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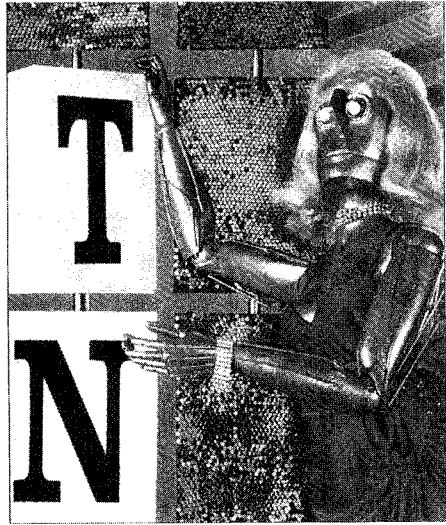
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# Note

## ***White v. Samsung Electronics America: The Ninth Circuit Turns a New Letter in California Right of Publicity Law***



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### I. Introduction

In *White v. Samsung Electronics America*,<sup>1</sup> game show hostess Vanna White brought suit against Samsung Electronics America and its advertising agency, David Deutsch Associates,

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\* NEWSWEEK, Apr. 5, 1993, at 54.

1. 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

alleging the violation of her common law right of publicity<sup>2</sup> and California Civil Code section 3344.<sup>3</sup> The defendants in *White* produced an advertisement, published in several national magazines, depicting a robot in women's clothing standing next to a game board similar to the set of the popular television show, *Wheel of Fortune*.<sup>4</sup> A caption along with the photograph read: "Longest-running game show. 2012 A.D."<sup>5</sup>

The United States District Court for the Central District of California granted summary judgment for the defendants on each of White's claims.<sup>6</sup> The United States Court of Appeals for the Ninth Circuit affirmed in part, reversed in part, and remanded.<sup>7</sup> The court of appeals affirmed the district court's dismissal of White's section 3344 claim.<sup>8</sup> The court concluded, however, that White's common law right of publicity claim could go to the jury.<sup>9</sup> The court reasoned that common law right of publicity claims in California are not limited to appropriation of a plaintiff's name or likeness,<sup>10</sup> which had been the most common methods of appropriation under prior case law,<sup>11</sup> but could also be brought for appropriation of a plaintiff's identity.<sup>12</sup> In

2. *White*, 971 F.2d at 1396. See *infra* notes 24-29 and accompanying text for various definitions of the right of publicity.

3. CAL. CIV. CODE § 3344 (West Supp. 1994) (prohibiting the nonconsensual use of a person's name, voice, signature, photograph, likeness, or signature for advertising purposes). See *infra* part II.E for a discussion of § 3344.

White also brought a claim under the Lanham Act § 43(a), 15 U.S.C. § 1125(a) (Supp. V 1993), alleging that the defendants had used a false description or representation, creating a likelihood of confusion as to whether White had endorsed Samsung's product. *White*, 971 F.2d at 1399-1400. Discussion of the Lanham Act claim in *White* is beyond the scope of this Note. For information on the Lanham Act, see, for example, CHARLES E. MCKENNEY & GEORGE F. LONG, III, FEDERAL UNFAIR COMPETITION: LANHAM ACT SECTION 43(a) (1990).

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

5. *Id.* See *infra* part III.A for a discussion of the facts of *White*.

6. See *White*, 971 F.2d at 1397-98, 1399.

7. *Id.* at 1396.

8. *Id.* at 1397.

9. *Id.* at 1402. The Ninth Circuit also permitted White's Lanham Act claim to go to the jury. See *id.* at 1401. See generally Lanham Act § 43(a), 15 U.S.C. § 1125(a) (Supp. V 1993).

On January 19, 1994, a jury found in favor of White in the amount of \$403,000. *The Reliable Source*, WASH. POST, Jan. 21, 1994, at 3.

10. *White*, 971 F.2d at 1397-98.

11. *Id.* at 1397 (citing William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 401-02 & nn.156-67 (1960)).

12. *Id.* at 1398.

addition, the court of appeals rejected the defendants' parody defense,<sup>13</sup> reasoning that the parody of Vanna White and *Wheel of Fortune* "was subservient and only tangentially related" to the advertisement's primary commercial purpose.<sup>14</sup> The parody defense did not apply because it was "better addressed to non-commercial parodies."<sup>15</sup>

The court's decision in *White* greatly expanded the scope of the California common law right of publicity,<sup>16</sup> creating a cause of action for the mere evoking of a celebrity's image in the viewer's mind, rather than requiring a more affirmative, concrete appropriation of a celebrity's image,<sup>17</sup> as had been required under prior case law.<sup>18</sup> Also, the court's decision did not provide adequate guidance regarding the relationship between the First Amendment and the common law right of publicity.<sup>19</sup> In addition, by rejecting the defendants' parody defense, the court created a right of publicity doctrine that conflicts with the Copyright Act.<sup>20</sup> Indeed, the common law right of publicity should have a parody defense.<sup>21</sup> Further, as a result of the *White* decision, it is possible that copyrights will decrease in

13. *Id.* at 1401.

14. *Id.*

15. *Id.* The nature of the use of the parody, that is, whether it is used for commercial or non-commercial purposes, is a factor that is taken into account in the analysis of a parody defense. See, e.g., *Campbell v. Acuff-Rose Music*, 114 S. Ct. 1164, 1171 (1994); *Rogers v. Koons*, 960 F.2d 301, 308-09 (2d Cir. 1992). See also 17 U.S.C. § 107 (1988 & Supp. V 1993). See *infra* part II.F.3 for a background discussion of the parody defense; see also *infra* notes 236-45 and accompanying text for a discussion of the *White* court's treatment of the defendants' parody defense.

16. See *White*, 971 F.2d at 1402 (Alarcon, J., dissenting).

17. See *White v. Samsung Elecs. Am.*, 989 F.2d 1512, 1514 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 113 S. Ct. 2443 (1993).

18. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983). See also *infra* part IV.B for criticisms of the *White* court's disposition of the plaintiff's common law right of publicity claim.

19. See *infra* part IV.C.

20. Copyright Act of 1976, 17 U.S.C. §§ 101-1010 (1988 & Supp. V 1993). See *White*, 989 F.2d at 1517-19 (Kozinski, J., dissenting); see also *infra* part II.F.2 for a background discussion of the Copyright Act.

21. See *infra* part IV.D.

value.<sup>22</sup> Finally, Vanna White's claim should have been preempted by the Copyright Act.<sup>23</sup>

Part II of this Note discusses the background law necessary for an analysis of the *White* case. First, the right of publicity is introduced and defined. Second, the right of privacy, from which the right of publicity evolved, is discussed. Next, the right of publicity, including its development in California, is examined in further detail. The statutory claim for nonconsensual use of a person's name, voice, signature, photograph, or likeness under California Civil Code section 3344 is then examined. In addition, the relationship between the right of publicity and federal law, including the First Amendment and fair use parody, is discussed.

Part III of this Note discusses the *White* case, including its facts, procedural history, holding, and reasoning. The two dissenting opinions, the first dissenting from the original holding, the second from the order rejecting the suggestion for rehearing en banc, are also discussed. Finally, Part IV of this Note provides an analysis of the majority and dissenting opinions in the *White* case.

## II. Background

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

The right of publicity has been defined as "the right to grant the exclusive privilege of using one's name or likeness for commercial purposes,"<sup>24</sup> the right of a celebrity to protect his or her "pecuniary interest in the commercial exploitation of his [or her] identity,"<sup>25</sup> "the inherent right of every human being to

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22. See *infra* part IV.E.

23. See *infra* part IV.F. See also *infra* notes 163-81 and accompanying text for a background discussion of federal preemption of state intellectual property law under the Copyright Act.

This Note also asserts that the dissenting opinion of Judge Kozinski inaccurately analyzed the application of choice of law issues to common law right of publicity claims. See *infra* part IV.G.

24. NEIL BOORSTYN, COPYRIGHT LAW § 4:11, at 113 (Supp. 1992) (citing *Haelan Lab. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953)).

25. *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831, 834 (6th Cir. 1983) (citing *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 572 (1977)).

control the commercial use of his or her identity,"<sup>26</sup> and "the right of each person to control and profit from the publicity values which he [or she] has created or purchased."<sup>27</sup> In his article on popular culture and publicity rights, Professor Michael Madow states that "[t]he right of publicity essentially gives a celebrity a legal entitlement to the commercial value of her identity, thus enabling [the celebrity] to control the extent, manner, and timing of its commercial exploitation."<sup>28</sup> Thus, the right of publicity focuses on the proprietary and commercial value of a person's identity.<sup>29</sup>

The development of the right of publicity has its origins in the right of privacy.<sup>30</sup> In his landmark article, *Privacy*,<sup>31</sup> William Prosser identified four distinct torts included within the right of privacy: (1) intrusion upon the plaintiff's seclusion; (2) public disclosure of embarrassing private facts; (3) publicity which places the plaintiff in a false light in the public eye; and (4) appropriation of the plaintiff's name or likeness.<sup>32</sup> The right of publicity evolved from the fourth category of Prosser's privacy torts—the right of privacy protecting against commercial appropriation, or "appropriation right of privacy."<sup>33</sup>

Prosser distinguished appropriation right of privacy from the other three privacy torts, stating that "[t]he interest protected [by appropriation right of privacy] is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity."<sup>34</sup> Commentator J. Thomas McCarthy, however, in his treatise on

26. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* vii (1992) [hereinafter MCCARTHY ON PUBLICITY].

27. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954), cited in Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 130 n.13 (1993).

28. Madow, *supra* note 27, at 130 n.14.

29. MCCARTHY ON PUBLICITY, *supra* note 26, § 5.8(A); see also Zacchini, 433 U.S. at 576 (stating that "[t]he rationale for (protecting the right of publicity) is to prevent unjust enrichment by the theft of good will") (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

30. MCCARTHY ON PUBLICITY, *supra* note 26, § 1.1(A), (B)(2).

31. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

32. *Id.* at 389. This fourth category of Prosser's privacy torts will be referred to either as appropriation right of privacy or commercial appropriation.

33. See MCCARTHY ON PUBLICITY, *supra* note 26, § 1.5(D).

34. Prosser, *supra* note 31, at 406.

publicity and privacy, states that the appropriation right of privacy and the right of publicity have developed into separate and distinct bodies of law.<sup>35</sup> The appropriation right of privacy protects against an unpermitted use of personal identity that would cause injury to self-esteem and dignity.<sup>36</sup> In contrast, the right of publicity protects the proprietary and commercial value of a person's identity and persona.<sup>37</sup> Courts and other commentators have, similar to McCarthy, distinguished between the right of publicity and the appropriation right of privacy.<sup>38</sup> Other courts, however, appear to have blurred or confused this distinction.<sup>39</sup> For purposes of this Note, the appropriation right of privacy and the right of publicity will be treated as separate and distinct theories.

### B. *Roots of the Right of Privacy*

The right of privacy has its origins in the landmark article by Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy*.<sup>40</sup> There, the authors opined that the growing excesses of the press had made it necessary for the law to protect the pri-

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35. MCCARTHY ON PUBLICITY, *supra* note 26, § 5.8(C).

36. *Id.* § 5.8(A).

37. *Id.* § 5.8(C). McCarthy states that the basic difference between appropriation right of privacy and the right of publicity is not based "upon the type of activity by the defendant but on the nature of the plaintiff's right and the nature of the resulting injury." *Id.* The appropriation right of privacy is violated by an injury to the psyche; the right of publicity is violated by an injury to the pocketbook. *Id.*

38. *See, e.g.,* Howard I. Berkman, Comment, *Right of Publicity*, 42 BROOK. L. REV. 527, 532-33 (1976); *Haelan Lab. v. Topps Chewing Gum*, 202 F.2d 866, 868 (S.D.N.Y. 1953).

39. *See, e.g.,* *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983). In *Carson*, the court referred to the fourth of Prosser's privacy torts, appropriation right of privacy, as the right of publicity, stating that appropriation right of privacy "has become known as the right of publicity." *Id.* at 834 (quoting *Factors Etc. v. Pro Arts*, 579 F.2d 215, 220 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979)). While the *Carson* court appeared to recognize that the appropriation right of privacy provides redress for embarrassment and mental damages which flow from appropriation of one's identity without consent, and that the right of publicity protects against the unauthorized exploitation of a celebrity's identity, its use of the terminology, "right of publicity," as the fourth of Prosser's privacy torts is confusing. *See id.* at 834.

40. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). *See Nimmer, supra* note 27, at 203-04; *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346 n.4 (Cal. Ct. App. 1983).

vate individual from the mental pain and distress resulting from the intrusion by the press into people's private affairs.<sup>41</sup>

Many of the earliest cases to arise under this emerging body of privacy law were not those brought by celebrity-plaintiffs, but by private individuals whose names or likenesses had been used in advertisements. One of the earliest and most well-known cases in the United States to recognize the common law right of privacy was *Pavesich v. New England Life Insurance Co.*<sup>42</sup> The *Pavesich* court explicitly accepted the premise of the Warren and Brandeis article, finding that the right of privacy was necessitated by both natural law and analogy to previous cases.<sup>43</sup> This type of unauthorized use of a plaintiff's name and

41. Warren & Brandeis, *supra* note 40, at 196. See also W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 849 & n.7, 850-51 (5th ed. 1984).

42. 50 S.E. 68 (Ga. 1905). See Prosser, *supra* note 31, at 384-86.

In *Pavesich*, the plaintiff complained that the defendant's unauthorized use of his photograph in its testimonial advertisement exposed him to ridicule. 50 S.E. at 69. The Georgia Supreme Court held this to be an actionable invasion of privacy. *Id.* at 80-81.

Statutory recognition of the right of privacy came prior to *Pavesich*, in 1903, when the New York Legislature enacted a statute which provided civil and criminal remedies for the unauthorized use of "the name, portrait or picture of any living person . . . for advertising purposes, or for the purposes of trade . . ." Act of Apr. 6, 1903, ch. 132, §§ 1-2, 1903 N.Y. Laws 308 (codified as amended at N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992)). The New York statute was enacted following the decision of the New York Court of Appeals in *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 64 N.E. 442 (1902). In *Roberson*, the plaintiff claimed that the defendant's unauthorized use of her picture in its advertisements caused her great distress, suffering, and humiliation, with both mental and physical manifestations. *Id.* at 542-43, 64 N.E. at 442. The court denied recovery, finding no precedent in the case law for Warren & Brandeis' "so-called right of privacy." *Id.* at 544, 547, 64 N.E. at 443, 444. The court suggested, however, that the legislature could intervene and "provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes without his consent." *Id.* at 545, 64 N.E. at 443. One year later, the New York Legislature followed the court's suggestion and enacted the statute. See Prosser, *supra* note 31, at 385. *Roberson* has never been overruled, and New York right of privacy law is limited to the scope of this statute; there is no common law right of privacy in New York. See *Stephano v. News Group Publications*, 64 N.Y.2d 174, 182, 474 N.E.2d 580, 583, 485 N.Y.S.2d 220, 223 (1984).

43. *Pavesich*, 50 S.E. at 70, 74-77 (citing *Schulyer v. Curtis*, 147 N.Y. 436, 42 N.E. 22 (1895); *Murray v. Gast Lithographic & Engraving Co.*, 8 Misc. 36, 28 N.Y.S. 271 (N.Y.C. C.P. Equity T. N.Y. County), *aff'd*, *Murray v. Babitt*, 10 Misc. 365, 31 N.Y.S. 17 (N.Y.C. C.P. Gen. T. N.Y. County 1894); *Marks v. Jaffa*, 6 Misc. 290, 26 N.Y.S. 908 (N.Y.C. Super. Ct. Spec. T. N.Y. County 1893); *Schulyer v. Curtis*, 15 N.Y.S. 787 (Sup. Ct. N.Y. County 1892); *Mackenzie v. Soden Mineral*



likeness, privacy right appropriation,<sup>44</sup> became a widely recognized aspect of the right of privacy in the ensuing years.<sup>45</sup>

The common law right of privacy has long been recognized in California.<sup>46</sup> In California, a plaintiff may assert a common law claim for appropriation of his or her name or likeness by alleging: (1) the defendant's use of his or her identity; (2) the appropriation of his or her name or likeness to defendant's advantage, commercially or otherwise; (3) the lack of consent; and (4) resulting injury.<sup>47</sup>

The earliest California case involving the right of privacy was *Melvin v. Reid*.<sup>48</sup> *Melvin* involved what would most likely fall under the "public disclosure of private fact" branch of pri-

Springs, 18 N.Y.S. 240 (Sup. Ct. Spec. T. N.Y. County 1891); *Pollard v. Photographic Co.*, 40 Ch. Div. 345 (1888); *Tuck & Sons v. Priester*, 19 Q.B.D. 629 (1887); *Prince Albert v. Strange*, 2 De G. & Sm. 652, 64 Eng. Rep. 293 (1849); *Abernethy v. Hutchinson*, 1 H. & Tw. 28, 47 Eng. Rep. 1313 (1825); *Yovatt v. Wingard*, 1 Jac. & W. 394, 37 Eng. Rep. 425 (1820); *Warren & Brandeis*, *supra* note 40, at 193, 202, 207-08, 212).

44. See *supra* text accompanying notes 32, 36.

45. *Madow*, *supra* note 27, at 168 & n.205 (citing *Flake v. Greensboro News*, 195 S.E. 55, 63-64 (N.C. 1938) (unauthorized use of likeness); *Kunz v. Allen*, 172 P. 532 (Kan. 1918) (unauthorized use of likeness); *Foster-Molburn Co. v. Chinn*, 120 S.W. 364 (Ky. 1909) (unauthorized use of name and likeness)).

46. *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983) (citing *Melvin v. Reid*, 297 P. 91 (Cal. Ct. App. 1931)).

In California, appropriation right of privacy is similar to the law in other jurisdictions discussed previously, see *supra* notes 40-45 and accompanying text, in that it is essentially a tort claim, *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 823 (9th Cir. 1974), involving "a direct wrong of a personal character resulting in injury to the feelings, without regard to any effect which the publication may have on the property, business, pecuniary interest, or the standing of the individual in the community." *Fairfield v. American Photocopy Equip. Co.*, 291 P.2d 194, 197 (Cal. Ct. App. 1955).

47. *Eastwood*, 198 Cal. Rptr. at 347. Note that the *Eastwood* court discussed these four elements under the rubric of Prosser's fourth branch of privacy tort, commercial appropriation, and in the same discussion stated that these elements state a cause of action for violation of the right of publicity. See *id.* at 346-49. The *White* court stated that these four elements state a "common law right of publicity [claim]." *White*, 971 F.2d at 1397 (citing *Eastwood*, 198 Cal. Rptr. at 342).

As stated previously, this author maintains a conceptual distinction between Prosser's fourth privacy tort, appropriation right of privacy, and the right of publicity, since the appropriation right of privacy protects the unpermitted use of one's personal identity which causes injury to self-esteem and dignity, and the right of publicity protects the proprietary and commercial value of a person's identity and persona. See *McCARTHY ON PUBLICITY*, *supra* note 26, § 5.8(A), (C). See also *supra* notes 30-39 and accompanying text.

48. 297 P. 91 (Cal. Ct. App. 1931).

vacy law.<sup>49</sup> The court permitted recovery based on a clause in the California Constitution: the right "to pursue and obtain happiness."<sup>50</sup>

One of the earliest California cases to allow recovery under the appropriation right of privacy was *Kerby v. Hal Roach Studios*.<sup>51</sup> In *Kerby*, the plaintiff was an actress and singer whose name was used in letters that the defendant had mailed to male householders to promote the defendant's motion picture, in which the plaintiff did not appear.<sup>52</sup> The court noted that the right of privacy had been recognized eleven years earlier in *Melvin v. Reid*.<sup>53</sup> The court in *Kerby* stated that although the facts were quite different from those in *Melvin*, the court would allow recovery because the letter imputed to the plaintiff "a laxness of character [and] a coarseness of moral fibre . . . ; and to spread such imputations . . . is as much an invasion of the right of privacy as was the publication of true but derogatory statements in *Melvin v. Reid*."<sup>54</sup>

Another noted California case is *Fairfield v. American Photocopy Equipment Co.*<sup>55</sup> In *Fairfield*, the court held that the plaintiff's right of privacy had been invaded since, without plaintiff's consent, the defendant had advertised in a national lawyers' publication that the plaintiff was a satisfied user of the defendant's photocopying equipment.<sup>56</sup>

49. See Prosser, *supra* note 31, at 392. See also *supra* text accompanying notes 31-32. *Melvin* involved the depiction of the past life of the plaintiff, a prostitute who had been tried and acquitted for murder and had, in the eight years since, remarried and been living a "virtuous, honorable and righteous life." *Melvin*, 297 P. at 91.

50. *Melvin*, 297 P. at 93 ("All men are by nature free and independent, and have certain inalienable rights, among which are those of enjoying and defending life and liberty; acquiring, possessing, and protecting property; and pursuing and obtaining safety and happiness.") (quoting CAL. CONST. of 1849, art. I, § 1). The *Melvin* court stated that whether this invasion of the plaintiff's "inalienable right" was termed the right of privacy or "any other name" was "immaterial" since it was guaranteed by the state's constitution. *Melvin*, 297 P. at 93-94.

51. 127 P.2d 577 (Cal. Ct. App. 1942).

52. *Id.* at 578-79.

53. *Id.* at 579 (citing *Melvin*, 297 P. at 92).

54. *Kerby*, 127 P.2d at 581.

55. 291 P.2d 194 (Cal. Ct. App. 1955).

56. *Id.* at 197. In *Fairfield*, the court stated that the right of privacy included the right of a person to be free from unauthorized and unwarranted publicity, *id.* (citing *Brents v. Morgan*, 299 S.W. 967, 970 (Ky. 1927)), and that "an unauthorized use or publication of a person's name may constitute an actionable invasion of

### C. *Roots of the Right of Publicity*

Confusion developed when celebrity-plaintiffs appeared in court claiming that their names or likenesses had been used for advertising purposes without their consent.<sup>57</sup> This confusion stemmed from the fact that the claim was for violating the right of *privacy*, which was based on the tort law concept of "personal injury to dignity and state of mind, measured by mental distress damages."<sup>58</sup> When a well-known public figure claimed to have suffered this type of harm, the courts were hesitant to apply the privacy concept to a "public" person and found it difficult to understand how such a person could suffer mental anguish from appearing in an advertisement.<sup>59</sup> Since celebrities had assumed positions of prominence and visibility, many courts held that they had waived their rights of privacy as to news commentaries and commercial advertisements.<sup>60</sup> In other courts, the rule was that a publicity claim was only actionable if "offensive," which had the effect of barring most actions involving commercial appropriations of celebrity likenesses.<sup>61</sup> Moreover, even where courts allowed recovery for damages for invasion of privacy, such damages were limited to "hurt feelings," and the

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[that] right." *Id.* (citing *Kerby*, 127 P.2d at 580-81). The court reasoned that the defendant's conduct fell within "the narrowest definition of the right of privacy," since it constituted an unauthorized and unwarranted appropriation of plaintiff's personality as a lawyer for pecuniary gain and profit. *Id.* at 197-98. The court found that the defendant knew at the time it published the advertisement that the representation was false. *Id.* at 197. The court further held that neither inadvertence nor mistake was a defense to an invasion of the plaintiff's right of privacy. *Id.*

57. See Madow, *supra* note 27, at 169; see also Berkman, *supra* note 38, at 529-30.

58. MCCARTHY ON PUBLICITY, *supra* note 26, § 1.6. See also *supra* text accompanying note 36.

59. *Id.*

60. See Madow, *supra* note 27, at 169 & n.210 (citing *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941); *Paramount Pictures v. Leader Press*, 24 F. Supp. 1004 (W.D. Okla. 1938), *rev'd on other grounds*, 106 F.2d 229 (10th Cir. 1939); *Martin v. F.I.Y. Theatre Co.*, 10 Ohio Op. 338 (Ohio C.P. 1938)).

In *O'Brien*, the plaintiff was a professional football player whose photograph was used by a beer company in an advertisement calendar. 124 F.2d at 168. The photograph was obtained from the publicity department at O'Brien's former university, where he had risen to national acclaim as a football player. *Id.* at 169. The court denied his right of privacy claim, reasoning that "the publicity he got was only that which he had been constantly seeking and receiving . . ." *Id.* at 170.

61. Madow, *supra* note 27, at 169 & n.211 (citing *Nimmer*, *supra* note 27, at 207).

damage awards were small or nominal.<sup>62</sup> The courts were not only unreceptive to celebrity claims for commercial appropriations of their images, but the right of privacy theory was a “less than perfect vehicle for celebrities eager to extract the maximum possible benefit from their publicity values.”<sup>63</sup>

The earliest case explicitly recognizing the right of publicity was *Haelan Laboratories v. Topps Chewing Gum*.<sup>64</sup> In *Haelan*, the court held that in addition to, and independent of, the statutory right of privacy in New York,<sup>65</sup> “a man has a right in the

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62. *Id.* at 169 & n.212 (citing *Miller v. Madison Square Garden Corp.*, 176 Misc. 714, 717, 28 N.Y.S.2d 811, 813-14 (Sup. Ct. N.Y. County 1941) (holding that a well-known performer, who acknowledged that his photo on the cover of an official program had not caused him any humiliation, was entitled to six cents in damages); *Fisher v. Murry M. Rosenberg, Inc.*, 175 Misc. 370, 371, 23 N.Y.S.2d 677, 679 (Sup. Ct. N.Y. County 1940) (finding that use of a famous dancer’s photograph in a shoe advertisement entitled the plaintiff to \$300 for “injured feelings”).

63. Madow, *supra* note 27, at 169-70. See also *infra* notes 71-77 and accompanying text.

64. 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). See Berkman, *supra* note 38, at 534.

In *Haelan*, the plaintiff chewing-gum company had contracted with a famous baseball player to put the player’s image on baseball cards, and the player agreed not to give this right to another gum manufacturer during the contract period. *Haelan*, 202 F.2d at 867. The defendant was a competitor of the plaintiff, and the defendant, knowing of the plaintiff’s contract, induced the baseball player to allow the defendant to also use his photograph on defendant’s baseball cards. *Id.* The plaintiff brought suit under New York Civil Rights Law §§ 50-51. *Id.* See *infra* note 65 for a discussion of §§ 50-51. The defendant in *Haelan* argued that the right of privacy under New York law was personal, non-assignable, and covered only the right to not have one’s feelings hurt by unauthorized publication of his likeness or name. *Haelan*, 202 F.2d at 867. Thus, the argument went, there was no “property” in the right or permission that the plaintiff had obtained from the player, and the defendant had not invaded any legal interest when it induced the player to breach his contract with the plaintiff. *Id.* The defendant further contended that the plaintiff’s contracts created no more than a release from liability for invasion of the right of privacy. *Id.* at 868.

65. The appropriation right of privacy in New York is governed by statute. See N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992). Section 50 provides in relevant part: “A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, . . . is guilty of a misdemeanor.” *Id.* § 50. Section 51 provides for a civil action for damages and an injunction in the case of such conduct. *Id.* § 51.

*Haelan* was decided by a federal court interpreting New York law. New York courts, however, have refused to find a common law right of privacy or publicity, restricting recovery to that permitted under §§ 50-51. See *Arrington v. New York Times*, 55 N.Y.2d 433, 440, 434 N.E.2d 1319, 1321, 449 N.Y.S.2d 941, 943 (1982) (stating that in New York, “there exists no so-called common-law right to privacy”)

publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . .”<sup>66</sup> The court did not decide whether such a right was, in fact, “property,” reasoning that the question was “immaterial,” since the label, “property,” “simply symbolizes the fact that courts enforce a claim which has pecuniary worth.”<sup>67</sup> Since *Haelan*, “[c]ourts and commentators [have] come to regard [the right of publicity] as a full-blooded property right.”<sup>68</sup>

In 1954, Melville B. Nimmer wrote the landmark article, *The Right of Publicity*.<sup>69</sup> One commentator has said that this article “did for the right of publicity what Warren and Brandeis did . . . for the right of privacy.”<sup>70</sup> Nimmer asserted that the right of privacy and other traditional areas of the law were inadequate to protect a person’s commercial interest in his or her identity.<sup>71</sup>

First, Nimmer reasoned that when a celebrity sought redress for the unauthorized use of his or her name or portrait under the right of privacy theory, most courts found that the celebrity had “waived” his or her right of privacy because certain aspects of the celebrity’s life had become public.<sup>72</sup>

Second, Nimmer concluded that recovery under the right of privacy required conduct that was “offensive to persons of ordi-

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(quoting *Cohen v. Hallmark Cards*, 45 N.Y.2d 493, 497 n.2, 382 N.E.2d 1145, 1146 n.2, 410 N.Y.S.2d 282, 284 n.2 (1978)); see also *Stephano v. News Group Publications*, 64 N.Y.2d 174, 183, 474 N.E.2d 580, 584, 485 N.Y.S.2d 220, 224 (1984) (stating that “the right of publicity’ is encompassed under the Civil Rights Law [§§ 50-51] as an aspect of the right of privacy . . .”).

66. *Haelan*, 202 F.2d at 868.

67. *Id.*

68. Madow, *supra* note 27, at 130 n.14 (citing *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8th Cir. 1969); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1355 (D. N.J. 1981); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1282 (D. Minn. 1970); STEPHEN R. MUNZER, A THEORY OF PROPERTY 52-53 (1990)).

Given this status as a property right, the right of publicity is transferable by license or assignment and in some states is descendible. Madow, *supra* note 27, at 130 (citing MCCARTHY ON PUBLICITY, *supra* note 26, §§ 10.3-10.4).

69. Nimmer, *supra* note 27.

70. MCCARTHY ON PUBLICITY, *supra* note 26, § 1.8 n.1 (citing Steven J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC’Y 111 (1980)). See *supra* text accompanying notes 40-41 for a discussion of Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

71. Nimmer, *supra* note 27, at 204.

72. *Id.* at 204-05. See also *supra* notes 57-63 and accompanying text.

nary sensibilities" or was "beyond the limits of decency."<sup>73</sup> In most cases a prominent celebrity could not honestly claim that the use of his or her name, photograph, or likeness was humiliating, offensive, or embarrassing since what the celebrity really sought was payment for the use of his or her publicity value, and it would be difficult to allege that nonpayment would offend the sensibilities of an ordinary person.<sup>74</sup>

Third, Nimmer stated that the right of privacy was personal and nonassignable.<sup>75</sup> Thus, when a celebrity granted permission to another to use his or her name or likeness, it was simply a release from liability for invasion of the right of privacy.<sup>76</sup> The grantee could not prevent a third party from infringing on his or her right to use the celebrity's name or likeness.<sup>77</sup>

Fourth, Nimmer reasoned that other legal theories, such as unfair competition,<sup>78</sup> breach of contract, or defamation were also inadequate to protect the celebrity's publicity value.<sup>79</sup> Unfair competition requires competition which is not always present when a person's publicity rights are violated.<sup>80</sup> Recovery under a contract theory is limited to parties to such contracts, yet a person whose right of publicity is violated may not be a party to any contract.<sup>81</sup> A defamation theory may be inadequate since such a claim requires that the defendant's conduct

73. *Id.* at 207 (citing RESTATEMENT (FIRST) OF TORTS § 867 cmt. d (1939)).

74. *Id.*

75. *Id.* at 209.

76. *Id.*

77. *Id.*

78. Unfair competition is broadly defined as "misappropriation for commercial advantage of a benefit or property right belonging to another." BLACK'S LAW DICTIONARY 1529 (6th ed. 1990). Recovery for unfair competition generally requires competition between the plaintiff and the defendant, and in many courts, the "palming off" of the goods or business of one person as that of another." Nimmer, *supra* note 27, at 210, 212, 213 (quoting American Broadcasting Co. v. Wahl Co., 36 F. Supp. 167, 168 (S.D.N.Y. 1940)).

79. Nimmer, *supra* note 27, at 210, 214-15.

80. *Id.* Nimmer asserted that the right of publicity "should exist . . . regardless of whether the defendant is in competition with the plaintiff, and regardless of whether he is passing off his own products as those of the plaintiff." *Id.* at 216.

81. *Id.* at 214.

be offensive or disparaging.<sup>82</sup> However, a person's right of publicity may be violated even without such disparaging conduct.<sup>83</sup>

Finally, Nimmer asserted that the right of publicity would compensate for the inadequacy of these existing legal theories and thereby protect a celebrity's publicity value in his or her name or likeness.<sup>84</sup> He suggested that the right of publicity should be "recognized as a property . . . right [and thus be] capable of assignment and subsequent enforcement by the assignee."<sup>85</sup> He also proposed that recovery should be allowed "regardless of whether the defendant has used the publicity in a manner offensive to the sensibilities of the plaintiff."<sup>86</sup> In addition, he suggested that damages should be measured not in terms of the injury sustained by the plaintiff, as in the right of privacy, but by the "value of the publicity appropriated by [the] defendant . . . ."<sup>87</sup>

#### D. *The Right of Publicity in California*

Long after the federal district court in *Haelan*<sup>88</sup> had assumed the existence of a right of publicity in New York, California courts were still hostile to this emerging theory.<sup>89</sup> By 1974,

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82. *Id.* at 215.

83. *Id.*

84. *Id.* at 216.

85. *Id.*

86. *Id.*

87. *Id.*

88. *Haelan Lab. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953). *See also supra* notes 64-68 and accompanying text for a discussion of *Haelan*.

89. In *Strickler v. National Broadcasting Co.*, 167 F. Supp. 68 (C.D. Cal. 1958), Melville B. Nimmer, arguing for the plaintiff, was unable to convince the United States District Court for the Central District of California to adopt a right of publicity cause of action under California law. *Id.* at 69-70. Nimmer was the author of the noted article, *The Right of Publicity*, 19 LAW AND CONTEMP. PROBS. 203 (1954), *see supra* notes 69-87 and accompanying text, and co-author of the noted treatise MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (1991).

However, several years later, a California court took a step towards finding a right of publicity in California, in *In re Weingand*, 41 Cal. Rptr. 778 (Cal. Ct. App. 1964). In *Weingand*, the estate of actor Peter Lorre successfully objected to an aspiring actor's request to change his name to Peter Lorie. *Id.* at 781. In denying the petitioner's application, the court stated that the confusion created by the petitioner in using the name would "directly affect the commercial and professional value of the services and performances of Peter Lorre both present and future," since Peter Lorre's name was "unique in the entertainment industry in that it connote[d] the unique characterization, style, manner of speaking and appearance of

however, the United States Court of Appeals for the Ninth Circuit, in *Motschenbacher v. R.J. Reynolds Tobacco Co.*,<sup>90</sup> had allowed recovery under the theory that the plaintiff had a proprietary interest in his identity.<sup>91</sup> In *Motschenbacher*, the plaintiff was a popular race car driver, and the defendants used a photograph of the plaintiff's distinctive and widely recognized race car in its cigarette advertisement.<sup>92</sup> In the advertisement, the defendants changed the number of the plaintiff's car, attached a spoiler to the car, and removed advertisements for other products that were on the car.<sup>93</sup> The defendants also added several comic-strip-type balloons to the advertisement, which contained advertising messages.<sup>94</sup> Although the plaintiff was not identifiable in the advertisement, he was, in fact, the driver.<sup>95</sup> Some viewers "who had seen the commercial . . . immediately recognized plaintiff's car and . . . inferred that it was sponsored by [the defendants]."<sup>96</sup>

The court in *Motschenbacher* began its analysis by recognizing that the plaintiff's claim was of the fourth variety of Prosser's privacy torts: commercial appropriation.<sup>97</sup> The court then stated that while the right of privacy was a right of a personal nature which protected injury to one's feelings, this fact applied more to Prosser's first three categories of the right of privacy<sup>98</sup> than it did to commercial appropriation.<sup>99</sup> Although the appropriation of one's name and likeness could cause harm that was mental and subjective, the court observed, when the identity appropriated has a commercial value, "the injury may be largely, or even wholly, of an economic or material nature."<sup>100</sup>

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[Peter] Lorre." *Id.* at 782. Although the court made no mention of a right of privacy or publicity, its language suggested that a commercial value existed in Lorre's name and that the petitioner's use of Lorre's name would bring economic harm to the estate of Peter Lorre. *See id.*

90. 498 F.2d 821 (9th Cir. 1974).

91. *Id.* at 825.

92. *Id.* at 822.

93. *Id.*

94. *Id.* One such message was: "Did you know that Winston tastes good like a cigarette should?" *Id.*

95. *Id.*

96. *Id.*

97. *Id.* at 824. *See supra* text accompanying notes 31-32.

98. *See supra* text accompanying note 32.

99. *Motschenbacher*, 498 F.2d at 824.

100. *Id.*



The court noted that some courts had protected this commercial aspect of an individual's interest in his own identity under a privacy theory, while others had done so "under the rubric of 'property' or a so-called 'right of publicity.'"<sup>101</sup> The court cited Prosser's treatise on torts<sup>102</sup> for the proposition that it is pointless to dispute whether such a right should be classified as property, that "it is at least clearly proprietary in its nature, and that [o]nce protected by the law, it is a right of value upon which the plaintiff can capitalize by selling licenses."<sup>103</sup> The court concluded that California courts would afford legal protection to an individual's proprietary interest in his own identity, but it did not need to decide "whether they would do so under the rubric of privacy, property, or publicity."<sup>104</sup> The court said only that California courts would, indeed, "recognize such an interest and protect it."<sup>105</sup>

Four years later, in *Lugosi v. Universal Pictures*,<sup>106</sup> the California Supreme Court explicitly recognized the right of publicity.<sup>107</sup> Although the case primarily concerned the post-mortem aspects of the appropriation of one's name and likeness, the case is significant for its statement describing the right of publicity:

The so-called right of publicity means in essence that 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 oppor-

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101. *Id.* For a discussion of the privacy theory, see, for example, *Palmer v. Schonhorn Enters.*, 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967); James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637 (1973); Victor S. Netterville, *Copyright and Tort Aspects of Parody, Mimicry and Humorous Commentary*, 35 S. CAL. L. REV. 225, 253-54, 267-75 (1962), cited in *Motschenbacher*, 498 F.2d at 825.

For a discussion of the publicity theory, see, for example, *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 485-93 (3d Cir.), cert. denied, 351 U.S. 926 (1956); *Haelan Lab. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1280-83 (D. Minn. 1983), cited in *Motschenbacher*, 498 F.2d at 825.

102. W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS (4th ed. 1971).

103. 498 F.2d at 825 (quoting KEETON ET AL., *supra* note 102, § 117, at 807).

104. *Id.* at 825-26.

105. *Id.* at 826.

106. 603 P.2d 425 (Cal. 1979).

107. *Id.* at 431.

tunities. The protection of name and likeness from unwarranted intrusion or exploitation is the heart of the law of privacy.<sup>108</sup>

Another important case construing California right of publicity law was *Midler v. Ford Motor Co.*<sup>109</sup> In *Midler*, the Court of Appeals for the Ninth Circuit held that the defendants, an advertising agency and its client, had appropriated part of entertainer Bette Midler's identity by using a "sound-alike" singer to imitate her voice in a commercial and had thereby committed a tort under California common law.<sup>110</sup> The court quoted *Motschenbacher* for the proposition that California "recognize[s] an injury from 'an appropriation of the attributes of one's identity.'"<sup>111</sup> The *Midler* court reasoned that just as a person's face is distinctive, so is a person's voice, especially that of a renowned singer.<sup>112</sup> The court stated, "to impersonate her voice is to pirate her identity."<sup>113</sup> Consequently, after *Midler*, the common law right of publicity in California can be violated by appropriating the attributes of a celebrity's distinctive voice.<sup>114</sup>

In *Nurmi v. Peterson*,<sup>115</sup> an actress who created the character, "Vampira," a 1950's television movie hostess, sued an actress who portrayed a horror movie hostess called "Elvira" for appropriation of the plaintiff's likeness as the "Vampira" character.<sup>116</sup> The plaintiff's causes of action were, *inter alia*, for the violation of her common law right of privacy and publicity, and for the violation of California Civil Code section 3344.<sup>117</sup>

108. *Id.*

109. 849 F.2d 460 (9th Cir. 1988).

110. *Id.* at 461, 463.

111. *Id.* at 463 (quoting *Motschenbacher*, 498 F.2d at 824).

112. *Id.*

113. *Id.*

114. See MCCARTHY ON PUBLICITY, *supra* note 26, § 4.14(B). Another Ninth Circuit voice appropriation case was *Waits v. Frito Lay*, 978 F.2d 1093 (9th Cir. 1992). In *Waits*, noted jazz/blues singer Tom Waits sued Frito Lay and its advertising agency for, *inter alia*, voice misappropriation, which the court stated was "a species of . . . the 'right of publicity.'" *Id.* at 1098. The defendants had used a "sound-alike" singer to imitate Waits' highly distinctive voice in a radio commercial. *Id.* The court found in favor of Waits, reasoning that "when voice is a sufficient indicia of a celebrity's identity, the right of publicity protects against its imitation for commercial purposes without the celebrity's consent." *Id.* (citing *Midler*, 849 F.2d at 463).

115. 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989).

116. *Id.* at 1776-77.

117. *Id.* at 1776. See *infra* part II.E for a discussion of CAL. CIV. CODE § 3344.

The court noted that the plaintiff had not alleged that the defendant's character exactly duplicated the plaintiff's character, but only that the defendant had used "certain props, clothes or mannerisms that were similar to [plaintiff's character]."<sup>118</sup> The defendants argued that "the use of another character's general characteristics, as opposed to specific facial features, photographs or other exact physical replicas, was not actionable under section 3344 or the common law rights of publicity or privacy."<sup>119</sup>

First, in construing the term "likeness" in section 3344, the court held that the California Supreme Court had employed the word to mean "an exact copy of another's features and not merely a suggestive resemblance."<sup>120</sup> Since the plaintiff had not alleged that the defendant's character "exactly duplicated" the physical qualities of the plaintiff's character, the plaintiff's section 3344 claim failed.<sup>121</sup> The court also reasoned that if, as the plaintiffs contended, the use of a person's general characteristics (as opposed to specific features, photographs or replicas) amounted to an appropriation of that person's likeness, the first person to portray a character or part would "freeze all rights to certain props, clothing, or other qualities surrounding a character."<sup>122</sup> The court noted that under this theory, "all subsequent actors would be subject to legal challenge on the grounds that they had copied elements of characters portrayed by earlier generations of actors."<sup>123</sup> The court asserted that "the result [of employing the plaintiff's theory] would greatly inhibit the development of the entertainment arts and the freedom of expression."<sup>124</sup> The court stated that the California Legislature could not have intended such a result when it drafted section 3344.<sup>125</sup>

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118. *Nurmi*, 10 U.S.P.Q.2d at 1777. The plaintiff's character consisted of "a distinctive dark dress, certain horror movie props, and a special personality." *Id.* at 1776.

119. *Id.* at 1777.

120. *Id.* (interpreting *Lugosi v. Universal Pictures*, 603 P.2d 425, 427, 431 (Cal. 1979)).

121. *Id.* at 1778.

122. *Id.* at 1777-78.

123. *Id.* at 1778.

124. *Id.*

125. *Id.*

Second, under the plaintiff's common law right of privacy and publicity claims, the court similarly held that because the plaintiff's allegations did "not amount to a claim that the plaintiff's actual features were used by the defendants for commercial purposes, no common law right of publicity or privacy action could be maintained."<sup>126</sup> The court distinguished *Midler v. Ford Motor Co.*,<sup>127</sup> and *Chaplin v. Amador*,<sup>128</sup> cited by the plaintiff, stating that in both of these cases the plaintiffs' claims were permitted to go forward only on fraud grounds and "not on right of privacy or publicity grounds."<sup>129</sup> The court reasoned that in *Midler*, the defendants had deceived the public into believing that Bette Midler was singing in the commercial by using a "sound-alike" singer;<sup>130</sup> in *Chaplin*, the defendant, a Charlie Chaplin imitator, had attempted by fraudulent means to deceive the public into believing his film was a Charlie Chaplin film.<sup>131</sup> The court concluded that neither of these two cases supported the proposition that a right of publicity claim could be brought for "a person's use of a character that bears a mere resemblance to another . . . ."<sup>132</sup>

#### E. California Civil Code Section 3344

Section 3344(a) of the California Civil Code<sup>133</sup> provides a cause of action for damages where any person "knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . ."<sup>134</sup>

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126. *Id.*

127. 849 F.2d 460 (9th Cir. 1988). See also *supra* text accompanying notes 109-14.

128. 269 P. 544 (Cal. Ct. App. 1928).

129. *Nurmi*, 10 U.S.P.Q.2d at 1778 (construing *Midler*, 849 F.2d at 463-64; *Chaplin*, 269 P. at 545-46).

130. *Id.* (citing *Midler*, 849 F.2d at 463-64).

131. *Id.* at 1778 (citing *Chaplin*, 269 P. at 545-46).

132. *Id.*

133. CAL. CIV. CODE § 3344(a) (West Supp. 1994).

134. *Id.* The statute was enacted in 1971 and, at the time, covered only commercial appropriations of name, photograph, and likeness. Act of Nov. 22, 1971, ch. 1595, 1971 Cal. Laws 3426. In 1984 it was amended to include commercial

To plead a cause of action under section 3344, the plaintiff must allege a knowing use of the plaintiff's name, photograph, voice, signature or likeness,<sup>135</sup> a direct connection between the use and the commercial purpose,<sup>136</sup> and satisfy the four common law elements previously mentioned.<sup>137</sup> Thus, the difference between common law and statutory right of privacy claims is that mistake and inadvertence are not defenses to common law commercial appropriation, but are valid defenses against statutory commercial appropriation.<sup>138</sup>

Subsection (d) of California Civil Code section 3344 exempts from liability the use of a name, voice, signature, photograph, or likeness "in connection with any news, public affairs, or sports broadcast or account, or any political campaign . . ." <sup>139</sup> Subsection (e) of the statute provides that consent is not required for the use of a person's name, voice, signature, photograph, or likeness "solely because the material containing such

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appropriations of voice and signature. Act of Sept. 30, 1984, ch. 1704, § 2, 1984 Cal. Laws 6172.

The case of *Stilson v. Reader's Digest Ass'n*, 104 Cal. Rptr. 581 (Cal. Ct. App. 1972), cert. denied, 411 U.S. 952 (1973), is stated to be the genesis of the California right of privacy statute. MCCARTHY ON PUBLICITY, *supra* note 26, § 6.4(E)(1) (citing Jerome E. Weinstein, *Commercial Appropriations of Name or Likeness: Section 3344 and the Common Law*, 52 L.A. B.J. 430, 432 (1977)). *Stilson* was a class action lawsuit in which the plaintiffs alleged that their names had been used without their consent in computer-generated solicitations received from Reader's Digest. *Stilson*, 104 Cal. Rptr. at 582. Each letter stated that the addressee and his neighbors had been selected to participate in a contest and listed each recipient's name as a neighbor of the other recipients. *Id.* The court stated that such a class action on behalf of over 20 million persons would be an "intolerable burden" on the judicial system, since each plaintiff would have to prove his or her state of mind and mental suffering. *Id.* at 583. As a result of these types of damage proof problems for non-celebrity plaintiffs, the statute includes a minimum recovery amount of \$750 per plaintiff. See CAL. CIV. CODE § 3344(a). See also MCCARTHY ON PUBLICITY, *supra* note 26, § 6.4(E)(1).

135. *Eastwood*, 198 Cal. Rptr. at 347 (citing Weinstein, *supra* note 134, at 430-33).

136. *Id.* (citing *Johnson v. Harcourt, Brace, Jovanovich, Inc.*, 118 Cal. Rptr. 370, 381 (Cal. Ct. App. 1974)).

137. The four common law elements are: (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury. *Id.*

138. *Id.* at 346 n.6 (citing *Fairfield v. American Photocopy Equip. Corp.*, 291 P.2d 194, 197 (Cal. Ct. App. 1955)).

139. CAL. CIV. CODE § 3344(d).

use is commercially sponsored or contains paid advertising.”<sup>140</sup> The statute makes it a question of fact whether the use “was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required . . . .”<sup>141</sup> In addition, the statute provides that its remedies “are cumulative and in addition to any provided for by law.”<sup>142</sup>

## F. Federal Law and the Right of Publicity

### 1. The First Amendment and the Right of Publicity

The scope of the right of publicity can be limited by First Amendment considerations of freedom of speech and press.<sup>143</sup> The First Amendment is often asserted as a defense in right of publicity cases.<sup>144</sup> In such cases the court must determine whether the First Amendment will preclude the plaintiff’s claim.<sup>145</sup>

140. *Id.* § 3344(e).

141. *Id.*

142. *Id.* § 3344(g). This language suggests that claims beyond the scope of § 3344 are possible. See MCCARTHY ON PUBLICITY, *supra* note 26, § 6.4(F)(8); Weinstein, *supra* note 134, at 432-33, 454-56.

California right of privacy law exists in both common law and statutory formulations. See *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983) (citing *Lugosi v. Universal Pictures*, 603 P.2d 425, 428 n.6 (Cal. 1979) (stating that the common law right of privacy, termed “appropriation” by Prosser, was “complemented legislatively” by California’s appropriation statute)). In contrast, the right of privacy in New York exists only under statute. See *supra* notes 42, 65 for discussions of right of privacy law in New York.

143. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28.05 (1992) [hereinafter MCCARTHY ON TRADEMARKS].

144. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 563 (1977); *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1401 (9th Cir. 1992), *reh’g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 458 (Cal. 1979) (en banc) (Bird, C.J., concurring); *Maheu v. CBS*, 247 Cal. Rptr. 304, 312 (Cal. Ct. App. 1988); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 350 (Cal. Ct. App. 1984).

145. See *Berkman*, *supra* note 38, at 550. Berkman asserts that “the right of publicity is not a restriction on freedom of speech because material that is the object of the right’s protection is thoroughly commercial, beyond the reach of the First Amendment.” *Id.* at 549. However, the Supreme Court case of *Central Hudson Gas & Elec. v. Public Serv. Comm’n*, 447 U.S. 557, 561-63 (1980), decided after Berkman’s article was written, makes it clear that purely commercial speech does receive First Amendment protection, albeit less protection than other forms of speech. See *infra* note 298 for further discussion of *Central Hudson* and its progeny.

In *Guglielmi v. Spelling-Goldberg Productions*,<sup>146</sup> then-Chief Justice Bird of the California Supreme Court stated in her concurring opinion that "an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression in this context."<sup>147</sup> Chief Justice Bird examined the decisions of other courts that had considered this question and found that the right of publicity had not been allowed to outweigh the value of free expression, regardless of whether the context was factual and biographical, or fictional.<sup>148</sup> She reasoned that in the absence of such a rule, reports and commentaries on the thoughts and conduct of public and prominent persons would be subject to censorship under the guise of preventing the dissipation of the publicity value of a person's identity.<sup>149</sup>

Commentator J. Thomas McCarthy has stated that when a court is presented with a First Amendment defense it must undertake "an informed balancing of rights"; he characterized this analysis as highly fact-specific.<sup>150</sup> McCarthy has also stated that "a given unauthorized use of a person's identity will fall within one of two categories: . . . 'communicative' or 'commercial.'"<sup>151</sup> Indeed, many of the right of publicity cases involving

146. 603 P.2d 454 (Cal. 1979) (en banc).

147. *Id.* at 461 (Bird, C.J., concurring).

148. *Id.* at 461-62 nn.17-18 (Bird, C.J., concurring) (citing *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978); *Factors Etc. v. Creative Card Co.*, 444 F. Supp. 279, 284 (S.D.N.Y. 1977); *Frosch v. Grosset & Dunlap, Inc.*, 4 Media L. Rep. 2307, 2307-08 (Sup. Ct. Spec. T. N.Y. County 1979), *aff'd*, 75 A.D.2d 768, 427 N.Y.S.2d 828 (1st Dep't 1980); *Rosemont Enters. v. McGraw-Hill Book Co.*, 85 Misc. 2d 583, 587-88, 380 N.Y.S.2d 839, 844 (Sup. Ct. Spec. T. N.Y. County 1975); *Rosemont Enters. v. Random House*, 58 Misc. 2d 1, 6, 294 N.Y.S.2d 122, 129 (Sup. Ct. Spec. T. N.Y. County 1968), *aff'd*, 32 A.D.2d 892, 301 N.Y.S.2d 948 (1st Dep't 1969); *Donahue v. Warner Bros. Pictures Distrib. Corp.*, 272 P.2d 177, 183 (Utah 1954)).

149. *Guglielmi*, 603 P.2d at 462 (Bird, C.J., concurring). In addition, a California appeals court has stated that the right of publicity "invokes constitutional [First Amendment] protections." *Maheu v. CBS*, 247 Cal. Rptr. 304, 312 (Cal. Ct. App. 1988).

150. 2 MCCARTHY ON TRADEMARKS, *supra* note 143, § 28.05.

151. *Id.* McCarthy states that speech is "communicative . . . where the policy of free speech predominates over the right of a person to his identity, and no infringement of the right of publicity takes place." *Id.* Speech is "commercial . . . where the right of publicity is infringed because, while there are overtones of ideas being communicated, the use is primarily commercial." *Id.*

First Amendment concerns consider the category of the speech in their analyses.<sup>152</sup>

Statutes governing commercial appropriation also use a categorical approach in determining which types of speech will be exempted from proscription. California Civil Code section 3344, which prohibits the unauthorized use of a person's name, voice, signature, photograph, or likeness for advertising purposes, provides an exception for uses in connection with news, public affairs, sports broadcasts or accounts, or political campaigns.<sup>153</sup> These uses, exempted from section 3344, have been extended to California common law appropriation claims.<sup>154</sup> The purpose of these exceptions is to "avoid First Amendment questions in the area of misappropriation by providing extra breathing space for the use of a person's name in connection with matters of public interest."<sup>155</sup>

## 2. *The Right of Publicity and Copyright Law*

Article I, Section 8, Clause 8 of the United States Constitution is the source of Congress' authority to enact federal copyright legislation.<sup>156</sup> "The primary purpose of copyright . . . is to

152. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 574-78 (1977); *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992); *New Kids on the Block v. News Am. Publishing*, 971 F.2d 302, 309-10 (9th Cir. 1992); *Guglielmi*, 603 P.2d at 459 (Bird, C.J., concurring); *Maheu*, 247 Cal. Rptr. at 312; *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 349-50 (Cal. Ct. App. 1984).

153. CAL. CIV. CODE § 3344(d).

154. *New Kids*, 971 F.2d at 309-10 (citing *Eastwood*, 198 Cal. Rptr. at 349-50, 352).

155. *Id.* at 310 n.10. Similarly, New York's privacy statute, which prevents nonconsensual use of the name, portrait, or picture of another for advertising or trade purposes, N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992), has a judicially-created exception for news accounts. See *Stephano v. New Group Publications*, 64 N.Y.2d 174, 185, 474 N.E.2d 580, 585, 485 N.Y.S.2d 220, 225 (1984). Note that unlike California, New York has no common law cause of action for appropriation of a person's name or likeness. See *Freihofer v. Hearst Corp.*, 65 N.Y.2d 135, 140, 480 N.E.2d 349, 353, 490 N.Y.S.2d 735, 739 (1985). See also *supra* notes 42, 65 for discussions of New York's privacy statute.

156. PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 20 (3d ed. 1993). Article I, Section 8, Clause 8 provides in relevant part: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. This language is known as the "Copyright Clause" of the Constitution. See, e.g., *Goldstein v. California*, 412 U.S. 546, 548-49 (1973).



secure 'the general benefits derived by the public from the labors of authors.'<sup>157</sup> Under the current Copyright Act ("the Act"),<sup>158</sup> a work must be an "original work[ ] of authorship [and] fixed in any tangible medium of expression" to receive copyright protection.<sup>159</sup> It must also fall within the subject matter set out in § 102 of the Act.<sup>160</sup> The subject matter protected by § 102 includes literary works, musical works, dramatic works, pictorial, graphic, and sculptural works, motion pictures and other audiovisual works, sound recordings, and architectural works.<sup>161</sup>

Under the Act, authors have the exclusive right to make and distribute copies or phonorecords of their works, to sell, rent, lease, or otherwise transfer their works, to perform and display their works publicly, and to prepare derivative works of their copyrighted works.<sup>162</sup>

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157. MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.03(A) (1991) [hereinafter *NIMMER ON COPYRIGHT*] (citing *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)).

158. Copyright Act of 1976, 17 U.S.C. §§ 101-1010 (1988 & Supp. V 1993). Congress passed the first Copyright Act in 1790. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831), cited in *NIMMER ON COPYRIGHT*, *supra* note 157, at OV-1.

159. 17 U.S.C. § 102 (1988); see also H.R. Rep. No. 1476, 94th Cong., 2d Sess. 51-58 (1976), reprinted in GOLDSTEIN, *supra* note 156, at 561.

160. 17 U.S.C. § 102 (1988 & Supp. V 1993); see also GOLDSTEIN, *supra* note 156, at 564.

161. See 17 U.S.C. § 102(a).

162. 17 U.S.C. § 106 (1988). Remedies provided under the Copyright Act for infringement of the copyright owner's exclusive rights include injunctions, impoundment of copies or phonorecords made in violation of the Act, damages, and profits. See 17 U.S.C. §§ 501-11 (1988 & Supp. V 1993).

The rights granted by § 106 can be thought of as a "bundle of rights," similar to the "bundle of rights" enjoyed by the owner of real property. See 17 U.S.C. § 106. In the case of real property, if any of those rights are impeded, the value of that owner's real property is decreased. See, e.g., *Loretto v. Teleprompter Manhattan CATV Corp.*, 458 U.S. 419, 436 (1982). Real Property law balances the property owner's rights to use and enjoy his or her real property against the public's right to some restrictions on that use for the common public good. *Id.* at 426 (stating that restrictions on an owner's use of his or her real property are often permitted "where deemed necessary to promote the public interest") (citing *Penn Central Transp. Co. v. City of New York*, 438 U.S. 104 (1978)), cited in EDWARD H. RABIN & ROBERTA ROSENTHAL KWALL, *FUNDAMENTALS OF MODERN REAL PROPERTY LAW* 4 (3d ed. 1992). Similarly, intellectual property law has struck a balance between the intellectual property owner's right to control his work and the public's access to the work. See GOLDSTEIN, *supra* note 156 and authorities cited therein. See also generally 17 U.S.C. §§ 101-1010 (1988 & Supp. V 1993) (Copyright Act); 15 U.S.C. §§ 1051-1127 (1988 & Supp. V 1993) (Lanham Act—trademarks and unfair competition); 35 U.S.C. §§ 1-376 (1988) (Patent Act).

Prior to the Act's enactment, both Congress and the individual state legislatures had promulgated their own copyright laws.<sup>163</sup> However, with the 1976, Act Congress ended the dual state and federal schemes,<sup>164</sup> preempting all state laws and rights which are "equivalent to any of the exclusive rights" within the Act.<sup>165</sup> This does not mean that the states have no power in the area of intellectual property rights, but the various state rights and remedies cannot conflict with the Act.<sup>166</sup> The legislative history of section 301 of the Act<sup>167</sup> states that federal copyright law does not preempt state law rights of publicity, "as long as the [state] causes of action contain elements, such as an invasion of personal rights, that are 'different in kind' from copyright infringement."<sup>168</sup>

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163. NIMMER ON COPYRIGHT, *supra* note 157, at OV-3.

164. *Id.*

165. 17 U.S.C. § 301 (1988); *see also* NIMMER ON COPYRIGHT, *supra* note 157, at OV-3.

166. NIMMER ON COPYRIGHT, *supra* note 157, § 1.01(B). As a general proposition, states remain free to develop their own intellectual property law so long as it does not conflict with federal intellectual property law. *See id.* In *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141 (1989), the Supreme Court stated that "the Patent and Copyright Clauses [of the U.S. Constitution] do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation within their own jurisdictions." *Id.* at 165. "Thus, where 'Congress determines that neither federal protection nor freedom from restraint is required by the national interest,' the States remain free to promote originality and creativity in their own domains." *Id.* (quoting *Goldstein v. California*, 412 U.S. 546, 559 (1973)).

For other Supreme Court cases discussing preemption and the co-existence of state and federal intellectual property law, see *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979); *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969); *Brulotte v. Thys Co.*, 379 U.S. 29 (1965); *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (1965); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), *cited in* GOLDSTEIN, *supra* note 156, at 21 n.\*.

167. 17 U.S.C. § 301(a). Section 301(a) provides in relevant part:

[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. . . . [N]o person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

*Id.*

168. BOORSTYN, *supra* note 24, § 4:11.

Congress' power to act under the Constitution with respect to copyright protection is broad.<sup>169</sup> However, Congress is not required to exercise this power to its outermost limits.<sup>170</sup> It is left to the discretion of Congress to prescribe the statutory scheme that it deems necessary.<sup>171</sup> Where Congress determines that national protection is not necessary, it may allow the states to protect certain intellectual property rights, provided that the state laws do not conflict with the areas in which Congress has acted.<sup>172</sup>

In *Zacchini v. Scripps-Howard Broadcasting Co.*,<sup>173</sup> the Supreme Court stated that the right of publicity, protected by state governments, does not necessarily conflict with the copyright or patent rights protected by the federal government.<sup>174</sup> The Court held that although these state and federal rights may share similar policy objectives, a state could protect an entertainer's economic interests through the right of publicity as long as the state's regulatory power in this area did not conflict with congressional legislation.<sup>175</sup>

Federal preemption was found, however, in *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n.*<sup>176</sup> In *Baltimore Orioles*, the Court of Appeals for the Seventh Circuit held that the major league baseball clubs' copyright in the telecasts of baseball games preempted the players' publicity rights in their game-time performances.<sup>177</sup> The court reasoned that the three-part test for preemption had been satisfied.<sup>178</sup> First, the

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169. *Goldstein v. California*, 412 U.S. 546, 562 (1972).

170. *Id.*

171. *Id.* For example, Congress added sound recordings to the subject matter protected under the Act in 1971. Copyright Act of 1909, Pub. L. No. 92-140, 85 Stat. 391 (1971).

172. *Goldstein*, 412 U.S. at 559.

173. 433 U.S. 562 (1977).

174. *See id.* at 573-77.

175. *Id.* at 577.

176. 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987).

177. *Id.* at 679. The players argued that broadcasts of their performances were made without their consent, which violated their right of publicity. *Id.* at 674.

178. *Id.* A right is preempted by the Copyright Act if: (1) the work in which the right is asserted is fixed in a tangible form; (2) the work in which the right is asserted comes within the subject matter of copyright under § 102 of the Act; and (3) the state right in question is equivalent to any of the exclusive rights granted in § 106 of the Act. *Id.* at 674, 676. *See* GOLDSTEIN, *supra* note 156, at 773 (citing II

players' performances were fixed in a tangible medium of expression.<sup>179</sup> Second, their performances came within the subject matter of copyright under § 102, as part of an audiovisual work.<sup>180</sup> Third, the state law right of publicity was "equivalent" to one of the rights within the general scope of § 106, since the state right was violated by the exercise of the rights set forth in § 106.<sup>181</sup>

### 3. *Parody Defense and the Right of Publicity*

"[P]arody is a form of artistic expression, protected by the First Amendment."<sup>182</sup> The Supreme Court has defined parody, for purposes of copyright law, as "the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's work."<sup>183</sup> Parody is often used

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PAUL GOLDSTEIN, COPYRIGHT—PRINCIPLES, LAW AND PRACTICE § 15.2 (1989); see also *supra* note 167 for the text of § 301, *supra* text accompanying notes 159-61 for a discussion of § 102, and *supra* note 162 and accompanying text for a discussion of § 106.

179. *Baltimore Orioles*, 805 F.2d at 674. Being "fixed in a tangible medium of expression" is one of the requirements for copyright protection. See 17 U.S.C. § 102(a); see also *supra* text accompanying note 159. Live telecasts are fixed in a tangible medium of expression by the simultaneous videotape recording of the event as it is being broadcast. See *Baltimore Orioles*, 805 F.2d at 674; see also GOLDSTEIN, *supra* note 156, at 562-63; 17 U.S.C. § 101 (definition of "fixed"). The performance is thus embodied in a copy (the videotape of the telecast), which enables it to be perceived, reproduced, and otherwise communicated indefinitely." *Baltimore Orioles*, 805 F.2d at 675.

180. *Baltimore Orioles*, 805 F.2d at 676-77. See 17 U.S.C. § 102(a)(6); see also *supra* text accompanying note 161. Although the court in *Baltimore Orioles* found that the players' performances lacked sufficient creativity to be copyrightable, it noted that "section 301(a) preempts rights claimed in works that lack sufficient creativity to be copyrightable . . . [in order] to prevent the states from granting protection to works which Congress has concluded should be in the public domain," that is, works which lack creativity. *Baltimore Orioles*, 805 F.2d at 676 n.23.

181. *Baltimore Orioles*, 805 F.2d at 676. By exercising rights granted under § 106, such as performance, distribution, and display, the state right of publicity was "equivalent" to a right granted by the Act. *Id.* at 677.

182. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing*, 886 F.2d 490, 493 (2d Cir. 1989).

183. *Campbell v. Acuff-Rose Music*, 114 S. Ct. 1164, 1172 (1994). The Court of Appeals for the Second Circuit has defined parody as "when one artist, for comic effect or social commentary, closely imitates the style of another artist and in so doing creates a new art work that makes ridiculous the style and expression of the original." *Rogers v. Koons*, 960 F.2d 301, 309-10 (2d Cir. 1992).

as a defense to claims of copyright infringement.<sup>184</sup> The defense derives from the fair use exception to copyright infringement under the Act.<sup>185</sup>

Under § 107 of the Act, the use of an author's copyrighted work is not an infringement if it constitutes a fair use.<sup>186</sup> Fair use is the "privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without [the owner's] consent, notwithstanding the monopoly granted to the owner."<sup>187</sup> Examples of fair use under § 107 include "criticism, comment, news reporting, teaching, . . . scholarship, or research . . ."<sup>188</sup> The terms "criticism" and "comment" include parody.<sup>189</sup> Section 107 sets out four factors that should be examined to determine whether a use is fair: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;<sup>190</sup> (2) the nature of the copyrighted work;<sup>191</sup> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole;<sup>192</sup> and (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>193</sup> Commentators,

184. See, e.g., *Campbell v. Acuff-Rose Music*, 114 S. Ct. 1164 (1994); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *Elsmere Music v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979).

In addition to copyright infringement, parody has been asserted as a defense to claims of trademark infringement, e.g., *Cliffs Notes*, 886 F.2d at 493; *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 27, 32-33 (1st Cir. 1987), intentional infliction of emotional distress and libel, e.g., *Hustler Magazine v. Falwell*, 485 U.S. 46, 47-49 (1988), and infringement of the right of publicity, e.g., *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1401 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 114 S. Ct. 2443 (1993).

185. See, e.g., *Campbell*, 114 S. Ct. at 1171; *Rogers*, 960 F.2d at 309-10.

186. 17 U.S.C. § 107 (1988 & Supp. V 1993).

187. *Rosemont Enters. v. Random House*, 366 F.2d 303, 306 (2d Cir. 1966) (quoting HORACE G. BALL, *LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944)).

188. 17 U.S.C. § 107.

189. See *Campbell*, 114 S. Ct. at 1171-72 (stating that "parody, like other comment or criticism, may claim fair use under [§ ] 107"); *Rogers*, 960 F.2d at 310 (stating that "parody and satire are valued forms of criticism, [and are] encouraged because [they] foster [ ] the creativity protected by the copyright law").

190. 17 U.S.C. § 107(1) (1988).

191. *Id.* § 107(2).

192. *Id.* § 107(3).

193. *Id.* § 107(4). See, e.g., *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539, 561 (1985); *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986).

making an analogy to copyright law, have stated that a parody defense can be applied to a right of publicity claim.<sup>194</sup>

### III. The Case: *White v. Samsung Electronics America*<sup>195</sup>

#### A. Facts

In *White v. Samsung Electronics America*,<sup>196</sup> Samsung Electronics America and its advertising agency, David Deutsch Associates, ran a series of advertisements in several national publications.<sup>197</sup> The common theme of these advertisements was that present Samsung products would still be in use in the twenty-first century.<sup>198</sup> The advertisements used the vehicles of humor, exaggeration, and popular culture to convey Samsung's message, and each displayed a different Samsung product.<sup>199</sup> For example, one advertisement showed the outrageous talk-show host Morton Downey, Jr. with the caption: "Presidential candidate. 2008 A.D."<sup>200</sup> Another advertisement poked fun at health-food enthusiasm by depicting raw steak with the caption: "Revealed to be health food. 2010 A.D."<sup>201</sup> The advertisement at issue in *White* depicted a robot wearing a gown, blond wig, and jewelry, standing next to a game board similar to that used on the *Wheel of Fortune* game show set.<sup>202</sup> The advertisement's caption read: "Longest running game show. 2012 A.D."<sup>203</sup>

The *Wheel of Fortune* game show is one of the most popular in television history and has an audience of about forty million viewers daily.<sup>204</sup> Vanna White, the popular hostess of the show, turns the letters of a game board like the one depicted in the

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194. See, e.g., MCCARTHY ON PUBLICITY, *supra* note 26, § 8.16(B)(5); Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97 (1993). See also *infra* part IV.D.

195. 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

196. *Id.*

197. *Id.* at 1396.

198. *Id.*

199. *Id.*

200. *Id.*

201. *Id.*

202. *Id.*

203. *Id.*

204. *Id.*

Samsung advertisement.<sup>205</sup> Unlike the other celebrities who appeared in the other Samsung advertisements, Vanna White was not paid for the advertisement.<sup>206</sup> However, the “[d]efendants referred to the ad as the ‘Vanna White’ ad.”<sup>207</sup>

### B. *Procedural History*

After the advertisement had been published, White sued both Samsung and Deutsch in the United States District Court for the Central District of California. She brought causes of action under California Civil Code section 3344, California common law right of publicity, and § 43(a) of the Lanham Act.<sup>208</sup> The defendants asserted a First Amendment defense and a “parody defense.”<sup>209</sup> The district court granted summary judgment against White on all causes of action.<sup>210</sup> White appealed to the United States Court of Appeals for the Ninth Circuit.<sup>211</sup>

### C. *Holding*

The court of appeals quickly disposed of White’s California Civil Code section 3344 claim, holding that the defendants had not used her “likeness” within the meaning of that term under

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205. *Id.* The *Wheel of Fortune* had a similarly attractive hostess prior to White’s tenure on the program. See Brief of Appellees at 3, *White v. Samsung Elecs. Am.*, 971 F.2d 1395 (9th Cir. 1992) (No. 90-55840) [hereinafter Brief of Defendant-Appellees].

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

207. *Id.*

208. *Id.* See generally Lanham Act § 43(a), 15 U.S.C. § 1125(a) (Supp. V 1993). Discussion of White’s Lanham Act claim is beyond the scope of this Note.

209. *White*, 971 F.2d at 1401. The defendants argued that although the depiction of the robot was contained in an advertisement and could be deemed commercial speech, it was still afforded “a large measure of protection under the First Amendment.” Brief of Defendant-Appellees, *supra* note 205, at 14 (citing *Board of Trustees v. Fox*, 492 U.S. 469 (1989); *U.S. Healthcare v. Blue Cross*, 898 F.2d 914 (3d Cir. 1990)). For further discussion of the commercial speech doctrine, see *infra* notes 296-98 and accompanying text.

The defendants also argued that their advertisement was afforded protection as a fair use parody. Brief of Defendant-Appellees, *supra* note 205, at 16 (citing *Elsmere Music v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980); *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990); *Columbia Pictures v. National Broadcasting Co.*, 137 F. Supp. 348, 354 (S.D. Cal. 1955)). See *supra* part II.F.3 for a discussion of fair use parody.

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

211. *Id.* at 1397.

section 3344.<sup>212</sup> The court reasoned that the defendants' advertisement featured a robot with mechanical features and "not, for example, a manikin molded to White's precise features."<sup>213</sup> The court found it unnecessary to decide how much of a resemblance would be needed to constitute a "likeness" under section 3344.<sup>214</sup> Consequently, the court affirmed the district court's dismissal of White's section 3344 claim.<sup>215</sup>

The court next examined White's common law right of publicity claim, applying the elements set out by the court in *Eastwood v. Superior Court*.<sup>216</sup> The *White* court noted that the district court had dismissed the common law claim for failure to satisfy the second element, the appropriation of the plaintiff's name or likeness to the defendant's advantage, since the defendants had not appropriated White's likeness in the robot advertisement.<sup>217</sup>

Although the court of appeals in *White* agreed that the defendants had not used White's likeness, it stated that the common law right of publicity is not confined only to appropriation of name or likeness.<sup>218</sup> The court reasoned that since the *Eastwood* case involved the use of photographs of the plaintiff, actor Clint Eastwood, the *Eastwood* court did not have the occasion "to consider the extent beyond the use of name or likeness to which the right of publicity reaches."<sup>219</sup> The *White* court noted that the *Eastwood* court had held that "the right of publicity 'may be' pleaded by alleging, *inter alia*, appropriation of name or likeness, not that the action may be pleaded only in those

212. *Id.* Likeness is not defined under § 3344. See generally CAL. CIV. CODE § 3344. See also *supra* part II.E for a discussion of § 3344.

213. *White*, 971 F.2d at 1397 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (holding that an imitation of entertainer Bette Midler's voice did not come within the definition of "likeness" under section 3344, since "likeness" meant visual image, not a vocal imitation)). See *supra* text accompanying notes 109-14 for a discussion of *Midler*.

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

215. *Id.*

216. *Id.* (citing *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983)). The elements for a common law right of publicity claim are: (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury. *Id.* (citing *Eastwood*, 198 Cal. Rptr. at 347).

217. *Id.*

218. *Id.*

219. *Id.*



terms.”<sup>220</sup> The *White* court concluded that the name or likeness formulation was simply “a description of the types of cases in which the cause of action had been recognized.”<sup>221</sup>

The *White* court stated that the notion that right of publicity claims are not limited to appropriations of name or likeness had its origin in William Prosser’s article, *Privacy*.<sup>222</sup> The court noted that although Prosser focused on appropriations of name or likeness in his article, he also stated that “[i]t is not impossible that there might be appropriation of the plaintiff’s identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy.”<sup>223</sup> The court then stated that Prosser’s statement had been borne out by the case law.<sup>224</sup>

The *White* court cited several cases to support its holding that common law right of publicity claims are not limited to appropriations of a person’s name or likeness. First, the court noted that in *Motschenbacher v. R.J. Reynolds Tobacco Co.*,<sup>225</sup> the plaintiff’s claim was permitted to go to the jury “[e]ven though the defendant had not appropriated the plaintiff’s name or likeness.”<sup>226</sup> The *White* court noted that the defendants in *Motschenbacher* had used a photograph of plaintiff’s race car in its advertisement and, although the defendant was actually driving the car in the photograph, his features were not visible.<sup>227</sup> Next, the *White* court noted that in *Midler v. Ford Motor Co.*,<sup>228</sup> plaintiff Bette Midler had stated a valid claim for violation of her right of publicity where the defendants had appropriated “part of her identity” by using a “sound-alike” singer to replicate her voice.<sup>229</sup> Finally, the *White* court noted that in

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220. *Id.*

221. *Id.*

222. *Id.* at 1397 (citing Prosser, *supra* note 31, at 401-07).

223. *Id.* at 1397-98 (quoting Prosser, *supra* note 31, at 401 n.155).

224. *Id.* at 1398 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Carson v. Here’s Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974)).

225. 498 F.2d 821 (9th Cir. 1974). *See supra* notes 90-105 and accompanying text.

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

227. *Id.*; *see Motschenbacher*, 498 F.2d at 822-23.

228. 849 F.2d 460 (9th Cir. 1988). *See supra* text accompanying notes 109-14.

229. *White*, 971 F.2d at 1398 (citing *Midler*, 849 F.2d at 463-64).

*Carson v. Here's Johnny Portable Toilets*,<sup>230</sup> entertainer Johnny Carson recovered for violation of his right of publicity where the phrase, "Here's Johnny," had been used without his permission on the defendant's portable toilets.<sup>231</sup>

The court in *White* concluded that these cases stood for the proposition that the common law right of publicity does not require that appropriations of identity be accomplished through only a "laundry list of specific means" to be actionable.<sup>232</sup> The court reasoned that if "the celebrity's identity is commercially exploited, there has been an invasion of his right [of publicity] whether or not his 'name or likeness' is used."<sup>233</sup> The court further reasoned that while the individual characteristics of the advertisement may not have implicated White's identity, when all of its aspects were viewed together, including the familiar game board and the robot dressed in female clothing, the advertisement could only have been designed to evoke the identity of Vanna White; thus, the defendants had appropriated her iden-

230. 698 F.2d 831 (6th Cir. 1983).

231. *White*, 971 F.2d at 1398 (citing *Carson*, 698 F.2d at 835-37). The *Carson* court reasoned that Carson's common law right of publicity had been violated because the phrase, "Here's Johnny," was clearly associated with Carson's identity. *Carson*, 698 F.2d at 836. The court noted that violation of the common law right of publicity may be accomplished by means other than the use of a name or likeness. *Id.* at 835. This rationale was similar to that used in *Motschenbacher*. See *id.*

Two cases on which the *Carson* court relied, *Ali v. Playgirl*, 447 F. Supp. 723 (S.D.N.Y. 1978) and *Hirsch v. S.C. Johnson & Son*, 280 N.W.2d 129 (Wis. 1979), were cases in which slogans or nicknames associated with famous persons were used in portraits or advertisements. In *Ali*, former heavyweight champion Muhammad Ali sued *Playgirl* magazine for, *inter alia*, violation of his common law right of publicity. *Ali*, 447 F. Supp. at 723. The defendants had published a photograph in which a nude African American man was seated on a stool in the corner of a boxing ring with the caption, "Mystery Man." An accompanying verse identified the man as "The Greatest," a phrase with which Ali had long been associated. *Ali*, 447 F. Supp. at 727.

The plaintiff in *Hirsch* was a famous football player known by the nickname "Crazy Legs." *Hirsch*, 280 N.W.2d at 129. The *Hirsch* court found that the plaintiff had stated a valid right of publicity claim where the defendants used the slogan, "Crazy Legs," for its shaving cream. *Id.* at 137. The court cited William Prosser's article, *Privacy*, for the proposition that "a stage or other fictitious name can be so identified with the plaintiff that he is entitled to protection against its use." *Id.* at 137 (citing Prosser, *supra* note 31, at 404).

The *Carson* court analogized its facts to *Ali* and *Hirsch*, and discussed at some length the fact that slogans or fictitious stage names, if wrongfully appropriated, could lead to violations of one's right of publicity. See *Carson*, 698 F.2d at 835-36.

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

233. *Id.* (quoting *Carson*, 698 F.2d at 835).

tity.<sup>234</sup> The court also noted a policy consideration underlying the right of publicity: protecting the celebrity's valuable commercial interest in his or her identity.<sup>235</sup>

Finally, the court focused on the defendants' parody defense.<sup>236</sup> The court began by distinguishing the cases cited by the defendant, *Hustler Magazine v. Falwell*,<sup>237</sup> and *L.L. Bean, Inc. v. Drake Publishers*.<sup>238</sup> The court held those cases inapplicable, reasoning that the parodies in those cases were for the purpose of poking fun at the respective plaintiffs, while in *White*, the parody was "only tangentially related to the ad's primary message: 'buy Samsung VCRs.'"<sup>239</sup> The court added that the defendants' parody arguments were "better addressed to non-commercial parodies."<sup>240</sup> In a footnote, the court reasoned that commercial advertising is different from other forms of expressive activity, when such advertising relies on a celebrity's fame.<sup>241</sup> The court stated that although some types of expressive activity, such as parody, evoke a person's identity, the First Amendment bars most right of publicity actions in noncommercial cases.<sup>242</sup> In the case of commercial advertising, however, "the First Amendment hurdle is not so high."<sup>243</sup> The court noted

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234. *Id.* at 1399. The court also presented a hypothetical to support its conclusion that White's right of publicity was violated. The court envisioned an advertisement depicting a mechanical robot with male features, a bald head, and an African American complexion. *Id.* The robot wears "Air Jordan" sneakers, a uniform similar in color to that of the Chicago Bulls basketball team, and former Chicago Bulls basketball star Michael Jordan's jersey number 23. *Id.* In the hypothetical advertisement, the robot performs basketball stunts characteristic of Michael Jordan. *Id.* The court concluded that when all of the various aspects of the advertisement were viewed together, it was clear that the advertisement was "about Michael Jordan." *Id.* The court then analogized this hypothetical advertisement to the advertisement of defendants Samsung and Deutsch, concluding that the defendants' advertisement was "meant to depict" Vanna White. *Id.*

235. *Id.* at 1398.

236. *Id.* at 1401.

237. 485 U.S. 46, 56-57 (1988) (barring the plaintiff's intentional infliction of emotional distress and libel claims on First Amendment grounds, where defendant's national magazine published a cartoon parody of plaintiff).

238. 811 F.2d 26, 30 (1st Cir. 1987) (finding that an injunction preventing continued distribution of a parody of plaintiff's catalogue, contained in defendant's magazine, was "constitutionally impermissible").

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

240. *Id.*

241. *Id.* at 1401 n.3.

242. *Id.*

243. *Id.*

that not all right of publicity actions are barred by the First Amendment.<sup>244</sup> The court concluded that White's common law right of publicity claim could be submitted to the jury.<sup>245</sup>

#### D. *The Dissent*

Judge Alarcon dissented with respect to the majority's disposition of the common law right of publicity and Lanham Act claims.<sup>246</sup> He concurred in the majority's disposition of White's claim under California Civil Code section 3344.<sup>247</sup>

The dissent began with a discussion of the majority's disposition of the common law right of publicity claim, stating that no holding of a California court had ever authorized recovery for appropriation of a person's "identity."<sup>248</sup> Judge Alarcon noted that the California cases all required proof of appropriation of a name or likeness.<sup>249</sup> He criticized the two main reasons on which the majority had rested its "innovative extension" of the California common law right of publicity.<sup>250</sup>

First, Judge Alarcon took issue with the majority's conclusion that the elements of the common law right of publicity cause of action are permissive rather than mandatory.<sup>251</sup> He pointed out that the *Eastwood* decision, on which the majority based this conclusion, had discussed the differences between the common law right of publicity and the statutory remedy under California Civil Code section 3344, but had not included among those differences appropriations of identity by means

244. *Id.* (citing *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)). See *supra* text accompanying notes 173-75 for a discussion of *Zacchini*.

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

246. *Id.* (Alarcon, J., dissenting).

247. *Id.*

248. *Id.*

249. *Id.* (citing *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 457 (Cal. 1979) (permitting the use of the name, Rudolph Valentino, in a fictional biography), see *supra* text accompanying notes 146-49 for a discussion of *Guglielmi*; *In re Weingand*, 41 Cal. Rptr. 778 (Cal. Ct. App. 1964), see *supra* note 89 for a discussion of *Weingand*; *Fairfield v. American Photocopy Equip. Co.*, 291 P.2d 194 (Cal. Ct. App. 1955); see *supra* notes 55-56 and accompanying text for a discussion of *Fairfield*; *Gill v. Curtis Publishing Co.*, 239 P.2d 630, 632-33, 635 (Cal. 1952) (holding that a magazine's use of a couple's photograph without consent constituted invasion of privacy and depiction of the couple in a false light in the public eye)).

250. *Id.* (Alarcon, J., dissenting).

251. *Id.* See *supra* notes 218-35 and accompanying text.

other than name or likeness.<sup>252</sup> Second, Judge Alarcon criticized the majority's interpretation of Prosser's statement that the right of publicity is not limited to appropriations of name or likeness, reemphasizing that California courts had never found such an infringement without the use of a plaintiff's name or likeness.<sup>253</sup> He concluded that these two reasons were "slender reeds" on which a federal court should base its extension of state law.<sup>254</sup>

The dissent also criticized the majority's interpretation of federal case law, noting that in *Motschenbacher*, *Midler*, and *Carson*, "the advertisement[s] affirmatively represented that the person depicted therein was the plaintiff,"<sup>255</sup> whereas in *White*, no affirmative representations had been made by Samsung.<sup>256</sup> The rule that the dissent drew from these cases was that "where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an advertisement, a triable issue of fact had been raised as to whether his or her identity [was] appropriated."<sup>257</sup> However, in this case, it was clear that a robot, and not Vanna White, was depicted.<sup>258</sup>

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252. *White*, 971 F.2d at 1403 (Alarcon, J., dissenting). See *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983).

The dissent examined the legislative history of section 3344, noting that it was amended ten years after *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), cited in *White*, 971 F.2d at 1403 (Alarcon, J., dissenting). See also Act of Sept. 30, 1984, ch. 1704, § 2, 1984 Cal. Laws 6172. The dissent stated that in amending the statute, the legislature added only protections of voice and signature to the methods of appropriation listed in the statute and did not add appropriation of identity. *White*, 971 F.2d at 1403 (Alarcon, J., dissenting). See *supra* part II.E for a discussion of CAL. CIV. CODE § 3344. The dissent concluded that the California Legislature had, therefore, "specifically contemplated protection for interests other than name or likeness . . . but wished to limit [commercial appropriation actions] to enumerated attributes." *White*, 971 F.2d at 1403 (Alarcon, J., dissenting).

253. *White*, 971 F.2d at 1403 (Alarcon, J., dissenting).

254. *Id.*

255. *Id.* at 1403-04 (Alarcon, J., dissenting) (citing *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), see *supra* text accompanying notes 109-14 for a discussion of *Midler*; *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983), see *supra* notes 230-31 and accompanying text for a discussion of *Carson*; *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), see *supra* text accompanying notes 90-105 for a discussion of *Motschenbacher*).

256. *White*, 971 F.2d at 1404 (Alarcon, J., dissenting).

257. *Id.*

258. *Id.*

Further, the dissent criticized the majority's reasoning that the attributes of the advertisement depicted Vanna White when viewed together, reasoning that the majority had confused White with the role she assumed on the game show.<sup>259</sup> The dissent argued that there is a distinction between the performer and the part he or she plays, and this distinction was essential for a proper analysis of the facts of this case.<sup>260</sup> The dissent reasoned that the wig, dress, and jewelry were not unique characteristics of Vanna White but quite common among actresses.<sup>261</sup> In addition, the only element in the advertisement that was not common among other female performers was the *Wheel of Fortune* set, which was not part of White's identity, but merely "a prop with which she interacts in her role as the current hostess" of the show.<sup>262</sup> The dissent noted, hypothetically, that if another female with similar physical characteristics appeared on the set as hostess, White would probably be preempted by federal law from initiating a right of publicity suit against her, since White does not own the copyright to the show itself.<sup>263</sup> The dissent stated that "the fact that a performer has become famous for playing a particular role has, until now, never been sufficient to give the performer a proprietary interest in it."<sup>264</sup>

Finally, the dissent argued that the majority had given the defendants' parody defense "short shrift" merely because the case involved a commercial advertisement.<sup>265</sup> The dissent argued that the cases cited by the defendants, *Hustler Magazine v. Falwell*<sup>266</sup> and *L.L. Bean, Inc. v. Drake Publishers*,<sup>267</sup> could not be so easily dismissed, since in those cases, the

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259. *Id.*

260. *Id.* (citing *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775, 1777-78 (C.D. Cal. 1989) (distinguishing between performer and role)). See *supra* text accompanying notes 115-32 for a discussion of *Nurmi*.

261. *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

262. *Id.*

263. *Id.* See *supra* notes 163-81 and accompanying text for a discussion of federal preemption of state intellectual property law by the Copyright Act.

264. *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

265. *Id.* at 1407.

266. 485 U.S. 46, 56-57 (1988) (barring the plaintiff's intentional infliction of emotional distress and libel claims on First Amendment grounds, where defendant's national magazine published a cartoon parody of plaintiff).

267. 811 F.2d 26, 30 (1st Cir. 1987) (finding that an injunction preventing continued distribution of a parody of plaintiff's catalogue, contained in defendant's magazine, was "constitutionally impermissible").

defendants, who were selling magazines, pursued a "purely commercial purpose," just as the defendants did in *White*.<sup>268</sup> The dissent concluded that the majority's holding would allow any famous person to bring an action where any commercial advertisement depicts a character or role performed by the plaintiff.<sup>269</sup>

E. *Dissenting Opinion of Judge Kozinski from the Order Rejecting the Suggestion for Rehearing En Banc*

In a unanimous decision, a three-judge panel of the Ninth Circuit voted to deny the defendants' petition for rehearing.<sup>270</sup> This was the same panel which had originally heard the case.<sup>271</sup> In addition, a nine-judge panel, in a six-to-three decision, rejected the suggestion for rehearing en banc.<sup>272</sup> Judge Kozinski dissented from the order rejecting the suggestion for rehearing en banc and was joined by Judges O'Scannlain and Kleinfeld.<sup>273</sup>

Judge Kozinski discussed, largely from a policy standpoint, the negative implications of the majority's holding, asserting that it unjustifiably expanded the right of publicity, conflicted with federal copyright law, raised First Amendment problems, and was generally "bad law."<sup>274</sup> The dissent contended that under the majority's holding, "it's now a tort . . . to remind the public of a celebrity . . . [and to] simply . . . evoke the celebrity's image in the public's mind."<sup>275</sup> The dissent stated that the majority had created a new and much broader property right under California law and questioned whether the case law supported

268. *White*, 971 F.2d at 1407 (Alarcon, J., dissenting) (citing *Falwell*, 485 U.S. at 47; *L.L. Bean*, 811 F.2d at 27).

269. *Id.* The dissent discussed several hypothetical examples of this proposition: Gene Autry could sue any performer portraying a singing cowboy, Clint Eastwood could sue any performer playing a tall, soft-spoken cowboy, and Sylvester Stallone could sue any performer portraying a blue collar boxer. *Id.*

270. *White v. Samsung Elecs. Am.*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

271. Judges Goodwin, Pregerson, and Alarcon comprised the Ninth Circuit panel that originally heard the case. *See White*, 971 F.2d at 1395. Note that Judge Alarcon dissented in the original case, but voted to deny the rehearing. *See id.* at 1402 (Alarcon, J., dissenting).

272. *White*, 989 F.2d at 1512.

273. *Id.* (Kozinski, J., dissenting).

274. *Id.* at 1514.

275. *Id.* Judge Kozinski opined that such a doctrine was "Orwellian." *Id.*

such a holding.<sup>276</sup> Judge Kozinski asserted, as had the dissent in the original case, that the *Wheel of Fortune* set, and not the robot's "attire," was what evoked White's image.<sup>277</sup> He argued that the right of publicity should not extend its protection beyond a celebrity's specific physical characteristics.<sup>278</sup> However, the majority's ruling had gone well beyond the protection of specific physical characteristics and created in celebrities a right of publicity in the role they play.<sup>279</sup> He reasoned that since the majority's holding was overbroad and contained no limitations, such as the traditional, essential intellectual property limitations of fair use or parody, vague claims of "appropriation of identity" would be brought by plaintiffs, and creativity would be curtailed by fear of litigation from such claims.<sup>280</sup>

Judge Kozinski also argued that the majority's overly-broad right of publicity conflicted with the Copyright Act because it would reduce the value of licenses which copyright owners might grant to others.<sup>281</sup> For example, after *White*, if the owner of a copyrighted work, such as a movie, granted a license to another to make a certain use of the copyrighted work, the licensee might be subjected to right of publicity claims from actors who appeared in the copyrighted work.<sup>282</sup>

Next, Judge Kozinski stated that the majority's holding directly conflicted with the Copyright Act by failing to recognize a parody exception to the right of publicity.<sup>283</sup> He reasoned that since the advertisement did not simply parody Vanna White, but parodied her appearing in the *Wheel of Fortune*, a copyrighted television show, a parody exception should have been

276. *Id.* at 1515 (Kozinski, J., dissenting).

277. *Id.*; see *White*, 971 F.2d at 1404 (Alarcon, J., dissenting). See generally *supra* text accompanying notes 261-62.

278. *White*, 989 F.2d at 1515 n.18 (Kozinski, J., dissenting).

279. *Id.* (Kozinski, J., dissenting). See *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775, 1777-78 (C.D. Cal. 1989); see also *supra* text accompanying notes 115-32 for a discussion of *Nurmi*. The plaintiff in *White* attempted to distinguish *Nurmi* because *Nurmi* involved fictional characters, while *White* involved a real person. Brief of Appellant Vanna White at 14-15, *White v. Samsung Elecs. Am.*, 971 F.2d 1395 (9th Cir. 1992) (No. 90-55840).

280. *White*, 989 F.2d at 1516 (Kozinski, J., dissenting).

281. *Id.* at 1518. See also Felix H. Kent, *Vanna Keeps Her Fortune*, N.Y. L.J. June 18, 1993, at 3.

282. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

283. *Id.* at 1517. See *supra* part II.F.3 for a discussion of parody.



recognized, since parodies of copyrighted works are permitted under federal law.<sup>284</sup> The dissent added that the Act covers subject matter "fixed in any tangible medium of expression," and White's identity "consists entirely of her [look and] appearances in a fixed, copyrighted TV show."<sup>285</sup>

In addition, Judge Kozinski asserted that the majority's overly-broad right of publicity would conflict with the Copyright Clause of the United States Constitution<sup>286</sup> through the application of the domicile choice of law principle.<sup>287</sup> Domicile is a choice of law principle in which the substantive law of the state where the plaintiff is domiciled is applied to adjudicate a claim.<sup>288</sup> The dissent's argument provided that if an out-of-state defendant created an advertisement using a California domiciliary's name or likeness, a California court, in which the California domiciliary brought the right of publicity claim, would employ the domicile choice of law principle.<sup>289</sup> This would result in California right of publicity law being applied to adjudicate the claim.<sup>290</sup> The out-of-state defendant would be subject to California's right of publicity law even if the advertisement was permitted under the law of the state in which the

284. *White*, 989 F.2d at 1517 (Kozinski, J., dissenting).

285. *Id.* at 1518 n.26. See *supra* part II.F.2 for a discussion of the Copyright Act.

286. See *supra* note 156 for the text of the Copyright Clause.

287. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

288. See Kent, *supra* note 281, at 3; MCCARTHY ON PUBLICITY, *supra* note 18, § 11.3(A), (D)(1-3).

A federal district court sitting in diversity must apply the choice of law principles of the forum state in which it sits. JACK H. FRIEDENTHAL ET AL., CIVIL PROCEDURE § 4.5, at 213 (1985) (citing *Klaxon Co. v. Stentor Elec. Mfg. Co.*, 313 U.S. 487 (1941); *Griffin v. McCoach*, 313 U.S. 498 (1941)). Thus, a federal district court in California, sitting in diversity, must apply California's choice of law principles to determine which state's law should be used in deciding the claim. *Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538, 1540 (11th Cir. 1983). Although this proposition seems well settled, *see id.*, it appears that there is much uncertainty as to what particular choice of law principle the forum state will apply, as there may be several. See MCCARTHY ON PUBLICITY, *supra* note 26, § 11.3(A) (citing WILLIAM M. RICHMAN & WILLIAM L. REYNOLDS, UNDERSTANDING CONFLICT OF LAWS § 70(a) (1984)). Choice of law principles include, *inter alia*, "the law of the place of infringement," "the law of the forum," "the law of the situs of the property," and "the law of the plaintiff's domicile." See MCCARTHY ON PUBLICITY, *supra* note 26, § 11.3(A)(and synopsis), (D)(1-3).

289. See *White*, 989 F.2d at 1518 (Kozinski, J., dissenting); *see also* Kent, *supra* note 281, at 3.

290. See *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

creator resided and was even if the advertisement never shown in California.<sup>291</sup> Even when the litigation was in the out-of-state defendant's forum state, if the court employed the domicile choice of law principle, California's broad right of publicity law would be applied to adjudicate the claim.<sup>292</sup>

The dissent noted that "under the . . . Copyright Clause a state's intellectual property laws can stand only so long as they do not 'prejudice the interests of other states.'"<sup>293</sup> Here, since California's right of publicity could be applied to out-of-state defendants in forums other than California, and since the right of publicity law of these other forums may not be as broad as California's, the interests of these other states may indeed be prejudiced.<sup>294</sup>

291. *Id.* at 1518-19 (Kozinski, J., dissenting).

292. *See Acme*, 711 F.2d at 1540.

293. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting) (quoting Goldstein v. California, 412 U.S. 546, 558 (1973)).

294. *See id.* at 1518-19 (Kozinski, J., dissenting); *see also Kent*, *supra* note 281, at 3. The dissent noted that "[t]he broader and more ill-defined a particular state's right of publicity law is, the more it interferes with the legitimate interests of other states." *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

In support of his "domicile argument," Judge Kozinski cited *Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538 (11th Cir. 1983). *See White*, 989 F.2d at 1518 (Kozinski, J., dissenting). Commentator Felix H. Kent, in his article discussing the *White* case, made a similar "domicile argument," also citing *Acme*. *See Kent*, *supra* note 281.

*Acme* involved a question of whether the right of publicity survived the death of a celebrity. *Acme*, 711 F.2d at 1539. The *Acme* court stated that the question was whether such a right existed at all, and that this question was one of personal property law. *Id.* at 1541. The federal court in *Acme* applied California choice of law principles and stated that California applies the law of the domicile to questions of personal property law. *Id.* Thus, California right of publicity law was applied. *Id.*

The *Acme* court distinguished the question of whether the right of publicity existed, as in the case before it, from the question of whether such right had been infringed. *Id.* at 1541 & n.1. The court noted that whether the right of publicity had been infringed was not a question of personal property law, but of tort or contract law. *Id.* at 1541 n.1. The court stated that under California choice of law principles, cases involving infringement do not require application of the domicile choice of law principle, but of the "governmental interests analysis" theory. *Id.* at 1541 & n.1. Since the domicile principle is not applied, California right of publicity law may not necessarily be applied. *See id.*; *see also Joplin Enters. v. Allen*, 795 F. Supp. 349, 350-51 (D. Wash. 1992) (stating that Washington courts would apply "the law of the state having the most significant relationship to [the dispute to] determine whether [the right of publicity] ha[d] been tortiously infringed") (citing *Bush v. O'Connor*, 791 P.2d 915, 918 (Wash. Ct. App. 1990)).

Finally, Judge Kozinski discussed the First Amendment aspects of the majority's holding.<sup>295</sup> As did the dissent in the original opinion, Judge Kozinski disagreed with the majority's view that because the advertisement was commercial speech, it was undeserving of First Amendment protection.<sup>296</sup> The dissent asserted that the majority ignored the *Central Hudson* test, which the dissent stated the Supreme Court had established to prevent lower courts from giving "short shrift"<sup>297</sup> to commercial speech in First Amendment contexts.<sup>298</sup>

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All of the most noted cases applying the domicile conflict of law principle have been post-mortem right of publicity cases, deciding whether the right existed and not whether it had been infringed. See, e.g., *Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538 (11th Cir. 1983); *Groucho Marx Prods. v. Day and Night Co.*, 689 F.2d 317 (2d Cir. 1982); *Factors Etc. v. Pro Arts*, 652 F.2d 278 (2d Cir. 1981), cert. denied, 456 U.S. 927 (1982); *Joplin Enters. v. Allen*, 795 F. Supp. 349 (D. Wash. 1992), cited in MCCARTHY ON PUBLICITY, supra note 26, § 11.3(D)(3); *South-east Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985).

295. *White*, 989 F.2d at 1519 (Kozinski, J., dissenting).

296. *Id.* See *White*, 971 F.2d at 1407-08 (Alarcon, J., dissenting).

297. *White*, 989 F.2d at 1520 (Kozinski, J., dissenting).

298. *Id.* (Kozinski, J., dissenting) (citing *Central Hudson Gas & Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557 (1980)). In *Central Hudson*, the Supreme Court held that the First Amendment protects commercial speech from unwarranted governmental regulation, although this protection may not be as great as with other constitutionally protected modes of expression. *Id.* at 563. The Court developed a four-step test to be applied in commercial speech cases in order to balance the interests of the state and the speaker. *Id.* at 566. First, the court determines whether the expression is protected by the First Amendment. *Id.* at 564. "For commercial speech to come within that protection it must at least concern lawful activity and not be misleading." *Id.* Second, the court determines "whether the asserted governmental interest to be served by the restriction on commercial speech is substantial." *Id.* "If both inquiries yield positive answers, [the court] must then decide whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest." *Id.* In *White*, Judge Kozinski chastised the majority for not applying the *Central Hudson* test, stating that the court "shouldn't thumb [its] nose at the Supreme Court by just refusing to apply its test." *White*, 989 F.2d at 1521 (Kozinski, J., dissenting).

The *Central Hudson* case is part of a large body of Supreme Court law involving state statutory restrictions on commercial speech. See *U.S. Healthcare v. Blue Cross*, 898 F.2d 914, 933 n.23 (3d Cir.) (citing *Posadas de Puerto Rico Assocs. v. Tourism Co.*, 478 U.S. 328 (1986); *Zauder v. Office of Disciplinary Counsel*, 471 U.S. 626 (1983); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983); *In re R.M.J.*, 455 U.S. 191 (1982); *Metromedia v. City of San Diego*, 453 U.S. 490 (1981); *Friedman v. Rogers*, 440 U.S. 1 (1979); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447 (1978); *Bates v. State Bar of Ariz.*, 433 U.S. 350 (1977); *Virginia Pharmacy Bd. v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976); *Pittsburgh Press v.*

## IV. Analysis

The defendants' advertisement in the *White* case may conjure up the image of Vanna White in the mind of many who are familiar with her and the game show of which she is a part, and it is certainly conceivable that one's initial reaction upon viewing the advertisement might be to proclaim that White's likeness was appropriated. Nevertheless, closer examination of prior right of publicity case law reveals that the *White* court's decision expanded the boundaries of what constitutes appropriation of a celebrity's common law right of publicity in California. Although this expansion is most likely favored by celebrities, it has several negative consequences that outweigh any benefits of increased protection of celebrities' publicity rights.

The following analysis first examines the *White* court's disposition of Vanna White's claim under California Civil Code section 3344 and concludes that the court properly affirmed the district court's dismissal of this claim. Second, the court's disposition of White's common law right of publicity claim is criticized because the court improperly expanded the common law right of publicity in California. The negative effects of this expanded right of publicity are also examined. Next, it is asserted that the court provided inadequate analysis in addressing the defendants' First Amendment defense. In addition, it is asserted that the court erred in not providing for a parody defense to right of publicity claims. Further, the argument is made that White's common law right of publicity claim should have been preempted by the Copyright Act. Finally, the dissent's applica-

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Pittsburgh Comm'n on Human Relations, 413 U.S. 376 (1973); *Valentine v. Christensen*, 316 U.S. 52 (1942)), *cert. denied*, 498 U.S. 816 (1990); *see also* *City of Cincinnati v. Discovery Network*, 113 S. Ct. 1505 (1993); *Board of Trustees v. Fox*, 492 U.S. 469 (1989).

Although the line of commercial speech cases leading up to and following *Central Hudson* dealt with state regulation of speech through various statutory schemes, the court in *U.S. Healthcare* stated that the doctrine, which created a subordinate standard of First Amendment protection for commercial speech, "is not confined to the government regulation line of cases." *U.S. Healthcare*, 898 F.2d at 932. *U.S. Healthcare* discussed *Central Hudson* in the context of a defamation claim stemming from an advertisement. *Id.* at 936-37. However, except for the dissent in *White*, there appear to be no right of publicity cases involving First Amendment concerns that discuss the *Central Hudson* test or recommend applying it in such cases.

tion of the "domicile" choice of law principle to right of publicity claims is criticized.

### A. *The Court Properly Decided the Section 3344 Claim*

The majority's decision regarding White's claim under California Civil Code section 3344 was a sound one. Indeed, the one issue on which the majority and the two dissents agreed was whether White's likeness had been appropriated for advertising purposes under section 3344(a).<sup>299</sup> The majority in *White* held that since the defendants had "used a robot with mechanical features and not, for example, a manikin molded to White's precise features," they had not appropriated her "likeness" under the statute.<sup>300</sup> The court noted that the term "'likeness' refers to a visual image,"<sup>301</sup> and since the visual image was not White's, but that of a robot, the section 3344 claim was properly rejected by the district court.<sup>302</sup>

In reaching its conclusion on the section 3344 claim, the majority simply reasoned that "the robot . . . [in the advertisement] was not White's 'likeness' within the meaning of section 3344."<sup>303</sup> The court provided no purpose or policy reasons for its decision.<sup>304</sup> Although the court cited *Midler v. Ford Motor Co.*,<sup>305</sup> the facts of *Midler* are inapposite to *White*;<sup>306</sup> the majority merely cited *Midler* for the proposition that the term, "like-

299. CAL. CIV. CODE § 3344(a) (West Supp. 1994); see *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1397 (9th Cir. 1992); *id.* at 1402 (Alarcon, J., dissenting); *White v. Samsung Elecs. Am.*, 989 F.2d 1512, 1514 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 113 S. Ct. 2443 (1993). See also *supra* part II.E for a discussion of CAL. CIV. CODE § 3344.

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

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

302. *Id.*

303. *Id.*

304. See *id.*

305. 849 F.2d 460 (9th Cir. 1988).

306. The defendants in *Midler* employed a "sound-alike" singer to imitate entertainer Bette Midler's distinctive singing voice in a television advertisement. *Id.* at 461. Many who heard the commercial thought that Midler was actually singing because it "sounded exactly" like one of Midler's recordings. *Id.* at 461-63. See also *supra* text accompanying notes 109-14 for a discussion of *Midler*. In contrast, the defendants in *White* used a robot dressed like a woman, and not, for example, a Vanna White "look-alike." See *White*, 971 F.2d at 1397. Indeed, there was no evidence that viewers of the advertisement mistook the robot for Vanna White. See *supra* part III.A for a discussion of the facts of *White*.

ness," does not refer to a "vocal imitation," but to a "visual image."<sup>307</sup>

Notwithstanding its lack of reasoning, the court's conclusion regarding White's section 3344 claim was correct for two reasons. First, it was supported by a plain meaning analysis of the term, "likeness." "Likeness" is defined as a "[r]esemblance to another. . . . An imitative appearance: semblance. . . . An artistic representation: image."<sup>308</sup> The robot dressed in a gown, wig, and jewelry was not a "resemblance," an "imitative appearance," a "semblance," an "artistic representation," or an "image" of Vanna White. It was simply a robot dressed in women's clothes. The defendants did not imitate Vanna White.

Second, the court's decision on this issue is in accord with the only other case to interpret the term, "likeness," under section 3344: *Nurmi v. Peterson*.<sup>309</sup> *Nurmi* held that the term, "likeness," in civil code section 3344 "means an actual representation of a person, rather than a close resemblance."<sup>310</sup> Under this standard, the robot in *White* would not be Vanna White's "likeness" since it was not an "actual representation" of her.

#### B. *The Majority Improperly Decided the Common Law Right of Publicity Claim*

The majority's decision regarding Vanna White's common law right of publicity claim was not as sound as its decision regarding her section 3344 claim. The *White* court held that common law right of publicity claims are not confined to appropriations of a person's name or likeness but could arise by other means as well.<sup>311</sup> While it is conceivable that the common law right of publicity could extend beyond appropriations of name or likeness,<sup>312</sup> as discussed below, there must be limits on

307. *White*, 971 F.2d at 1397 (citing *Midler*, 849 F.2d at 463).

308. WEBSTER'S II NEW RIVERSIDE UNIVERSITY DICTIONARY 693 (1988).

309. 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989). See *supra* text accompanying notes 115-32 for a discussion of *Nurmi*. The majority opinion in *White* did not cite *Nurmi*.

310. *Nurmi*, 10 U.S.P.Q.2d at 1777. The *Nurmi* court also noted that the California Supreme Court had employed the term, "likeness," to mean "an exact copy of another's features and not merely a suggestive resemblance." *Id.* (citing *Lugosi v. Universal Pictures*, 603 P.2d 425, 427, 431 (1979)).

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

312. Expansion of common law right of publicity claims beyond name or likeness is supported by the language of § 3344 and case law. Section 3344(g) states

how far such a doctrine is extended. Unfortunately, the *White* decision extended the common law right of publicity well beyond what was supported by case law and sound jurisprudence.

First, the majority overlooked *Nurmi v. Peterson*,<sup>313</sup> which is remarkably similar to *White*.<sup>314</sup> In *Nurmi*, the plaintiff alleged that the defendant's "Elvira" character appropriated the plaintiff's likeness in her "Vampira" character.<sup>315</sup> The *Nurmi* court held that since the plaintiff did not allege that her "actual features were used by the defendants for commercial purposes,"<sup>316</sup> her common law right of publicity claim failed.<sup>317</sup> The *Nurmi* court found that neither of the cases cited by the plaintiff, *Midler v. Ford Motor Co.*<sup>318</sup> and *Chaplin v. Amador*,<sup>319</sup> supported the proposition that a right of publicity claim could be brought for "a person's use of a character that bears a mere resemblance to another . . ." <sup>320</sup> The *Nurmi* court reasoned that in both of these cases, the plaintiffs' claims were permitted to go forward only on fraud grounds and "not on right of privacy or publicity grounds."<sup>321</sup>

Under the analysis in *Nurmi*, *White's* common law right of publicity claim should have failed, since the defendants' robot was not a "resemblance" of Vanna White; nor did the defend-

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that its remedies are "cumulative and shall be in addition to any others provided for by law." CAL. CIV. CODE § 3344(g) (West Supp. 1994). This suggests that claims beyond the scope of the statute are possible. See MCCARTHY ON PUBLICITY, *supra* note 26, § 6.4(F)(8); Weinstein, *supra* note 134, at 432-33, 454-56. Case law also suggests such an interpretation of the statute. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974). See also *Lugosi v. Universal Pictures*, 603 P.2d 425, 443 n.23 (Cal. 1979) (Bird, C.J., dissenting).

313. 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989). See *supra* text accompanying notes 115-32 for a discussion of *Nurmi*. See also *White*, 971 F.2d 1395, 1404 (Alarcon, J., dissenting).

314. Since *Nurmi* was a district court case, it was not binding on the *White* court and would have served as merely persuasive authority.

315. *Nurmi*, 10 U.S.P.Q.2d at 1776.

316. *Id.* at 1778.

317. *Id.*

318. 849 F.2d 460 (9th Cir. 1988). See *supra* text accompanying notes 109-14 for a discussion of *Midler*.

319. 269 P. 544 (Cal. Ct. App. 1928). See *supra* text accompanying notes 128-29, 131-32 for a discussion of *Chaplin*.

320. *Nurmi*, 10 U.S.P.Q.2d at 1778.

321. *Id.* See *supra* text accompanying notes 115-32 for a discussion of *Nurmi*.

ants use White's "actual features."<sup>322</sup> The wig, gown, and jewelry that adorned the robot were not Vanna White's actual features, but features common to many women.<sup>323</sup> The one unique element of the advertisement which did evoke the image of Vanna White was the *Wheel of Fortune* set, but the set is the property of the show's owners and not an attribute of Vanna White.<sup>324</sup> Allowing recovery for imitating another person's clothes, props, and mannerisms would "freeze all rights" to these attributes with the first person to employ them, precisely the result the *Nurmi* court sought to avoid.<sup>325</sup> Moreover, it would create a property right<sup>326</sup> in the relatively common attributes that comprise a celebrity's personae. Such a result would stifle creativity, lead to more litigation, and upset the careful balance that has been struck by courts and legislatures between the rights of intellectual property owners to control their property's use and the rights of the public to have access to public domain ideas for the enrichment of society.<sup>327</sup>

Second, the majority in *White* confused the issue of whether the common law right of publicity can be violated by means other than appropriation of name or likeness with the issue of whether, in a particular case, there has been an actual infringement of a person's right of publicity. Indeed, the majority explicitly stated that "the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity."<sup>328</sup> This language demonstrates that the court combined the issue of the means of appropriation and the issue of whether there was actual infringement or appropriation of the right of publicity. This confusion is untenable, since under the formulation set out in *Eastwood v. Superior Court*<sup>329</sup> the means of appropriation and the use of a

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322. See *Nurmi*, 10 U.S.P.Q.2d at 1778.

323. See *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

324. *Id.*

325. *Nurmi*, 10 U.S.P.Q.2d at 1777-78.

326. The right of publicity is considered a property right. See *supra* note 68 and accompanying text.

327. See *White*, 989 F.2d at 1515-17 (Kozinski, J., dissenting); *Nurmi*, 10 U.S.P.Q.2d at 1778.

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

329. 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983). See *supra* note 47 and accompanying text for a discussion of *Eastwood* and the elements of a common law right of publicity claim.



plaintiff's identity are separate elements of a common law right of publicity claim.<sup>330</sup> Moreover, as is demonstrated in the following paragraphs, the *White* court's analysis is devoid of any discussion as to why *White*'s common law right of publicity was infringed by the defendants' advertisement.

The *White* court relied on *Motschenbacher v. R.J. Reynolds Tobacco Co.*,<sup>331</sup> *Midler v. Ford Motor Co.*,<sup>332</sup> and *Carson v. Here's Johnny Portable Toilets*<sup>333</sup> for the proposition that recovery under the common law right of publicity is not limited to appropriations of one's name or likeness.<sup>334</sup> This proposition is not disputed. However, the court offered these cases solely for this proposition.<sup>335</sup> The court did not offer these cases as factually analogous to the *White* case in order to support its decision that *White*'s claim of infringement of her right of publicity could go to the jury.<sup>336</sup> In fact, the court offered no factually analogous authority to support its decision that Vanna *White*'s right of publicity was infringed.<sup>337</sup>

What the court did offer to support its decision was a hypothetical advertisement purporting to demonstrate that the defendants' advertisement violated *White*'s right of publicity.<sup>338</sup> In this hypothetical advertisement, a robot dressed like basketball star Michael Jordan performed basketball stunts for which Jordan is famous.<sup>339</sup> The court stated that if all of the various elements of this hypothetical advertisement were viewed together, it would be clear that the advertisement was "about

330. As provided by the *Eastwood* court, the first two elements of a common law claim for appropriation of name or likeness are: (1) the defendant's use of the plaintiff's identity; and (2) the appropriation of plaintiff's name or likeness. *Eastwood*, 198 Cal. Rptr. at 347.

331. 498 F.2d 821 (9th Cir. 1974). See *supra* text accompanying notes 90-105 for a discussion of *Motschenbacher*.

332. 849 F.2d 460 (9th Cir. 1988). See *supra* text accompanying notes 109-14 for a discussion of *Midler*.

333. 698 F.2d 831 (6th Cir. 1983). See *supra* notes 230-31 and accompanying text for a discussion of *Carson*.

334. *White*, 971 F.2d at 1397-98.

335. See *id.* at 1397-99.

336. See *id.*

337. See *id.*

338. *Id.* at 1399.

339. *Id.* See also *supra* note 234 for further description of the hypothetical advertisement.

Michael Jordan.”<sup>340</sup> The court then analogized this hypothetical advertisement to the “robot advertisement” of defendants Samsung and Deutsch, concluding that the defendants’ advertisement was “meant to depict” Vanna White.<sup>341</sup>

The court’s reliance on *Motschenbacher*, *Midler*, *Carson*, and the Michael Jordan hypothetical advertisement can be reduced to the following syllogism: The right of publicity can be violated by means other than the appropriation of a celebrity’s name or likeness; the defendants’ advertisement reminded viewers of Vanna White; therefore, the defendants violated White’s right of publicity. The assumption implicit in this syllogism is that reminding viewers of a celebrity violates that celebrity’s right of publicity. The cases and the hypothetical do not support this flawed logic.

From a policy standpoint, should an image in an advertisement that merely reminds viewers of a celebrity be actionable? Such a rule seems to be without parameters or guidelines, and without any legal principle for discerning the point at which summary judgment would be granted in favor of a defendant. As Judge Kozinski stated in his dissent, such a doctrine is “Orwellian.”<sup>342</sup>

If the court was, *sub silentio*, asserting that the facts of *Motschenbacher*,<sup>343</sup> *Midler*,<sup>344</sup> and *Carson*,<sup>345</sup> are analogous to *White* and therefore support White’s claim of infringement, the court was in error because these cases are distinguishable.<sup>346</sup>

In *Motschenbacher*, the Ninth Circuit held that the plaintiff race car driver’s claim could go to the jury since the defendant had appropriated the plaintiff’s “proprietary interest in his own identity.”<sup>347</sup> The court reasoned that although the plaintiff’s “likeness” was not discernible in the defendant’s advertisements, the distinctive decorations of the race car caused persons

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

341. *Id.*

342. *White*, 989 F.2d at 1514 (Kozinski, J., dissenting).

343. See *supra* text accompanying notes 92-96 for the facts of *Motschenbacher*.

344. See *supra* text accompanying note 110 for the facts of *Midler*.

345. See *supra* note 231 and accompanying text for the facts of *Carson*.

346. See *White*, 971 F.2d at 1403 (Alarcon, J., dissenting).

347. *Motschenbacher*, 498 F.2d at 825.

to think the car was the plaintiff's and to infer that the plaintiff was driving.<sup>348</sup>

There are only limited parallels between *Motschenbacher* and *White*. In *Motschenbacher*, attributes of the plaintiff's identity, namely, his distinctively decorated car, evoked the plaintiff's image in the minds of viewers.<sup>349</sup> In *White*, however, the *Wheel of Fortune* set, which may have reminded viewers of Vanna White, was not an attribute of Vanna White; rather, it was an attribute of the *Wheel of Fortune* game show.<sup>350</sup> Furthermore, in *Motschenbacher*, the plaintiff was actually driving his car,<sup>351</sup> while in *White*, the robot was clearly not Vanna White. Moreover, unlike *Motschenbacher*, the surrounding circumstances in the advertisement in *White* did not lead viewers to believe that the robot was actually Vanna White.

In *Midler*, the defendants created the false impression that entertainer Bette Midler was actually singing in the commercial by using a "sound-alike" singer.<sup>352</sup> However, in *White*, the defendants did not create the false impression that Vanna White was in the advertisement; they merely depicted a robot dressed in women's clothing on the *Wheel of Fortune* set,<sup>353</sup> which could not be mistaken for Vanna White.

In *Carson*, the defendant used the phrase, "Here's Johnny," on its portable toilets.<sup>354</sup> The court held that entertainer Johnny Carson's common law right of publicity had been vio-

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348. *Id.* at 827.

349. *Id.*

350. *See generally White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

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

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

353. The court in *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989), noted that in *Midler*, the plaintiff's claim was allowed to go forward because the defendants had deceived the public into believing that Midler actually sang in the advertisement. *Id.* at 1778 (citing *Midler*, 849 F.2d at 463-64); *see also* Robert M. Callagy and Gillian M. Lusins, *Commercial Speech and Private Rights*, in *FALSE ADVERTISING AND COMMERCIAL SPEECH* 1993 (PLI Corp. Law & Practice Course Handbook Series No. B4-7023, Feb.-Mar. 1993)). This notion of deception is also present in *Motschenbacher*. *See supra* text accompanying notes 90-105, 348 and accompanying text. The notion of deception is not, however, present in *White*.

Claims of false endorsement, that is, claims that the public will be deceived into thinking that Vanna White endorsed Samsung's products, should be brought under the Lanham Act § 43(a), 15 U.S.C. § 1125(a) (Supp. V 1993). *See White*, 989 F.2d at 1515 n.17 (Kozinski, J., dissenting).

354. *Carson*, 698 F.2d at 832-33.

lated, since the phrase, "Here's Johnny," was clearly associated with Carson's identity.<sup>355</sup> The court reasoned, similar to the reasoning in *Motschenbacher* and *Midler*, that violation of the common law right of publicity may be accomplished by means other than the use of name or likeness.<sup>356</sup>

Two cases upon which the *Carson* court greatly relied, *Ali v. Playgirl*<sup>357</sup> and *Hirsch v. S.C. Johnson & Son*,<sup>358</sup> were cases in which slogans or nicknames associated with famous persons were used in portraits or advertisements.<sup>359</sup> The *Carson* court analogized its facts to these cases<sup>360</sup> and devoted much discussion to the notion that slogans or fictitious stage names, if wrongfully appropriated, could lead to violations of one's right of publicity.<sup>361</sup> Thus, *Carson* stands primarily for the proposition that a slogan or name which is clearly identified with a well known celebrity, when wrongfully appropriated, may lead to a violation of the common law right of publicity. Unlike *Carson*, however, *White* did not involve use of a name or slogan of a celebrity. Therefore, *Carson* should not have been used by the *White* court to support the conclusion that Vanna White stated a valid claim for infringement of her right of publicity.

### C. *The Majority's First Amendment Analysis Was Inadequate*

The result reached by the *White* court with respect to the defendants' free speech argument<sup>362</sup> was correct; however, the court dismissed the defendants' First Amendment defense with little discussion. The lack of analysis on this issue is unfortunate.

The defendants in *White*, argued that although their advertisement was commercial speech, it was still afforded "a large

355. *Id.* at 836.

356. *Id.* at 835.

357. 447 F. Supp. 723 (S.D.N.Y. 1978).

358. 280 N.W.2d 129 (Wis. 1979).

359. See *supra* note 231 for a discussion of *Ali* and *Hirsch*.

360. See *Carson*, 698 F.2d at 835.

361. See *id.* at 835-36. The *Carson* court also cited William Prosser's article, *Privacy*, for the proposition that "a stage or other fictitious name can be so identified with the plaintiff that he can be so identified with its use." *Id.* at 836 (citing Prosser, *supra* note 31, at 404). The *Carson* court also cited Prosser's treatise on the law of torts for the proposition that a plaintiff's name may be a symbol of his identity. *Id.* at 836 & n.2 (citing KEETON ET AL., *supra* note 102, § 117, at 805).

362. See *White*, 971 F.2d at 1401 & n.3.

measure of protection" under the First Amendment.<sup>363</sup> The court dismissed this argument as "unavailing," reasoning that the type of speech involved was commercial,<sup>364</sup> and the level of First Amendment protection typically afforded commercial speech is low.<sup>365</sup>

In his dissent, Judge Kozinski asserted that the majority had dismissed the defendants' First Amendment argument too quickly because the speech was commercial.<sup>366</sup> Since *White* is now the law in the Ninth Circuit,<sup>367</sup> it would have been helpful for the majority to provide some discussion of the extent to which the First Amendment restrains the right of publicity. The majority merely stated in a footnote that "the First Amendment hurdle will bar most right of publicity actions"<sup>368</sup> against expressive activity which may evoke one's identity, such as parodies.<sup>369</sup> In the next sentence, the court stated that "the First Amendment hurdle is not [as] high" for commercial advertising as it may be for other types of speech.<sup>370</sup>

While it is true that the level of protection afforded commercial speech is lower than other forms of constitutionally protected speech,<sup>371</sup> commercial speech is, nevertheless, protected under the First Amendment.<sup>372</sup> In addition, commercial advertising can be expressive activity, as it was in *White*. Moreover, the Supreme Court has repeatedly recognized the important value of commercial speech.<sup>373</sup> Since commercial speech can be

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363. Brief of Defendant-Appellees, *supra* note 205, at 14 (citing Board of Trustees v. Fox, 492 U.S. 469 (1989); U.S. Healthcare v. Blue Cross, 898 F.2d 914 (3d Cir. 1990)). See *supra* text accompanying notes 242-44. See also *supra* notes 296-98 and accompanying text.

364. *White*, 971 F.2d at 1401 n.3.

365. *Id.* (citing Central Hudson Gas & Elec. v. Public Service Comm'n, 447 U.S. 557, 566 (1980)).

366. *White*, 989 F.2d at 1401 n.3.

367. The Supreme Court denied certiorari. *Samsung Elecs. Am. v. White*, 113 S. Ct. 2443 (1993).

368. *White*, 971 F.2d at 1401 n.3.

369. *Id.*

370. See *id.*

371. See *City of Cincinnati v. Discovery Network*, 113 S. Ct. 1505, 1512 (1993) (citing *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 455-56 (1978); *Central Hudson Gas & Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980)).

372. See *id.* and cases cited therein. See also *supra* note 298.

373. See *Discovery Network*, 113 S. Ct. at 1512 n.17 (stating that "significant societal interests are served by [commercial speech]") (citing *Bates v. State Bar of Ariz.*, 433 U.S. 350 (1977) (citing *Bigelow v. Virginia*, 421 U.S. 809 (1975); *FTC v.*

expressive and serve valid societal purposes, the First Amendment defense should not have been dismissed as summarily as it was in *White*; rather, the court should have provided some analysis as to the role First Amendment considerations play in right of publicity claims.

Section 3344(e) of the California Civil Code demonstrates that the California Legislature was concerned with balancing First Amendment considerations in right of publicity cases. Section 3344(e) provides that the use of a person's name, voice, signature, photograph, or likeness is not actionable "solely because the . . . use is commercially sponsored . . . . Rather, it shall be a question of fact whether or not the use . . . was so directly connected with the commercial sponsorship" as to be actionable.<sup>374</sup> This language suggests that the California Legislature considered at least a minimum level of First Amendment breathing room for commercial speech when it enacted this statute. The *White* court should have provided similar breathing room in the common law right of publicity doctrine.<sup>375</sup>

In his dissent, Judge Kozinski argued that the court should have applied the four factor test set out in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, in order to balance First Amendment concerns against the plaintiff's right of publicity.<sup>376</sup> While a balancing approach would have been the preferred approach to a First Amendment defense, there are two reasons why the majority in *White* probably did not apply the *Central Hudson* test. First, although *Central Hudson* and its progeny<sup>377</sup> afford protection to commercial speech, when the balancing test of *Central Hudson* is applied, commercial speech will receive less protection than non-commercial speech. Thus,

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Procter & Gamble, 386 U.S. 568, 603-04 (1967) (Harlan, J., concurring)); *Central Hudson*, 447 U.S. at 561-62 (stating that "[c]ommercial expression not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information").

374. CAL. CIV. CODE § 3344(e) (West Supp. 1994).

375. See Weinstein, *supra* note 134, at 453-54 (stating that the question of fact provided for in California Civil Code § 3344(e) also applies to common law claims).

376. *White*, 989 F.2d at 1519-20 (Kozinski, J., dissenting) (citing *Central Hudson*, 447 U.S. at 566). See *supra* note 298 for a discussion of the *Central Hudson* test.

377. See *supra* note 298 and cases cited therein.

the outcome of the court's decision on this point, even if it had applied the test, may not have differed.

Second, *Central Hudson* and its progeny were cases involving direct statutory regulation of commercial speech through government regulation.<sup>378</sup> The common law right of publicity claim in *White*, however, involved an action between two private parties to vindicate a private right, the residual effect of which may have been the curtailment of commercial speech. There is little authority for applying the *Central Hudson* analysis to non-statutory cases such as *White*.<sup>379</sup> Indeed, other right of publicity cases involving First Amendment issues do not mention *Central Hudson*.<sup>380</sup>

Moreover, a closer examination of the *Central Hudson* test<sup>381</sup> suggests that its language is not suitable for use with right of publicity claims. Under the first *Central Hudson* factor, the court must determine whether the expression is protected by the First Amendment.<sup>382</sup> For commercial speech to come within that protection it must concern lawful activity and not be misleading.<sup>383</sup> Under the second factor, the court must determine whether the restriction on commercial speech serves a substantial governmental interest.<sup>384</sup> If both inquiries yield positive answers, the court must then decide whether the regulation directly advances the governmental interest and whether it is more extensive than necessary to serve that interest.<sup>385</sup>

The language of this test is difficult to apply to the situation in *White* or other common law claims by private citizens for appropriation of the right of publicity. The elements of the test are phrased in terms of balancing statutory regulation of com-

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378. See *U.S. Healthcare v. Blue Cross*, 898 F.2d 914, 933 n.23 (3d Cir. 1990). See also *supra* note 298.

379. *U.S. Healthcare* may be the only case discussing *Central Hudson* in a non-statutory context. *U.S. Healthcare* involved a defamation claim stemming from an advertisement. See *U.S. Healthcare*, 898 F.2d at 936-37. See also *supra* note 298.

380. See, e.g., *New Kids on the Block v. News Am. Publishing*, 971 F.2d 302 (9th Cir. 1992); *Cher v. Forum Int'l*, 692 F.2d 634 (9th Cir. 1982); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983).

381. See *supra* note 298 for a discussion of the *Central Hudson* test.

382. *Central Hudson*, 447 U.S. at 564.

383. *Id.*

384. *Id.*

385. *Id.*

mercial speech against First Amendment rights. Since the *Central Hudson* test would not have been easily applied to the issues in *White*, Judge Kozinski was incorrect in chastising the majority for not doing so.<sup>386</sup>

#### D. *The Right of Publicity Should Have a Parody Defense*

The defendants in *White* argued that their advertisement should have been afforded protection as a fair use parody.<sup>387</sup> Judge Kozinski's dissent also argued that the majority's decision conflicted with the Copyright Act in failing to recognize a parody exception.<sup>388</sup> Judge Kozinski noted that the defendants had parodied a copyrighted work, the *Wheel of Fortune* television program, and that fair use parodies of copyrighted works are permitted under the Act.<sup>389</sup>

There are several probable reasons why the *White* court did not seriously consider a fair use parody defense. First, fair use parody is a defense to a claim of copyright infringement under the Copyright Act.<sup>390</sup> Since there was no claim of copyright infringement in *White*, there was no occasion to apply the fair use analysis as set out in the Act.<sup>391</sup>

A second probable reason is that the court did not desire to break new ground and establish a parody defense for right of publicity claims. There appear to be no right of publicity cases providing for a parody defense. Furthermore, even Judge Kozinski, who advocated such a defense, did not give any indication of how such an exception would operate;<sup>392</sup> he simply

386. *White*, 989 F.2d at 1520-21 (Kozinski, J., dissenting). Judge Kozinski stated that "the court shouldn't thumb its nose at the Supreme Court by . . . refusing to apply [the *Central Hudson*] test." *Id.* at 1521.

387. Brief of Defendant-Appellees, *supra* note 205, at 16 (citing *Columbia Pictures v. National Broadcasting Co.*, 137 F. Supp. 348, 354 (S.D. Cal. 1955); *Elsmere Music v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980); *Tin Pan Apple v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990)). See *White*, 989 F.2d at 1517; see also *supra* part II.F.3 for a discussion of parody and fair use.

388. *White*, 989 F.2d at 1517 (Kozinski, J., dissenting).

389. *Id.*

390. See, e.g., *Campbell v. Acuff-Rose Music*, 114 S. Ct. 1164 (1994); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978). See also *supra* notes 184-85 and accompanying text.

391. See 17 U.S.C. § 107 (1988).

392. See *White*, 989 F.2d at 1517-18 (Kozinski, J., dissenting).



stated that "I doubt even a name-and-likeness-only right of publicity can stand without a parody exception."<sup>393</sup>

Judge Kozinski was correct, however, in pointing out a conflict with the Copyright Act that may result from the *White* decision. He stated that a parodist who lawfully parodies a copyrighted work may be subject to a right of publicity claim from someone who appears in the work.<sup>394</sup> He gave an example where, based upon the court's decision in *White*, a parody of the motion picture *Star Wars*, which included the character Luke Skywalker, could be subject to a right of publicity claim from Mark Hamill, the actor who portrayed Luke Skywalker.<sup>395</sup> This conflict with the Copyright Act demonstrates the need for a parody defense for right of publicity claims. Moreover, the four fair use factors listed in the Copyright Act<sup>396</sup> would provide a sound analytical framework for a parody defense to right of publicity claims.

#### E. *The White Rule Reduces the Value of Copyrights*

There is an economic rationale for criticizing the decision in *White*: a right of publicity which is overly broad reduces the value of licenses which copyright owners may grant to others.<sup>397</sup> This is an argument advanced by both Judge Kozinski and Felix Kent.<sup>398</sup>

Suppose the owner of a copyrighted work, such as a movie, grants a license to another to make a certain use of that work. Under the *White* decision, the licensee could be subject to a right of publicity claim from actors who appear in the copyrighted work.<sup>399</sup> If the defendants in *White* had obtained a license from the owners of the *Wheel of Fortune* copyright, would the defendants still have been subject to a claim from Vanna White for "evoking her image"? Under the *White* decision, the answer may be "yes." Moreover, under *White*, Vanna White

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393. *Id.* at 1519.

394. *Id.* at 1517.

395. *Id.*

396. See 17 U.S.C. § 107. See also *supra* text accompanying notes 190-94.

397. See *supra* note 162 and accompanying text for a discussion of the exclusive rights under the Copyright Act.

398. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting); Kent, *supra* note 281, at 3.

399. See *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

could bring a right of publicity claim against her future replacement if he or she “evoked White’s image” in the minds of the public.<sup>400</sup> It is possible that fear of such claims will reduce the value of copyright licenses<sup>401</sup> or deter prospective licensees from obtaining licenses altogether.

F. *White’s Right of Publicity Claim Should Have Been Preempted by the Copyright Act*

A comparison of *White* with *Baltimore Orioles v. Major League Baseball Players Ass’n*<sup>402</sup> suggests that White’s right of publicity claim should have been preempted by the Copyright Act. In *Baltimore Orioles*, professional baseball players claimed that their rights of publicity in their game-time performances were wrongfully appropriated by the major league baseball clubs since broadcasts of these performances were made without their consent.<sup>403</sup> The Seventh Circuit Court of Appeals held that since the clubs held the copyright in the telecasts,<sup>404</sup> the telecasts “preempt[ed] the Players’ rights of publicity in their game-time performances.”<sup>405</sup> The court reasoned that the three-part test for preemption under the Copyright Act had been satisfied.<sup>406</sup>

First, the work in which White claimed a right was “fixed in a tangible medium of expression.”<sup>407</sup> White claimed a right in

400. See *id.* at 1516.

401. See Kent, *supra* note 281, at 3.

402. 805 F.2d 663 (7th Cir. 1986). See *supra* notes 176-81 and accompanying text for a discussion of *Baltimore Orioles*.

403. *Id.* at 674.

404. *Id.* at 668. The court stated that the telecasts were “fixed in a tangible form” and were “original works of authorship,” as required under § 102(a) of the Copyright Act. *Id.*; see 17 U.S.C. § 102(a) (1988 & Supp. V 1993). See also *supra* notes 158-61 and accompanying text.

405. *Baltimore Orioles*, 805 F.2d at 674.

406. *Id.* at 677. A right is preempted by the Copyright Act if: (1) the work in which the right is asserted is fixed in a tangible form; (2) the work in which the right is asserted comes within the subject matter of copyright under § 102 of the Act; and (3) the state right in question is equivalent to any of the exclusive rights granted in § 106 of the Act. *Id.* at 674, 676; see 17 U.S.C. § 301(a) (1988); see also GOLDSTEIN, *supra* note 156, at 773 (citing II GOLDSTEIN, *supra* note 178, § 15.2). See *supra* note 167 for the text of § 301(a); see also *supra* notes 178-81 and accompanying text.

407. Section 102 of the Copyright Act of 1976 provides copyright protection to “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102.

the "attributes of her identity," namely, the wig, gown, and jewelry which adorned the robot.<sup>408</sup> However, under *Nurmi v. Peterson*,<sup>409</sup> White should not have been able to claim these attributes as her own.<sup>410</sup> These are characteristics common to many women.<sup>411</sup> The *Wheel of Fortune* set is the only unique attribute of the advertisement that reminds viewers of White, and it is not White's intellectual property but the property of the owners of the *Wheel of Fortune* copyright.<sup>412</sup> The only aspect of the advertisement in which White could attempt to assert a right is the *Wheel of Fortune* set, which is fixed in a tangible form. Thus, the first element of the preemption test is satisfied. The second element is satisfied because the *Wheel of Fortune* comes within the subject matter of copyright as an audiovisual work.<sup>413</sup> Third, the right of publicity is equivalent to rights within the general scope of § 106 of the Act, since the right of publicity was violated by the exercise of such rights.<sup>414</sup> In *White*, exercising the right of performance or display of the *Wheel of Fortune* led to the violation of the right of publicity. In addition, since the rights under § 106 are subject to the fair use parody exception,<sup>415</sup> the exercise of the fair use parody exception also led to a violation of the right of publicity in *White*.<sup>416</sup>

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

409. 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989).

410. See *supra* text accompanying notes 115-32 for a discussion of *Nurmi*. See *supra* text accompanying notes 313-27 for an analysis of *Nurmi*. See also *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

411. *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

412. See *id.* at 1404.

413. See 17 U.S.C. § 102(a); see *supra* text accompanying note 161 for a discussion of the subject matter of copyright. See *supra* notes 163-81 for a discussion of preemption. See also note 180 and accompanying text for the application of the second element of the preemption test by the court in *Baltimore Orioles*.

414. See 17 U.S.C. § 106 (1988); see *supra* note 162 and accompanying text for a discussion of the rights granted under § 106 of the Copyright Act. See also *supra* note 181 and accompanying text for application of the third factor of the preemption test by the court in *Baltimore Orioles*.

415. See 17 U.S.C. §§ 106, 107 (1988 & Supp. V 1993). See also part II.F.3 for a discussion of parody.

416. Factually, *White* is also analogous to *Baltimore Orioles*. The performances of the baseball players are analogous to Vanna White's performances on *Wheel of Fortune*, since they are both part of a live performance that is fixed at the time of transmission. See *supra* note 179. In addition, the baseball clubs and the owners of the *Wheel of Fortune* are analogous in that they each own the copyright to their respective broadcasts.

Consequently, White's right of publicity claim should have been preempted by the Copyright Act.

G. *The Dissent's Choice of Law Analysis Was Flawed*

In his dissent from the order rejecting the suggestion for rehearing en banc, Judge Kozinski argued that the decision in *White* conflicted with the Copyright Clause of the United States Constitution<sup>417</sup> through the application of the domicile choice of law principle.<sup>418</sup> He stated that "under the . . . Copyright Clause, a state's intellectual property laws can stand only so long as they do not 'prejudice the interests of other states.'"<sup>419</sup> He noted that an overly broad right of publicity, such as the law advanced by the *White* court, may interfere with more restrictive right of publicity laws of other states. He reasoned that when the domicile choice of law principle was applied to a claim brought by a California domiciliary, California right of publicity law would be applied to adjudicate the claim, even where the defendant is not a California domiciliary, and even when the litigation was not in California.<sup>420</sup>

Judge Kozinski also noted that California law would apply even if a resident of another state did not realize that his or her conduct violated the right of publicity of a California domiciliary, because the common law right of publicity does not require a knowing violation of another's right.<sup>421</sup> He further asserted that the unknowing violation of California law may be particularly unfair when the celebrity is one of only local (California) reputation, and the non-California resident violates that celebrity's right of publicity.<sup>422</sup> Commentator Felix Kent made similar arguments in his article on the *White* case.<sup>423</sup>

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417. See *supra* note 156 for the text of the Copyright Clause.

418. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting). See Kent, *supra* note 281, at 3; MCCARTHY ON PUBLICITY, *supra* note 26, §§ 11.3(A), (D)(1-3). See also *supra* notes 286-94 and accompanying text for a full discussion of Judge Kozinski's "domicile argument."

419. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting) (quoting Goldstein v. California, 412 U.S. 546, 558 (1973)).

420. *Id.* at 1518-19 (Kozinski, J., dissenting); see also Kent, *supra* note 281, at 3.

421. See *White*, 989 F.2d at 1519; Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 n.6 (Cal. Ct. App. 1984). See *supra* text accompanying note 138.

422. *White*, 989 F.2d at 1519 (Kozinski, J., dissenting).

423. See Kent, *supra* note 281.

The situation envisioned by Judge Kozinski and Felix Kent will not necessarily occur in the manner in which they claim. The weakness in their argument is that they assume the domicile choice of law principle will always be applied in right of publicity cases where there is a choice of law issue. There are several reasons, however, why this assumption is incorrect.

First, one case cited by both Judge Kozinski and Felix Kent, *Acme Circus Operating Co. v. Kuperstock*,<sup>424</sup> actually undercuts their argument. *Acme* involved the question of whether the right of publicity survived the death of a celebrity—in other words, whether the right existed post-mortem.<sup>425</sup> This question was one of personal property law, and California courts apply the domicile choice of law principle to issues of personal property law.<sup>426</sup> The issue in *White*, however, was whether the plaintiff's right of publicity had been infringed.<sup>427</sup> The *Acme* court noted that the question whether an existing right of publicity had been *infringed* was one of tort or contract law.<sup>428</sup> In tort or contract cases, California courts may not necessarily apply the domicile choice of law principle, but may apply a principle that results in a different state's right of publicity law being applied to adjudicate the claim.<sup>429</sup> For example, California may apply the "governmental interests analysis" to a question of whether a right has been tortiously infringed.<sup>430</sup> Thus, the *Acme* case calls into doubt Judge Kozinski's and Felix Kent's arguments that the domicile choice of law principle will always be applied to choice of law issues in right of publicity cases involving a celebrity domiciled in California and an out-of-state defendant. Consequently, California's right of publicity law may not always be applied.<sup>431</sup>

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424. 711 F.2d 1538 (11th Cir. 1983); see *White*, 989 F.2d at 1518; Kent, *supra* note 281, at 3; see also *supra* note 294 for a discussion of *Acme*.

425. *Acme*, 711 F.2d at 1539.

426. *Id.* at 1540-41.

427. *White*, 971 F.2d at 1397-99.

428. *Acme*, 711 F.2d at 1541 n.1.

429. *Id.* at 1541.

430. *Id.*

431. Indeed, of the most noted right of publicity cases applying the domicile conflict of law principle, all were "post-mortem" right of publicity cases, deciding whether the right existed, not whether it had been infringed. See, e.g., *Joplin Enters. v. Allen*, 795 F. Supp. 349 (D. Wash. 1992); *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985), cited in,

However, which California choice of law rules would be applied in an infringement case,<sup>432</sup> and whether the results would be as "onerous" as Judge Kozinski and Felix Kent predict are questions that have not been squarely addressed by the Ninth Circuit or California state courts. The situation remains further complicated and unpredictable due to the morass of confusing rules and principles comprising the conflict of laws doctrine.<sup>433</sup>

## V. Conclusion

The unfortunate result of the *White* decision is that California's common law right of publicity has been expanded to the point where both bench and bar will be unsure of its boundaries. Indeed, simply reminding viewers of a celebrity is now the basis of a right of publicity claim in California. In addition, it is unclear to what extent, if at all, the First Amendment and parody constitute valid defenses to right of publicity claims. What is clear is that Vanna White now has a property right in the image of game show hostesses who wear sequined gowns, glittering jewelry, and blond hair. Moreover, other performers may similarly be able assert property rights in the attributes that constitute their personae.

The *White* decision will also result in an increase in litigation by celebrities, a decrease in the value of certain copyright licenses, and a restriction on the creativity and speech of advertisers and others who utilize mass commercial media. The decision also upsets the careful balance that has been struck by courts and legislatures between the rights of public domain ideas owners to control their property's use and the rights of the public to have access to public domain ideas for the enrichment of society.<sup>434</sup> If simply reminding viewers of a celebrity can

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MCCARTHY ON PUBLICITY, *supra* note 26, at § 11.3(D)(3); *Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538 (11th Cir. 1983); *Groucho Marx Productions v. Day and Night Co.*, 689 F.2d 317 (2d Cir. 1982); *Factors Etc. v. Pro Arts*, 652 F.2d 278 (2d Cir. 1981).

432. See, e.g., *supra* notes 288, 294.

433. See MCCARTHY ON PUBLICITY, *supra* note 26, § 11.3(A) (quoting RICHMAN & REYNOLDS, *supra* note 288, § 70(a)); see also *supra* note 288.

434. *White*, 989 F.2d at 1516 (Kozinski, J., dissenting).

state a cause of action for violation of the right of publicity, that balance has been upset indeed.

*John R. Braatz\**

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\* For my wife, Hatsué.