



Volume 10

Issue 2 Spring 2000: American Association of
Law Schools Intellectual Property Section
Meeting

Article 4

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Recommended Citation

Bela G. Lugosi, *California Expands the Statutory Right of Publicity for Deceased Celebrities While Its Courts Are Examining the First Amendment Limitations of That Statute*, 10 DePaul J. Art, Tech. & Intell. Prop. L. 259 (2000)

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**CALIFORNIA EXPANDS THE STATUTORY RIGHT OF
PUBLICITY FOR DECEASED CELEBRITIES WHILE ITS
COURTS ARE EXAMINING THE FIRST AMENDMENT
LIMITATIONS OF THAT STATUTE**

*Bela G. Lugosi**

I. INTRODUCTION

This article presents an overview of the law on the right of publicity for deceased celebrities for actions under California law and related actions under federal intellectual property laws, and discusses in particular the recent legislative expansion of the California statute and also the case presently pending before the California Supreme Court involving a First Amendment challenge to that statute.

Celebrities can enjoy immense commercial value in their identities—a value that frequently remains high, and may even intensify, after a celebrity's death. This phenomenon occurred, for example, after the sudden death of Princess Diana, when the merchandising of goods using the name or image of the Princess increased dramatically.¹ Similarly, Elvis Presley, Marilyn Monroe,

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1 *Cairns v. Franklin Mint Co.*, 24 F. Supp.2d 1013 (C.D. Cal. 1998); Jon G. Auerbach and Robert Frank, *Hasbro Toys With the Idea of a 'Diana' Doll*, *Wall Street Journal*, March 26, 1998, at B1; Edward H. Rosenthal, *Selling Princess Diana: Legal Limits on Celebrity Memorabilia*, *Intellectual Property Strategist*, November 1997, at 1 (noting that there is no protection for the right of publicity in Great Britain and that the prospect for successful claims is much better in the United States where the right of publicity is widely recognized and is a matter of the statutory and common laws of individual states).

James Dean, Lucille Ball and the classic monsters, Lon Chaney, Jr., Bela Lugosi and Boris Karloff, are currently among the most popular and successful images in the multibillion-dollar celebrity licensing industry. The use of a celebrity's identity in connection with a product has a fusion effect, with some of the celebrity's publicity value and goodwill attaching to the product and increasing its value and appeal.²

The commercial value of celebrity identity is a side effect of celebrity status, but that does not mean that a celebrity's good fortune must be shared freely with the public at large or relinquished to some opportunist with no connection to the celebrity. Celebrities have invested years of time and effort to hone the skills that earned them their celebrity status.³ In recognition of this fact, both federal and state laws provide celebrities with the right to exclusively control and benefit from the use of their own images and identities.⁴ Protection also has been extended to the heirs of deceased celebrities.

Practitioners representing owners of the intellectual property rights of deceased celebrities must offer a broad range of legal services including the following. The owner's claim to the rights must be properly registered under publicity, trademark, and copyright statutes. The title to the rights must be established by analyzing wills, trusts, probate proceedings, judgments and contracts. Transfers of rights must be documented. In exploiting the rights, potential licensing arrangements must be identified, negotiated, drafted, administered and enforced for uses such as those on or in products, commercials, motion pictures, television programs, home videos, books, domain names, fan clubs, conventions, and mail order catalogs.

² See generally, *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) (Bird, C. J., dissenting).

³ See generally, *Roberta Rosenthal Kwall, Fame*, 73 IND. L.J. 1 (1997).

⁴ See e.g., *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992), cert. denied, 508 U.S. 951 (1993) ("Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof").

Once established, intellectual property rights require constant vigilance. Counsel representing successors to deceased celebrities will need to pursue enforcement litigation, with different remedies available under state publicity doctrines, federal trademark and copyright laws, and typical contract provisions in the entertainment industry.

II. RIGHTS OF PUBLICITY

The right of publicity is an intangible property right of an individual to control the commercial exploitative usages of the associative value of his or her own identity or characteristics. Rights of publicity arise under state law and protect specifically against the purely commercial use of qualities such as the name, voice, signature or likeness of celebrities. Currently 25 states recognize publicity rights to some degree, either as common law rights or by statute, although not all states recognize the descendibility of publicity rights.⁵ A movement is underway to have a bill introduced in Congress recognizing publicity rights which would provide a uniform federal law applicable in all states. Whether based on common law or statute, claims for misappropriation of the publicity rights of either living or deceased celebrities most commonly involve the unauthorized use of a celebrity's identity on merchandise (such as T-shirts, posters, buttons, figurines, or other collectibles) or in the advertising of goods or services. Both types of uses, if unlicensed, are expressly prohibited in California, which has maintained its role at the forefront of the entertainment industry by recognizing both

5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §28:16 (4th ed. 2000 rev.); RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§46-49 (1995). New York is one example of a state in which the publicity rights are not descendible. *See* N. Y. CIV. RIGHTS LAW §51 (1995) and *Piracy v. MacMillan*, Inc., 894 F.2d 579, 585-586 (2nd Cir. 1990).

common law and statutory publicity rights of living and deceased celebrities.⁶

A. California's Recent Expansion of Statutory Protection

The statute protecting the publicity rights of living persons is California Civil Code Section 3344. For deceased celebrities, the applicable statute was California Civil Code Section 990 which has recently been amended and renumbered as Civil Code Section 3344.1. (The statute uses the defined term “personality” rather than “celebrity.” In this article, the term “celebrity” is used interchangeably with “personality.”)

The 1999 amendment to former Section 990 was introduced as Senate Bill 209 to expand the protection of the right of publicity statute for deceased celebrities in three respects. First, to delete the list of exemptions for works of creative art and provide that Section 990 would not apply “to the extent the use is protected by the constitutional guarantees of freedom of speech or freedom of the press” (in order to avoid decisions such as *Astaire v. Best Film*, *infra*). Second, to allow claimants like the Princess Di Foundation to enforce their rights of publicity under Section 990 even if the place of the deceased celebrity’s domicile at death did not recognize rights of publicity. Finally, to extend the protection of the Act from 50 to 70 years after death to conform to the recent extension of copyright protection.

The bill as introduced and later amended also added a prohibition against unauthorized digital manipulation of a celebrity performance to create a new performance; and a prohibition against a biographical use which was known to be false and presented as true. However, these latter two provisions were eliminated in the final compromise version of the bill. As adopted, the statutory protection was extended by SB209 from 50 to 70 years. A statutory cause of action is given even where the domicile at death

6 CAL. CIV. CODE §§3344, 3344.1 (West 1999); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1971, *amended* 1984); and *Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997).

of the celebrity does not recognize publicity rights, as long as the act occurs in California. The specific blanket exemption for certain enumerated expressive works was deleted, but rather than replacing the blanket exemption for the statutory list of expressive works, the legislature adopted a provision stating that those expressive works are not to be considered “products” or “services” if they are entertainment, or a dramatic, literary, or musical work, except to the extent the claimant proves that the use of the name, likeness, etc. within such works is so directly connected with a product or service so as to constitute an act of advertising, or selling that product or service by the deceased personality.

Both statutes, Section 3344 and Section 3344.1, protect against the unauthorized use of a name, voice, signature, photograph, or likeness, on or in products, merchandise, or goods, or for the purpose of advertising or selling products, merchandise, or goods.⁷ Like the pre-1998 Federal Copyright Act, the statutory protection under former Civil Code Section 990 of the publicity rights of deceased celebrities endured for 50 years after a celebrity’s death. Under the 1999 amendment, that period was extended to 70 years which is the number of years for which copyright protection was extended in the 1998 amendment to the Copyright Act.

Although California’s publicity rights arise under both statutory and common law,⁸ the common law rights descend only where (and possibly only to the extent that) the celebrity exploited the right during his or her lifetime.⁹ In order to qualify for statutory protection the successor in interest to the rights needs only to register a claim with the Secretary of State and pay a \$10 fee. Under the 1999 amendment, subsection (f), the Secretary of State posts on the World Wide Web the claims and the entire registry of people claiming to be the successors in interest to the rights of a

7 CAL. CIV. CODE §3344.1 provides that: “Any person who uses a deceased personality’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.”

8 *Lugosi*, 603 P.2d at 818-822, 824.

deceased personality, or registered licensees. If the claim is challenged, the claimant must be able to establish good title to the rights.

There are several limitations on the application of Section 3344.1. First, an action must be filed within the specified limitations period and prior to 70 years from the death of the deceased celebrity. Second, statutory damages are not recoverable for misappropriations that occur before the claim of the successor in interest to the rights has been registered with the Secretary of State. Third, former Section 990 applied if the celebrity was domiciled in California at the time of his or her death, since California choice of law doctrine dictates that personal property is generally controlled by the law of a decedent's domicile at the time of his or her death.¹⁰ In a recent decision by a federal district court in California in *Cairns v. Franklin Mint*,¹¹ the Princess Di case (which is still pending), the court denied a claim under the California statute because it was brought by the claimant to the publicity rights for a personality who was a British citizen and domiciled there at the time of her death and the laws of that country do not recognize such rights. The 1999 amendment to the statute was responsive to that decision and added the following provision as part of Section 3344.1:

This section shall apply to the adjudication of liability and the imposition of any damages or other remedies in cases in which the liability, damages, and other remedies arise from acts occurring directly in this state. For purposes of this section, acts giving rise to liability shall be limited to the use, on or in products, merchandise, goods, or services, or the advertising or selling, or soliciting

10 *Cairns v. Franklin Mint Co.*, 24 F. Supp.2d 1013 (C.D. Cal. 1998); CAL. CIV. CODE §946; J. THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY, §11.3[D][3][b] (1998).

11 *Cairns v. Franklin Mint Co.*, 24 F. Supp.2d 1013.

purchases of, products, merchandise, goods, or services prohibited by this section.¹²

Under this addition, California courts should apply the California statute when the claim is based on the rights of publicity of a deceased celebrity who died domiciled in another state or country when the infringing use i.e., the sale or advertisement, occurred directly in California, and regardless of whether the right of publicity is recognized in the deceased celebrity's domicile at the time of his or her death.

Although the original California celebrity rights statute was enacted in 1984, only one decision by a California state appellate court interpreting Section 990, predecessor to Section 3344.1, has been reported to date. That case, *Comedy III Productions, Inc. v. Saderup*,¹³ was decided in 1998 and is currently pending on appeal to the California Supreme Court. The trial court and Court of Appeal found that the defendants had violated former Section 990 by imprinting a portrait of *The Three Stooges* on thousands of lithographic prints and T-shirts without consent from the plaintiff owner of the rights.¹⁴ While the case law in California is sparse, courts in other jurisdictions have found liability resulting from similar uses of publicity rights of both living and deceased celebrities: the use of a photograph of Elvis Presley on posters,¹⁵ the unauthorized printing on shirts of the names or likenesses of entertainers and musical groups,¹⁶ and the use of performers' names and likenesses on buttons and other novelty items.¹⁷

12 CAL. CIV. CODE § 3344.1 (West 1999).

13 *Comedy III Productions, Inc. v. Saderup*, 68 Cal. App. 4th 744 (1998).

14 *See id.* The plaintiff owns and administers the intellectual property rights of *The Three Stooges*.

15 *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 222 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981).

16 *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1213 (N.D. Ill. 1981), *aff'd* 830 F.2d 195 (7th Cir. 1987); *Brockum Co., a Div. of Krimson Corp. v. Blaylock*, 729 F. Supp. 438, 446 (E.D. Pa. 1990).

17 *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188, 1191, 1199 (S.D.N.Y. 1983).

While claims of misappropriation for the unauthorized use of a celebrity's identity in the advertising of merchandise, goods or services—often referred to as false endorsement—are equally available to living and deceased celebrities in California, the case law to date deals primarily with the claims of living celebrities. Some of the more widely known false endorsement cases involve the misappropriation of the vocal styles of Bette Midler and Tom Waits for use in television commercials,¹⁸ the unauthorized use of Kareem Abdul-Jabbar's birth name in an advertisement for GMC automobiles,¹⁹ the unauthorized use of a Vanna White-like robot in an advertisement for Samsung videocassette recorders,²⁰ the unauthorized placement in airport bars of robotic figures based on two of the characters from the television show *Cheers*,²¹ and the use of a drawing of a former major league baseball player's distinctive pitching pose in a print advertisement for Killian's Irish Red Beer.²²

Various defenses have been raised against statutory and common law right of publicity claims, including defenses based on the First Amendment to the United States Constitution. In response, courts have noted that the First Amendment's protection of free expression does not afford infringers the right to appropriate legally recognized property and intellectual property rights.²³ Rather than indiscriminately affording immunity under the First Amendment, courts have examined the defendant's conduct to determine whether it constitutes speech or simply commercial exploitation.

18 *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513 (1992); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

19 *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996).

20 *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993).

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

22 *Newcombe v. Adolf Coors Co.*, 157 F.3d 686 (9th Cir. 1998).

23 *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454 (1979); *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979) (citing *Zacchini v. Scripps-Howard Broadcasting Co.*, 443 U.S. 562, 577 and n.13 (1977), in which the Supreme Court expressly upheld state regulation of publicity rights in the face of a First Amendment defense).

For example, the Court of Appeal in *Comedy III Productions, Inc. v. Saderup* upheld the constitutionality of former Section 990 in the face of a challenge based on the First Amendment, stating that “although the First Amendment protects speech that is sold . . . , reproductions of an image, made to be sold for profit, do not per se constitute speech.”²⁴ Similarly, in *Lugosi v. Universal Pictures*, former Chief Justice Rose Bird explained in her dissenting opinion that the use of a deceased celebrity’s identity in connection with the sale of such objects as plastic toy pencil sharpeners, soap products, target games, candy dispensers and beverage stirring rods does not implicate the First Amendment.²⁵

B. The First Amendment Limitations of the Right of Publicity Statute Are Being Considered By the California Supreme Court

The constitutional defenses raised in the *Comedy III Productions* case against former California Civil Code Section 990, the predecessor to current Section 3344.1, have not been finally adjudicated at this writing. The case is pending before the California Supreme Court and has been fully briefed by both sides and various *amici*.

The case involves the question whether an artist, who sketched the likeness of a celebrity, has the constitutional right to appropriate for his own economic benefit the celebrity’s property right in his likeness by selling multiple copies of the likeness on merchandise and products.²⁶

This case did not involve the sale of the original charcoal drawing, or the sale of products which bear any message of the artist. There was no evidence or facts in the case of custom and practice, or evidence that the shirts and posters were themselves art, and it was never established that Saderup is even an “artist.” The case is limited to the California right of publicity law and does

²⁴ *Comedy III Productions*, 68 Cal. App. 4th 744.

²⁵ *Lugosi*, 603 P.2d 425.

²⁶ See *ETW Corp. v. Jireh Publishing, Inc.*, 2000 U.S. Dist. Lexis 4816 (N.D. Ohio 2000) presently on appeal in Ohio, which discusses the constitutional right of an artist to sell prints of his painting of Tiger Woods.

not involve a claim or defense under the trademark or copyright laws.

The defendant argued that his sale of multiple reproductions of his sketch of the celebrities was “speech” protected by the First Amendment. The trial court and the Court of Appeals rejected that argument. The Court of Appeals opinion held that Section 990 did not seek to regulate protected speech but rather secured and protected a declared interest in property (namely the right of publicity). The Court of Appeals also held that defendant’s products were not protected by the First Amendment; and did not fall within any of the exemptions in Section 990 for newsworthy material or the host of other expressive materials and media exempted by Section 990(n). The California Supreme Court, in an order signed by six justices (including Justice Mosk who wrote an opinion which concurred with the majority result in the *Lugosi* case), agreed to hear the case.

If the Supreme Court reverses and upholds Saderup’s position, any self-proclaimed artist (or by logical extension any company which can hire an artist or anyone who can draw a picture) will need no permission to exploit the images of either living or deceased celebrities on mass produced merchandise (cups, belt buckles, pencils, posters, T-shirts, hats, calendars, etc.), or for advertising (magazine, TV, bus bench, etc.), where the image of the celebrity is reproduced from a drawing or a photograph created by a so-called artist. Under that interpretation, the whole licensing industry established over the years since the Hopalong Cassidy days would be turned upside down. The celebrity or his or her heirs, or their authorized assignees or licensees, would no longer have the exclusive right under the state right of publicity law to control or benefit from the unlicensed use of the celebrity’s name and likeness and will suffer any damages or dilution done by such unlicensed and uncontrolled uses to the value of the rights. This concerns celebrities from movies, television, sports and politics, living or deceased; agents and others who represent celebrities; licensing companies; and others similarly situated.

In Appellant’s Opening Brief, the defendant argued, among other things, that the statute as applied by the Court of Appeals censored speech based upon its content and that the right of

publicity statute could not pass the strict scrutiny test and must therefore be held unconstitutional. David Welkowitz of the Whittier Law School filed an *amicus* brief on behalf of Saderup. He actually did not contest that portion of the Court of Appeal opinion prohibiting the use on T-shirts, but is opposed to the portion of the opinion denying Saderup's alleged First Amendment right to commercially produce unlicensed posters or lithographs from his charcoal portrait. He argues that the right to free expression allowing artists to sell copies of their art on posters or lithographs outweighs the Legislature's judgment that the family of the deceased celebrity must be allowed to decide how the right of publicity is to be used.

Four *amicus* briefs were filed supporting the Court of Appeals opinion. The briefs were filed on behalf of: (1) The Screen Actors Guild representing 96,000 members; (2) The American Intellectual Property Law Association representing 10,000 lawyers who practice in that field in private law firms, corporations, universities and government representing owners, licensees and alleged infringers; (3) Wayne Enterprises, Inc. which purchased the John Wayne rights during his lifetime; the owner of the rights to Frank Sinatra; Groucho Marx Productions, Inc.; and Global Icons on behalf of its list of 14 deceased celebrities and 3 living personalities, Buzz Aldrin, Milton Berle and Bob Hope; and (4) The Gene Autry Survivor's Trust; Tiger Wood's corporation, ETW; The Diana, Princess of Wales Memorial Fund; and Elvis Presley Enterprises, Inc.

The plaintiff and its *amici* argue that celebrities in most cases invest heavily to develop the skills which create a persona that has commercial value, and that persona is a recognized property right entitled to statutory and constitutional protection permitting the personalities or their estates to reap the benefit and to control their status as public figures. They, and not strangers, should have those rights. Legitimate licensees from the celebrity or his estate should also not suffer the loss due to unauthorized uses because they provided consideration for the right.

Amici further argue that mass commercial distribution of unauthorized likenesses is not speech by the defendant and not shielded by the competing constitutional protection for free speech

and free expression. They compare the results and tests applied by the courts when First Amendment defenses have been raised in the past under trademark, copyright and other intellectual property laws. They argue that Section 990 is content neutral in that it does not prevent the artist from using other means to express whatever message he wants. There is no restraint in Section 990 on the message.

Amici advocated three different tests in their briefs to the Court. First, the *Spiritual Psychic Science Church*²⁷ four part test, where if the statutory regulation of use is aimed at the noncommunicative impact of the Act (as in the *Comedy III Productions*²⁸ case) the regulation is constitutional even as applied to expressive conduct so long as it does not unduly constrict the flow of information and ideas. Second, a two-step test, that initially reviews the infringing use to determine if the product is primarily merchandise that commercially exploits, or is a media use that significantly comments on the individual and implicates significant expressive interests. If the former, disregard the First Amendment and analyze the right of publicity claim on the merits under the statute. If the latter, the court should determine whether defendant has adequate alternative means to communicate the message that do not involve the taking of others' intellectual property—if so, disregard the First Amendment; if not, the First Amendment is a defense. Finally, *amici* recommended the fair use test which is applied in copyright cases.

Amici argued that the reproduction of likenesses of deceased celebrities on T-shirts and posters is not “speech” by Saderup, and thus not protected by the First Amendment, because the only speech in the drawing is by *The Three Stooges* and is merely recreated by Saderup to trade on their goodwill. Even if it were speech, any First Amendment interest at stake would be outweighed by the property interest in the right of publicity.

Finally, *amici* argued that publicity rights should not be abrogated by the First Amendment because (1) the right of

27 *Spiritual Psychic Science Church of Truth, Inc. v. City of Azusa*, 703 P.2d 1119 (1985).

28 *Comedy III Productions*, 68 Cal. App. 4th 744.

publicity is a fundamental property right to be protected; (2) it is also akin to the privacy right not to be put on exhibition; (3) the creator of the value should enjoy the fruits; (4) individuals need to be encouraged to invest their time and energy to develop a persona which has value; (5) unjust enrichment of strangers to the right should be prevented; (6) the commercial value of the persona should not be allowed to be diluted by excessive commercial use; (7) the rights of licensees and assignees must be protected in this multi-billion dollar industry because they paid value to use the rights; and (8) our national economic interests in the value abroad of U.S. celebrities should be protected.

III. STATUTORY EXEMPTIONS FROM LIABILITY FOR EXPRESSIVE WORKS

Although the California right of publicity statute applicable to living persons lists no exemptions for expressive works, former Section 990 applicable to deceased celebrities, in order to avoid constitutional objections, did contain certain blanket exemptions for books, films, television and other specified expressive material.

In *Astaire v. Best Film & Video Corp.*, the court held that the use of film clips of Fred Astaire in the opening of a commercial for a dance instruction video was equivalent to use in film or television programs and specifically was exempted from statutory liability.²⁹ Similarly, the claim in *Joplin Enterprises v. Allen* for the unauthorized use of Janis Joplin's identity in a play was precluded by the express exemption contained in former Section 990(n) for plays and musical compositions.³⁰

Section 3344.1 also states that single and original works of art will not be considered a product, which is a provision not contained in the statutory protection of the publicity rights for

²⁹ *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297, 1300 (9th Cir. 1997), *modified*, 136 F.3d 1208 (1998), *cert. denied*, 119 S. Ct. 161 (1998); CAL. CIV. CODE § 990(n)(1) (West 1999).

³⁰ *Joplin Enterprises v. Allen*, 795 F. Supp. 349, 351-352 (W.D. Wash. 1992).

living persons.³¹ The Court of Appeals recently held in *Saderup* that the exemption in former Section 990 for single and original works of fine art does not protect multiple reproductions on T-shirts and lithographs of a hand-drawn work. The court further rejected a challenge to former Section 990 on the grounds that this provision is an unconstitutional quantitative limitation of artists' rights to reproduce and sell their work.³²

Another defense to claims of misappropriation of the publicity rights of both living and deceased celebrities which arises from the First Amendment, but which is not an express exception to liability under either section, is parody. In the case of parody, the justifications for the right of publicity arguably may be outweighed by First Amendment interests in social commentary.³³

One of former Civil Code Section 990's other exemptions was for newsworthy material—an exemption that applies only if the material has some actual news value and is not intended solely for commercial exploitation. The exemption does not apply if the use merely constitutes the identity of a newsworthy individual. This exemption was carried over to Section 3344.1.³⁴

Finally, the advertising of activity either protected by the First Amendment or the statute is not considered a product and thus requires no consent.³⁵ Thus, in *Page v. Something Weird Video*, the court held that the defendants' advertising of Bettie Page videos was protected by the First Amendment as incidental to the protected publication of the videos and was protected from liability.³⁶

The recent amendment to the California statute, deleting the specific exemptions for certain of expressive works, now specifies

31 CAL. CIV. CODE §3344.1(a)(2) and (3) (West 1999).

32 *Comedy III Productions*, 68 Cal. App. 4th 744.

33 *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996).

34 *Comedy III Productions*, 68 Cal. App. 4th 744; see also *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (1995); CAL. CIV. CODE §3344.1(j) (West 1999).

35 *Page v. Something Weird Video*, 960 F. Supp. 1438 (C.D. Cal. 1996); CAL. CIV. CODE §3344.1(a)(2) and (3) (West 1999).

36 *Page*, 960 F. Supp. at 1444.

in Section 3344.1(a)(3) that the use of a deceased personality's image within an otherwise exempt creative work may not be exempt if the claimant proves that the use is so directly connected with a product or service that it appears as though the deceased personality is endorsing, advertising or selling the product or services. In other words, the exemption is based on the content, not the media chosen.

In a memorandum of decision dated January 22, 1999, the U.S. District Court for the Central District of California held that the unauthorized commercial use by Los Angeles Magazine of a computer-generated image of actor Dustin Hoffman constituted unfair competition, misappropriation of Hoffman's common law and statutory publicity rights, and a violation of Section 43(a) of the Lanham Act.³⁷ Although this decision pre-dated the amendment to the California Civil Code Section which added subsection 3344.1(a)(3), it is consistent with that new subsection.

Los Angeles Magazine digitally "cannibalized" photographs of both living and deceased actors and actresses so that the celebrities appeared to be wearing current fashions. In Hoffman's case, the magazine used a photograph of Hoffman's face and head as he appeared in the 1982 motion picture *Tootsie* and combined it with a new photograph of a male model's body clothed in a gown by Richard Tyler and shoes by Ralph Lauren.

Rejecting the magazine's First Amendment defenses, the Court found that the use of Hoffman's name and image was not newsworthy and that the magazine's speech was false. The court awarded \$1.5 million in compensatory damages, \$1.5 million in punitive damages, and attorney's fees and costs, stating that Hoffman was entitled to the fair market value that a celebrity of Hoffman's reputation, appeal, talent, and fame would bring in the open market for the same type of one-time use in a publication in the Los Angeles area. In calculating this fair market value, the court considered several factors, including Hoffman's stature in the

37 Hoffman v. Capital Cities/ABC, Inc., et. al, Case No. CV 97-3638 DT (District Court, Los Angeles, California filed Jan. 22, 1999), pending appeal to

motion picture industry and the value of the first-time use of Hoffman's name and likeness in a non-movie promotional context.

Other celebrities whose names and images were used in the same issue of Los Angeles Magazine included Humphrey Bogart, Ingrid Bergman, Cary Grant, Marlene Dietrich and Elvis Presley. The case brought on behalf of the Elvis Presley rights holder against Los Angeles Magazine for that use is still pending. Ironically, Cary Grant previously prevailed in a lawsuit filed against Esquire magazine under New York law for substantially similar conduct.³⁸ In that case, Esquire had used a photograph of Grant's face and had replaced the body with that of a male model wearing then-current fashions. Just like the *Hoffman* Court, the *Grant* Court rejected the defendant's First Amendment defenses, stating that the First Amendment allowed Esquire to report almost any activity in which Grant might engage but did not entitle the magazine to appropriate Grant's services as a professional model.

Under both Sections 3344.1 and 3344, a minimum of \$750 in economic damages may be awarded in cases of misappropriation. Awards could also consist of the actual damages suffered, such as the reasonable value of a license, plus any profits not taken into account in computing the actual damages, along with punitive damages and attorney's fees and costs.³⁹ The plaintiff is required to present proof of the defendant's profits, but the burden of proof for any deductible expenses rests on the defendant. While Sections 3344.1 and 3344 do not expressly authorize injunctive relief, their remedies are cumulative and in addition to any others provided for by law.⁴⁰ Therefore, a plaintiff with claims under Sections 3344.1 and 3344 may additionally pursue injunctive relief under Code of Civil Procedure Section 525 and Civil Code Section 3422. In fact,

³⁸ *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (1973).

³⁹ CAL. CIV. CODE §§ 3344(a) and 3344.1(a)(1) (West 1999). To date, there is no California case law awarding non-economic damages in the form of either punitive or emotional distress type damages in a case of misappropriation of deceased celebrity rights. See, however, *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080, (1993) (awarding both punitive damages and emotional distress damages as a form of compensatory damages).

⁴⁰ CAL. CIV. CODE §§ 3344(g) and 3344.1(m) (West 1999).

injunctive relief has specifically been held to be a proper form of relief for the misappropriation of publicity rights.⁴¹

IV. TRADEMARK AND UNFAIR COMPETITION

The rights of both living and deceased celebrities may also be protected under trademark law if some aspect of the celebrity's identity is used as an identifier of goods or services.⁴² A trademark is defined as any "word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."⁴³ Since the requirement for trademark protection is that the celebrity's identity be used to identify goods or services, there is no distinction between the trademark protection of living and deceased celebrities. Unlike copyrights or rights of publicity, there is no arbitrary limitation on the duration of the rights. Trademark rights endure as long as the marks are being used.

The names of many deceased celebrities are registered as trademarks or service marks, including Frank Sinatra, Elvis Presley, Marilyn Monroe, James Dean, and numerous others. A trademark, however, need not be registered with the U.S. Patent and Trademark Office in order to receive protection—unregistered trademarks are protected under Section 43(a) of the Lanham Act.⁴⁴

Nonetheless, there are distinct advantages to registering a mark, including the fact that federal registration is *prima facie* evidence

41 *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (citing *United States v. W.T. Grant Co.*, 345 U.S. 629, 633 (1953)).

42 In fact, trademark protection of a deceased celebrity identity is comparable to the common law right of publicity that the California Supreme Court found to be descendible where the right was exploited during the lifetime of the celebrity. *Lugosi*, 603 P.2d at 428-429.

43 15 U.S.C. § 1127 (2000).

44 *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992), *reh'g denied*, 505 U.S. 1244, (1992); *Metro Pub., Ltd. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir. 1993), summary judgment granted, in part, 861 F. Supp. 870 (N.D. Cal. 1994); Lanham Act §43(a), 15 U.S.C § 1125(a) (2000).

of the validity, registration and ownership of the mark, and of the registrant's exclusive right to use the mark.⁴⁵ This evidence certainly makes it easier to obtain prompt injunctive relief in federal court against an infringer.

A mark is protectable if it either is inherently distinctive or has acquired "secondary meaning," and thus becomes distinctive of the applicant's goods in commerce.⁴⁶ The names or other indicators claimed as marks by celebrities or their successors are likely to be inherently distinctive where the name or logo is unusual. Where the name or logo of a celebrity is not unique, such as the name Marilyn, it is nonetheless likely to have acquired secondary meaning in connection with the status of celebrity.⁴⁷

In the context of living celebrities, the Ninth Circuit has held that trademark protection extends to a celebrity's persona, "a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic..." and unique physical characteristics.⁴⁸ Similarly, the Trademark Trial and Appeal Board has held that the Lanham Act protection extends to the act performed by a character, the name of a radio character, and the name Johnny Carson.⁴⁹ Furthermore, a California District Court held that Tarzan was a mark protected by the Lanham Act,⁵⁰ while the Second Circuit has even held that the protection of the Lanham

45 15 U.S.C. §1057(b) (1994); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, §§ 19:9 and 32:135 (4th ed. 2000 rev.).

46 *Two Pesos, Inc.*, 505 U.S. at 769.

47 *But see* Cairns v. Franklin Mint Co., 24 F. Supp.2d 1013, 1036 (C.D. Cal. 1998) (the name, Diana, Princess of Wales, has such a clear primary meaning as a description of the person herself that it seems unlikely that any secondary meaning could be acquired in her name in the context of charity fund-raising).

48 *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993); and *Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997), respectively.

49 *In re Florida Cypress Gardens Inc.*, 208 U.S.P.Q.288, 292 (T.T.A.B. 1980) (act performed by a character); *In re Folk*, 160 U.S.P.Q. 213 (T.T.A.B. 1968) (the name of a radio character) and *In re Carson*, 197 U.S.P.Q. 554, 555 (T.T.A.B. 1977) (the name Johnny Carson).

50 *Edgar Rice Burroughs, Inc. v. Manns Theatres, et al.*, 195 U.S.P.Q. 159 (C.D. Cal. 1976).

Act extends to specific ingredients of a successful television series, such as a recognizable car.⁵¹

To maintain an action for trademark infringement under Section 43(a) of the Lanham Act, a plaintiff must show that the defendant's use of the mark would create a likelihood of consumer confusion as to the source or sponsorship of the goods or services in connection with which the defendant is using the mark.⁵² The Ninth Circuit analyzes eight factors to determine whether a likelihood of confusion exists: 1) strength of the mark; 2) proximity or relatedness of the goods; 3) similarity of sight, sound and meaning; 4) evidence of actual confusion; 5) marketing channels; 6) type of goods and purchaser care; 7) intent; and 8) likelihood of expansion.⁵³ When a celebrity plaintiff challenges what seems to be an endorsement for its likelihood of confusion, the term "mark" is used for the celebrity's persona—and the "strength" of the mark refers to the level of recognition among members of society.⁵⁴

Claims of trademark infringement may be subject to First Amendment and parody defenses, much like publicity rights. Unlike copyright and publicity rights, however, the failure to prosecute infringers of a trademark, and the licensing of a mark without adequate control over the quality of goods or services sold under the mark, may result in involuntary abandonment of the mark.⁵⁵

Plaintiffs—a celebrity, or a celebrity's successors—must first establish ownership of a protected mark based on some aspect of the celebrity's identity. Next, a plaintiff must show that the defendant's use of the celebrity's identity is a trademark use and is

51 Warner Brothers, Inc. v. Gay Toys, Inc., 658 F.2d 76, 78 (2nd Cir. 1981).

52 Murray v. CNBC, 86 F.3d 858, 860 (9th Cir. 1996), *cert. denied*, 117 S. Ct. 689 (1997).

53 Dreamwerks Production Group, Inc. v. SKG Studio, 142 F.3d 1127 (9th Cir. 1998) (citing AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979)).

54 White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1400 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993).

55 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, note 4, §§ 17:6,

likely to cause consumer confusion as to the source or sponsorship of the goods or services.⁵⁶ If both burdens are met, the plaintiff is entitled to injunctive relief as well as monetary damages under the Lanham Act.⁵⁷ Included in the monetary damages are the defendant's profits, any damages sustained by the plaintiff, the costs of the action, and, in exceptional cases, attorneys' fees. The plaintiff also may be awarded up to three times the amount found as actual damages. As in California Civil Code Section 3344.1 claims for misappropriation of publicity rights, the plaintiff in a trademark infringement case need only prove defendant's sales, with proof of deductible expenses falling to the defendant.⁵⁸

California state law claims that are substantially similar to a federal trademark infringement claim are unfair competition under California Business & Professions Code Section 17200, which prohibits any unlawful, unfair or fraudulent business act or practice; or a claim for false advertising. The standard for a claim of unfair competition is whether members of the public are likely to be confused or deceived.⁵⁹ In contrast to the more expansive federal remedies, however, private litigants under the unfair competition statute are limited to injunctive relief and restitution.⁶⁰

V. COPYRIGHT PROTECTION

In certain circumstances, the intellectual property rights of a deceased celebrity may also be protected by copyright law.⁶¹

⁵⁶ The 9th Circuit held that a clip featuring *The Three Stooges* from a public domain motion film, used in another film without permission of the owner of certain trademark rights to *The Three Stooges*, does not constitute infringement. *See generally*, Comedy 111 Productions v. New Line Cinema, 200 F.3d 593 (9th Cir. 2000).

⁵⁷ 15 U.S.C. §§1116 & 1117 (2000).

⁵⁸ *Id.* at §1117(a) (2000).

⁵⁹ Murray v. CNBC, 86 F.3d at 860, *cert. denied*, 117 S. Ct. 689 (1997); Freeman v. Time, Inc., 68 F.3d 285 (9th Cir. 1995).

⁶⁰ MAI Systems Corp. v. UIPs, 856 F. Supp. 538, 541 (N.D. Cal. 1994).

⁶¹ The majority of copyright issues arising from enforcement of the rights by successors to deceased celebrities are no different than the enforcement of any other copyrights and the numerous copyright issues, such as validity,

Copyright protection does not apply to intangible rights such as the right of publicity. It attaches to an original work of authorship that is fixed in a tangible medium of expression, such as literary works, musical works, dramatic works, audiovisual works, pictorial works, or sound recordings.⁶² Most commonly, however, the copyrights to works to which deceased celebrities contributed or in which they performed were not owned by the celebrities but by motion picture or television studios, record companies, or other business entities.

The deceased celebrity may have authored a copyright-protected work, however, and then transferred the copyright. If so, special attention should be paid to the potential reversion of the copyright to the author's heirs. Transfers of copyrights executed by the author on or after January 1, 1978, may be terminated by the author or his heirs during a five-year period beginning at the end of 35 years after execution of the grant.⁶³ Moreover, if the author of a pre-1978 copyright-protected work dies before the renewal period for his copyright begins, any grant of rights made by the author prior to January 1, 1978, may be terminated within specific time periods set forth in the Copyright Act.⁶⁴ The intent of Congress regarding these reversion-of-rights provisions was to give the author a second chance to control and benefit from his work, secure the opportunity to exploit the work for the author's family if the author died before he or she could register for the renewal, and provide for the author's family after the author's death.⁶⁵

State law right of publicity claims based solely on the exploitation of the copyrighted works could be preempted by federal copyright law. Preemption only occurs when (1) the subject of the claim is a work fixed in a tangible medium of expression and comes within the subject matter or scope of copyright, and (2) the right asserted under state law is equivalent to

infringement, duration, remedies, and so on, are therefore beyond the scope of this article.

62 17 U.S.C. § 102(a) (1994).

63 *Id.* at § 203(a).

64 *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373 (1960); 17 U.S.C. §§ 304 (c) and (d) (2000).

65 *Supernova, Inc. v. American Idol*, 495 U.S. 207 (1990).

the exclusive rights afforded by federal copyright law. An actor's right of publicity is preempted, for example, if the actor's claim is against the owner of the copyright on a motion picture in which the actor performed and is based solely on the distribution of the motion picture containing the actor's performance.⁶⁶ Preemption does not occur, however, if the claims asserted by the celebrity or the celebrity's heirs contain elements that are different from copyright infringement. The right of publicity claims of George Wendt and John Ratzenberger, from the television show *Cheers*, were based on the use of robots resembling the actors in airport bars—not simply on the mere exhibition of the television series—and thus the Ninth Circuit held that the right of publicity claims were not subject to preemption by the Federal Copyright Act.⁶⁷ Similarly, there would be no copyright preemption of a right of publicity claim by a celebrity against an infringer for the unlicensed use of a portrait of the celebrity on neckties, because the right of publicity involved is not equivalent to the copyright right to copy the portrait.

VI. CONTRACT PROTECTIONS

Out of the infinite number of possible contract claims that can be brought on behalf of celebrities, there are several claims that commonly arise in the context of deceased celebrity rights. One is for the use of the deceased celebrity's persona or performance in a manner that is beyond the scope of a contract. A studio licensing the image, for example, for use on T-shirts, of a deceased actor who performed in a movie created by the studio could face a lawsuit if the contract allowed the studio to use the actor's name and image only for the purpose of promoting the motion picture. Further, the contracts that many now-deceased actors entered into with movie studios frequently did not contemplate the modern technological uses of the actors' performances through distribution

66 *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1919 (1996).

67 *Wendt v. Host International, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997).

by television, cable television, home video, laser discs, digital video discs (“DVD”), and other new media.

Numerous courts have faced this issue already, but their decisions are inconsistent because the outcome is dependent upon the actual language of the contract.⁶⁸ A New York district court held that contracts between actor Mickey Rooney and various studios granted to the studios all rights in films in which Rooney appeared, including the rights to use the films on broadcast and cable television, and in home video and merchandising.⁶⁹ On the other hand, the Ninth Circuit held that the language of a license conferring the right to use the plaintiff’s musical composition in synchronization with a film to be exhibited by television did not include the right to distribute videocassettes of the film.⁷⁰

No one can doubt that the use of a deceased celebrity’s previous motion picture performance in a newly created commercial advertisement is likely to be outside the scope of any agreement between the celebrity and a movie studio. Through the use of computer-generated images (“CGIs”), Humphrey Bogart appeared in a Diet Coke commercial, John Wayne performed in advertisements for Coors beer, and Fred Astaire danced with the advertised product in Dust Devil commercials. With advanced technology, deceased celebrities now will be able to appear via CGIs in entirely new motion pictures that would not possibly have been contemplated at the signing of the original contracts—not to mention the spin-offs from such a film, including merchandise, video games, television shows, and theme park attractions. All these uses will require the authorization of the deceased celebrity’s heirs or other successors in interest. This complicated issue of digital manipulation of a celebrity’s image is not covered specifically in any California statute but is presently the subject of discussions by representatives of the studios, talent and the legislature in contemplation of future legislation.

68 For a comprehensive comparison of many of the conflicting decisions, see Kenneth A Linzer, *Coming Soon*, LOS ANGELES LAWYER, April 1998.

69 *Rooney v. Columbia Pictures Industries, Inc.*, 538 F. Supp. 211, 224 (S.D.N.Y. 1982); *aff’d*, 714 F.2d 117 (1982); *cert. denied*, 460 U.S. 1084 (1983).

70 *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851 (9th Cir. 1988).

VII. CONCLUSION

In sum, a deceased celebrity's successors can bring a variety of state and federal infringement claims to halt the unauthorized commercially exploitative use of some aspect of the identity of the celebrity even in expressive works. Infringement can take many forms, particularly in light of the Internet and other technological developments.⁷¹ Consequently, a successor in interest to the intellectual property rights of a deceased celebrity must engage in careful policing of a broad marketplace in order to discover infringers.

⁷¹ See, e.g., *Michaels v. Internet Entertainment Group, Inc.*, 5 F. Supp.2d 823 (C.D. Cal. 1998) (granting preliminary injunction on the basis of copyright, rights of publicity and privacy rights, prohibiting further display via Internet of home video showing singer Bret Michaels and actress Pamela Lee engaging in sexual intercourse).