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Torts - White v. Samsung Electronics America, Inc.: The Wheels of Justice Take an Unfortunate Turn

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TORTS

WHITE v. SAMSUNG ELECTRONICS AMERICA, INC.: THE WHEELS OF JUSTICE TAKE AN UNFORTUNATE TURN

I. INTRODUCTION

The Ninth Circuit's decision in *White v. Samsung Electronics America, Inc.*,[1] greatly expands the protection afforded to an individual's right of publicity under California common law[2] and Federal statutory law.[3] In *White*, the Ninth Circuit held that an advertisement depicting a robot dressed in a wig, gown and jewelry, while posed next to a game board,[4] did not bear a sufficient likeness to Plaintiff Vanna White to constitute an appropriation of her identity under California Civil Code section 3344.[5] However, the court ruled that this same advertisement may be a violation of White's common law right of publicity.[6] The court remanded the case so that the issue could be submitted to a jury.[7] Similarly, the court remanded White's claim under section 43(a) of the Lanham Act,[8] ruling that White had raised a genuine issue of material fact concerning a likelihood of confusion as to

1. White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992) (per Goodwin, J., with whom Pregerson, J., joined; Alarcon, J., concurring in part, dissenting in part), *petition for reh'g en banc denied*, 1993 U.S. App. LEXIS 4928 (9th Cir. March 18, 1993).

2. *See* 5 BERNARD E. WITKIN, SUMMARY OF CALIFORNIA LAW, *Torts* §§ 587, 588 (9th ed. 1988) [hereinafter WITKIN] for a discussion of the common law right of publicity in California.

3. Lanham Act § 43(a), 15 U.S.C.A. § 1125(a) (West 1982).

4. *White*, 971 F.2d at 1396.

5. *See infra* note 75 for the relevant text of CAL. CIV. CODE § 3344 (West 1992).

6. *See* WITKIN, *supra* note 2, §§ 587, 588.

7. *White*, 971 F.2d at 1402.

8. *See infra* note 99 for the text of section 43(a) of the Lanham Act.

her endorsement of Defendant Samsung's products.[9]

II. FACTS

In 1988, Samsung Electronics America, Inc. (hereinafter "Samsung")[10] ran a series of advertisements in approximately six publications.[11] The circulation of these publications was widespread, even national in some instances.[12] The advertisements, created by David Deutsch Associates, Inc. (hereinafter "Deutsch"),[13] all employed a similar theme: a Samsung product purchased today will still be operating in the twenty-first century.[14] The advertisements created a humorous effect by portraying outrageous future outcomes involving cultural items popular at the time the advertisements were published.[15]

One of these advertisements, promoting Samsung video-cassette recorders (VCRs), was the impetus to this action.[16] The advertisement pictured a robot, dressed in a wig, gown and jewelry and was designed by Deutsch to resemble Vanna White.[17] The robot is positioned in front of a game board distinctly resembling the one used on the "Wheel of Fortune" game show.[18] The

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9. *White*, 971 F.2d at 1401.

10. Samsung Electronics America, Inc. is a manufacturer of various electronic products, including televisions, stereos, and video cassette recorders.

11. White v. Samsung Electronics America, 971 F.2d 1395, 1396 (9th Cir. 1992), *petition for reh'g en banc denied*, 1993 U.S. App. LEXIS 4928 (9th Cir. March 18, 1993).

12. *Id.*

13. *Id.* David Deutsch Associates, Inc. is an advertising agency incorporated in New York. *Id.* at 1395. Deutsch was also named a defendant in this action.

14. *Id.*

15. *White*, 971 F.2d at 1396. One ad depicted a raw steak with the caption: "Revealed to be health food. 2010 A.D." Another pictured controversial television show host Morton Downey Jr. in front of an American flag with the caption: "Presidential candidate. 2008 A.D." *Id.*

16. *Id.*

17. *Id.* Defendants do not contest that the robot was styled to resemble Vanna White and, in fact, referred to the ad as the "Vanna White ad." *Id.* at 1399.

18. *White*, 971 F.2d at 1396. The "Wheel of Fortune" gameshow set includes a large board composed of a number of blocks. These blocks are blank on one side and inscribed with a letter of the alphabet on the other side. When all of the blocks are turned around, a word or phrase is revealed. The contestants on the show take turns guessing which letters are included in the word or phrase. When a contestant guesses correctly the corresponding block designating that letter is turned around. Eventually, enough of the letters are revealed to enable a contestant to guess what the word or phrase spells. The winning contestant receives prizes and/or money. Vanna White's primary duty on the show is to turn the blocks to reveal a letter upon a correct guess by one of the contestants.

robot is set in a stance for which Vanna White is famous.[19] Accompanying this picture is a caption reading: "Longest-running game show. 2012 A.D."[20]

After this advertisement was published, Vanna White, who did not consent to the publication or receive any payment for it,[21] brought an action against Samsung and Deutsch in the United States District Court for the Central District of California.[22] The action alleged a violation of: (1) California Civil Code § 3344;[23] (2) California common law right of publicity;[24] and (3) Lanham Act § 43(a).[25] The district court granted summary judgment against White on each of her three claims.[26] White appealed to the United States Court of Appeals for the Ninth Circuit.[27]

III. BACKGROUND

Vanna White alleged that Samsung had "attempted to capitalize on [her] fame to enhance their fortune."[28] The three areas of law under which she brought this action are each concerned with the commercial interest Vanna White retains in her identity as a celebrity.[29] Section 3344 of the California Civil Code

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19. *Id.* The advertisement depicted the robot in the process of turning one block around to reveal a letter. Because turning the letter blocks is Vanna White's primary duty on the "Wheel of Fortune," this is a position in which she would be seen many times throughout the course of the show.

20. *Id.* Below the picture of the robot on the game show set and its accompanying caption was a close-up picture of the control panel of a VCR and the Samsung product insignia. The caption under this picture was: "The VCR you'll tape it on. 2012 A.D. Samsung. The future of electronics."

21. *Id.*

22. Case number CV-88-06499-RSWL. The Honorable Ronald S.W. Lew, Judge.

23. *See infra* notes 75-86 and accompanying text for a discussion of CAL. CIV. CODE § 3344.

24. *See infra* notes 32-73 and accompanying text for a discussion of the California common law right of publicity.

25. 15 U.S.C.A. § 1125(a). *See infra* notes 86-107 and accompanying text for a discussion of Lanham Act § 43(a).

26. *White*, 971 F.2d at 1396-97.

27. *Id.* at 1396.

28. White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1396 (9th Cir. 1992), *petition for reh'g en banc denied,* 1993 U.S. App. 4928 (9th Cir. March 18, 1993).

29. In *White* the court recognized the publicity value of a celebrity's identity:

> Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit.

and the common law right of publicity each concern the resulting invasion of an individual's privacy,[30] as well as the individual's right to control the commercial value of her identity.[31] The Lanham Act § 43(a) addresses the false representation aspect and its ensuing effect on trade and fair competition.

A. California Common Law

1. *The Right of Publicity: Born in Privacy*

Following the publication of *The Right of Privacy* by Samuel Warren and Louis Brandeis,[32] the individual right of pri-

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> 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.

Id. at 1399.

30. The unauthorized appropriation of an individual's name or likeness for commercial benefit was recognized by Professor Prosser as one of the four distinct types of invasion of privacy. William L. Prosser, *Privacy*, 48 Cal. L. Rev. 383, 401-07 (1960) [hereinafter Prosser]. *See also* Witkin, *supra* note 2, §§ 587-591 (discussing California Civil Code § 3344 as a statutory action for invasion of privacy).

31. *See* Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 203-04 (1954).

The distinction between an appropriation which constitutes an invasion of privacy and one which is a "taking" of the commercial value of one's identity is best illustrated by the manner in which damages are calculated. As McCarthy summarized:

> The appropriation type of invasion of privacy, like all privacy rights, centers on damage to human dignity. Damages are usually measured by "mental distress" — some bruising of the human psyche. On the other hand, the right of publicity relates to commercial damage to the business value of human identity. Put simplistically, while infringement of the right of publicity looks to an injury to the pocketbook, an invasion of appropriation privacy looks to an injury to the psyche.

2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 28.01[3] (3rd. ed. 1992) [hereinafter McCarthy].

Moreover, while the right of publicity has emerged as an independent property right, see *infra* notes 35-38 and accompanying text, it is possible that an appropriation may be both an invasion of privacy and an invasion of a commercial interest. This will most likely occur where the plaintiff is a celebrity, and therefore her identity has some commercial value, and the particular means of appropriation cause some damage to the plaintiff's dignity. So, while the right of publicity is an independent right, it retains some connection to the right of privacy. Therefore, because § 3344 and the common law are not restricted to either mental distress damages or commercial damages, they may be regarded as protecting both privacy and property rights.

32. Samuel D. Warren and Louis D. Brandeis, *The Right of Privacy*, 4 Harv. L. Rev. 193 (1890). Warren and Brandeis reviewed cases recognizing what amounted to a right of privacy but which were explained by courts using various tort, property or contractual applications. The authors concluded that what these courts were in effect pro-

vacy gradually gained recognition. This right of privacy is comprised of four distinct types of invasions.[33] It is the fourth type, appropriation of an individual's name or likeness for commercial benefit, which is commonly known as the right of publicity.[34]

Since 1953,[35] the right of publicity, while originally viewed as one type of invasion of privacy,[36] has grown into "an independent legal right with its own distinct characteristics."[37] Today,

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tecting was an individual's "right to be let alone." *Id.* at 195.

33. *See* RESTATEMENT (SECOND) OF TORTS § 652A (1977). The Restatement adopted the four-part division advanced by Professor Prosser. *See*, Prosser, *supra* note 30, at 401-07. The four types of invasion of privacy are:

1. Intrusion upon the plaintiff's seclusion, solitude, or private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation for commercial benefit of the plaintiff's name or likeness.

RESTATEMENT (SECOND) OF TORTS § 652A (1977).

34. The term "right of publicity" apparently was first coined in 1953 by Judge Frank. *See* MCCARTHY, *supra* note 31, § 28.01[2][b]. It was Judge Frank in Haelan Lab., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953), who stated:

> We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photographs, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross', i.e., without an accompanying transfer of a business or anything else. . . . This right might be called a 'right of publicity.'

Id. at 868.

Though it was Judge Frank who seemingly first used the term "right of publicity," the idea that this right exists as an independent property right distinct from the right of privacy was advanced twelve years earlier in a dissenting opinion by Judge Holmes in O'Brien v. Pabst Sales Co., 124 F.2d 167 (5th Cir. 1941) (Holmes, J., dissenting), *cert. denied*, 315 U.S. 823 (1942). Holmes observed:

> The right of privacy is distinct from the right to use one's name or picture for purposes of commercial advertisements. The latter is a property right that belongs to everyone; it may have much or little, or only a nominal, value; but it is a personal right, which may not be violated with impunity.

Id. at 170.

35. *See generally Haelan Laboratories, supra* note 34.

36. *See supra* note 33 and accompanying text.

37. *See* MCCARTHY, *supra* note 31, § 28.01[3]. McCarthy states:

> While there has been much confusion generated by the semantic distinction between "privacy" and "publicity," the courts have now come to recognize that the two rights are clearly separable and rest on quite different legal policies: the right to privacy protects against intrusion upon an individual's private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual's personality for commercial exploitation.

this right exists under the common law of fifteen states.[38]

2. *The Right of Publicity in California: How Broad the Scope?*

California first recognized the right of publicity in 1955. In *Fairfield v. American Photocopy Equip. Co.*,[39] the defendant, a manufacturer of photocopy machines, circulated[40] an advertisement containing a list of lawyers and law firms currently using a particular model of photocopy machine manufactured by the defendant.[41] The plaintiff was an attorney who, prior to circulation of the advertisement, had purchased one of the photocopy machines but who had returned it to the defendant in order to receive a refund.[42] The advertisement contained plaintiff's name as one of the lawyers using the photocopy machine.[43] In ruling that the plaintiff was entitled to bring an action for invasion of his privacy,[44] the court noted that "[t]he exploitation of another's personality for commercial purposes constitutes one of the most flagrant and common means of invasion of privacy."[45]

The unauthorized use of an individual's photograph for commercial purposes is also well recognized as a basis for liability in an action for invasion of privacy.[46] In *Eastwood v. Superior Court*,[47] well-known actor Clint Eastwood brought an action against *The National Enquirer*, a weekly newspaper, for the un-

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Id. See also Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (recognizing that the right of publicity is "an entirely different tort" than invasion of privacy).

38. *See* McCarthy, *supra* note 31, § 28.04[1]. These states are: California, Connecticut, Florida, Georgia, Hawaii, Illinois, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin. Four of these states also have statutes which encompass the right of publicity: California, Florida, Texas, and Wisconsin. *Id.* Nine other states have statutes which include most aspects of the right of publicity: Kentucky, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, and Virginia. *Id.*

39. 291 P.2d 194 (Cal. Dist. Ct. App. 1955).

40. "About 30,000 copies of the advertisement were circulated in major cities throughout the United States." *Id.* at 196.

41. *Id.* The advertisement was meant to convey a list of satisfied customers using the "Apeco Systematic Auto-Stat."

42. *Id.*

43. The advertisement also contained the location of the attorney's practice. The plaintiff was the only Los Angeles lawyer listed. *Id.*

44. *Fairfield*, 291 P.2d at 197-98.

45. *Id.* at 197.

46. *See* Witkin, *supra* note 2, at 685.

47. 198 Cal. Rptr. 342 (Cal. Ct. App. 1983).

authorized use of his photograph.[48] The Enquirer published[49] a story about "Eastwood's romantic involvement with two other celebrities, singer Tanya Tucker and actress Sondra Locke. The pictures of Eastwood and Tucker appeared on the cover of this edition above the caption 'Clint Eastwood in Love Triangle with Tanya Tucker.' "[50] The court ruled that *The Enquirer* had used Eastwood's photograph and name in order to gain a commercial advantage over its competitors.[51] Therefore, "Eastwood ha[d] sufficiently alleged that *The Enquirer* ha[d] commercially exploited his name, photograph, and likeness under both the common law and section 3344, subdivision (a)."[52] The court ordered the respondent court to set aside its order sustaining the demurrer to Eastwood's second cause of action without leave to amend.[53]

The unauthorized use of an individual's voice is also actionable as an invasion of one's right of publicity. In *Midler v. Ford Motor Co.*,[54] the Ninth Circuit ruled that Bette Midler, a well known professional singer and actress, could bring an action under the common law against the defendant for using a "sound-alike"[55] singer in a television commercial advertising defendant's automobiles. After Midler refused an offer to sing one of her most popular songs[56] in the commercial, Ford Motor Company and its advertising agency[57] hired Ula Hedwig, a former backup singer for Bette Midler, to sing the song and instructed her to imitate Midler to the best of her ability.[58] The

48. *Eastwood*, 198 Cal. Rptr. at 344-45. The first cause of action alleged that The Enquirer had invaded Eastwood's privacy by placing him in a false light. The second cause of action, similar to *White*, alleged an invasion of privacy through the commercial appropriation of his photograph, name, and likeness under both the common law and California Civil Code § 3344.

49. The 600-word article appeared in the April 13, 1982 edition. *Id.* at 344.

50. *Id.* at 345.

51. *Id.* at 349.

52. *Eastwood*, 198 Cal. Rptr. at 349. The court refused to recognize an exemption from liability under California Civil Code § 3344(d) which exempts a use of a name, photograph, or likeness in connection with the reporting of news. *Id.* at 349-52.

53. The court issued a peremptory writ of mandamus. *Id.* at 352.

54. 849 F.2d 460 (9th Cir. 1988).

55. *Id.* at 463.

56. The song which the defendants had asked Bette Midler to sing was entitled, "Do You Want To Dance" from Midler's 1973 album, "The Divine Miss M." *Id.* at 461.

57. Young & Rubicam, Inc. was hired in 1985 by Ford Motor Company to develop this particular advertising campaign for the Ford Lincoln Mercury. *Id.*

58. *Id.*

court held "that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California."[59]

Finally, there may be an invasion of one's right to publicity where an individual's likeness is appropriated. In *Motschenbacher v. R. J. Reynolds Tobacco Co.*,[60] the Ninth Circuit[61] ruled that there may be an appropriation even though the defendant had used neither the name, photograph, likeness, or voice of the plaintiff.[62] Here, the defendant[63] produced and broadcast a television commercial depicting racing cars on a racetrack.[64] The race car pictured in the foreground was very similar to the one driven by Plaintiff Motschenbacher.[65] After the commercial was broadcast nationally,[66] Motschenbacher brought an action[67] alleging "misappropriation of his name, like-

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59. *Midler*, 849 F.2d at 463. The court also stated that "[t]o impersonate her voice is to pirate her identity." *Id.*

60. 498 F.2d 821 (9th Cir. 1974).

61. Here, jurisdiction was based on diversity. Therefore, the Ninth Circuit applied the common law as it believed the California courts would. *Motschenbacher*, 498 F.2d at 823 (following Erie R.R. Co.v. Tompkins, 304 U.S. 64 (1938)). Although the case was tried in Federal court, *Motschenbacher* represents an application of the California common law right of publicity. *Motschenbacher*, 498 F.2d at 823.

62. *See id.* at 822.

63. R.J. Reynolds is a tobacco company which produces Winston brand cigarettes. *See id.* The William Esty Company is an advertising agency which was also named a defendant in this action. *See id.*

64. *Id.*

65. *Id.* Motschenbacher was at the time a "professional driver of racing cars, internationally known and recognized in racing circles and by racing fans." *Id.* Since 1966, he had "consistently 'individualized' " his cars to set them apart from those of other drivers and to make them more readily identifiable as his own. *Id.* The defendants made slight alterations to the photograph of the racing cars, including:

> they changed the numbers on all racing cars depicted, transforming plaintiff's number "11" into "71"; they "attached" a wing-like device known as a "spoiler" to plaintiff's car; they added the word "Winston," the name of their product, to that spoiler and removed advertisements for other products from the spoilers of other cars. However, they made no other changes, and the white pinstriping, the oval medallion [these were the distinguishing marks of plaintiff's car], and the red color of plaintiff's car were retained.

Id.

66. *Id.*

67. The action was filed in the United States District Court for the Central District of California. *Id.* at 822.

ness, personality, and endorsement. . . ."[68] The district court granted summary judgment for the defendants noting that the driver of the car in the advertisement was not recognizable and therefore could not reasonably be understood to be Motschenbacher.[69] The Ninth Circuit concluded that an individual's proprietary interest in his identity should be afforded legal protection.[70] The court agreed that the plaintiff's likeness was not recognizable.[71] However, the court found that the distinguishing features of the car made it possible for a reasonable inference to be drawn that it was in fact plaintiff in the car.[72]

Thus, under California common law there may be an invasion of one's right to publicity by appropriation of his or her name, photograph, voice or likeness. The plaintiff must establish: (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent by plaintiff; (4) resulting injury.[73]

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68. *Motschenbacher*, 498 F.2d at 822.

69. *Id.* at 822-23. The court first characterized plaintiff's action as an invasion of privacy action. *Id.* at 822. The court then found as a matter of law that:

> The driver of car No. 71 in the commercial (which was plaintiff's car No. 11 prior to said change of number and design) is anonymous; that is, (a) the person who is driving said car is unrecognizable and unidentified, and (b) a reasonable inference could not be drawn that he is, or could reasonably be understood to be plaintiff, Lothar Motschenbacher, or any other driver or person.

Id. at 822-23.

70. *Id.* at 825. The Ninth Circuit first discussed the dual theories under which courts have protected an individual's interest in his own identity: a privacy theory or a "right of publicity" property theory. *Id.* The court then decided that it did not need to distinguish between the two theories and that it only needed to determine whether California courts would recognize such an interest and protect it. *Id.* at 826.

71. *Motschenbacher*, 498 F.2d at 827.

72. *Id.* The court stated:

> [T]he court's . . . conclusion of law to the effect that the driver is not identifiable as plaintiff is erroneous in that it wholly fails to attribute proper significance to the distinctive decorations appearing on the car. As pointed out earlier, these markings were not only peculiar to the plaintiff's cars but they caused some persons to think the car in question was plaintiff's and to infer that the person driving the car was the plaintiff.

Id. The court vacated the district court's grant of summary judgment in favor of the defendants and remanded the case for further proceedings. *Id.*

73. *Eastwood*, 198 Cal. Rptr. at 347 (citing WILLIAM L. PROSSER, LAW OF TORTS pp. 804-07 (4th ed. 1971)).

B. California Civil Code § 3344

The California statute was passed in 1971 prohibiting the unauthorized use of a person's name, photograph, or likeness.[74] In 1984, the statute was amended to extend the protection to include use of one's voice or signature.[75]

While there is disagreement as to whether section 3344 of the Civil Code codifies or complements the common law right of privacy,[76] both the statute and the common law protect the same right.[77] However, in order to prevail under the statute the plaintiff must show that the appropriation was intentional.[78] In contrast, proof of intent is not required under the common law.[79]

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74. Cal. Civ. Code § 3344 (West 1992) (added Stat. 1971 ch. 1595, § 1).

75. The portions of California Civil Code § 3344 pertinent to this article provide:

> (a) Any person who knowingly uses another'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 such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. . . .
>
> (b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable.
>
> (1) A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.
>
> . . .
>
> (g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

Cal. Civ. Code § 3344 (West 1992) (amended Stat. 1984 ch. 1704, § 2).

76. In *Eastwood*, 198 Cal. Rptr. at 346, the court stated that "the fourth category of invasion of privacy, namely, appropriation, 'has been *complemented* legislatively by Civil Code section 3344. . . .' " (citing Lugosi v. Universal Pictures, 603 P.2d 425, 428 n.6 (Cal. 1979)).

But see Witkin, *supra* note 2, at 687, stating "C. C. 3344 . . . *codified* a person's right to recover damages for the knowing use of his 'name, photograph, or likeness.' " (emphasis added).

77. *Compare* Cal. Civ. Code § 3344(a) (West 1992) *with* notes 32-73 and accompanying text. Both the statute and the common law right of publicity protect against appropriations of a person's name, photograph, voice, or likeness.

78. "Any person who *knowingly* uses . . . ." Cal. Civ. Code § 3344(a) (emphasis added).

79. *See* Fairfield v. American Photocopy Equip. Co., 291 P.2d 194 (Cal. Dist. Ct.

Additionally, plaintiff must show a "direct" connection between the unauthorized use and the commercial purpose.[80]

In *Midler v. Ford Motor Co.*,[81] the Ninth Circuit ruled that Bette Midler was not entitled to bring an action under section 3344(a) because the voice used in the commercial was not her voice.[82] The Court also held that the "term 'likeness' refers to a visual image not a vocal imitation."[83]

The interpretation of section 3344(a) by the courts in *Midler* and *Johnson v. Harcourt, Brace, Jovanovich, Inc.*[84] demonstrates the narrow applicability of the statute.[85]

C. THE LANHAM ACT § 43(a)

The Lanham Act[86] was enacted in 1946 in an attempt to

App. 1955). There the court stated:

> The motives of a person charged with invading the right are not material with respect to the determination whether there is a right of action, and malice is not an essential element of a violation of the right. . . . Inadvertence or mistake is no defense where the publication does in fact refer to the plaintiff in such manner as to violate his right of privacy.

Id. at 197.

80. *Eastwood*, 198 Cal. Rptr. at 347 (following Johnson v. Harcourt, Brace, Jovanovich, Inc., 118 Cal. Rptr. 370 (Cal. Ct. App. 1974)). In *Johnson*, the defendant had published a college textbook containing a reprint of an article about plaintiff's finding a large sum of money and turning in the money. *Id.* at 372-73. The court held that defendant's use of the article was not a violation of § 3344(a) because it was not included primarily for purposes of selling the textbook. *Id.* at 381. "[T]he article was not a primary reason for the textbook; nor was it a substantial factor in the students' purchases of the books." *Id.*

81. *See supra* notes 54-59 and accompanying text.

82. *Midler*, 849 F.2d at 463.

83. *Id.*

84. *See supra* note 80.

85. The *Johnson* court refused to read the phrase "for purposes of advertising or selling, or soliciting purchases . . ." from § 3344 broadly so as to encompass use in a college textbook. *Johnson*, 43 Cal. App. 3d at 895. The *Midler* court read both "voice" and "likeness" narrowly in denying the applicability of Bette Midler's claim. *Midler*, 849 F.2d at 463.

86. 15 U.S.C.A. §§ 1051-1127 (West 1982). The 1946 Trademark Act, more commonly known as the Lanham Act, derives its name from Representative Fritz Garland Lanham, a Democratic representative from Texas who was a member of Congress from 1919 to 1947. As chairman of the House Committee on Patents, Congressman Lanham was given the draft of a trademark statute developed by Edward S. Rogers, a member of the American Bar Association Committee appointed to investigate alternatives to trademark legislation existing in the 1930's. Congressman Lanham introduced the draft as

create a general federal law of unfair competition.[87] Three factors provided the greatest catalyst for the creation of this general federal law of unfair competition. First, as a result of the 1938 Supreme Court decision in *Erie Railroad Co. v. Tompkins*,[88] the existing body of federal substantive law, including the body of law pertaining to unfair competition, lost its significance.[89] The net result of the *Erie* decision was to create as many bodies of unfair competition law as there were states.[90] In passing the Lanham Act, Congress could provide for a nationally uniform unfair competition law, notwithstanding the holding of *Erie*.[91]

Second, passage of the Lanham Act was necessary if the United States was going to recognize its obligations as a signatory to the Inter-American Convention of 1929.[92] United States companies doing business in foreign countries found it difficult to secure protection from unfair trade practices due to the failure of the United States to carry out, through legislation, its international treaty obligations.[93]

Third, the Lanham Act served as a response to the restrictive holding of *American Washboard Co. v. Saginaw Manufacturing Co.*[94] *American Washboard* established the doctrine that in actions involving misrepresentations about goods, only claims against "palming off"[95] were actionable.[96] Because the Inter-

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H.R. 9041 on January 19, 1938. After many years of hearings and compromise, the Lanham Act was finally signed into law by President Truman on July 5, 1946, and took effect one year later, July 5, 1947. *See* MCCARTHY, *supra* note 31, § 5.04.

87. MCCARTHY, *supra* note 31, § 27.02[1].

88. 304 U.S. 64 (1938) (holding that there is no federal general common law).

89. Walter J. Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, 32 N.Y.U. L. REV. 1029, 1030 (1957) [hereinafter Derenberg]; *see also*, MCCARTHY, *supra* note 31, § 27.02[1].

90. Derenberg, *supra* note 89, at 1030.

91. *See id.*

92. *See id.* As a signatory to the Inter-American Convention of 1929, the United States obligated itself to provide effective legal protection against many different forms of unfair practices in international trade. *Id.*

93. S. Rep. No. 1333, 79th Congress, 2d Sess. (1946), *reprinted in* 1946 U.S.C. Cong. Serv. 1274, 1276.

94. 103 F.2d 281 (6th Cir. 1900); *see also* Paul E. Pompeo, Note, *To Tell The Truth: Comparative Advertising And The Lanham Act Section 43(a)*, 36 CATH. U. L. REV. 565, 570 (1987) [hereinafter Pompeo].

95. "Palming off" occurs when the defendant sells his goods as those of the plaintiff; e.g., the manufacturer imitates another's trademark, trade name, product appearance, or packaging, leading consumers to purchase *Y*'s goods in the belief that they are actually

American Trademark Convention of 1929 required relief beyond such claims as "palming off" in cases of unfair competition, the restrictive holding of *American Washboard* was contrary to the United States' obligations on the international level.[97] Thus, the United States could meet its obligations under the Inter-American Trademark Convention by passing the Lanham Act and creating federal relief broader in scope than that of "palming off."[98]

Section 43(a) of the Lanham Act[99] was originally conceived as a means of easing the restrictive requirements of proof in the common law false advertising cases,[100] which required proof of willfulness and an intent to deceive.[101]

X's. In *American Washboard*, the plaintiff, who was the nation's sole manufacturer of aluminum washboards, claimed deception since the defendant's zinc washboards were represented as being made of aluminum. The court concluded that deception alone could not raise a cause of action. The court held that "it is only where this deception induces the public to buy the goods as those of the complainant that a private right of action arises." *Id.* at 284-85.

96. *Id.* at 285; *see also* L'Aiglon Apparel, Inc. v. Lana Lobell, Inc., 214 F.2d 649, 651 (3rd Cir. 1954) (holding that section 43(a) of the Lanham Act does not require claims of "palming off").

97. *See* Derenberg, *supra* note 89, at 1037-38; *see also* Pompeo, *supra* note 94, at 570.

98. *See* Derenberg, *supra* note 89, at 1037-38; *see also* Pompeo, *supra* note 94, at 570.

99. Section 43(a) of the Lanham Act, 15 U.S.C.A § 1125(a) (West 1982), provides as follows:

> Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

In 1988, § 43(a) was amended to its current version, 11 U.S.C.A. § 43(a) (West Supp. 1992). This amendment, however, was enacted after White filed her complaint and is therefore not applicable to the Ninth Circuit's consideration of Vanna White's action. *White*, 971 F.2d at 1399 n.2.

100. McCarthy, *supra* note 31, § 27.02[1]. *See also American Washboard Co.*, 103 F.2d at 281.

101. *Id.* Section 3 of the Act of March 19, 1920, ch. 104, 41 Stat. 533, which was

The true vehicle which the drafters envisioned guiding them to their destination of a "federal law of unfair competition" was actually section 44 of the Lanham Act.[102] Section 44[103] contained the language, "protection against unfair competition," which implied that a great deal of leeway would be afforded in the breadth with which protections against unfair competition would be available. This expansive vehicle, however, never materialized in section 44.[104]

Although the language of section 43(a) is restrictive in regard to its application,[105] it has gradually expanded through judicial construction[106] into the foremost federal vehicle for the assertion of the two major and distinct types of unfair competition: (1) false advertising and (2) infringement of registered and unregistered marks, names and trade dress.[107]

IV. COURT'S ANALYSIS

A. THE MAJORITY

1. *Section 3344: A Narrow Application*

In *White v. Samsung Electronics America, Inc.*,[108] the Ninth Circuit began its review of the district court's[109] entry of

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superseded by section 43(a) of the Lanham Act, required a showing of wilfulness and an intent to deceive. This proof of wilfulness made enforcement of section 3 practically impossible. Parkway Baking Co. v. Freihofer Baking Co., 255 F.2d 641, 648 n.7 (3rd Cir. 1958) (citing Parfumerie Roger et Gallet Societe Anonyme v. Godet, Inc., 17 Trade-Mark Rep. 1, 2 (S.D.N.Y. 1926)).

102. MCCARTHY, *supra* note 31, § 27.02[1].

103. 15 U.S.C.A. § 1126 (West 1982).

104. *See* MCCARTHY, *supra* note 31, § 27.02[1].

105. Because § 43(a) is limited to a prohibition against a "false description or representation," it can never be a federal codification of the overall law of "unfair competition." MCCARTHY, *supra* note 31, § 27.02[1]; *Cf.* Lanham Act § 44, which provides for "protection against *unfair competition*." *See id.* (emphasis added).

106. The leading case which provided the impetus for the explosion of § 43(a) as a federal vehicle for protection against unfair competition was L'Aiglon Apparel, Inc. v. Lana Lobell, Inc., 214 F.2d 649 (3rd Cir. 1954). This explosion was due to the court in *L'Aiglon Apparel* completely breaking with common law precedents regarding false advertising and embracing section 43(a). Derenberg, *supra* note 89, at 1046.

107. MCCARTHY, *supra* note 31, § 27.02[1].

108. White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992), *petition for reh'g en banc denied*, 1993 U.S. App. LEXIS 4928 (9th Cir. March 18, 1993).

109. This action before the Ninth Circuit was an appeal from the United States District Court for the Central District of California. Ronald S.W. Lew, District Judge,

summary judgment in favor of the defendant by discussing Vanna White's claim under California Civil Code section 3344.[110] The court disagreed with White's contention that the "Samsung advertisement used her 'likeness' in contravention of section 3344."[111] The Ninth Circuit in *White* again applied a narrow interpretation of the statute as it did in *Midler v. Ford Motor Co.*[112] The court noted that it previously rejected Bette Midler's section 3344 claim[113] because the statutory prohibition against appropriation of an individual's voice was limited to actual recordings of the plaintiff's voice and did not include "vocal imitation."[114] Similarly, the section 3344 prohibition against appropriation of "likeness" is limited to a visual "image."[115] Relying on *Midler*, the court again adopted a narrow application of section 3344.

Applying this narrow standard, the court held that the robot used by Samsung in the advertisement was not a "likeness" within the meaning of section 3344.[116] Thus, the court affirmed the district court's dismissal of White's section 3344 claim.[117]

Presiding. Argued and submitted June 7, 1991 in Pasadena California.

110. *White*, 971 F.2d at 1397.

111. *Id.*

112. 849 F.2d 460 (9th Cir. 1988). *See supra* notes 82-84 and accompanying text.

113. *See supra* notes 54-59 and accompanying text.

114. *See White*, 971 F.2d at 1397 (quoting *Midler*, 849 F.2d at 463).

115. *White*, 971 F.2d at 1397.

116. *Id.* The court stated:

> In this case, Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White's precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a 'likeness,' we agree with the district court that the robot at issue here was not White's 'likeness' within the meaning of section 3344.

Id. From this statement it is difficult to determine what the meaning of "likeness" is for purposes of the statute. It can only be determined that this particular robot in the Samsung advertisement was not a "likeness." By applying the statute narrowly, the court has aligned itself with its previous decisions and the decisions of the California courts. However, it has reserved itself an avenue by which a broader application of the statute, even under similar circumstances, might be embraced.

117. *Id.*

2. *The Common Law: Beyond "Name" or "Likeness"*

The court began its analysis of White's common law right of publicity claim[118] with a discussion of the four elements of the right of publicity claim as stated in *Eastwood v. Superior Court*.[119] While the court agreed with the district court that Samsung's use of the robot was not an appropriation of White's "name or likeness,"[120] it did not believe the common law right of publicity was so confined.[121] Rather, it held that because *Eastwood* involved the appropriation of Clint Eastwood's name and photograph,[122] that court did not have "occasion to consider the extent beyond the use of name or likeness to which the right of publicity reaches."[123] The court stated that appropriation of "name or likeness" is not a required element of the right of publicity, but only a species of cases in which the cause of action had been recognized.[124]

In recognizing that the right of publicity is not limited to an appropriation of "name or likeness,"[125] the court relied on Prosser's article *Privacy*.[126] In *Privacy*, Prosser contended that there may be an appropriation of one's identity without the use of his name or likeness.[127] From this the court draws support for its conclusion that the common law covers means of appropriation beyond those specified in section 3344.[128]

The court then discussed *Motschenbacher v. R.J. Reynolds*

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118. *White*, 971 F.2d at 1397.

119. 198 Cal. Rptr. 342 (Cal. Ct. App. 1983). *See supra* note 73.

120. *White*, 971 F.2d at 1397. Therefore Vanna White had not established the second prong of the *Eastwood* test. *Id.*

121. *Id.*

122. *See supra* notes 46-53 and accompanying text.

123. *White*, 971 F.2d at 1397. The court stated that: "[The *Eastwood* court] held only that the right of publicity 'may be' pleaded by alleging, inter alia, appropriation of name or likeness, not that the action may be pleaded only in those terms." *Id.*

124. *Id.*

125. *Id.*

126. *Id.* at 1397-98; *see also generally* Prosser, *supra* note 30.

127. *See* Prosser, *supra* note 30, at 401 n.155. Prosser states: "It is not impossible that there might be appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy." *Id.*

128. *See supra* note 75. Section 3344 includes appropriations of name, voice, signature, photograph, or likeness.

Tobacco Co.,[129] as a case in which the Ninth Circuit extended the protection afforded an individual by the common law right of publicity beyond appropriation of "name or likeness."[130] From *Motschenbacher*, the court adopted the proposition that the common law protects against appropriations of one's "identity."[131] The court drew further backing for this proposition from *Midler v. Ford Motor Co.*,[132] wherein the Ninth Circuit ruled that Bette Midler had stated a claim because the defendants had appropriated her identity.[133]

The court's final illustration is found in a decision of the United States Court of Appeals for the Sixth Circuit. In *Carson v. Here's Johnny Portable Toilets, Inc.*,[134] the Sixth Circuit ruled that defendant corporation, which rented and sold portable toilets, had appropriated appellant Johnny Carson's[135] right of publicity in naming its products "Here's Johnny Portable Toilets."[136] The *Carson* court stated that "[i]f the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his 'name or likeness' is used."[137]

The Ninth Circuit then concluded that *Motschenbacher*, *Midler*, and *Carson* demonstrated that the common law right of publicity reaches beyond appropriation of "name or likeness."[138]

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129. *See supra* notes 60-72 and accompanying text.

130. *See White*, 971 F.2d at 1398.

131. *See id.*

132. 849 F.2d 460.

133. *Id.* The court stated:

> In *Midler*, this court held that, even though the defendants had not used Midler's name or likeness, Midler had stated a claim for violation of her California common law right of publicity because "the defendants . . . for their own profit in selling their product did appropriate part of her identity" by using a Midler sound-alike.

Id. (citing Midler v. Ford Motor Co., 849 F.2d 460, 463-64 (9th Cir. 1988)).

134. 698 F.2d 831 (6th Cir. 1983).

135. Johnny Carson was the host and star of "The Tonight Show," a well-known television program broadcast five nights a week by the NBC television network. *Id.* at 832. Each night on the show he was introduced by a drawn-out pronunciation of the phrase "Here's Johnny." *Id.*

136. *Id.* at 834-37.

137. *Id.* at 835. In disagreeing with the district court's dismissal of Carson's right of publicity claim, the court noted that its "conception of the right of publicity is too narrow." *Id.* In *White*, the Ninth Circuit cites this ruling in its discussion of the broad protection afforded by the common law right of publicity. *White*, 971 F.2d at 1398.

138. *Id.* The court stated:

From here the court began its analysis of the facts presented in Vanna White's case.[139]

First, the court reiterated its interpretation of the common law right of publicity as protecting against more than merely a "laundry list" of express means of appropriating identity.[140] The court believed this interpretation was necessary in order to ensure the effectiveness and viability of the right of publicity.[141] According to the court, the "laundry list" will no longer be composed of particular means in which one's identity may be appropriated but rather will protect against all appropriations of one's identity.[142]

The court did not attempt to define or describe the reaches of the term "identity."[143] However, the court's discussion sug-

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> These cases teach not only that the common law right of publicity reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity. The right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable.

Id.

139. *Id.*

140. *White*, 971 F.2d at 1398-99.

141. *Id.* The court stated:

> A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth. . . . Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. The right would fail to protect those plaintiffs most in need of its protection.

Id.

142. *See id.* This appears to be the direction in which the Ninth Circuit is advancing the common law right of publicity as seen in the court's elimination of the requirement that the plaintiff show a particular means of appropriation; i.e., name or likeness. *Id.*

143. *See id.* at 1399. The court does imply that the attributes by which a celebrity is recognized are likely to fall under the umbrella of "identity":

> The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

Id.

gests that the appropriate test is whether the defendant has used a significant combination of attributes identifiable as belonging to the plaintiff and through which the plaintiff is recognizable.[144]

The court then applied this test to the Samsung advertisement.[145] Initially, it noted that the individual aspects of the advertisement say little.[146] However, the court emphasized that when viewed as a whole, "they leave little doubt about the celebrity the ad is meant to depict."[147] Also significant, noted the court, is the fact that the defendants themselves referred to the advertisement as the "Vanna White ad."[148]

In concluding its discussion of Vanna White's claim under the common law right of publicity, the court summarized the need to protect a celebrity's marketable identity.[149] The court

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144. This test is implicitly derived from a hypothetical presented by the court:

> Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the last five years would reach: the ad is about Michael Jordan.

White, 971 F.2d at 1399.

145. *Id.*

146. *Id.*

147. *Id.* The court's description of the advertisement noted that:

> The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna white dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one.

Id.

148. *Id.*

149. *Id.*

viewed the argument advanced by Samsung, i.e. that there was no appropriation because Samsung did not use Vanna White's name or likeness, as one which would eviscerate the common law right of publicity and the Ninth Circuit therefore held that the district court erred in granting summary judgment against Vanna White for her common law claim.[150]

3. *Lanham Act § 43(a): Likelihood of Confusion?*

The Ninth Circuit next addressed the district court's determination of White's claim under section 43(a) of the Lanham Act.[151] In order to prevail on her Lanham Act claim, the court noted that White must show that Samsung, in running the robot ad, created a likelihood of confusion as to whether White was endorsing Samsung's VCRs.[152]

While the Ninth Circuit has recognized several different multi-factor tests for determining whether a likelihood of confusion exists,[153] the court pointed out that none of them are correct to the exclusion of the others.[154] Since the court reviews appeals from summary judgment de novo, and because the district court apparently did not utilize any test in granting Samsung's summary judgment motion,[155] the court chose to apply the eight-factor test enumerated in *AMF, Inc. v. Sleekcraft Boats*.[156]

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150. *White*, 971 F.2d at 1399.

151. *See supra* notes 86-107 and accompanying text for a discussion of the legislative history of Lanham Act § 43(a).

152. *White*, 971 F.2d at 1399.

153. *See* AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979) (applying eight-factor test); J.B. Williams Co. v. Le Conte Cosmetics, Inc., 523 F.2d 187, 191 (9th Cir. 1975), *cert. denied*, 424 U.S. 913 (1976) (applying six-factor test); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1217 (9th Cir. 1987) (applying five-factor test).

154. *White*, 971 F.2d at 1399. Each multi-factor test was applied not as an exclusive list of requirements for determining the existence of a likelihood of confusion, but rather was meant to provide a list of factors from which the district court might more easily make its ultimate determination. *See* Eclipse Associates Ltd. v. Data General Corp., 894 F.2d 1114, 1118 (1990).

155. *See White*, 971 F.2d at 1400.

156. 599 F.2d 341, 348-49 (9th Cir. 1979). The relevant factors for consideration, as stated in *AMF*, are as follows:

(1) the strength of the plaintiff's mark;
(2) relatedness of the goods;
(3) similarity of the marks;
(4) evidence of actual confusion;
(5) marketing channels used;

In determining the strength of the plaintiff's mark, the court began by defining the terms "mark" and "strength" such that they would apply to cases involving confusion over endorsement by a celebrity plaintiff. In such cases, the court pointed out that "mark" means the celebrity's persona,[157] while the "strength" of the mark refers to the level of recognition the celebrity enjoys among members of society.[158] The court stated: "[i]f Vanna White is unknown to the segment of the public at whom Samsung's robot ad was directed, then that segment could not be confused as to whether she was endorsing Samsung VCRs."[159] However, because of White's extreme familiarity to the general public, the court held that White's mark, or "celebrity identity," is strong.[160]

The court applied the second factor, the relatedness of the goods, by defining the term "goods," in cases involving confusion over celebrity endorsement, to mean "the reasons for or source of the plaintiff's fame."[161] Since Vanna White had attained her fame through the medium of television, and since the ad's premise was that Samsung VCRs would be taping the "longest-running game show" well into the future, the court found that White's goods are closely related to Samsung's VCRs.[162]

In consideration of the third factor, the similarity of the marks, the court determined that it both supports and contradicts a finding of likelihood of confusion.[163] While the court stated that, "[o]n the one hand, all of the aspects of the robot ad identify White; on the other, the figure is quite clearly a robot, not a human."[164] Due to this ambiguity, the court concluded that the remaining *AMF* factors must be considered to deter-

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(6) likely degree of purchaser care;
(7) defendant's intent in selecting the mark;
(8) likelihood of expansion of the product lines.

157. *White*, 971 F.2d at 1400 (citing Allen v. National Video, Inc., 610 F. Supp. 612 (D.C.N.Y. 1985)).

158. *Id.* (citing Academy of Motion Picture Arts v. Creative House, 944 F.2d 1446, 1455 (9th Cir. 1991)).

159. *Id.*

160. *Id.*

161. *Id.*

162. *White*, 971 F.2d at 1400.

163. *Id.*

164. *Id.*

mine whether a likelihood of confusion existed.[165]

Because she did not present any evidence of actual confusion, the court found that the fourth factor, whether there is any evidence of actual confusion, did not favor White's claim.[166]

Applying the fifth factor, or the marketing channels used, the court determined that it favored White because she had appeared in many magazines in the same stance that the robot was depicted in the ad in question, and it was magazines which were used as the marketing channel for the robot ad.[167]

As to the sixth factor, the likely degree of purchaser care, the court simply stated that "[c]onsumers are not likely to be particularly careful in determining who endorses VCRs, making confusion as to their endorsement more likely."[168]

Perhaps finding the seventh factor, the defendant's intent in selecting the mark, more important than the other *AMF* factors, the court analyzed the defendant's intent in much more detail than any other factor. While noting that the district court had found that the defendants had intended the ad as a spoof of the "Wheel of Fortune" game show,[169] the court stated that "[t]he relevant question is whether the defendants 'intended to profit by confusing consumers' concerning the endorsement of Samsung VCRs."[170]

In determining the intent of the defendants, the court looked to the series of advertisements as a whole and found that a "[j]ury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers" that Vanna White was endorsing Samsung VCRs.[171]

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165. *Id.*

166. *White*, 971 F.2d at 1400.

167. *Id.*

168. *Id.*

169. *Id.* at 1400-01. The court did not disagree with the district court that the defendants intended to spoof Vanna White and "Wheel of Fortune." Rather, the court found that intending to spoof Vanna White does not preclude the possibility that defendants also intended to confuse consumers regarding White's endorsement of Samsung VCRs.

170. *Id.* at 1400 (quoting Toho Co. Ltd. v. Sears Roebuck & Co., 645 F.2d 788 (9th Cir. 1981)).

171. *White*, 971 F.2d at 1401.

To support its conclusion, the court compared two ads: the robot ad and an ad involving Morton Downey Jr.[172] Since Morton Downey Jr. personally appeared in the ad, the court held that consumers would likely believe that Morton Downey Jr. was paid to appear in the ad and was endorsing Samsung products.[173] The court concluded that the series of ads, when taken as a whole, could leave consumers with the impression that celebrity Vanna White, like celebrity Morton Downey Jr., was endorsing Samsung products,[174] therefore showing that Samsung intended to profit from such confusion.[175]

Finally, the court dismissed the eighth factor, the likelihood of expansion of the product lines, as not being appropriate for consideration in a celebrity endorsement case such as this.[176]

Considering its application of each of the *AMF* factors to the facts of this case, the court held that the district court erred in granting summary judgment against Vanna White as to her Lanham Act claim.[177]

B. THE DISSENT

Judge Alarcorn, while concurring with the court's resolution of section 3344 of the California Civil Code, dissented from the court's analysis of White's claims under both the common law right of publicity and Lanham Act § 43(a).[178]

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172. *Id.* The Morton Downey Jr. ad depicted Mr. Downey as a presidential candidate in the year 2008.

173. *See id.* The court acknowledged that the Morton Downey Jr. ad was clearly intended as a spoof of presidential elections and Morton Downey Jr.

174. *Id.* at 1400-01.

175. *See id.*

176. *Id.* at 1401.

177. *Id.* The court emphasized, however, the following two points:

> First, construing the motion papers in White's favor, as we must, we hold only that White has raised a genuine issue of material fact concerning a likelihood of confusion as to her endorsement. Whether White's Lanham Act claim should succeed is a matter for the jury. Second, we stress that we reach this conclusion in light of the peculiar facts of this case. In particular, we note that the robot ad identifies White and was part of a series of ads in which other celebrities participated and were paid for their endorsement of Samsung's products.

Id. (citations omitted).

178. *White*, 971 F.2d at 1402.

1. *Right of Publicity*

The dissent rejected the majority's conclusion that a plaintiff may recover damages where there is an appropriation of the plaintiff's "identity," pointing to the fact that no California court has recognized such a right.[179] Moreover, the dissent found no evidence in the record to support the majority's holding that Vanna White's "identity" was appropriated.[180]

The dissent emphasized that a cause of action for appropriation of the right of publicity has always been limited to the requirement of proof of an appropriation of name or likeness.[181] Indeed, the district court based its decision on *Eastwood v. Superior Court* because there had been no use of a likeness.[182]

The dissent focused on the intent of the California Legislature and the distinguishable facts of the cases relied upon by the majority to refute the majority's holding. The intent of the California Legislature, Judge Alarcon pointed out, seemed to have implicitly precluded the result reached by the majority through the maxim, *inclusio unius est exclusio alterius*.[183] Section 3344 of the California Civil Code originally protected against appropriations of name or likeness. After the Ninth Circuit's decision in *Motschenbacher v. R.J. Reynolds Tobacco Co.*,[184] however, the California Legislature amended section 3344 to where it now protects against appropriations of voice or signature, as well as appropriations of name or likeness.[185] According to Judge Alarcon, "[t]he clear implication from the fact that the California Legislature chose to add only voice and signature to the previously protected interests is that it wished to limit the cause of

179. *Id.*

180. *Id.*

181. *Id.* (citing, *inter alia*, Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (holding that an actor's right to exploit his name or likeness for value was personal to the actor and did not survive his death); Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454 (Cal. 1979) (holding that the use of the name Rudolph Valentino in a fictional biography was not an appropriation); Eastwood v. Superior Court, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983)).

182. *White*, 971 F.2d at 1402.

183. *Id.* at 1403. The phrase *inclusio unius est exclusio alterius* means the inclusion of one is the exclusion of another. BLACK'S LAW DICTIONARY 763 (6th ed. 1990); *see infra* note 222 and accompanying text.

184. 498 F.2d 821 (9th Cir. 1974).

185. *White*, 971 F.2d at 1403.

action to enumerated attributes."[186]

The dissent distinguished each of the federal cases relied upon by the majority, *Motsenbacher v. R.J. Reynolds Tobacco Co.*,[187] *Midler v. Ford Motor Co.*[188] and *Carson v. Here's Johnny Portable Toilets, Inc.*,[189] instructing that "[t]he proper interpretation of *Motsenbacher*, *Midler*, and *Carson* is that where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an ad, a triable issue of fact has been raised as to whether his or her identity [h]as been appropriated."[190] In the advertisement in dispute in *White*, the dissent pointed out that it is "patently clear" to anyone viewing the ad that Vanna White was not being depicted.[191] In fact, "[n]o reasonable juror could confuse a metal robot with Vanna White."[192]

Essential to a proper analysis of the facts of *White*, according to the dissent, is a recognition of the distinction between a performer and the part he or she plays; a distinction between Vanna White, the person, and the role that she plays as the current hostess on the "Wheel of Fortune" television game show.[193] Once this distinction is realized, the dissent claimed, it is evident that because her role as hostess of "Wheel of Fortune" is not a part of her personal identity, there was no appropriation of her identity.[194]

2. *The Lanham Act*

Finally, the dissent rejected the majority opinion as an instance of applying the wrong legal standard.[195] In order to suc-

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186. *Id.*

187. 498 F.2d 821 (9th Cir. 1974). *See supra* notes 129-131 and accompanying text for a discussion of *Motschenbacher*.

188. 849 F.2d 460 (9th Cir. 1988). *See supra* notes 112-117 and accompanying text for a discussion of *Midler*.

189. 698 F.2d 831 (6th Cir. 1983). *See supra* notes 134-137 and accompanying text for a discussion of *Carson*.

190. *White*, 971 F.2d at 1404.

191. *Id.*

192. *Id.*

193. *Id.*

194. *Id.* at 1404-05.

195. *Id.*

ceed on a claim for damages under section 43(a) of the Lanham Act, the dissent noted, contrary to the majority, that White must prove actual deception of the consuming public.[196] Since White offered no evidence of actual confusion, the dissent concluded that the district court was correct in granting summary judgment on White's Lanham Act claim.[197]

Nevertheless, the dissent considered the majority's application of the eight-factor test enumerated in *AMF, Inc. v. Sleekcraft Boats*.[198] Stating that the third factor, the similarity of the marks, is the most important factor, the dissent noted that the majority merely glossed over it.[199] While the majority pointed out that the common characteristics "identify" White, the dissent recognized the requirement that the marks be compared in their entirety.[200] Accordingly, the consideration must involve two entities: the robot on the one hand, and Vanna White on the other. Looked at this way, the dissent found that no one could reasonably confuse the two.[201] Support for this conclusion can be seen when attributes other than the hair, dress, physical proportions and jewelry are compared.

When a mark has certain "salient aspects," they are given greater weight due to their correspondingly greater impact upon the consumer.[202] The dissent found that the face of Vanna White and the features of the robot are more important characteristics than those considered by the majority.[203] When these more important characteristics are compared, the dissent stated that "[i]t should be clear to anyone viewing the commercial advertisement that the crude features of the robot are very dissimilar to Vanna White's attractive and human face."[204]

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196. *Id.* at 1405 (citing Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197, 208 (9th Cir. 1989) (holding that a claim for damages under section 43(a) requires a showing that the defendant "actually deceived a significant portion of the consuming public")).

197. *White*, 971 F.2d at 1406.

198. *Id. See supra* notes 156-177 and accompanying text for a discussion of the *AMF* eight-factor test.

199. *White*, 971 F.2d at 1406.

200. *Id.*

201. *Id.*

202. *Id.*

203. *Id.*

204. *White*, 971 F.2d at 1406.

Absent any confusion on the part of the consuming public, there can be no claim for a Lanham Act violation.[205] Therefore, because Vanna White failed to offer any evidence of actual deception, and it is clear that no reasonable person could confuse the robot with Vanna White, the dissent concluded that the district court was correct in granting Samsung's motion for summary judgment.[206]

V. CRITIQUE

A. California Civil Code Section 3344

The Ninth Circuit agreed with the district court that Samsung's use of the robot was not an appropriation of Vanna White's likeness.[207] In doing so, the court interpreted section 3344 narrowly and thereby aligned itself with previous decisions interpreting the statute.[208]

B. California Common Law

The reasoning of the Ninth Circuit in its decision to remand White's common law claim reveals a failure to recognize the significant expansion of the common law which the court has allowed. This expansion has been accomplished in two steps. Initially, the common law right was freed from the confines of the statutory provisions.[209] Next, the court broadened the common law to such an extent that an individual may now bring an action not only where the figure portrayed in the advertisement[210]

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205. *Id.*

206. *Id.* at 1407.

207. White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1397 (9th Cir. 1992), *petition for reh'g en banc denied,* 1993 U.S. App. LEXIS (9th Cir. March 18, 1993).

208. *See supra* note 85 and accompanying text.

209. *See White*, 971 F.2d at 1397-99. The court's determination that Samsung had not appropriated White's "likeness" under § 3344 would likewise have been determinative of her common law claim if the court did not find that the common law provided broader protection. The court stated that it "agree[d] that the robot did not make use of White's name or likeness. However, the common law right of publicity is not so confined." *Id.* at 1397.

210. For purposes of this article, it will be assumed that the vehicle of appropriation was a television, radio, or print advertisement. It is, however, possible that the appropriation might occur in a different medium. *See, e.g.*, Eastwood v. Superior Court, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983) (plaintiff's photograph used on the cover of a tabloid

is or may be the plaintiff,[211] but even where the figure portrayed is clearly *not* the plaintiff.

The court, therefore, has cast loose from its mooring the common law right of publicity and has placed upon the jury the burden of ensuring that it does not drift too far. Moreover, the court has failed to provide any standard of guidance by which the jury's burden may be allayed.

1. *Does Section 3344 Place a Limit on the Scope of the Common Law Protection?*

The conclusion that the common law right of publicity affords broader protection to a plaintiff than does section 3344 marks the first point on which the court's augmentation of the right of publicity becomes questionable. This development beyond the statutory confines is not itself flawed for this issue is not firmly resolved.[212] It is the degree of expansion which is problematic.

In support of its conclusion that the right of publicity is not limited to appropriations of "name or likeness,"[213] the court relied upon *Eastwood v. Superior Court*.[214] The court interpreted *Eastwood* as a denotation that the "name or likeness" formulation is not an element of the right of publicity,[215] but rather "a description of the types of cases in which the cause of action had been recognized."[216] Therefore, a cause of action under the common law is not restricted to the terms of section 3344 and may

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newspaper). *See also* Young v. Greneker Studios, 26 N.Y.S.2d 357 (1941) (manikins made in form, features, and likeness of plaintiff).

211. *See, e.g., Eastwood, supra* notes 119-124 and accompanying text. In *Eastwood*, the defendant used an actual photograph of the plaintiff. *Eastwood*, 198 Cal. Rptr. at 345. *See also Motschenbacher, supra* notes 129-131 and accompanying text. In *Motschenbacher*, the plaintiff was not clearly visible in the commercial. *Motschenbacher*, 498 F.2d at 822. However, the similarity of the racing car depicted and the plaintiff's car could have reasonably led one to believe that it was in fact the plaintiff featured in the commercial. *Id.* at 827.

212. *See supra* note 76.

213. *White*, 971 F.2d at 1397. It is likely that the court also would find that the right of publicity extends beyond appropriations of voice, signature, or photograph. These means of appropriation are prohibited by section 3344(a). However, because these means were not at issue in *White* the court did not discuss them in its analysis.

214. 198 Cal. Rptr. 342 (Cal. Ct. App. 1983).

215. *White*, 971 F.2d at 1397.

216. *Id.*

be pleaded in terms other than "name or likeness."[217]

A contrary position is advanced by the dissent. In his dissenting opinion, Judge Alarcon took issue with the majority's ruling that the use of a likeness is not required under California common law.[218] Judge Alarcon disagreed that a plaintiff need only show an appropriation of her "identity" to recover.[219] The dissent found that the only difference between the common law and section 3344 is that section 3344 is limited to *intentional*[220] appropriations, whereas the common law protects against both intentional and unintentional appropriations.[221] Judge Alarcon believed that this had been decided by the California Court of Appeal in *Eastwood* and therefore it was not an issue which the Ninth Circuit needed to resolve.[222] Additionally, the dissent inferred a legislative resolution to this issue from the 1988 amend-

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217. *Id.* The majority stated that the *Eastwood* court "held only that the right of publicity cause of action 'may be' pleaded by alleging, *inter alia*, appropriation of name or likeness, not that the action may be pleaded *only* in those terms." *Id.*

218. *White*, 971 F.2d at 1402.

219. *Id.* Judge Alarcon stated:

> According to the majority, recovery is authorized if there is an appropriation of one's "identity." I cannot find any holding of a California court that supports this conclusion. . . . All of the California cases that my research has disclosed hold that a cause of action for appropriation of the right to publicity requires proof of the appropriation of a name or likeness.

Id.

220. CAL. CIV. CODE § 3344(a). "Any person who *knowingly* uses another's name . . ." *Id.* (emphasis added).

221. *White*, 971 F.2d at 1403. Judge Alarcon stated:

> [T]he majority has ignored the fact that the California Court of Appeal in *Eastwood* specifically addressed the differences between the common law right to publicity and the statutory cause of action codified in California Civil Code section 3344. The court explained that '[t]he differences between the common law and the statutory actions are: (1) Section 3344, subdivision (a) requires *knowing* use whereas under case law, mistake and inadvertence are not a defense against commercial appropriation and (2) section 3344, subdivision (g) expressly provides that its remedies are cumulative and in addition to any provided by law.' *Eastwood*, 198 Cal.Rptr. at 346 n.6 (emphasis in original). The court did not include appropriations of identity by means other than name or likeness among its list of differences between the statute and the common law.

Id.

222. *White*, 971 F.2d at 1403. Judge Alarcon viewed the majority's expansion of the right of publicity as an unsupported "attempt [by a federal court] to create new law for the state of California." *Id.*

ment to section 3344. Judge Alarcon noted that the California Legislature's amendment to the statute included appropriations of voice or signature thereby evidencing the intent of the Legislature to "limit the cause of action to enumerated attributes."[223] Upon this, the dissent based its opposition to the majority's conclusion that the right of publicity provides broader protection than does section 3344.

From the opposing conclusions reached by the majority and dissent it is clear that the relationship between section 3344 and the common law right of publicity is not firmly resolved. Moreover, the disagreement is not unique to the *White* court.[224] So,

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223. *Id.* Judge Alarcon stated:

> The interest of the California Legislature as expressed in California Civil Code section 3344 appears to preclude the result reached by the majority. The original section 3344 protected only name or likeness. In 1984, ten years after our decision in Motschenbacher v. R. J. Reynolds Tobacco Company, 498 F.2d 821 (9th Cir.1974) and 24 years after Prosser speculated about the future development of the law of the right of publicity, the California legislature amended the statute. California law now makes the use of someone's voice or signature, as well as name or likeness, actionable. Cal.Civ.Code sec. 2233(a) (Deering 1991 Supp.). Thus, California, after our decision in *Motschenbacher* specifically contemplated protection for interests other than name or likeness, but did not include a cause of action for appropriation of another person's identity. The ancient maxim, *inclusio unius est exclusio alterius*, would appear to bar the majority's innovative extension of the right of publicity. The clear implication from the fact that the California Legislature chose to add only voice and signature to the previously protected interests is that it wished to limit the cause of action to enumerated attributes.

Id.

Apparently, Judge Alarcon believed that the Legislature intended for the statute to provide a list of "enumerated attributes" which are protected by both section 3344 *and* the common law. This conclusion is inevitable if Judge Alarcon's discussion of the exclusive nature of the statute is to have any bearing on the exclusivity of the common law. Otherwise, the exclusivity would apply only to interests protected by the statute and would have no bearing upon actions brought under the common law. Therefore, this would support the position of the majority rather than Judge Alarcon's position.

224. The disagreement about whether California Civil Code § 3344 "codifies" or "complements" is evidenced by the conflicting discussions of the majority and dissenting opinion in *White*, in particular, the opposing interpretations of *Eastwood*. The difficulty lies in determining whether section 3344 codified the right of publicity; i.e., reduced the common law right to statutory language, and added the "*knowing*" element, or whether section 3344 complemented the right of publicity; i.e., provided an additional basis of recovery where the appropriation is intentional, and also fixed the amount of damages.

The court in Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979), stated that the

while the majority's expansion of the right of publicity beyond the confines of section 3344's enumerated types of appropriations is debatable, it is not necessarily defective. Rather, the weakness is found in the next step the court took in its analysis after espousing the more liberal view. It is with this second step that the court sets the right of publicity adrift.

2. *Determining Appropriation: What are the Limits?*

Having concluded that the common law right of publicity covers more than *name* or *likeness*, the court went further by eliminating the need to categorize the means of appropriation at all. After *White*, there need only be an appropriation of an individual's *identity*.[225] A plaintiff who brings a right of publicity action may be successful if she can show that the defendant has used some combination of attributes which are identifiable as belonging to the plaintiff. The court proposed that the *identity* test was necessary in order to protect celebrities from "clever advertising strategist[s]"[226] who would simply develop new methods of appropriating one's identity if the common law only prohibited specific means of appropriation.[227] For the court, this was simply the natural progression of the right of publicity as anticipated by Prosser[228] and illustrated in cases such as *Motschenbacher*,[229] *Midler*,[230] and *Carson*.[231] However, the court's discussion reveals that, as applied to the particular facts of *White*, its decision was not merely an inherent advancement of the law.

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right of publicity "has been *complemented* legislatively by Civil Code section 3344. . . ." *Id.* at 428 n.6 (emphasis added). *See also* Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 n.6 (Cal. Ct. App. 1983) (citing *Lugosi* and noting that section 3344 complements the common law right of publicity). *But see* WITKIN, *supra* note 2, at § 589, stating that section 3344 "*codified* a person's right to recover. . . ." *Id.* at 687 (emphasis added).

The distinction is further distorted by the fact that although *Eastwood* states that section 3344 *complements* the common law, Judge Alarcon derives from that opinion the view that it *codifies* the common law. *White*, 971 F.2d at 1403.

225. *See supra* note 142 and accompanying text.

226. *White*, 971 F.2d at 1398.

227. *See supra* note 141 and accompanying text.

228. *See supra* notes 126-128 and accompanying text.

229. *See supra* notes 60-72 and accompanying text.

230. *See supra* notes 54-59 and accompanying text.

231. *See supra* notes 134-137 and accompanying text.

The court first discussed *Motschenbacher v. R.J. Reynolds Tobacco Co.*[232] as a case where the Ninth Circuit found that there might be an appropriation without the use of either name or likeness.[233] The court then cited *Midler v. Ford Motor Co.*[234] as additional authority. The court's final basis of support was found in *Carson v. Here's Johnny Portable Toilets, Inc.*[235]

While these cases do lend support to the majority's conclusion, they are wholly distinguishable in one important aspect. In each of these cases there is a reasonable basis for confusion as to whether the plaintiff was in fact the individual associated with or identified with the product. As the dissent noted:

> [t]he common theme in these federal cases is that identifying characteristics unique to the plaintiffs were used in a context in which they were the only information as to the identity of the individual. The commercial advertisements in each case showed attributes of the plaintiff's identities which made it appear that the plaintiff was the person identified in the commercial. No effort was made to dispel the impression that the plaintiffs were the source of the personal attributes at issue. The commercials affirmatively represented that the plaintiffs were involved.[236]

In contrast, in *White* the robot depicted in the advertisement clearly was not Vanna White.[237]

Therefore, while *Motschenbacher*, *Midler* and *Carson* may fairly be read as protecting more than "name" or "likeness," these cases do not lend support to the majority's conclusion that there may be an appropriation even where the depiction complained of is obviously not the plaintiff. To allow a plaintiff to bring an action where the defendant has appropriated neither the plaintiff's *name* or *likeness* may be simply an advancement of the common law. To allow this same action where the subject

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232. 498 F.2d 821 (9th Cir. 1974).

233. *White*, 971 F.2d at 1398.

234. 849 F.2d 460 (9th Cir. 1988).

235. 698 F.2d 831 (6th Cir. 1983). *See supra* notes 134-137 and accompanying text.

236. *White*, 971 F.2d at 1404.

237. Judge Alarcon noted that "[i]t is patently clear to anyone viewing the commercial advertisement that Vanna White was not being depicted. No reasonable juror could confuse a metal robot with Vanna White." *Id.*

in the advertisement is *clearly* not the plaintiff marks a significant departure from the common law right of publicity.

3. *What Effect on the Common Law?*

By allowing Vanna White to present her claims to a jury[238] the Ninth Circuit has opened the floodgates through which numerous right of publicity claims may now flow. A plaintiff need not show that the defendant employed a particular means of appropriation. She does not have to prove that the defendant used her voice, signature, likeness, photograph, or name.[239] Under the *identity* test[240] announced in *White*, the plaintiff only has to show that the defendant has used attributes or characteristics through which the plaintiff is recognizable. Moreover, the plaintiff will be permitted to proceed with the action even where reasonable people viewing the advertisement would not mistake the portrayal as being the plaintiff.

The troubling result is that in reaching its decision a jury is left with near complete discretion in concluding what constitutes an appropriation. The jury is not limited to certain types of appropriations.[241] Nor is the jury required to find that the appropriation which is the subject of the action *is* or *could reasonably be mistaken for* the plaintiff. In short, this allows a jury to find for the plaintiff where the advertisement does not identify the plaintiff but merely reminds one of her.[242] The minimum stan-

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238. *Id.* at 1402. The court cautioned that "we hold only that White has pleaded claims which can go to the jury for its decision." *Id.*

239. *See supra* note 75.

240. *See supra* note 144 and accompanying text.

241. The majority's conclusion that the right of publicity protects against appropriations of one's *identity* does not evidence a departure from either the common law or section 3344. The departure is found in the court's conclusion that one's identity may be appropriated by means other than name, likeness, photograph, voice, or signature.

242. "[I]nfringement of the right of publicity is governed by the test of 'identifiability' of the plaintiff as a person. . . . [A]n infringement of one's right of publicity is triggered if a more than insignificant number of people identify the object person from the defendant's unpermitted commercial use." *See* MCCARTHY, *supra* note 31, § 28.02[5].

When this test is applied to the Samsung advertisement, it becomes apparent that the right of publicity could not be triggered. The word *identify* means "to regard as identical." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1123 (1976). No reasonable person could regard the robot in the advertisement as identical to Vanna White. However, the court held that a jury could find that the right of publicity had been triggered. *See supra* note 212. It appears that for the Ninth Circuit in *White*, the right of publicity may be triggered if the defendant's unpermitted commercial use simply *reminds* people

dard for identification has been reduced to the capability of reminding one of another individual. It is not difficult to imagine that a jury who has seen the plaintiff in the courtroom, had her identifying characteristics and attributes described to them, and is then asked to decide whether the advertisement identifies the plaintiff, will quite often find that it does.[243]

In *White*, the court granted the jury great discretion in determining what constitutes an appropriation of a person's identity. This degree of discretion will prove problematic for defendants in right of publicity actions for nearly every advertisement will contain elements which might remind prospective jurors of some celebrity.[244] In granting this discretion even where no reasonable person could find that Vanna White was depicted in the Samsung advertisement, the court has cast loose the right and placed the burden of charting its course upon the jury, with very little guidance from the court. Without some limitations on the jury's discretion it will be very difficult to strike a fair balance between those with "celebrity identity value"[245] and those who market and advertise products.

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of the plaintiff. *See* WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1920 (1976) (defining *remind* as putting one in mind of something or causing to remember).

243. This after-the-fact judgment of the advertisement by the jury is, of course, always a problem in a right of publicity action. However, the problem is greatly reduced if the jury is limited to finding that the advertisement appropriated a particular aspect of the plaintiff's identity; i.e. likeness, voice, name, photograph, or signature. Where the depiction in the advertisement is clearly *not* the plaintiff, the need for further restrictions on the jury's discretion arises. *See infra* notes 249-253 and accompanying text.

244. While the court did not have to address the issue because Samsung acknowledged that the robot was purposefully styled to resemble Vanna White, the holding in *White* does not preclude the possibility that an action may be brought even where the resemblance is purely coincidental. The effect upon the creative processes of advertising departments and agencies will be dramatic. Those who develop and create the advertising campaigns will proceed with great caution when seeking to in some way invoke any celebrity image for fear that they may have appropriated *someone's* identity. Not only will they be prohibited from intentionally using a celebrity's identity in a manner similar to the Samsung advertisement, but considerable effort will have to be directed toward ensuring that there is no inadvertent appropriation. The likelihood of "accidental" appropriation is not insignificant. As the court states, "[t]he identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice." *White*, 971 F.2d at 1399. So, just as it is easy for one to intentionally evoke the identity of a celebrity, it is likewise as easy to do so inadvertently.

245. *Id.*

4. *Striking a Balance*

In order to ensure that its expansion of the common law adequately protects both plaintiffs and defendants, the Ninth Circuit should have required that where it is clearly not the plaintiff depicted in the advertisement the plaintiff must prove an appearance of endorsement.[246] This would allow plaintiffs such as Vanna White to bring a right of publicity action where the defendant has appropriated some aspect of her identity other than name, likeness, voice, photograph, or signature while also protecting the creative expression of advertisers and marketers. Those creating advertisements would be free to evoke celebrity identities "without resorting to obvious means such as name, likeness, or voice"[247] but only up until the point of using that which is of value in a celebrity's identity: the power to exploit the identity for profit through endorsement.[248]

Currently, there is no requirement that the plaintiff show that the appropriation bears an appearance of endorsement.[249] However, there are two justifications for this which do not apply to an appropriation like that in *White*. First, while the right of publicity has grown to become an independent right,[250] it still remains closely related to the right of privacy.[251] Where there is

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246. This requirement would be similar to the *likelihood of confusion* test applied with respect to Lanham Act § 43(a). *See supra* notes 156-176 and accompanying text.

247. *White*, 971 F.2d at 1399.

248. This endorsement value is the property which the right of publicity protects. "[T]he right of publicity protects against commercial loss caused by appropriation of an individual's personality for commercial exploitation." MCCARTHY, *supra* note 31, § 28.01[3].

249. "California law has not imposed any requirement that the unauthorized use or publication of a person's name or picture be suggestive of an indorsement or association with the injured person. . . . [T]he appearance of an 'indorsement' is not the *sine qua non* of a claim for commercial appropriation." *Eastwood*, 198 Cal. Rptr. at 348. *See also* MCCARTHY, *supra* note 31, § 28.03[1]: "The unpermitted use of a person's identity merely to draw attention to a product or advertisement infringes the right of publicity. There need be no false inference that plaintiff endorses or approves the product."

250. *See supra* note 38.

251. This is illustrated by the Ninth Circuit's discussion of the right of publicity in *Motschenbacher*. The court first recognized that injury sustained in an appropriation action "may be largely, or even wholly, of an economic or material nature." *Motschenbacher*, 498 F.2d at 824. After discussing the fact that some courts protect this right under a privacy theory and others under a property theory, the court noted that it was not necessary to decide under which of these theories the California courts would recognize the right. *Id.* at 825-26. It was only necessary for the court to determine that the California courts would protect the right. *Id.*

an appropriation in an advertisement though no appearance of an endorsement, there is still an injury to the person due to the invasion of her privacy. The absence of an endorsement does not mean that there is no resulting injury. For this reason it is not essential to the right of publicity that there be an appearance of an endorsement.

A second reason is that endorsement may be implicit in appropriations where the subject depicted in the advertisement is or could reasonably be mistaken for the plaintiff. A celebrity endorsement does not necessarily have to take the form of the celebrity appearing in the advertisement and specifically proclaiming that she endorses the product. The mere presence of a celebrity will often be sufficient to cause those viewing the advertisement to believe that the celebrity is lending her credibility[252] to the product and therefore recommends or uses the product. Endorsement suggests credibility. The celebrity's presence in the advertisement suggests endorsement. Therefore, because endorsement is tacit in the very presence of the celebrity, it need not be proved.

These justifications do not hold true where the advertisement is one like that in *White*. Where it is clearly not the plaintiff in the advertisement, the right of publicity has completely separated from its invasion of privacy roots. The damages Vanna White sought had very little, if anything, to do with her suffering "humiliation, embarrassment, and outrage."[253] There was not, nor could there be, any invasion of Vanna White's privacy because it was not her in the advertisement. And no reasonable person would have thought it was.

Vanna White sought damages entirely for the unauthorized use of her property; i.e. the endorsement value of her celebrity identity. Therefore, in order to prevail she should be required to

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The court's discussion suggests that the right of publicity retains elements of both privacy and property theories and that there is no need to categorize it as one or the other.

252. "Spokespersons and endorsers are thought to build credibility. They are either celebrities we admire, experts we respect, or someone 'just like us' whose advice we might seek out." WILLIAM WELLS ET AL., ADVERTISING PRINCIPLES AND PRACTICE 403 (2nd ed. 1992).

253. *See Motschenbacher*, 498 F.2d at 824 (discussing the mental and subjective injuries resulting from an appropriation).

show that Samsung did in fact use her property. Her endorsement was not implicit because she was not present in the advertisement. The advertisement simply featured a robot styled to resemble her.

A requirement that the jury find that Samsung's advertisement suggested an endorsement by Vanna White would focus the jury's attention on whether there was an appropriation rather than whether the advertisement reminded the viewer of Vanna White. This would act as a check upon the expanded discretion of the jury and ensure that the right of publicity is not lost in a sea of reminders and vague similarities.

C. The Lanham Act

The majority's analysis with regard to Vanna White's Lanham Act claim attempted to determine whether a likelihood of confusion existed as a result of Samsung's portrayal of a robot dressed in a similar fashion to Vanna White.[254] Its analysis, however, is misplaced and merely glosses over the relevant factors to be considered.

The dissent emphasized that the majority utilized the wrong legal standard in passing on White's Lanham Act claim.[255] Citing *Harper House Inc. v. Thomas Nelson, Inc.*,[256] the dissent found that White must show *actual deception* in order to prevail in an action for damages under Lanham Act § 43(a).[257] Inasmuch as Vanna White offered no evidence of actual confusion among the consuming public,[258] her Lanham Act claim must fail.

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254. *See* notes 17-20 and accompanying text for a description of the "Vanna White ad."

255. *White*, 971 F.2d at 1405.

256. 889 F.2d 197, 208 (9th Cir. 1989) (opinion by Goodwin, C.J.) (holding that Lanham Act § 43(a) requires, *inter alia*, "that defendants' false and deceptive representations and advertisements *actually deceived* a significant portion of the consuming public") (emphasis added).

257. *White*, 971 F.2d at 1405. The Second, Third, Seventh and Tenth Circuits each have also held that proof of *actual confusion* is a prerequisite to a claim for damages under Lanham Act § 43(a). PPX Enterprises v. Audio Fidelity Enterprises, 818 F.2d 266, 271 (2nd Cir. 1987); Parkway Baking Co. v. Freihofer Baking Co., 255 F.2d 641, 648 (3rd Cir. 1958); Hesmer Foods, Inc. v. Campbell Soup Co., 346 F.2d 356, 359 (7th Cir. 1965), *cert. denied*, 382 U.S. 839 (1965); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 525 (10th Cir. 1987).

258. *White*, 971 F.2d at 1400.

While the dissent was correct in concluding that the district court did not err in granting Samsung's summary judgment motion, a consideration of the majority's analysis of the factors enumerated in *AMF, Inc. v. Sleekcraft Boats*[259] results in a similar conclusion.

The majority focused on the seventh *AMF* factor, the intent of the defendant in selecting the mark, in reaching its conclusion that a likelihood of confusion existed.[260] This emphasis is misplaced, however, due to the apparent intention of the advertisements as a whole.

Samsung chose to develop a series of advertisements, each of which involved a popular cultural item of today which evolved into an outrageous, twenty-first century existence.[261] The underlying theme of each of these advertisements was: a Samsung product purchased today would be in operation in the twenty-first century.

In the so-called "Vanna White ad," a robot was depicted in the *role* in which Vanna White has become famous. Certainly no one could believe that Samsung intended to suggest that Vanna White would still be the hostess of the "Wheel of Fortune" game show in the year 2012. Rather, the "Vanna White ad" was intended to parody the way television will be in the twenty-first century;[262] instead of a human being playing the role of hostess on the "longest-running game show," we will be watching a robot.

The *AMF* factor which is dispositive to this case is, as the dissent points out, the third factor, or the similarity of the marks. The majority finds that this factor both favors and disfa-

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259. *See* notes 156-177 and accompanying text for a discussion of the majority's analysis of the *AMF* eight-factor test.

260. *White*, 971 F.2d at 1400.

261. *See id.* at 1396.

262. While the advertisement has the effect of reminding consumers of Vanna White, it does not identify her. *See* note 241 for a discussion of the distinction between *identify* and *remind*. It is illustrative to note that Vanna White is not the only person to have been the hostess of "Wheel of Fortune." Indeed, for the first seven years of its existence, the hostess of "Wheel of Fortune" was Susan Stafford, who also has blonde hair. Appellees' Brief at 3, White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992) (No. 90-55840).

vors Vanna White.[263] While the majority states that all of the aspects of the robot ad identify Vanna White, it concedes that the figure in the ad is "quite clearly a robot, not a human."[264] This concession precludes the majority's statement that the ad identifies Vanna White.

As stated in the dissent, where certain aspects of a mark create a greater impact in the consumer, such aspects are given greater weight.[265] In the "Vanna White ad," it is the features of the robot's face which create the greatest impact. Upon looking at the advertisement, a consumer instantly recognizes that the figure in the ad, while playing a role which Vanna White has made famous, is clearly a robot. Thus, inasmuch as no reasonable consumer could possibly confuse the robot as resembling Vanna White, a consideration of the third factor, or similarity of the marks, must be resolved in Samsung's favor.

The Ninth Circuit has repeatedly held that where circumstances are such that no likelihood of confusion exists, there can be no violation of Lanham Act § 43(a).[266] The majority has failed to recognize the difference between a likelihood of confusion as to Vanna White's endorsement of Samsung's products, and the inevitable result of a robot appearing in a set similar to the "Wheel of Fortune" game show set: the robot merely reminds the consumer of Vanna White. While it is this reminder which makes the advertisement so amusing, the vast distinction between the robot and Vanna White precludes the determination that the consuming public was confused as to whether White endorsed Samsung's products.[267]

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263. *White*, 971 F.2d at 1400.

264. *Id.*

265. *Id.* at 1406 (citing Country Floors, Inc. v. Gepner, 930 F.2d 1056 (3rd Cir. 1991) (holding that the word "Country" should be given greater weight in comparing the marks "Country Tiles" and "Country Floors")).

266. *White*, 971 F.2d at 1406-07 (Alarcon, J., dissenting) (citing Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir. 1981) ("Bagzilla" garbage bags did not infringe "Godzilla" mark); Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978), *cert. denied sub nom*, O'Neill v. Walt Disney Prods., 439 U.S. 1132 (1979) ("Silly Sympathies" in adult comic books did not infringe on Disney's "Silly Symphonies")).

267. *See White*, 971 F.2d at 1406 (Alarcon, J., dissenting).

VI. CONCLUSION

The effectiveness of the law is largely contingent upon its ability to adapt and advance as society changes. The necessity of progression in the law is not diminished by opposition to it. However, unchecked expansion may be as detrimental as an inability to change.

Thus, the Ninth Circuit's conclusion that the right of publicity affords greater protection than does section 3344 of the California Civil Code is not flawed simply because it may be a break from the common law. The error lies in the court's failure to recognize the significant departure and to provide substantive guidelines to ensure that the right of publicity does not drift too far, too fast. As applied to the facts of *White*, the court's reasoning is troubling. The effects of its holding will prove even more so.

The Ninth Circuit's reasoning with regard to White's Lanham Act claim is similarly troubling. In failing to recognize the requirement of proof of actual confusion where damages are sought, the court has departed from the reasoning of several other Circuits. The net effect of such departure will be witnessed by the confusion that will inevitably result as the court's reasoning is relied upon as precedent.

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