. 14(3).

fixation of their performance on a phonogram undertaken without authorization.<sup>162</sup> This adoption is narrowly tailored to the protection of performers by reference to the Rome Convention.<sup>163</sup> Article 3 of the Rome Convention of 1961 defines performers “actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works.”<sup>164</sup> Similarly, this comment proposes a narrowly tailored scope of protection for celebrities, as recognized and defined by the courts in the United States.

## 2. Proposed Text of the Statute

In order to guarantee a feasible system for enforceability, the proposed provision is narrowly tailored to protect the rights of a smaller class of individuals. A draft of the right of publicity as Article 15 would look like the following:

### Article 15

#### Protection of The Right of Publicity: Persona and Image Rights

1. In respect of the use of an individuals’ likeness for commercial use without prior consent from the individual or the individual’s successor-in-interest, the individual shall have the possibility to prevent such use of his or her persona or image.<sup>165</sup>
2. Infringement shall occur when the individual’s image or persona is used for a commercial purpose without authorization and from such use the individual is ‘readily identifiable’ when one who views the image with the naked eye can reasonably determine that it is such natural person depicted in the image.<sup>166</sup>
3. Rights in Persona and Image shall last for the lifetime of the Registrant plus a period of fifty (50) years after the death of the Registrant.<sup>167</sup>
4. Rights in Persona and Image vest in the right-holder regardless of whether such rights were commercially exploited during that individual’s lifetime by either that individual or a licensee or assignee<sup>168</sup> and shall be deemed exclusive to the individual, or

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162. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Oct. 26, 1961, (Rome 1961), 496 U.N.T.S. 43, reprinted in 3 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD (Supp. 1978) [hereinafter Rome Convention].

163. TRIPs, *supra* note 11, art. 3, 4.

164. Rome Convention, *supra* note 125, art. 3.

165. See 15 U.S.C. § 1125(a)(1) (1998); CAL. CIV. CODE §§ 990(a), 3344(a); TENN. CODE ANN. § 47-25-1105(a) (1997).

166. *Id.* at 317.

167. See TENN. CODE ANN. §47-25-1104(a).

168. Lapter, *supra* note 121, at 322.

licensee or assignee of such rights, for the full duration of such rights as protected under this statute.<sup>169</sup>

5. The individual rights provided for in this statute are considered property rights and are freely assignable and licensable.<sup>170</sup>
6. After the death of any individual, the rights under this statute shall belong to the successor-in-interest.<sup>171</sup>
7. Members shall provide limitations and exceptions to exclusive rights to certain special cases that do not conflict with a normal exploitation of the Persona or Image and do not unreasonably prejudice the legitimate interests of the right-holder, such as fair use and newsworthiness.<sup>172</sup>

### 3. Elements of The Statute

In order to provide the best enforcement mechanism, the draft of The Right of Publicity: Persona and Image Rights draws various elements from court decisions in the United States, as well as state statutes. The following part of this comment discussed the elements it draws and the benefits of adopting them into an international provision into TRIPs.

#### a. Commercial Value as a Limitation

To qualify for protection an individuals' persona must be used for commercial value as stated in the first sentence under Section 1 of the proposed statute. This means that an individual qualifies for protection if the individual can prove that his or her persona or image has commercial value and he or she intends to profit from that value.<sup>173</sup> This definition of what it means to have commercial value would be included in the definitions section of the statute. The definition of commercial value, for purposes of this provision, shall be proven by the distinctiveness of the identity and by the degree of recognition of the person among those receiving the publicity.<sup>174</sup> Commercial value is what this paper justifies as the requirement to be deemed a 'celebrity or public figure' in order to receive protection. This definition exemplifies and expands what it means to have commercial value in one's image or persona. This requirement is essential to narrow the scope of protection for a more enforceable provision.

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169. *Id.* at 323.

170. *See* TENN. CODE ANN. §47-25-1103(b).

171. *See* CAL. CIV. CODE § 990(d).

172. INTA, *supra* note 53.

173. *Id.* at 386.

174. *Id.*

The scope of protection offered by the drafted provision is more likely to be enforced because it is narrowly tailored to celebrities. It has been articulated by some courts in the United States that they “sense a difficulty in allowing any individual to sue under the right of publicity” because it conflicts with the duty of the court not to unduly restrict commercial speech.<sup>175</sup> This justification is based on the fact that non-celebrities do not have any commercial value to be protected and no other countervailing right is being harmed in right of publicity cases. Instead, privacy right is the appropriate route for private citizens. This was expressed by The Supreme Court of Georgia which held that “the right of publicity historically grew from the need to protect property rights of celebrities or public figures, the right of publicity applied only to public figures, while the right of privacy applied to private citizens.”<sup>176</sup>

Furthermore, this article also suggests that to determine when an individual has gained commercial value, the test derived from the decision in *Cheatham v. Paisano Publications, Inc.* should be adopted.<sup>177</sup> There, the court decided that “celebrity status “should not be an absolute prerequisite” but plaintiffs must establish ‘commercial value’ which can be shown by ‘(1) the distinctiveness of the identity and by (2) the degree of recognition of the person among those receiving the publicity.”<sup>178</sup> The author of this paper believes that this test is the most appropriate for adoption into the drafted provision given its flexibility and lack of complexity.

#### b. Scope of Protection

The proposed statute intends to protect the unauthorized use of an individual’s persona or image. Thus, “Persona” as intended by this statute, would mean the following or an imitation thereof: the legal name of any natural person or any other name by which a natural person is known to any material segment of the general public; signature; voice; image; distinctive characteristics or appurtenances by which a natural person is known to any material segment of the general public; or a character portrayed by the natural person on stage, in film or television or in live performances or other entertainment media, provided that the character has been created by the natural person and has become so associated with the natural person as to be indistinguishable from the natural person's public image.<sup>179</sup>

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175. Alicia M. Hunt, *Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 NW. U.L. REV. 1605, 1621 (2001).

176. *Id.* at 1624.

177. 891 F. Supp. 381, 384 (W.D. Ky. 1995).

178. *Id.*

179. Lapter, *supra* note 121, at 320.

The term “image” would include but not be limited to, a picture, portrait, likeness, photograph or photographic reproduction, still or moving, or any videotape or live television transmission or audio/visual representation or any analog or digital representation or transmission or any other method of crating or reproducing a likeness, now know or hereafter created, such that the natural person is readily identifiable.<sup>180</sup> These definitions are implemented from an amendment proposed by the International Trademark Association (“INTA”) in 1998.<sup>181</sup> The proposal called for the expansion of the Lanham Act, the controlling federal act for trademarks in the United States, to cover “persona” rights as defined in the proposed definitions.<sup>182</sup>

Lastly, The length of the protection is also adopted from the Tennessee statute, which allows the right of publicity to last the life of the right-holder plus 50 years.<sup>183</sup> This length is appropriate in relation to the duration that the Berne Convention affords to copyrights.<sup>184</sup> In addition, the drafted provision adopts the language of the Tennessee statute, which deems the right of publicity a property right.<sup>185</sup> Thus, the right is freely alienable. Likewise, the provision would allow the right to pass to a successor-in-interest after death of the right-holder.<sup>186</sup>

### c. Specific Defenses

As developed in the case law, defenses to claims of infringement of a right of publicity have included legal and equitable defenses such as constitutional free speech, the non-confusing use of a person's own name or other aspects of persona, or that the alleged infringer has obtained consent to the use. The INTA Right of Publicity Subcommittee proposed that federal right of publicity legislation be designed to accommodate First Amendment constitutional and fair use principles and to permit use of aspects of persona in connection with matters of public interest.<sup>187</sup> Expressly permitted uses of aspects of persona would include, but not be limited to, news, biography, history, fiction, commentary, and parody.<sup>188</sup> In congruence with INTA, and in the interest of free speech, the drafted statute suggests adoption of a similar exception.

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180. *Id.* at 316.

181. INTA, *supra* note 53.

182. *Id.*

183. *See* TENN. CODE ANN. §47-25-1104(a).

184. Berne Convention, *supra* note 125.

185. TENN. CODE ANN. §47-25-1103(b).

186. *See* CAL. CIV. CODE § 990(d).

187. INTA, *supra* note 53.

188. *Id.*

d. Protection Based On U.S. Courts Decisions and Statutes

Although the United States does not currently have a federal statute addressing the right of publicity, there have been many states that have ruled on the matter and many other states that have adopted statutes protecting it. The first subsection on the draft of the provision in this paper adopts similar language from the statute protecting the right of publicity in Tennessee. The Tennessee statute provides a clear and concise introduction to the right of publicity.<sup>189</sup>

*B. Reasons for Adopting Proposal*

The proposal provides a solution to the current uncertainty generated from the lack of consistency in the way all nations treat the right of publicity. This proposal is the most advantageous because “legal certainty promotes commercial efficiency,”<sup>190</sup> it promotes public policy by protecting the fruits of labor of individuals, and it institutes a more efficient administrative system. Most importantly, this proposal is a resolution to the harmonization and national treatment issues that the right of publicity faces.

1. Harmonization

An international scheme like the one proposed is the best solution to harmonize the right of publicity around the world. Given the global landscape of marketing and advertising campaigns, the commercial appropriation of celebrities without authorization creates tension between the celebrities, the authorized licensors and the unauthorized entity or individual. This proposal solves this issue by introducing the WTO as the main body to resolve disputes associated with the right of publicity. The WTO provides an effective dispute resolution system that governs TRIPs and all its other treaties.<sup>191</sup> The WTO has “presided over hundreds of cases invoking agreements under their auspices including several dozen claims alleging violations of TRIPs.”<sup>192</sup> Additionally, one legal standard will generate certainty for those exploring international marketing and advertising campaigns and those interested in using the image or persona of a celebrity for similar purposes.

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189. TENN. CODE ANN. § 47-25-1105(a) (1997).

190. Eric J. Goodman, *A National Identity Crisis: The Need for A Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. 227, 243 (1999).

191. See Alain Lapter, *The WTO's Dispute Resolution Mechanism: Does the United States Take it Seriously? A TRIPs Analysis*, 4 CHI.-KENT J. INTELL. PROP. 217 (2005).

192. Lapter, *supra* note 121, at 312.

## 2. Solving the Issue of National Treatment

As mentioned previously, under the Lockean “labor theory,” a person is entitled to the fruits of his labor.<sup>193</sup> Professor Nimmer in his seminal article, earlier mentioned, advocates for the labor theory as the rationale behind the need to recognize the right of publicity.<sup>194</sup> The multiple countries that protect the right of publicity endorse this rationale. However, the intended result of protecting individuals from unauthorized use of their image is diminished once an individual is left with no recourse in foreign countries where he cannot be protected. For “some celebrities consumers automatically assume that they have been compensated,” without realizing that they are being used with no compensation.<sup>195</sup> There is an expectation of profit from the use of a celebrity’s image and persona, which is the fruit of their labor, and this expectation should be protected regardless of the place of residence. Celebrities should receive the profit that is generated from the use of their own persona or image. The ability to receive national treatment translates into the ability to “retain control over one’s identity” in any part of the world. This is a fairness principle that has been endorsed by those who believe in the protection of intellectual property rights, which should be extended to the right of publicity.<sup>196</sup>

### III. CRITICISMS OF THE PROPOSAL

Critics might object that the right of publicity shouldn’t belong in the set of intellectual property rights and argue that the current set of rights overlaps with the rights protected by the proposed statute. Additionally, critics may believe that there are better alternatives other than a statute in TRIPs and under the Neighboring rights provision. These potential criticisms will be addressed in the following sections of the paper.

#### A. Intellectual Property

The right of publicity may be questioned as a right that should not belong as intellectual property. This criticism is derived from the attack on intellectual property rights in general, viewed as growing “uncontrolled to

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193. See Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287 (1988).

194. See Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

195. Jeff Bercovici, *How The FTC’s Endorsement Rules Unfairly*, DAILY FINANCE (Jan. 06, 2010), <http://www.dailyfinance.com/2010/01/06/how-the-ftcs-endorsement-rules-unfairly-favor-celebrities> (last visited Jan. 20, 2015).

196. See Patrick Whitman, Comment, *Everyone’s a critic: Tiger Woods, The Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41, 48-56 (2001).

the point of recklessness.”<sup>197</sup> Similarly, critics present that courts have given too much weight to celebrities’ interest in the control of their image as opposed to freedom of speech.<sup>198</sup> They argue, “treating limited monopolies in certain expression as a ‘property’ leads people to embrace broad and dangerous new form of protections for that ‘property.’”<sup>199</sup> Thus, they conclude that the right of publicity in its growing form clashes with the freedom of speech.<sup>200</sup> The argument made is that it “puts the power of the state behind private individuals who want to control whether and how information about important people...can be used by other people.”<sup>201</sup> Furthermore, critics also argue that this right overlaps with other already existing rights, thus, does not need to be a stand-alone right.<sup>202</sup>

However, the right of publicity should be considered a stand-alone intellectual property right that is not in conflict with any other right. The rationale behind the right of publicity is analogous to the rationale behind the protection of other intellectual property rights, such as trademarks and copyrights. Additionally, the right of publicity has been recognized by multiple courts in the United States as an independent right under intellectual property. This uniformity of decisions is only seen with similar intellectual property rights.

The right of publicity grew out of the natural rights theory to protect an individual’s own image and identity that is generated as the fruit of their labor.<sup>203</sup> Similarly, the remaining rights protect assets created upon the same natural rights principle. Trademark law protects words or symbols that identify goods or services in order to prevent consumer confusion and companies’ good will.<sup>204</sup> Copyright protects original works of expression as

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197. Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 864-69 (1995).

198. Corynne McSherry, *Publicity Rights Aren’t Property Rights: Appellate Court Gets It Very Wrong in Hart v. Ea*, ELECTRONIC FRONTIER FOUNDATION (May 22, 2013), <https://www.eff.org/deeplinks/2013/05/publicity-rights-arent-property-rights-court-wrong-hart-v-ea>.

199. *Id.*

200. Alicia M. Hunt, *Everyone Wants to Be A Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 NW. U.L. REV. 1605, 1616 (2001).

201. Diane L. Zimmerman, *Who Put the Right in the Right of Publicity?* 9 DEPAUL-LCA J. ART & ENT. L. & POL’Y 35, 53 (1998).

202. Andrew Beckerman-Rodau, *The Right of Publicity. A Doctrine Gone Wild?* (Mar. 11, 2010), <http://www.ipwatchdog.com/2010/03/11/the-right-of-publicity-a-doctrine-gone-wild/id=9647/>.

203. David S. Welkowitz & Tyler T. Ochoa, *Teaching Rights of Publicity: Blending Copyright and Trademark, Common Law and Statutes, and Domestic and Foreign Law*, 52 ST. LOUIS U. L.J. 905, 909 (2008).

204. William Fisher, *Theories of Intellectual Property*, CAMBRIDGE UNIVERSITY PRESS, [http://www.law.harvard.edu/faculty/tfisher/iptheory.html#\\_ftn2](http://www.law.harvard.edu/faculty/tfisher/iptheory.html#_ftn2) (last visited Mar. 29, 2015).

well as neighboring rights, such as performer's rights.<sup>205</sup> Patent protects inventions and discoveries.<sup>206</sup> Lastly, trade-secret law protects commercially valuable information.<sup>207</sup> All the current rights identified as intellectual property are based on the same theory "that creators' or inventors' entitlement to their work is akin to an inherent natural right which the state is under an obligation to protect and enforce."<sup>208</sup>

Although there is no universal definition of intellectual property, a possible definition "might begin by identifying it as nonphysical property which stems from, is identified as, and whose value is based upon some idea or ideas," and which requires some level of novelty.<sup>209</sup> The right of publicity is the creation of the author, it is his image and identify generated based on his own popularity and fame. Similar to the rights of performers granted under the TRIPs agreement, it is the same principle that should protect the rights of those who have generated an image of significant economic importance.

### B. Overlapping Rights

The similarity of the right of publicity to other rights may give rise to criticism that it should be protected under an already existing right such as trademarks.<sup>210</sup> For example, in Germany there is a continuing debate in deciding whether celebrity trademarks should comply with trademark rules or right publicity rules.<sup>211</sup> Nonetheless, the overlap with other intellectual property rights is an indication that the right of publicity belongs as a stand-alone right within the same family of rights. Courts in the United States view the right of publicity as having similarities and differences to other types of intellectual property rights.<sup>212</sup> However, the historical origin of each right demonstrates distinct policies and rationales for the interests that each is intended to protect.<sup>213</sup> Given the many similarities, overlap is inevitable.<sup>214</sup>

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205. William Fisher, *Theories of Intellectual Property*, CAMBRIDGE UNIVERSITY PRESS, [http://www.law.harvard.edu/faculty/ffisher/iptheory.html#\\_ftn2](http://www.law.harvard.edu/faculty/ffisher/iptheory.html#_ftn2) (last visited Mar. 29, 2015).

206. *Id.*

207. *Id.*

208. Chidi Oguamanam, *Beyond Theories: Intellectual Property Dynamics in the Global Knowledge Economy*, 9 WAKE FOREST INTELL. PROP. L.J. 104, 108 (2009).

209. Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 294 (1988).

210. Sarah M. Konsky, *Publicity Dilution: A Proposal for Protecting Publicity Rights*, 21 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347, 362 (2005).

211. *When Trademarks Overlap with Other IP Rights*, TheIPKat (Dec. 9, 2014), [http://ipkitten.blogspot.com/2014/12/when-trademarks-overlap-with-other-ip\\_35.html](http://ipkitten.blogspot.com/2014/12/when-trademarks-overlap-with-other-ip_35.html).

212. RIGHTS OF PUBLICITY AND PRIVACY § 10:7 (2d ed).

213. Reichman, *supra* note 1.

214. *Id.*

Copyright and trademark have constant overlaps. For example: “a picture of a person or character is copyrightable as a pictorial work and may also be used as a mark to identify the source of goods or services.”<sup>215</sup>

### C. *Neighboring Rights and TRIPs*

Adding the proposed provision under TRIPs is the best route. TRIPs, as administered by the WTO, has an effective dispute resolution system that is already procedurally sound and enforceable against those signatory of its treaties.<sup>216</sup> Thus, this provision is better placed after the rights granted to performers under Article 14 of Section 1, Copyright and Neighboring Rights. It is logical to introduce the right of publicity, which protects only those who have gained commercial interest in their image, after performer’s rights, because both provisions protect a narrow set of individuals. The rights granted to performers can be analogized to the rights granted to celebrities under the right of publicity. Celebrities and performers sometimes are one in the same. The protection for celebrities should not be overlooked.

### CONCLUSION

Right of publicity laws around the world are evolving at a rapid pace. The many differences resulting from a broad set of jurisprudence in the matter is generating inconsistent treatment and application of this right to many individuals.<sup>217</sup> An international right of publicity based on TRIPs will provide a solution to the current lack of harmonization and lack of national treatment in those countries that fail to provide adequate protection. The current laws in different countries differ in great nature procedurally and in substance. Therefore, the best solution is to harmonize the right of publicity as proposed in this paper. Adopting this proposal would not only provide a solution to the current issues generated by the lack of harmonization and national treatment, but it would also serve the theories behind protecting intellectual property rights in their entirety.

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215. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:14 (4th ed.).

216. INTA, *supra* note 53.

217. Lindenbaum, *supra* at 1-2.