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Fame: Ownership Implications of Intellectual Property and Agency Law

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Cover Page Footnote

B.S., cum laude, Princeton University; J.D., Harvard Law School; Professor of Law, University of Baltimore School of Law; member, National Academy of Television Arts and Sciences. The author would like to thank Louis Angelos, League Representative, Baltimore Orioles, for his comments on the manuscript, Rebecca Oppenheimer of Andalman and Flynn for her suggestions on the entertainment sections and for lending her encyclopedic knowledge of movies, and Hayley Hassan, UB '19 and Julia Anne McKeachie, UB '20 for their extraordinary research assistance. The views expressed are the author's own.

Fame: Ownership Implications of Intellectual Property and Agency Law

Max Stul Oppenheimer*

In the pre-internet era, it was difficult to reach a wide audience without the help of a professional organization, so as a practical matter control typically rested with distributors rather than with talent. Now that direct public distribution is easy and inexpensive, distributors' practical control has greatly diminished, and it is therefore important to consider the legal principles that govern the control of the use of "fame." This Article defines fame as a bundle of intellectual property rights and analyzes the ownership of those rights under intellectual property and agency theories.

* B.S., cum laude, Princeton University; J.D., Harvard Law School; Professor of Law, University of Baltimore School of Law; member, National Academy of Television Arts and Sciences. The author would like to thank Louis Angelos, League Representative, Baltimore Orioles, for his comments on the manuscript, Rebecca Oppenheimer of Andalman and Flynn for her suggestions on the entertainment sections and for lending her encyclopedic knowledge of movies, and Hayley Hassan, UB '19 and Julia Anne McKeachie, UB '20 for their extraordinary research assistance. The views expressed are the author's own.

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INTRODUCTION

A professional football player kneels during the National Anthem in order to draw attention to a cause that he personally believes in.¹ Our initial reaction is “First Amendment,” or maybe the more subtle “symbolic speech . . . First Amendment.”² A

¹ See Steve Wyche, *Colin Kaepernick Explains Why He Sat During the National Anthem*, NAT'L FOOTBALL LEAGUE (Aug. 27, 2016, 10:04 AM), <http://www.nfl.com/news/story/0ap3000000691077/article/colin-kaepernick-explains-why-he-sat-during-national-anthem> [https://perma.cc/FRJ6-6JHB]. While the most recent high-profile example, Mr. Kaepernick was not the only, or even the first, performer to use the platform provided by their performance to promote a personal belief. In the 1968 Olympics, American gold and bronze medalist sprinters Tommie Smith and John Carlos raised their fists during the National Anthem at their award ceremony. See, e.g., Ben Cosgrove, *The Black Power Salute That Rocked the 1968 Olympics*, TIME (Sept. 27, 2014), <https://time.com/3880999/black-power-salute-tommie-smith-and-john-carlos-at-the-1968-olympics/> [https://perma.cc/ESN4-384W]. Boxer George Foreman waived an American flag after winning his gold medal. See *Meet George—Biography*, OFFICIAL WEBSITE GEORGE FOREMAN, <https://www.georgeforeman.com/pages/biography> [https://perma.cc/VK2L-MPFX]. In 1996, basketball player Mahmoud Abdul-Rauf initially refused to stand for the National Anthem because of religious beliefs. He then “negotiated a fast truce with the league, acquiescing to its rule requiring players to stand for the anthem in an acceptable posture—while also cupping his hands and bowing his head in adherence to his Muslim faith.” See Harvey Araton, *From the N.B.A., a Cautionary Tale on National Anthem Protests*, N.Y. TIMES (Nov. 6, 2017), <https://www.nytimes.com/2017/11/06/sports/basketball/anthem-nba-abdul-rauf-kaepernick.html> [https://perma.cc/D2UA-8UGM]. During the 2004 season, Toronto Blue Jays first baseman Carlos Delgado protested the invasion of Iraq by remaining in the dugout rather than stand when “God Bless America” was played at major league games during the seventh inning stretch after the 9/11 attack. See William C. Rhoden, *Delgado Makes a Stand by Taking a Seat*, N.Y. TIMES (July 21, 2004), <https://www.nytimes.com/2004/07/21/sports/sports-of-the-times-delgado-makes-a-stand-by-taking-a-seat.html> [https://perma.cc/QXJ9-Z2CV]. Mr. Delgado was not, however, seeking publicity: “I’m not trying to get anyone mad, he said . . . This is my personal feeling. I don’t want to draw attention to myself or go out of my way to protest. If I make the last out of the seventh inning, I’ll stand there. But I’d rather be in the dugout.” *Id.* Even earlier, the singing group Dixie Chicks had used a performance to promote personal views. See David Segal, *Dixie Chicks Bare Their, Uh, Souls*, WASH. POST (Apr. 25, 2003), <https://www.washingtonpost.com/archive/lifestyle/2003/04/25/dixie-chicks-bare-their-uh-souls/d926396e-603d-4ae8-87a0-5bb041193b9b/> [https://perma.cc/L2EK-5MM9]. The Tampa Bay Buccaneers’ Mike Evans also took a knee during the national anthem. See Michal Addady, *Another NFL Player Takes a Knee to Protest Donald Trump’s Victory*, FORTUNE (Nov. 14, 2016), <http://fortune.com/2016/11/14/donald-trump-mike-evans-tampa-bay-buccaneers/> [https://perma.cc/ZG79-KNW6]. “He explained that he did so to express disappointment in the U.S. for electing a reality television star to lead the country, saying it’s ‘not a good look for America.’” *Id.*

² See *W.Va. Bd. of Educ. v. Barnette*, 319 U.S. 624, 642 (1943) (establishing a constitutional right not to salute the flag); see also *Tinker v. Des Moines Indep. Cmty. Sch.*

moment's thought reminds us that the First Amendment does not generally authorize all speech by all people in all contexts—it only constrains government interference with speech.³ More specifically, the First Amendment rarely authorizes using property that belongs to someone else.⁴ Imagine that one of the groundskeepers shares the same personal beliefs regarding the same cause. Realizing that there would be no media coverage of a groundskeeper kneeling during the National Anthem, he instead spray-paints “End Injustice” in ten-foot-tall letters on the stadium. Should our initial reaction be the same in that case? This Article explores that question by examining the concept of fame from a legal perspective.

Fame has always been valuable. However, fame as an asset has changed; not only has it increased in value,⁵ but it has changed in nature.⁶ Fame has become both more widely accessible and more

Dist., 393 U.S. 503, 514 (1969) (establishing a constitutional right to wear an armband showing support of a cause in violation of a school dress code); *Texas v. Johnson*, 491 U.S. 397, 419 (1989) (establishing a constitutional right to burn a flag as a protest).

³ “Congress shall make no law . . . abridging the freedom of speech . . . or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.” U.S. CONST. amend. I. The 14th Amendment extended the limitation to state action. *See generally* *Meyer v. Nebraska*, 262 U.S. 390 (1923).

⁴ *See Zacchini v. Scripps-Howard Broad.*, 433 U.S. 562, 564 (1977). Scripps-Howard had broadcast the entirety of Zacchini's “human cannonball” performance on local news. *Id.* at 563. The Supreme Court held that the broadcast violated Zacchini's right of publicity and was not protected by the First or Fourteenth Amendment. *Id.* at 578–79. The analysis that follows ignores contractual agreements; in most cases, famous performers and athletes will be subject to contract terms and league requirements that either authorize or constrain many of the activities considered below.

⁵ *See, e.g.*, Bill Shaikin, *A Look at How Major League Baseball Salaries Have Grown More Than 20,000% the Last 50 Years*, L.A. TIMES (Mar. 28, 2016, 6:23 PM), <https://www.latimes.com/sports/mlb/la-sp-mlb-salaries-chart-20160329-story.html> [<https://perma.cc/CVD5-G5T6>].

⁶ The phenomenon predates the internet. Writing in the television era, Malcolm Muggeridge observed, “[i]n the past if someone was famous or notorious, it was for something—as a writer or an actor or a criminal; for some talent or distinction or abomination. Today one is famous for being famous.” MALCOLM MUGGERIDGE, *MUGGERIDGE THROUGH THE MICROPHONE* 7 (1969). However, the internet has made it easier, cheaper and faster to become “famous for being famous” and that phrase has come to be “[s]aid of someone who is well-known only for being a fixture in the media, rather than having a particular talent or achievement.” *Famous*, FREE DICTIONARY, <https://idioms.thefreedictionary.com/famous+for+being+famous> [<https://perma.cc/98L3-HTS7>].

directly accessible.⁷ Historically, famous artists and performers clearly benefitted economically from fame; fame increased attention and, therefore, the value of the activity for which they were famous. Especially where fame was a function of skill, increased fame resulted in increased recognition of that skill and its value. Recently, however, fame has developed into an asset,⁸ independent of the underlying activity that created the fame, and transferable to other fields.⁹

This Article explores two related questions: “what is fame?” and “who owns it?”¹⁰ These questions have grown in importance in

⁷ For example, internet broadcasting has reduced the need for intermediaries and allowed direct access to followers and fans. As of September 2019 Barack Obama and Katy Perry each had about 108 million Twitter followers, and Justin Bieber had about 106 million. J. Clement, *Most Followed Accounts on Twitter 2019*, STATISTA (Sept. 2, 2019), <https://www.statista.com/statistics/273172/twitter-accounts-with-the-most-followers-worldwide/> [<https://perma.cc/ALY4-3SLF>]. As of November 2019, Cristiano Ronaldo had 188 million Instagram followers. *List of Most-Followed Instagram Accounts*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_most-followed_Instagram_accounts [<https://perma.cc/6FES-3EHU>]. By comparison, the top Nielsen-rated TV show for the week of October 21, 2019 had a “10.4 share,” equivalent to about 18 million viewers. *See generally Top 10*, NIELSEN, <https://www.nielsen.com/us/en/top-ten/> [<https://perma.cc/AXQ9-QXYA>]. And attendance for *Gone with the Wind*, among the highest all-time box office movies, was about 225 million. Patricia Bauer, *Gone with the Wind*, ENCYCLOPEDIA BRITANNICA, <https://www.britannica.com/topic/Gone-with-the-Wind-film-by-Fleming> [<https://perma.cc/ZG5H-YBEW>]; *see also* Robert Munafo, *All-Time Top 232 Movies by U.S. Theatre Attendance*, MROB, <https://www.mrob.com/pub/film-video/topadj.html> [<https://perma.cc/XE64-CB9L>].

⁸ In financial terminology, an “asset” is any resource that has economic value and that is owned or controlled. *See Asset*, INVESTOPEDIA (May 3, 2019), <https://www.investopedia.com/terms/a/asset.asp> [<https://perma.cc/8MRJ-QPTK>]. Note that the definition does not require that an asset be physical, as for example intellectual property rights. *See, e.g., Intellectual Property*, MICROSOFT, <https://www.microsoft.com/en-us/legal/intellectualproperty/default.aspx> [<https://perma.cc/GXK6-WRJ8>] (“Intellectual property (IP) is a strategic asset that provides significant value to Microsoft and its customer and partners.”).

⁹ *See, e.g.,* Alissa Schulman, *Studios Are Now Looking for Actors Who Are Insta-Famous*, N.Y. POST, (May 27, 2018, 9:31 AM), <https://nypost.com/2018/05/27/studios-are-now-looking-for-actors-who-are-insta-famous/> [<https://perma.cc/38WA-ZD7V>] (“Actresses are now saying, ‘I have 1 million followers. If you employ me in a film, I can guarantee 1 million people.’”)

¹⁰ In many cases, the issues posed in this Article are resolved by contract (for example, broadcast rights or the right to wear character costumes or team uniforms), but some rights cannot be completely resolved by contract, for example copyright reversionary rights. *See infra* note 88 and accompanying text.

recent years, as the economics of fame has shifted. Fame has increasingly come to be valued independently from underlying achievements—it is pursued, admired, coveted, and marketed as something highly desirable in itself.¹¹ Fame on its own is now a very valuable asset.

Section I of this Article surveys the available legal definitions of “fame” and, finding little available authority, expands the survey to include lay definitions. Section II then explores legal frameworks suitable for characterizing fame and the mechanisms for protecting it. This section concludes that fame is, in fact, a collection of intellectual property rights. Section III then analyzes each type of intellectual property making up that collection and explores how the characteristics of each component contribute to the definition and protection of fame. Section IV looks at the question of ownership and control of fame, both element by element and as a collection of elements. Of special note will be issues that arise when ownership claims to different elements of fame come into conflict. Section V then explores a complication that arises under agency law, primarily the duty of an agent to account to a principal for opportunities arising by virtue of the agency relationship. Finally, Section VI provides an analytical framework and applies it to examples of specific types of fame.

I. DEFINING FAME

In defining any legal concept, a logical first step is to identify statutes that provide an explicit definition. For a status that is so highly valued and sought after, the statutory treatment of “fame” is surprisingly sparse and ambiguous. No state statutes define the terms “fame” or “famous.”¹² Only one federal statute comes close: the Lanham Trademark Act.¹³ This federal statute defines “famous” but not “fame,” and only does so in the limited context of according

¹¹ See Schulman, *supra* note 9.

¹² There are state statutes defining the arguably allied concept of a right to publicity. See *infra* note 117 and accompanying text.

¹³ See generally Lanham Act (Trademark Act of 1946), Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified in scattered section of 15 U.S.C.).

special rights¹⁴ to owners of “famous” trademarks.¹⁵ Under the Lanham Act, an owner of a famous trademark, in addition to possessing the right of all trademark owners to prevent the use of confusingly similar trademarks, may obtain an injunction to prevent “tarnishment” of the famous mark “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”¹⁶

The statute establishes factors to be considered in determining whether a trademark is famous:

[T]he duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

The amount, volume, and geographic extent of sales of goods or services offered under the mark.

The extent of actual recognition of the mark.

Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.¹⁷

However, the statute also provides that “[i]n determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors”¹⁸ This vague and expansive provision ultimately results in the statute leaving the term “famous”—much less “fame”—largely undefined. Courts have tended to fill this gap by equating “famous” with sales volume or advertising expenditures.¹⁹ While this approach might have been

¹⁴ 15 U.S.C. § 1125(c)(1) (2018).

¹⁵ The statute defines famous trademarks as those which are “widely recognized by the general consuming public of the United States.” *Id.* § 1125(c)(2)(A).

¹⁶ *Id.* § 1125(c)(1).

¹⁷ *Id.* § 1125(c)(2)(A).

¹⁸ *Id.* See *infra* Section III for further discussion of trademark law and its application to fame.

¹⁹ See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012) (“The fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures, and by the length of time those indicia of commercial awareness have been evident.”); see also *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (“We have consistently accepted statistics of sales and advertising as indicia of fame: when the numbers are large, we have tended to accept them without any further supporting proof.”). For examples of the scale involved, see, e.g., *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1072 (Fed. Cir. 1989)

reasonable in the pre-internet economy, it ignores the substantial publicity that is now available at no cost through outlets such as Facebook, YouTube, Twitter, and Instagram. This approach also assumes that advertising expenditures are effective.²⁰

Despite these problems, the formulation “widely recognized” makes a certain amount of sense in a trademark context. Because trademarks are intended to prevent consumer confusion,²¹ consumer recognition is an appropriate basis on which to define fame in the trademark context. The issue in terms of agency duties is much broader, involving determinations of ownership and use of a variety of intellectual property rights. In other legal contexts that are not inherently consumer-focused, the formulation “widely recognized” would be even more problematic.

In the absence of a statutory definition, we might look to lay definitions and then attempt to fit them into appropriate legal pigeonholes. Unfortunately, dictionary definitions provide little help. Merriam-Webster’s online dictionary merely defines fame as “public estimation or popular acclaim,”²² and other dictionaries do not reveal much more.²³

(NINA RICCI deemed famous for perfume, clothing and accessories because of \$200 million in sales, over \$37 million in advertising over 27 years); *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146–47 (Fed. Cir. 1985) (HUGGIES famous for diapers because of over \$300 million in sales over 9 years, \$15 million in advertising in one year).

²⁰ George Bradt, *Wanamaker Was Wrong—The Vast Majority of Advertising Is Wasted*, FORBES (Sept. 14, 2016), forbes.com/sites/georgebradt/2016/09/14/wanamaker-was-wrong-the-vast-majority-of-advertising-is-wasted/#1fe98a2f483b [https://perma.cc/TWZ9-NA7V] (“Nineteenth-century Philadelphia retailer John Wanamaker supposedly said ‘Half the money I spend on advertising is wasted; the trouble is I don’t know which half.’”).

²¹ See generally 15 U.S.C. § 1125(a) (2018).

²² *Fame*, MERRIAM WEBSTER, <https://www.merriam-webster.com/dictionary/fame> [https://perma.cc/D4CY-73R6].

²³ See *Fame*, OXFORD ENG. DICTIONARY, <https://www.oed.com/view/Entry/67941?rskey=oH4fMQ&result=1#eid> [https://perma.cc/QJ3U-U9WA] (defining fame (in the sense used in this Article) as “2a. The character attributed to a person or thing by report or generally entertained; reputation. Usually in good sense,” or “3a. The condition of being much talked about. Chiefly in good sense: Reputation derived from great achievements; celebrity, honour, renown”); *Fame*, DICTIONARY.COM, <https://www.dictionary.com/browse/fame> [https://perma.cc/W6A3-RGKF] (defining fame as “widespread reputation, especially of a favorable character; renown; public eminence . . .” or “common estimation or opinion generally held of a person or thing; reputation”).

In sum, there is no widely applicable legal definition of “fame.” The Trademark Act’s definition provides only an indirect, *ex post* definition of fame once it has been achieved. Yet the Trademark Act’s definition does at least provide a framework in which to examine fame as a collection of legally cognizable components that go into achieving the status of being famous. For the purposes of the analysis here, the Trademark Act seems to represent an acceptable (and, in any event, the best available) framework in which to view fame. As a working definition, this Article will use a slight modification of the Trademark Act’s definition: this Article considers fame to be acquired when it is widely recognized by a relevant section of the consuming public. In other words, a person’s or entity’s fame need not be recognized by the general public in order for the fame to exist; all that is required is that some segment of the population—one that counts economically for the particular situation—recognizes their fame.²⁴

II. A PROPOSED LEGAL FRAMEWORK

In order to be “widely recognized,” and thus come within our working definition of fame, a person must be distinguishable in some respect to some relevant market.²⁵ If an individual cannot be distinguished from others, that individual cannot be famous. Although the statutes use different words, protecting “distinguishableness” is the core characteristic of the class of legal rights known as intellectual property: copyrights prevent copying of “original” works;²⁶ patents protect “new” inventions;²⁷ trademarks

²⁴ This is the approach taken in trademark cases. *See Palm Bay Imps. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1375 (Fed. Cir. 2005) (“Although this court has not directly addressed the question of what segment of the consuming public must be aware of a mark in order for it to be considered famous in a likelihood of confusion analysis, it has indirectly suggested that a mark’s renown within a specific product market is the proper standard.”).

²⁵ In the trademark context, this is a threshold requirement for protectability under the Lanham Act. 15 U.S.C. § 1125(c)(2)(A) (2018).

²⁶ 17 U.S.C. § 102(a) (2018).

²⁷ 35 U.S.C. § 101 (2017).

protect “distinctive” symbols of origin;²⁸ and trade secrets protect information that is “not generally known.”²⁹

It would seem reasonable, therefore, to place “fame” in the legal pigeonhole of intellectual property. Accordingly, this Article will examine the definition of fame as a bundle of rights selected from the collection of intellectual property rights. Precisely which rights comprise the bundle will vary depending on the particular circumstances of each example or set of examples. Although there is no single IP right that defines fame, fame fits comfortably in the general category of “intellectual property” because it is an intangible right and enjoys a zone of exclusivity if, only if, and only to the extent that, the law recognizes the right.³⁰

Within this broad legal framework, the principal elements are trademark rights, copyright rights, patent rights, and trade secret rights.³¹ Several components that make a famous person³² famous may be eligible for intellectual property protection. For example, a person’s name, image, or voice may in itself be a trademark,³³ and

²⁸ 15 U.S.C. § 1127 (2019); 8 TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01 (2018).

²⁹ Uniform Trade Secrets Act § 1(4) (amended 1985), 14 U.L.A. 529–659 (Supp. 2010).

³⁰ Tangible property inherently creates exclusivity by virtue of the laws of physics: possession of a tangible object inherently prevents others from taking possession. On the other hand, intangible property is susceptible to multiple simultaneous ownership unless constrained by law. For example, downloading a song does not take the song away from the original owner; what constrains downloading is not the limitation that only one person can have physical possession at any given time, but the constraint legally imposed by copyright law. *Metro-Goldwyn-Mayer Studios v. Grokster*, 545 U.S. 913 (2005). Absent that legal constraint, the act of downloading a digital copy is simple and the copy is indistinguishable from the original. *Id.*; *see also* 17 U.S.C. § 106 (2018);

³¹ There are other specialized intellectual property rights which may apply in unusual cases but do not seem relevant to the general discussion of fame. For example, there is federal statutory protection for the three-dimensional design of semiconductor mask works, Semiconductor Chip Protection Act of 1984, 17 U.S.C. §§ 901–14 (2018); and for plants, Plant Variety Protection Act of 1970, 7 U.S.C. §§ 2321–2582 (2018); 35 U.S.C. § 161 (2017).

³² Fame may be associated with an individual, a group of individuals or a legal entity. For convenience, the term “person” is used to include all of them.

³³ *See, e.g.*, Registration No. 916522 (a mark comprising the musical notes G, E, C played on chimes, owned by NBC Universal Media LLC); Registration No. 3411881 (a mark consisting of the spoken word “D’OH,” owned by Twentieth Century Fox Film Corporation).

registered with the U.S. Trademark Office³⁴ or protected at common law.³⁵ Those same images or sounds, or a combination of them, may also qualify for copyright protection³⁶ and may be registered with the Copyright Office.³⁷ Innovative aspects of a performance may be protected by patent, either by utility patent if the innovation is useful³⁸ or by design patent if the innovation is ornamental.³⁹ While there is a tension between concepts of fame and trade secrecy, fame may arise from use of a trade secret in certain situations. One example would be the “secret” recipe for Kentucky Fried Chicken: the product is sold and has become famous, but the process of making it is kept secret. Another example would be a magician’s fame, which arises from skill in performing a trick, while the method of performing the trick remains a trade secret. Finally, the combination of these factors may create uniqueness sufficient to qualify for protection of a right of publicity under some states’ laws.⁴⁰

III. THE INTELLECTUAL PROPERTY COMPONENTS OF FAME

A. Trademarks

Recognizability is the central aspect of fame. In intellectual property terms, this fits most directly within the scope of trademark rights.⁴¹ Under the federal trademark statute,⁴² a registrable

³⁴ 15 U.S.C. § 1051(a)(1) (2018).

³⁵ While trademark rights can also exist at common law, the underlying definitions and principles are the same as those set out in the federal statute and therefore state common law rights are not treated separately here.

³⁶ 17 U.S.C. § 102 (2018).

³⁷ *Id.* § 408.

³⁸ 35 U.S.C. § 101 (2017). *See, e.g.*, U.S. Patent No. 5,255,452 (filed Oct. 26, 1993) (example of a patent that protects an innovative aspect of a performance, issued to Michael Jackson and co-inventors for a shoe that enabled him to perform the seemingly gravity-defying move in Smooth Criminal).

³⁹ 35 U.S.C. § 171 (2017).

⁴⁰ *See* Section III(E), *infra*.

⁴¹ Some states also recognize a “right of publicity.” *See infra* notes 121–27 and accompanying text.

⁴² 15 U.S.C. § 1051 *et seq.* (2018). Trademark rights can also exist at common law. The underlying definitions and principles are the same as those set out in the federal statute and therefore state common law rights are not treated separately here.

trademark is a symbol⁴³ “by which the goods of the applicant may be distinguished from the goods of others.”⁴⁴ Thus, fame may be viewed as essentially a trademark, if the famous person is viewed as the “goods.”

1. The Rights of a Trademark Owner

Properly used, trademarks can be a long-term building block of fame. The owner of a trademark has the right to prevent use of a competing mark in connection with the sale of similar goods or services if the competing mark is likely to cause consumer confusion as to the source of the goods or services.⁴⁵ This can be used to protect—or enhance—fame by preventing others from using elements which make the owner famous. In its most basic operation, a trademark can be used to stop others from entering the same field using the same name.⁴⁶ More creative uses of trademark rights include protecting famous characteristics—for example, a sound associated with the product.⁴⁷

A trademark has no fixed term. Legal recognition of a trademark owner’s rights over a mark comes into effect as soon as the mark is capable of identifying the source of goods or services associated with the mark,⁴⁸ and continues to exist for as long as the mark is

⁴³ “The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” *Id.* at § 1127.

⁴⁴ *Id.* § 1052.

⁴⁵ 15 U.S.C. §§ 1114, 1125 (2018); *see, e.g.*, *Polaroid v. Polarad Elec. Corp.*, 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961).

⁴⁶ *See* 15 U.S.C. §§ 1114, 1125 (2018).

⁴⁷ *See, e.g.*, Registration No. 2821863 (a mark consisting of the spoken words YOU’VE GOT MAIL, initially registered by America Online). For more examples of sound marks, *see Trademark “Sound Mark” Examples*, USPTO, <https://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples> [<https://perma.cc/P3C8-WFE7>].

⁴⁸ *Protecting Your Trademark: Enhancing Your Rights Through Federal Registration*, USPTO, at 10 <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf> [<https://perma.cc/Q364-QCZ2>]. There is also a procedure for federally registering an “intent to use” a trademark before the mark is in actual use. *Id.* at 21. This procedure, however, confers no trademark rights—it is merely a tool for determining whether the U.S. Patent and Trademark Office will register the mark once it is in actual use in federally regulated commerce. *Id.* at 21, 26.

capable of doing so.⁴⁹ Trademark rights are lost if the mark is no longer used or otherwise no longer uniquely identifies the source.⁵⁰ This potential to lapse is particularly significant, in that it may compel owners of trademarks to take steps to assure that they maintain control over the use of the trademark.⁵¹

2. Ownership of Trademarks

There are two major theories of trademark law. One theory views trademarks as a property right designed to afford protection to its owner against unfair competition by others.⁵² The other theory views trademark as a consumer protection device, designed to assure consumers that when they choose a particular brand they can be assured that it comes from the source they expect.⁵³ Since, under either theory, a symbol must create a distinction between similar goods originating from different sources and must convey assurances of expected quality in order to become a trademark, the owner of the trademark must be the source of the trademarked product, in the sense of being the entity responsible for the product's

⁴⁹ Federal registration rights require periodic affidavits confirming continued use and renewing registration. 15 U.S.C. § 1058 (2010).

⁵⁰ A mark may be lost by becoming generic if the owner does not prevent others from using it. Examples of trademarks that lost protection include aspirin, originally—and in some foreign companies still—a trademark of Bayer. *See Bayer Co. v. United Drug Co.*, 272 F. 505, 512 (S.D.N.Y. 1921) (“[I]t was too late in the autumn of 1915 to reclaim the word which had already passed into the public domain.”). Thermos was originally a trademark of the King-Seeley Thermos Company. *See also King-Seeley Thermos v. Aladdin Indus.*, 321 F.2d 577, 581 (2d Cir. 1963) (“the primary significance to the public of the word “thermos” is its indication of the nature and class of an article rather than as an indication of its source . . .”).

⁵¹ Thus, for example, a team owner who would otherwise prefer not to create tension with a player may be compelled to do so if failure would lead to the loss of trademark rights.

⁵² *See generally, e.g.*, Adam Mossoff, *Trademark as a Property Right*, 107 KY. L.J. 1 (2018); William Landes & Richard Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

⁵³ “Trademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ for it quickly and easily assures a potential customer that . . . the item with this mark . . . is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.” *Qualitex Co. v. Jacobson Prod. Co. Inc.*, 514 U.S. 159, 163–64 (1995).

quality.⁵⁴ Indeed, an application for federal registration must include a verified statement to that effect⁵⁵: “The application must be filed in the name of the owner of the mark. The owner of the mark is the person or entity who controls the nature and quality of the goods or services identified by the mark.”⁵⁶

The choice of theory does, however, impact the analysis of whether trademark components of fame belong to the famous person or to someone else (e.g. an employer). If viewed as a consumer protection device, the mark should belong to the person with whom the public associates it—which is usually the performer.⁵⁷ However, if viewed as a property right, the analysis is more complicated and depends on several additional factors, including who conceived, financed, and publicized the mark so as to make it famous.⁵⁸

Regardless of who the owner of the mark is, it is easy to see how a trademark right is a component of fame. Examples of how trademarks can help to protect fame include protecting the famous

⁵⁴ 15 U.S.C. § 1051(a)(1) (2018).

⁵⁵ *Id.* § 1051(a)(3)(A).

⁵⁶ See *Protecting Your Trademark*, *supra* note 48.

⁵⁷ In some cases, the actor and role are so closely associated as to defy separation. Examples include Jerry Mathers (“The Beaver”), Linda Carter (TV’s “Wonder Woman”), and Clayton Moore (TV’s “Lone Ranger”). See *Jerry Mathers*, IMDB, https://www.imdb.com/name/nm0558487/?ref=mv_sr_1?ref=mv_sr_1 [<https://perma.cc/7EVT-NQZJ>]; *Lynda Carter*, IMDB, https://www.imdb.com/title/tt0074074/?ref=fn_al_tt_2 [<https://perma.cc/8LQQ-8LAR>]; *Clayton Moore*, IMDB, https://www.imdb.com/name/nm0138194/?ref=mv_sr_1?ref=mv_sr_1 [<https://perma.cc/9JWU-CAZD>]. Resolution of ownership, if not dictated by contract, is critical in the case of remakes and sequels. An example resolved by settlement is the dispute between Universal Studios and Crispin Glover over the right to the role of George McFly in the sequel to *Back to the Future*. See *Glover v. Universal City Studios, Inc.*, Docket No. BC012735 (Cal. Super. Ct. Oct. 15, 1990); see also Steve Palace, ‘*Back to the Future 2*’ Recreated the Face of Crispin Glover—So He Sued the Studio, VINTAGE NEWS (Aug. 30, 2019), <https://www.thevintagenews.com/2019/08/30/crispin-glover/> [<https://perma.cc/R737-VDEV>]; Eriq Gardner, ‘*Back to the Future II*’ From a Legal Perspective: Unintentionally Visionary, HOLLYWOOD REP. (Oct. 21, 2015), <https://www.hollywoodreporter.com/thr-esq/back-future-ii-a-legal-833705> [<https://perma.cc/J77F-FYBH>].

⁵⁸ See Section V.

person's name as it relates to their fame⁵⁹ or as it relates to "spin-off" products.⁶⁰

B. Copyright

Copyright is a powerful form of legal protection. Although federal copyright protection is only available if the work is fixed, the statutory definition of fixed is broad enough to cover most forms of communication.⁶¹ Moreover, while copyrights do not have the same potential as trademarks to endure indefinitely, they are an exceptionally long-lived intellectual property right. The term of any particular copyright depends on the identity of the author and whether or not the work has been published.⁶² In the case of identified individuals, the term is the life of the author plus seventy

⁵⁹ For example, Madonna Ciccone owns U.S. Registration No. 1473554 covering the use of "Madonna" relating to entertainment. See *Trademark Electronic Search System (TESS)*, U.S. PATENT & TRADEMARK OFFICE, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4809:v8ja52.2.1> [<https://perma.cc/N4GT-PC9C>] (follow the "Basic Word Mark Search (New User)" link; then type in "1473554" into the "Search Term" field, select "Serial or Registration Number" in the "Field" drop-down menu, and click on the "Submit Query" button).

⁶⁰ For example, Madonna Ciccone owns U.S. Registration No. 1463601 covering the use of "Madonna" on clothing. See *Trademark Electronic Search System (TESS)*, U.S. PATENT & TRADEMARK OFFICE, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4809:v8ja52.4.1> [<https://perma.cc/N4GT-PC9C>]. Another example is Electronic Arts' "Madden NFL Football" computer game, which generated considerable litigation by real football players depicted in the game, under various theories. In one of those cases, *Brown v. Elec. Arts, Inc.*, the court held that the use of Jim Brown's likeness did not violate his trademark or unfair competition rights, but noted that a different result might be warranted in a right of publicity case. 724 F.3d 1235, 1240 (9th Cir. 2013). Although it was a copyright case, and complicated by transformative-use and public figure issues, *Noriega v. Activision/Blizzard* is another interesting example: Manuel Noriega, former president of Panama and in federal custody at the time, objected to the use of his likeness in Activision's Call of Duty videogame. See *Noriega v. Activision/Blizzard Inc.*, No. BC551747 (Cal. Sup. Ct. Oct. 16, 2014).

⁶¹ See 17 U.S.C. § 102(a) (2018). "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission." See 17 U.S.C. § 101 (2018).

⁶² *How Long Does Copyright Protection Last?*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/help/faq/faq-duration.html> [<https://perma.cc/FW49-U9R3>].

years.⁶³ In the case of anonymous authors, the term is the earlier of 95 years from publication or 120 years from creation.⁶⁴

This potentially lengthy duration makes copyright a particularly useful component of fame.⁶⁵ The effective term of a copyright can be extended if derivative works are created, because derivative works receive their own copyright.⁶⁶ Even though the derivative work's independent copyright will only cover the new elements⁶⁷ and so will not directly enlarge or extend the parent work's copyright, the derivative work will nevertheless memorialize the parent, because in reality people do not stop recognizing the borrowed elements as originating from the parent work simply because the parent has fallen out of copyright protection.

Often the connection between the work and fame is direct, as, for example, when fame is the result of the production of a copyrightable work. Andy Warhol's personal fame is inextricably entwined with the notoriety of his paintings, which are copyrighted;⁶⁸ Andy Warhol is famous because works such as his "Marilyn Diptych" or "Campbell's Soup Cans" are famous, and vice versa—and copyright helps to prevent the tie between the artist and the artworks from being severed. Similarly, copyright may protect the connection between a famous sculptor and the works that made him famous.⁶⁹ Even some computer game designers have developed a sufficiently identifiable style to gain personal fame from their

⁶³ 17 U.S.C. § 304 (2018).

⁶⁴ *Id.* The term of copyright has been modified by Congress from time to time, in each case extending the term. The limits of Congress' ability to extend the term given the constitutional limitation of "limited terms" was questioned in *Eldred v. Ashcroft*, and the Court appeared to see no limit on the length of term, even permitting the extension of copyright to works that had already fallen into the public domain. *See Eldred v. Ashcroft*, 537 U.S. 186 (2003)

⁶⁵ 17 U.S.C. § 106 (2018).

⁶⁶ *See id.* § 101.

⁶⁷ U.S. COPYRIGHT OFFICE, Circular No. 14, Copyright in Derivative Works and Compilations, at 2 (2013), available at <https://www.copyright.gov/circs/circ14.pdf> [<https://perma.cc/43XP-3BAT>].

⁶⁸ *See, e.g., Licensing Images, Rights Clearance, and Merchandise*, ANDY WARHOL FOUND. FOR VISUAL ARTS, <https://warholfoundation.org/licensing/index.html> [<https://perma.cc/J5G9-72QA>].

⁶⁹ *See, e.g., Rogers v. Koons*, 960 F.2d 301, 312 (2d. Cir. 1992) (sculpture depicting puppies infringing copyright in photograph on which it was based).

copyrighted works.⁷⁰ Moreover, the dynamic of mutually reinforcing fame can operate indirectly and run between separate works, even if created by different authors. For example, a musical theme can be protected by copyright,⁷¹ yet at the same time might instantly evoke association with another work that includes a similar musical theme, such as a particular TV show, movie,⁷² or series, and related works (such as sequels, prequels, common works,⁷³ or spinoffs⁷⁴).

1. The Rights of a Copyright Owner

Although common law copyrights continue to exist, most commercially valuable copyrights are covered by federal statute.⁷⁵ The statute establishes protection for original works of authorship fixed in a tangible medium.⁷⁶ The statute also provides for the registration of copyrights.⁷⁷ Although registration is not a prerequisite to the existence of a copyright, it is essential to the enforcement of a copyright, because only a registered copyright can be the subject of

⁷⁰ For example, Sid Meiers of “Sid Meiers’ Civilization” fame. Benj Edwards, *Game Design Legends: The Golden Age of Sid Meier*, PC MAG. (Mar. 16, 2018, 2:30PM), <https://www.pcmag.com/feature/359828/game-design-legends-the-golden-age-of-sid-meier> [<https://perma.cc/F7QP-9WLB>]. For a list of Mr. Meiers’ awards, see Christopher McFadden, *Sid Meier: The Godfather of Computer Gaming*, INTERESTING ENGINEERING (Feb. 23, 2018), <https://interestingengineering.com/sid-meier-the-godfather-of-computer-gaming> [<https://perma.cc/K3C8-RUU8>].

⁷¹ For example, themes from James Bond movies are copyrighted. See, e.g., U.S. Registration No. PAu000132174 (filed Aug. 24, 1979), <https://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First> [<https://perma.cc/7NH8-93CM>] (in the “Search for” field, enter “PAu000132174,” and select “Registration Number” in the “Search by” drop-down menu) (The theme from “For Your Eyes Only.”).

⁷² An example would be the use of the same Henry Mancini theme in the original Peter Sellers Pink Panther movies and in the later Steve Martin Pink Panther movies. See *Henry Mancini*, IMDB, <https://www.imdb.com/name/nm0000049> [<https://perma.cc/K7HC-4Y25>].

⁷³ Compare, for example, the main themes from the DaVinci Code and Angels and Demons. See *Discography*, HANS ZIMMER, <http://www.hans-zimmer.com/index.php?rub=discography&bt=2&numid=1> [<https://perma.cc/PL2Y-5U7J>]. Both movies are based on books by Dan Brown. See *Novels*, DAN BROWN, <https://danbrown.com/#books-section> [<https://perma.cc/4TLX-L9X8>].

⁷⁴ For example, the Pink Panther and Friends TV show, which used the same Henry Mancini theme music as the Pink Panther movies. See *Henry Mancini*, *supra* note 72.

⁷⁵ 17 U.S.C. § 102 (2018).

⁷⁶ *Id.*

⁷⁷ *Id.* § 408.

a civil action for infringement in federal court, and statutory copyright cases can only be filed in federal courts.⁷⁸

The owner of a copyright has the right to prevent others from performing a list of activities,⁷⁹ foremost of which are copying the work or creating a derivative work based on the copyrighted work.⁸⁰ Note that the list of rights that belong to a copyright owner does not limit other people's use of the underlying concepts,⁸¹ nor does it preclude independent development of a similar work.⁸²

2. The Ownership of Copyrights

The federal statute provides that copyrights initially belong to the work's "author."⁸³ However, the term "author" has a meaning within the statutory scheme that in some circumstances diverges from the word's everyday meaning. If a work is a "work made for hire,"⁸⁴ the creator's employer rather than the creator of the work is

⁷⁸ *Id.* § 411(a). See also *Fourth Estate Public Benefit Corp. v. Wall-Street.com*, 139 S. Ct. 881 (2019) (holding that copyright owners must obtain a registration from the United States Copyright Office prior to filing an infringement action). Timely registration also gives the owner the right to seek attorney fees "statutory damages," which are fixed damages which do not require proof of actual damages. 17 U.S.C. § 412.

⁷⁹ The copyright owner's exclusive rights are set forth in title 17, section 106, as limited by exceptions set forth in sections 107 to 115. Principally, the owner has the exclusive right of reproduction, i.e., the right to stop others from making copies, derivative works, and public displays or performances.

⁸⁰ The concept of copying is relatively straightforward, although complicated by the introduction of digital copying. See, e.g., 17 U.S.C. § 107 (2018). Although defined by title 17, section 101, what constitutes a derivative work is a more subjective determination. Simple examples include a movie script as a derivative work of a book, a videogame based on a movie (or vice versa), or a resulting screen display as a derivative work of the underlying computer code. A more imaginative claim of derivation is Vladimir Putin's claim that a Harry Potter character is based on him. See *Russian Lawyers Say Harry Potter Character Dobby Is Based on Putin*, *GUARDIAN* (Jan. 30, 2003, 6:13AM), <https://www.theguardian.com/film/2003/jan/30/harrypotter.news> [<https://perma.cc/M3AP-W42Q>]. Derivative works can and often do include works in formats other than the original, subject only to the statutory constraint that to be considered a derivative work, the work must incorporate a portion of the copyrighted work "in some concrete or permanent form." *Lewis Galoob Toys, Inc. v. Nintendo of Am.*, 964 F.2d 965, 967 (9th Cir. 1992).

⁸¹ See U.S. COPYRIGHT OFFICE, Circular No. 31, Ideas, Methods, Systems (Jan. 2012), available at <https://www.copyright.gov/circs/circ31.pdf> [<https://perma.cc/6WYB-4US4>].

⁸² *Id.*

⁸³ 17 U.S.C. § 101 (2018).

⁸⁴ A work is "made for hire" if it is prepared by an employee within the scope of his or her employment. It may also be "made for hire" if it is "specially ordered or commissioned

considered the author.⁸⁵ If a work is jointly authored,⁸⁶ then any one of the authors may use the work but must account to the other authors for any revenues flowing from that use.⁸⁷

Copyrights are personal property, and as such can be assigned or licensed by contract.⁸⁸ There is great flexibility in assignment and licensing: the copyright owner can assign some or all of the categories of rights, can grant licenses that allocate geographic territories, time limits, or other conditions to the assignment, and can make the assignment or license exclusive, non-exclusive, or sole.⁸⁹

C. Patents

Two categories of patents are relevant to this Article's examination of fame: utility patents, which protect new and useful inventions,⁹⁰ and design patents, which protect new and ornamental

for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas" if the parties expressly agree in a writing that the work shall be considered a work made for hire. 17 U.S.C. § 101 (2018).

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.12(A) (Matthew Bender, Rev. Ed. 2019).

⁸⁸ Copyright assignments (unlike assignments of other intellectual property rights) are, by statute, terminable at the option of the author under certain circumstances, and this option to terminate cannot be varied by contract. 17 U.S.C. § 304 (2018). Because an employer is the initial owner in the case of a work made for hire, but a transferee if ownership is acquired by assignment, this is an important distinction.

⁸⁹ U.S. COPYRIGHT OFFICE, Circular No. 1, Copyright Basics, at 2 (Rev. 2019), <https://www.copyright.gov/circs/circ01.pdf> [<https://perma.cc/AH3T-SNGM>]. A non-exclusive license allows the copyright owner to grant other licenses; an exclusive license does not allow other licenses but allows the copyright owner to continue to use the copyright; a sole license grants the assignee the sole right to use the copyright (including the right to exclude even the copyright owner from using the copyright); an assignment transfers ownership of the copyright. See Christopher M. Newman, *An Exclusive License Is Not an Assignment: Disentangling Divisibility and Transferability of Ownership in Copyright*, 74 LA. L. REV. (2013); see also DRAFTING LICENSE AGREEMENTS § 1.02 (Michael A. Epstein & Frank L. Politano eds., 4th ed. 2012).

⁹⁰ To be more precise, utility patents may be issued upon review of an application filed under 35 U.S.C. § 111, showing that the claimed invention is new and useful as required by 35 U.S.C. § 101, that the claimed invention falls into one of four statutory categories (machine, manufacture, composition of matter or process) enumerated in 35 U.S.C. § 101, that the claimed invention is novel as defined by 35 U.S.C. § 102, that the claimed invention

designs for manufactured articles.⁹¹ Utility patents rarely play a significant role in establishing fame,⁹² but design patents can function much like trademarks in connecting public perceptions with a particular individual or company.⁹³

1. The Rights of a Patent Owner

Utility patents last for twenty years from the date an application is filed,⁹⁴ whereas design patents last for fifteen years.⁹⁵ Patent rights, in each case, begin when the patent application is approved and issued.⁹⁶ During its term, a patent prevents all others from making, using, selling, or importing items which are covered by the patent claims.⁹⁷

2. Ownership of Patents

The default rule for patent ownership is that it belongs to the inventor.⁹⁸ In the case of joint invention, each joint inventor has an undivided interest in the entire patent and, as such, can license its use and keep the proceeds without the permission of the other joint

is non-obvious as defined by 35 U.S.C. § 103 and that the claimed invention is enabled as required by 35 U.S.C. § 112.

⁹¹ Compare 35 U.S.C. § 101 (2017) (requiring that the claimed invention be useful), with 35 U.S.C. § 171 (2017) (requiring that the claimed invention be ornamental).

⁹² But see U.S. Patent No. 5,255,452, *supra* note 38. That patent discloses the “trick” behind the seemingly gravity-defying move in Michael Jackson’s Smooth Criminal video: it was done with “[a] system for allowing a shoe wearer to lean forwardly beyond his center of gravity by virtue of wearing a specially designed pair of shoes which will engage with a hitch member movably projectable through a stage surface. The shoes have a specially designed heel slot which can be detachably engaged with the hitch member by simply sliding the shoe wearer’s foot forward, thereby engaging with the hitch member.” *Id.*

⁹³ See generally, e.g., *Apple v. Samsung*, 727 F.3d 1373 (2013) (illustrating the use of design patents as part of a strategy to prevent competitors’ imitation of the appearance of the iPhone).

⁹⁴ 35 U.S.C. § 154(a)(2) (2017).

⁹⁵ *Id.* § 173.

⁹⁶ *Id.* § 154.

⁹⁷ *Id.* § 271.

⁹⁸ Patents are intangible personal property, so ownership may be assigned in whole or in part. *Id.* § 261. It is common for employers to require contractual assignment of any patentable inventions made by employees.

inventor.⁹⁹ This is so even if a co-inventor only contributed to the invention of some of the claims of the patent.¹⁰⁰

Patents are not commonly used to protect fame because their costs are high and their duration is brief compared with other types of IP protection. Nevertheless, patents can be a component of fame in certain circumstances. Design patents in particular may be an especially important element in a product's popular recognition. For example, Apple protected the design of its iPhone and successfully sued Samsung to prevent it from using Apple's patented design elements to build a competing phone.¹⁰¹ Design patents can also be used as part of a trademark development strategy, by securing patent protection during the period that it takes to develop the public recognition required for trademark protection to be available.¹⁰² Likewise, utility patents may be useful where fame is based on the exclusive possession of a machine, manufacture, composition of matter, or process.¹⁰³

D. Trade Secrets

Superficially, trade secret rights might seem inconsistent with the concept of fame. It is, however, quite possible that an individual might become famous by virtue of possession of a—or use of someone else's—trade secret. There are situations where it is possible to maintain in secrecy the “how” while capitalizing on the

⁹⁹ *Id.* §§ 116, 262(e)(4); *Ethicon v. U.S. Surgical Corp.*, 135 F.3d 1456, 1468 (Fed. Cir. 1998) (dismissing an infringement suit where one of two co-inventors had granted a license to the defendant).

¹⁰⁰ *See Ethicon*, 135 F.3d at 1460.

¹⁰¹ *Apple Inc. v. Samsung Elec. Co., Ltd.*, 727 F.3d 1352, 1373 (Fed. Cir. 2013).

¹⁰² A design patent can be prepared and obtained comparatively quickly. All that is required is a drawing of the design and a formulaic claim to “[T]he ornamental design . . . as shown.” 37 C.F.R. § 1.153 (2019). When issued, the design patent will, for a period of 15 years, prevent competitors from using the design on competing goods. 35 U.S.C. § 173 (2017). Since no competitor could make a competing use of the design, the patent owner's use will be “exclusive” for the 5 years ordinarily required to establish distinctiveness, and therefore the right to a federal trademark, under Section 2(f) of the Lanham Act. 15 U.S.C. § 1052(f) (2006) (“The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”).

¹⁰³ *See supra* note 90.

“what.” An obvious example would be that of a magician, whose fame might be based on the ability to perform tricks which the audience can observe but cannot figure out how to do. A less obvious example would be confidential information that allows an individual to achieve success, such as a sports team’s playbook, a talent agent’s contact list, or a law firm’s form file.

1. The Rights of a Trade Secret Owner

Trade secrets are largely common-law rights under state law.¹⁰⁴ While state laws differ in the details of the definition of trade secrecy, the general pattern is that information qualifies as a trade secret if it is not generally known and the owner takes reasonable steps to keep the information confidential.¹⁰⁵ The owner of a trade secret has the right to prevent misappropriation,¹⁰⁶ which includes improper acquisition, disclosure, or use of the trade secret.¹⁰⁷ Misappropriation does not include independent creation of the same information,¹⁰⁸ nor does it include acquisition of the information by “proper” means.¹⁰⁹ In most jurisdictions, reverse engineering of a publicly available embodiment of the trade secret is proper.¹¹⁰ Thus, unlike patent rights,¹¹¹ trade secret rights do not protect against independent development of the same technology.

A trade secret has no fixed term—it begins when information meets the definition, and continues to exist for as long as the information continues to do so.¹¹² In theory, a trade secret could be perpetual. However, the legally recognized secrecy is destroyed if the owner ceases to protect the confidentiality of the information¹¹³

¹⁰⁴ See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 493 (1974).

¹⁰⁵ Uniform Trade Secrets Act § 1(4) 14 U.L.A. 529–659 (Supp. 2010) (amended 1985).

¹⁰⁶ *Id.* § 2(a).

¹⁰⁷ *Id.* § 1(2).

¹⁰⁸ *Id.* § 2(a).

¹⁰⁹ *Id.*

¹¹⁰ *Id.* § 1(4) cmt.

¹¹¹ *Id.* § 2(a).

¹¹² *Id.* § 1(4).

¹¹³ *Id.*

or if, notwithstanding the owner's efforts, the information becomes generally known.¹¹⁴

2. Ownership of Trade Secrets

Information becomes a trade secret as soon as it meets the elements of the term's definition in the relevant state's law.¹¹⁵ There is no registration system for trade secrets, nor is there any examination to determine if the claimed secret meets the definition.¹¹⁶ There is therefore no system in place for establishing ownership or resolving competing claims, nor is there a need for one: multiple people can "own" the same trade secret because ownership only confers the right to prevent misappropriation.

E. State Rights: The Right of Privacy and the Right of Publicity

The right of publicity and right of privacy both stem from common law protections over the interests of the individual "self."¹¹⁷ Despite their similar foundation, however, privacy rights and publicity rights differ in their underlying public policy goals and scope of protection. The common-law right of privacy is said to protect against intrusion upon the plaintiff's private affairs, disclosure of embarrassing private facts, false light, and appropriation of the plaintiff's name or likeness at the defendant's advantage.¹¹⁸ To

¹¹⁴ For example, if a trade secret owner's competitor independently discovers the same information and chooses to disclose it, the trade secret owner loses protection because the information has become "generally known." *Id.* § 1(4).

¹¹⁵ *Id.* § 1(4).

¹¹⁶ "Contrary to patents, trade secrets are protected without registration, that is, trade secrets are protected without any procedural formalities." *How Are Trade Secrets Protected??*, WORLD INTELL. PROP. ORG., https://www.wipo.int/sme/en/ip_business/trade_secrets/protection.htm [<https://perma.cc/5PSJ-VKFG>].

¹¹⁷ As common law rights, specific definitions, interpretations, and rights vary from state to state. For a list of state right of publicity statutes, see *Statutes & Interactive Map*, RIGHT PUBLICITY, <http://www.rightofpublicity.com/statutes> [<https://perma.cc/BF6A-49BP>], which lists twenty-one states with such statutes. See WESTON ANSON, RIGHT OF PUBLICITY: ANALYSIS, VALUATION, AND THE LAW 66–78 (2015) (discussing states that recognize a common-law right of publicity).

¹¹⁸ See *Battaglieri v. Mackinac Ctr. For Pub. Policy*, 680 N.W.2d 915, 919 (Mich. Ct. App. 2004).

the extent this may be thought of as a property right,¹¹⁹ that right is secondary to protection of the owner's right to be left alone.¹²⁰

On the other hand, instead of protecting the individual's right to be left alone,¹²¹ the right of publicity "protects an individual's pecuniary interest in the commercial exploitation of his or her identity"¹²² and is therefore a more traditional property right.¹²³ The concept of a "right of publicity" was recognized as early as 1905,¹²⁴ in a case in which the use of plaintiff's image as the "before" picture in an advertisement was held to violate the plaintiff's right to her own image. That case extended the then-recently-developed theory of a right of privacy¹²⁵ to conclude, "I think that the plaintiff has the same property in the right to be protected against the use of her face for defendants' commercial purposes as she would have if they were publishing her literary compositions . . . if her face . . . has a value, the value is hers exclusively"¹²⁶

¹¹⁹ See *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 69 (Ga. 1905). The right of privacy cannot be transferred. However, it is possible to surrender the right in exchange for consideration, so it can be thought of as a property right.

¹²⁰ See *Herman Miller, Inc. v. Palazzetti Imps. and Exps.*, 270 F.3d 298 (6th Cir. 2001).

¹²¹ States that recognize the right of privacy generally extend to the owner protection against: (1) intrusion upon the plaintiff's seclusion or solitude, or into his 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; or (4) appropriation, for the defendant's advantage, of the plaintiff's name or likeness. See *Battaglieri*, 680 N.W.2d at 919.

¹²² *Ruffin-Steinback v. dePasse*, 82 F. Supp. 2d 723, 729 (E.D. Mich. 2000). States that recognize the right of publicity generally extend to the owner protection against those who "[appropriate] the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade" RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2006).

¹²³ The right of publicity is an intellectual property right that arises when "the reaction of the public to name and likeness, which may be fortuitous or which may be managed or planned, endows the name and likeness of the person involved with commercially exploitable opportunities." *Id.* at 541–42.

¹²⁴ See *Pavesich*, 50 S.E. at 68–69.

¹²⁵ Several Restatements recognize appropriation of name or likeness as a type of invasion of privacy. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2006); RESTATEMENT (SECOND) OF TORTS § 652C cmts. a & b, illus. 1 & 2 (AM. LAW INST. 1977).

¹²⁶ See *Pavesich*, 50 S.E. at 79 (quoting *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902) (Gray, J., dissenting)).

The right of publicity is now protected by statute in at least twenty-one states¹²⁷ and has been recognized by the Supreme Court¹²⁸ and the Restatement of Unfair Competition.¹²⁹ As with all intellectual property rights, there is a conflict between granting control through the right of publicity, and the right to free speech under the First Amendment.¹³⁰

The right of publicity may include features broader than mere appearance.¹³¹ The Indiana statute provides a good example of the multiplicity of components that make up the right: a personality's name, voice,¹³² signature, photograph, image,¹³³ likeness, distinctive appearance, gestures or mannerisms.¹³⁴ However, even that broad set of attributes is not exclusive. For instance, in the "human cannonball" case, the Supreme Court recognized entertainer Hugo Zacchini's right to control the "exploitation of his personality and the exercise of his talents," which in this case encompassed Zacchini shooting from a cannon into a net "some 200 feet away."¹³⁵ Additionally, courts have recognized the right in a catchphrase

¹²⁷ Those states are Alabama, California, Florida, Hawaii, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington, and Wisconsin. *See Statutes & Interactive Map, supra* note 117.

¹²⁸ *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 562, 564 (1977) (holding that the First Amendment did not allow broadcasters to show the plaintiff's entire "human cannonball" performance without permission, as televising the event diminished its value by reducing the number of people willing to pay to see it).

¹²⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2006).

¹³⁰ *See, e.g., Keller v. Elec. Arts, Inc.*, 724 F.3d 1268, 1271 (9th Cir. 2013) ("In this case, we must balance the right of publicity of a former college football player against the asserted First Amendment right of a video game developer to use his likeness in its expressive works.").

¹³¹ *See generally* *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786 (2011).

¹³² IND. CODE ANN. § 32-36-1-7 (2017). *See also* *Midler v. Ford*, 849 F.2d 460, 463 (9th Cir. 1989); *Waits v. Frito-Lay*, 978 F.2d 1093, 1100 (9th Cir. 1992).

¹³³ *See generally* *White v. Samsung Elec.*, 971 F.2d 1395 (9th Cir. 1992).

¹³⁴ IND. CODE ANN. § 32-36-1-7.

¹³⁵ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563 (1977). The Court held that, while the Ohio Supreme Court had a right to privilege the press in its broadcast of "matters of public interest," such as the footage of the "human cannonball," such right is not guaranteed by the First or Fourteenth Amendment. *Id.* at 578-79.

widely associated with an individual¹³⁶ and even in a car widely associated with its driver.¹³⁷

The right of privacy and the right of publicity confer different terms of protection. The right of publicity fundamentally consists of a person's legal right to exclude others from commercial exploitation of his or her identity,¹³⁸ and thus it preserves the fundamental role that the right to exclude plays in traditional property rights.¹³⁹ The right of publicity further reflects traditional property rights in that it is assignable and survives the individual who created it.¹⁴⁰ On the other hand, the right of privacy is typically limited to the lifespan of the individual because it is a "dignitary" right.¹⁴¹

IV. RECONCILING OWNERSHIP: THE BLOCKING NATURE OF INTELLECTUAL PROPERTY RIGHTS

It should be apparent that, because the definition of each type of intellectual property is different, they generally are not mutually exclusive rights. Nothing in the definitions of copyright, trademark, patent, trade secret, or the right of publicity precludes someone from simultaneously using a combination of these IP rights to protect components of the overall thing that is fame.¹⁴² For example, the manufacturer of a motorcycle can have a utility patent on components of the motorcycle, a design patent on the appearance of the motorcycle, copyrights on designs for the motorcycle, a trademark

¹³⁶ See, e.g., *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831, 836 (6th Cir. 1983) (recognizing a right in Johnny Carson's catchphrase "Here's Johnny").

¹³⁷ See, e.g., *Motschenbacher v. R.J. Reynolds Tobacco*, 498 F.2d 821, 827 (9th Cir. 1974) (professional race car driver Lothar Motschenbacher was known for individualizing his race cars).

¹³⁸ See *Herman Miller, Inc. v. Palazetti Imps. & Exps.*, 270 F.3d 298, 325 (2001).

¹³⁹ On the traditional right to exclude, see, e.g., Thomas W. Merrill, *Property and the Right to Exclude*, 77 NEB. L. REV. 730, 730 (1998).

¹⁴⁰ See *Palazetti* 270 F.3d at 325.

¹⁴¹ *Id.*; see also *Maritote v. Desilu Prod., Inc.*, 345 F.2d 418, 420 (1965) ("It is anomalous to speak of the privacy of a deceased person.").

¹⁴² There is one notable exception: because patents are published and must be enabling under 35 U.S.C. § 112, while trade secrets require that the information not be public, these rights impose inconsistent requirements and therefore cannot be maintained simultaneously.

on the sound of the motorcycle engine, and trade secrets covering its upcoming advertising campaign. Furthermore, because the definitions and default ownership rights differ, different people may own different components of the same collective fame. Ultimately, the central principle of intellectual property is that it consists in negative rights—IP rights exist to stop others from doing things; they do not confer any affirmative right on the owner.

Given the variety of rights potentially involved in fame and the negative nature of these rights, in many instances a group of people may need to act in concert in order to assemble all of the rights necessary to comprise fame. Therefore, before we can determine ownership of the overall thing that is fame, it is necessary to determine precisely which rights are involved, which aspects of fame they cover, and who possesses each of the rights.

V. THE AGENCY COMPLICATION

There is one additional legal concept beyond intellectual property itself that must be considered: agency. Any activity involving one person acting on behalf of others raises questions of agency law, and fame is often created in conjunction with, or on behalf of, another person or organization. Indeed, the law of agency bears on the interrelated questions of ownership of fame and the right to profit from that fame.

A. *The Nature of Agency*

Agency arises whenever two parties manifest their consent¹⁴³ that one party (the “agent”) will act on behalf of, and subject to the

¹⁴³ Section 1.01 of the Third Restatement of Agency formally defines agency as “the fiduciary relationship that arises when one person (a ‘principal’) manifests assent to another person (an ‘agent’) that the agent shall act on the principal’s behalf and subject to the principal’s control, and the agent manifests assent or otherwise consents so to act.” RESTATEMENT (THIRD) OF AGENCY § 1.01 (AM. LAW INST. 2006). Such an agreement is measured using standard contract rules. There is no requirement that the agreement be in writing (unless the acts to be carried out by the agent are within the Statute of Frauds and therefore are required to be in writing under that rule). There is no requirement that the parties use the words “agent,” “agency,” “principal,” or other “magic” words. The relationship is purely definitional, and if the definition is met an agency is created. *See, e.g., Jenson Farms v. Cargill*, 309 N.W.2d 285, 290 (Minn. 1981); *see also Gorton v. Doty*, 69 P.2d 136, 143 (Idaho 1937).

control of, the other party (the “principal”).¹⁴⁴ If those requirements are met, an agency is created. The relationship arises as a matter of common law, and an agency may even be created unintentionally.¹⁴⁵ Therefore, agency is not limited to situations in which the main reason for creating the relationship is to delegate authority from the principal to the agent. It can arise even in traditional employment relationships, where the employer remains in nominal control.¹⁴⁶

Agencies are ubiquitous, if often unrecognized or called by other names. For example, any business entity with more than one person inherently involves agency: in a general partnership, every partner is an agent of the partnership¹⁴⁷; a corporation must have a resident agent,¹⁴⁸ and it may also have many other agents whose titles do not indicate agency.¹⁴⁹ In the “fame” context, examples of agency relationships would include those between sports figures and the teams for which they play,¹⁵⁰ between media stars and media organizations,¹⁵¹ and even between political figures and party organizations or constituencies. Therefore, the question of the extent to which the famous agent may use that fame for purposes other than furthering the principal’s goals is one of broad concern and applicability. The answer to that question turns on the nature and definition of fame, the property elements that make up “fame” (however defined), and the ownership of those property elements.

Particularly relevant to the question of ownership are those rights and duties, both between the parties and with respect to third

¹⁴⁴ RESTATEMENT (THIRD) OF AGENCY § 1.01 (AM. LAW INST. 2010).

¹⁴⁵ There must be an intent that one party will act on behalf of and subject to the control of the other party, but the parties need not intend to—or even realize—that by doing so they are creating an agency relationship. *See, e.g., Cargill*, 309 N.W.2d at 290; *Doty*, 69 P.2d at 143.

¹⁴⁶ RESTATEMENT (THIRD) OF AGENCY § 1.01 (AM. LAW INST. 2010).

¹⁴⁷ *See, e.g., MD. CODE ANN., CORPS. & ASS’NS (“MCAA”) § 9A-301 (1998); Summers v. Dooley*, 481 P.2d 318, 320 (Idaho 1971).

¹⁴⁸ *See, e.g., MCAA § 2-108.*

¹⁴⁹ For example, a corporation’s board of directors are agents under MCAA section 2-401, as are its officers under MCAA section 2-414.

¹⁵⁰ While playing, even a famous ballplayer acts on behalf of and subject to the direction of (and is funded and supported by) a team. The ballplayer is thus an agent.

¹⁵¹ While arguably of less importance than before the Internet allowed cheap, easy self-promotion, publishers and recording and movie studios provide support for authors, musicians, and actors that make significant contributions to establishing their fame.

parties, that arise by operation of law upon the creation of an agency relationship. Most of the elements of fame are transferrable intangible property rights¹⁵² and therefore can be controlled by contract. However, contracts do not always address all ownership issues, particularly in fields where the scope of what may be owned is evolving. In situations that are not governed by contract, each of the intellectual property rights has its own set of rules for the creation of the right, the ownership of the right, the duration of the right, and the power which ownership confers on the owner, as well as the degree to which contracts can overrule the defaults. Some of the statutes make explicit provision for determining ownership when one party creates the right but another party pays for it or otherwise controls its creation.¹⁵³ Moreover, the principles of common law agency may impact ownership of those rights that are not controlled by statute.¹⁵⁴

B. The Power of the Agent

Merely by virtue of the creation of the agency relationship, the agent is given authority to bind the principal in contract within the scope of the agency, and to impose tort liability on the principal for acts done by the agent within the scope of the agency.¹⁵⁵ The authority may be “actual authority,” which consists in the power that

¹⁵² One exception arises under U.S. copyright law. *See supra* Section III(B)(2).

¹⁵³ Compare the ownership rights conferred by the copyright statute’s work-made-for-hire-provisions of 17 U.S.C. § 101 (employer is the “author” and therefore owns the copyright, *see, e.g.*, *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) (noting the employer is the “author” and therefore owns the copyright), with the ownership rights conferred by the patent statute. *See, e.g.*, *Hapgood v. Hewitt*, 119 U.S. 226, 233 (1886) (noting the employee owns the patent, subject at most to an implied license to the employer).

¹⁵⁴ *See, e.g.*, *supra* note 145 and accompanying text.

¹⁵⁵ Many cases turn on determination of the “scope of the agency.” *See, e.g.*, *Birkner v. Salt Lake*, 771 P.2d 1053, 1057 (Utah 1989). Factors normally considered include the objective of the agency, whether the agent’s actions were motivated by the interests of the principal or personal interests, and whether the agent’s actions were within the control of the principal. RESTATEMENT (THIRD) OF AGENCY § 8.01 (AM. LAW. INST. 2006). The cases are not reliably consistent. *Compare, e.g.*, *Robarge v. Bechtel*, 640 P.2d 211, 213 (Ariz. Ct. App. 1982) (holding that traveling to and from a job was not within the scope), with *Luth v. Rogers*, 507 P.2d 761, 764–66 (Alaska 1973) (holding that a jury determination that such travel was within the scope would not be disturbed).

the principal intended to confer on the agent.¹⁵⁶ Alternatively, the agent may have “apparent authority,” which encompasses power that the principal may not have intended to confer on the agent, but which nevertheless is traceable to manifestations made by the principal to a third party and arises if that third party reasonably believes the agent to have been given that power. As long as the third party’s perception of authority is reasonable and traceable back to the principal’s manifestations, apparent authority may even arise in situations where the principal has explicitly forbidden what the agent did.¹⁵⁷

C. Fiduciary Duties of the Agent

Agents with actual or apparent authority have the power to do extreme damage to principals, because they have the power to bind the principals to legal obligations to third parties.¹⁵⁸ Accordingly, a set of rules govern the behavior of agents—namely, fiduciary duties.¹⁵⁹ Because agents have broad and only partially limited

¹⁵⁶ Actual authority is sometimes broken down into “explicit” authority, that authority which the principal and agent explicitly agreed to, and “implied” or “inherent” authority, authority which, while not explicitly discussed, was necessary in order to exercise the explicit authority. RESTATEMENT (THIRD) OF AGENCY §§ 2.01–03 (AM. LAW. INST. 2006). An example of explicit authority would be “here are my car keys and credit card. You are authorized to drive my car to the gas station, fill the tank with gas, and charge it to my credit card.” If, instead, the instructions had been “here is my credit card—fill my car with gas,” it would be implicit that the agent could use the keys and drive the car to the gas station.

¹⁵⁷ *Jenson Farms v. Cargill*, 309 N.W.2d 285, 290 (Minn. 1981); *Gorton v. Doty*, 69 P.2d 136, 143 (Idaho 1937). For example, if the principal gave the agent a credit card and said “you may use it to buy pencils but not pens” and the agent bought pens, the principal would be obligated to pay the credit card bill because the merchant would have no reason to know of (or suspect) the limitation on the use of the credit card. Note that actual authority is determined from the viewpoint of the principal and the agent, while apparent authority is measured from the viewpoint (and knowledge) of an outsider. The outsider’s belief that agency exists must be reasonable and must be based on actions of the principal. *See* RESTATEMENT (THIRD) OF AGENCY §§ 2.01–03. This second requirement should be obvious—otherwise a principal could be liable merely if a completely unrelated third party falsely claimed to be an agent.

¹⁵⁸ *See supra* text accompanying note 148. A separate issue is the liability of the agent to the principal for violation of instructions. If the agent has the resources to compensate the principal, the problem is minimized. However, since the principal is directly liable to the third party, any loss would be borne by the principal.

¹⁵⁹ *See* RESTATEMENT (THIRD) OF AGENCY § 8.01; *see also supra* text accompanying note 143.

power to deal with their principals' resources, they are required to act in their principals' best interests.¹⁶⁰ This requirement is expressed in two basic rules of agency: agents owe their principals duties of loyalty and care.¹⁶¹

The duty of loyalty requires that the agent's primary concern be the best interests of the principal, not those of the agent.¹⁶² It is easy to see how an agent, having the power to exercise control over assets belonging to the principal by virtue of the agency relationship, might be tempted to use those assets in a way that benefits the agent.¹⁶³ Conceptually, an agent might be presented with a profitable opportunity and need to decide whether to take the opportunity on the principal's behalf or take it personally; an agent might be presented with a choice between options, one of which benefits the principal but harms the agent and one of which does not benefit the principal as much but does less harm to the agent; or an agent might be presented with an opportunity which costs the principal nothing but requires the agent to use the principal's resources in order to benefit personally.¹⁶⁴ Each of these poses a conflict of interest.

It is a fundamental rule of agency law that an agent must avoid conflicts of interest, or must disclose them to the principal and act

¹⁶⁰ See RESTATEMENT (THIRD) OF AGENCY § 8.01.

¹⁶¹ For example, a Maryland corporate director (an agent of the corporation) is by statute required to act "(1) In good faith; (2) In a manner he reasonably believes to be in the best interests of the corporation; and (3) With the care that an ordinarily prudent person in a like position would use under similar circumstances." MCAA § 2-405(1) I (2016). The requirement to act in good faith is not the result of agency law, but is a general requirement applicable to all contractual relationships. Partnership law makes this distinction clear: MCAA section 9A-404(a) states that "[t]he only fiduciary duties a partner owes to the partnership and the other partners are the duty of loyalty and the duty of care," but section 9A-404(d) states "[a] partner shall discharge the duties to the partnership and the other partners . . . and exercise any rights consistently with the obligation of good faith and fair dealing," making clear that although there are only two fiduciary duties, there is a third (non-fiduciary) duty as well. MCAA § 9A-404(a), (d).

¹⁶² See MCAA § 9A-404(b).

¹⁶³ See, e.g., *Reading v. Regem* [1948], 2 KB 268, 268 (Eng.); *Meinhard v. Salmon*, 164 N.E. 545, 547 (N.Y. 1928).

¹⁶⁴ For example, the agent may learn of an opportunity—or be offered an opportunity—because of the agent's association with the principal or because of access to the principal's assets. See, e.g., *In re eBay, Inc. Shareholders Litig.*, No. C.A. 19988-NC, 2004 WL 253521, at *5 (Del. Ch. 2004) (unpublished opinion); see also *Meinhard*, 164 N.E. at 547; RESTATEMENT (THIRD) OF AGENCY §§ 8.03, 8.04 (AM. LAW INST. 2006).

only after gaining the principal's approval to do so.¹⁶⁵ This is so even if the agent's gain does not correspond to a loss by the principal,¹⁶⁶ and even if the agent's actions result in a profit for the principal.¹⁶⁷ Moreover, the duty of loyalty can be violated even if the agent did not receive a monetary benefit—even, for example, using an intangible asset, such as access to the principal's facilities in order to promote a cause the agent believes worthy, but is not in the best interests of the principal, would suffice to breach this fiduciary duty.¹⁶⁸

The duty of care generally¹⁶⁹ requires that, in dealing on behalf of a principal, an agent must exercise the skill and judgment that a reasonable person would exercise if dealing with his own assets in

¹⁶⁵ See, e.g., MCAA § 2-419(b) (2016) (corporate directors); MCAA § 9A-103(b)(3) (partnerships).

¹⁶⁶ See *Reading v. Regem* [1948], 2 KB 268, 268 (Eng.); *County of Essex v. First Union Nat'l Bank*, 891 A.2d 600, 607 (N.J. 2006) (upholding disgorgement of fees earned under a contract secured by bribery regardless of lack of actual damages, because “[i]t is the evil of the wrongdoer retaining any of the fruits of its wrongful conduct that grounds the claim”).

¹⁶⁷ See *Smith v. Van Gorkom*, 488 A2d 858, 864 (Del. 1985) (noting that the principal might have profited even more).

¹⁶⁸ See, e.g., *Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 516 (4th Cir. 1999) (describing undercover reporters who obtained employment at Food Lion in order to videotape food handling practices for a story violated their duty of loyalty to their employer). “Because Dale and Barnett did not compete with Food Lion, misappropriate any of its profits or opportunities, or breach its confidences, ABC argues that the reporters did not engage in any disloyal conduct that is tortious under existing law. Indeed, the district court acknowledged that it was the first court to hold that the conduct in question ‘would be recognized by the Supreme Courts of North Carolina and South Carolina’ as tortiously violating the duty of loyalty . . . ABC’s interest was to expose Food Lion to the public as a food chain that engaged in unsanitary and deceptive practices. Dale and Barnett served ABC’s interest, at the expense of Food Lion, by engaging in the taping for ABC while they were on Food Lion’s payroll. In doing this, Dale and Barnett did not serve Food Lion faithfully, and their interest (which was the same as ABC’s) was diametrically opposed to Food Lion’s. In these circumstances, we believe that the highest courts of North and South Carolina would hold that the reporters—in promoting the interests of one master, ABC, to the detriment of a second, Food Lion—committed the tort of disloyalty against Food Lion.” *Id.*

¹⁶⁹ Learned Hand noted this limitation in *The T.J. Hooper*, observing “in most cases reasonable prudence is common prudence; but strictly it is never its measure: a whole calling may have been laggard in the adoption of new and available devices.” 60 F.2d 727, 740 (2d Cir. 1932).

like circumstances.¹⁷⁰ In some contexts, this standard has been augmented by statute, the most pervasive being the federal Sarbanes-Oxley Act relating to disclosures by publicly held corporations, and the so-called “Caremark duties” also relating to corporate directors,¹⁷¹ but none of these contexts apply to the analysis that follows.

D. The Principal’s Rights

The principal/agent relationship is a contractual relationship. Therefore, if an agent violates (or threatens to violate) any of the above duties, the principal has standard contract remedies: damages and, if appropriate, injunctive relief. Because the relationship is a fiduciary relationship with significant potential for abuse, principals have the additional remedy of disgorgement.¹⁷² This remedy is intended to remove temptation by eliminating the potential for benefitting from disloyalty.¹⁷³

One of the best examples of the application of the absolute rule of disgorgement is an English case holding that the use of a uniform by an employee (in this case, a soldier) indicating affiliation with a principal (in this case, the British government) required the employee to turn over to the principal the profits earned using the uniform.¹⁷⁴ What is notable about the case is that Reading, as agent,

¹⁷⁰ RESTATEMENT (THIRD) OF AGENCY § 8.08 (providing that an agent must act with the care, competence and diligence normally exercised by agents in similar circumstances); *Hun v. Carey*, 82 N.Y. 65, 73 (1880); *Brane v. Roth*, 590 N.E.2d 587, 592 (Ind. 1993) (describing duty of corporate directors).

¹⁷¹ See *In re Caremark*, 698 A.2d 959, 967–68 (Del. 1996).

¹⁷² See *Mosser v. Darrow*, 341 U.S. 267, 271–73 (1951); see also *Graham Douthwaite, Profits and Their Recovery*, 15 VILL. L. REV. 346, 370 (1970); *Gelfand v. Horizon*, 675 F.2d 1108, 1111–12 (10th Cir. 1982) (recognizing the availability of the remedy, but holding that it is within the trial court’s equitable discretion whether or not to impose it).

¹⁷³ Disgorgement is appropriate when “any lesser liability would provide an inadequate incentive to [engage in] lawful behavior.” RESTATEMENT (THIRD) OF RESTITUTION AND UNJUST ENRICHMENT § 3 cmt. c (AM. LAW INST. 2010); see also *Tarnowski v. Resop*, 51 N.W.2d 801, 803 (Minn. 1952) (allowing recovery of agent’s secret profits even though the offending contract had been rescinded).

¹⁷⁴ During World War II, Sergeant Reading was serving in the Royal Army Medical Corps, stationed in Cairo. *Reading v. Regem* [1948] 2 KB 268 (Eng.). He was approached by a stranger who asked if he would help transport liquor from Alexandria to Cairo, for which he would be paid “a few” Egyptian pounds. *Id.* He agreed and was instructed to board a lorry, wearing his uniform, at an appointed time and take it to the delivery point.

had not taken advantage of an opportunity that was available to his principal—had Reading offered the opportunity to the government, the government would not have gone into the smuggling business. Therefore, the principal did not lose profits. This is not, therefore, a typical case of contract damages. Rather, it establishes the rule that, in order to discourage disloyalty by eliminating the incentive for an agent to take advantage of the position of trust, *any* use of a principal’s resources requires the agent to disgorge any resulting profits.

The rule is generally applicable in the United States as well,¹⁷⁵ as exemplified by *General Auto v. Singer*.¹⁷⁶ Singer was general manager of General Auto, responsible for obtaining machine-shop work for the company.¹⁷⁷ Singer apparently had an excellent personal reputation, which attracted so much business that at some point Singer began turning business away. Rather than consult with the owner, Singer brokered the business to other companies, charging the customer and having the work done by other machine shops for a lower price and keeping the difference. The Supreme Court of Wisconsin held this was “inconsistent with the obligations of a faithful agent or employee” and that Singer owed an accounting for his “secret profit.”¹⁷⁸

Id. Upon completing the first delivery he received 2,000 pounds. *Id.* He then carried out several similar deliveries, earning roughly 20,000 Egyptian pounds. *Id.* The relationship eventually came to the attention of British authorities. *Id.* It is easy to conclude that Sgt. Reading was in trouble. *Id.* The specific type of trouble is interesting: the Crown seized the proceeds and claimed that the government was entitled to the money because the funds were “received and held . . . in trust for His Majesty.” *Id.* The theory appeared to be that Reading was an agent for the government and used his principal’s resources (the uniform) in order to profit. *Id.* Not explicit in the case, but obvious, is that Reading had no special skill that justified the payments he received—it was his presence, in uniform, that helped move contraband liquor through wartime checkpoints. *Id.* Notwithstanding his argument that he was required by army regulations to wear his uniform even when off-duty, the court held the government entitled to the proceeds. *Id.*

¹⁷⁵ 3 AM. JUR. 2d Agency § 268.

¹⁷⁶ See generally *General Auto. Mfg. v. Singer*, 120 N.W.2d 659 (Wis. 1963).

¹⁷⁷ *Id.* at 660.

¹⁷⁸ As is typical in this type of case, the agent argued that no harm was done: Singer argued that when the company had the shop capacity to fill an order he would award them the job, but it was his duty as general manager to refuse orders which in his opinion the company could not or should not fill and in that case he was free to treat the order as his own property. *Id.* at 662. The court rejected this theory, holding that “Singer had the duty to exercise good faith by disclosing to Automotive all the facts regarding this matter,” leaving to the company the choice to accept, refuse or to sub-contract them. *Id.* at 663. As

Gelfand v. Horizon Corp. represents a further extension of an agent's duty to act solely for the benefit of the principal and to disgorge any profits made in violation of that duty, even when the principal could not establish any loss as a result of the agent's violation of the duty of loyalty.¹⁷⁹ In that case, Mr. Gelfand was a real estate salesman for Horizon. In one of the transactions at issue in the case, Horizon owned a piece of property known as Barranca Estates. Horizon had been trying to sell it for one or two years before Gelfand arrived and had set a sales price of \$165,000. Gelfand's wife and son were owners of one-third of a company formed solely for the purpose of obtaining an option on the property—a fact not disclosed to Horizon. Their company paid \$2,500 for the option, then sold the option to a third party for \$60,000—the Gelfands received \$20,000 as their share of the profits. The third party then exercised the option, paying Horizon the full \$165,000 asking price. The court noted the general rule:

The law regarding fiduciary relationships in New Mexico is generally similar to the laws throughout the United States. An agent occupies a relationship in which trust and confidence is the standard. When the agent places his own interests above those of the principal there is a breach of fiduciary duty to the principal.¹⁸⁰

The trial court had, unsurprisingly, denied Gelfand a commission on the transaction. The Tenth Circuit Court of Appeals affirmed that ruling, but also went further and held that Horizon was also entitled to recover the \$20,000 profit made by Gelfand's family. The Tenth Circuit further noted that the trial court had the discretion to award the entire \$60,000 profit even though the Gelfand family only received \$20,000.¹⁸¹ As to this point, the court explained:

the court noted, Singer's actions deprived the company of the right to decide whether to expand, buy more equipment, or make its own arrangements to subcontract the work. *Id.*

¹⁷⁹ See *Gelfand v. Horizon Corp.*, 675 F.2d 1108, 1111–12 (10th Cir. 1982).

¹⁸⁰ *Id.* at 1110.

¹⁸¹ The court held that this award was discretionary and that the trial court's decision as to whether or not to award the additional \$40,000 earned by others as a result of the violation of fiduciary duty was within its general power to do equity. *Id.* at 1114.

It would appear from the cases that a fiduciary who has, by violating his obligation of loyalty, made it possible for others to make profits, can himself be held accountable for that profit regardless of whether he has realized it The theory is that the trustee is not to be free to authorize others to do what he is forbidden The cases hold that the purpose for restoring profits is to discourage potential conflicts of interest and duty; the complaining principal or employer need not prove that any loss was caused by fiduciary's misconduct The restitution of profits remedy serves primarily as a deterrent To require him to account for the gains of others still more plainly operates to deter him and other fiduciaries from disloyalty.¹⁸²

While it is an interesting—and apparently unresolved—question at what point (if ever) the agent's profits might be so far removed from the misappropriation of the principal's resources, the underlying principle of law is clear: to remove the temptation for an agent to misappropriate a principal's resources, the principal is allowed to recover not only the value of the misappropriated resources but also any profit made by the use of those resources.

E. The Agency Issue in Fame

When considering an agent who is famous, interesting questions regarding the agent's right to exploit that fame in an unrelated field arise from agency law's central principle that an agent owes a duty of loyalty to a principal, and its two corollaries that (i) the agent must prefer the principal's interests to the agent's own, and (ii) the agent must refrain from using the principal's resources for the agent's benefit even if such use does no harm to the principal.

Under general agency principles, agents may use their own resources for their own purposes as long as they do not violate the duty of loyalty, but agents may not use their principals' resources for their own purposes. However, it is unclear whether "fame" is a resource belonging to the principal or the agent. Even if it is a

¹⁸² *Id.* at 1111–12 (citations omitted).

resource belonging to the agent, to what extent can the principal control use of that resource? While it is important to remember the duty to act in the principal's best interest, the more important duty for purposes of analyzing fame is the duty to use the principal's assets solely on the principal's behalf. Understanding how a famous agent would exercise this duty requires determining precisely which assets belong to the agent and which belong to the principal. Agents are allowed to use their own assets, as long as they do not act adversely to their principals;¹⁸³ agents may not use their principals' assets for the agents' purposes, even if those purposes are not adverse to the principals' interests. The assets of interest for this Article are primarily the intellectual property rights discussed above.

Accepting the proposition that fame is a bundle of intellectual property rights, the combined effect of which is to create wide—and distinctive—recognition, the next step in the analysis is to examine each of the components of that bundle, in order to identify which are assets of the famous person and which are the assets of that person's principal.¹⁸⁴ Since the constraints on agents' activities fundamentally relate to use of the *principal's* resources, only those components of fame (developed above in Section I) that belong to the principal are of concern from an agency perspective. Determining whether there are constraints on a famous person's use of their fame, or whether control of such fame belongs to the famous person's principal requires returning to the analysis of ownership of the components of fame and noting that there are broad categories of situations in which this question arises.

Given that agency law primarily constrains use of the principal's assets for the benefit of the agent, it is important to distinguish those cases in which the agent properly advances the principal's interests from those in which the agent uses the principal's assets for self-

¹⁸³ RESTATEMENT (THIRD) OF AGENCY § 8.01 cmt. b (AM. LAW INST. 2006) (“Although an agent’s interests are often concurrent with those of the principal, the general fiduciary principle requires that the agent subordinate the agent’s interests to those of the principal and place the principal’s interests first as to matters connected with the agency relationship.”).

¹⁸⁴ Recall that the ultimate question is whether there are constraints on whether a famous person may make use of that fame, or whether control belongs to the famous person's principal.

benefit. For example, the analysis would differ for a famous ballplayer who poses for selfies at the ballpark owned by the team, i.e., the principal; a famous person who opens a restaurant using his own name in order to capitalize on the fame he has accrued through an activity unrelated to the restaurant; and someone who makes a political statement that attracts attention not due to the reasoning it articulates but rather due to the fame that the speaker already has.¹⁸⁵ In each case, the question would be twofold: (1) whether the famous person was using an asset that belonged to his principal, which would require analyzing the nature of the asset being used and its ownership in the IP context; and (2) whether the activity benefitted the famous person, that person's principal, or both—which is purely a question of agency law.

VI. A FRAMEWORK FOR ANALYSIS AND SAMPLE APPLICATIONS

As demonstrated above, fame is not a single right. Rather, it is a bundle of rights potentially owned by different people. Analyzing fame, therefore, requires identifying the component rights, who owns them, and how they interact in a particular situation. Certain situations may involve the question of which party is entitled to money, but also may involve the question of availability of injunctions to compel or prohibit actions. Intellectual property rights are “exclusive” rights, meaning that they give the owner the right to exclude others from using the protected rights.¹⁸⁶ Therefore, there will be situations where cooperation¹⁸⁷ among multiple owners is required or else the status quo (no action) will prevail.

¹⁸⁵ See *supra* text accompanying note 1.

¹⁸⁶ See *supra* Part IV.

¹⁸⁷ See, e.g., *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390 (2006) (holding that all intellectual property rights are intangible personal property and therefore can be assigned or licensed. An alternative to cooperation is, of course, judicial compulsion through injunctive relief). The traditional “four-factor” test for an injunction requires that the plaintiff establish: (1) that it has suffered an irreparable injury; (2) that remedies available at law are inadequate to compensate for that injury; (3) that considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction. *Id.* at 391.

A. *Inherent Fame*

Some people are famous *ab initio*. Examples would include heirs to the throne of the United Kingdom, children of American political dynasties, and children of famous performers. They are widely recognized by virtue of who they are, even before they have done anything noteworthy. In these cases, there are no agency relationships or copyright or patent issues to consider. Indeed, the only intellectual property right that need even be considered is trademark. These people possess an inherent fame that derives in part from a famous last name, which became famous through the work of others.

B. *Self-Developed Fame*

In today's world, where the Internet provides direct access to wide audiences, individuals can develop fame without any institutional apparatus or industry professionals to support them. Examples would include bloggers who develop an audience by creating their own content and posting it directly, self-published authors, and self-published musicians.¹⁸⁸ This category is arguably even simpler than the inherent fame category, because there is no issue over the ownership of any trademarks: there is only one potential claimant. Therefore, in the absence of any agency or non-trademark intellectual property constraint,¹⁸⁹ self-developed fame should be free for use in any manner that the famous person chooses.

C. *Assisted Fame*

“Assisted Fame” is the broadest category—i.e., fame which attaches to an individual, but is the result of a group effort. Examples

¹⁸⁸ Even this requires the use of third-party tools, but these tools may be acquired by contract without creating a principal-agent relationship or any other duty to the supplier. One example would be the use of YouTube or a similar service to distribute a video. While there may be no contract negotiation, the relationship is governed by YouTube's terms of service. See, e.g., *Terms of Service*, YOUTUBE, <https://www.youtube.com/static?template=terms> [<https://perma.cc/DV2Q-P9NK>]. Another example would be the use of a web hosting service. See, e.g., *Terms of Service*, AMAZON WEB SERVICES, <https://aws.amazon.com/service-terms/> [<https://perma.cc/2EW7-9W4S>].

¹⁸⁹ Of course, even a famous person must respect all rights belonging to others. The following analyses only consider rights directly related to the creation of that element of fame under consideration and not to other components which may be necessary to develop fame.

would include performers backed by studio productions, athletes backed by team organizations, and authors backed by publishers. In each case, an organization (often one with long experience and assets developed for the creation of fame) selects an individual possessing talent and develops that talent at the organization's expense.

Fundamentally, two sets of factors are involved in developing Assisted Fame. First, the organization brings its own intellectual property, which is helpful in establishing the individual's fame because it associates the individual with an already famous entity. For example, since MGM is a famous studio,¹⁹⁰ starring in an MGM film can confer fame on an otherwise unknown performer.¹⁹¹ Rights issues do not arise to the extent that the organization is using its own intellectual property on its own behalf, for example, in marketing the movie. However, marketing the movie incidentally contributes to the development of the performer's fame, which in turn raises the question of who owns the new bundle of rights comprising the performer's fame.

This observation brings us to the second factor. The organization contributes its "star-making" machinery, its publicity skills, and its contacts. The individual celebrity-in-the-making becomes, in effect, the agent through which all this machinery belonging to the principal operates. Again, as long as the agent is acting on the principal's behalf, such as by marketing the movie, the principal-agent relationship will not become problematic. However, complications related to fiduciary duties do arise if the performer uses the newfound fame in another venture.

Conversely, the performer's personal skills may be an independent source of intellectual property rights. If so, the performer's own IP rights would counterbalance the organization's claims to the fame, as the agent would arguably be using her own assets, not the principal's. This configuration of rights may negate the agency

¹⁹⁰ Even the MGM lion is famous. See Kat Escher, *The Story of Hollywood's Most Famous Lion*, SMITHSONIAN (Apr. 17, 2017), <https://www.smithsonianmag.com/smart-news/mgms-first-lion-didnt-roar-180962852/> [<https://perma.cc/32NM-REX5>].

¹⁹¹ See, for example, Julia Roberts or Matt Damon in *MYSTIC PIZZA* (MGM 1988), Aaron Eckhart in *IN THE COMPANY OF MEN* (MGM 1997), or Jeffrey Wright in *BASQUIAT* (MGM 1996).

rule preventing agents from using the principal's assets for the agent's benefit.

D. Group Fame

This category includes fame associated with a group of people rather than the individuals who make up the group. Examples would be bands or dance troupes. While each may have a standout performer, other performers in the group would be unrecognizable to the general public except as part of the group.¹⁹² The issues are similar to those in the Assisted Fame category, except that no organization outside the group can claim ownership of the jointly developed intellectual property or rights as a principal under agency theory.

E. Fungible Fame

This category includes individuals who become famous, not through any personal skill or attribute, but simply by being in the right place at the right time. Examples would be game show contestants and reality show participants. In these cases, there is a famous role, but it does not matter who plays that role—it is the role itself that is famous. The analysis is similar to that set out above in respect of the Assisted Fame category, except that the individual's own skills are a greatly diminished, or even absent, factor—thus supporting the broadest possible ownership by the principal.

VII. APPLICATION

While media coverage of conflicts between famous people and the organizations for which they work, or which otherwise fulfill the role of a principal, has tended to focus on the First Amendment rights of the performer,¹⁹³ the coverage has often failed to recognize

¹⁹² For example, individual members of the Alvin Ailey Dance Troupe or the Blue Man Group likely cannot be named or identified by the general public; instead, they are generally recognized only by their respective group names.

¹⁹³ See, e.g., Travis Waldron, *Does Colin Kaepernick Have A First Amendment Case Against Donald Trump?*, HUFFINGTON POST (June 5, 2018), https://www.huffpost.com/entry/kaepernick-trump-first-amendment-nfl-national-anthem_n_5b15b680e4b093ac33a0f94c [<https://perma.cc/6HYE-BPGJ>] (suggesting that Colin Kaepernick sue President Trump and the NFL for violating his First Amendment rights); Daniel Victor, *Obama Says*

that the First Amendment is a constraint on *government* action: “Congress shall make no law . . . abridging the freedom of speech”¹⁹⁴ The Constitution does not guarantee an absolute license to speak¹⁹⁵ or to use others’ facilities to do so. Private parties are at liberty to constrain actions, even those that are constitutionally guaranteed against government constraint.

The theory advanced in this Article that fame is a bundle of intellectual property rights allows us to resolve the tension that often arises between different parties’ claims of entitlement to control the famous person’s use of that fame.¹⁹⁶ The first step is to identify the type of fame involved, which in turn permits identification of which intellectual property rights are involved. Each of the involved intellectual property rights is then analyzed to determine its owner. If the famous person owns that right, there are no constraints on that person’s use. If, however, the use involves a property right belonging to another, resolution requires no more than application of basic rules of intellectual property.

For example, if a professional football player calls a press conference and shows up in “civilian” clothes to discuss social issues, there is no constraint. While the type of fame operative in this example is Assisted Fame—the football player would be unknown but for association with the football team—the professional is using his own property right; ultimately, the professional’s individual fame determines whether or not reporters will attend the press conference.

On the other hand, property rights owned by others are invaded if the football player seeks the same publicity by making the same

Colin Kaepernick Is ‘Exercising His Constitutional Right’, N.Y. TIMES (Sept 5, 2016), <https://www.nytimes.com/2016/09/06/sports/obama-colin-kaepernick-national-anthem.html> [https://perma.cc/LB37-K83C]; *Kneeling Is a Form of Free Speech Protected by the First Amendment*, KY. KERNEL (Oct. 11, 2017), http://www.kykernel.com/opinion/kneeling-is-a-form-of-free-speech-protected-by-the/article_64289330-acc2-11e7-a02f-9b3e53103372.html [https://perma.cc/T9VF-HFJA].

¹⁹⁴ U.S. CONST. amend. I.

¹⁹⁵ Confidentiality agreements are a simple, but clear, example of the right of private parties to limit speech.

¹⁹⁶ All intellectual property rights are enforceable not only by actions for damages, but also by injunctions in appropriate cases. *See eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390–91 (2006).

statement symbolically during a football game that is being televised and watched not because of the personal fame of the player but because of the public interest in the game. In this scenario, the football player is harnessing Assisted Fame to send his message. The resources he is using do not depend on his personal skills, and so his own rights cannot support the right to make the symbolic statement. To the contrary, he is exploiting the fame of the team and of the game itself, and paraphernalia of those two fames (e.g. the uniform)¹⁹⁷—all of which are owned by the team, the NFL, and perhaps other institutions such as the broadcaster, but certainly not by the individual player. The audience is not there to hear what the player thinks about political issues, but rather to watch the game—a game that will unfold based in part on plays contained in the team’s proprietary playbook. The player is acting as the agent of the team, and the right to use the team’s assets is limited to uses on the team’s behalf. Thus the same statement in a different context produces a different result, and the player’s right to make the statement is subject to the team’s control. The analysis would differ for someone who had developed independent fame. For example, if a famous actress were to stage a photo opportunity to publicize opposition to a war,¹⁹⁸ it would be necessary to determine whether she used any assets belonging to her employer in the process. If she appeared in a costume associated with a film character, that could infringe on the employer’s rights. If she used nothing more than her own star power to attract the media, she would be within her rights and under no duty to seek approval from her employer.

More generally, use of an employer’s uniform for personal purposes appears to be sufficient to constitute a violation of the duty of loyalty. *Reading v. Regem*¹⁹⁹ is a clear example not only of the absolute rule regarding use of a principal’s resources for the agent’s purposes, but also of the presumption that the use of an employer’s

¹⁹⁷ See *Reading v. Regem* [1948], 2 KB 268 (Eng.) (holding that a soldier who wore his uniform to facilitate smuggling was held to owe the government the proceeds of the smuggling operation).

¹⁹⁸ Colby Itkowitz, *How Jane Fonda’s 1972 Trip to North Vietnam Earned Her the Nickname Hanoi Jane*, WASH. POST (Sept. 18, 2017 10:15AM), <https://www.washingtonpost.com/news/retropolis/wp/2017/09/18/how-jane-fondas-1972-trip-to-north-vietnam-earned-her-the-nickname-hanoi-jane/> [https://perma.cc/UKW3-9U7N].

¹⁹⁹ See *supra* text accompanying note 167.

uniform violates the duty of loyalty. Moreover, in *Bridgeport Guardians, Inc. v. Delmonte*, the court upheld disciplining an officer for “importuning, while in uniform, of a small business owner, appearing to exploit the authority of his position for personal gain”²⁰⁰ The officer had, while in his police officer uniform, asked the owner of a hotdog stand for a \$500 loan and “took four hot dogs on two occasions . . . without paying” and also intimidated a witness in connection with those actions.²⁰¹ In addition, appearing in uniform may also be evidence that, at the time an act took place, the agent was acting as the principal’s employee.²⁰² U.S. military services prohibit appearing in uniform in connection with political events, and Major League Baseball (rather than individual players) controls the use of player uniforms in the production of trading cards and the licensing of team logos on merchandise.²⁰³

Given that the issue of ownership of fame by definition involves people who are aware of the value of publicity, the issue is likely to be recognized and negotiated in the majority of cases. Especially in cases involving professional athletes or performers, those negotiations will probably take place in the context of broader union contracts. However, it is critical that those negotiating on behalf of performers actually do recognize and address the ownership of fame in those negotiations, because there is no intellectual property right that confers an implied license to a performer when the underlying right is owned by a third party. In situations where the issue has not been negotiated, principals retain significant rights and the powerful ability to control the actions of their famous agents, especially when the action takes place during a principal-sponsored activity or

²⁰⁰ *Bridgeport Guardians, Inc. v. Delmonte*, 2010 WL 5625647, at *3 (D. Conn. Dec. 30, 2010).

²⁰¹ *Id.* at 1.

²⁰² See generally *Boehm v. U.S. Postal Service*, No. 8:12-CV-198, 2013 WL 6002874 (D. Neb. Nov. 12, 2013) (in which a postal employee was disciplined for removing undeliverable coupons for personal use and attempting to redeem them while wearing her uniform).

²⁰³ U.S. DEP’T OF DEFENSE, Instruction No. 1334.01, ¶ 3 (Oct. 26, 2005). Major League Baseball controls logos through Major League Properties, Inc. See *Legal Notices*, MAJOR LEAGUE BASEBALL (2019), <https://www.mlb.com/official-information/legal-notices> [<https://perma.cc/H8GS-HNW3>] (listing of intellectual property rights licensed through Major League Properties, Inc.). Most professional sports leagues centrally own and license logos.

involves use of a uniform or other device that associates the famous agent with the principal.

CONCLUSION

When mass communications were expensive, the development of fame generally required the resources and efforts of production institutions. Those institutions typically were able to dictate policy because they controlled access to the mass media and because they—not the famous person—had the resources to reach the general public. The technological trend toward cheaper avenues of mass communication has weakened this practical control, thereby increasing the importance of legal mechanisms of control. As barriers to mass communication continue to fall, the opportunity for commercialization of fame divorced from the institutions that traditionally created fame will increase. This can be expected to increase the gap between the interests of the principals who enabled the creation of fame and the agents who embody the fame, and therefore to increase the need to address issues of ownership of intellectual property in a growing number and wider range of cases. We have only seen the tip of the iceberg, and in the future, famous individuals should be more cognizant of the issues regarding the IP rights in their fame and aware of the need to negotiate for such rights in agreements with the people and entities that help make them famous.