

The Other Side of *Garcia*: The Right of Publicity and Copyright Preemption

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The subject of my talk is a perfect transition from the two prior talks, and a perfect place to end an entire symposium about *Copyright Outside the Box*—by literally getting out of the copyright box entirely, and talking about the right of publicity and its intersection with copyright law. I want to begin by thanking Jane Ginsburg for inviting me and encouraging me to participate, despite the fact that I’m stepping way outside the box. I also want to thank everyone here at the Kernochan Center, and the students of the *Columbia Journal of Law and the Arts* for putting this all together.

June Besek started off this panel by describing it as being about “If authorship, what then?” and my twist on this question is, “If *not* authorship, what then?” Or perhaps instead the turn is toward thinking about authorship in a different way: Are we talking about the author of the underlying film or the underlying work, *or* instead, are we perhaps talking about a different type of authorship—meaning authorship over oneself, one’s name, or one’s likeness? This latter notion of being the author of oneself is the purview of the right of publicity.

Perhaps another way of thinking about my topic is that co-panelist Jay Dougherty’s film producers should still be worried even though they ultimately won in the Ninth Circuit’s rehearing of *Garcia v. Google, Inc.*¹ Or, yet another lens to consider, is to pick up where my other co-panelist, Eva Subotnik, left off—perhaps the actors and the subjects of photographs have another avenue of asserting their rights, other than copyright law.

The title of this talk is “The Other Side of *Garcia*.” The “other side” is the right of publicity, and its interface with copyright, and in particular with the doctrine of copyright preemption. This intersection or really conflict between the two laws was actually at the heart of *Garcia v. Google*, although it is rarely talked about in the context of the case.

When Cindy Lee Garcia, the plaintiff and actress in the case, initially filed a lawsuit against the filmmaker, she did so in state court, and her complaint didn’t have a copyright claim at all; it had a right of publicity claim, and privacy-based

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1. *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015) (holding that actress was not likely to succeed in claim that her performance in a short film was an independently copyrightable contribution).

claims.² When it was refiled in federal court with additional plaintiffs, including Google, a right of publicity claim was still lurking in there, but Garcia did not include that cause of action in her complaint.³ Now Jay said Garcia couldn't have brought a right of publicity claim against Google. Well, she could, but the problem is, as he said, the Communications Decency Act (CDA), section 230.⁴ The Ninth Circuit has decided that under the CDA Google cannot be liable for third party speech that violates the right of publicity.⁵ Other courts in other circuits have not so held.⁶ So I want to put out there, that there is not uniform agreement with the Ninth Circuit that service providers are immunized from right of publicity claims. What Garcia really wanted in this instance was for the film, *The Innocence of Muslims*, to be taken down, so the right of publicity was not the right avenue for that, at least under California law in the Ninth Circuit. As a result, however, her right of publicity claim was never decided by the Ninth Circuit or to date by any other court.

Nevertheless, if you read the Ninth Circuit opinion in the *en banc* decision very carefully, you could not be hit more clearly over the head with a right of publicity claim. I have pulled out a couple of evocative quotes from the opinion, but there are many. The court takes pains to explain that its "conclusion [that Garcia is not an author] does not mean a plaintiff like Garcia is without options, or that she could not have sought an injunction against different parties on other legal theories, like the right of publicity and defamation."⁷ In another place, the opinion says, "[p]rivacy laws, not copyright, may offer remedies tailored to Garcia's personal and reputational harms."⁸

These two quotes demonstrate how clearly the majority in this decision thought Garcia had a right of publicity claim, or privacy-based claim. Such claims were mentioned almost ten times in the opinion. The court was essentially saying: "We're not saying she doesn't have a lawsuit; she really does. We feel really bad for her, and she can win, but not against Google here, because the film industry scared us with all of its amicus briefs about the parade of horrors that would follow a decision that an actor owns a copyright in her performance."⁹

So, what does this mean that the Ninth Circuit thinks Garcia has a right of publicity violation? Well, this is a problem, and this really presents a collision course with copyright law, and this is something I've thought a lot about, and considered, and because this is a copyright conference, I'll just remind people, in case you've forgotten, what the right of publicity is. It's a state-based tort that

2. Complaint, *Garcia v. Nakoula*, No. BC492358 (Cal. Sup. Ct. Sep. 19, 2012).

3. See Complaint, *Garcia v. Nakoula*, No. CV12-8315-MWF (C.D. Cal. Sep. 26, 2012); see also *Garcia v. Nakoula*, First Amended Complaint, No. CV12-8315-MWF (C.D. Cal., Oct. 4, 2012).

4. 47 U.S.C. § 230.

5. *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1108, 1118–19 (9th Cir. 2007).

6. See, e.g., *Gauck v. Karamian*, 805 F. Supp.2d 495 (W.D. Tenn. 2011); *Stayart v. Yahoo!*, 651 F. Supp. 2d 873 (E.D. Wis. 2009).

7. *Garcia*, 786 F.3d at 740–41.

8. *Id.* at 745.

9. I do not think the Ninth Circuit was wrong on this point, but the quick shift from the panel decision to the *en banc* reversal was no doubt driven in part by the outcry from Hollywood.

prevents others from using your name or likeness, and sometimes other indicia of your identity without permission in various contexts. The right of publicity differs in every state, which is crazy. I've just launched a website in which I provide a survey of all fifty states using an interactive website that provides guidance on each state's laws.¹⁰ So you can click on your state, or whatever state you want to know about, and find out about the law in that state.

One of the problems with all the different state laws is that it is difficult to provide an all-encompassing definition of the right of publicity given the wide variations among states. It is therefore hard to boil down what the right of publicity is across all the states, without using a very broad definition. The law allows people to control the use of their identities; sometimes this is limited to control over names or likenesses, but sometimes only limited to anything that reminds people of the person. Sometimes the right of publicity is limited to commercial uses, sometimes it's not. Sometimes it's limited to commercial speech and particularly to advertising, and sometimes it's not. Some states expressly exclude expressive works from the tort's reach, but many others do not. The broader the right of publicity is, the more likely that we're going to have a collision course with copyright.

One of the reasons that the right of publicity and copyright law are increasingly in conflict is that we have an expanding reach of the right of publicity. And I say expanding perhaps with a little bit of overselling because in some sense it's simply that we've forgotten how expansive the right of publicity is, or we pretend that it's not as expansive as it is.

One of the ways that the right of publicity is broader than we often think is what I call the "commercial speech fallacy." People often say, "Well, the right of publicity is just limited to commercial speech, advertising about commercial products. Let's not lose sleep over it." J. T. McCarthy, who's the leading treatise writer on the right of publicity, says that's the case.¹¹ But, it's not true. The right of publicity is limited to commercial speech in only a very few jurisdictions. For those who want to read more about it, I have an article that was just published in the *Virginia Law Review* titled, "Commercial Speech, Commercial Use, and the Intellectual Property Quagmire."¹² That article reaches much more broadly than the right of publicity, to copyright and trademark, but in the right of publicity context, I highlight in the article the myriad right of publicity cases that have succeeded outside of commercial speech. These cases often arise in the heartland of copyright and involve expressive works. The right of publicity, for example, has stopped uses in comic books,¹³ and in video games, such as in the recent decisions

10. Jennifer Rothman, ROTHMAN'S ROADMAP TO THE RIGHT OF PUBLICITY, www.rightofpublicityroadmap.com [https://perma.cc/ATZ6-6QX2]. The website also provides breaking news and commentary on the right of publicity.

11. See, e.g., J. T. McCarthy, *The Spring 1995 Horace S. Manges Lecture – The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 131 (1995).

12. See Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929 (2015).

13. See, e.g., *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003).

in the *Davis* and *Keller* cases.¹⁴ There's a pending right of publicity lawsuit in the Ninth Circuit that's stuck in some outer circle of hell involving the movie, *The Hurt Locker*, where there is a lawsuit by the person upon whom the main character allegedly was based. If this lawsuit succeeds, its logic could apply to *The Innocence of Muslims* and Garcia's claims there, as well as to many other movies.¹⁵

Another avenue of expansion of the right of publicity is to cover characters and the underlying actors who play those characters. It is difficult to refer to a character without evoking the actor who played that character. Such associations have been held in some jurisdictions to provide a basis for liability under right of publicity laws, whether in the context of action figures, or robots. For example, Vanna White successfully brought a right of publicity suit not for the use of her likeness, but for the use of a robot with a wig that made people say "Hey! That makes me think of Vanna White."¹⁶

Similarly, John Ratzenberger and George Wendt, who were the actors who played the characters Cliff Clavin and Norm Peterson in the hit sitcom series *Cheers*, successfully moved forward with a suit arising out of the use of robots in an airport bar that evoked those characters. The characters had been licensed by the copyright holder of the *Cheers* series.¹⁷ The robots were called Hank and Bob, not Norm and Cliff, though the names appear to have been changed after the defendant, Host International, was threatened with suit. The district court had held that the robots did not look like John Ratzenberger or George Wendt, but you can imagine that if you see two men in a bar that's from the *Cheers* set, one dressed as a mail carrier, and the other in a suit, you're going to go, "Hey, that's Norm, and hey, that's Cliff, oh, that reminds me of those actors from *Cheers*."

Another similar example includes a case involving Spanky McFarland of *Our Gang* fame, who sued a restaurant for displaying posters from *Our Gang* which were lawfully purchased, but that he claimed illegally used the actor's identity in a commercial setting.¹⁸

These cases and the expansion of right of publicity laws raise a number of concerns, notably a conflict with copyright law—the subject of this conference.

Each example raises a specific conflict with copyright law. Some conflicts arise with the original copyright holder and potentially limit the rights of distribution, performance, display, and sale, as well as the production or licensing of derivative

14. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.* ("Keller v. Electronic Arts"), 724 F.3d 1268 (9th Cir. 2015); *Davis v. Elec. Arts Inc.*, 775 F.3d 1172 (9th Cir. 2015).

15. The district court's dismissal was recently affirmed by the Ninth Circuit. *Sarver v. Hurt Locker, LLC*, No. 2-10 Civ. 01076, 2010 WL 4810813 (D. N.J. Nov. 18, 2010), *aff'd*, *Sarver v. Chartier*, No. 11-56986 (9th Cir. Feb. 17, 2016). Nevertheless, the logic of *Keller* and *Davis* extends to uses in motion pictures. For a more detailed analysis of the Ninth Circuit's recent decision in *Sarver* see my commentary, *Ninth Circuit Tosses Hurt Locker Case*, <http://www.rightofpublicityroadmap.com/news-commentary/ninth-circuit-tosses-hurt-locker-case> [<https://perma.cc/6R6C-C63P>].

16. *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); see also *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc).

17. *Wendt v. Host Intern., Inc.*, 125 F.3d 806 (9th Cir. 1997).

18. *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994).

works, from merchandise to sequels, to prequels, to adaptations. One could think of the *Garcia* case as a derivative work case. Even though we have the original copyright holder distributing the work, there may in fact be a derivative work at issue because it was reedited and Garcia's performance was dubbed.

The right of publicity also interferes with the public's right to display lawfully purchased works, and to perform things like soundalikes which are authorized by the Copyright Act. A number of right-of-publicity suits have successfully restricted soundalikes, and even just imitative voices, as well as the ability to display lawfully purchased works.¹⁹ And, of course, the right of publicity interferes with the public's right to fairly use copyrighted works, because the right of publicity is much more expansive and has many fewer limitations that are speech-protective in contrast to copyright law.

What can we do to rein in the right of publicity? Well, a number of years ago (many now, it seems), I wrote an article about this coming collision in the *U.C. Davis Law Review*.²⁰ In the 2002 article, I discussed that section 301, which is the explicit preemption provision in copyright law, actually doesn't do much to help us out here. Section 301 asks two questions to determine preemption. First, is the state law equivalent to a right protected by copyright?; and second, does the work at issue fall within the subject matter of copyright?²¹

The problem is that courts really don't know how to interpret this provision. Various interpretations of each provision lead to extreme conclusions that the right of publicity is always preempted, or alternatively, that it is never preempted. In the interest of time, I will take one example of such an absurd interpretation of § 301. One common interpretation is to conclude that if a law has an extra element, then it is not an equivalent right. So the right of publicity, we say, has an extra element because it's about a person's identity, or it's for a commercial purpose. If there's such an extra element, the law is never preempted. The problem with this interpretation is that the one thing we know that section 301 was supposed to preempt, based on clear legislative history, is common law copyright. But common law copyright has an extra element—the works were supposed to be unpublished. So, that's a confusing interpretation of section 301 and one that cannot be correct. It cannot be interpreted not to preempt the one thing we are certain it was meant to preempt.

The other tack courts take is to consider if the state law is violated by an exercise of a section 106 right.²² In other words, are you distributing, copying, performing or displaying the original copyrighted work? If you are, then we would have preemption. Such an approach means that the right of publicity would almost

19. 17 U.S.C. § 114(b); *see, e.g.*, *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (allowing a right of publicity claim on the basis of a similarly styled vocal performance); *Midler v. Ford*, 849 F.2d 460 (9th Cir. 1988) (allowing a right of publicity claim based on unauthorized use of a "sound alike" in a commercial that imitated the plaintiff's voice).

20. *See* Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199 (2002).

21. 17 U.S.C § 301.

22. 17 U.S.C. § 106.

always be preempted, because the use will almost always be in the context of a copyrighted work.

The same problems arise when analyzing whether the state law fits within the subject matter of copyright. One interpretation in the context of right of publicity laws is that the underlying work is the person's identity which is not copyrightable so there is never preemption. Other courts, however, have concluded that if the person's identity is captured in a copyrightable work then it is always preempted. As you can see, section 301 is a big mess.

One of the ways out of this big mess that I have proposed is to use conflict preemption under the Supremacy Clause of the Constitution. Such an approach is permissible despite the explicit statutory provision because the statute does not exclude other preemption analysis. Supremacy Clause preemption would focus on places where copyright and right of publicity laws conflict, and when the two laws conflict, the right of publicity should be preempted.

In the more than a decade since I wrote the article on copyright preemption and the right of publicity, the law has not become any clearer. Even though a couple of courts have taken my lead to consider conflict preemption, most have not and the law has remained mired in the uncertainties of the section 301 approach. We have, up on the screen here, a host of cases involving performances being captured, in which courts found right of publicity claims preempted.²³ Of particular interest here are some in which there was reediting of the underlying materials, such as in *Dryer v. NFL*, in which copyrighted footage was reedited and presented in a new work and new context.²⁴ Or *Lewis v. Activision Blizzard, Inc.*, in which a court held that a right of publicity claim was preempted by copyright law when the alleged violation was the capture of an employee's voice on tape. The underlying recording was done with permission, but the use in the videogame was not.²⁵

On the other hand, there are many cases in which courts held that the right of publicity was *not* preempted by copyright law.²⁶ It's hard to make heads or tails

23. See, e.g., *Jules Jordan Video, Inc. v. 144942 Canada, Inc.*, 617 F.3d 1146 (9th Cir. 2010); *Laws v. Sony Music Entm't*, 448 F.3d 1134 (9th Cir. 2006); *Maloney v. T3Media, Inc.*, 94 F. Supp.3d 1128 (C.D. Cal. 2015).

24. *Dryer v. National Football League*, 55 F. Supp. 3d 1181 (D. Minn. 2014), *aff'd* No. 14-3428, - F.3d ---- (8th Cir. Feb. 26, 2016). For coverage of this recent decision see my commentary, *Eighth Circuit Tosses NFL Players' Lawsuit*, <http://www.rightofpublicityroadmap.com/news-commentary/eighth-circuit-tosses-nfl-players-lawsuit>. [https://perma.cc/HW2Q-S9Q4]. There were also several earlier examples of preemption of performances. See, e.g., *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986) (holding right of publicity claims preempted that arose out of use of performances by baseball players because teams owned copyright in telecasts of those performances); *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134 (N.D. Ill. 1997); *Fleet v. CBS, Inc.*, 50 Cal. App.4th 1911 (1996). *Dryer*, 55 F. Supp. 3d 1181 (right of publicity claim against NFL for using historical footage of former players in television productions without permission).

25. *Lewis v. Activision Blizzard, Inc.* No. C 12-1096, 2012 WL 5199505 (N.D. Cal. Oct. 22, 2012), *aff'd*, 2015 WL 9258962 (9th Cir. Dec. 18, 2015).

26. See, e.g., *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005); *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000); *Dent v. Renaissance Mktg. Corp.*, No. 14 C-02999, 2015 WL 3484464 (N.D. Ill. Jun. 1, 2015); *No Doubt v. Activision Publ'g, Inc.*, 702 F. Supp. 2d 1139 (C.D. Cal. 2010); *Perfect 10, Inc. v. Google, Inc.*, No Civ. 04-9484, 2008 WL 4217837 (C.D. Cal. 2008).

out of these decisions. There is often no basis to distinguish them. Consider *Facenda v. NFL Films*. In that case, a famous sports announcer's voice was used—taken from a lawful recording to which the defendant owned the copyright. NFL Films then edited these works and reused his voice in a documentary film. This use was found not to preempt Facenda's right of publicity claim because the use was in a derivative work, even though in *Dryer v. NFL* a very similar use of preexisting footage of players was held preempted.²⁷

So, back to *Garcia*, and the other side of *Garcia*. Would Garcia have a legitimate right of publicity claim? First, would she have it against the filmmaker, Nakoula? Well, he happens to be bankrupt and last I checked in jail, so he's not a great defendant for her. But in terms of people in Hollywood staying awake at night, she actually might have a claim if we read the tea leaves. To be clear this is not normatively what I think should happen, because I think her claim should be preempted, but just reading the tea leaves from a legal realist perspective, let's think about consent here. The initial panel said she did not consent to the use of her performance in the film.²⁸ She did not sign a contract, there was no implicit consent, and it was viewed as sort of a bait and switch about the nature of the work that she had agreed to appear in.²⁹

So I think Garcia might be viewed as not consenting to the use of her performance. In most instances in which courts have considered right of publicity and preemption with copyright law, when there has not been consent by the actor or other identity-holder, courts have held that the right of publicity is not preempted. Such a possibility should be pretty concerning here, especially since in Hollywood you might start out making a drama, and then things don't turn out how you planned and it looks like a pretty terrible drama, so you decide to turn it into a comedy in the cutting room. Filmmakers need room for that to happen. Alternatively, you might want to dub over someone's horrible performance. Anything like that can happen. So it would be very troubling if an actor could sue for a right of publicity violation if their performance is altered or the underlying script changes dramatically in post-production.

On the other hand, all is not lost. Some things weigh against a right of publicity claim in *Garcia*, and instead weigh in favor of preemption. First, the original copyright holder is using her performance, and is using it in the distribution of the original (even if altered) work, rather than a derivative work. Second, she made a copyright claim, and even though her copyright ownership claim was ultimately rejected *en banc* by the Ninth Circuit, cases in which a plaintiff has pled both a copyright claim and a right of publicity claim have most often led to a conclusion that the latter is preempted. So if you want to make a successful right of publicity claim, don't also make a copyright claim, because that is bad for your chances. Also weighing in favor of preempting the claim here, the use is not an advertisement, and there's no suggestion of false endorsement. Although neither of

27. Compare *Facenda*, 542 F.3d 1007 with *Dryer*, 55 F.Supp.3d 1181.

28. *Garcia v. Google, Inc.* 766 F.3d 929, 937 (9th Cir. 2014).

29. *Id.*

those things really have anything to do with conflict preemption or with section 301 preemption, courts often point to such features as a basis to reject preemption claims.

So, back to our collision course: the right of publicity presents serious problems for copyright holders and licensees. Even though Garcia may not have a copyright claim, she may be able to claim “authorship” over her name and image in the film, a possibility that should resurrect Hollywood’s worst fears.

As the threat of an expansive right of publicity grows, I want to alert you to some upcoming work that hopefully will be helpful to you as we navigate this future together. If you’re interested in learning more about the right of publicity, its past, present and future, I have a book coming out on the right of publicity to be published by Harvard University Press, titled *A Right is Born: The Right of Publicity, Celebrity and Privacy in a Public World*.³⁰ The book will consider the right’s collision course with copyright law, as well as its collision with the First Amendment. The website that I mentioned earlier will also help navigate these treacherous waters, both by providing updated state laws, as well as news and commentary about the right of publicity. It’s now available at www.rightofpublicityroadmap.com. So, enjoy.

30. JENNIFER E. ROTHMAN, *A RIGHT IS BORN: THE RIGHT OF PUBLICITY, CELEBRITY, AND PRIVACY IN A PUBLIC WORLD* (Harvard Univ. Press forthcoming 2017).