

# THE RIGHT OF PUBLICITY

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Louis Brandeis and Samuel Warren in their essay "The Right to Privacy"<sup>1</sup> produced what is perhaps the most famous and certainly the most influential law review article ever written. In the words of Roscoe Pound, it did "nothing less than add a chapter to our law."<sup>2</sup> It was primarily due to the persuasiveness of this article that first Georgia<sup>3</sup> and then 14 other states<sup>4</sup> came to recognize a common law right of privacy. Furthermore, when the New York Court of Appeals rejected the Brandeis-Warren arguments and refused to recognize a common law right of privacy,<sup>5</sup> the New York Legislature instituted legislation<sup>6</sup> which in some ways has extended the scope of privacy actions even beyond that envisaged by Brandeis and Warren. Moreover, two states have since adopted privacy statutes substantially similar to the New York statute.<sup>7</sup>

But although the concept of privacy which Brandeis and Warren evolved fulfilled the demands of Beacon Street in 1890, it may seriously be doubted that the application of this concept satisfactorily meets the needs of Broadway and Hollywood in 1954. Brandeis and Warren were concerned with the preservation of privacy against a press "overstepping in every direction the obvious bounds of propriety and of decency," and in which "to satisfy a prurient taste the details of sexual relations are spread broadcast in the columns of the daily papers."<sup>8</sup> Without in any way implying that the right of privacy is less important today than when first suggested by Brandeis and Warren, it is suggested that the doctrine, first developed to protect the sensibilities of nineteenth century Brahmin Boston, is not adequate to meet the demands of the second half of the twentieth century, particularly with respect to the advertising, motion picture, television, and radio industries. Well known personalities connected with these industries do not seek the "solitude and privacy"<sup>9</sup> which

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<sup>1</sup> 4 HARV. L. REV. 193 (1890).

<sup>2</sup> Quoted in A. T. MASON, *BRANDEIS, A FREE MAN'S LIFE* 70 (1946).

<sup>3</sup> *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S. E. 68 (1904).

<sup>4</sup> Alabama, Arizona, California, Florida, Illinois, Indiana, Kansas, Kentucky, Michigan, Missouri, Montana, North Carolina, Oregon, and Pennsylvania.

<sup>5</sup> *Roberson v. Rochester Folding Box Co.*, 171 N. Y. 538, 64 N. E. 442 (1902).

<sup>6</sup> N. Y. CIVIL RIGHTS LAW §550, 51 (1948).

<sup>7</sup> Utah and Virginia. Wisconsin also gives some protection to the right of privacy. See Yankwich, *The Right of Privacy*, 27 NOTRE DAME LAW. 499, 521 (1952).

<sup>8</sup> Warren and Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 196 (1890).

<sup>9</sup> Warren and Brandeis, *supra* note 8, at 196.

Brandeis and Warren sought to protect. Indeed, privacy is the one thing they do "not want, or need."<sup>10</sup> Their concern is rather with publicity, which may be regarded as the reverse side of the coin of privacy. However, although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him. With the tremendous strides in communications, advertising, and entertainment techniques, the public personality has found that the use of his name, photograph, and likeness has taken on a pecuniary value undreamed of at the turn of the century. Often, however, this important value (which will be referred to in this article as publicity value) cannot be legally protected either under a privacy theory or under any other traditional legal theory. Recently a few cases have begun to indicate that publicity values are emerging as a legally cognizable right protectible without resort to the more traditional legal theories. This tendency reached its culmination in *Haclan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>11</sup> where the Court of Appeals for the Second Circuit in an opinion written by Judge Jerome Frank expressly recognized a "right of publicity." This article will attempt to outline the inadequacy of traditional legal theories in protecting publicity values, and will then discuss the probable substance of and limitations on the right of publicity, followed by an examination of the extent of judicial recognition thus far accorded to this new right.

#### INADEQUACY OF PRIVACY

Those persons and enterprises in the entertainment and allied industries wishing to control but not prohibit the use by others of their own or their employees' names and portraits will find, for the reasons indicated below, that the right of privacy is generally an unsatisfactory means of assuring such control.

*Waiver by Celebrities.* It is generally the person who has achieved the somewhat ephemeral status of "celebrity" who must cope with the unauthorized use by others of his name and portrait, since the fact of his fame makes such use commercially attractive to others. Yet, when such a person seeks to invoke the right of privacy to protect himself from such unauthorized use, he finds that by the very fact of his being a celebrity "he has dedicated his life to the public and thereby waived his right to privacy."<sup>12</sup> Some courts find this waiver to be absolute so that even aspects of the celebrity's private life which he has never made public no longer command the protection of the law of privacy.<sup>13</sup> Most courts, however, have adopted the more limited waiver which Brandeis and Warren suggested when they wrote: "to

<sup>10</sup> *Gautier v. Pro-Football*, 304 N. Y. 354, 361, 107 N. E. 2d 485, 489 (1952).

<sup>11</sup> 202 F. 2d 866 (2d Cir. 1953).

<sup>12</sup> Leon R. Yankwich, Chief Judge, United States District Court for the Southern District of California, in his article, *The Right of Privacy*, 27 NOTRE DAME LAW. 499 (1952).

<sup>13</sup> *Donahue v. Warner Bros. Pictures*, District Court of the Third Judicial District, State of Utah, No. 87,714 (1952). This case had been transferred from the federal courts after the Court of Appeals for the Tenth Circuit, in 194 F. 2d 6 (10th Cir. 1952), reversed the summary judgment entered for the defendant, in the federal district court. See *Peay v. Curtis Publishing Co.*, 78 F. Supp. 305 (D. D. C. 1948); and *Reed v. Real Detective Publishing Co.*, 162 P. 2d 133 (Sup. Ct. Ariz. 1945).

whatever degree and in whatever connection a man's life has ceased to be private . . . to that extent the protection is to be withdrawn."<sup>14</sup> Thus the fact that an actor has waived his right of privacy with respect to his professional life, does not mean that he has no right of privacy in connection with his private life. This doctrine permits the celebrity to maintain the privacy of his non-professional life, but it does not protect him from the appropriation by others of the valuable use of his name and portrait, showing him in the capacity or role which he has made famous. Thus it was held in *O'Brien v. Pabst Sales Co.*<sup>15</sup> that the plaintiff could not invoke the right of privacy to prevent the defendant from using his photograph in football uniform on a calendar because the plaintiff, having been the most publicized football player of the year 1938-1939, had thereby surrendered his right of privacy. Again, in *Martin v. F. I. Y. Theatre Co.*,<sup>16</sup> the plaintiff, an actress, brought an action for invasion of privacy on the ground that the defendant had without plaintiff's permission placed a photograph of her on the front of defendant's burlesque theatre, although plaintiff was not appearing in the theatre. The court found for defendant on the ground that the plaintiff as an actress had previously surrendered her right of privacy.<sup>17</sup> Similarly in *Paramount Pictures, Inc. v. Leader Press, Inc.*<sup>18</sup> it was held that motion picture stars in the employ of the plaintiff had waived their right to privacy so that the defendant could with impunity make and sell posters bearing the names and portraits of the Paramount stars.

Some courts have taken a more limited approach to the doctrine of waiver by celebrities. These courts hold that the mere fact that the plaintiff is a celebrity will not affect his right of privacy, but that if a person consents to appear or perform before a limited audience (*e.g.*, a live audience in the immediate presence of the performer), then such person cannot complain of an invasion of privacy if by means of motion pictures, still pictures or live television persons other than the limited audience also view the performance or appearance. However, even this limited waiver can be highly injurious to a professional performer. Thus, in *Gautier v. Pro-Football, Inc.*<sup>19</sup> the plaintiff, having consented to perform before an audience of thirty-five thousand persons during the half time of a professional football game, was held to have waived his privacy with respect to the persons who might view this performance by television. Certainly one cannot quarrel with the court's conclusion that plaintiff by performing in the football stadium had consented to the loss of his "privacy," but to conclude that the plaintiff had thereby waived any right to control and profit from the reproduction of his image on television seems to be unnecessarily

<sup>14</sup> Warren and Brandeis, *supra* note 8, at 215.

<sup>15</sup> 124 F. 2d 167 (5th Cir. 1941).

<sup>16</sup> 10 Ohio Ops. 338 (1938).

<sup>17</sup> A similar factual situation occurred in *Loftus v. Greenwich Lithographing Co.*, 192 App. Div. 251, 182 N. Y. S. 428 (1st Dep't 1920), where plaintiff's right of privacy under the New York statute was upheld. The issue of waiver apparently was not raised. Cf. *Sinclair v. Postal Telegraph and Cable Co.*, 72 N. Y. S. 2d 841 (1935); *Semler v. Ultem Publications*, 170 Misc. 551, 9 N. Y. S. 2d 319 (N. Y. City Ct. 1938); *Lane v. F. W. Woolworth Co.*, 171 Misc. 66, 11 N. Y. S. 2d 199 (Sup. Ct. 1939); and *Young v. Greneker Studios*, 175 Misc. 1027, 26 N. Y. S. 2d 357 (Sup. Ct. 1941).

<sup>18</sup> 24 F. Supp. 1004 (W. D. Okla. 1938), *reversed on other grounds*, 106 F. 2d 229 (10th Cir. 1939).

<sup>19</sup> 304 N. Y. 354, 107 N. E. 2d 485 (1952).

harsh. Similarly, in *Chavez v. Hollywood American Legion Post No. 43*,<sup>20</sup> a California court denied a prize fighter a preliminary injunction to restrain a broadcasting station from televising a prize fight in which he was participating. The court in an oral opinion stated that a prize fighter who participates in a public boxing match waives his right of privacy as to that fight.<sup>21</sup> The California Supreme Court in *Gill v. Hearst Publishing Co.*<sup>22</sup> invoked this same doctrine in connection with a still photograph made of the plaintiffs in a public market. The court stated that "the photograph did not disclose anything which until then had been private, but rather only extended knowledge of the particular incident to a somewhat larger public than had actually witnessed it at the time of occurrence."<sup>23</sup> However, the court nevertheless indicated that if plaintiffs could establish that defendant consented to a use of the photograph in a manner which would be offensive to persons of ordinary sensibilities, then a cause of action for invasion of privacy would be stated.<sup>24</sup> Thus, apparently in California the fact that plaintiff consents to appear before a limited audience does not waive the right of privacy as to a more extensive audience where the exhibition is made in an offensive manner.<sup>25</sup>

Although the doctrine of waiver in privacy cases is not always<sup>26</sup> nor uniformly<sup>27</sup> applied, it nevertheless presents a very real obstacle to the protection by a well known personality of the publicity values which often constitute an important part of his assets.

*Offensive Use.* It is reported that Brandeis and Warren first became interested in the problem of privacy and decided to write their article as a direct result of a Boston newspaper's practice of reporting in lurid detail the activities of Samuel Warren and his wife.<sup>28</sup> Thus, the doctrine of privacy was evolved as a means of

<sup>20</sup> 16 U. S. L. WEEK 2362 (U. S. Feb. 3, 1948).

<sup>21</sup> See also *Peterson v. KMTR Radio Corp.*, 18 U. S. L. WEEK 2044 (U. S. July 26, 1949). It should be noted, however, that the *Gautier*, *Chavez*, and *Peterson* cases all involved employment relationships. It might well be argued that in the absence of an express reservation by the employee, he should be deemed to have granted to his employer the right to exhibit the performance for which he is employed in any medium which the employer may choose.

<sup>22</sup> 40 Cal. 2d 224, 253 P. 2d 441 (1953).

<sup>23</sup> 40 Cal. 2d at 230, 253 P. 2d at 445.

<sup>24</sup> *Accord*, *Gill v. Curtis Publishing Co.*, 38 Cal. 2d 273, 239 P. 2d 630 (1952).

<sup>25</sup> It may be argued that the doctrine of waiver in California is introduced merely as a makeweight and that if the use of the plaintiff's name or portrait is made in a manner offensive to ordinary sensibilities a right of privacy action will lie regardless of whether or not the plaintiff is a celebrity or has consented to appear before a limited audience. Thus, in *Cohen v. Marx*, 94 Cal. App. 2d 704, 211 P. 2d 320 (1949), Groucho Marx on his radio program referred to the plaintiff in what was probably a non-offensive manner. The court found for the defendant and invoked the doctrine of waiver, stating that "plaintiff, by entering the prize ring, seeking publicity, and becoming widely known as a prize fighter under the name of 'canvasback Cohen,' waived his right to privacy. . . ." On the other hand, in *Kirby v. Hal Roach Studios*, 53 Cal. App. 2d 207, 127 P. 2d 577 (1942), defendant used plaintiff's name in an offensive manner and although plaintiff was an actress the court expressly held that she had not waived her right of privacy so as to permit an invasion of her privacy.

<sup>26</sup> For an example of an almost complete rejection of the waiver theory, see *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S. E. 68 (1904).

<sup>27</sup> Within New York state there would appear to be a lack of consistency in applying the doctrine of waiver. Thus, compare *Jansen v. Hilo Packing Co.*, 202 Misc. 900, 118 N. Y. S. 2d 162 (Sup. Ct. 1952); *Oma v. Hillman Periodical Inc.*, 281 App. Div. 240, 118 N. Y. S. 2d 720 (1st Dep't 1953); and *Redmond v. Columbia Pictures Corp.*, 277 N. Y. 707, 14 N. E. 2d 636 (1938).

<sup>28</sup> MASON, BRANDEIS, *A FREE MAN'S LIFE* 70 (1946).

preventing offensive (as distinguished from non-offensive) publicity. To this day most courts recognize the rule of the *Restatement of Torts* that in a privacy action "liability exists only if the defendant's conduct was such that he should have realized that it would be offensive to persons of ordinary sensibilities. It is only where the intrusion has gone beyond the limits of decency that liability accrues."<sup>29</sup>

In attempting to control and profit from the use of publicity values connected with the use of his name, photograph, and likeness, the well known personality will usually find it difficult to invoke such protection under the right of privacy for the reason that usually such publicity cannot be considered such as "would be offensive to persons of ordinary sensibilities" or as an intrusion "beyond the limits of decency." Situations may of course occur where exploitation of a plaintiff's publicity values will prove humiliating or embarrassing to him,<sup>30</sup> but in most situations one who has achieved such prominence as to give a publicity value to the use of his name, photograph, and likeness cannot honestly claim that he is humiliated or offended by their use before the public. The fact that he wishes to be paid for such use does not indicate that use without payment is so offensive as to give a right of action in privacy. *Gill v. Hearst Publishing Co.*<sup>31</sup> clearly indicates that in California a right of privacy will not lie unless the use of the plaintiff's photograph was made in a manner which would prove offensive to persons of ordinary sensibilities.<sup>32</sup> Most other jurisdictions will likewise find no right of privacy action unless the plaintiff can establish a use offensive to one's sensibilities<sup>33</sup> and the sensibilities which will be protected are "ordinary sensibilities and not . . . super-sensitiveness or agoraphobia."<sup>34</sup>

There are some jurisdictions which do not require that the use of the plaintiff's name, photograph or likeness be made in an offensive manner in order to constitute a cause of action in privacy. Florida is one such jurisdiction,<sup>35</sup> and the New York privacy statute is regarded generally as creating at least a technical cause of action despite the fact that the use of the plaintiff's name or portrait is not done in an offensive manner.<sup>36</sup> Recently, however, the opinion in *Gautier v. Pro-Football* rendered by the Appellate Division of the New York Supreme Court<sup>37</sup> indicated that

<sup>29</sup> RESTATEMENT, TORTS §867, comment *d* (1939). See also Yankwich, *The Right of Privacy*, 27 NOTRE DAME LAW. 499, 506 (1952).

<sup>30</sup> For example, in *Sinclair v. Postal Telegraph and Cable Co.*, 72 N. Y. S. 2d 841 (1935), the defendant used a photograph of the plaintiff (an actor) which had been taken in connection with a motion picture photoplay in which plaintiff appeared. Defendant's use of the photo made it appear that plaintiff was notifying his "enthusiastic admirers" by telegraph that he was about to appear in a motion picture at a given theatre. Plaintiff brought an action under the New York privacy act arguing that defendant's use of his photograph was humiliating to plaintiff in that it put him in an undignified light, in the same manner as an attorney would appear if he telegraphed his friends requesting that they attend a court room where he was about to participate in a case. Plaintiff recovered.

<sup>31</sup> 40 Cal. 2d 224, 253 P. 2d 441 (1953).

<sup>32</sup> *Accord*, *Gill v. Curtis Publishing Co.*, 38 Cal. 2d 273, 239 P. 2d 630 (1952).

<sup>33</sup> See, e.g., *Maysville Transit Co. v. Ort*, 296 Ky. 524, 177 S. W. 2d 369 (1943); *Vassar College v. Loose-Wiles Biscuit Co.*, 197 Fed. 982 (W. D. Mo. 1912).

<sup>34</sup> *Davis v. General Finance & Thrift Corp.*, 80 Ga. App. 708, 711, 57 S. E. 2d 225, 227 (1950).

<sup>35</sup> *Cason v. Baskin*, 155 Fla. 198, 20 So. 2d 243 (1944).

<sup>36</sup> See *Miller v. Madison Square Garden*, 176 Misc. 714, 28 N. Y. S. 2d 811 (Sup. Ct. 1941).

<sup>37</sup> 278 App. Div. 431, 438, 106 N. Y. S. 2d 553, 560 (1st Dep't 1951), *aff'd*, 304 N. Y. 354, 107 N. E. 2d 485 (1952).

even in New York "the recovery is grounded on the mental strain and distress, on the humiliation, on the disturbance of the peace of mind suffered by the individual affected."

Even in those jurisdictions where it is held that a cause of action in privacy is stated despite the fact that use of the plaintiff's name, photograph or likeness was done in a non-offensive manner, the person wishing to be paid for the publicity value of such use will find himself effectively circumvented by the rule of damages.<sup>38</sup> Thus, in *Cason v. Baskin*,<sup>39</sup> the defendant Marjorie Kinnan Rawlings in her book *Cross Creek* depicted the plaintiff, using plaintiff's real first name. The court held that plaintiff had stated a cause of action in privacy but because "there was no mental anguish—no loss of friends—no loss of respect to the community—no loss of character or reputation," the court refused to award plaintiff any damages. Thus even if a plaintiff can establish a cause of action in privacy for non-offensive use of his publicity values, he will not succeed in recovering any damages if he cannot show an offensive use. Again, in *Miller v. Madison Square Garden*<sup>40</sup> plaintiff, a well known performer, known as "Bronco Charlie," brought an action alleging invasion of his privacy under the New York statute because of the unauthorized use of his name and photograph by defendant on its official program sold to patrons in connection with the six day bicycle races. At the trial, plaintiff frankly admitted that the use of his name and picture by defendant did not subject him to any ridicule or cause him any humiliation whatever. The court held that there was a technical violation of the New York privacy statute but since the use of plaintiff's name and picture was non-offensive to him, plaintiff received nominal damages in the sum of six cents. Plaintiff might well have taken the position that the use of the name and picture of a famous performer on defendant's program was worth a great deal more to defendant than six cents. In *Fisher v. Rosenberg*<sup>41</sup> plaintiff was a professional dancer who, while dancing with Irene Castle, had his photograph taken in two dancing poses. Defendant used these pictures in newspaper advertisements of defendant's shoes. Plaintiff sued under the New York privacy statute and was awarded \$300 damages. However, the court stated: "Plaintiff is entitled to compensatory damages only for injured feelings."<sup>42</sup> The court concluded that the use of plaintiff's picture in connection with the sale of shoes was humiliating to plaintiff, but noted that if the publication of the picture had been made "in connection with his profession" then the publicity attached to the picture would inure to his benefit and therefore plaintiff would not be entitled to any recovery under the privacy statute. Thus here again the court indicates a refusal to protect publicity values apart from an offensive use thereof. When the express question has arisen as to whether or not there is a right in a privacy action to recovery for the defendant's unjust enrichment, the

<sup>38</sup> See *O'Brien v. Pabst Sales Co.*, 124 F. 2d 167 (5th Cir. 1941).

<sup>39</sup> 159 Fla. 31, 30 So. 2d 635 (1947).

<sup>40</sup> 176 Misc. 714, 28 N. Y. S. 2d 811 (Sup. Ct. 1941).

<sup>41</sup> 175 Misc. 370, 23 N. Y. S. 2d 677 (Sup. Ct. 1940).

<sup>42</sup> 175 Misc. at 371, 23 N. Y. S. 2d at 679.

courts have usually indicated that no such measure of recovery will be permitted.<sup>43</sup> In New York, however, there is at least one case—*Bunnell v. Keystone Varnish Co.*<sup>44</sup>—in which it was held that plaintiff may recover for defendant's unjust enrichment under the privacy statute. This decision, however, may be said to be doubtful in view of the fact that the court's only authority for this holding was a case not in point.<sup>45</sup> Furthermore, Justice Desmond's concurring opinion in *Gautier v. Pro-Football Inc.*<sup>46</sup> indicates that the Court of Appeals might not agree with the *Bunnell* holding. Justice Desmond, speaking of the New York privacy statute, stated that it was "enacted to fill a gap in existing law" and that it "should not be held to apply to a violation of a contract right to be compensated for public or semi-public theatrical, or similar, exhibitions. . . ."

Therefore since a defendant may well exploit for his own gain the publicity values of a plaintiff without presenting such publicity in an offensive manner, it follows that in such instances a plaintiff will usually be unable to protect his publicity values under a privacy theory.

*Non-assignable.* In most jurisdictions it is well established that a right of privacy is a personal right rather than a property right<sup>47</sup> and consequently is not assignable.<sup>48</sup> The publicity value of a prominent person's name and portrait is greatly restricted if this value cannot be assigned to others. Moreover, persons willing to pay for such publicity values will usually demand that in return for payment they obtain an exclusive right.<sup>49</sup> Yet since the right of privacy is non-assignable, any agreement purporting to grant the right to use the grantor's name and portrait (as in connection with a commercial endorsement or tie-up) is construed as constituting merely a release as to the purchaser and as not granting the purchaser any right which he can enforce as against a third party.<sup>50</sup> Thus, if a prominent motion picture actress should grant to a bathing suit manufacturer the right to use her name and portrait in connection with its product and if subsequently a competitive manufacturer should use the same actress's name and portrait in connection with its product, the first manufacturer cannot claim any right of action on a privacy theory against its competitor since the first manufacturer cannot claim to "own" the actress's right of privacy. Assuming the second manufacturer acted with the consent of the actress, it is possible that the first manufacturer would have a cause of action for breach of contract against the actress, but this would present a remedy in damages only and in some instances even recovery of damages might be doubtful. Therefore, if a

<sup>43</sup> *Cason v. Baskin*, 155 Fla. 198, 20 So. 2d 243 (1944). See *Peterson v. KMTR Radio Corp.*, 18 U. S. L. WEEK 2044 (U. S. July 26, 1949).

<sup>44</sup> 254 App. Div. 885, 5 N. Y. S. 2d 415 (2d Dep't 1938).

<sup>45</sup> The case cited was *Franklin v. Columbia Pictures Corp.*, 246 App. Div. 35, 284 N. Y. S. 96 (1st Dep't 1935).

<sup>46</sup> 304 N. Y. 354, 361, 107 N. E. 2d 485, 489 (1952).

<sup>47</sup> *Mau v. Rio Grande Oil*, 28 F. Supp. 845 (N. D. Calif. 1939); *Metter v. Examiner*, 35 Cal. App. 2d 304, 95 P. 2d 491 (1939).

<sup>48</sup> *Hanna Manufacturing Co. v. Hillerich & Bradsby*, 78 F. 2d 763 (5th Cir. 1935); Note, 45 YALE L. J. 520 (1936); see *Haelan Laboratories v. Topps Chewing Gum*, 202 F. 2d 866 (2d Cir. 1953).

<sup>49</sup> See *Rogers v. Republic Productions*, 104 F. Supp. 328, 341 (S. D. Calif. 1952).

<sup>50</sup> Cf. *Haelan Laboratories v. Topps Chewing Gum*, 202 F. 2d 866 (2d Cir. 1953).

prominent person is found merely to have a personal right of privacy and not a property right of publicity, the important publicity values which he has developed are greatly circumscribed and thereby reduced in value.

*Limited to Human Beings.* It is common knowledge that animals often develop important publicity values. Thus, it is obvious that the use of the name and portrait of the motion picture dog Lassie in connection with dog food would constitute a valuable asset. Yet an unauthorized use of this name could not be prevented under a right of privacy theory, since it has been expressly held that the right of privacy "does not cover the case of a dog or a photograph of a dog."<sup>51</sup> Not only animals but business enterprises as well are unprotected under the right of privacy,<sup>52</sup> and this applies to both partnerships<sup>53</sup> and corporations.<sup>54</sup> Yet as in the case of animals so also with business enterprises, the economic realities are such that the use of a business name may have a considerable publicity value. Thus, the name of a major motion picture studio (and perhaps a portrait of its physical plant) could prove a valuable asset if used in connection with format of a television program dealing with Hollywood, or if used in connection with the advertising of a commercial product. Yet no objection to such use could be made under a privacy theory.

#### INADEQUACY OF UNFAIR COMPETITION

If the well known personality finds that misappropriation of his publicity values cannot be effectively prevented under a privacy theory, he will usually find no greater relief under the traditional theory of unfair competition.

*Competition Requirement.* The absence of competition between the plaintiff and defendant is in a number of jurisdictions an effective defense to an unfair competition action.<sup>55</sup> In such jurisdictions, it is obvious that publicity values are not effectively protected, since a person's publicity values may be profitably exploited in non-competitive fields. Thus, a chewing gum company which includes in its packages pictures of prominent baseball players could hardly be characterized as in competition with the players. Even with respect to business or other enterprises (as distinguished from personalities) which, as has been indicated *supra*,<sup>56</sup> cannot invoke the right of privacy, the defense of no competition will effectively prevent a successful unfair competition action for misappropriation of the enterprise's publicity values. Thus, in *Vassar College v. Loose-Wiles Biscuit Co.*,<sup>57</sup> the defendant

<sup>51</sup> Lawrence v. Ylla, 184 Misc. 807, 55 N. Y. S. 2d 343 (Sup. Ct. 1945).

<sup>52</sup> Shubert v. Columbia Pictures Corp., 189 Misc. 734, 72 N. Y. S. 2d 851 (Sup. Ct. 1947); Gautier v. Pro-Football, 278 App. Div. 531, 106 N. Y. S. 2d 553 (1st Dep't 1951), *aff'd*, 304 N. Y. 354, 107 N. E. 2d 485 (1952); Maysville Transit Co. v. Ort, 296 Ky. 524, 177 S. W. 2d 364 (1943).

<sup>53</sup> Rosenwasser v. Ogoglia, 172 App. Div. 107, 158 N. Y. S. 56 (2d Dep't 1916).

<sup>54</sup> Vassar College v. Loose-Wiles Biscuit Co., 197 Fed. 982 (W. D. Mo. 1912). See also Jaccard v. R. H. Macy & Co., 176 Misc. 88, 26 N. Y. S. 2d 829 (Sup. Ct. 1941), *aff'd*, 265 App. Div. 15, 37 N. Y. S. 2d 570 (1st Dep't 1942).

<sup>55</sup> *E.g.*, Women's Mutual Benefit Society v. Catholic Society Feminine, 304 Mass. 349, 23 N. E. 2d 886 (1939); Acme Screen Co. v. Pebbles, 159 Okla. 116, 14 P. 2d 366 (1932); Scutt v. Bassett, 86 Cal. App. 2d 373, 194 P. 2d 781 (1948). See Riggs Optical Co. v. Riggs, 132 Neb. 26, 270 N. W. 667 (1937).

<sup>56</sup> See p. 210.

<sup>57</sup> 197 Fed. 982 (W. D. Mo. 1912).



manufactured chocolates which it sold in a package labeled "Vassar Chocolates," and upon which there appeared a seal closely resembling the seal of the plaintiff college and a picture of a young lady wearing a mortarboard. The court rendered judgment for the defendant, holding that no unfair competition could be established since the parties were not in competition. Yet, it can hardly be doubted that the defendant was trading on the publicity values established by the plaintiff. A recent case, *Loeb v. Turner*,<sup>58</sup> in recognizing the defense of no competition, plainly illustrates the inadequacy of unfair competition in protecting publicity values. In this case plaintiff, operator of a radio station in Phoenix, Arizona, had acquired from the owner of an auto racetrack, also in Phoenix, the exclusive right to broadcast the races. Plaintiff's transmitter covered a radius of forty miles, and within this radius defendant stationed an agent who listened to plaintiff's broadcast and thus was enabled to phone defendant (who owned a radio station in Dallas, Texas) and to relate the course of the race as it occurred. Defendant then "recreated" the race several minutes thereafter in a broadcast over his station. The court found for the defendant in plaintiff's action for unfair competition, for the reason that the parties were not in competition since plaintiff's radio station covered a radius of only forty miles and defendant's station was 1000 miles away. Taken within the narrow confines of the traditional view of unfair competition, this case may be said to be correct or at least conceptually consistent. It is suggested, however, that were the plaintiff regarded as having been granted an exclusive property right in the race-track's radio publicity values, a result more consonant with the economic realities and the demands of justice would have been achieved. Under such a view, since plaintiff had an exclusive right (as was indicated in his contract), the fact that he chose to exercise this right only within a forty mile radius of the track would not divest him of the right beyond this radius.

*Smith v. Surati*<sup>59</sup> presents another example of the inadequate protection afforded publicity values under a theory of unfair competition. In that case plaintiff was the director of an expedition which planned to fly over the North Pole. Part of the cost of the expedition was to be obtained from the sale of moving pictures of the expedition to be photographed by Pathe News Service under an arrangement with the expedition. Defendant, a representative of International News Service, planned to photograph the expedition without plaintiff's consent and to sell the photographs prior to the time Pathe could market its officially approved pictures. Plaintiff sought an injunction to prevent defendant from proceeding as above described, to which defendant entered a demurrer. The court sustained defendant's demurrer, finding that no cause of action for unfair competition had been stated since the expedition was not engaged in a business, but was rather "a heroic adventure." Here again it would seem that a realistic recognition of the very considerable publicity values inherent in the expedition should have warranted protection of these values against

<sup>58</sup> 257 S. W. 2d 800 (Tex. Civ. App. 1953). Cf. *Twentieth Century Sporting Club v. Transradio Press Service*, 165 Misc. 71, 300 N. Y. S. 159 (Sup. Ct. 1937).

<sup>59</sup> 7 Alaska Rep. 416 (1926).

unauthorized appropriation, regardless of whether or not the appropriators were business competitors of those responsible for the publicity values.<sup>60</sup>

*Passing Off Requirement.* It is generally recognized that "the essence of unfair competition consists in the palming off of the goods or business of one person as that of another."<sup>61</sup>

This requirement of passing off (or palming off), which is probably more universally recognized than the requirement of competition discussed *supra*, serves to limit further the protection available for publicity values under the theory of unfair competition. Publicity values of a person or firm may be profitably appropriated and exploited without the necessity of any imputation that such person or firm is connected with the exploitation undertaken by the appropriator. That is to say, publicity values may be usefully appropriated without the necessity of passing off, and therefore without violating the traditional theory of unfair competition. Thus in *Paramount Pictures, Inc. v. Leader Press*<sup>62</sup> the defendant manufactured and sold to theatre exhibitors advertising accessories (posters, etc.) relating to plaintiff's motion pictures; these accessories were valuable and salable by reason of their containing and exploiting the publicity values inherent in both plaintiff's motion pictures and in the actors employed by plaintiff. The Court of Appeals for the Tenth Circuit found that the above practice did not constitute unfair competition since there was no passing off of the advertising accessories of the defendant as those of the plaintiff.<sup>63</sup>

The commercial "tie up," as distinguished from the commercial endorsement,<sup>64</sup> presents another instance in which publicity values may be appropriated without the necessity of passing off. Advertisements, almost regardless of their nature, will increase their reader appeal by including the name and portrait of a prominent personality or a well known enterprise, although there is no "passing off" that such personality or enterprise produces or endorses the product being advertised.

*No Assignment in Gross.* The pecuniary worth of publicity values will be greatly diminished if not totally destroyed if these values cannot be effectively sold. Yet, under the theory of unfair competition, an assignee cannot acquire the right to use a name except as an incident to his purchase of the business and good will in connection with which the name has been used.<sup>65</sup> Therefore, if the potential purchaser of publicity values must rely upon the law of unfair competition to protect his investment, he will be unwilling to purchase publicity values unconnected with a business. This in effect means that the sale of publicity values will usually be

<sup>60</sup> Even the right of publicity, however, should be subject to the defense of public interest, and it is possible that this defense would have been appropriate in the *Suratt* case. See page 216, *infra*.

<sup>61</sup> *American Broadcasting Co. v. Wahl Co.*, 36 F. Supp. 167, 168 (S. D. N. Y. 1940). The leading case on this point is *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118 (1905).

<sup>62</sup> 106 F. 2d 229 (10th Cir. 1939).

<sup>63</sup> However, the court found for the plaintiff on the theories of disparagement and inducing breach of a contract.

<sup>64</sup> The commercial "tie-up" presents the name and portrait of an actor or other celebrity within the context of an advertisement without necessarily indicating that the actor endorses the product advertised.

<sup>65</sup> *Fisk v. Fisk*, 3 F. 2d 7 (8th Cir. 1924).

effectively blocked, since the potential seller of publicity values generally has established such value not in connection with his own business but rather through the rendering of personal services for another; he will therefore be unable to sell the business in connection with which his name has achieved fame. Furthermore, even if the potential seller has achieved fame through his own business, if he can only sell his publicity values as an incident to the sale of his business, he will ordinarily prefer not to enter such a transaction.

*Unfair Competition Extended.* In recent years there has been a marked tendency in a number of jurisdictions to take a broader view of the scope of unfair competition. Many courts have rejected the defense of lack of competition between the parties.<sup>66</sup> Some other courts no longer require a showing of passing off in order to establish an action in unfair competition.<sup>67</sup> However, even in those jurisdictions which have permitted recovery in the absence of either competition or passing off, the doctrine would generally not appear to be so far extended as to permit recovery where *both* competition and passing off are absent. Thus, in *International News Service v. Associated Press*,<sup>68</sup> a case usually cited by those courts which have extended the doctrine of unfair competition, I.N.S. appropriated news gathered by the Associated Press, and although there was no passing off in that I.N.S. did not represent the appropriated news as emanating from Associated Press, there was, of course, the element of competition between the two major news services.<sup>69</sup> Other instances may be found in which relief was granted under an unfair competition theory upon a showing of passing off although the parties were not in competition.<sup>70</sup> The language contained in *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*,<sup>71</sup> however, goes so far as to indicate that relief might be granted although both competition and passing off were not established. This is dicta, however, since the court found as a matter of fact the existence of both competition and passing off.<sup>72</sup> The danger of protecting publicity values on an unfair competition theory

<sup>66</sup> *Finchley, Inc. v. Finchly Co.*, 40 F. 2d 736 (D. Md. 1929); *Horlick's Malted Milk Corp. v. Horluch's, Inc.*, 43 F. 2d 767 (W. D. Wash. 1930); *Kotabs, Inc. v. Kotex Co.*, 50 F. 2d 810 (3d Cir. 1931); *Standard Oil Co. of New Mexico v. Standard Oil Co. of California*, 56 F. 2d 973 (10th Cir. 1932); *Emerson Electric Mfg. Co. v. Emerson Radio & Phonograph Corp.*, 105 F. 2d 908 (2d Cir. 1939).

<sup>67</sup> *International News Service v. Associated Press*, 248 U. S. 215 (1918); *Montegut v. Hickson*, 178 App. Div. 94, 164 N. Y. S. 858 (1st Dep't 1917). See *In re Northern Pigment Co.*, 61 F. 2d 447 (C.C.P.A. 1934).

<sup>68</sup> 248 U. S. 215 (1918).

<sup>69</sup> *Mutual Broadcasting System v. Muzak*, 117 Misc. 489, 30 N. Y. S. 2d 419 (Sup. Ct. 1941) presented another instance wherein, although passing off could not be established, relief was nevertheless granted on the basis of competition between the parties. See *Hanna Mfg. Co. v. Hillerich and Bradsby*, 78 F. 2d 763 (5th Cir. 1935).

<sup>70</sup> See *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 App. Div. 459, 7 N. Y. S. 2d 845 (1st Dep't 1938).

<sup>71</sup> 101 N. Y. S. 2d 483 (Sup. Ct. 1950).

<sup>72</sup> In this case the defendant recorded radio broadcasts of the Metropolitan Opera and made phonograph records therefrom which it sold to the public. Defendant advertised and sold the records as records of broadcast Metropolitan Opera performances. The court found that competition existed due to the fact that Columbia Records, Inc. joined the Metropolitan Association as a plaintiff in the case (Columbia having contracted for the phonograph rights in the Metropolitan performances). Furthermore, the court found that the element of passing off existed since an inference could be drawn that the activities of the defendant misled the public into believing that the recordings were made with the cooperation of the Metropolitan Opera Association.

in the absence of both competition and passing off is indicated by further language found in the *Metropolitan* case. The court stated that the law of unfair competition rests on the principle that "property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality, and a court of equity will penetrate and restrain every guise resorted to by the wrongdoer. The courts have thus recognized that in the complex pattern of modern business relationships, persons in theoretically non-competitive fields may, by unethical business practices, inflict as severe and reprehensible injuries upon others as can direct competitors."<sup>73</sup> It will be seen from the above passage that under this view (*i.e.*, discarding the requirements of competition and passing off) the scope of unfair competition covers "any form of commercial immorality," and "unethical business practices." If this loose standard were in fact applied by the courts, the already uncertain field of unfair competition would be reduced to a chaos of complete uncertainty, since what lawyer or business man could predict with any degree of certainty where the courts would find that properly aggressive business practices leave off and "commercial immorality" and "unethical business practices" begin? True, publicity values might be protected under such a broad theory, but in doing so the courts would be adopting a standard which by its uncertainty could prove highly detrimental to orderly commercial intercourse. It is suggested that publicity values can be adequately protected under the right of publicity discussed *infra*, without going to the extremes indicated above.

#### INADEQUACY OF OTHER THEORIES

Publicity values may to a limited extent be protected by contract,<sup>74</sup> but such protection extends, of course, only to the parties to such contracts. The inadequacy of the contract theory in protecting publicity values is illustrated in *Corliss v. E. W. Walker Co.*,<sup>75</sup> in which plaintiff's deceased husband had his portrait taken by a photographer who agreed by contract not to furnish prints of the photograph to anyone other than plaintiff and plaintiff's husband. Thereafter the defendant purchased a print of the photograph from the photographer and inserted it in a biographical sketch of the deceased husband. The plaintiff sought to obtain an injunction against the use of the photograph, and the court granted the defendant's motion to dissolve the injunction on the ground that defendant was not a party to the contract between the plaintiff's husband and the photographer, and therefore defendant was not bound thereby.<sup>76</sup> However, if the plaintiff can establish a contract restricting use of the publicity values and if defendant although not a party to the contract can be shown to have induced breach of the contract, then relief may be obtained.<sup>77</sup> Thus if *A* purchases the right to use *B*'s publicity values under a contract in which *B* agrees not to grant the right to use such publicity values to

<sup>73</sup> 101 N. Y. S. 2d 483, 492 (Sup. Ct. 1950).

<sup>74</sup> See *Wood v. Lucy, Lady Duff Gordon*, 222 N. Y. 88, 118 N. E. 214 (1917).

<sup>75</sup> 64 Fed. 280 (C. C. D. Mass. 1894).

<sup>76</sup> See also *Lawrence v. Ylla*, 184 Misc. 807, 55 N. Y. S. 2d 343 (Sup. Ct. 1945).

<sup>77</sup> *Paramount Pictures v. Leader Press*, 106 F. 2d 229 (10th Cir. 1939).

anyone else, and if thereafter *C* induces *B* to grant to him the same publicity values and thereby causes *B* to breach his contract with *A*, *C* will be liable to *A* for the tort of inducing breach of contract. However, if *C* having thus acquired the publicity rights from *B* in turn assigns these rights to *D*, *D* in using such publicity rights will not be liable to *A* for the tort of inducing breach of contract since *D* merely benefited from the breach of the contract but did not induce it,<sup>78</sup> and *D* will not be liable for breach of contract since he was not a party to the contract between *A* and *B*. Thus even in the limited situations where appropriation of publicity values involves a breach of contract, a person who is not a party to the contract and who has not induced its breach may not be prevented from using the publicity values on either a contract theory or a theory of inducing breach of contract.

If the use of the plaintiff's publicity values is made in a manner so as to constitute defamation, trade libel or disparagement then, of course, liability will ensue. Thus, in *Paramount Pictures, Inc. v. Leader Press*,<sup>79</sup> although the court found that defendant's practice of producing advertising accessories embodying the publicity value of plaintiff's pictures and stars constituted neither an invasion of privacy nor unfair competition, still relief was granted on the theory of disparagement because of the fact that defendant's advertising accessories depicted plaintiff's stars in an unattractive manner. However, for the reasons discussed in connection with the right of privacy, publicity values are not adequately protected if relief can only be granted when the use of the values is made in an offensive manner, since generally an appropriation of publicity values does not involve a disparagement of the values thus appropriated, or of the persons identified with such values.<sup>80</sup>

#### SUBSTANCE OF AND LIMITATIONS ON THE RIGHT OF PUBLICITY

The substance and direction of the right of publicity has to some extent been indicated by adjudicated cases which will be discussed later.<sup>81</sup> Before examining the somewhat fragmentary outline embodied in existing case law, it might be well first to attempt some perspective as to the fundamental elements necessary to a workable and socially useful right of publicity. From such a perspective, the meaning and continuity of existing case law will be more apparent.

The substance of the right of publicity must be largely determined by two considerations: first, the economic reality of pecuniary values inherent in publicity and, second, the inadequacy of traditional legal theories in protecting such publicity values. It is an unquestioned fact that the use of a prominent person's name, photograph or likeness (*i.e.*, his publicity values) in advertising a product or in attracting an audience is of great pecuniary value. This is attested to by the now pervasive trade practice of paying well known personalities considerable sums for the right

<sup>78</sup> *Haelan Laboratories v. Topps Chewing Gum*, 202 F. 2d 866 (2d Cir. 1953).

<sup>79</sup> 106 F. 2d 229 (10th Cir. 1939).

<sup>80</sup> This section is not intended to exhaust other possible theories under which publicity values may be protected in particular circumstances. For instance, a copyright theory may be invoked if defendant uses a photograph in which plaintiff can claim a common law or statutory copyright.

<sup>81</sup> See page 218, *infra*.

thus to use such publicity values.<sup>82</sup> It is also unquestionably true that in most instances a person achieves publicity values of substantial pecuniary worth only after he has expended considerable time, effort, skill, and even money. 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. Yet, because of the inadequacy of traditional legal theories discussed *supra*, persons who have long and laboriously nurtured the fruit of publicity values may be deprived of them, unless judicial recognition is given to what is here referred to as the right of publicity—that is, the right of each person to control and profit from the publicity values which he has created or purchased.

The nature of the inadequacy of the traditional legal theories dictates in large measure the substance of the right of publicity. The right of publicity must be recognized as a property (not a personal) right, and as such capable of assignment and subsequent enforcement by the assignee. Furthermore, appropriation of publicity values should be actionable regardless of whether the defendant has used the publicity in a manner offensive to the sensibilities of the plaintiff. Usually the use will be non-offensive, since such a use is more valuable to the defendant as well as to the plaintiff. Likewise, the measure of damages should be computed in terms of the value of the publicity appropriated by defendant rather than, as in privacy, in terms of the injury sustained by the plaintiff. There must be no waiver of the right by reason of the plaintiff being a well known personality. Indeed, the right usually becomes important only when the plaintiff (or potential plaintiff) has achieved in some degree a celebrated status. Moreover, since animals, inanimate objects, and business and other institutions all may be endowed with publicity values, the human owners of these non-human entities should have a right of publicity (although no right of privacy) in such property, and this right should exist (unlike unfair competition) regardless of whether the defendant is in competition with the plaintiff, and regardless of whether he is passing off his own products as those of the plaintiff.

It is not possible to set forth here in any detail the necessary limitations on the right of publicity which only the unhurried occurrence of actual cases will clearly establish. Yet some few suggestions can be made. In privacy cases there is a tendency by some courts to confuse or at least fail to distinguish between the defense of waiver by a well known personality and the defense of "news" or public interest.<sup>83</sup> Although, as indicated *supra*, the defense of waiver by celebrities should not be recognized in a publicity action, the defense of public interest should be no less effective in a publicity action than in a privacy action. Where use of a person's name, photograph, or likeness is made in the dissemination of news or in a manner

<sup>82</sup> See *Haelan Laboratories v. Topps Chewing Gum*, 202 F. 2d 866 (2d Cir. 1953); *O'Brien v. Pabst Sales Co.*, 124 F. 2d 167 (5th Cir. 1941).

<sup>83</sup> *E.g.*, *Gautier v. Pro-Football*, 304 N. Y. 354, 107 N. E. 2d 485 (1952); *Smith v. Suratt*, 7 Alaska 416 (1926).

required by the public interest, that person should not be able to complain of the infringement of his right of publicity.

The question will be raised as to whether there is an infringement of the right of publicity when defendant appropriates the plaintiff's publicity values and uses them, but not for purposes of trade or advertising. It may be argued that since publicity values are useful mainly in connection with trade and advertising, this presents a convenient place to draw the line between wrongful infringement of the right of publicity and proper exercise of freedom of expression. However, in view of the holding in *Gautier v. Pro-Football*<sup>84</sup> that only that portion of a television broadcast containing the "commercial" may be said to be for purposes of trade or advertising,<sup>85</sup> if the right of publicity were restricted to uses for purposes of trade or advertising, there might be no protection against appropriation of publicity values on television programs.<sup>86</sup> Probably it would be wiser not to inject any arbitrary limitation on the scope of the right of publicity, relying instead on the limitation imposed by the rule of damages. In most instances, the use of publicity values for purposes other than for trade or advertising will be of no great value to the defendant and consequently will result in small or nominal damages for the plaintiff. It may also be suggested that the right of publicity should be limited to those persons having achieved the status of a "celebrity," as it is only such persons who possess publicity values which require protection from appropriation.<sup>87</sup> Here too, however, it would probably be preferable not to impose an arbitrary limit on the right but rather to rely upon the rule of damages. It is impractical to attempt to draw a line as to which persons have achieved the status of celebrity and which have not; it should rather be held that every person has the property right of publicity, but that the damages which a person may claim for infringement of the right will depend upon the value of the publicity appropriated which in turn will depend in great measure upon the degree of fame attained by the plaintiff. Thus, the right of publicity accorded to each individual "may have much or little, or only a nominal value,"<sup>88</sup> but the right should be available to everyone.

It may also be argued that the right of publicity should be limited to protection against appropriation of one's portrait but should not protect against appropriation of one's name.<sup>89</sup> However, the use of a name may in itself carry considerable

<sup>84</sup> 304 N. Y. 354, 107 N. E. 2d 485 (1952).

<sup>85</sup> Note, however, that the program telecast in the *Gautier* case was a sports event, with plaintiff's animal act appearing only during the half time.

<sup>86</sup> This raises the possibility of piracy by kinescope. That is, traditional legal theories discussed *supra* may not effectively prevent the unauthorized recording and use of a film made from a live television broadcast where, as in a sports program, the material contained in the broadcast would not command common law copyright protection. See *Loeb v. Turner*, 257 S. W. 2d 800 (Tex. Civ. App. 1953); *National Exhibition Co. v. Teleflash*, 24 F. Supp. 488 (S. D. N. Y. 1936); *Smith v. Suratt*, 7 Alaska 416 (1926). *But cf.* *Twentieth Century Sporting Club v. Transradio Press Service*, 165 Misc. 71, 300 N. Y. S. 159 (Sup. Ct. 1937); *Mutual Broadcasting System v. Muzak Corp.*, 177 Misc. 489, 30 N. Y. S. 2d 419 (Sup. Ct. 1941).

<sup>87</sup> *Cf.* *Shubert v. Columbia Pictures Corp.*, 189 Misc. 734, 72 N. Y. S. 2d 851 (Sup. Ct. 1947).

<sup>88</sup> *O'Brien v. Pabst Sales Co.*, 124 F. 2d 167 (5th Cir. 1941) dissenting opinion.

<sup>89</sup> *Haelan Laboratories v. Topps Chewing Gum*, 202 F. 2d 866 (2d Cir. 1953) indicates that the right of publicity may be limited to the protection of the publicity value of one's photograph.

publicity value, and there would seem to be no reason to exclude such appropriation from the protection of the right of publicity.

#### RECOGNITION OF THE RIGHT OF PUBLICITY

It would be premature to state that the right of publicity has as yet received any substantial degree of judicial recognition. Yet, even before Judge Jerome Frank's recent express application of the right in *Haelan Laboratories v. Topps Chewing Gum Inc.*,<sup>90</sup> a number of cases<sup>91</sup> have indicated a judicial willingness to extend protection to publicity values which would not be protectible under the traditional legal theories discussed *supra*.

Before examining the cases which have extended protection to publicity values, it might be noted that even where such protection has not been forthcoming there has been an increasing recognition of the pecuniary value of modern publicity and of the need for evolving some appropriate legal protection. Thus in *Paramount Pictures, Inc. v. Leader Press*<sup>92</sup> the court recognized that "proper and adequate publicity and advertising is indispensable to the stars and featured players appearing in motion pictures as well as to the pictures themselves . . . and that such attractive and adequate advertising as the medium of attracting the public to its motion pictures is of great value to plaintiff [Paramount]." Because of the particular facts of this case, however, the court was able to protect plaintiff's publicity values on trade libel and inducing breach of contract theories, thereby avoiding the necessity of invoking the right of publicity.

In *Gautier v. Pro-Football Inc.*,<sup>93</sup> for reason indicated *supra*,<sup>94</sup> plaintiff was denied protection under the New York privacy statute. However, Justice Desmond in a concurring opinion<sup>95</sup> recognized the inadequacy of protecting publicity values under a privacy theory, stating: "Privacy is the one thing he (plaintiff) did not want or need in his occupation. His real complaint, and perhaps a justified one, but one we cannot redress in this suit brought under the New York Right of Privacy statutes, is that he was not paid for the telecasting of his show . . . Enacted to fill a gap in existing law . . . these statutes have always been narrowly construed, and what plaintiff is asking for is the broadest kind of application."<sup>96</sup>

Although until the *Haelan* case no court has named the right to the protection and control of publicity values the "right of publicity,"<sup>97</sup> in a number of previous

<sup>90</sup> *Supra*.

<sup>91</sup> In addition to the cases discussed *infra*, see *Waring v. WDAS*, 327 Pa. 433, 194 Atl. 631 (1937), and *Waring v. Dunlea*, 25 F. Supp. 338 (E. D. N. C. 1939) wherein a performer's interpretation of a musical composition was regarded as a protectible property right. This is at least akin to the right of publicity. Cf. *RCA v. Whiteman*, 114 F. 2d 85 (2d Cir. 1940).

<sup>92</sup> 106 F. 2d 229, 230 (10th Cir. 1939).

<sup>93</sup> 304 N. Y. 354, 107 N. E. 2d 485 (1952).

<sup>94</sup> See page 205, *supra*.

<sup>95</sup> 304 N. Y. 354, 361, 107 N. E. 2d 485, 489-490 (1952).

<sup>96</sup> Although Justice Desmond appears to be referring to the possibility that plaintiff might find redress in a breach of contract action (due to an AGVA form agreement which restricted the televising of plaintiff's performance), it would seem that plaintiff's "real complaint" to which Justice Desmond refers would be no less worthy of redress even in the absence of restrictive contractual provisions.

<sup>97</sup> However, compare *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 196, 50 S. E. 68, 69 (1904), wherein "the right of publicity" is spoken of as the correlative of the right of privacy.



cases this right has either been tacitly recognized or even expressly invoked without use of the name. In *Uproar Co. v. N.B.C.*,<sup>98</sup> it was held that the name "Graham," when used in reference to the popular radio announcer Graham McNamee, had "acquired through the efforts of McNamee and the National Broadcasting Co., a very substantial value, especially valuable for advertising purposes; and this definite commercial value exists apart from the services as radio announcer. Rights of a pecuniary nature have been created which partake of the elements of property rights, and which will receive the protection of equity." The court thus recognized a property right in the name "Graham," which it held could be validly assigned to N.B.C. so as to give the broadcasting company the right to prevent the use of the name by others.

In *Madison Square Garden Corp. v. Universal Pictures Co.*,<sup>99</sup> the defendant produced a motion picture which purported to show professional ice hockey games played in New York City in the Stanley Cup Series. The locale of the games in the motion picture was not expressly represented as being Madison Square Garden, but since the Stanley Cup Series was generally known to occur only in Madison Square Garden the court found that defendant's picture produced a false impression upon the part of the public that the picture contained scenes made in plaintiff's arena. The picture also contained actual newsreel scenes of plaintiff's ice hockey team, the Rangers, taken during an actual game, but these scenes were taken outside of New York City and therefore did not show the Garden. Although the plaintiff brought an action for unfair competition, the language of the court's opinion indicates that in finding for the plaintiff the court recognized publicity values as a property right. The court stated:<sup>100</sup>

We think, too, that the complaint sufficiently alleges a misappropriation of plaintiff's property rights. Plaintiff had built up a valuable business licensing the use of genuine photographs taken in the Garden in feature moving pictures, and from that business had derived substantial revenue. That business had been created by the expenditure on plaintiff's part of large sums of money and of effort and skill in the management of its enterprise . . . [quoting from *Fisher v. Star Co.*, 231 N. Y. 414, 428, 132 N. E. 133, 137 (1921)] "any civil right not unlawful in itself nor against public policy that has acquired a pecuniary value, becomes a property right that is entitled to protection as such."

However, the court in the *Madison Square Garden* case seems to regard publicity values as a protectible property right under the expanded theory of unfair competition. It is, of course, of no serious concern to a plaintiff that his action for protection of publicity values is regarded as within the scope of unfair competition so long as the relief sought is granted. However, as discussed *supra*,<sup>101</sup> it is suggested that if the *Madison Square Garden* court had found as it did purely on a theory of misappropriation of publicity values, the case would have been more helpful as a

<sup>98</sup> 8 F. Supp. 358, 361 (D. Mass. 1934).

<sup>99</sup> 255 App. Div. 459, 7 N. Y. S. 2d 845 (1st Dep't 1938).

<sup>100</sup> 255 App. Div. at 464, 7 N. Y. S. 2d at 850-851.

<sup>101</sup> See page 213, *supra*.

guide to future conduct since it would, on the one hand, have indicated that misappropriation of publicity values will be proscribed even when the publicity values are not of the exact same nature as those in the adjudicated case, and, on the other hand, by not invoking the already muddied concept of unfair competition the danger of further extending this doctrine into uncertain and unpredictable areas would be avoided. In those cases in which the court finds liability under *both* an unfair competition theory and a publicity theory the two theories should be carefully distinguished so that the impression is not given that the right of publicity is but a particular aspect of unfair competition. This better practice was followed in *Pittsburgh Athletic Co. v. KQV*<sup>102</sup> wherein defendant at a vantage point outside of plaintiff's baseball stadium broadcast play-by-play reports of plaintiff's baseball games. Plaintiff had previously granted the exclusive right to broadcast the games to a third party. The court found the defendant liable both for unfair competition *and* for violation of plaintiff's property rights.<sup>103</sup> On the latter point the court held that the plaintiff had a property right to capitalize on the news value of its games by selling exclusive broadcasting rights, thus recognizing a property right approximating the right of publicity, without expressly designating it as such.

Perhaps the most persuasive argument for the right of publicity appears in *O'Brien v. Pabst Sales Co.*<sup>104</sup> In that case the plaintiff, the most publicized football player of the year 1938-39, posed for football publicity pictures taken by the publicity department of his university. He agreed that such pictures might be distributed to "newspapers, magazines, sports journals and the public generally." Defendant purchased a copy of plaintiff's picture and published it on a calendar next to the words "Pabst Blue Ribbon Football Calendar, 1939." The court refused to find for plaintiff on a privacy theory for reasons indicated *supra*.<sup>105</sup> However, the court expressly refused to rule on the question of whether the plaintiff would be entitled to recover on quantum meruit (which would amount to a recovery under a right of publicity) because the plaintiff did not advance this argument. Circuit Judge Holmes in his dissenting opinion was not deterred by this procedural point, and concluded that plaintiff should recover not for invasion of his right of privacy but in quantum meruit for infringement of his property right to use his name and picture for commercial purposes. Judge Holmes, in a well reasoned opinion, stated: "The great property rights created by the demands of modern methods of advertising are of comparatively recent origin . . . but the common law of Texas is subject to growth and adaptation. . . . No one can doubt that commercial advertisers customarily pay for the right to use the name and likeness of a person who has become famous. The evidence in this case shows that appellant refused an offer by a New York beer company of \$400 for an endorsement of its beer. . . ."

<sup>102</sup> 24 F. Supp. 490 (W. D. Pa. 1938).

<sup>103</sup> Cf. *National Exhibition Co. v. Teleflash*, 24 F. Supp. 488 (S. D. N. Y. 1936) where on similar facts it was held that defendant was not liable for unfair competition and the question of property (or publicity) right was not discussed.

<sup>104</sup> 124 F. 2d 167 (5th Cir. 1941).

<sup>105</sup> See page 205 and notes 15 and 38 *supra*.

Judge Holmes concluded that the decision in this case means that "if one is popular and permits publicity to be given to one's talent and accomplishment in any art or sport, commercial advertisers may seize upon such popularity to increase their sales of any lawful article without compensation of any kind for such commercial use of one's name and fame. This is contrary to usage and custom among advertisers in the marts of trade. They are undoubtedly in the habit of buying the right to use one's name or picture to create demand and good will for their merchandise. It is the peculiar excellence of the common law that, by general usage, it is shaped and moulded into new and useful forms."<sup>106</sup>

It would seem to be entirely possible that this perceptive Holmes dissent (as with the dissenting opinions of another Holmes on another court) will eventually be adopted by the majority, particularly since in the *O'Brien* case the majority opinion was careful to point out that "nothing in the majority opinion purports to deal with or express an opinion on the matter dealt with in the dissenting opinion" because "that was not the case pleaded and attempted to be brought."<sup>107</sup>

There are certain cases which speak neither of the "right of publicity" nor of a "property right" in matters which contain publicity values, but which by their results indicate a tacit recognition of the right of publicity.<sup>108</sup> One such case is *Lawrence v. Ylla*<sup>109</sup> wherein the plaintiff contracted for *A* to photograph plaintiff's dog. Thereafter *A* sold prints of the photograph to *B* who used the prints in advertisements which he published in the newspapers of *C* and *D*. Plaintiff brought an action against *A*, *B*, *C*, and *D*. The court held that the plaintiff could not recover under a right of privacy theory since that right "does not cover the case of a dog or a photograph of a dog." The court further found that only *A* was liable to plaintiff under a contract theory since the other defendants were not in privity of contract with plaintiff. Yet, the court enjoined defendants *B*, *C*, and *D* from further use of the photograph, although admittedly such use constituted neither an invasion of privacy nor a breach of contract. This case can, perhaps, best be explained as a tacit application of the right of publicity.

Finally, with *Haelan Laboratories Inc. v. Topps Chewing Gum Inc.*<sup>110</sup> the right of a person (or his assignee) to protect the publicity value of his photograph was expressly recognized and designated the "right of publicity." The facts of this case, in so far as they involve the right of publicity, were as follows: The plaintiff and defendant were competitors in that both were manufacturers of candy or chewing gum confections. Plaintiff contracted with certain prominent baseball players for the exclusive right to use their photographs in connection with the sale of

<sup>106</sup> 124 F. 3d 167, 170-171 (5th Cir. 1941).

<sup>107</sup> It may be that even if the plaintiff had pursued both a privacy theory and a publicity theory, the two theories would have been found to be inconsistent. See *Cason v. Baskin*, 155 Fla. 198, 20 So. 2d 243 (1944). Note that the *O'Brien* case is a federal diversity case and therefore subject to the limitations discussed at page 222, *infra*.

<sup>108</sup> See *Wood v. Lucy, Lady Duff Gordon*, 222 N. Y. 88, 118 N. E. 214 (1917).

<sup>109</sup> 184 Misc. 807, 55 N. Y. S. 2d 343 (Sup. Ct. 1945).

<sup>110</sup> 202 F. 2d 866 (2d Cir. 1953). See subsequent history in 112 F. Supp. 904 (E. D. N. Y. 1953).

plaintiff's products. Thereafter one Russel contracted with the same players for the same purpose. Russel subsequently assigned his rights to the defendant who proceeded to use photographs of the players in connection with his product. In the ensuing litigation, the defendant argued plaintiff could not recover either under a privacy theory since the right of privacy is personal and non-assignable, nor for inducing breach of contract since it was Russel, not the defendant, who induced the breach.<sup>111</sup> The court impliedly recognized the validity of these defenses, but went on to state:<sup>112</sup>

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may be validly made "in gross" i.e., without any accompanying transfer of a business or anything else. . . . This right may be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances. This right of publicity would usually yield no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

Thus in the *Haelan* case the highly respected Second Circuit of the Federal Courts of Appeals granted to the right of publicity a recognition and status of a qualitatively higher order than had been accorded in any previous case. The court clearly held that the right of publicity, unlike the right of privacy, is a property right which may be validly assigned and it at least implied that the privacy defenses of waiver by celebrities and of no liability for non-offensive uses are not applicable in a right of publicity action. Yet, by the very nature of our judicial process, a new principle of law can never be completely embodied in any one decision. The *Haelan* case in the final analysis is limited to its own facts, and therefore leaves unexplored certain important phases of the right of publicity. It remains for future cases finally to determine that the measure of damages in a publicity action shall be for the value of the use of the appropriated publicity rather than for the injury to the plaintiff's sensibilities. Likewise, the right to recover for misappropriation of publicity values inherent in animals, inanimate objects, and business and other institutions (regardless of competition and passing off) remains to be established. Furthermore, the effect of the *Haelan* case as a precedent is questionable since the Court of Appeals had jurisdiction on grounds of diversity of citizenship and therefore the resulting decision represents the federal court's interpretation and application of New York law,<sup>113</sup> which is of course not binding in other jurisdictions. In fact, although persuasive, it is not even binding on the New York courts. Despite its limitations,

<sup>111</sup> Defendant had directly contracted with certain other players who had previously contracted with plaintiff. As to these players, the court found defendant liable for inducing breach of contract.

<sup>112</sup> 202 F. 2d 866, 868 (2d Cir. 1953).

<sup>113</sup> *Erie Railroad v. Tompkins*, 304 U. S. 64 (1938).

the *Haelan* case represents a major step in the inexorable process of reconciling law and contemporary problems.

This raises the final question of the right of our courts, in the absence of legislation, to enforce a right not previously recognized. Here we may return to the essay by Brandeis and Warren discussed at the beginning of this article. The argument was there advanced that "the beautiful capacity for growth which characterizes the common law" would with respect to the right of privacy "enable the judges to afford the requisite protection, without the interposition of the legislature."<sup>114</sup> That this proved true is attested by judicial opinions in fifteen jurisdictions. There is no less reason to believe that the common law can likewise meet the publicity problems created by modern methods of advertising and communications without doing violence to our concept of an independent but limited judiciary. But whether the right of publicity is finally and fully realized by statute or through growth and adaptation of common law principles, eventual recognition of the right seems assured both from the trend of decisions already rendered, and from the more fundamental fact of community needs.

<sup>114</sup> Warren and Brandeis, *supra* note 8, at 195.