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Copyright Preemption and the Right of Publicity

Jennifer Rothman

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Copyright Preemption and the Right of Publicity

Jennifer E. Rothman*

TABLE OF CONTENTS

INTRODUCTION.....	200
I. PROBLEMS WITH THE CURRENT SYSTEM.....	209
A. <i>Harms to Copyright Holders and Their Licensees</i>	209
1. Derivative Works	209
2. Performance Rights.....	214
B. <i>Harm to the Public</i>	216
1. Limitations on Displays of Copyrighted Works.....	216
2. Limitations on Performance Rights.....	217
3. Limitations on the First Sale Doctrine.....	218
4. Sound-Alikes and Imitative Recordings.....	219
5. Limitations on the Use of Persona.....	222
II. COPYRIGHT PREEMPTION UNDER SECTION 301.....	225
A. <i>Equivalent Rights</i>	227
1. Extra Element Test.....	228
2. Exercise of Section 106 Rights	229
B. <i>Scope of Copyright</i>	232
C. <i>Deletion of Language From Section 301</i>	234
III. GENERAL PRINCIPLES OF PREEMPTION UNDER THE SUPREMACY CLAUSE	236
A. <i>Preemption When Conflict With Federal Law's Objectives or Explicit Provision</i>	238
B. <i>No Preemption When Federal Indifference</i>	240
C. <i>No Preemption When Complementary Objectives</i>	241
IV. CRITICISMS OF SUGGESTED SOLUTIONS.....	243
A. <i>Calls for Constricting the Right of Publicity</i>	244
B. <i>Calls for the Elimination of the Right of Publicity</i>	245
C. <i>Calls for a Federal Right of Publicity</i>	248
D. <i>Calls for Federal Preemption</i>	248

E. Contractual Solutions	249
V. PROPOSED SOLUTION	250
A. <i>The Proposed Test</i>	250
1. <i>Persona</i>	252
2. <i>Consent and Licensed Use</i>	254
3. <i>Uses Explicitly Authorized by the Copyright Act</i>	254
B. <i>Test Suite</i>	255
1. <i>No Preemption</i>	255
a. <i>Unlicensed Advertisement</i>	255
b. <i>Woody Allen Look-Alike</i>	255
c. <i>Beatlemania</i>	256
2. <i>Preemption of Persona-based Claims</i>	257
a. <i>White — The Wheel of Fortune Advertisement</i>	257
b. <i>Hirsch — Crazylegs Advertisement</i>	258
c. <i>Lombardo</i>	258
3. <i>Preemption Because of Authorized or Licensed Use</i>	259
a. <i>Baltimore Orioles</i>	259
b. <i>Fleet</i>	259
c. <i>Wendt</i>	259
d. <i>Shamsky — Mets T-shirts</i>	261
e. <i>Ahn — Mortal Kombat Videogame</i>	261
4. <i>Preemption Under Explicit Copyright Provisions</i>	262
a. <i>Friends Broadcast in Bar</i>	262
b. <i>Bar Playing a Madonna CD</i>	263
c. <i>Midler</i>	263
d. <i>Display of Posters in Restaurant/Bar</i>	264
CONCLUSION	265

INTRODUCTION

Consider the following scenarios:

You are the executive producer and creator of *Cheers*, one of the most successful television series ever made. You created the concept for the show and developed its characters. You also wrote many of the show's episodes. You own an uncontested copyright in the series and its characters. After the show goes off the air, you sell Host International the right to use the Norm and Cliff characters as models for animatronic robots in its airport bars. The actors who played Norm and Cliff on the series sue both Host International and you for licensing the characters to Host, claiming that the robots violate their rights of publicity. A recent

Ninth Circuit decision held that in this situation the actors' right of publicity prevails over your copyright in the characters and the show.¹

You are in charge of advertising for Ford Motor Company. You negotiate and pay for a license from the composer to use a popular song first recorded by Bette Midler. You know that under Section 114 of the Copyright Act you can make sound-alike recordings, so you choose a singer who sounds similar to Bette Midler and ask her to imitate Midler's voice. When the commercial airs, Bette Midler sues for violation of her right of publicity. The Ninth Circuit held that in this situation Midler's right of publicity trumps the permission granted under copyright law to make sound-alike recordings.²

You own a small restaurant in Ocean Township, New Jersey. To attract more customers you decide to name the restaurant "Spanky's" after your favorite character on the old television series, *Little Rascals*.³ You decorate the dining room with posters and photos of the cast and stills from the show which you bought from Hollywood memorabilia stores. The Copyright Act allows you to display such posters and photos without receiving permission from the copyright holder.⁴ The actor who played Spanky on the show sues you for violating his right of publicity by displaying a photograph of him and naming the restaurant after the character he played in the show. Given the direction of current precedents, such as that of the *Cheers* case described above, the actor has a good chance of winning this right of publicity action.⁵

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Many thanks to Eugene Volokh for his insight and challenging rebuttals, and to Sarah Boyd for her encouragement and perspective. I would also like to thank David Nimmer and Justin Hughes for their thoughtful comments. This article is dedicated to the memory of Professor Gary Schwartz, who first introduced me to the right of publicity.

¹ See *Wendt v. Host Int'l*, 125 F.3d 806 (9th Cir. 1997), *reh'g en banc denied*, 197 F.3d 1284 (9th Cir. 1999), *cert. denied*, 121 S.Ct. 33 (2000).

² See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

³ Assume that you obtain the right to use the name from the trademark owner of the television series.

⁴ See 17 U.S.C. § 109(c) (2002).

⁵ This scenario is loosely based on *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994). The facts have been changed in several key respects from the actual case. In *McFarland*, the restaurant was named "Spanky McFarland's," the restaurant contained murals of the *OUR GANG* and *Little Rascals* cast (in violation of the copyright of the series), and the menu included numerous references to the characters. See *id.* at 916. The Third Circuit held that the restaurant could be held liable for violating McFarland's right of publicity. See *id.* at 922-23.

You own a trendy bar in Los Angeles and your newest bartender has developed an obsession for Madonna's latest CD, "Music." She has been playing the CD nonstop for weeks. You're sick of the CD, but not worried about any liability because you have dutifully obtained a blanket ASCAP/BMI license for musical compositions played in your bar. Madonna swings through town on her Drowned World tour. She hears about your trendy bar and the fact that her CD is being repeatedly played there. She believes her album has contributed to your bar's success and sues you for violating her right of publicity. Although no case has decided who would win such a lawsuit, recent precedents suggest that Madonna might well prevail.⁶

The scenarios described above demonstrate only a few of the many situations in which the right of publicity and copyright law conflict. The federal Copyright Act provides authors of original works with the exclusive rights to reproduce, distribute, display, and perform their work, as well as the right to make derivative works from their original.⁷ Copyright law also gives rights to the public, such as the right to use ideas, the right to display purchased works, the right to re-sell lawfully purchased copies, and the right to make sound-alike recordings by precluding any copyright infringement liability for such actions.⁸

In contrast, the right of publicity is a state tort which allows a person to recover damages if an unauthorized individual or entity appropriates the person's name or likeness (and in some states persona and voice) for a commercial purpose.⁹ The right has primarily been used by celebrities

⁶ See discussion *infra* Parts I.A.2 and I.B.2.

⁷ See 17 U.S.C. §§ 102, 106 (2002). Most provisions of the Copyright Act confer negative rights on the copyright holder; in other words, the copyright holder is given the power to prevent others from doing something, such as reproducing the work. Implicit in the Act, however, are affirmative rights. The advantage of having a copyright is not only that one can exclude others from copying, distributing, displaying, and making derivative works of the original, but also by necessary implication that the copyright holder has the right to do these things in the first place. See *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*) (emphasizing that a copyright holder has the right to make derivative works from his original); see also *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986) (holding that a copyright gives its holder the right to broadcast the copyrighted work); *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134, 1137 (N.D. Ill. 1997) (finding that copyright law gives a copyright holder the right to make a derivative work). If a copyright holder could not distribute his own work, there would be little point in preventing others from doing so.

⁸ See 17 U.S.C. §§ 102, 109(a), (c), 114 (2002).

⁹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 3.1 (2d ed. 2000). Some form of the right of publicity has been adopted in almost every state either by statute or at common

law. Seventeen states recognize a right of publicity by statute: California (CAL. CIV. CODE §§ 3344, 3344.1 (formerly § 990) (West 2002)); Florida (FLA. STAT. ch. 540.08 (2001)); Illinois (765 ILL. COMP. STAT. 1075/1 (2002)); Indiana (IND. CODE §§ 32-13-1-1 to -20 (2002)); Kentucky (KY. REV. STAT. ANN. §§ 391.170) (Michie 2002); Massachusetts (MASS. GEN. LAWS ch. 214, § 3A (2002)); Nebraska (NEB. REV. STAT. §§ 20-201 to -211, 25-840.01(2002)); Nevada (NEV. REV. STAT §§ 597.770-597.810 (2002)); New York (N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 2002)); Oklahoma (OKLA. STAT. tit. 12, §§ 1448-49, tit. 21 §§ 839.1-3 (2002)); Rhode Island (R.I. GEN. LAWS §§ 9-1-28-28.1 (2002)); Tennessee (TENN. CODE ANN. §§ 47-25-1101 (2002)); Texas (TEX. PROP. CODE ANN. §§ 26.001-.015 (Vernon 2002)); Utah (UTAH CODE ANN. §§ 45-3-1 to -6 (2002)); Virginia (VA. CODE ANN. §§ 8.01-40, 18.2-216.1 (Michie 2002)); Washington (WASH. REV. CODE § 63.60.010 (2002)); and Wisconsin (WIS. STAT. § 895.50 (2002)).

Thirty-four states plus the District of Columbia recognize a common law right of publicity: Alabama, Arkansas, California, Connecticut, Delaware, District of Columbia, Florida, Georgia, Hawaii, Illinois, Indiana, Kansas, Kentucky, Louisiana, Maine, Maryland, Michigan, Minnesota, Mississippi, Missouri, Montana, New Jersey, New Mexico, Nevada, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, Tennessee, Texas, Utah, Vermont, West Virginia, and Wisconsin. *See, e.g., Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998) (Alabama); *Olan Mills, Inc. v. Dodd*, 353 S.W.2d 22 (Ark. 1962) (Arkansas); *Slivinsky v. Watkins-Johnson Co.*, 270 Cal. Rptr. 585, 589 (Cal. Ct. App. 1990) (California); *Venturi v. Savitt, Inc.*, 468 A.2d 933 (Conn. 1983) (Connecticut); *Slibeck v. Union Oil Co.*, 1986 WL Docket #11542 at *2 (Del. Super. Ct. 1986) (Delaware); *Vassiliades v. Garfinckel's*, 492 A.2d 580 (D.C. 1985) (District of Columbia); *Zim v. Western Publ'g Co.*, 573 F.2d 1318, 1326-27 (5th Cir. 1978) (Florida); *Martin Luther King Jr., Ctr. for Social Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 705-06 (Ga. 1982) (Georgia); *Fergerstrom v. Hawaiian Ocean View Estates, Inc.*, 441 P.2d 141, 142-43 (Haw. 1968) (Hawaii); *Douglass v. Hustler Magazine, Inc.* 769 F.2d 1128 (7th Cir. 1985) (Illinois); *Cont'l Optical Co. v. Reed*, 86 N.E.2d 306 (Ind. Ct. App. 1949) (Indiana); *Johnson v. Boeing Airplane Co.*, 262 P.2d 808 (Kan. 1953) (Kansas); *Foster-Milburn Co. v. Chinn*, 120 S.W. 364 (Ky. 1909) (Kentucky); *Prudhomme v. Proctor & Gamble Co.*, 800 F. Supp. 390, 396 (E.D. La. 1992) (Louisiana); *Nelson v. Maine Times*, 373 A.2d 1221, 1223 (Me. 1977) (Maine); *Lawrence v. A.S. Abell Co.*, 475 A.2d 448, 451 (Md. 1984) (Maryland); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (Michigan); *Lake v. Wal-Mart Stores, Inc.*, 582 N.W.2d 231 (Minn. 1998) (Minnesota); *Candebat v. Flanagan*, 487 So.2d 207, 209 (Miss. 1986) (Mississippi); *Haith v. Model Cities Health Corp.*, 704 S.W.2d 684, 687 (Mo. Ct. App. 1986) (Missouri); *Gilham v. Burlington N., Inc.*, 514 F.2d 660, 662 (9th Cir. 1975) (Montana); *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1378 (D.N.J. 1981) (New Jersey); *Benally v. Hundred Arrows Press, Inc.*, 614 F. Supp. 969, 977 (D.N.M. 1985), *rev'd on other grounds*, 858 F.2d 618 (10th Cir. 1988) (New Mexico); *Peta v. Berosini*, 895 P.2d 1269, 1284 (Nev. 1995) (Nevada); *Flake v. Greensboro News Co.*, 195 S.E. 55 (N.C. 1938) (North Carolina); *Reeves v. United Artists Corp.*, 765 F.2d 79, 80 (6th Cir. 1985) (Ohio); *McCormack v. Oklahoma Publ'g Co.*, 613 P.2d 737, 740 (Okla. 1980) (Oklahoma); *Martinez v. Democrat-Herald Publ'g Co.*, 669 P.2d 818, 820 (Or. Ct. App. 1983) (Oregon); *Gee v. CBS, Inc.*, 471 F. Supp. 600 (E.D. Pa. 1979), *aff'd mem.*, 612 F.2d 572 (3d Cir. 1979) (Pennsylvania); *State ex rel. Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89 (Tenn. Ct. App. 1987) (Tennessee); *Cox v. Hatch*, 761 P.2d 556, 563-65 (Utah 1988) (Utah); *Staruski v. Cont'l Tel. Co.*, 320 S.E.2d 266, 268 (Vt. 1990) (Vermont); *Crump v. Beckley Newspapers, Inc.*, 320 S.E.2d 70, 85-86 (W. Va. 1984) (West Virginia); *Hirsch v. S.C. Johnson & Sons, Inc.*, 280 N.W.2d 129, 130 (Wis. 1979) (Wisconsin). The states not listed in either group have simply not addressed the issue.

to protect against unauthorized uses of their identity, but the action is not limited to celebrities.¹⁰

Both copyright and the right of publicity strive to protect creative artists and to provide incentives for them to create; however, the two rights, as seen in the scenarios above, can come into serious conflict. The right of publicity conflicts not only with explicit provisions of the Copyright Act, but also with the implicit grant of affirmative rights to copyright holders and the public, as well as with the purposes behind copyright protection.¹¹ These conflicts have become increasingly common as right of publicity actions have proliferated and the right has

¹⁰ See, e.g., *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974); *Tellado v. Time-Life Books, Inc.*, 643 F. Supp. 904 (D. N.J. 1986); *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362 (2000) (allowing nude models to bring a right of publicity action); *Canessa v. J. I. Kislak, Inc.*, 235 A.2d 62, 75 (N.J. 1967); *Ippolito v. Ono-Lennon*, 526 N.Y.S.2d 877 (1988) (allowing a back-up musician to bring a right of publicity action); *Vinci v. American Can Co.*, 459 N.E.2d 507 (Ohio 1984); see also MCCARTHY, *supra* note 9, at § 4.1[A], [B], [E], 4.3[C] (supporting the inclusion of non-celebrities in the tort); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. d (1995); J. Thomas McCarthy, *Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 UCLA L. REV. 1703, 1710 (1987) [hereinafter *A Tribute*].

A few courts, however, have limited the right to celebrities. See, e.g., *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527, 530 (9th Cir. 1984); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978); *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. Am. Heritage Products, Inc.*, 296 S.E.2d 697 (Ga. 1982); *State ex rel. Elvis Presley*, 733 S.W.2d 89 at 97; see also MCCARTHY, *supra* note 9, § 4.3[B], & n.1, 7; Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1591 n.78 (1979); Steve J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112-14 (1980); Alicia M. Hunt, Comment, *Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 Nw. U. L. Rev. 1605 (2001) (supporting limiting the right to celebrities); cf. *Landham v. Lewis Galoob Toys*, 227 F.3d 619, 627 (6th Cir. 2000) (denying an actor's right of publicity claim because the actor was not well-known enough to be recognizable in an action figure based on the character he played in a movie); Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity "Wheel" Spun Out of Control*, 45 U. KAN. L. REV. 329 (1997) (arguing that the right of publicity, in practice, applies only to celebrities).

Even though most states allow non-celebrities to file right of publicity claims, in practice most right of publicity claims involve celebrities because their identity is more likely to be worth appropriating. See, e.g., *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (Dustin Hoffman); *Eastwood v. Nat'l Enquirer, Inc.*, 123 F.3d 1249 (9th Cir. 1997) (Clint Eastwood); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (Kareem Abdul-Jabbar); *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634 (9th Cir. 1982); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1990); *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317 (2d Cir. 1982).

In part because most right of publicity actions are brought by actors and musicians, the bulk of right of publicity jurisprudence has been made in the Ninth Circuit, Second Circuit, and the state courts of New York and California.

¹¹ See also discussion *infra* Part V.A.

expanded to cover “persona.”¹² Initially, the right of publicity was limited to actions where either the person’s name or likeness was used.¹³ A person’s “likeness” encompasses both an actual image of the person, such as a photograph, as well as re-creations of the person’s appearance, such as a drawing or use of a look-alike. In either case, there can be no appropriation of a person’s likeness unless the allegedly infringing image actually looks like the right of publicity holder. In contrast, “persona” encompasses a use where a viewing audience is merely *reminded* of a person even when neither the likeness nor the name of the person is used.¹⁴ For example, if a movie studio makes action figures of characters from a successful film, an actor may be able to win a right of publicity claim based on the action figure of her character even if the ultimate figure looks nothing like the actor herself. This is true because viewers who see the action figure of the character are likely to associate it with the actor who they saw play the role in the movie.¹⁵

The use of persona in right of publicity claims is troubling. As I will argue in more detail, persona should be thought of as the *idea* of a person

¹² Many courts have allowed right of publicity actions based on the use of persona alone. See *Wendt v. Host Int’l*, 125 F.3d 806, 811 (9th Cir. 1997) (California); *McFarland v. Miller*, 14 F.3d 912, 921 (3d Cir. 1994) (New Jersey) (supporting the holding in *Hirsch v. S.C. Johnson & Son Inc.*, 90 Wis. 2d 379, 397 (1979), that an association with a person’s identity is enough to prove a right of publicity violation); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398-99 (9th Cir. 1992) (California); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (California); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463-64 (9th Cir. 1988) (California); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983) (Illinois); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974) (California); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379 (1979) (Wisconsin); see also *Langvardt*, *supra* note 10, at 413-22.

A minority of states protect only against the use of the name, portrait, or picture of a person. See *e.g.*, *Allen v. Nat’l Video, Inc.*, 610 F. Supp 612, 620-21 (S.D. N.Y. 1985); *Stephano v. News Group Publ’ns, Inc.*, 64 N.Y.2d 174 (1984); FLA. STAT. ch. § 540.08 (2001) (limiting the right to name, portrait, photograph or other likeness); N.Y. CIV. RIGHTS LAW §§ 50-51 (2002); MASS. GEN. LAWS ch. 214, § 3A (2002); R.I. GEN. LAWS § 9-1-28 (2002); VA. CODE ANN. § 8.01-40 (Michie 2002); WIS. STAT. § 895.50 (2002); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. d (1995); MCCARTHY, *supra* note 9, § 4.459 (supporting the use of persona as the best way to protect people’s rights); *cf.* CAL. CIV. CODE § 3344.1 (formerly § 990) (covering voice, likeness, and name under California’s statutory right of publicity — California covers persona under common law right) (West 2002).

¹³ See, *e.g.*, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 824 (1979); see also MCCARTHY, *supra* note 9, § 4.459.

¹⁴ See *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284 (9th Cir. 1999) (Kozinski, J. dissenting) (objecting to denial of rehearing *en banc*); see also discussion *infra* Parts I.B.5., V.A.1., V.B.2, and V.B.3.

¹⁵ See, *e.g.*, *Wendt*, 125 F.3d at 811; *Lugosi*, 25 Cal. 3d at 821-27.

rather than the *expression* of that person.¹⁶ Copyright law explicitly precludes copyright holders from protecting ideas.¹⁷ Ideas are left in the public domain for all to use. The application of persona to right of publicity actions allows publicity holders to take property rights in an idea — in contravention of the principles behind copyright law. Thus, the expansion of the right of publicity to include persona severely constrains the creative ability of authors, the public, and copyright holders who wish to create both original and derivative works.¹⁸

The conflict between copyright law and the right of publicity has also become an increasing problem as courts have expanded the right of publicity beyond merchandising and commercials to cover works of entertainment such as movies, songs, musicals, games, and books.¹⁹ In

¹⁶ See discussion *infra* Parts I.B.5. and V.A.1.

¹⁷ See 17 U.S.C. § 102(b) (2002).

¹⁸ See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][3][b] 1-66-66.1, and n.286.14, 2.86.18 (2002); see also *Wendt*, 197 F.3d at 1285 (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*); *White v. Samsung Elecs. Am. Corp., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*).

¹⁹ Numerous cases have allowed right of publicity actions to go forward even though the works at issue were not advertisements for goods or services, nor were the works merchandising. See, e.g., *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000) (allowing a right of publicity action arising out of the creation of action figures based on a movie); *Elvis Presley Enters. v. Capece*, 141 F.3d 188 (5th Cir. 1998) (expanding the right of publicity to cover decor in a nightclub); *Wendt*, 125 F.3d at 811 (expanding the right of publicity to cover decor in a bar and merchandising based on a fictional television series); *Ventura v. Titan Sports Inc.*, 65 F.3d 725 (8th Cir. 1995) (allowing a right of publicity action arising out of a video of professional wrestling matches); *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994) (expanding the right of publicity to cover decor in a restaurant); *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986) (considering a right of publicity action arising out of a television broadcast of baseball games); *Michaels v. Internet Entm't Group*, 5 F. Supp. 2d 823 (C.D. Cal. 1998) (allowing a right of publicity action arising out of internet adult entertainment sites); *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134 (N.D. Ill. 1997) (considering a right of publicity action arising out of a video game); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (allowing a right of publicity action based on the use of a photograph on the cover of a compact disc for a soundtrack of a motion picture); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D. N.J. 1981) (allowing a right of publicity action against Elvis impersonators); *Uhlaender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970) (allowing a right of publicity action arising out of a board game based on major league baseball); *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911 (1996) (considering a right of publicity action arising out of a motion picture); *Apple Corp. v. Leber*, 229 U.S.P.Q. 1015, 1986 WL 215081 (Cal. App. Dep't Super. Ct. 1986) (expanding the right of publicity to cover a musical show about the Beatles); *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. Am. Heritage Prods., Inc.*, 250 Ga. 135 (1982) (allowing a right of publicity action for the creation of busts of Martin Luther King, Jr.); *Ippolito v. Ono-Lennon*, 526 N.Y.S.2d 877 (1988) (allowing a right of publicity action stemming from a videotaped benefit concert); *Factors Etc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981) (allowing a right of publicity action against Elvis impersonators); *Palmer v. Schonhorn Enters., Inc.*, 96 N.J. Super. 72 (1967) (allowing a right of publicity claim arising

theory, at least, the right of publicity does not extend to the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or advertising for these works.²⁰ Even though the expansion of the right of publicity to these generally protected areas is primarily a First Amendment issue,²¹ the fact that such an expansion is taking place puts more and more of copyright law at risk.

Even though compelling justifications exist for both copyright and the right of publicity, when the goals and/or specific provisions of the two conflict, federal law must prevail. It is a well-established principle of constitutional law that federal laws have supremacy over state laws.²² In spite of the clear guidance from our constitution, courts have rarely used federal copyright law to preempt right of publicity claims. When courts have considered whether copyright law preempts the right of publicity, they have relied primarily on Section 301 of the Copyright Act.²³ Section 301 sets forth a test for preempting state laws when they interfere with

out of a board game based on professional golf players); *see also* Langvardt, *supra* note 10, at 348-49.

Regardless of whether one believes that the right of publicity should cover some of these works, it is important to know the scope of the right of publicity in order to understand the potential conflicts with copyright law.

²⁰ *See, e.g.*, *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67 n.14 (1983); *Montana v. San Jose Mercury News*, 34 Cal. App. 4th 790, 793-94, 797 (1995); CAL. CIV. CODE § 3344.1(d) (Deering 2002) (excluding news, public affairs, sports broadcasts, and political campaigns, but not explicitly exempting movies and other forms of entertainment); CAL. CIV. CODE § 3344.1(a), (j) (Deering 2002) (excluding news, sports, political campaigns, plays, books, magazines, musical compositions, films, radio, television, fine arts, and advertisements for these items); FLA. STAT. ch. 540.08(3)(a) (2001) (exception for news reporting); NEV. REV. STAT. § 598.984(2)(f) (2002); OKLA. STAT. tit. 12, § 1448(N)(4), 1449 (West 2002); TENN. CODE ANN. § 47-25-1107 (2001); TEX. PROP. CODE ANN. § 26.012(a)(5), (b) (Vernon 2002); *see also* MCCARTHY, *supra* note 9, § 7.5 (describing the biography and fiction exceptions) (2d ed. 2000); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995) (litigation exception). These exclusions exist primarily because of the limits placed on the right of publicity by the First Amendment.

²¹ The First Amendment is one of the main defenses used in right of publicity actions. *See* MCCARTHY, *supra* note 9, §§ 8.8, 8.9. For a further discussion of the First Amendment and the right of publicity see Alfred Hill, *Defamation and Privacy under the First Amendment*, 76 COLUM. L. REV. 1205, 1304-05 (1976) (arguing that the right of publicity should not apply to fictional works); Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994); Langvardt, *supra* note 10, at 430-39; Jeff Sanders, *By Force of Persona: How the Right of Publicity Undermines the First Amendment*, 28 BEVERLY HILLS B.A.J. 13 (1994); James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEXAS L. REV. 637, 660 (1973) (arguing that fictional works fall under a First Amendment exception to the right of publicity).

²² *See* U.S. CONST. Art. VI; *see also* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964).

²³ *See* discussion *infra* Part II, and notes 206 and 207.

copyright law.²⁴ Section 301 states that copyright law preempts state laws when the state laws are equivalent to rights provided in the Copyright Act and when the work at issue falls within the scope of copyright protection.²⁵ The vast majority of courts have held that Section 301 does not preempt the right of publicity.²⁶ This is primarily true because both the language and legislative history of Section 301 make the provision virtually impossible to apply.

Few courts or scholars have looked beyond the Copyright Act's explicit preemption clause when considering preemption of publicity rights. Section 301, however, is not the only avenue for preempting state laws that conflict with copyright law. The Supremacy Clause of the Constitution requires state laws to yield to federal laws when the state rights stand as an obstacle to the *purposes* and *objectives* of federal law.²⁷ This is true even when a statute, like the Copyright Act, contains an explicit preemption clause.²⁸ Without useful guidance from the Copyright Act, it makes sense to rely on the broader principles of the Supremacy Clause to determine when copyright law should preempt the right of publicity. In addition, the purposes behind copyright law extend beyond the specific rights granted to copyright holders in the Copyright Act. Such goals include the promotion of creation and guaranteeing an expansive public domain from which to create new works.²⁹

This Article presents a practical test for determining when the right of publicity stands as an obstacle to copyright law and the purposes behind it. I set forth three situations in which the right must yield to copyright law: first, when a publicity holder's action is based solely on the use of his or her persona rather than on the publicity holder's name or likeness; second, when the use at issue was licensed or authorized by a copyright holder who received consent from the publicity holder for the original work; and finally, when the use at issue is explicitly authorized by the Copyright Act.

Even though some of the problems discussed in this Article could be remedied by refashioning and limiting the right of publicity directly, only a federal preemption approach can provide adequate and uniform

²⁴ See 17 U.S.C. § 301 (2002).

²⁵ See *id.*

²⁶ See discussion *infra* Part II and notes 206 and 207.

²⁷ See *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

²⁸ See *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 867 (2000) (holding that as long as the preemption clause of a federal statute does not state that it is the sole avenue of preemption, general precepts of the Supremacy Clause apply).

²⁹ See discussion *infra* Part V.A and notes 238-40.

protection for both copyright holders and the public. Because each state has its own right of publicity, reforming both the statutory and common law state rights would be a daunting task even if there were support for such an action. In contrast, the principles of federal preemption are already in place and do not require legislative action. The main obstacle to applying federal preemption is simply the failure of courts to recognize the seriousness of the problem and the availability of the solution.

Part I of this Article examines both the current and foreseeable problems associated with the courts' failure to preempt the right of publicity when it conflicts with copyright law. Part II analyzes preemption under Section 301 of the Copyright Act. Part III argues that the broader preemption principles of the Supremacy Clause apply to copyright preemption. Part IV critically examines several of the most common suggestions for solving the conflict between the right of publicity and copyright law. Finally, Part V presents the proposed test and applies it to both hypothetical and actual cases in a "test suite" to demonstrate the soundness of the proposed solution.³⁰

I. PROBLEMS WITH THE CURRENT SYSTEM

The failure of courts to preempt the right of publicity harms copyright holders, licensees, and the public. Some of these harms have already come to pass, and others are foreseeable extensions of current trends in right of publicity jurisprudence.

A. Harms to Copyright Holders and Their Licensees

1. Derivative Works

Section 106(2) of the Copyright Act explicitly grants copyright holders and their licensees the exclusive right to prepare works based on their original work.³¹ By denying others the right to make derivative works without permission, the Act implicitly confirms the rights of copyright

³⁰ I borrow this term from Eugene Volokh who adopted the term from computer programmers as a way to evaluate any proposed test using tough scenarios to challenge the test's validity. See Eugene Volokh, *Intermediate Questions of Religious Exemptions — A Research Agenda with Test Suites*, 21 CARDOZO L. REV. 595, 599-600 & n.8 (1999).

³¹ See 17 U.S.C. § 106(2) (2002); see also *id.* § 101. Section 101 provides examples of derivative works including translations, musical arrangements, dramatizations, motion picture adaptations, sound recordings, and other forms "in which a work may be recast, transformed, or adapted." *Id.*

holders to make derivative works from their own works.³² The protection of derivative rights serves the fundamental copyright goals of encouraging the creation of new works. Derivative works are a major source of income; allowing copyright holders to produce such derivative works is a vital element in encouraging the production of new work.

In the entertainment context, derivative works include prequels, sequels, spin-offs, the use of fictional characters in different stories, the re-recording of musical compositions, and the production of merchandise related to the original work. For example, in *Wendt v. Host International*,³³ Paramount Pictures, the holder of the copyright in *Cheers*, had the right to use the characters Norm and Cliff in a derivative work. They also had the right to license anyone else to make such a derivative work.³⁴

³² See *supra* note 7.

³³ *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997), *reh'g en banc denied*, 197 F.3d 1284 (9th Cir. 1999), *cert. denied sub nom.*, *Paramount Pictures Corp. v. Wendt*, 531 U.S. 811 (2000).

³⁴ Plaintiff's Brief at 1, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 96-55243); Plaintiff's Brief at 4-5, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 96-55243).

Whether characters can be copyrighted independently of the work in which they appear is a hotly contested area of copyright law and beyond the scope of this article. See generally *Silverman v. CBS, Inc.*, 870 F.2d 40 (2d Cir. 1989) (finding that the characters Amos and Andy are copyrightable); *Filmvideo Releasing Corp. v. Hastings*, 668 F.2d 91 (2d Cir. 1981) (holding that Hopalong Cassidy is a copyrightable character); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978) (protecting Mickey Mouse with a copyright); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930) (suggesting the possibility that characters could be copyrighted separate from the work in which they originally appear); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287 (C.D. Cal. 1995) (finding James Bond copyrightable); *Anderson v. Stallone*, 11 U.S.P.Q. 2d 1161 (C.D. Cal. 1989) (finding Rocky a copyrightable character). But see *Warner Bros. Pictures, Inc. v. CBS, Inc.*, 216 F.2d 945 (9th Cir. 1954) (suggesting that Sam Spade had no copyright protection separate from the story in which he appeared). See generally DOROTHY J. HOWELL, *INTELLECTUAL PROPERTIES AND THE PROTECTION OF FICTIONAL CHARACTERS: COPYRIGHT, TRADEMARK, OR UNFAIR COMPETITION?* (1990); Stephen Clark, *Of Mice, Men, and Supermen: The Copyrightability of Graphic and Literary Characters*, 28 ST. LOUIS U. L.J. 959 (1984); Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429 (1986); Dean D. Niro, *Protecting Characters through Copyright Law: Paving a New Road Upon Which Literary, Graphic, and Motion Picture Characters Can All Travel*, 41 DEPAUL L. REV. 359 (1992); Francis M. Nevins, Jr., *Copyright + Character = Catastrophe*, 39 J. COPR. SOC'Y 303 (1992); David B. Feldman, Comment, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CAL. L. REV. 687 (1990); Michael Todd Helfand, Note, *When Mickey Mouse is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional, Literary and Pictorial Characters*, 44 STAN. L. REV. 623 (1992).

For the purposes of this article I will not distinguish between the copyrightability of a character separate from the work in which it arises and the protection of a character within a work. Instead, I will treat characters as being generally copyrightable and the copyright of such characters as resting in the hands of their initial creators.

In *Wendt*, one of the defendants, Host International, wanted to open up a chain of airport bars to capitalize on the success of the television show *Cheers*.³⁵ Host developed animatronic robots based on the Norm and Cliff characters from the show.³⁶ The District Court held that there was no right of publicity violation because the robots did not look similar to the actors, George Wendt and John Ratzenberger.³⁷ The Ninth Circuit reversed and remanded the case for a jury trial. The court held that the jury could find a right of publicity violation even if the robots did not look like the actors, as long as the robots evoked the actors' "persona."³⁸ The court explicitly rejected the defendants' argument that the right of publicity was preempted by copyright law.³⁹

Ultimately, the parties in *Wendt* settled for a confidential amount and no jury ever decided whether the robots did in fact evoke Wendt and Ratzenberger's personas.⁴⁰ Nonetheless, the Ninth Circuit's holding in *Wendt* demonstrates the current legal view that right of publicity claims are not preempted by copyright law even when they prevent the creation of authorized derivative works. This finding is particularly troubling, given the reliance on persona as a ground for finding a right of publicity violation, because it is nearly impossible for anyone familiar with *Cheers* to separate out an image that evokes the *characters* Norm and Cliff from one that calls to mind the *actors* who played the characters.⁴¹ Using

Undoubtedly, actors contribute substantially to the creation of the characters whom they play. In our legal system, however, the actor's authorial stake is transferred via the work-for-hire doctrine to the producers who become the copyright holders of the work. See 17 U.S.C. §§ 101, 201 (2002); see also F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures under U.S. Copyright Law*, 49 UCLA L. REV. 225 (2001); Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 96 (1998) (describing the failure of the American copyright system to recognize collaborative authorship).

³⁵ See Defendant's Brief at pp. 7-8, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 96-55243); Defendant's Brief at p. 3, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 93-56318); Plaintiff's Brief at p. 4, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 96-55243).

³⁶ Host International changed the names of the robots to Hank and Bob after the lawsuit began. See Plaintiff's Brief at 4-7, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 96-55243).

³⁷ See *Wendt*, 125 F.3d at 811.

³⁸ See *id.* at 809-11 (stating that "common-law right of publicity protects more than the knowing use of a plaintiff's name or likeness"); see also *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000) (stating that a right of publicity violation overcomes copyright law when an actor's persona is used in an action figure derived from a movie); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398-99 (9th Cir. 1992).

³⁹ See *Wendt*, 125 F.3d at 810.

⁴⁰ See *Norm and Cliff Cheered By Lawsuit*, CHI. TRIB., June 22, 2001, at C2.

⁴¹ See *Wendt*, 125 F.3d at 811; Plaintiff's Brief at pp. 10, 13, 16, *Wendt v. Host Int'l, Inc.*,

persona as a basis for a right of publicity violation essentially wrests control of characters away from the copyright holders and gives control of the characters to the actors who first portrayed the roles.⁴² Such an outcome severely limits the rights of creators of fictional characters.

The holding in *Wendt* not only limits merchandising rights, but it also limits, to the extent that the right of publicity includes fictional works,⁴³ the ability of copyright holders to make sequels, prequels, and spin-offs.⁴⁴ Preventing copyright holders from using their characters in derivative works severely limits both their creative potential and their ability to fund their work. Much of television and film is financed by deficit-financing.⁴⁵ The few big hits finance the rest of the losers.

125 F.3d 806 (9th Cir. 1997) (No. 96-55243); Plaintiff's Reply at pp. 3-4, *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (No. 93-56318).

⁴² The control of fictional characters is one of the most often discussed intersections of right of publicity and copyright law. See, e.g., Mark Bartholomew, *Protecting the Performers: Setting a New Standard for Character Copyrightability*, 41 SANTA CLARA L. REV. 341 (2001); Michael J. Albano, Note, *Nothing to "Cheer" About: A Call for Reform of the Right of Publicity in Audiovisual Characters*, 90 GEO. L.J. 253 (2001); Angela D. Cook, Case Note & Comment, *Should Right of Publicity Protection Be Extended to Actors in the Characters Which They Portray*, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 309 (1999); Dawn H. Dawson, Note, *The Final Frontier: Right of Publicity in Fictional Characters*, 2001 U. ILL. L. REV. 635 (2001); Eric Lee, Note, *Titan Sports, Inc. v. Hellwig: Wrestling with the Distinction Between Character and Performer*, 3 TUL. J. TECH & INTELL. PROP. 155 (2001); Peter K. Yu, Note, *Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters*, 20 CARDOZO L. REV. 355 (1998) (suggesting that right of publicity claims based on fictional personas should be preempted by copyright law and that those based on human personas should not be preempted).

Although no one has argued that an actor could produce derivative works on his own based on a character he played without violating copyright law, the fact that without copyright preemption an actor can prevent a copyright holder from producing a derivative work with that character leads to a similar ultimate effect — preventing a copyright holder from benefiting from derivative works based on the original.

⁴³ Even though right of publicity does not traditionally cover works of entertainment, it has been expanded to cover such works in recent years. See *supra* note 19.

⁴⁴ In his dissent from the denial of an *en banc* rehearing in *Wendt*, Judge Alex Kozinski highlighted the dangers of the decision. He imagined a situation in which the creators of "Seinfeld" want to make a spin-off of the show called "Kramer" and the actor who played Newman, the fat mail carrier, is unavailable. If the producers hire another overweight actor to play the role, the original actor, Wayne Knight, might have a valid right of publicity claim under the logic in *Wendt*. As Judge Kozinski warns: "To avoid going to trial in such a situation, producers will have to cast new actors who look and sound very different from the old ones. A *Seinfeld* spin-off thus ends up in a bizarre world where a skinny Newman sits down to coffee with a svelte George, a stocky Kramer, a fat Jerry and a lanky blonde Elaine. Not only is goodwill associated with the old show lost, the artistic freedom of the screenwriters and producers is severely cramped." *Wendt*, 197 F.3d at 1287 n.6 (Kozinski, J., dissenting) (objecting to denial of *en banc* rehearing).

⁴⁵ In television, production companies and studios tend to front the costs of new television series. They do not make back their money until a series is syndicated — usually after five seasons on air. Thus, most television shows are funded using "deficit-financing."

Therefore, selling merchandise from the hits is one of the main ways that artists and creators can make a profit from their work.⁴⁶ Such things as t-shirts, action figures, and posters provide vital profits for producers and copyright holders, and also provide additional publicity for the original works. Similarly, being able to create sequels of big hits, such as *Speed II* and *Die Hard III*, allows producers to maximize the pay-off of successful films. The incentive to create, one of the main objectives of copyright law, is severely reduced if copyright holders cannot adequately profit from their creations.

The recent expansion and success of right of publicity actions means that most smart producers with good attorneys will explicitly include a grant of merchandising and sequel rights into any performer's contract, as well as a waiver of publicity rights arising out of the work. However, there are many older contracts that do not contain such explicit provisions, and undoubtedly there are still poorly drafted contracts being made. Therefore, a question remains of who should suffer from the ambiguities created by these old and inadequate contracts. Even though it is generally true that ambiguous contracts are interpreted against their drafters and in favor of the less sophisticated party,⁴⁷ it is unreasonable to preclude copyright holders from making derivative works absent a specific grant of such rights. This is true for several reasons. First, the right to make derivative works was known and in existence at the time of the formation of the original contract. Second,

See generally Marc L. Herkovitz, Note, *The Repeal of the Financial Interest and Syndication of Rules: The Demise of Program Diversity and Network Competition?*, 15 *CARDOZO ARTS & ENT. L.J.* 177 n.112 (1997); Farrow Boyd, *Beryl Vertue*, *FIN. TIMES*, Jan. 22, 2002, at 40; "Cybill" Suit Filed by Eye is Dismissed, *DAILY VARIETY*, Apr. 30, 2001, at 7; John Dempsey, *Company Reports: Diller Doesn't Dally With Empire*, *DAILY VARIETY*, Jan. 11, 1999, at 17; Jay Greene, *Savoy Expands Plans: Indie Slates 22 Films and Plans Foray Into TV Production*, *DAILY VARIETY*, Oct. 7, 1994, at 1; Brian Lowry, *MGM Cedes to TV Prod in Gerber*, *DAILY VARIETY*, June 22, 1992, at 1; Chris Pursell, *Looking for Love*, *DAILY VARIETY*, Nov. 19, 1999, at 58; Shauna Snow, *Morning Report: Pop/Rock*, *L.A. TIMES*, Mar. 5, 1993, at F2; Diane Wertz, *There Ought to be a Misfit Network*, *NEWSDAY*, July 17, 1996, at C14.

Similarly, most motion pictures cost more to make than they recoup — especially at the domestic box office. The Motion Picture Association of America (MPAA) has found that "four out of ten movies never recoup the original investment." *See* MPAA e-mail correspondence with author (August 14, 2002, 3:47pm) (on file with author). This means that film producers count on the profits from merchandising tie-ins and sequels for the few big hits.

⁴⁶ *See, e.g.*, Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 *J. COPYRIGHT L. SOC'Y* 209, 209 (1983); Stephen J. Sansweet, *MCA, Inc. Expects E.T. Merchandise to Outsell the Movie*, *WALL ST. J.*, July 19, 1982, at 7.

⁴⁷ *See, e.g.*, *Golden Eagle Ins. Co. v. Ins. Co. of the West*, 121 *Cal. Rptr. 2d* 682, 686 (*Cal. Ct. App.* 2002).

most actors have agents and lawyers who are experienced and knowledgeable about such contracts and should know how to obtain additional compensation for future derivative works. Thus, the actors are not significantly less sophisticated than the studios. Finally, most actor contracts are explicitly works-for-hire in which it is clear that all copyright privileges vest in the producer and not in the actor.⁴⁸ Actors should not be able to use the right of publicity as a back door to obtaining property rights which they were required to waive at the outset.

2. Performance Rights

The ability of copyright holders to profit from licensing performance rights is also endangered by the right of publicity. For example, if the right of publicity is never preempted, then music composers may lose out on licensing fees. Under copyright law, a song has at least two copyrights: one for the underlying musical composition and another for the actual sound recording.⁴⁹ Sometimes the same person composes and records a song, but often two different artists are involved. Section 106(4) of the Copyright Act provides composers with the exclusive right to publicly perform their work or license such performances.⁵⁰ In contrast, although copyright holders in sound recordings can preclude others from reproducing and distributing copies of the sound recording, the Copyright Act does not accord them an exclusive right of public performance.⁵¹ Thus, businesses that play CDs, tapes, or records must obtain licenses for the musical compositions performed, but not for the sound recordings.

If copyright law does not preempt the right of publicity, then recording artists, who under copyright law do not have any performance rights, will be able to sue restaurants, bars, and other businesses that play their recordings. A right of publicity action could be sustained here because the businesses would be using a performer's voice or persona for commercial purposes. For example, suppose Tina Turner finds out

⁴⁸ See note 34.

⁴⁹ See NIMMER, *supra* note 18, § 2.10. There may also be a separate copyright for the song's lyrics.

⁵⁰ See 17 U.S.C. § 106(4) (2002). Composers benefit from both compulsory and negotiated licensing fees for the public performances of their works. See MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT 348 (3d ed. 1999).

⁵¹ A recent exception was made to this under the 1998 Digital Millennium Copyright Act which provides a right of public performance in sound recordings when they are digitally transmitted. See 17 U.S.C. § 106(6) (2002).

that a bar plays her rendition of "In the Midnight Hour"⁵² every night at midnight. She is outraged that the composers are the only ones getting royalties and decides to rally for the rights of performing artists. Even though she cannot sue for a violation of her copyright, she can sue for a right of publicity violation.

Under current right of publicity precedents, there is nothing to stop recording artists from prevailing in such a situation. Such an application of the right of publicity would render the language denying exclusive performance rights to the recording artist meaningless because in every instance a right of publicity action could be applied to assert property rights over the recordings. Congress has already weighed the value of compensating recording artists against the benefit to the public of being able to enjoy such works in public spaces, and decided against providing a public performance right in sound recordings. Publicity holders should not be able to circumvent this congressional decision through a state law.⁵³

Another problem with allowing a recording artist's right of publicity action to succeed is that composers will suffer a severe loss of revenue if businesses stop paying ASCAP/BMI for licenses for composers' work⁵⁴—a likely outcome if such licenses do not protect businesses from lawsuits. Composers will therefore lose royalties and the ASCAP/BMI system which provides the main and most practical avenue for

⁵² Composed by Wilson Pickett and Steve Cropper. The song appears on TINA LIVE IN EUROPE (1988). Tina Turner, *In the Midnight Hour*, on TINA LIVE IN EUROPE (Festival Records 1993).

⁵³ The regulations enacting the Copyright Act explicitly state that "since sound recordings are now . . . copyrightable works, it would not be possible to afford them any rights of public performance under State law even though they are denied those rights under [the Copyright Act pursuant to Section 114]." REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, 87th CONG., 1st Sess., Copyright Law Revision (Comm. Print 1961) (as quoted in NIMMER, *supra* note 18, § 1.01[B][1] n. 44).

⁵⁴ The ASCAP/BMI system allows for convenient payment of licensing fees to composers. See LEAFFER, *supra* note 50; see also <http://www.ascap.org>; <http://www.bmi.org>. Businesses can obtain blanket licenses from ASCAP and BMI which allow the user to pay one fee for all of the musical compositions in the ASCAP or BMI library. See LEAFFER, *supra* note 50, at 348; see also NIMMER, *supra* note 18, § 8.19; SIDNEY SHEML & WILLIAM M. KRASILOVSKY, THIS BUSINESS OF MUSIC, Ch. 18 (7th ed. 1995). ASCAP/BMI then distributes royalties to the composers based on how much of their works were used and by whom. Determinations of use are done primarily using a sampling technique. See LEAFFER, *supra* note 50, at 349; see also Bernard Korman & I. Fred Koeningsberg, *Performing Rights in Music and Performing Rights Societies*, 33 J. COPYRIGHT L. SOC'Y 332, 360 (1987).

compensation of composers may collapse.⁵⁵ This loss of revenue will discourage composers from creating new musical works and interfere with the incentive scheme created by copyright law.

B. Harm to the Public

Copyright holders and their licensees are not the only ones who suffer when copyright law does not preempt the right of publicity. The public also suffers when rights granted to the public under copyright law are constrained by a boundless right of publicity.

1. Limitations on Displays of Copyrighted Works

Under copyright law, the owner of a lawfully obtained copy is allowed to “display that copy publicly” without receiving permission from the copyright holder.⁵⁶ The right to display a work is severely limited by performers’ publicity rights if such rights are never preempted by copyright law. For example, if the owner of a bar wants to pay homage to Hollywood movies and buys movie posters to cover the walls, the actors who appear in those posters may be able to win a right of publicity action against the owner.

An example of such a situation can be seen in a variation on *McFarland v. Miller*.⁵⁷ Suppose that a restaurant owner receives permission from the copyright holder of the movie, OUR GANG, and the television series, *The Little Rascals*, to call her restaurant “Spanky’s” after one of the main characters in the series. The restaurant displays purchased posters and photographs on the wall from the OUR GANG series, including numerous pictures of the character Spanky. Under copyright law, the owner of the restaurant is free to do this; however, without the protection of copyright

⁵⁵ Ultimately, one can imagine a new system of licensing springing up to collect licensing fees for performing artists, however, the initial impact may be substantial.

⁵⁶ 17 U.S.C. § 109(c) states that a person who owns a copyrighted work may “display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.” *Id.*

⁵⁷ *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994). In the actual case, George McFarland sued the defendant for naming his restaurant “Spanky McFarland,” after both the character and the actor. *Id.* at 913. McFarland played Spanky in both the movie and television series, OUR GANG and *The Little Rascals*. *Id.* at 913-15. OUR GANG was a popular short subject comedy series shown in movie theaters from the 1920s to the 1940s. *Id.* It was later revived as the *Little Rascals* on television. *Id.* The restaurant used McFarland’s image from his OUR GANG days along with 1,000 photos of other movie characters, including some of the *Little Rascals*. *Id.* at 916. The restaurant had two giant murals of the OUR GANG cast and the menu contained items named after characters from the show. *Id.* The court did not address copyright preemption in holding for the plaintiff. *Id.* at 923.

preemption the actor who played Spanky could prevent such a display by asserting his right of publicity. The actor could sue under the theory that the restaurant was using his name, likeness, and persona for commercial purposes. Unlike the producers of the movie, the restaurant owner had no opportunity to contract with the performer at the outset.⁵⁸

Prohibiting such displays contradicts federal copyright law, which explicitly allows them. There are compelling policy justifications for allowing people to display purchased works. If a person lawfully purchases something, he or she should be able to put it to use.⁵⁹ Further, the public should have the opportunity to appreciate such works. There would be an evident loss to the public if a private collector who purchased Andy Warhol's painting of Marilyn Monroe was unable to display the work in his Las Vegas casino for fear that Marilyn Monroe's estate could sue.⁶⁰ Even less artistic works, such as a paparazzi photograph of Marilyn Monroe, provide value to the public and warrant display.

2. Limitations on Performance Rights

The right of publicity can be used not only to limit copyright holders' performance rights,⁶¹ but also to limit the rights of the public to see and hear performances otherwise authorized by copyright law. Under current right of publicity precedents, an individual actor, athlete, or singer can sue the owner of a restaurant, bar, or store that shows her performance for a violation of her right of publicity with a good chance of prevailing. For example, if Jennifer Aniston discovers that a local bar plays *Friends*, she could sue because the bar is using her image for a commercial purpose. Similarly, quarterback Brett Favre could sue sports bars that profit from showing his performances on Monday Night Football. As discussed earlier, singers could also sue for performances of their songs.

⁵⁸ Producers can most likely take care of this problem in the future by including a grant of licensing rights to third parties in a performer's contract.

⁵⁹ See H.R. REP. NO. 94-1476, at 79-80 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5692-94 (stating that "the lawful owner of a copy of a work should be able to put his copy on public display without the consent of the copyright owner").

⁶⁰ The First Amendment defense to a right of publicity action might be enough to allow the display of Warhol's painting. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 7, 407-10 (2001) (holding that the First Amendment may protect a transformative artistic work from a right of publicity action).

⁶¹ See discussion *supra* Part I.A.2.

Such an outcome conflicts with both the purposes and provisions of federal copyright law. Section 110(5) gives businesses the right to play broadcast transmissions of radio and television programming without gaining permission or paying any licensing fees.⁶² Furthermore, under copyright law, businesses can play videotapes and musical recordings without securing the permission of the recording artists, actors, or athletes who appear in the works.⁶³

If such right of publicity actions are sustained, businesses will lose customers because fewer people will want to visit a bar that cannot play music, show their favorite television programs, or air the big games.⁶⁴ Furthermore, Congress has already indicated that the benefit to the public of allowing such broadcasts outweighs the property rights in the works.⁶⁵ Congress' logic was based in part on the fact that such performances are unlikely to affect sales of the original works and are *de minimis* uses not unlike what customers would experience at home.⁶⁶

3. Limitations on the First Sale Doctrine

Section 109(a) of the Copyright Act empowers a purchaser of a copyrighted work "to sell or otherwise dispose of the possession of that copy or phonorecord" without the permission of the copyright owner.⁶⁷ For example, a person can buy a compact disc or a video, then sell it to someone else when she gets bored with it. This "first sale" doctrine allows for the free alienability of goods, one of the core values of

⁶² See 17 U.S.C. § 110(5) (2002). This so-called homestyle exception is not unlimited — it puts certain restrictions on the size of the restaurant or business and limits the numbers of speakers and television sets used. See *id.*

⁶³ In these instances, the business would need to pay licensing fees to the copyright holders, but not to the performers.

⁶⁴ Even though large businesses might be able to pay right of publicity holders, the expense would be prohibitively expensive for small businesses. Furthermore, it would be difficult to pay right of publicity holders because it would be difficult to identify less famous performers and keep track of every performer's appearances. In addition, there is no system currently in place to locate and compensate actors for this use nor is there a standard negotiated fee.

⁶⁵ By adopting Section 110(5), Congress supported the logic in *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151 (1975) (upholding a restaurant's ability to play music without compensating composers prior to the adoption of Section 110(5), because the public interest outweighs the rights of composers to benefit from public broadcasts in small businesses). See 17 U.S.C. § 110(5) (2002).

⁶⁶ See H.R. REP. NO. 94-1476, at 85-86 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5700; see also *Twentieth Century Music*, 422 U.S. at 162-63 n.13 (describing the unfairness of forcing restaurants to compensate composers because of the obstacles to complying with such requirements and the unfairness of necessarily limited enforcement).

⁶⁷ See 17 U.S.C. § 109(a) (2002); see also *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908).

property law.⁶⁸

If the right of publicity is never preempted, then the first sale doctrine will be severely limited. *Allison v. Vintage Sports Plaques*⁶⁹ raises the issue of what happens when a right of publicity claim conflicts with the first sale doctrine of copyright law. In *Allison*, the defendant bought trading cards featuring the images of sports stars, including race car driver Clifford Allison and baseball player Orel Hershisser.⁷⁰ Allison's widow and Hershisser sued the defendant for placing the trading cards on plaques and selling them.⁷¹ Both Allison and Hershisser had approved the use of their images on the original cards and were compensated for doing so.⁷² The Eleventh Circuit found that the right of publicity must, as a matter of policy, include the first sale doctrine.⁷³ The court emphasized that, without a first sale doctrine, the right of publicity would unreasonably encroach on the rights of the public.⁷⁴ The court did not address copyright preemption in its holding. Absent principles of copyright preemption, there is a danger that future courts will decide otherwise and allow the right of publicity to interfere with the rights provided by Section 109(a) of the Copyright Act.

4. Sound-Alikes and Imitative Recordings

Under federal copyright law, the making of sound-alike recordings is explicitly allowed.⁷⁵ People are free to re-record a song provided that the license fees for the musical composition are paid and the new version of the song does not radically alter the original composition.⁷⁶ Allowing

⁶⁸ See Nannette Diacovo, *Going Once, Going Twice, Sold: The First Sale Doctrine Defense in Right of Publicity Actions*, 12 U. MIAMI ENT. & SPORTS L. REV. 57, 64 n.44 (1994); see also NIMMER, *supra* note 18, § 1.01[B].

⁶⁹ *Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998).

⁷⁰ See *id.* at 1444.

⁷¹ See *id.*

⁷² See *id.* at 1444-45.

⁷³ See *id.* at 1451. There have been few cases to address this issue. See *id.* at 1448 ("There is virtually no case law in any state addressing the application of the first-sale doctrine to the right of publicity. . ."). Only one other case so far has agreed with *Allison v. Vintage Sports Plaques*. See *Upper Deck Authenticated, Ltd. v. CPG Direct*, 971 F. Supp. 1337 (S.D. Cal. 1997). Accord Diacovo, *supra* note 68, at 64.

⁷⁴ See *Allison*, 136 F.3d at 1448-49.

⁷⁵ See 17 U.S.C. § 114(b) (2002) ("The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.") (emphasis added).

⁷⁶ See *id.* § 115. An artist can radically alter the original but then he cannot use a

right of publicity actions for sound-alikes limits the freedom of future performers to make covers of original musical compositions and limits the public's ability to enjoy new versions of these compositions.

Barring sound-alikes would essentially give a monopoly on a musical composition to the first artist to perform the song. For example, if the first recording artist were a woman with an alto voice, another woman singing the same song with an alto voice might well be confused with the original artist. The Copyright Act specifically allows imitative recordings because of this danger that performers will monopolize musical compositions.⁷⁷ Furthermore, even if the second performer does not sound similar to the first performer, the song is likely to conjure up the original performer in listeners' minds. Such an identification would be sufficient to prove a right of publicity violation in states which allow a right of publicity action based on persona.⁷⁸ This is especially true because the compulsory license requires that a performer not radically alter the initial arrangement of the composition.⁷⁹

Giving the first recording artist a virtual monopoly over a musical composition interferes with the copyright goal of providing incentives to create. New performers will be discouraged from re-recording songs and advertisers will shy away from using musical compositions that have been previously recorded for fear of right of publicity actions from the original performing artists. The resulting loss of revenue to composers will discourage the creation of new musical works by reducing the economic incentives provided by copyright law; in addition, new generations of listeners will lose out on appreciating old standards.

Despite the evident conflict with copyright law, courts have held that the right of publicity can bar sound-alike recordings. For example, in *Midler v. Ford Motor Co.*,⁸⁰ Bette Midler sued Ford for recording "Do You Want to Dance," a song from Midler's 1972 album, "The Divine Miss M," composed by Bobby Freeman.⁸¹ Even though Ford and its advertising

compulsory license and must instead negotiate an individual license. *Id.*

⁷⁷ See H.R. Rep. 94-1476, at 106-07 (1976) reprinted in 1976 U.S.C.A.A.N. 5659, 5721-22; see also *Goldstein v. California*, 412 U.S. 546, 551 (1973) (upholding a state law punishing piracy of sound recordings in part because the law still allowed for the creation of imitative recordings).

⁷⁸ See note 12. In the few states which explicitly limit the right of publicity to use of name, image, or voice the claim would not be allowed.

⁷⁹ See 17 U.S.C. § 115 (2002); see also H.R. REP. NO. 94-1476, at 108-09 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5724.

⁸⁰ *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

⁸¹ See *id.* at 461.

agency had licensed the song, Midler objected to Ford's use of a sound-alike singer.⁸² The court found that Midler had stated claims sufficient for a right of publicity violation and remanded for trial.⁸³ The court did not address copyright preemption. The holding in *Midler* creates a danger that artists with similar voices will not be able to sing songs which other artists have previously performed. For example, under the logic in *Midler*, Celine Dion could be barred from performing or recording "Memories," a song made famous by Barbra Streisand, because Dion's voice is similar enough to Streisand's that her rendition might be deemed a "sound-alike."⁸⁴

Courts have gone even further than *Midler* and limited not just sound-alike recordings, but also recordings that imitate merely the style of a certain performer. For example, in *Waits v. Frito-Lay, Inc.*,⁸⁵ the Ninth Circuit upheld the bulk of a multi-million dollar recovery awarded to the singer Tom Waits for a Frito-Lay commercial which used a singer imitating Waits' low-register, raspy singing voice.⁸⁶ In contrast to *Midler*, the commercial did not use a song previously performed by Waits, but instead used an original composition written for the commercial.⁸⁷ The court held that the defendant's copyright in the song did not preempt Waits' right of publicity.⁸⁸

This decision essentially gives Waits ownership of a masculine raspy singing style. Such a grant of rights severely limits the creativity of future performers as well as the number and type of works available to the public. Under the logic of *Waits*, Billie Holiday's estate could sue pop singer Macy Gray, who has a similar vocal lilt and style to Holiday,⁸⁹ even if Gray did not sing any songs made famous by Holiday.⁹⁰ This would be especially true in a jurisdiction in which courts have held that

⁸² See *id.* at 462.

⁸³ See *id.* at 463-64.

⁸⁴ Celine Dion has been dubbed the "Barbra Streisand of this generation." Robert Hilburn, *Music's Hot Properties are Lukewarm at Best*, THE RECORD, Bergen County, NJ, Apr. 29, 2001.

⁸⁵ *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

⁸⁶ *Id.* at 1096-98, 1112.

⁸⁷ See *id.* at 1097.

⁸⁸ See *id.* at 1100.

⁸⁹ See Shawn Edwards, *Macy Gray*, PITCH WEEKLY, Nov. 22, 2001; Edna Gunderson, *A 'Supernatural' Sweep: Santana's Magic Enchants the Grammys a Record-tying Eight Times*, USA TODAY, Feb. 24, 2000, at D1; Bryan Mochizuki, *Macy Gray*, FRESNO BEE, Oct. 21, 2001, at E6; Heidi Sherman, *Vamped and Amped*, IN STYLE, July 2001, at 186.

⁹⁰ In fact, Macy Gray has done a cover version of Billie Holiday's "I Want To Be Your Mother's Son-in-Law." MACY GRAY, *I Want to Be Your Mother's Son-In-Law*, on *Divine Secrets of the Ya-Ya Sisterhood Soundtrack* (Columbia Records 2002).

evoking a performer's persona is enough to sustain a right of publicity claim.⁹¹

5. Limitations on the Use of Persona

The courts' failure to preempt the right of publicity also leads to a more abstract harm than those discussed so far. Extending the right of publicity to cover persona severely limits the public's ability to use ideas. As a preliminary matter, it is important to discuss in more detail what exactly is "persona." The best way to understand the concept of persona is to examine the specific instances in which courts have based a right of publicity violation solely on the grounds of the use of persona. Perhaps the most illustrative example is the Vanna White case.

In *White v. Samsung Electronics*,⁹² Samsung was held accountable for a right of publicity violation even though it did not use White's image, name, or even a look-alike. Samsung, instead, used a futuristic robot in a blonde wig turning letters on a screen, much like Vanna White does on the *Wheel of Fortune* show.⁹³ The Ninth Circuit held that Samsung's commercial violated White's right of publicity because it used her persona.⁹⁴

One judge has described the use of persona as creating a tort when "advertisers . . . remind the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness, not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind."⁹⁵ Because the actual name or likeness of the person need not be used, right of publicity holders can monopolize abstractions and reminders about themselves and the characters that they play.⁹⁶

⁹¹ Applying persona to such a scenario, a listener need simply think to herself, "this Macy Gray really reminds me of Billie Holiday," in order for a right of publicity violation to be sustained. A violation in such an instance could be found even if the listener did not think that Macy Gray sounded like Billie Holiday or even imitated Holiday's style. Thus, there are three levels of singing implicated by the holdings in *Midler* and *Waits*. One, where a sound-alike is performed; two, where a singer imitates the style of the right of publicity holder; and three, where the singer simply reminds a listener of the right of publicity holder.

⁹² *White v. Samsung Elecs. Am. Inc.*, 971 F.2d 1395, 1396-1402 (9th Cir. 1997).

⁹³ *See id.* The concept of Samsung's advertising campaign was to emphasize the longevity of its television sets. *See id.* at 1396.

⁹⁴ *See id.* at 1399.

⁹⁵ *See White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting) (emphasis in original) (objecting to denial of rehearing *en banc*).

⁹⁶ *See, e.g., Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (holding that Johnny Carson could prevent others from using the phrase "Here's Johnny" as a name of a business under a right of publicity theory); *Prudhomme v. Procter & Gamble*

Ultimately, the use of "persona" allows people to protect the *idea* of themselves rather than the concrete expression of their name or likeness. For example, in *Motschenbacher v. R. J. Reynolds Tobacco Co.*,⁹⁷ the Ninth Circuit held that the use of a red race car was enough to violate a race car driver's right of publicity. The defendant in *Motschenbacher* used a stock color photograph of a racetrack which contained within it the plaintiff's car among several others.⁹⁸ The plaintiff was not visible in the picture, and the defendants altered the photograph by changing the number of the plaintiff's car and by adding a spoiler to the car to make it distinguishable from the plaintiff's actual vehicle.⁹⁹

By protecting *Motschenbacher's* right of publicity in this instance, the court essentially gave *Motschenbacher* a monopoly on the *idea* of a "red race car." The image in the advertisement did not show *Motschenbacher*, his likeness, or even his exact race car. Instead, a right of publicity violation was found simply because a red race car on a racetrack conjured up *Motschenbacher* in the minds of some viewers when the advertisement was aired.

Similarly, in *Lombardo v. Doyle, Dane & Bernbach, Inc.*,¹⁰⁰ the well-known bandleader Guy Lombardo won a lawsuit simply because another band sang "Auld Lang Syne" on New Year's Eve. Lombardo sued when an automobile manufacturer showed an orchestra wearing New Year's Eve party hats playing "Auld Lang Syne" with the manufacturer's vehicles in the foreground.¹⁰¹ The commercial used the same musical beat and choice of music ("Auld Lang Syne") with which Lombardo was associated in the public's mind.¹⁰² The court held that New York Civil Rights Laws §§ 50 and 51, which provide New York's statutory right of publicity, did not apply because neither Lombardo's name nor his picture was used.¹⁰³ Nevertheless, the court found that Lombardo had a cause of action for appropriation of his "personality" under the common law.¹⁰⁴ Two concurring judges also argued that the civil rights laws should apply because the evocation of the plaintiff's persona could be

Co., 800 F. Supp. 390, 392-93 (E.D. La. 1992) (denying a motion to dismiss a right of publicity claim where an advertisement used a fat chef).

⁹⁷ *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

⁹⁸ *See id.* at 822, 827.

⁹⁹ *See id.*

¹⁰⁰ *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661, 664 (1977).

¹⁰¹ *See id.* at 661-63.

¹⁰² *See id.*

¹⁰³ *See id.* at 663-64.

¹⁰⁴ *See id.* at 664-65. Under current New York law there is no common law right of publicity. *See Stephano v. News Group Publ'ns, Inc.*, 64 N.Y.2d 174, 175 (1984).

equated with the use of his name or picture.¹⁰⁵ Because neither Lombardo's likeness, name, or voice were used, the infringement was solely based on his persona and the likely, or simply possible, association in a viewer's mind of the commercial's band leader with Lombardo.

Another example of persona is provided in *Hirsch v. S.C. Johnson & Son, Inc.*,¹⁰⁶ where a company named a women's shaving gel "Crazylegs."¹⁰⁷ The plaintiff, a well-known football player nicknamed "Crazylegs," sued alleging a violation of his right of publicity when the company advertised the product on television.¹⁰⁸ The Supreme Court of Wisconsin said that the use of his nickname alone could violate the plaintiff's right of publicity even though it was simply a single word.¹⁰⁹ There was little doubt that the plaintiff was known and associated with the nickname, but there was nothing about the commercial beyond the product name and the use of a sporting-event-like cheer that implicated the plaintiff's identity.¹¹⁰ Again, the concept of persona allowed the plaintiff to win his right of publicity claim on the sole grounds that some viewers might bring to mind the plaintiff while watching the commercial.

Allowing right of publicity actions on the basis of persona where the right of publicity holder's name, likeness, and voice are not used contravenes the Copyright Act's explicit grant of ideas to the public.¹¹¹ For example, the use of a big band playing "Auld Lang Syne" on New Year's Eve is a general idea which under copyright law is explicitly left in the public domain. Eliminating the use of this idea severely constrains the ability of others to perform and to create new works. "Auld Lang Syne" is played by bands at the stroke of midnight at nightclubs and parties all over the United States on New Year's Eve. Guy Lombardo should not be able to monopolize the song nor the playing of the song by another big band. Yet, the right of publicity allowed him to obtain property rights in this concept — something specifically prohibited by copyright law and the principles behind it.¹¹²

¹⁰⁵ See *Lombardo*, 396 N.Y.S.2d. at 665-66 (Titone and Suozzi, JJ., concurring).

¹⁰⁶ See *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 130 (1979).

¹⁰⁷ See *id.*

¹⁰⁸ See *id.* at 130-32.

¹⁰⁹ See *id.* at 132-33.

¹¹⁰ See *id.* at 137-38.

¹¹¹ See 17 U.S.C. § 102(b) (2002). Section 102(b) of the Copyright Act makes clear that "[i]n no case does copyright protection for an original work of authorship extend to any idea." See also *Mazer v. Stein*, 347 U.S. 201, 217 (1954); *Baker v. Selden*, 101 U.S. 99, 107 (1879).

¹¹² Copyright law allows ideas to be freely taken because ideas are necessary building

Similarly, the plaintiff in *Hirsch* should not have been able to use the right of publicity to claim ownership of a generic term like "Crazylegs." First, it seems quite possible that the product was independently named Crazylegs without any intent to refer to the plaintiff — it was a women's shaving gel, not a football jersey. Second, even if the defendants got the idea for the name from Hirsch's nickname, this kind of use of others' ideas is explicitly allowed and encouraged by copyright law. Third, even if some members of the public did conjure up Hirsch in their minds while watching the commercial, Hirsch had the opportunity to remedy such consumer confusion under the Lanham Act.¹¹³ Allowing the protection of a single word in an instance like *Hirsch* means that Magic Johnson might be able to prevent others from using the term "Magic." Obviously, Magic Johnson should not be able to prevent others from making Magic Markers, Magic White-Out, or Magic Autowax.¹¹⁴

As the above cases demonstrate, the failure of courts to preempt the right of publicity when it interferes with copyright law principles is not an isolated or insignificant occurrence. The expansion of the right of publicity to cover persona and its application to works that are not purely commercial threatens an ever-widening scope of works. The ability of copyright holders to make derivative works from their originals and to capitalize on their works through performance licenses is endangered by courts' preference for the rights of performers over the rights of copyright holders. Furthermore, the public is also harmed by an unrestrained right of publicity, because what we create, listen to, and perform are all limited by an unchecked right of publicity.

II. COPYRIGHT PREEMPTION UNDER SECTION 301

Despite the frequent conflict between the right of publicity and the provisions of and purposes behind copyright law, few courts have found that copyright preempts the right of publicity. The failure to preempt

blocks in all works. See *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 90 (2d Cir. 1940) (stating that "all civilization is built [on ideas which] may never be 'owned'"); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*) ("Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before."); see also discussion *infra* Part V.B.2.

¹¹³ See 15 U.S.C. 1125(a) (2002) (Section 43(a) of the Lanham Act) (providing a remedy when consumer confusion is created).

¹¹⁴ In certain instances a performer might be able to trademark his name, but I do not address the parameters of trademark protection for proper names in this article.

the right of publicity primarily springs from the courts' belief that the Copyright Act's explicit preemption clause, Section 301, never preempts the right of publicity.¹¹⁵ Section 301 describes situations in which state laws must yield to the Copyright Act. To understand why Section 301 has been interpreted to allow the right of publicity to interfere with copyright, it is necessary to analyze the provisions of the section in some detail.

Under Section 301, copyright law preempts a state law when two requirements are met.¹¹⁶ First, a court must find that the state law gives

¹¹⁵ See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-05 (9th Cir. 2001); *Landham v. Lewis Galoob Toys*, 227 F.3d 619, 623-24 (6th Cir. 2000); *Wendt v. Host Int'l*, 125 F.3d 806, 809 (9th Cir. 1997); *Wendt v. Host Int'l*, Nos. 93-56318, 93-56510, 1995 U.S. App. LEXIS 5464 (9th Cir. Mar. 16, 1995); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 871 (C.D. Cal. 1999), *rev'd on other grounds*, 255 F.3d 1180 (9th Cir. 2001); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930, 935-36 (1995); see also *NIMMER*, *supra* note 18, § 1.01[B] (stating that courts should primarily rely on § 301 preemption); *MCCARTHY*, *supra* note 9, § 11.43; Marc S. Williams, Note, *Copyright Preemption: Real-Time Dissemination of Sports Scores and Information*, 71 S. CAL. L. REV. 445, 451 (1998).

Many other courts have not addressed copyright preemption even though the right of publicity action before the court conflicted with copyright law. See, e.g., *Hoffman*, 255 F.3d at 1180; *White v. Samsung Elec. Am. Inc.*, 971 F.2d 1395 (9th Cir. 1997); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 130 (1979); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661, 664 (1977) (predating the effective date of Section 301).

One reason courts may not address the issue is that parties are unlikely to waste time including preemption arguments in their briefs given the general consensus that the right of publicity is rarely, if ever, preempted.

¹¹⁶ See 17 U.S.C. § 301(a) (2002). Section 301(a) states:

All 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.

Section 301(b) says essentially the exact same thing in reverse. It states that rights which do not meet the 301 criteria are not preempted. See *NIMMER*, *supra* note 18, § 1.01[B]. Section 301 (b) provides:

Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to —

- (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103; including works of authorship not fixed in any tangible medium of expression; or
- (2) any cause of action arising from undertakings commenced before

rights which are *equivalent* to the rights provided in Section 106 of the Copyright Act.¹¹⁷ Second, the works at issue must fall within the *scope* of copyright protection under Sections 102 and 103 of the Copyright Act.¹¹⁸

A. Equivalent Rights

Section 106 gives copyright owners the exclusive rights to reproduce their copyrighted work, to prepare derivative works, to distribute copies, to perform the work, and to display the work.¹¹⁹ Section 301, however, does not define what it means for a state action to be “equivalent” to one of these rights. Courts have interpreted the equivalent rights phrase in one of two ways: a state law is equivalent either when (1) no additional element beyond exercise of the right is required to violate the state law; or (2) the state law is violated simply by the exercise of a Section 106

January 1, 1978;

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106; or

(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8).

¹¹⁷ See 17 U.S.C. § 301 (a) (2002).

¹¹⁸ See *id.*; see also MCCARTHY, *supra* note 9, at 301.

¹¹⁹ See 17 U.S.C. § 106 (2002). The complete text of Section 106 states that subject to sections 107 through 121, the owner of a copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

right.

1. Extra Element Test

Most courts have adopted the "extra element" test.¹²⁰ Under the extra element test, a state law is *not* equivalent if it requires any additional element beyond what copyright law requires to prove infringement. Melville and David Nimmer describe the test as follows: "[I]f under state law . . . qualitatively other elements are required, instead of, or in addition to, the acts of reproduction, performance, distribution, or display . . . then . . . there is no pre-emption."¹²¹

The vast majority of courts to apply the extra element test have held that the right of publicity is not preempted because it has an extra element.¹²² The Restatement (Third) of Unfair Competition states that "[c]laims for infringement of the right of publicity are . . . not generally preempted by federal law" because the rights are not generally equivalent to the rights provided in Section 106.¹²³ Courts point to a variety of extra elements in the right of publicity, ranging from a commercial purpose to the appropriation of identity.¹²⁴

¹²⁰ See, e.g., *Downing*, 265 F.3d at 1005; *Landham*, 227 F.3d at 623-24; *Wendt*, 1995 U.S. App. LEXIS 5464, at *3; *Waits*, 978 F.2d at 1100; *Hoffman*, 33 F. Supp. 2d at 875; *Michaels v. Internet Entm't. Group*, 5 F. Supp. 2d 823, 837 (C.D. Cal. 1998); *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1989 WL 206431 at *5 (C.D. Cal. April 25, 1989); *KNB Enters.*, 78 Cal. App. 4th at 370, 374-75 (citing *Hoffman*, 33 F. Supp. 2d at 875); *Shamsky*, 632 N.Y.S.2d at 935; see also MCCARTHY, *supra* note 9, § 11:46; NIMMER, *supra* note 18, § 1.01[B][1] & n.60.1.

¹²¹ See NIMMER, *supra* note 18, § 1.01[B][1].

¹²² See, e.g., *Downing*, 265 F.3d at 1005 (finding the use of names and likenesses not equivalent to Section 106 rights); *Landham*, 227 F.3d at 623-34 (finding an extra element in protecting the "idea" and "personal identity" of an individual); *Wendt*, 1995 U.S. App. LEXIS 5464, *3 (finding an extra element in the invasion of personal rights); *Waits*, 978 F.2d at 1100 (finding that the right of publicity is different in kind because it relies on the use of identity); *Michaels*, 5 F. Supp. 2d at 837 (finding that the use of name and likeness is different in kind from Section 106 rights); *KNB Enters.*, 78 Cal. App. 4th at 370, 374-75 (finding that the use of a name and image is an extra element); *Shamsky*, 632 N.Y.S.2d at 935 (finding an extra element in the requirement that the use be for purposes of trade); see also MCCARTHY, *supra* note 9, § 11:48; NIMMER, *supra* note 18, § 1.01[B][1].

¹²³ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. i (1995).

¹²⁴ See *supra* note 122; see also Sean Elliot, *Dancing Promotions, Dodging Preemption, and Defending Personae: Why Preempting the Right of Publicity Deprives Talent the Publicity Protection They Deserve*, 73 NOTRE DAME L. REV. 1625, 1642-43 (1998) (arguing that a defendant's profit from the use of a plaintiff's identity qualifies as extra element); Shelley Ross Saxer, Note, *Baltimore Orioles, Inc. v. Major League Baseball Players Association: The Right of Publicity in Game Performances and General Copyright Preemption*, 36 UCLA L. REV. 861, 881-82 (1989) (stating that the requirement of commercial use counts as an extra element).

Despite the broad acceptance of the extra element test, the test has several serious flaws. First, as Nimmer points out, simply adding an extra element to a state right should not protect it from preemption.¹²⁵ For example, the performance right under Section 106(4) is limited to *public* performance.¹²⁶ It follows, therefore, that a state law that requires an author's consent for *private* as well as public performances of the author's play should be preempted as well. In practice, however, the extra element test would *not* preempt the law because it has an extra element — being a *private* performance.¹²⁷ Allowing such an easy procedure for circumventing Section 301 preemption contravenes Congress' intent.¹²⁸

Second, states' common law copyright protection would not be preempted under the extra element test because such laws usually require a work to be unpublished. The requirement that the work be unpublished would constitute an extra element. This is not what the Copyright Act had in mind. One of the only certainties about Section 301 is that Congress intended it to preempt common law copyright.¹²⁹ The problems with the dual copyright system, state and federal, were the main impetus for the adoption of Section 301.¹³⁰

2. Exercise of Section 106 Rights

The alternative interpretation of the equivalent rights language does not fare much better than the extra element test. This approach finds a state law "equivalent," for purposes of Section 301, if a copyright holder violates the state law merely by exercising any of his Section 106 rights.¹³¹

¹²⁵ See NIMMER, *supra* note 18, § 1.01[B][1].

¹²⁶ See *id.*

¹²⁷ See *id.*

¹²⁸ See H.R. REP. NO. 94-1476, at 129-31 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5746; see also NIMMER, *supra* note 18, § 1.01[B][1].

¹²⁹ See H.R. REP. NO. 94-1476, at 129-131 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5745-46; see also NIMMER, *supra* note 18, § 1.01[B][1]; David E. Shipley, *Three Strikes and They're Out at the Old Ball Game: Preemption of Performers' Rights of Publicity Under the Copyright Act of 1976*, 20 ARIZ. ST. L.J. 369, 374 (1988) [hereinafter *Three Strikes*]; David E. Shipley, *Publicity Never Dies: It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 701 (1981) [hereinafter *Publicity Never Dies*].

¹³⁰ The motive behind preempting such works was to substitute "a single Federal [copyright] system for the present anachronistic, uncertain, impractical, and highly complicated dual system" in order to more effectively "carry out the basic constitutional aims of uniformity and the promotion of writing and scholarship." See H.R. REP. NO. 94-1476, at 129-131 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5745-46.

¹³¹ See, e.g., *Baltimore Orioles, Inc v. Major League Baseball Players Ass'n*, 805 F.2d 663, 676 (7th Cir. 1986) ("A right under state law is 'equivalent' to one of the rights within the

Only a few courts follow this view and those that do usually find that copyright law can preempt the right of publicity.

The Seventh Circuit adopted such a position in *Baltimore Orioles, Inc v. Major League Baseball Players Assoc.*¹³² In *Baltimore Orioles*, baseball players sued their team alleging that their right of publicity was violated by the broadcast of baseball games in which they played.¹³³ The Seventh Circuit found that the telecasts were copyrightable and that the team owned the copyright in the broadcasts.¹³⁴ The court explained that “[b]ecause the exercise of the Clubs’ right to broadcast telecasts of the games infringes the Players’ rights of publicity in their performances, the Players’ rights of publicity are equivalent to at least one of the rights encompassed by copyright... the right to perform an audiovisual work.”¹³⁵

Similarly, in *Fleet v. CBS*,¹³⁶ the plaintiffs were actors who had agreed to appear in the defendants’ movie.¹³⁷ When the plaintiffs were not paid for their performances, they sued claiming a right of publicity violation.¹³⁸ The court held that the plaintiffs’ publicity rights were equivalent to the rights available under copyright because the actors were seeking “to prevent a party from exhibiting a copyrighted work [the movie]” — a Section 106 right.¹³⁹

general scope of copyright if it is violated by the exercise of any of the rights set forth in § 106.”); *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134, 1137 (N.D. Ill. 1997); *Brode v. Tax Mgmt., Inc.*, 1990 WL 25691 at *10 (N.D. Ill. Feb. 1, 1990); *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1919 (1996); see also *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*).

¹³² *Baltimore Orioles*, 805 F.2d at 677.

¹³³ See *id.* at 665-66.

¹³⁴ See *id.* at 677.

¹³⁵ See *id.*

¹³⁶ See *Fleet*, 50 Cal. App. 4th 1911.

¹³⁷ See *id.* at 1913-14.

¹³⁸ See *id.*

¹³⁹ See *id.* at 1913-14, 1920-25 (making clear that “a right is equivalent to rights within the exclusive province of copyright when it is infringed by the mere act of reproducing, performing, distributing, or displaying the work at issue. A claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted.”) (citing with approval *NIMMER*, *supra* note 18, § 1.01[B][1] and *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663 (7th Cir. 1986)).

The *Fleet* court distinguished the case before them from other precedents in California in which the right of publicity was not preempted by relying on the fact that in those cases it was plaintiffs’ image or likeness outside the context of their copyrightable “performance” which had been appropriated. See, e.g., *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996); *Cher v. Forum Int’l, Ltd.*, 692 F.3d 407 (9th Cir. 1996); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Midler v. Ford Motor Co.*,

Most courts have rejected the holding in *Baltimore Orioles* and limited the *Fleet* decision to its narrow set of facts.¹⁴⁰ There are legitimate reasons to criticize these opinions. First, the holdings in both cases were unnecessary given that the plaintiffs consented to the works on which the claims were based.¹⁴¹ Because consent is a defense to a right of publicity claim, the entire preemption analysis of both cases was ancillary.

Second, and most relevant to the discussion of the equivalent rights analysis, the preemption logic used in these cases would preempt the right of publicity every time it arose in a copyrighted work. For instance, if a commercial advertisement uses uncopyrighted footage of a celebrity without permission, the right of publicity would still be preempted because the disputed work appears in a *copyrighted* commercial. Thus, the right of publicity holder would be trying to prevent the *distribution* of a *copyrighted* work — the advertisement. The action would be preempted because the copyright holder in the advertisement would violate state law simply by exercising a Section 106 right. Such an interpretation of Section 301 would essentially eliminate the right of publicity.¹⁴²

Even though neither of the currently accepted interpretations of equivalent rights are convincing, no legal theorist or court has presented an alternative. Unfortunately, the legislative history of Section 301 does not shed any light on the meaning of the equivalent rights language. Thus, courts are left with little useful guidance in applying the equivalent rights language of Section 301.

849 F.2d 460 (9th Cir. 1988); *Eastwood v. Superior Court*, 149 Cal. App. 3d 409 (1983). This distinction does not make sense because the use of a film clip would be use of a performance even if it was an unauthorized use squarely falling within a right of publicity action.

¹⁴⁰ See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-05 (9th Cir. 2001); *Brown v. Ames*, 201 F.3d 654, 659 (5th Cir. 2000); *Wendt v. Host Int'l*, 125 F. 3d 806, 810 (9th Cir. 1997); *Michaels v. Internet Entm't Group, Inc.*, 5 F. Supp. 2d 823, 837 (S.D. Cal. 1998); *Seifer v. PHE, Inc.*, 196 F. Supp. 2d 622, 626-27 (S.D. Ohio 2002); *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 372-74 (2000) ("In our view, a section 3344 [right of publicity] claim is preempted . . . where an actor or model with no copyright interest in the work seeks to prevent the exclusive copyright holder from displaying the copyrighted work"); *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930, 936 (1995); see also *Saxer, supra* note 124, at 878-84; *Three Strikes, supra* note 129, at 373, 381-83; cf. *Motown Record Corp. v. Hormel & Co.*, 657 F. Supp. 1236, 1238-90 (C.D. Cal. 1987) (preempting the right of publicity claim where the plaintiffs owned a copyright in the work that was misappropriated).

¹⁴¹ Consent is a basic defense to the right of publicity. See *MCCARTHY, supra* note 9, § 3.1[B]; *RESTATEMENT (THIRD) UNFAIR COMPETITION* § 46, cmt. f (1995).

¹⁴² See *Three Strikes, supra* note 129, at 373, 381-83. For a discussion of why a total elimination of the right of publicity would be a bad outcome see discussion *infra* Part IV.B.

B. Scope of Copyright

The second requirement for preemption, under Section 301, is that the state law protect material within the scope of copyright law. Section 301 relies on Sections 102 and 103 of the Copyright Act to delineate works that are and are not within the scope of copyright.¹⁴³ Section 102 states that copyright protection is only given to original works of authorship fixed in a tangible medium of expression and does not extend to ideas, processes or procedures.¹⁴⁴ Case law has established that facts cannot be protected by copyright.¹⁴⁵ Section 103 adds that compilations and derivative works are copyrightable, but the preexisting and underlying materials contained within them are not.¹⁴⁶

The legislative history of Section 301 suggests that a work can fall within the scope of Section 102 and 103 regardless of whether it is actually copyrightable.¹⁴⁷ Thus, as long as a work fits within one of the categories in Section 102, such as being a fixed literary or musical work, it falls within the scope of copyright even if the individual work is

¹⁴³ See 17 U.S.C. § 301(a) (2002).

¹⁴⁴ 17 U.S.C. § 102(a) (2002) states:

Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

17 U.S.C. § 102(b) (2002) states: "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."

¹⁴⁵ See, e.g., *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344-45 (1991).

¹⁴⁶ See 17 U.S.C. § 103 (2002); see also *Feist*, 499 U.S. at 1359; *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 543-44 (1985).

¹⁴⁷ See H.R. REP. NO. 94-1476, at 131-32 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5747.

ultimately not copyrightable. For example, a newspaper article is a literary work within the scope of copyright, even if the actual piece contains only facts which are not copyrightable and has no other original expression. The legislative history of Section 301 points to unfixed works, such as unfilmed choreography, to provide an example of a work which is outside the scope of copyright and therefore not preempted.¹⁴⁸

The main dispute in applying the requirement that the work fall within the scope of copyright is determining what the work at issue is. Is it the work in which the right of publicity holder appears or is the work the publicity holder's likeness, name, persona, or voice? Most courts have interpreted the latter as the relevant inquiry.¹⁴⁹ It is widely agreed that a person's name, likeness, voice and persona cannot be copyrighted.¹⁵⁰ Therefore, most courts have concluded that right of publicity claims fall outside the scope of copyright.¹⁵¹ This conclusion means that the right of publicity can never be preempted under Section 301.

The alternative interpretation — treating the work as the one in which the violation occurs — has the opposite problem, because such a view

¹⁴⁸ See *id.*

¹⁴⁹ See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-05 (9th Cir. 2001); *Brown v. Ames*, 201 F.3d 654, 658-59 (5th Cir. 2000); *Wendt v. Host Int'l*, 125 F.3d 806, 810 (9th Cir. 1997); *Wendt v. Host Int'l*, Nos. 93-56318, 93-56510, 1995 U.S. App. LEXIS 5464, at *3 (9th Cir. Mar. 16, 1995); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988); *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 871 (C.D. Cal. 1999), *rev'd on other grounds*, 255 F.3d 1180 (9th Cir. 2001); *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 374-75 (2000); see also MCCARTHY, *supra* note 9, §§ 11:13[c], 11:50; NIMMER, *supra* note 18, § 1.01[B][1][c]; Saxer, *supra* note 124, at 879; *Three Strikes*, *supra* note 129, at 408-10. *But see* Ippolito v. Ono-Lennon, 526 N.Y.S.2d 877, 881-82 (1988) (finding that the work at issue is the copyrighted work in which the performance appears).

¹⁵⁰ See NIMMER, *supra* note 18, § 1.01[B][1][c]. See, e.g., *Brown*, 201 F. 3d at 658-59 (5th Cir. 2000); *KNB Enters.*, 78 Cal. App. 4th at 374-75; *Midler*, 849 F.2d at 462; *Waits*, 978 F.2d at 1100. The RESTATEMENT (THIRD) OF UNFAIR COMPETITION states that the even the "[f]ixation of particular indicia of identity within a work of authorship does not bring the indicia within the subject matter of copyright. Copyright in a photograph or portrait of a person, for example, extends only to the particular depiction, not to the underlying likeness of the person depicted. Similarly, copyright in a film or videotape of a person's performance does not extend to the personal likeness or other identifying characteristics of the performer, and copyright in a sound recording does not create exclusive rights in the identifying characteristics of the performer's voice. Thus, the subject matter of the right of publicity generally lies outside the scope of copyright." RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. i (1995). Nimmer also makes clear that persona does not fall within the scope of copyright nor does a name or likeness. See NIMMER, *supra* note 18, § 1.01[B][1][c].

¹⁵¹ See *supra* notes 149 and 150.

means that the right of publicity is almost always preempted. If the right of publicity were preempted every time a claim involves a copyrighted work, then the state tort would “virtually cease to exist.”¹⁵² In almost every possible example of a right of publicity violation there will be a copyrightable work — after all, commercials are themselves copyrightable. Thus, like the equivalent rights language, the scope of copyright provision does not provide clarity for courts trying to apply Section 301.

C. Deletion of Language From Section 301

As seen in the preceding sections, the legislative history of Section 301 provides little guidance for interpreting the provision.¹⁵³ Worse yet, the deletion of language from the final version of the statute further confuses courts as to Congress’ intent. Initially, Section 301 listed state rights which were different in nature from the rights covered by copyright and which were not meant to be preempted. The original Section 301(b)(3) stated that Section 301 preemption did not limit the rights of:

any state with respect to . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106, including rights against misappropriation not equivalent to any of such exclusive rights, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.¹⁵⁴

¹⁵² Landham v. Lewis Galoob Toys, 227 F.3d 619, 623 (6th Cir. 2000).

¹⁵³ See MCCARTHY, *supra* note 9, § 11.46; NIMMER, *supra* note 18, § 1.01[B] & n.38; *Publicity Never Dies*, *supra* note 129, at 705; *Three Strikes*, *supra* note 129, at 375; Jeffrey A. Trueman, *Is it Live or is it a Soundalike?: Federal Copyrights in Soundalike Recordings and Preemption of State Publicity Claims*, 1 J. INTELL. PROP. 80, 91 (1999); Patrick McNamara, Note, *Copyright Preemption: Effecting the Analysis Prescribed by Section 301*, 24 B.C. L. REV. 963, 967 (1983); Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 814 (1990); Saxer, *supra* note 124, at 879; Yu, *supra* note 42, at 368-70.

The confusion is ironic given Congress’ claim that it was trying to use “the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation . . . and to avoid the development of any vague borderline areas between State and Federal protection.” H.R. REP. NO. 94-1476, at 130-31 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5746.

¹⁵⁴ Language of S.22 as of September 3, 1976, as reported by the Committee on the Judiciary. H.R. REP. NO. 94-1476, at 24 (1976).

These actions were not to be preempted if they contained elements different in kind from copyright infringement.¹⁵⁵ The legislative history suggests that the list incorporated the right of publicity as a state tort which was not meant to be preempted.¹⁵⁶

There is debate over why this language was deleted. There is a suggestion in the record that it was struck because it would have destroyed the intent of Section 301 by failing to preempt state laws which interfered with copyright law, such as the right of publicity.¹⁵⁷ Other parts of the legislative record, however, suggest another reason the language was struck. Some members of Congress thought the language was unnecessary since it was obvious that certain state rights, such as the right of publicity, would not be preempted.¹⁵⁸

Some courts and scholars have taken the position that the legislative history is inconclusive on this issue and have looked elsewhere for guidance on whether the right of publicity can be preempted under Section 301.¹⁵⁹ Other courts have used the deleted language to prove that the right of publicity can never be preempted.¹⁶⁰ This latter view is

¹⁵⁵ See *id.* This language sounds very similar to the extra element test developed by the courts.

¹⁵⁶ See H.R. REP. NO. 94-1476, at 132-33 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5748. "The evolving common law rights of 'privacy,' 'publicity,' and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement. Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract; however, to the extent that the unfair competition concept known as 'interference with contract relations' is merely the equivalent of copyright protection, it would be preempted." H.R. REP. NO. 94-1476 at 132, reprinted in 1976 U.S.C.A.A.N. 5659, 5748.

¹⁵⁷ See MCCARTHY, *supra* note 9, § 11.46.

¹⁵⁸ See 122 Cong. Rec. H. 10910 (Sept. 22, 1976) (relaying an interchange between several congressional representatives); see also MCCARTHY, *supra* note 9, §§ 11:46, 11.48; NIMMER, *supra* note 18, § 1.01[B][1][f].

¹⁵⁹ See, e.g., *Nat'l Car Rental Sys. v. Computer Assocs.*, 991 F.2d 426, 433-34 (8th Cir. 1993); *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 677 n.25 (7th Cir. 1986); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1239 (C.D. Cal. 1987); *Mayer v. Josiah Wedgwood & Sons*, 601 F. Supp. 1523, 1531-32 (S.D.N.Y. 1985); see also MCCARTHY, *supra* note 9, § 11.46; NIMMER, *supra* note 18, § 1.01 [B][1]; Paul Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 UCLA L. REV 1107, 1118 (1977).

¹⁶⁰ See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930, 935 (N.Y. Sup. Ct. 1995); *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *Harper & Row Publishers, Inc. v. Nation Enter.*, 501 F. Supp. 848, 852 (S.D.N.Y. 1980), *rev'd on other grounds*, 471 U.S. 539 (1985); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1096-97 (S.D.N.Y. 1980); *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408, 444 (S.D. Ohio 1980), *aff'd*, 679 F.2d 656 (6th Cir. 1982); *Mitchell v. Penton Indus. Publ'g*, 486 F. Supp. 22, 25 (N.D. Ohio 1979); *Shamsky v. Garan, Inc.*, 632

erroneous because the very language these courts rely on is not in the statute. Given that the reasons for its deletion are unclear, the most logical course of action is to disregard the deleted language.

Overall, Section 301 is a legislative disaster. The current interpretations of the section's language are both illogical and unsupportable. Nonetheless, the most common reading of the section, primarily based on the deleted language, is that it never preempts the right of publicity. Therefore, authority to preempt the right of publicity when it conflicts with copyright law must come from a source outside the Copyright Act.

III. GENERAL PRINCIPLES OF PREEMPTION UNDER THE SUPREMACY CLAUSE

The Supremacy Clause provides the best avenue for remedying the conflict between the right of publicity and copyright law. The Clause establishes a general principle that state laws are preempted when they conflict with the objectives of federal laws or the Constitution.¹⁶¹ The Supreme Court has described three scenarios in which state laws and regulations are preempted by federal law: (1) when Congress expresses "a clear intent to pre-empt state law" in a statutory provision; (2) "when it is clear, despite the absence of explicit pre-emptive language, that Congress has intended, by legislating comprehensively, to occupy an entire field of regulation and has thereby 'left no room for the States to supplement' federal law;"¹⁶² and (3) when compliance with both state and federal law is impossible, or when the state law "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."¹⁶³

N.Y.S.2d 930, 935 (1995); *Ippolito v. Ono-Lennon*, 526 N.Y.S.2d 877, 882 (N.Y. Sup. Ct. 1988).

¹⁶¹ The Supremacy Clause of our Constitution states that "This Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the Supreme Law of the Land; and the Judges in every State shall be bound thereby, anything in the Constitution or Laws of any State to the Contrary notwithstanding." U.S. CONST. art. VI, § 1, cl. 2; see also LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 6-28 (3d ed. 2000).

¹⁶² This is sometimes called "field preemption."

¹⁶³ *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 698-99 (1984) (citations omitted) (quoting *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947); *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)); see also *Fla. Lime & Avocado Growers, Inc. v. Paul*, 373 U.S. 132, 142-143 (1963); THE FEDERALIST NO. 32, at 166 (Alexander Hamilton) (Clinton Rossiter ed., 1999) ("This exclusive delegation or rather this alienation, of State sovereignty would only exist in three cases: where the Constitution in express terms granted an exclusive authority to the Union; where it granted in one instance an authority to the Union, and in another prohibited the States from exercising the like authority; and where it granted an authority

The first type of preemption, an explicit statutory provision, clearly exists in copyright law because of the Section 301 preemption clause contained within the Copyright Act. The second type of preemption, field preemption, does not seem to apply to copyright preemption analysis because there is no evidence that Congress sought to occupy the entire field of intellectual property. Section 301 of the Copyright Act explicitly leaves room for some state laws in the arena of intellectual property which do not fall within the scope of federal copyright protection.¹⁶⁴ In addition, the Supreme Court has explicitly held that states can legislate in the arena of intellectual property.¹⁶⁵

Until recently there was an open question of whether an explicit preemption clause forecloses other avenues of preemption and, in particular, the third type of preemption, conflict preemption.¹⁶⁶ The Supreme Court settled the matter in *Geier v. American Honda Motor Co.*,¹⁶⁷ holding that an explicit preemption clause does not preclude application of the conflict of purposes analysis.¹⁶⁸ As long as Congress has not explicitly stated that the preemption clause of a statute is meant to be the *only* avenue of preemption, the general principles of conflict and field preemption apply.¹⁶⁹ Because neither Section 301 nor its legislative history suggest an abrogation of other preemption principles, conflict

to the Union to which a similar authority in the State would be absolutely and totally contradictory and repugnant.”)

This third form of preemption is sometimes called “conflict preemption.”

¹⁶⁴ See 17 U.S.C. § 301 (2002); see also H.R. REP. NO. 94-1476, at 129-32 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5746-47.

¹⁶⁵ See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165-66 (1989); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478-79 (1974); *Goldstein v. California*, 412 U.S. 546, 552-53, 556-58, 568-69 (1973); see also NIMMER, *supra* note 18, § 1.01 [A].

¹⁶⁶ See, e.g., *Cippollone v. Liggett Group, Inc.*, 505 U.S. 504, 517 (1992).

¹⁶⁷ *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 872 (2000).

¹⁶⁸ See *id.* at 867.

¹⁶⁹ See *id.* at 872. Although the decision in *Geier* was five-to-four and appears to be a matter of some controversy among the Court, the decision is likely to stand. First, as applied to copyright law it is especially likely to stand because the main hesitation of the dissent in *Geier* was based on a deference to traditional state police powers. See *id.* at 907 (Stevens, J., dissenting). This deference makes sense with regards to regulating the safety of automobile designs, but does not make sense in the realm of intellectual property, which has traditionally been under the control of the federal government. Thus, principles of federalism weigh less heavily on states' rights when it comes to copyright preemption. Furthermore, as Justice Scalia's dissent in *Cippollone* points out, there is a serious logical flaw with limiting preemption to the explicit clause. Such a limitation would mean that, when Congress specifically went out of its way to make clear certain parameters of preemption in an explicit clause, there would actually be less protection against interfering state laws than if Congress had just ignored the whole preemption issue altogether. See *Cippollone*, 505 U.S. at 547 (Scalia, J., dissenting).

preemption analysis still applies.¹⁷⁰ Therefore, state law can be preempted even if the state action does not fall under the parameters of Section 301.¹⁷¹

The doctrine of preemption, when state law stands as an obstacle to federal intellectual property laws, has been developed over the years in a handful of patent and copyright cases. These cases provide several important lessons for determining when the right of publicity should and should not be preempted by federal copyright law.¹⁷²

A. Preemption When Conflict With Federal Law's Objectives or Explicit Provision

When the objectives of the laws conflict, the federal law should prevail. The Supreme Court affirmed in *Sears, Roebuck & Co. v. Stiffel Co.*¹⁷³ that "[w]hen state law touches upon [federal patent and copyright statutes], it is 'familiar doctrine' that the federal policy 'may not be set at naught, or its benefits denied' by state law."¹⁷⁴ In other words, state law cannot stand in the way of the objectives of federal law or contradict

¹⁷⁰ The legislative history refers to the *Sears/Compco* line of cases, which discuss conflict preemption in the intellectual property arena, but the record does not suggest a rejection of these cases. See H.R. REP. NO. 94-1476, at 131-32 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5747. In fact, the record expresses a desire to act consistently with these cases. See *id.* But see NIMMER *supra* note 18, § 1.01 [B] ("Because of the existence of Section 301, in order to determine whether state law may grant protection to works of authorship, the courts usually need not gauge whether the federal interest in this field is dominant, whether the field of federal regulation is sufficiently comprehensive to raise an inference of intent to pre-empt or whether any of the other pre-emption tests apply; rather, in general the courts may simply turn to the explicit statutory language.")

Several courts point to the Supreme Court case, *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (upholding a right of publicity claim when the plaintiff's human cannonball act was broadcast in its entirety on a news broadcast), as evidence that the right of publicity is never preempted by copyright laws. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *Landham v. Lewis Galoob Toys*, 227 F.3d 619, 622 (6th Cir. 2000). There is no support for this proposition in *Zacchini*. The Supreme Court did not address copyright preemption in that case and the mere fact that the right of publicity was not preempted in that instance does not stand for the proposition that it is never preempted. In fact, the Supreme Court reiterated in a footnote discussing *Goldstein* that states cannot regulate in the "area of patents and copyrights" if the state laws "conflict with the operation of the laws in this area passed by Congress." See *Zacchini*, 433 U.S. at 577 n.13.

¹⁷¹ See *Geier*, 529 U.S. at 866.

¹⁷² Some scholars have argued that these Supreme Court cases are irreconcilable and represent shifts in the Supreme Court's preemption doctrine over time. See, e.g., MCCARTHY, *supra* note 9, § 11:45. I believe, however, that the cases are consistent with each other and simply represent different facets of preemption analysis.

¹⁷³ *Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225 (1964).

¹⁷⁴ *Id.* at 229 (quoting *Sola Elec. Co. v. Jefferson Elec. Co.*, 317 U.S. 173 (1942)).

explicit provisions of federal statutes.¹⁷⁵

When federal law explicitly precludes something from protection, state laws should not be able to provide protection. For example, in *Sears and Compco Corp. v. Day-Brite Lighting Inc.*,¹⁷⁶ the Court held that state unfair competition laws could not prohibit the copying of a work which was not protected under federal copyright or patent law.¹⁷⁷ Therefore, in both cases, federal patent law preempted a state's unfair competition laws.¹⁷⁸ The Court stressed the importance of strictly limiting the protection of unpatentable works in order to protect the public interest:

To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to patent would be to permit the State to block off from the public something which federal law has said belongs to the public . . . This would be too great an encroachment on the federal patent system to be tolerated.¹⁷⁹

Similarly, in *Bonito Boats v. Thunder Craft Boats, Inc.*,¹⁸⁰ a unanimous Supreme Court held that states could not protect utilitarian and design ideas which patent law does not protect.¹⁸¹ The Court held that such protection would conflict with the balance that patent law strikes between promoting invention and allowing unpatented ideas to remain in the public domain.¹⁸² The Court emphasized that "the federal patent laws must determine not only what is protected, *but also what is free for all to use.*"¹⁸³ The principle here is that the states cannot take something out

¹⁷⁵ See *Geier*, 529 U.S. at 873; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, at 152-53 (1989); *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479 (1974); *Goldstein v. California*, 412 U.S. 546, 561 (1973); *Sears*, 376 U.S. at 229; *Hines v. Davidowitz*, 312 U.S. 52, 66 (1941).

¹⁷⁶ *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

¹⁷⁷ See *Sears*, 376 U.S. at 232-33; *Compco*, 376 U.S. at 237-38.

¹⁷⁸ See *Sears*, 376 U.S. at 232-33; *Compco*, 376 U.S. at 237-38.

In *Sears*, the plaintiff, Stiffel, created a pole lamp for which it had secured design and mechanical patents. See *Sears*, 376 U.S. at 225-26. Sears then developed a nearly identical lamp that it sold for much less than the Stiffel lamp. See *id.* Stiffel sued alleging both patent infringement and violation of Illinois' unfair competition laws based on customer confusion. See *id.*

¹⁷⁹ See *id.* at 231-32.

¹⁸⁰ *Bonito Boats*, 489 U.S. 141 (1989).

¹⁸¹ See *id.* at 144, 168. The plaintiffs in *Bonito Boats* designed a fiberglass recreational boat hull. See *id.* at 144. The defendants used a direct molding process to duplicate the hull. See *id.* at 144-45. A Florida law prohibited the direct molding process. See *id.*

¹⁸² See *id.* at 146.

¹⁸³ See *id.* at 151 (emphasis added); *Ark. Elec. Coop. Corp. v. Ark. Pub. Serv. Comm'n*,

of the public domain that the federal government has granted to the public.

Even though *Sears* and *Compco* were patent cases, their holdings apply equally to copyright law cases. The Court in both *Sears* and *Compco* specifically referred to uncopyrightable items along with unpatentable items in its holdings.¹⁸⁴ Furthermore, the Court in *Goldstein v. California*,¹⁸⁵ a copyright case, affirmed the same principle by stating that "if a State attempted to protect that which Congress intended to be free from restraint or to free that which Congress had protected," then preemption would be appropriate.¹⁸⁶

B. No Preemption When Federal Indifference

When federal law is silent on whether something should be protected or not, the states are free to regulate the area. For example, in *Goldstein*, the defendants were convicted under a California statute that made it a criminal offense to pirate sound recordings.¹⁸⁷ The defendants copied musicians' recordings without compensating the artists or receiving permission.¹⁸⁸ California state law forbade the transfer of "any performance fixed on a tape or record onto other records or tapes with the intention of selling the duplicates, unless [a party has] first received permission."¹⁸⁹ The defendant argued that copyright law preempted the state anti-piracy law because the protection was of an unlimited duration and because sound recordings were not copyrightable.¹⁹⁰

The Court held that the state law was not preempted because Congress was silent on the issue of whether or not sound recordings could be protected.¹⁹¹ At the time the events at issue in *Goldstein* took

461 U.S. 375, 384 (1983) ("A federal decision to forgo regulation in a given area may imply an authoritative federal determination that the area is best left *unregulated*, and in that event would have as much pre-emptive force as a decision *to regulate*.") (emphasis in original).

¹⁸⁴ See *Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225, 232-33 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

¹⁸⁵ 412 U.S. 546 (1973).

¹⁸⁶ See *id.*

¹⁸⁷ See *id.* at 548-51.

¹⁸⁸ See *id.*

¹⁸⁹ See *id.* at 550. The Supreme Court made clear that the statute did not preclude the defendants from hiring their own musicians or even the same musicians as on the recording and making an original sound recording of a song. See *id.* at 550-51.

¹⁹⁰ See *Goldstein*, 412 U.S. at 551.

¹⁹¹ See *id.* at 571. *But see id.* at 574 (Douglas, J., dissenting) (arguing that the state law should be preempted because it provided unlimited protection for a creative work).

place, sound recordings were neither protected nor expressly unprotected by federal law. Therefore, California was free to pass an anti-piracy statute.¹⁹² Furthermore, the Court found that the anti-piracy statute did not stand “as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.”¹⁹³

C. No Preemption When Complementary Objectives

When the justifications for the state law and the federal law are in accordance, then there should be no preemption. The Supreme Court has repeatedly emphasized that states can create laws that protect against consumer confusion by requiring labeling and protecting trade dress or trademarks.¹⁹⁴ Such laws serve to protect the public interest, which is also a primary goal of patent and copyright law. An example of state laws working in conjunction with federal intellectual property laws can be seen in *Kewanee Oil Company v. Bicorn Corporation*.¹⁹⁵

In *Kewanee*, the Court emphasized that trade secret law, governed exclusively by state statutes, generally does not interfere with federal patent law because it does not confer patent-like powers.¹⁹⁶ In particular, trade secret law “does not offer protection against discovery by fair and honest means, such as by independent invention, accidental disclosure,

¹⁹² See *id.* at 571. The Court in *Goldstein* specifically contrasts this with the situation in *Sears and Compco*. *Id.* at 569-70 (reaffirming both precedents). The 1909 Copyright Act did not consider whether sound recordings should or should not be afforded protection. See *id.* at 564-66.

After 1972, sound recordings were protected by copyright law. The Supreme Court suggested in *Goldstein* that if the same case had arisen after the inclusion of sound recordings under copyright’s purview the result would likely have been different. See *id.* at 571. Because the copyright statute now explicitly protects the reproduction rights of sound recordings, such anti-piracy laws should be preempted by federal law which already has provisions to protect sound recording artists and the musical composers of the songs at issue. See *id.*

¹⁹³ See *id.* at 561 (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)). *Goldstein* was read by many courts as a retreat from the broader principles of preemption that the Supreme Court had outlined in *Sears and Compco*. This reading misses the crucial distinction made by the *Goldstein* court which is that if copyright law does not specifically include or exclude a work from copyright protection then states are free to legislate, but when copyright law explicitly excludes something from protection states cannot step in to provide protection. Thus, *Goldstein* is consistent with both *Sears and Compco* and explicitly reaffirms these cases. Furthermore, the unanimous 1989 decision in *Bonito Boats* resolves any lingering doubt regarding the currency of *Sears and Compco*. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

¹⁹⁴ See, e.g., *Bonito Boats*, 489 U.S. at 154; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1965); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964).

¹⁹⁵ *Kewanee Oil Co. v. Bicorn Corp.*, 416 U.S. 470 (1974).

¹⁹⁶ See *id.* at 491.

or by so-called reverse engineering."¹⁹⁷ In fact, trade secret law dovetails with the purposes of patent law by promoting progress and scientific discovery,¹⁹⁸ while at the same time not removing articles from the public domain — a key consideration in a determination of preemption.¹⁹⁹ In addition, the Supreme Court noted that preempting trade secret law would serve to discourage public disclosure — one of the main goals of patent law — because without trade secret protections companies would not want to reveal information to the public.²⁰⁰

Similarly, in *Aronson v. Quick Point Pencil Co.*,²⁰¹ the Supreme Court held that state contract law was not preempted by federal patent law where a contract provided for payment of royalties to a patent applicant who was later denied a patent.²⁰² The Supreme Court held that enforcement of the contract was not inconsistent with any of the principles of patent law.²⁰³ The contract in question encouraged invention, did not withdraw any idea from the public domain, and did not discourage anyone from seeking patent protection.²⁰⁴

Despite the development of these preemption principles, only a few lower courts have analyzed principles of general preemption when determining whether a right of publicity claim is preempted by federal copyright law, and most of these cases were decided prior to the adoption of Section 301 in the 1976 Copyright Act.²⁰⁵ After the adoption of Section 301 many courts have assumed that Section 301 delineates the only way to analyze copyright preemption.²⁰⁶ Even the courts that

¹⁹⁷ *Id.* at 476.

¹⁹⁸ *See id.* at 480-82.

¹⁹⁹ *See id.* at 481, 484. The Supreme Court reiterated that states cannot remove from the public domain items which are dedicated to the public via patent law. *See id.* at 481; *see also* *Lear Inc. v. Adkins*, 395 U.S. 653, 668 (1969) (stating that "Federal laws require that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent.").

²⁰⁰ *See Kewanee Oil Co.*, 416 U.S. at 483, 486-87.

²⁰¹ *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979).

²⁰² *See id.* at 265-66.

²⁰³ *See id.*

²⁰⁴ *See id.* at 262-64.

²⁰⁵ *See, e.g.,* *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-18 (9th Cir. 1970); *CBS, Inc. v. Decosta*, 377 F.2d 315, 317-21 (1st Cir. 1967).

²⁰⁶ *See, e.g.,* *Wendt v. Host Int'l*, Nos. 93-56318, 93-56510, 1995 U.S. App. LEXIS 5464 (9th Cir. Mar. 16, 1995); *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 871-72 (C.D. Cal. 1999), *rev'd on other grounds*, 255 F.3d 1180 (9th Cir. 2001); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *see also* NIMMER, *supra* note 18, § 1.01[B] ("Because of the existence of Section 301, in order to determine whether state law may grant protection to works of authorship, the courts usually need not gauge whether the federal interest in this field is dominant, whether the field of federal regulation is

mention the *Sears/Compco* line of cases and the principle that state laws cannot stand as an obstacle to federal law often continue as if the only way for federal copyright law to preempt the right of publicity is to meet the requirements of Section 301.²⁰⁷ Therefore, despite the existence of the preemption principles arising from the Supremacy Clause, they have not been put to use to remedy the conflicts between state right of publicity actions and federal copyright law.

IV. CRITICISMS OF SUGGESTED SOLUTIONS

Only a handful of solutions have been offered to resolve the conflicts between the right of publicity and copyright law. One of the reasons there have been few well-thought-out solutions to the conflict is that many scholars — including Professor J. Thomas McCarthy, the author of the foremost treatise on the right of publicity — think it is clear that the right of publicity generally is not preempted and believe that this is a positive outcome.²⁰⁸ This complacency emerges in part from a failure to recognize the breadth of the potential conflicts between the two rights and also by a blind adherence to the analysis under Section 301. In addition, some supporters of the right of publicity believe that even if the two rights conflict, performers should win out over what they believe to be more powerful copyright holders.²⁰⁹

The few scholars and judges who do see a problem with the right of publicity have recommended solutions that do not satisfactorily address the problems discussed in Part I. Many of these solutions were developed to remedy the problems arising from the expansion of the right of publicity more generally, especially its clash with the First Amendment, rather than to remedy the specific clash with copyright

sufficiently comprehensive to raise an inference of intent to pre-empt, or whether any of the other pre-emption tests apply; rather, in general the courts may simply turn to the explicit statutory language.”).

²⁰⁷ See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003 (9th Cir. 2001); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623-24 (6th Cir. 2000); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *KNB Enter. v. Matthews*, 78 Cal. App. 4th 362, 368 (2000); *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1918 (1996). *But see* *Brown v. Ames*, 201 F.3d 654, 660 (5th Cir. 2000) (applying principles of conflict preemption but finding that copyright law does not preempt right of publicity).

²⁰⁸ See MCCARTHY, *supra* note 9, § 11.58; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. i (1995); Elliot, *supra* note 124, at 1642-43; Ashley D. Hayes, Note, *The Right of Publicity and Protection of Personae: Preemption Not Required*, 51 SYRACUSE L. REV. 1049 (2001); Trueman, *supra* note 153, at 99.

²⁰⁹ See, e.g., MCCARTHY, *supra* note 9, § 11.58 (arguing that copyright holders should not have a *carte blanche*).

law.

A. Calls for Constricting the Right of Publicity

Several scholars and judges have called for a narrowing of the right of publicity.²¹⁰ David W. Melville and Harvey S. Perlman, for example, argue that the right of publicity should not cover roles or characters that actors play.²¹¹ They also suggest that the right of publicity be limited to the use of the plaintiff's identity, which is within "the direct, personal sphere," such as the plaintiff's name and image, and should not expand beyond this.²¹² Several other scholars and judges have also suggested limiting the right of publicity to name and likeness, thereby eliminating the expansion of the right to persona and voice.²¹³ Furthermore, Melville and Perlman believe that the right of publicity should only apply to advertising and merchandising.²¹⁴

These suggestions have some validity, but view the situation from an ivory tower without consideration of real world practicalities. Despite numerous articles and vociferous dissents suggesting things have gone too far,²¹⁵ the right of publicity has been expanding its scope all across the country. Because the right of publicity is a state tort, each state would have to adopt, either by statute or via the common law, Melville and Perlman's suggestions. The likelihood of such widespread changes taking place is small.²¹⁶ Therefore, the best way to protect copyright law

²¹⁰ See, e.g., *Wendt v. Host Int'l*, 197 F.3d 1284, (9th Cir. 1999) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514-16 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1402-03 (9th Cir. 1992) (Alarcon, J., dissenting); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837-39 (6th Cir. 1983) (Kennedy, J., dissenting); see also Langvardt, *supra* note 10, at 451-52.

²¹¹ See David W. Melville & Harvey S. Perlman, *Protection for Works of Authorship Through the Law of Unfair Competition: Right of Publicity and Common Law Copyright Reconsidered*, 42 ST. LOUIS U. L.J. 363, 402-04 (1998).

²¹² See *id.* at 408.

²¹³ See, e.g., Pesce, *supra* note 153, at 797-99 (1990); see also *supra* note 210.

²¹⁴ See Melville and Perlman, *supra* note 211, at 408.

²¹⁵ See generally Albano, *supra* note 42; Lee Goldman, *Elvis Is Alive, But He Shouldn't Be: The Right of Publicity Revisited*, 1992 BYU L. REV. 597, 601-02 (1992); William N. Heberer III, Comment, *The Overprotection of Celebrity: A Comment on White v. Samsung Elecs. Am., Inc.*, 22 HOFSTRA L. REV. 729, 747-48 (1994); Hill, *supra* note 21; Hoffman, *supra* note 10; Hunt, *supra* note 10; Kwall, *supra* note 21; Langvardt, *supra* note 10; Melville and Perlman, *supra* note 211, at 392-97; Pesce, *supra* note 153, at 794-95; Sanders, *supra* note 21; Yu, *supra* note 42; see also notes 210-11, 213.

²¹⁶ The states have little incentive to reform or coordinate their right of publicity laws. States benefit from a broad right of publicity and have no incentive to limit the state law on the basis of federal law when even federal courts do not see a problem.

is through federal principles of preemption, not through convincing individual states to reform their right of publicity. Federal preemption principles are already in place; courts can solve the problems that arise from the clash of right of publicity and copyright law simply by enforcing Supreme Court precedent.

B. Calls for the Elimination of the Right of Publicity

At least one scholar, Lee Goldman, argues that the right of publicity should not exist at all.²¹⁷ The wholesale elimination of the right of publicity, however, would not be a good outcome. The right of publicity fills a void that is not covered by other actions such as unfair competition, false advertising, and contract law. Consider the most egregious example of a right of publicity violation where an advertiser takes unauthorized and unlicensed photographs of a celebrity and slaps them into a commercial advertisement. The celebrity should be able to stop this use even if there is no consumer confusion regarding the performer's participation. Eliminating the right of publicity will leave this performer with no recourse.

Two of the most often mentioned justifications for the right of publicity demonstrate the importance of retaining the right: the natural rights justification and the unjust enrichment rationale.²¹⁸ The natural

²¹⁷ See Goldman, *supra* note 215, at 625-28.

²¹⁸ I will not address in detail several of the less compelling justifications. For example, the incentive rationale is one of the most frequently mentioned and not particularly compelling justifications for the right of publicity. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563, 576 (1977); see also Cristina Fernandez, *The Right of Publicity on the Internet*, 8 MARQ. SPORTS L.J. 289, 314, 316-18 (1998); Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 110-11 (1994); *Publicity Never Dies*, *supra* note 129, at 681. The only people who are likely to get the lucrative deals are already so well paid that further income is unlikely to provide an additional incentive. In addition, it's hard to believe that young aspiring actors are dreaming of endorsing Palmolive soap or Puritan oil, rather than of winning an Academy Award. The endorsement deals are more akin to a reward for success than to an incentive to create.

Another commonly mentioned justification for right of publicity law is protecting consumers from deceptive advertising. See, e.g., *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 975 (1996); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835, 838-39 (6th Cir. 1983) (Kennedy, J., dissenting); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. c (1995); MCCARTHY, *supra* note 9, § 2.4; Diavaco, *supra* note 68, at 78-79; Fernandez, *supra* note 218, at 314, 318-20; Heberer, *supra* note 215, at 747-48. This is the least compelling of the justifications because no right of publicity law limits actions to those in which consumers are deceived or even where they are likely to be deceived. Furthermore, the Lanham Act and other state torts address such confusion. Section 43(a) of the Lanham Act provides that "any person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into

rights justification suggests that a person has a property interest in his own identity. He should be able to control how his name and likeness are used, and should be compensated for such use.²¹⁹ There are two elements of the natural rights analysis: first, an abstract sense that one should be able to control one's own property, and in particular one's own identity; and second, that a person should be rewarded or compensated for the use of his property especially to the extent that he has cultivated his land or in the case of the right of publicity, his personality.

In addition to the natural rights justification, the next most often mentioned justification for the right of publicity is the unjust enrichment rationale.²²⁰ The justification here is that advertisers, merchandisers, and others who misappropriate another's likeness are being unjustly enriched by getting use of a valuable asset without having to pay for it.²²¹ It is only fair to allow people to control how their own images are used.²²² Most people would be disturbed to look up at a billboard on

commerce" can be held civilly liable. See 15 U.S.C. § 1125(a) (2002).

For discussion of the economics rationale for a right of publicity see MCCARTHY, *supra* note 9, § 2.7; RICHARD A. POSNER, *ECONOMIC ANALYSIS OF LAW* § 3.3 (4th ed. 1992); McCarthy, *A Tribute*, *supra* note 10, at 1711; Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 412-29 (1978).

²¹⁹ See, e.g., *Carson*, 698 F.2d at 838 (Kennedy, J., dissenting); *Cardtoons*, 95 F.3d at 973-75; see also MCCARTHY, *supra* note 9, § 2; Meville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 215-16 (1954) ("It would seem to be a first principle of Anglo-American jurisprudence, an axiom of the most fundamental nature, that every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations."); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. c; Fernandez, *supra* note 218, at 314-16 (naming this "moral" right); Grady, *supra* note 218, at 108-10; McCarthy, *A Tribute*, *supra* note 10, at 1711 (describing this as the most compelling and most important of the justifications).

²²⁰ See *Carson*, 698 F.2d at 837 (Kennedy, J., dissenting); *Cardtoons*, 95 F.3d, at 973-75; *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1282 (D. Minn. 1970); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 134 (1979); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995); MCCARTHY, *supra* note 9, § 2.1; *Diavaco*, *supra* note 68, at 78; Grady, *supra* note 218, at 109-10; *Heberer*, *supra* note 215, at 748; Harry Kalven, Jr., *Privacy in Tort Law — Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966); Nimmer, *The Right of Publicity*, *supra* note 219, at 216.

²²¹ See, e.g., *McFarland v. Miller*, 14 F.3d 912, 922 (3d Cir. 1994) (stating that "[i]t is unfair that one should be permitted to commercialize or exploit or capitalize upon another's name, reputation or accomplishments merely because the owner's accomplishments have become highly publicized.") (quoting *Palmer v. Schonhorn Enters. Inc.*, 232 A.2d 458 (N.J. 1967)).

²²² As Justice Cobb described in *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 80 (Ga. 1905):

The knowledge that one's features and form are being used . . . and displayed . . .

their way to work and see a large photograph of themselves advertising some product when they did not consent to appear in the advertisement. Even though we cannot control all images of ourselves and how they are used,²²³ we should certainly be able to stop someone from making money off of our existence without our permission. Otherwise people, especially celebrities, will be used like puppets with advertisers controlling the strings.

The Supreme Court has explicitly supported state laws which remedy unjust enrichment. In *International News Service v. Associated Press*,²²⁴ the Supreme Court upheld an unfair competition action against a news service based on the logic of not rewarding the defendant for another's labor. The court emphasized that one should not "reap" what one has not "sown."²²⁵

The flip side of unjust enrichment is unjust impoverishment — the notion that artists lose out on revenue from marketing their own identity and the monetary value of their name and likeness is diluted and diminished.²²⁶ This justification is a strong one. If an entity profits from you, you should be compensated. If an entity destroys your chance of profitability, you should have an action.²²⁷ Thus, the right of publicity serves important values which do not conflict with copyright. A wholesale elimination of the right would be detrimental to both artists and the public.

brings . . . even the individual of ordinary sensibility, to a realization that his liberty has been taken away from him, and, as long as the advertiser uses him for these purposes, he can not be otherwise than conscious of the fact that he is, for the time being, under the control of another, that he is no longer free, and that he is in reality a slave without hope of freedom, held to service by a merciless master. *Id.* at 80.

²²³ The First Amendment limits the right of publicity and allows for the use of a person's name and likeness if the value of the speech weighs in favor of allowing the expression. For example, numerous cases have held that the right of publicity does not apply to news reporting or works with entertainment value so long as the main purpose of the works is not the advertising of a material good of commerce. See discussion *supra* Introduction and note 21.

²²⁴ *Int'l News Serv. v. Associated Press*, 248 U.S. 215 (1918).

²²⁵ See *id.* at 239-40.

²²⁶ See, e.g., *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 824 (1979); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 140 (Wis. 1979); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. c (1995).

²²⁷ This justification relies on well-established principles of contract law which seek to protect parties from being wrongly profited off of and impoverished at the hands of others under the theory of quantum meruit or restitution.

C. Calls for a Federal Right of Publicity

Some scholars think a federal right of publicity would best balance federal and state interests while at the same time uniformly protecting performers.²²⁸ Even though such a federal law might be tempting, tort law is traditionally the province of states and state courts.²²⁹ All other privacy actions are under the control of state laws.²³⁰ It does not make sense, nor is it necessary, to have the federal government step in to create a federal tort claim simply because a federal and state right may occasionally conflict. Instead, as I have discussed, there already is a means in place to control the excesses of the right of publicity by applying principles of preemption. Therefore, there is no need to burden federal resources and courts with a federal right of publicity. Furthermore, the likelihood of such a right getting through Congress may be slim given powerful lobbying groups who would oppose such a law.²³¹

D. Calls for Federal Preemption

Even though some scholars have applied principles of preemption to suggest that the right of publicity should be preempted in some circumstances, few have discussed under what circumstances such preemption should take place. Those who have done so have usually thrown their ideas in at the end of their articles without describing how their suggestions will work in practice.²³²

²²⁸ See, e.g., Albano, *supra* note 42, at 290-97; Fernandez, *supra* note 218, at 360-62; Goldman, *supra* note 215, at 628; Lorin L. Reisner, *The Right of Publicity: History and Scope*, 574 PLI/PAT 725, 732 (1999) (describing the ABA's Intellectual Property Section and International Trademark Association as recommending the adoption of a federal right of publicity); Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183 (1998).

²²⁹ Even though there are some notable exceptions such as the Federal Torts Claim Act and employment discrimination statutes, tort law is generally an area for state law.

²³⁰ Originally the right of publicity developed out of privacy law. See Nimmer, *The Right of Publicity*, *supra* note 219, at 204 (describing publicity as "reverse side of the coin of privacy"); William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 401-07 (1960) (describing the tort of appropriation). I think, however, that the right of publicity is more properly analyzed as a property right.

²³¹ The motion picture industry, television studios, and recording studios would no doubt oppose a federal right of publicity.

²³² See, e.g., Aaron A. Bartz, Comment, . . . *And Where It Stops, Nobody Knows: California's Expansive Publicity Rights Threaten the Federal Copyright System*, 27 SW. U. L. REV. 299 (1997) (suggesting the use of general preemption principles but not presenting any specific guidance); Daniel Margolis, Note, *Cheers to the Church Lady: Resolving the Conflict Between Copyright and the Right of Publicity*, 1996 ANN. SURV. AM. L. 627 (1996) (failing to provide a

One commentator, Marc Apfelbaum, suggests that preemption should only apply when the initial work is not in a fixed form, such as was the case in *Zacchini v. Scripps-Howard Broadcasting Co.*²³³ This would severely limit the right of publicity by preventing its applications in most cases. For example, if an unauthorized photograph or movie clip is used in a commercial, then the original work, the photograph, would be in a fixed form and fall outside of Apfelbaum's proposal.

Another suggestion is to preempt the right of publicity whenever it limits the creation of derivative works.²³⁴ Again the parameters of this are not clear, but it seems that the example above of taking a photograph and using it in an advertisement would create a derivative work from the photograph and thus be exempt under such a proposal.

Another scholar, Paul Heald, proposes preempting state law when the state law gives incentives to create a copyrighted work and not preempting it if the incentives are to create a non-copyrighted work.²³⁵ It is difficult to imagine how this would be put into effect and again it seems underprotective of publicity rights. It seems that the most encouraging thing for the creation of copyrighted works would be to eliminate all potential tort liability for any works, but this would mean the wholesale elimination of right of publicity actions. Overall, to date, no good answer has emerged from any of the myriad articles and student notes.

E. Contractual Solutions

Contracts can solve some of the problems associated with the right of publicity's interference with copyright privileges. This is especially true in the classic situation where an actor is hired to appear in a movie or television show. A contract can easily clarify advertising and merchandising rights. But contract law is not a panacea. First, works which were created prior to the advent and proliferation of right of publicity actions do not have associated contracts addressing issues of merchandising or advertising. Second, contracts do not solve the problem when the party being sued was not party to the original

detailed recommendation).

²³³ See Marc J. Apfelbaum, Note, 71 GEO L.J. 1567, 1582 (1983). Recall that in *Zacchini* a television news station broadcast the entirety of Zacchini's live human cannonball act. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

²³⁴ See Margolis, *supra* note 232, at 633.

²³⁵ See Paul Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 IOWA L. REV. 959, 999-1000 (1991).

contract. For example, if a recording artist sues a bar owner for playing her song, the bar owner had no up front opportunity to contract with the artist.²³⁶ It is unrealistic for a bar owner to contract with every performer whose music might possibly be played in his bar. Therefore, licensees and members of the public cannot rely on contract provisions to resolve the conflicts between copyright and the right of publicity.

Additionally, copyright holders should not be penalized for failures to obtain waivers. If a contract is silent on the matter or if there is no contract, the default rule should be that the copyright holder can advertise as well as create and sell merchandise based on the work in which the actor consented to appear. Such rights are a given under copyright law and the actors were contracted with under the "work-for-hire" doctrine in which they gave up all potential copyright claims over the work. Most actors have experienced agents and lawyers who negotiate their contracts and deal memos; they are not the unsophisticated parties that many might initially envision. Obviously, agents cannot work miracles, but actors generally know what they are in for when they sign on to a project.

Another reason to favor copyright holders when a contract is silent on derivative works is that it is more important to provide incentives for the creation of the original work than for the actors to perform in the project. Actors have sufficient economic incentives to perform even if they lose out on merchandising rights because they will still be paid a salary for their work. In addition, the actors whose personalities have the most value will be able to negotiate for additional compensation for merchandising rights. Finally, because of the fundamental primacy of federal law, the rights provided to copyright holders under federal law should prevail over the rights conferred by state law when a contract is silent on the issue.

V. PROPOSED SOLUTION

A. *The Proposed Test*

The primary tenet of copyright preemption should be that all state laws must be preempted, if, as applied, they stand in the way of the purposes and objectives of federal copyright law. This is the basic

²³⁶ Going forward, copyright owners who hire performers can make explicit the ability of the copyright holder to assign the work to third party licensees. Even so, it seems unfair to burden an innocent bar or restaurant owner if a producer poorly drafts a contract.

principle of the Supreme Court's case law on preemption arising out of the Supremacy Clause and it should apply to the right of publicity.²³⁷ To understand when the right of publicity interferes with the objectives of the Copyright Act, a brief review of the purposes behind copyright law is necessary.

The most important goal of copyright law is to provide incentives for innovation and creation.²³⁸ The basis of copyright law is the belief that authors and artists will be encouraged to create if they are compensated for their work. Without adequate compensation, fewer people will devote time to creation, and those who do will spend less time creating works and more time earning enough to support themselves.

There are several other goals of copyright law. One fundamental principle is that authors should be compensated for their work and other people should not be able to use an author's work without permission. This goal, however, is severely limited by a primary tenet of copyright law that facts and ideas must remain in the public domain.²³⁹ In fact, much of copyright law boils down to promoting the public interest. Even the focus on providing incentives to create is based on the ideal of increasing the number of works available to the public.²⁴⁰ As the Supreme Court explained in *Aiken*:

²³⁷ See discussion *supra* Part III.

²³⁸ See U.S. CONST. art. I, § 8; H.R. REP. NO. 94-1476, at 46-47 (1976), reprinted in 1976 U.S.C.A.A.N. 5659, 5660; see also *Goldstein v. California*, 412 U.S. 546, 555 (1973) (describing the purpose of copyright as "to encourage people to devote themselves to intellectual and artistic creation" by "guarantee[ing] to authors and inventors a reward in the form of control over the sale or commercial use of copies of their works."); *Zacchini*, 433 U.S. at 576.

²³⁹ See *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

²⁴⁰ See, e.g., *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts."); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*):

"Intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us. The relatively short life of patents; the longer, but finite, life of copyrights; copyright's idea-expression dichotomy; the fair-use doctrine; the prohibition on copyrighting facts; the compulsory license of television broadcasts and musical compositions; federal preemption of overbroad state intellectual property laws; . . . the right to make soundalike recordings. All of these diminish an intellectual property owner's rights. All let the public use something created by someone else. But all are necessary to maintain a free environment in which creative genius can flourish."

The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. "The sole interest of the United States and the primary object in conferring the monopoly . . . lie in the general benefits derived by the public from the labors of authors."²⁴¹

Because of the complexities of both copyright law and the right of publicity, additional guidance on when the two rights conflict is necessary. Therefore, I have developed a practical approach to determining when copyright law should preempt the right of publicity. Copyright law should preempt the right of publicity when: (1) the right of publicity claim is based solely on appropriation of a "persona" rather than a likeness, image, voice, or name; or (2) the right of publicity holder consented to the original work in which his or her performance²⁴² is captured — and the use is either by the copyright holder or a licensee; or (3) the right of publicity holder consented to the original copyrighted work and the work is used by the public in a way that is explicitly allowed by the Copyright Act.

1. Persona

The *Sears/Compco* line of cases suggests that when copyright law explicitly protects or does not protect a work, the right of publicity should not be able to undo what Congress has established. The Copyright Act explicitly leaves ideas in the public domain. As discussed earlier, persona is simply the idea of a person.²⁴³ Therefore, the right of publicity should not be able to protect persona, just as states cannot protect utilitarian designs under state law.²⁴⁴ Preempting the right of publicity when it is based only on persona preserves the incentive rationale of copyright law by leaving breathing room for creation.

The natural rights and unjust enrichment logic of the right of publicity are not seriously implicated by the use of persona because neither the image nor name, nor even the likeness, of the person is used. In addition, there is no direct competition with obtaining other endorsements since the publicity holder's actual name or likeness was not used. Even

²⁴¹ *Aiken*, 422 U.S. at 156 (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 1263, 127 (1932)).

²⁴² I use the word "performance" for clarity and also because I am focusing on entertainment figures, but the test is just as applicable to nonperformers. One could substitute, for example, the word "image" for "performance."

²⁴³ See discussion *supra* Part I.B.5.

²⁴⁴ See discussion *supra* Part III.

though the publicity holder may have lost out on the advertisement or merchandising revenue in the specific instance at issue, because her name and likeness were not used, the publicity holder's value has not been diluted and customers will still be interested in seeing or hearing the real McCoy.

In contrast, when the work at issue depicts a person's likeness, rather than merely her persona, there would be no preemption. This meshes with the copyright principle that *ideas* are free for the taking but the *expression* of those ideas are not. If an image not only "reminds" people of the right of publicity holder, but also "looks like" the right of publicity holder, then the defendant has taken the expression of the person's identity, not merely the idea of that person.

Although I argue that ideas should not be protected by the right of publicity, facts are another story. Excluding facts from the right of publicity would essentially eliminate the tort. This is true because a person's name and physical features are little more than facts about that person. Even though copyright law leaves facts in the public domain, allowing the right of publicity to protect the name and likeness of a person is not a severe blow to the public. There is a big difference in the harm caused by taking ideas out of the public domain and taking the facts of a person's name and likeness out of the public domain. This is especially true because facts already receive additional protection from the clearly established news exception to the right of publicity and the allowance of the use of facts in biographies and fictional works.²⁴⁵ Furthermore, the First Amendment stands guard against the right of publicity by limiting its ability to prevent the use of facts.

Most importantly, preventing the public from having access to ideas is a much greater constraint on the ability to create than preventing an author from using a name or likeness. For example, the harm from not allowing someone to use the image of a red race car or a big band on New Year's Eve is much greater than that from preventing the use of Motschenbacher's name or a photograph of Guy Lombardo without the publicity holder's permission. Furthermore, the Supreme Court cases on preemption specifically focus on preventing state laws from protecting *ideas*.²⁴⁶

²⁴⁵ See discussion *supra* Introduction and note 20.

²⁴⁶ See discussion *supra* Part III.

2. Consent and Licensed Use

Copyright law should preempt the right of publicity if the right of publicity holder consented to the original use of his or her identity as long as the work at issue was not created by an unlicensed entity.²⁴⁷ Even though consent is a defense to right of publicity claims, it is rarely applied once the work involved in the lawsuit is not the original work. For example, if an actor consented to appear in a movie, and later sues about related merchandising, most courts will not consider the consent to the movie as relevant to the derivative merchandising.²⁴⁸

Extending the principles of consent to derivative works and licensed uses preserves the rights of copyright holders who have already compensated performers for their work. Such a limitation on the right of publicity guarantees copyright holders the right to retain control of their characters, movies, television shows, stories, musical compositions, and related derivative works. This promotes incentives to create by rewarding copyright holders for their work. At the same time, the right of publicity holder is still protected from unauthorized uses of his name or likeness.

3. Uses Explicitly Authorized by the Copyright Act

The third scenario in which preemption should occur is when the Copyright Act explicitly grants the public the right to use the copyrighted work and the publicity holder consented to the original appearance. For example, the public is allowed under the Copyright Act to display copyrighted works. A right of publicity holder who agreed to appear in the original work should not be able to stop the lawful display of such a work. Allowing such authorized uses promotes the public interest by permitting the public to enjoy such works and by promoting the creation of both new and derivative works. Furthermore, the rights of publicity holders are not severely injured by such uses because they agreed to the original work and should have known what rights the copyright holder and the public would be able to exercise as a result.

²⁴⁷ If the copyright of the underlying work has expired, the initial contracts should be treated as still governing and the user should be treated as a licensee.

²⁴⁸ See, e.g., *Landham v. Lewis Galoob Toys*, 227 F.3d 619 (6th Cir. 2000); *Wendt v. Host Int'l Inc.*, 125 F.3d 806 (9th Cir. 1997), *reh'g en banc denied*, 197 F.3d 1284 (9th Cir. 1999), *cert. denied sub nom*, *Paramount Pictures Corp. v. Wendt*, 531 U.S. 811 (2000).

B. Test Suite

The best way to evaluate the efficacy of the proposed test is to apply it to actual and hypothetical situations in which the right of publicity and copyright come into conflict.

1. No Preemption

a. Unlicensed Advertisement

The most obvious example of a right of publicity violation is a commercial that uses the right of publicity holder's image without the permission of either the copyright holder in the original image or the performer. None of the three criteria for preemption under the proposed test applies here.

This is a good outcome because there is only a minimal copyright rationale for allowing such an unauthorized use. First, if the original image was copyrighted then the advertisement is not a copyrightable work because it infringed another's work. Second, the advertiser's ability to create is not severely limited by having to get the permission of either the copyright holder or the performer. If the advertisers are too cheap to take either of these routes then they can come up with a way of making an advertisement that does not infringe on the copyright or publicity rights of others. In addition, the most compelling justifications for a right of publicity apply here because the performer's image was used without his consent or knowledge and the advertiser profited without compensating the performer.

b. Woody Allen Look-Alike

In a print advertisement for a New York videostore, a Woody Allen look-alike stands at a video store counter with videotapes of ANNIE HALL and BANANAS visible on the counter.²⁴⁹ Even though it is clear to the audience that the actor is not Woody Allen (some of the ads even have a disclaimer saying a celebrity double was used), there is little doubt that the videostore is using Woody Allen's likeness for a commercial purpose.²⁵⁰ In this instance, Woody Allen did not consent to such a use.²⁵¹

²⁴⁹ See *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 617-18 (S.D.N.Y. 1985).

²⁵⁰ See *id.* at 624.

²⁵¹ See *id.* at 618.

Under the proposed test, the right of publicity would not be preempted because the use of the Woody Allen look-alike goes beyond mere use of persona. The actor does not simply “remind” people of Woody Allen; he, in fact, *looks like* Woody Allen.²⁵² Therefore, more than just an idea has been evoked — the expression of Woody Allen’s identity has been used. The fact that viewers do not think the look-alike is actually Woody Allen should not immunize the makers of the advertisement who clearly are profiting from the use of Woody Allen’s identity.

c. *Beatlemania*

In *Apple Corp. Ltd. v. Leber*,²⁵³ the defendants staged a production titled *Beatlemania*.²⁵⁴ *Beatlemania* consisted of Beatles look-alike and sound-alike imitators performing Beatles songs live on stage against the backdrop of slides and movies depicting events from the 1960s.²⁵⁵ The producers of *Beatlemania* paid substantial royalties for the licensing of the music in the show.²⁵⁶ The court held that the defendants violated the Beatles’ rights of publicity.²⁵⁷

Under the proposed test, the right of publicity would not be preempted because the defendants profited from their use of the Beatles’ names and likenesses.²⁵⁸ The title of the show, *Beatlemania*, explicitly referred to the Beatles and much more than the mere persona of the Beatles was used in the show. Undoubtedly, the audiences who flocked to the show were drawn by the attraction of seeing an imitation Beatles concert.

Even though copyright law allows the public performance of the Beatles’ music, it does not authorize the copying of the band’s likeness and stage show. This meshes with the objectives of copyright law by providing incentives for the Beatles to create artistic works, while not overly limiting the options of the defendants to create new works. The

²⁵² To the extent that a jury found otherwise this case could come out differently.

²⁵³ *Apple Corp. v. Leber*, 229 U.S.P.Q. 1015, 1986 WL 215081 (Cal. App. Dep’t. Super. Ct. 1986).

²⁵⁴ *See id.* at 1016.

²⁵⁵ *See id.*

²⁵⁶ *See id.* at 1016, 1017-18.

²⁵⁷ *See id.* at 1017.

²⁵⁸ There is a potential First Amendment defense for the defendants here — after all, a biographical picture or musical about the Beatles would be protected by the First Amendment. However, here the performance was primarily a concert emulating an actual Beatles concert. For this reason, the court found that the First Amendment did not protect the production. *See Apple Corp.*, 229 U.S.P.Q.

defendants were free to sing Beatles songs in public or to do a show about the 1960s music scene. Although the Beatles had disbanded by the time *Beatlemania* toured, the Beatles corporation, Apple Corps., could have profited from producing or licensing imitation acts itself, and should have been reimbursed for the right to do so.

2. Preemption of Persona-based Claims

a. *White* — The *Wheel of Fortune* Advertisement

In *White*,²⁵⁹ one of Samsung's ads depicted a futuristic robot in a blonde wig turning letters on a screen, much like Vanna White does on the *Wheel of Fortune* show.²⁶⁰ The Ninth Circuit reversed the lower court's dismissal of White's right of publicity claim, and held that Samsung's commercial could be found to have violated White's right of publicity solely on the basis of its use of White's persona.²⁶¹

In contrast, under the proposed test, White's right of publicity claim would be preempted by copyright law because only her persona was evoked.²⁶² The advertisement may have reminded viewers of Vanna White, but the robot was not a *likeness* of White — instead it evoked the idea of a blond model turning letters on the *Wheel of Fortune* set.

Allowing Samsung to use the idea of a model who turns letters is directly in line with the directives of copyright that ideas belong to the public. Furthermore, there is no need to use the right of publicity to reward or give incentives for White's creative work since so little of what Samsung took was of her creation. White did not create the concept for *Wheel of Fortune* or the idea of having a beautiful model turn letters.²⁶³ If Samsung violated anyone's property rights it was Merv Griffin's copyright to the show *Wheel of Fortune*. Allowing White's right of publicity action here might also allow White to prevent the show's producers from hiring another blonde model to press the computer screens or turn the letters.

²⁵⁹ *White v. Samsung Elecs. Am. Inc.*, 971 F.2d 1395 (9th Cir. 1992).

²⁶⁰ *See id.* at 1399; *see also* discussion *supra* Part I.B.5.

²⁶¹ *See id.*

²⁶² I do not address the argument that White's right of publicity claim should not have prevailed because the parody/First Amendment exception should have been extended to commercial speech, although I think such an argument is meritorious. *See White v. Samsung Elecs. Am. Corp.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing *en banc*).

²⁶³ To the extent that White adds anything unique and creative to the show, it is in her banter with her co-host and the way in which she turns, or now pushes, the letters.

b. *Hirsch*—Crazylegs Advertisement

A famous football player, named Hirsch, known by his nickname “Crazylegs”, sued for a violation of his right of publicity when a women’s shaving gel named Crazylegs advertised on television.²⁶⁴ The Wisconsin court allowed his right of publicity action to go forward to a jury.²⁶⁵

Under the proposed test, Hirsch’s right of publicity would be preempted by copyright law. Calling a product “Crazylegs” at most evokes Hirsch’s persona. His actual name is not used nor is his likeness. Nor is there any reason to associate Hirsch with a women’s shaving gel — few people watching the commercial are likely to bring to mind the image of a large burly football player. Hirsch’s nickname should not prevent others from using the phrase. After all, it is simply an idea protected by copyright law. As discussed earlier, protecting such words would lead to absurd results such as allowing O. J. Simpson, nicknamed “the Juice,” to control the word “juice” and prevent companies from making products such as “Juice Squeezes” and “Juicy Fruits.”²⁶⁶

c. *Lombardo*

In *Lombardo*, the famous bandleader Guy Lombardo sued the makers of a television commercial that showed a big band playing “Auld Lang Syne” on New Year’s Eve.²⁶⁷ The court held that Lombardo’s right of publicity was violated by the use.²⁶⁸

Under the proposed test, Lombardo’s claim would be preempted since at most his persona was evoked. Lombardo cannot claim a monopoly on the idea of a bandleader playing the most common New Year’s Eve tune. Leaving this idea free to the public furthers the ability of others to create new works and allows other performers to act and sing. Lombardo’s commercial value will not be seriously undercut since people will still want to see Lombardo, rather than an impersonator, perform or endorse various products. Ultimately, the commercial did not profit from Lombardo’s identity, but rather from people’s pleasant associations of a big band playing a New Year’s Eve favorite.

²⁶⁴ See *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 130-32 (Wis. 1979).

²⁶⁵ See *id.* at 138.

²⁶⁶ See discussion *supra* Part I.B.5.

²⁶⁷ See *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661, 664 (1977); see also discussion *supra* Part I.B.5.

²⁶⁸ *Lombardo*, 396 N.Y.S.2d at 664-65.

3. Preemption Because of Authorized or Licensed Use

a. *Baltimore Orioles*

In *Baltimore Orioles*, baseball players tried to stop the broadcast of baseball games in which they had agreed to play.²⁶⁹ The Seventh Circuit, in an unusual and at the time unprecedented decision, found that the right of publicity claim was preempted by federal copyright law.²⁷⁰

The players' right of publicity claim would also be preempted under the proposed test. The players agreed to appear in the original work knowing it would be broadcast and the copyright holders did nothing more than distribute and publicly broadcast the game. Protecting the copyright holders' rights here gives them the incentive to continue to produce baseball games and telecasts. By contrast, there is a slim chance that ballplayers will be discouraged from playing if they are not additionally compensated for the broadcasts on top of their underlying contracts.

b. *Fleet*

In *Fleet*, actors who had agreed to perform in a motion picture tried to block its distribution.²⁷¹ The court dismissed the actors' right of publicity actions because they were preempted by copyright law.²⁷²

The proposed test would yield the same result. The right of publicity would be preempted because the actors consented to the original work and the distribution of the film was a lawful exercise of the copyright holder's privileges. No actor would be surprised to discover that the movie he performed in was going to be distributed. In fact, actors pray that the films they appear in will be released to the public. Preempting the right of publicity claim here promotes the incentives necessary for copyright holders to continue to produce films and to pay actors to appear in them.

c. *Wendt*

In *Wendt*, the Ninth Circuit held that the actors from *Cheers* could prevent the copyright holder and its licensees from creating derivative

²⁶⁹ See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 665-66 (7th Cir. 1986).

²⁷⁰ See *id.* at 679.

²⁷¹ See *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1913-14 (1996).

²⁷² See *id.* at 1920-25.

works based on the characters of Norm and Cliff in the television series.²⁷³ Specifically, the actors were able to stop the use of animatronic robots based on the characters.²⁷⁴

Under the proposed test, the right of publicity would be preempted because Wendt and Ratzenberger consented to the original work and the creation of derivative works from the original is an authorized and foreseeable use under copyright law. This outcome fits with the joint purposes of both copyright and the right of publicity in rewarding creation. The creators of *Cheers* are rewarded for their imagination and success which will encourage them and other potential television writers and producers to create more shows.

Most importantly, the producers and writers of *Cheers* — not Ratzenberger or Wendt — invented, cast, costumed, and wrote dialogue for the now recognizable characters Norm and Cliff, thereby creating the characters' identities.²⁷⁵ If the actors' rights of publicity trump the copyright holders' rights in this instance, the creators of fictional characters lose all control over their characters as soon as actors portray the roles. This would severely hamper not only merchandising rights, but also the ability to make sequels, prequels, and spin-offs. Such severe constraints on the future uses of characters would discourage the creation of new works by writers and producers.²⁷⁶ In contrast, the actors from the show will not be discouraged from working in the future since the use of the characters in an airport bar in no way diminishes their value separately as actors in future shows. An imitation robot will not satisfy the desires of the public to see Ratzenberger and Wendt in advertisements or in new roles.

In addition, Wendt and Ratzenberger's right of publicity claims would be preempted under the proposed test because liability was based solely on persona. The robots did not look like Wendt or Ratzenberger, but instead simply reminded the court of the actors. In this circumstance, their right of publicity claim should be preempted because it is solely

²⁷³ See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 809, 811 (9th Cir. 1997), *reh'g en banc denied*, 197 F.3d 1284 (9th Cir. 1999), *cert. denied sub nom.*, *Paramount Pictures Corp. v. Wendt*, 531 U.S. 811 (2000).

²⁷⁴ See *id.*

²⁷⁵ It is true that the actors added substantially to the characters and that Norm and Cliff would be very different characters if played by other actors. Nonetheless, the actors were hired under work-for-hire provisions and under American copyright law relinquish any ownership claims over the product. The actors should not be able to use the right of publicity to achieve ex post facto what they could not achieve at the outset.

²⁷⁶ See discussion *supra* Part I.A.

based on persona.²⁷⁷

d. *Shamsky* — Mets T-shirts

In *Shamsky v. Garan, Inc.*,²⁷⁸ members of the 1969 World Series Champion New York Mets sued the defendant for selling a t-shirt with a group portrait of the team.²⁷⁹ The t-shirt was licensed by Major League Baseball.²⁸⁰ Despite the licensing agreement, the New York court held that the players' rights of publicity had been violated.²⁸¹

In contrast, under the proposed test, the right of publicity would be preempted because the defendant was authorized to use the copyrighted photograph. Even though the players' images were used, the players agreed to appear in the photograph and such pictures were within the scope of their employment. Thus, if the players had a problem with the merchandising they should have sued for a contract violation, not a right of publicity claim.²⁸²

If a situation arose in which the t-shirt was not licensed, then there should be no preemption. In fact, in this instance, there would be a copyright infringement violation as well as a right of publicity violation. It makes sense to allow the players to be able to sue directly for a right of publicity violation rather than trying to assert the rights of third party copyright holders or needing to convince the copyright holders to bring suit themselves. In this alternative scenario, the interests of the original copyright holder and the right of publicity holders are in alignment so there is no conflict between the two rights. In addition, copyright law would not protect the unlicensed t-shirt because the work is an unlicensed derivative work.

e. *Ahn* — *Mortal Kombat* Videogame

In *Ahn v. Midway Mfg. Co.*,²⁸³ videogame makers used digitized performances by martial artists in multiple versions of a *Mortal Kombat* videogame.²⁸⁴ The artists had explicitly agreed to the use of their images

²⁷⁷ See discussion *supra* Parts I.B.5 and V.A.1.

²⁷⁸ 632 N.Y.S.2d. 930 (1995)

²⁷⁹ See *id.* at 931-32.

²⁸⁰ See *id.*

²⁸¹ See *id.* at 935-37.

²⁸² This is assuming their contract limited the use of photographs in future merchandising.

²⁸³ 965 F. Supp. 1134 (N.D. Ill. 1997).

²⁸⁴ See *id.* at 1136-37.

in the first version.²⁸⁵ The contract was silent on derivative rights. The plaintiffs, however, alleged that verbal representations were made that there would be additional compensation for such derivative works.²⁸⁶ The court followed the Seventh Circuit precedent in its holding that the artists' rights of publicity were preempted.²⁸⁷

Under the proposed test, the right of publicity actions would also be preempted. The plaintiffs agreed to the digitizing of their performances for use in the original videogame and did not explicitly state in the contract that further permission was required in order for the defendants to make derivative works using their images. The creation of the derivative home version of the game is explicitly authorized by copyright law and was a foreseeable use of the consented-to performance. Protecting the copyright holders in this instance promotes incentives to create videogames and does not unfairly profit off of the actors. If the actors wanted further compensation for derivative works they should have put it into their contract. To the extent that the actors thought such a use exceeded the scope of their contract, they could sue on a contractual basis for damages or further compensation.

4. Preemption Under Explicit Copyright Provisions

a. *Friends* Broadcast in Bar

Suppose a bar owner has television sets playing in the bar, and a *Friends* episode is on. Outraged, Brad Pitt encourages Jennifer Aniston to sue the bar owner for a right of publicity violation. Under the proposed test, the right of publicity would be preempted because Aniston agreed to appear in the *Friends* episode and copyright law explicitly allows such broadcast transmissions without requiring additional compensation.²⁸⁸

This outcome is in keeping with the focus on giving incentives to create in both copyright and right of publicity law. Broadcasters and show creators need compensation for their work. If right of publicity holders can shut down broadcasts, both creators and broadcasters lose out on advertising revenue and producing fees. Furthermore, Aniston agreed to the original broadcasts and was handsomely paid for her

²⁸⁵ *See id.*

²⁸⁶ *See id.*

²⁸⁷ *See id.* at 1138-40.

²⁸⁸ *See* 17 U.S.C. § 110(5)(A) (2002).

performance.²⁸⁹ She certainly knew that the show would be widely broadcast. Furthermore, the public interest in being able to enjoy such broadcasts is specifically protected by copyright law in an effort to leave certain things freely available to the public.²⁹⁰

b. Bar Playing a Madonna CD

Suppose a bar has a CD player and the bartender pops in her favorite Madonna CD and presses play. This action is allowed under copyright law as long as the bar owner pays ASCAP/BMI for the use of the musical composition. Nevertheless, Madonna could sue for the use of her voice for a commercial purpose in a drinking establishment.²⁹¹

Under the proposed test, Madonna's claim would be preempted. Madonna agreed to the initial recording and was compensated for doing so. She knew how that recording could be used and undoubtedly that recording artists are not compensated for public performances. Copyright law explicitly denies copyright holders in sound recordings a right of public performance.²⁹² Madonna should not be able to use the right of publicity to create a property right in a sound recording when this is specifically forbidden by copyright law.

c. *Midler*

In *Midler*, the defendant made a television commercial using a performer who imitated Midler's voice.²⁹³ The defendant had lawfully licensed the song.²⁹⁴ The Ninth Circuit held that this use violated Midler's right of publicity.²⁹⁵

In contrast, under the proposed test, Midler's right of publicity would be preempted because such sound-alike recordings are explicitly allowed under copyright law.²⁹⁶ Congress specifically chose to give composers rather than recording artists control over a musical composition. The use of the right of publicity to prevent the re-recording of licensed compositions clearly conflicts with the Copyright Act. It makes sense to reward composers for their musical compositions rather than recording

²⁸⁹ Aniston is also paid residuals under her SAG contract.

²⁹⁰ See discussion *supra* Parts I.A.2. and I.B.2.

²⁹¹ See discussion *supra* Parts I.A.2. and I.B.2.

²⁹² See 17 U.S.C. § 106 (2002); see also discussion *supra* Part I.A.2. and I.B.2.

²⁹³ See *Midler v. Ford Motor Co.*, 849 F.2d 460, 461-43 (9th Cir. 1988).

²⁹⁴ See *id.*

²⁹⁵ See *id.* at 463.

²⁹⁶ See discussion *supra* Parts I.B.4. and V.A.3.

artists, who often have little or nothing to do with the creation of the song. Without the underlying music, the recording artist would have nothing to record.

Furthermore, more often than not it is the recording artist with the public personality who garners the lucrative deals for her recordings upfront, while composers rely on royalties to support their music careers. In addition, Midler's natural rights were not affected because her actual voice was not used. To the extent that she is concerned that consumers will think the inferior singer was her, she can sue under the Lanham Act for the creation of consumer confusion.²⁹⁷

It is worth pointing out that under the proposed test, the Midler sound-alike should be preempted because of Section 114, not because it is based on use of her persona. A sound-alike is akin to a look-alike, and would fall outside a persona-based claim. Using sound-alikes may, in fact, be unfair to performers in the same way that using a look-alike in an advertisement seems unfair. In order for Midler to succeed, however, the underlying copyright law allowing for sound-alike recordings needs to be amended.

d. Display of Posters in Restaurant/Bar

Suppose a bar called *Hollywood Stars* tries to capitalize on the success and allure of Hollywood movies by putting up posters from various movies along its walls. One of the posters is from *TERMINATOR* and shows Arnold Schwarzenegger's picture. If Schwarzenegger walks into the bar and sees the poster of himself, should he be able to win a right of publicity claim?

Under the proposed test, the right of publicity would be preempted because Schwarzenegger agreed to appear in the movie, was compensated for doing so, and the display of such derivative works as the posters is explicitly allowed under copyright law. This outcome encourages the producers of the movie to create by rewarding them with profits from merchandising. There would undoubtedly be fewer poster purchases if one could not publicly display them. The creators of the movie should certainly be able both to profit from and to advertise their film through movie posters.

²⁹⁷ See Lanham Act § 43 (a), 15 U.S.C. 1125(a) (2002).

CONCLUSION

If the right of publicity continues to have free reign there will be great financial injury to copyright holders and enormous losses to the public. There will be fewer incentives to create new works and more limitations on the works that are produced. Celebrities and other publicity holders will be able to determine what we are free to look at, listen to, and display.

As courts expand the right of publicity further and further from its origins, it is increasingly important to set clear limits for when copyright law preempts this state tort. The reliance on Section 301 of the Copyright Act for a solution to the clash between copyright law and the right of publicity is misplaced. Section 301 does not provide sufficient guidance for preempting state rights and in practice has been used to immunize the right of publicity from preemption altogether.

Section 301, however, is not the sole basis for preemption. Despite being overlooked, the preemption principles arising out of the Supremacy Clause are as valid in the world of copyright as anywhere else. There are many advantages to adopting the conflict preemption approach. First, the Supreme Court has developed, through a series of cases, detailed principles for applying conflict preemption to intellectual property. Second, preemption using the Supremacy Clause is already in place and does not require legislative action either at the federal or state level. Finally, it has the flexibility to apply to any new situation which the right of publicity may be stretched to cover in the future.

The test proposed in this article uses a practical approach to identify when the right of publicity interferes with the objectives of copyright. Courts must preempt the right of publicity when it is based solely on persona, is used to thwart a copyright holder's lawful exercise of rights to which the publicity holder consented, or when the Copyright Act explicitly permits the use at issue. These guidelines will work in any future conflict between the two rights even as the right of publicity expands and even as new media emerge. If courts continue to turn a blind eye to the problems of an unpreempted right of publicity, we will lose the rich tradition of unfettered creativity which copyright law seeks to preserve.
