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Should Right of Publicity Protection be Extended to Actors in the Characters Which They Portray

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SHOULD RIGHT OF PUBLICITY PROTECTION BE EXTENDED TO ACTORS IN THE CHARACTERS WHICH THEY PORTRAY

INTRODUCTION

"Hello . . . Newman."

"Get OUT!"

"It's Shrinkage!"

"Giddy Up!"

Millions of Americans who faithfully watched the television show *Seinfeld* identify these "catch phrases" with the characters that spoke them episode after episode on the most watched sitcom on television.[1] Pursuant to the Federal Copyright Statute, these characters are protected by the *Seinfeld* copyright, as they appear in the "original work[s] of authorship fixed in a tangible medium of expression."[2] Additionally, certain distinct characters may receive copyright protection when they are removed from their original works and then placed in an unrelated work.[3] In such cases, courts

1 Tom Gliatto, *Much Ado About Nothing*, PEOPLE, Jan. 12, 1998, 119, 120. Roughly 32 million people tuned in to *Seinfeld* each week. For the benefit of those who strayed from the "Must See TV" line-up, these "catch phrases" were spoken weekly by Jerry Seinfeld (playing the self-entitled star); Julia Louis-Dreyfus (Elaine Benes); Jason Alexander (George Costanza); and Michael Richards (Cosmo Kramer), respectively.

2 17 U.S.C. § 102 (1976).

3 When determining the copyrightability of motion picture characters, courts have applied both the "story being told" and "character delineation" tests. *See* 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). Courts agree on one issue when determining the copyrightability of a character: "To be protected by copyright apart from the story in which it originally appeared, a character must be more than an idea in the public domain." Niro, at 360. *See also Anderson v. Stallone*,

have provided copyright owners with protection from infringement of the characters' physical likenesses,[4] speaking mannerisms,[5] personalities, methods of interacting with others[6] and physical surroundings.[7]

For example, Castle Rock Entertainment, the owner of the *Seinfeld* copyright,[8] may seek redress against anyone who, without authorization, displays the *Seinfeld* character, Kramer, as he appears in the original work of authorship, on a tee shirt. However, copyright law does not provide the actor Michael Richards, who plays the part of Kramer, the means by which to seek redress for the unauthorized use of his character on the same tee shirt. Thus, the question arises: Since actors do not receive copyright protection of the characters which they play, should these characters be protected by the right of publicity?

The right of publicity "signif[ies] the right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his [or her] name and picture or likeness and to prevent others from unfairly appropriating this value for commercial benefit." [9] The doctrine is based on the recognition that "a famous individual's name, likeness, and endorsement carry value and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation."[10] The theory for extending the right of publicity to

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11 U.S.P.Q.2d (BNA) 1161 (C.D. Cal. 1989) (The court applied both the character delineation and the story being told tests when providing copyright protection for the characters from the motion picture, Rocky.); *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) (The Ninth Circuit applied the character delineation test, with emphasis on the character's "total concept and feel" in its decision to provide copyright protection for the character, H.R. Pufnstuf).

4 *See, e.g., Universal City Studios v. J.A.R. Sales, Inc.*, 216 U.S.P.Q. (BNA) 679 (C.D. Cal. 1982)(E.T.).

5 *Anderson*, 11 U.S.P.Q.2d (BNA) at 1167.

6 *Sid & Marty Krofft Television Prods.*, 562 F.2d at 1166-1169.

7 *Id.*

8 The Library of Congress Catalogs (visited Oct. 22, 1998) http://lcweb.loc.gov/cgi-bin/zgate.

9 *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1353 (D.N.J. 1981).

10 *McFarland v. Miller*, 14 F.3d 912, 919 (3d Cir. 1994).

provide redress for misappropriations of an actor's character stems from the belief that in certain situations, an actor may develop the character in a way so distinctive as to elicit recognition of the actor from use of the character alone.[11] As the purpose of the right of publicity is to prevent exploitation of an individual,[12] it should then follow that the doctrine should protect against *any* commercial misappropriation, such as use of an actor's character, that exploits an individual.

Although the right of publicity is a well-recognized doctrine and about half of the states have right of publicity statutes, some academics and practitioners are opposed to the doctrine. Scholars adverse to the right of publicity argue that actors do not create their characters, rather, characters are developed by studios, producers, writers, and the audiences who perceive them.[13] However, "[r]egardless of the input from others, celebrities still remain the vehicles through which their images are conveyed to the public."[14] After all, using the above hypothetical, the recognition of a "Kramer" tee shirt is elicited by the public's association of the character with Michael Richard's face.[15] Although the script is written, the timing is rehearsed, and the movements are directed, the actor's interpretation and presentation of these elements form the fictional character into an actual person in the public's mind. Accordingly, Seinfeld's writers' formulation of the script does not, in and of itself, create the aforementioned "catch phrases." The actor's delivery, personality and energy are just a few factors that

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11 *See id.* at 920. The court held that "originality plays a role" when deciding whether the character is associated with the actor who portrayed the part. *Id.*

12 *Presley*, 513 F. Supp. at 1353.

13 *See, e.g.*, Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights Postmodern Politics, and Unauthorized Genders*, 10 Cardozo Arts & Ent. L.J. 365, 368 (1992); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 18 Calif. L. Rev. 127, 182-196 (1993).

14 Roberta Rosenthal Kwall, *Fame*, 73 Ind. L.J. 1, 42 (1997).

15 *See* Kwall, supra note 14, at 41-43. Professor Kwall notes that use of a celebrity's likeness to appropriate a fictional character that he or she played supports the position that "the character is as much the creation of the individual playing the character as the author of the script and the show's producer."

contribute to the construction of the character identified by these phrases.

Nonetheless, not every character is so closely associated with the actor who plays the role that the character elicits recognition of the actor who plays the part. Thus, this Case Note proposes that a celebrity's right of publicity should extend beyond the celebrity's personal image and encompass characters that have become so associated with the actor as to elicit recognition of the celebrity solely through appropriation of the character. [16] An individual may also seek redress for unauthorized commercial uses of his or her persona under other theories of law, such as §43 of the Lanham Act,[17] state unfair competition claims,[18] and state misappropriation claims; however, these causes of action will not be discussed here.[19]

A few recent decisions have provided redress for actors upon appropriation of their closely associated character, without holding that such protection was conferred by the actor's right of publicity.[20] This Case Note takes the position that the policies and goals underlying the right of publicity not only allow, but necessitate the protection of any misappropriation of an

16 *McFarland*, 14 F.3d 912. The Third Circuit is currently the only jurisdiction to adopt this test.

17 This section of the Lanham Act prohibits the use of any word, term, name, symbol or device that is a "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S.C. §1125 (a)(1)(A).

18 State unfair competition laws are designed to protect less distinctive subject matter. Unfair competition is defined as "include[ing] any unlawful, unfair or fraudulent business act or practice and unfair, deceptive, untrue or misleading advertising . . ." California Business and Professions Code Section 17200.

19 Misappropriation is a state based tort claim. *See Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (The Ninth Circuit held that defendant's imitation of Bette Midler's voice was an actionable misappropriation claim).

20 *See* infra notes 26 through 31, 35 through 46, 49 through 52, 59 through 64, 72 through 80, 103 through 110 and accompanying text.

individual's identity. Moreover, this Case Note opines that courts must uniformly recognize a celebrity's right of publicity, not just in his or her personal image, but also in the image of a character that is closely associated with the actor.

Thus, this Case Note consists of three parts. Part I will provide an overview of decisions that have provided an actor with protection from appropriation of a character closely associated with the performer. Only one court has explicitly held the right of publicity protects an actor from unauthorized uses of his or her character when the actor has become so "closely associated" or "inextricably linked" to a character, that exploitation of the character appropriated the actor's identity.[21] Therefore, the overview will center on decisions which have considered the issue of character misappropriation in the context of a violation of the actor's personal right of publicity. Moreover, the overview will be structured as a "spectrum of protection," beginning with situations where the actor is incorporated into the creation of the character, which are presumed protectible, and continuing to instances in which the character is independently created, thus requiring evidence of the public's association of the character with the actor in order to necessitate protection.

Part II will analyze the inadequacies in the application of the current law, noting the three areas where courts seem the most inconsistent: (1) what characters are eligible to receive right of publicity protection; (2) what aspects or traits of the characters are protected by the right of publicity; and (3) how much of the character must be appropriated to warrant a right of publicity cause of action.

Part III will propose an alternative analysis that provides for protection of characters under the doctrine of the right of publicity. This section will acknowledge that in order to truly serve the objectives of the right of publicity, a federal statute must be implemented to provide notice to would-be infringers and eliminate a defendant's ability to "forum shop" for a state with more lenient laws in the area of personal rights. The proposed test will determine which characters may receive right of publicity

21 *McFarland*, 14 F.3d 912.

protection by using a sliding scale approach, which compares the degree the actor is incorporated in the development of the character with the degree of public association of the actor with the character. In addition, this test will propose that characters should be afforded the same protection that the right of publicity provides for misappropriation of celebrity personas. Finally, a case by case analysis should be implemented to determine the extent to which a defendant must appropriate the character's identity in order to warrant a valid right of publicity claim.

PART I. AN OVERVIEW OF THE RIGHT OF PUBLICITY'S APPLICATION TO CHARACTERS

Many court decisions have granted an actor protection from exploitation of his or her character without explicitly holding that the right of publicity may extend to the protection of characters.[22] Courts appear reluctant to grant a celebrity a property interest in a character, to which the actor retains no legal rights.[23] Therefore, this overview is not structured to set forth cases where acceptance of this view has been advanced, but will analyze the case law as it provides a spectrum for protection of characters, beginning when a character's protection is the most compelling, as the actor is incorporated in the development of the character, and continuing to instances which require a case by case analysis of the public's view of the character, as the character is distinct from the actor playing the part.

This spectrum is comprised of the following "tiers" of protection: (1) the actor portrays himself or herself as a character; (2) the actor creates the character; (3) the character is based on the

22 *See* infra notes 26 through 31, 35 through 46, 49 through 52, 59 through 64, 72 through 80, 103 through 110 and accompanying text.

23 *See, e.g., Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911 (1996); *Baltimore Orioles v. Major League Baseball Players*, 805 F.2d 663 (7th Cir. 1986). Both courts have held right of publicity actions cannot be brought against unauthorized uses of copyrighted works, as actors do not own any rights in the works, thus causing preemption by the Federal Copyright Act. *See also Wendt*, 125 F.3d at 811, where the court held that the actors could not retain any rights in their characters, as Paramount held the copyright of the creative elements of the characters. *See also Lugosi v. Universal Pictures*, 603 P.2d 425, 431-435 (1979).

actor; (4) the actor plays a character with the same name, but with fictional elements; (5) the actor plays a character with the same first name, but with fictional elements; and (6) the actor plays a character who is dissimilar to himself or herself, but has become associated with the character. It should be noted that these tiers provide an outline of the levels by which a character is inherently protected; however, these categories are illustrative rather than exhaustive, as new ideas for characterizations emerge. Moreover, the spectrum should be viewed as a continuum, with the tiers overlapping and the examples fitting into two and sometimes three classifications.

A. The Actor Plays Himself or Herself as a Character

For almost fifty years,[24] celebrities have enjoyed protection of their "pecuniary interest[s] in the commercial exploitation of [their] identit[ies]" under the right of publicity.[25] When an actor plays himself or herself as a character, the character shares the actor's identity. Therefore, these situations present the strongest argument for right of publicity's extension to cases of character misappropriation.

The clearest example of an actor playing himself or herself in a role is that of a game show host or talk show host. In these situations, the character has the same name as the actor and the actor is not bound to a writer's script. The character has the same personality, mannerisms, speech patterns and style as the actor.

The Sixth Circuit's holding in *Carson v. Here's Johnny Portable Toilets*[26] supports the contention that such characters should receive right of publicity protection. In this case, the appellee, Here's Johnny Portable Toilets, used the slogan "Here's Johnny" coupled with the phrase, "The World's Foremost Commodian" to identify and advertise their portable toilets.[27] The court held that the phrase violated Johnny Carson's right of publicity, despite the

24 *Haelan Laboratories, Inc. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953) *cert. denied*, 346 U.S. 816 (1953). The right of publicity was officially recognized in this 1953 decision.

25 Madow, supra note 13, at FN 14.

26 698 F.2d 831 (6th Cir. 1983).

27 *Id.* at 833.

fact that the appellee did not use Carson's name or likeness.[28] The court explained the right of publicity protects an actor's pecuniary interest in his identity; therefore, any phrase or image identifying the actor is an invasion of this right.[29] Although the court held the phrase "Here's Johnny" sufficiently identified Carson,[30] the phrase did not identify Johnny Carson the individual, but rather, Johnny Carson as the host of *The Tonight Show*.[31] Therefore, this decision supports the view that a celebrity, such as a game show host, who plays himself as a character has a right of publicity in the character, as the defendant in the case appropriated Carson's character rather than Carson as an individual.

Thus, the *Carson* holding provides a basis for which celebrities such as David Letterman, Conan O'Brien, Oprah Winfrey, and yes, even Jerry Springer, may retain a proprietary interest in their on-screen talk show characters. Although these celebrities' monologues and interviews are undoubtedly written by someone other than themselves, the impromptu and unpredictable style of these shows permit the celebrity to incorporate himself or herself into the character. Similarly, an actor can also create a character when he or she has no script, but creates the character apart from himself or herself. These situations will be discussed in the next tier of the spectrum.

B. The Actor Creates the Character

In 1979, Justice Mosk explained in his concurrence to *Lugosi v. Universal Pictures*:[32]

> I do not suggest that an actor can never retain a proprietary interest in a characterization. An original creation of a fictional figure played exclusively by its creator may well be protectible.[33] Thus Groucho Marx just being Groucho Marx, with his mustache, cigar, slouch and

28 *Id.* at 835.

29 *Id.*

30 *Id.*

31 *Id.* at 836. The court acknowledged that "the phrase 'Here's Johnny' had been used for years to introduce Carson" on the Tonight Show.

32 603 P.2d 425.

33 *Goldstein v. California*, 412 U.S. 546 (1973).

> leer, cannot be exploited by others. Red Skelton's variety of self-devised roles would appear to be protectible, as would the unique personal creations of Abbott and Costello, Laurel and Hardy and others of that genre.[34]

Justice Mosk's concurrence both explains and provides examples for the second level of the spectrum: situations where the actor creates his or her character. This tier resembles the previous section in that the actor is not confined to a script; however, here the actor portrays a fictional character rather than acting as himself or herself.

In *Price v. Worldvision Enterprises, Inc.*,[35] the descendants of Stanley Laurel and Oliver Hardy brought suit for violation of the actors' rights of publicity. Worldvision Enterprises, the copyright holder of certain Laurel and Hardy pictures, impersonated the Laurel and Hardy characters in a pilot and proposed television series, "Stan n' Ollie."[36] The court held the defendant's use of the

34 603 P.2d at 431 (Mosk, J., concurring). In *Lugosi*, the appellants, Bela Lugosi's descendants, sought to recover profits made by Universal Pictures' commercial licensing of the Count Dracula character. *Id.* at 426. The items that were merchandised were made in the likeness and appearance of Bela Lugosi in his role of Count Dracula, even though other actors such as Christopher Lee, Don Chaney and John Carradine had also played Count Dracula. *Id.* at 427. The court based its decision on the issue of whether the right to exploit one's image is a personal right that can only be exercised during one's lifetime. *See id.* at 429-430. The court held that such a right is personal; however, concurring Justice Mosk and dissenting Chief Justice Bird seemed to conflict on the issue of whether an actor could hold a right of publicity in a character. *See id.* at 431-454. Justice Mosk opined that an actor may only possess a proprietary interest in an "original creation" played by its "creator," *Id.* at 431 (Mosk, J., concurring), as opposed to Chief Justice Bird's assertion that the right of publicity should extend to appropriations of the actor's likeness in his or her portrayal of a fictional character because the portrayals of the characters "may well be considerably more important than protection for the individual's 'natural' appearance." *Id.* at 445 (Bird, C.J., dissenting).

35 455 F. Supp. 252 (S.D.N.Y. 1978).

36 *Price*, 455 F. Supp. at 257. The defendants advertised the series with the following printed flyer: "Chuck McCann plays the explosive Ollie opposite Jim Mac George's portrayal of the lovable, bumbling Stan. They get involved in all types of side-splitting situations which seem to end in total chaos with Ollie's indignant disclaimer ' . . . a fine mess you've gotten us into!'" *Id.*

characters violated a previously issued injunction which prohibited the defendants from impersonating Laurel and Hardy's "physical likeness or appearances, costumes and mannerisms, and/or the simulation of their voices, for advertising or commercial purposes, including their use in or in connection with . . . the production of animated cartoons or motion pictures . . ."[37] The court then explained that right of publicity protection is more frequently extended to characters in instances, such as the one at hand, where the actors create the fictional characters, rather than a screenwriter.[38] Moreover, this decision resulted in the actors' rights of publicity, where were bequeathed to the plaintiffs, trumping the defendants' copyright ownership in the motion pictures, in that such ownership did not "entitle [the copyright owners] to exclusive use of the names and likeness of Laurel and Hardy for all commercial purposes."[39]

The same court gave credence to Justice Mosk's expansive views on the right of publicity in its subsequent decision of *Goucho Marx Prods. v. Day and Night Co., Inc.*,[40] holding the right of publicity extends to the "unique characters" which Groucho, Harpo and Chico Marx created.[41] In *Groucho Marx*, the plaintiff, the assignee of all "rights, title and interest in the name, likeness and style of the character Groucho, both as an individual and as a member of the Marx Brothers,"[42] brought suit against the defendants for their production of a Broadway play where the actors in the second half simulated the "unique appearance, style and mannerisms of the Marx Brothers."[43] The court recognized that "the Marx Brothers' fame arose as a direct result of their

37 *Id.* at 257-258.

38 *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 845 (S.D.N.Y. 1975).

39 *Price*, 400 F. Supp. at 842-843. Justice Stewart issued the injunctive order against Hal Roach Studios in this 1975 opinion. In a later opinion, Justice Haight affirmed the injunctive order against Worldvision Enters, Inc., as the case involved "the same cause of action and the same parties or their privies . . . involved in both suits." *Price*, 455 F. Supp. at 256.

40 523 F. Supp. 485, 491 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

41 *Id.* at 492.

42 *Id.* at 486.

43 *Id.*

efforts to develop instantly recognizable and popular stage characters, having no relation to their real personalities."[44] The court held that the defendants' impersonation of these characters violated the plaintiffs' right of publicity,[45] as the "Marx Brothers exploited their rights of publicity in their self-created characters."[46]

Additionally, an actor may create multiple characters which are recognized for one distinctive combination of style, appearance and mannerisms, such as Woody Allen's characterizations he has developed and portrayed throughout his career. Woody Allen, a well known movie star and director, is renowned for his common portrayal of a neurotic, nervous and worrisome character in most of his earlier roles.[47] Although the personalities of the characters are the same, the characters themselves differ from film to film. While the characters are not usually named after the actor himself, Woody Allen's development of these common characteristics in his roles sets his characters apart as distinctly his own. The public can only speculate as to whether these character traits are a fictitious creation by the actor, or in fact the essence of the actor's personality.[48]

This precise issue was addressed in *Allen v. National Video, Inc.*[49] where the defendant ran an advertisement featuring a celebrity look-alike whose hair style and expression resembled the

44 *Id.* at 491.

45 *Id.* at 492.

46 *Id.*

47 Allen's characters in his earlier films frequently portray elements of his "obsessive love of New York, his dislike of California (mostly L.A.) fads and intellectual pomposity, his introspective neuroses and pessimism, his requisite jokes and psychosexual angst about sex, put-downs of his own appearance and personality, the subjects of anti-Semitism, life, drugs and death, and distorted memories of his childhood." Time Dirks, *Review of Annie Hall (1977)*, (visited Nov. 19, 1998) http://www.filmsite.org/anni.html.

48 "Annie Hall clearly has autobiographical elements – it is the free-wheeling, stream-of-consciousness story of an inept, angst-ridden comedian much like Allen himself who experienced crises related to his relationship and family. [A real-life relationship and breakup did occur between Allen and co-star Keaton. Keaton's birth name was Diane Hall and her nickname was Annie. And Woody Allen played a similar role as mentor to Diane Keaton.]" Dirks, supra note 47.

49 610 F. Supp. 612 (S.D.N.Y. 1985).

"schlemiel" character which was embodied by Woody Allen in "Annie Hall" and similar films.[50] The court recognized the advertisement exploited the persona created by Allen in his earlier works;[51] however, in finding in favor of the plaintiff, the court did not decide whether Allen's right of publicity was violated, but rather deferred the issue to a determination under the Lanham Act, under which the court held that a likelihood of consumer confusion existed as a matter of law.[52] Nonetheless, the court's recognition that a celebrity may be exploited by his character supports the view that right of publicity protection should be extended to characters that identify the actors who create and portray them.

Consequently, an actor can create a unique fictional character, and in some instances can create a unique character trait common throughout multiple characters, that will identify the actor if exploited. These decisions exemplify certain courts' willingness to provide right of publicity protection to characters when the actor who plays the role also created it.[53] As this overview moves away from the more obvious situations where a character may receive right of publicity protection, the next tier discusses instances where the character is created by the writer or producer, rather than by the actor himself or herself, but the character is based on the actor.

C. The Character is Based on the Actor

When casting a well-known celebrity, a producer or director may develop a role which is based on the actor's identity, yet invent a character separate from the celebrity. In these situations, sometimes referred to as cameo appearances, an actor plays a character that is based on his or her real-life persona, sometimes

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50 *Id.* at 617. The advertisement is described as portraying "a customer in a National Video store, an individual in his forties, with a high forehead, tousled hair, and heavy black glasses. The customer's elbow is on the counter, and his face, bearing an expression at once quizzical and somewhat smug, is leaning on his hand. It is not disputed that, in general, the physical features and pose are characteristic of plaintiff." *Id.* at 617-618.

51 *Id.* at 624.

52 *Id.* at 629-630.

53 This view is common to scholars' criticism of the right of publicity. *See* supra note 13 and accompanying text.

even playing a character with the same name; however, in the portrayal of the role, the actor does not have the freedom to actually "play" himself or herself, because he or she is confined to a script. For instance, in the movie Ace Ventura: Pet Detective,[54] Dan Marino played a character who was the quarterback for the Miami Dolphins named "Dan Marino". Obviously, it is no coincidence that Marino actually is the Miami Dolphin's quarterback; however, Dan Marino, while playing this character based on himself, did not "play himself" in Ace Ventura, because the character was developed in relation to the plot of the movie.[55]

Other examples of this type of "celebrity as a celebrity" casting could be seen on episodes of the television show *Murphy Brown*, where news broadcasters frequently appeared on the sit-com as "themselves," although their portrayals were restricted to the show's script.[56] Moreover, Woody Allen's latest film, Celebrity,[57] features Leonardo DiCaprio, one of today's most popular celebrities, in a role that is quasi-based on the actor, as it explores some of the dynamics of the celebrity life.[58] Though DiCaprio's real-life experiences are undoubtedly similar to those of his character in the film, the character is a creation separate from the actor himself.

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54 Ace Ventura: Pet Detective was directed by Tom Shadyac and written by Jack Bernstein, Tom Shadyac and Jim Carrey. The cast includes Jim Carrey, Sean Young, Courtney Cox, Tone Loc, and Dan Marino. *Great Comedies* (visited Nov. 18, 1998) http://www.homevideos.com/revcom/1.htm.

55 In the movie, "Ace . . . is hired to solve the kidnapping of the Miami Dolphins' mascot, Snowflake, which is followed by the disappearance of quarterback Dan Marino." Rita Kempley, *"Ace Ventura: Pet Detective" (PG-13)* (last modified Feb. 4, 1994) http://www.washintonpost.com/wp-s.

56 *Murphy Brown* hosted cameo appearances by celebrities such as Leeza Gibbons, John Tesh and Kathleen Sullivan (Episode 49: "Going to the Chapel"); Larry King (Episode 57: "Rootless People"); Katie Couric, Joan Lunden and Paula Zahn (Episode 100: "A Chance of Showers"). *Guide to Murphy Brown* (visited Oct. 22, 1998) <http://www.xnet.com>.

57 (Miramax 1998).

58 DiCaprio portrays an out-of-control movie star who is followed by a writer/journalist who is assigned to the celebrity beat. *Celebrity* (visited Oct. 22, 1998) http://www.miramax.com:8888/ows-doc/celebrity.

Right of publicity cases have also arisen in these types of casting situations. In *Rogers v. Girmaldi and MM/UA Ent. Co.*,[59] the Southern District of New York addressed the issue of whether Ginger Rogers' right of publicity was violated by the defendants' distribution and production of a film in which the characters were dancers who imitated Fred Astaire and Ginger Rogers, and consequently were nicknamed "Fred and Ginger."[60] Rogers claimed that the film, "Frederico Fellini's 'Ginger and Fred'" misappropriated her public personality which she developed in her performances in some seventy-three motion picture films, the most renowned of which being her portrayal of a ballroom dancer with her co-star, Fred Astaire.[61] Rogers presented survey evidence reporting that a number of people exposed to the film's title and the film's advertisement connected the film with Rogers.[62] Rogers also cited MGM's marketing strategies for the film, which included a request that guests invited to the premiere dress as "Ginger and Fred" by using a dance cane and other associated attire, as evidence of misappropriation.[63] While the court did not reject the contention that Roger's right of publicity could be violated through appropriation of her elegant ballroom-dancing

59 695 F. Supp. 112 (S.D.N.Y. 1988).

60 *Id.* at 114. The film is described as "a fictional work that depicts the bittersweet reunion of two retired dancers. Decades earlier, as the Film's story goes, these two dancers had made a living in Italian cabarets imitating Fred Astaire and Ginger Rogers, thus earning the nickname "Ginger and Fred." The Film satirizes the world of television by presenting the central characters' reunion against the background of an Italian television special for which they are called upon to reprise the routine that they have not performed in 30 years." *Id.*

61 *Id.* at 113-115. Fred and Ginger co-starred in ten musical films, "beginning with "Flying Down to Rio" in 1933 and concluding with "The Barkleys of Broadway" in 1949, established Fred Astaire and Ginger Rogers as the icons of elegant ballroom dancing during Hollywood's Golden Age." *Id.*at 113.

62 *Id.* at 115. "Rogers . . . submitted a market research survey dated July 1986 reporting that based on approximately 200 interviews in Boston and New York (Staten Island) 43% of those exposed to the Film's title only connected the Film with Rogers and that 27% of those exposed to the Film's advertisement connected the Film with Rogers." *Id.*

63 *Id.*

character, the court held the film did not use Rogers' name for a commercial purpose and consequently dismissed her right of publicity claim.[64]

Despite the court's judgment for the defendant, its opinion did not undermine the viability of an actor's right of publicity claim against a defendant who commercially exploits a character based on the actor. Although Ginger Rogers did not make cameo appearances per se in her countless ballroom dancing films,[65] she did appear in her capacity as a dancer named Ginger Rogers; thus creating a situation analogous to the aforementioned "celebrity as celebrity" castings. Consequently, the *Rogers* opinion presents a case for which such characters should be eligible for right of publicity protection.

The next tier of the spectrum addresses situations where an actor plays a character who has the same name as the actor, but possesses fictional elements.

D. The Actor Plays a Character with the Same Name, but with Fictional Elements

This category is closely related to the preceding section; however, differs in that the character, although bearing the same name as the actor, is not developed in relation to the actor's persona, but rather, is based on fictional elements. Television sitcoms such as *Seinfeld* and *The Cosby Show* utilize this type of casting and character development.[66]

Seinfeld derived both the title of the series and the name of its central character from the actor who portrayed him. While the character of Jerry Seinfeld was based on the actor, as both are

64 *Id.* at 124.

65 *Id.* at 113. "This famous pair became so well known that the term 'Fred and Ginger' has come to be a metaphorical symbol for fine ballroom dancers and is frequently used in the press as a shorthand term for elegant dancers and dancing." *Id.*

66 It should be noted that the classification of the television show, *Seinfeld*, is difficult to determine, as it contains elements of both the aforementioned category and the current category. Thus, the reader should keep in mind that, as explained earlier, the tiers of the spectrum should not be viewed as distinct, but rather as a continuum in which some works may fall somewhere between the explanations of each tier.

single, stand-up comedians who perform much of their comic acts in New York, Jerry Seinfeld the character was based on fictional elements outside of the scope of Jerry Seinfeld the individual.[67] Although the previous category also encompasses characterizations that, though based on the actor contain fictional elements, the character of Jerry Seinfeld differs in that it was not based entirely on the actor's public image as a stand-up comedian. Rather, the show focused on the daily activities on the character Jerry instead of his stand-up routines, thus deriving the series' classification as "a show about nothing."[68]

The casting of *The Cosby Show*,[69] which was also named after the actor who played the main character, differs from *Seinfeld* in that Bill Cosby did not play a character named after himself, but instead portrayed the character of Heathcliff Huxtable.[70] Nonetheless, the series was named after the actor and thereby associated with Bill Cosby. Moreover, the main character was based on Bill Cosby to an extent, as he portrayed a father and a "funny-man."[71]

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67 "Stand-up comedian Jerry Seinfeld stars in this innovative, half-hour series, which blends situation "Seinfeld" comedy with his own stand-up routines." *Seinfeld* (visited Nov. 23, 1998) http://www.spe.song.com/tv/shows/seinfeld.

68 Perhaps another explanation for the placement of Jerry's character within this category is that this character was developed throughout the nine year life of the series, thus taking on an identity of his own, unlike the characterizations in the previous category which were guest-appearances or one-time portrayals.

69 (NBC television broadcast, 9/20/84 to 9/17/92).

70 "The series was one of the few to portray African-Americans as upper-class. It was more reminiscent of the old style comedies such as *Ozzie and Harriet* than it was *Sanford and Son*. Cosby had total creative control of the series and it often spotlighted his views on childrearing." F. Colin Kingston, *TV Dads, Past and Present* (last modified June 9, 1998) http://www.suite101.com/article.cfm/television/8088.

71 The show was based, at least in part, on Cosby's own experiences as a father of multiple children, as evidenced in the show's script, which at times borrowed from Cosby's stand-up routines detailing his life as a father. F. Colin Kingston, *TV Dads, Past and Present* (last modified June 9, 1998) http://www.suite101.com/article.cfm/television/8088.

One case which addressed a similar type of casting is the Ninth Circuit's decision of *White v. Samsung Electronics, Inc.*[72] In *White*, the defendant, Samsung, developed a series of advertisements depicting a Samsung product along with other items and a humorous prediction of their existence in the twenty-first century.[73] "The ads were meant to convey—humorously—that Samsung products would still be in use twenty years from now."[74] The advertisement that spawned litigation depicted a robot, dressed in a wig, gown and jewelry which resembled Vanna White's hair and dress.[75] The robot was positioned in front of a Wheel-of-Fortune like game board, with its arms outreached as if displaying the board.[76] The advertisement was captioned: "Longest-running game show. 2012 A.D."[77]

The Ninth Circuit held this depiction violated Vanna White's right of publicity.[78] The court premised its decision on a determination of whether the defendant used White's "likeness," and held that even though the robot itself did not resemble White, its blond wig, elegant dress and, most importantly, its position in front of a game-show board elicited recognition of White's identity.[79] The court relied on Professor Prosser's explanation of the right of publicity, where he noted, "'[i]t is not impossible that there might be appropriation of the plaintiff's identity, as by impersonation, without the use of either his [or her] name or his [or

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72 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993), *cert. denied*, 508 U.S. 951 (1993).

73 *Id.* at 1396. "By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by depicting a raw steak with the caption: 'Revealed to be health food. 2010 A.D.' Another depicted irreverent 'news'-show host Morton Downey, Jr. in front of an American flag with the caption 'Presidential candidate. 2008 A.D.'" *Id.*

74 *Id.*

75 *Id.*

76 *Id.*

77 *Id.*

78 *Id.*

79 *Id.* at 1397-1399.

her] likeness, and that this would be an invasion of his [or her] right of privacy.'"[80]

Thus, the *White* decision supports the views advanced in this Case Note by providing Vanna White right of publicity protection from unauthorized uses of her character, as Samsung's advertisement evoked the image of Vanna White as the character who turns—or now presses—the letters on the game-show "Wheel of Fortune."[81] Though Vanna White's character is not identical to those portrayed by Jerry Seinfeld and Bill Cosby, the characters played by these celebrities are all recognized by their real names, yet their characters are fictional creations.[82] Although one may argue that Vanna White's status as a game-show hostess is not a character at all, her performance is also not based on herself as an individual, as Vanna presumably only presses letters on the *Wheel of Fortune* set in her capacity as a game-show hostess. Thus, the Ninth Circuit's decision lends support to the view that fictional characters based on the celebrity playing the role, are protected by the celebrity's right of publicity.

Similar character development is discussed in the proceeding tier, where a character is fictionally created, but only adopts the actor's first name.

E. The Actor Plays a Character with the Same First Name, but with Fictional Elements

This tier is closely aligned with the previous section, as the only variable is the change of the character's last name. For instance, an actor who frequently brings his name to his characters is Tony Danza, whose characters acquired the actor's first name in series

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80 *Id.* at 1397-1398, *citing* Prosser, *Privacy*, 48 Cal.L.Rev. 383, 389 (1960).

81 *White* 989 F.2d at 1517 (Kozinski, J., dissenting). Circuit Judge Kozinski explained: "Samsung didn't merely parody Vanna White. It parodied Vanna White appearing in 'Wheel of Fortune,' a copyrighted television show . . ." *Id.*

82 The placement of the character of Vanna White in a category is, once again, a troublesome task, as her character does not read a script and thus, may be comparable to talk show host characterizations. However, White's character appears to possess less freedom in her performance, as her role as a game-show hostess does not allow her to express her identity beyond a few closing comments at the end of the show.

such as *Taxi*, *Who's the Boss*, and *The Tony Danza Show*.[83] Similarly, the sit-com *Roseanne*,[84] which derived its name from the show's central character, cast the character with the same first name as the actress who played her. The character of Roseanne Connor was fictional; nonetheless, the character of Roseanne, much like the character of Jerry Seinfeld, was based at least in part on reality, as Roseanne also lived in a lower-class neighborhood and struggled to make ends meet before becoming a celebrity.[85]

In *McFarland v. Miller*,[86] the Third Circuit addressed the issue of whether right of publicity protection extends to an actor's character of the same first name.[87] George McFarland played the character "Spanky" in the *Our Gang* series, appearing in ninety-five *Our Gang* films from 1937 and 1942.[88] Thus, McFarland became known by the name "Spanky McFarland," in recognition of the character he had played since the age of three.[89] McFarland also appeared in minor roles in a total of eight feature films,[90] appearing in the credits as Spanky McFarland in all but one film.[91]

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83 *E! Online – Fact Sheet – Tony Danza* (visited Nov. 23, 1998) http://www.eonline.com/Facts/People.

84 (NBC television broadcast, 10/18/88 to 3/28/95).

85 The series, *Roseanne*, is a comedy which mirrors Roseanne's own blue collar life before entering showbiz. *Roseanne Episode Guide* (visited 11/23/98) http://www.tardis.ed.ac.uk/~dave/guides/Roseanne/index.html.

86 14 F.3d 912 (3d Cir. 1994).

87 *Id.* at 915.

88 *Id.* The "Our Gang" series is described as: "The series' foundation was pitting scruffy, mischievous have-not kids against pretentious rich kids, sissy kids, and in general a hardened, rule-governed, class-conscious adult world that would stand between them and the only thing that they were interested in—making their own fun." *Id.* at FN 3, *citing* Leonard Maltin & Richard Bann, *The Little Rascals: The Life and Times of Our Gang* 4 (1992).

89 *Id.*

90 *Id.* While playing the character Spanky, George McFarland appeared in the films: "M-G-M's Day of Reckoning (1933), Paramount's Miss Fane's Baby is Stolen (1934), RKO-Radio's Kentucky Kernels (1935) (also starring Jackie Cooper and Wallace Beery), Paramount's early Technicolor western Trail of the Lonesome Pine (1936), Warner Bros.' Variety Show (1937) (with Dick Powell), and RKO's Peck's Bad Boy with the Circus (1938) . . . After leaving the Gang, McFarland had a small part in Republic's Johnny Doughboy (1943) with fellow former Gang member Carl "Alfalfa" Switzer." *Id.* at FN 4.

91 *Id.*

McFarland brought suit for infringement of his right of publicity against a restaurant operating under the name "Spanky McFarland's" and using pictures of and references to the *Little Rascals* and *Our Gang* characters in its decor and menu.[92] The Third Circuit, in holding for the plaintiff, acknowledged that an actor may have a cause of action for infringement of his or her right of publicity by appropriating a character in situations "where an actor's screen persona becomes so associated with him that it becomes inseparable from the actor's own public image." [93] Additionally, the court ruled that originality also plays a role when deciding whether a character should receive protection, citing Justice Mosk's concurring opinion in *Lugosi*.[94] The court reasoned, "the actor who develop[s] the image [has] the right to exploit it as superior to third parties which [have] nothing to do with the actor of the character identified with the actor."[95]

Although George McFarland acquired the name "Spanky" from his portrayal of the character, unlike the situations listed above where the character derived its name from the actor, the court's discussion focused on the fact that both the character and the actor possessed the same name, rather than who first acquired the name.[96] Consequently, the Third Circuit is the only jurisdiction to explicitly acknowledge that in certain situations, an actor may receive a proprietary interest in a character. Additionally, the court set forth the "associative value" test to determine when an actor's right of publicity may extend to protect appropriation of his or her character.[97] Consequently, *McFarland* sets forth the test whereby characters, such as those discussed in this tier, can receive right of

92 *Id.* at 916.

93 *Id.* at 920.

94 *Id.* In his concurrence, Justice Mosk explained that an actor could obtain a proprietary interest in a character in situations with "[a]n original creation of a fictional figure played exclusively by its creator." *Id., citing Lugosi*, 603 P.2d at 432 (Mosk, J., concurring).

95 *Id.* at 921.

96 *Id.* at 922. "[T]he restaurant, by using the name "Spanky McFalrnad's," appears to be commercially exploiting the image not only of the character "Spanky" but of the actor known through most of his life as George "Spanky" McFarland." *Id.*

97 *Id.* at 920.

publicity protection if they are "so associated with [the actor] that [they] become inseparable from the actor's own public image."[98]

This final tier will address situations where the character is entirely dissimilar to the actor who portrays the role; however, pursuant to the test set forth in *McFarland*, the character becomes "inextricably identified" with the actor.[99]

F. The Actor Plays a Character Dissimilar to Himself or Herself, but has Become Associated with the Character.

This tier identifies situations when a character who, though dissimilar from the actor who portrays the character, has become "so associated with [the actor] that [the character] becomes inseparable from the actor's own public image, [thereby giving] the actor . . . an interest in the image which gives him [or her] standing to prevent mere interlopers from using it without authority."[100] This may occur in situations where, as in *McFarland*, the actor has played the same character as his or her main role for most of the actor's life.[101] Additionally, an actor may develop a proprietary interest in his or her character when the actor brings an essence of originality to the role.[102]

In *Wendt v. Host International, Inc.*,[103] the Ninth Circuit faced the issue of whether the actors, George Wendt and John Ratzenberger, who played the characters of "Norm and "Cliff" in

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98 *Id.*

99 *Id.* The *McFarland* court also cites Justice Mosk's concurrence in *Lugosi* in its explanation, "[w]here an actor plays a well-defined party which has not become inextricably identified with his own person, it has been suggested that actor receives no right of exploitation in his portrayal of the character." *Id., citing Lugosi,* 603 P.2d at 432 (Mosk, J., concurring).

100 *Id.* at 920. This is the test set forth in *McFarland.*

101 *Id.* at 914-915. George McFarland began playing the character "Spanky" in 1931, at the age of three, and continued to play the character through 1942. *Id.* at 914. McFarland appeared in a number of films, both during and after his portrayal of the role "Spanky;" however, his appearances were only minor roles and at times, he was also cast with other member of the Gang. *Id.*

102 *Id.* at 920. The Third Circuit held that originality may also be a factor when determining whether an actor's right of publicity extends to appropriations of his or her character.

103 125 F.3d 806 (9th Cir. 1997).

the series *Cheers* could recover under California's statutory and common law right of publicity.[104] In *Wendt*, the defendants placed animatronic robots resembling the Norm and Cliff characters in airport bars that were modeled after the *Cheers* set.[105] The defendants claimed the robots, named "Hank" and "Bob," were neither modeled after the *Cheers'* characters, nor sufficiently similar to the plaintiffs to constitute their likenesses.[106] The Ninth Circuit ruled in favor of the actors and reversed the district court's grant of defendant's summary judgment motion.[107]

The *Wendt* court held an actor has no rights to his or her character,[108] but may claim a violation of the right of publicity if the misappropriation identifies the actor.[109] Thus the court remanded the case for a determination of whether the robots were "sufficiently 'like'" the actors to violate California's statutory and common law rights of publicity.[110] Although the Ninth Circuit did not expressly adopt the Third Circuit's position that a celebrity may claim a right of publicity in his or her character upon a

104 *Id.* at 809.

105 *Id.*

106 *Id.* at 809-813.

107 *Id.* at 810-812.

108 *Id.* at 811. The actors did not even attempt to claim that a proprietary interest vests in a character which the actor has become associated with, as the court noted that the "[a]ppellants freely concede that they retain no rights to the characters Norm and Cliff; they argue that the figures, named "Bob" and "Hank," are not related to Paramount's copyright of the creative elements of the characters Norm and Cliff." *Id.*

109*Id.* The court further explained that while an actor cannot have a property interest in his or her character, an actor's portrayal of a character does not negate the ability to control exploitation of his or her own image. "While it is true that appellants' fame arose in large part through their participation in Cheers, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character." *Id., citing Lugosi*, 603 P.2d at 431. The court's explanation seems circular in nature, in that an actor typically cannot rise to celebrity status, where his or her right of publicity becomes valuable, unless the actor plays a character which the public recognizes. Perhaps the court's analysis acknowledged that the actors have become "so associated" with their characters, that the public equated one with the other, and attempted to disregard this phenomenon by explaining that its occurrence did not affect the actors' proprietary interests in themselves.

110 *Id.*

showing of high "associative value," the court's remand order indicated its acceptance of the view that unauthorized uses of a character, such as the defendants' robots, may violate a celebrity's right of publicity if the appropriation identifies the celebrity.

Although the *Wendt* court premised its decision upon a question of fact of whether the appropriated images resembled the actors, the decision effectively granted actors, bearing no similarities such as name or personality with their characters, right of publicity protection over exploitation of their characters.[111] This tier does not set forth examples of characters which may be eligible for such protection, as such an analysis would require a factual determination of whether the character is highly associated with the actor.

Wendt's failure to acknowledge the expansion of the right of publicity's protection to characters is common throughout the majority of opinions discussed in this overview. This overview has demonstrated that many courts are hesitant to provide a celebrity with an interest in a character that he or she does not own or has not developed.[112] However, in cases where the actor created the character, courts appear more willing to protect the actor from appropriation of the character.[113] This reasoning could stem from a common argument of opponents to the right of publicity, many of which opine that a character is not a creation of the actor, and therefore, an actor cannot seek redress for uses of such.[114]

Therefore, *McFarland* illustrates that the actor's invention of the character is not the sole determination of whether exploitation of a character may appropriate the actor's identity, as McFarland did not "create" his character by writing the script; nonetheless, he became so associated with his role that he became known by the

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111 The "Hank" and "Bob" robots were modeled after the characters "Norm" and "Cliff" as they appeared in the Cheers series. The issue of whether the robots' faces resembled the actors who portrayed the characters is incidental, as it was not the actors' images which the defendants attempted to misappropriate, but rather, the characters as they appeared when portrayed by the actors.

112 *See* supra notes 103 through 110 and accompanying text.

113 *See* supra notes 26 through 31, 35 through 46, 49 through 52, 59 through 64 and accompanying text.

114 *See* supra note 13 and accompanying text.

character's name.[115] Additionally, the "invention" requirement loses sight of the goal underlying the right of publicity, which is to protect individuals from commercial exploitation of their identities.[116] An individual can be exploited by avenues other than those which he or she "created," thus, it seems logical that the relevant inquiry should be whether the individual's identity is commercially exploited, as every actor imports some sort of creativity in the portrayal of the character. These issues will be discussed in Part II of this Case Note, which analyzes the previously cited opinions.

PART II. ANLAYSIS OF THE RIGHT OF PUBLICITY'S EXTENTION TO CHARACTERS

Since only one jurisdiction has expressly held an actor may retain a proprietary interest in certain characters, the issues of (1) which characters receive right of publicity protection; (2) what attributes of the characters are protected; and (3) what a defendant is required to take in order to support a right of publicity claim have not been addressed by court decisions implicitly granting this right. Therefore, this section will analyze each of these issues in turn, attempting to determine the courts' intentions and reasoning in each of these areas. The analysis will begin with the issue of what characters receive protection.

A. What Characters Receive Right of Publicity Protection

While it is clear that one jurisdiction provides a celebrity with right of publicity protection,[117] and it can be inferred that other courts favor such protection,[118] it is unclear to whom this protection is afforded. The Third Circuit set forth the "associative value" test to define the situation where an actor retains a proprietary interest in his or her character.[119] However, while the question of whether a character has become "so associated with [the actor] that [the character] becomes inseparable form the actor's own public

115 *McFarland*, 14 F.3d at 915-919.
116 *See* supra note 9.
117 *McFarland*, 14 F.3d 912.
118 *See* supra notes 26 through 110.
119 *McFarland*, 14 F.3d at 920.

image"[120] may be easily decided in the situation of George McFarland as "Spanky," the answer is not as clear when the character is not as "legendary" as one of the "Little Rascals" and also has not been in existence since the early 1930's.

To illustrate, consider another *Seinfeld* scenario involving its cast member, Jason Alexander. Alexander played the character of George Costanza for the entire nine-year life of the show. With an average of 32 million viewers per week, it can be assumed a majority of Americans associate Jason Alexander with his character of George. Therefore, pursuant to the test set forth in *McFarland*, if the public associates the character of George with the actor who portrays him to the extent that the two are inseparable, it seems Jason Alexander has a proprietary interest in his *Seinfeld* character.

However, though Alexander may be best known for his character of *Seinfeld*, he has also played in other rolls spanning from the evil lawyer in Pretty Woman to his Tony-winning roll in *Jerome Robbins' Broadway.*[121] Neither *McFarland*, nor other courts' decisions are instructive as to determining whether an actor's right of publicity may vest in one character when he or she has portrayed other roles. For instance, in *Wendt*, the court essentially held that George Wendt and John Ratzenberger held proprietary interests in the characters they played on *Cheers* if, upon remand, the district court determined that the appropriations of the characters looked "sufficiently 'like'" the actors.[122] Although the *Wendt* court did not discuss whether consideration should be given to other roles the actors have played, it seems the existence of other roles played by Wendt and Ratzenberger was of no significance to the court, as both actors have played numerous other characters.[123]

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120 *Id.* at 920.

121 Gliatto, supra note 1, at 124.

122 *Wendt*, 125 F.3d at 811-812.

123 George Wendt, besides playing the character of Norm for eleven seasons from the years of 1982 through 1993, has also appeared in the motion pictures: Spice World (1998); The Price of Heaven (1997); Space Truckers (1997); The Lovemaster (1996); Man of the House (1995); Shame II: The Secret (1995); Hostage for a Day (1994); Forever Young (1992); NBA Comic Relife – The Great Blooper Caper (1991); Never Say Die (1990); Plain Clothes (1988); Gung

Additionally, the *McFarland* court held the actor had a right of publicity in his character after the actor's death.[124] This is significant for two reasons. First, McFarland, like Wendt and Ratzenberger, played other characters besides the character that was the subject of the litigation.[125] However, the court had the benefit of hindsight to determine that throughout McFarland's career, he was best associated with the character "Spanky."[126] This raises numerous issues. First, if litigation were to arise concerning the hypothetical situation of Jason Alexander as the character George Costanza, a court would not have the ability to look at Alexander's career in its entirety to determine the public's perception of the character with whom the actor is most associated, as Alexander may go on to portray other, more memorable characters in the future. Moreover, if a court were to hold that Alexander is so associated with the character of George Costanza that the actor's persona is implicated upon exploitation of the character, and Alexander goes on to portray another well-known character with whom he becomes inextricably identified, could Alexander's right of publicity also vest in the subsequent character? Finally, would an actor then have a proprietary interest in more than one character, or would he or she lose the proprietary interest in the initial character by virtue of the public's new association with another character?

Ho (1986); House 1 (1986); Fletch (1985); No Small Affair (1984); and Sometime (1982). Moreover, John Ratzenberger, in addition to his role as Cliff Clavin, has appeared in the films: That Darn Cat (1997); Star Wars Triology Special Edition (1997); One Night Stand (1997); The Empire Strikes Back – Special Edition (1997); The Legend of the North Wind (1996); Toy Story (1995); Bill Nye the Science Guy: Dinosaurs – Those Big Boneheads (1994); How I Spent My Summer (1990); She's Having a Baby (1988); Going to the Chapel (1988); House 2 – The Second Story (1987); Timestalkers (1987); Combat Academy (1986); Warlords of the 21st Century (1982): Sometime (1982); The Bitch (1979); Arabian Adventure (1979); and Star Wars (1977).

124 *McFarland*, 14 F.3d at 923.

125 *See* supra note 90.

126 *McFarland* may have had a different result if the court decided this issue in the 1930s or 1940s, when McFarland played the character of "Spanky," and portrayed other characters as well.

Secondly, *McFarland* is unique because the character at issue is an American classic, who has retained his wide-spread recognition throughout the generations, nearly seventy years since the inception of the "Spanky" character. However, such wide-spread recognition is unlikely to occur in this era as technology and inventions are leading the younger generations into unexplored processes and ideas, inevitably resulting in less emphasis on the classical representations of "the old days." Therefore, the *McFarland* analysis leaves the question of whether the actor must acquire some sort of perpetual identity with his or her character in order to meet the "associative value" test.

Furthermore, the *McFarland* decision does not answer the question of whether, when applying the "associative value" test, the public's perception should be taken as the public at large, or whether such a determination should focus on the relevant audience who had been exposed to the character. It seems that cases such as *McFarland* and *White* base their opinions on the general public's perception of the characters.[127] However, in *Allen*, the court held the defendant appropriated the plaintiff's image, even though the defendant's appropriation of Allen's earlier character would not elicit recognition by those acquainted solely with Allen's post-Annie Hall appearance.[128] Accordingly, the court

127 *See McFarland*, 14 F.3d at 920, where the court generally refers to an actor's "public image" and the issue of whether "people" link the person with the character; *see also White*, 971 F.2d at 1399, where the court does not limit the analysis to a certain section of the population in its explanation, "The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product." *Id.* The dissent also notes that the majority's decision is based on the perception of the general "public." *White*, 989 F.2d at 1514 (Kozinski, J., dissenting).

128 *Allen*, 610 F. Supp. at 624. The court notes:

> [T]he hair style and expression, while characteristic of the endearing "schlemiel" embodied by plaintiff in his earlier comic works, are out of step with plaintiff's post-"Annie Hall" appearance and the serious image and somber mien that he has projected in recent years. While this distinction would be of no moment if defendants had appropriated an actual photograph of plaintiff from 15 years ago such as those submitted by plaintiff for comparison, it is relevant to the question of whether the audience of movie watchers at whom this advertisement

relied on evidence that the target audience of the advertisement associated the character with the actor.[129]

Additionally, *McFarland* is not instructive as to what method the court used to determine that public's perceptions and associations. In *Rogers* and *Wendt*, the plaintiffs used survey evidence to demonstrate whether the public associated the celebrities with the defendants' use of their personas. Rogers' survey targeted the public at large,[130] while Wendt surveyed only those who may be exposed to the defendant's appropriation.[131] Nonetheless, these techniques were used only to provide evidence of the misleading nature of the defendants' advertisements, not to demonstrate whether the public identified the actor with his or her character.

B. What Aspects of the Character are Protected

Once it is determined which characters should be protected via the right of publicity, the next step is to identify which aspects of the character are shielded by this protection. It has been noted the right of publicity is no longer limited to "the name or likeness of an individual, but now extends to a person's nickname, signature, physical pose, characterizations, singing style, vocal characteristics, body parts, frequently used phrases, car, performance style, mannerisms, and gestures, provided that these are distinctive and publicly identified with the person claiming the right."[132] The *White* court acknowledged the expansive scope of right of publicity protection by holding "the common law right of publicity reaches means of appropriation other than name or likeness, [and] . . . the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identify."[133] The court explained: "[t]he

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was aimed would conclude thatplaintiff had actually appeared in the 1984 advertisement. *Id.*

See Negri v. Schering Corp., 333 F. Supp. 101 (S.D.N.Y. 1971).

129 *Id.*

130 *See* supra note 62.

131 *Wendt*, 125 F.3d at 814. The actors offered data obtained by a consumer survey into evidence which was "taken in the vicinity of the Cheers bars at the Cleveland and Kansas City airports." *Id.*

132 Coombe, supra note 13, at 367.

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

right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable."[134] Thus, the court held the defendant's robot appropriated Vanna White's identity despite the fact that the robot did not physically resemble Ms. White.[135] Rather, the defendant appropriated her identity by displaying the robot in surroundings that evoked the identity of White in the public's mind.[136]

Similarly, the *Carson* court held that the phrase "Here's Johnny" sufficiently identified the plaintiff, explaining a right of publicity violation is not dependent on whether the actor's name or likeness was used, but rather, whether the actor's identity was exploited.[137] The *Carson* ruling has additional significance, in that the phrase "Here's Johnny" was not coined by Carson but rather by his co-host, Ed McMahon, when announcing Carson's character on *The Tonight Show*. Hence, combining the *Carson* opinion with the test set forth in *McFarland*, it seems if a phrase or nickname becomes associated with a character, and the character is so

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134 *Id.*

135 *Id.*

136 *Id.* The court reasoned:

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

137 *Carson*, 698 F.2d at 835. The Sixth Circuit in its reversal of the district court's opinion held:

> The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected form the unauthorized commercial exploitation of that identity . . . If the celebrity's identity is commercially exploited, there was been an invasion of his right whether or not his "name or likeness" is used. Carson's identity may be exploited even if his name, John W. Carson, or his picture is not used. *Id.*

inextricably identified with the actor that the actor's own identity would be evoked by the nickname, the actor's right of publicity may be violated by misappropriation of the phrase or nickname.[138]

Not all courts are accepting of the right of publicity's expansive scope of protection. As earlier noted, the *Wendt* court noted the right of publicity "protects more than the knowing use of a plaintiff's name or likeness for commercial purposes,"[139] yet remanded the case for a determination of "the degree to which the figures look like [the actors]."[140] Therefore, the *Wendt* decision seems opposed to the expanding coverage of the right of publicity by limiting its analysis solely to the determination of the degree of physical similarity.

C. How Much of the Character Must a Defendant Take

This section examines the issues of what must be appropriated to subject a defendant to a claim for violating an individual's right of publicity. Courts continue to vary their assessments of this issue by finding violations of the right of publicity in a variety of circumstances, ranging from exact copying to reminding the public of the celebrity through the representation.[141] Some courts have extended the definition of actionable uses by the defendant by finding appropriation of the celebrity's identity in situations where

138 Cases which have addressed a celebrities' right of publicity in their personas, rather than in their characters have upheld this rationale. *See, e.g. Hirsch v. S.C. Johnson & Sons, Inc.*, 90 Wis.2d 379, 280 N.W.2d 129 (1979) (holding that the defendant's use of the name "Crazylegs" on its shaving gel for women violated Elroy Hirsch's right of publicity, as he was known by that nickname); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (holding that a nude sketch of a black man in a boxing ring entitled "Mystery Man" violated Muhammad Ali's right of publicity, in that the advertisement contained language referring to the figure as "The Greatest," and Ali commonly referred to himself by that phrase.) Additionally, Prosser has explained that "a stage or other fictitious name can be so identified with the plaintiff that he is entitled to protection against its use." Prosser, *Privacy*, 48 Cal. L. Rev. 383, 404 (1960). Prosser also pointed out that "[i]f a fictitious name is used in a context which tends to indicate that the name is that of the plaintiff, the factual case for identity is strengthened." Prosser, at 403.

139 *Wendt*, 125 F.3d at 811.

140 *Id.*

141 *See* infra notes 143 through 155 and accompanying text.

the commercial use was arguably not to suggest the celebrity's endorsement of the product.[142]

McFarland involved exact copying of both the name and likeness of the plaintiff.[143] The defendant entitled his restaurant "Spanky McFarland's" and decorated the interior of the establishment with pictures and murals of the plaintiff in his portrayal of the character, Spanky McFarland.[144] Thus, the defendant took both the plaintiff's name and likeness, the two attributes that the right of publicity was originally deemed to protect.[145] Additionally, the defendant's use of the plaintiff's identity indicated the plaintiff either endorsed or owned the establishment, as the entire theme of the restaurant centered on the plaintiff's character and the television series which featured the role.[146]

In *Wendt*, the defendants developed a bar depicting the atmosphere associated with the *Cheers* television show, on which the plaintiffs played characters that were also displayed within the defendant's establishment.[147] Although the bar was designed to resemble the bar in *Cheers*, the figures which resembled the plaintiffs' characters of Norm and Cliff were not exact replicas of the characters and not akin to the photographs or murals displayed by the defendants in *McFarland*.[148] The court held that a violation of the right of publicity does not require the use of the name or exact likeness of the celebrity to present a potential cause of

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142 The *White* decision was criticized, both by the dissenting opinion and academics, as an unprecedented expansion of the right of publicity, claiming that the advertisement did not suggest sponsorship and the opinion extended the scope of the doctrine to simply reminding the public of a celebrity. *See White*, 989 F.2d at 1514 (Kozinski, J., dissenting); John R. Braatz, *White v. Samsung Electronics America: The Ninth Circuit Turns a New Letter in California Right of Publicity Law*, 15 Pace L. Rev. 161, 195-222 (1994).

143 *McFarland*, 14 F.3d at 915.

144 *Id.* at 915-916.

145 *Haelan Laboratories, Inc.*, 202 F.2d 866. Courts originally extended right of publicity protection only to appropriations of a celebrity's name and likeness.

146 *Id.*

147 *Wendt*, 125 F.3d at 809.

148 *Id.*

action.[149] The court required a determination that the robots physically resembled the actors, but did not require an exact replication of the plaintiffs' physical images in order to evoke an actionable claim.[150] However, the court held that the "comparison must be decided without reference to the context in which the image appears;"[151] consequently limiting the analysis to the characters themselves, without reference to the bar's design.[152] Therefore, the *Wendt* court, by looking solely to the robots without requiring associated surroundings, appeared to require less of a taking by the defendant than the *McFarland* decision.

The defendants in *White* arguably took very little of the celebrity's image, but only appropriated the location with which the plaintiff was associated.[153] Neither the robot nor its dress or accessories clearly resembled the plaintiff; nonetheless, the robot's placement in a location associated with Vanna White was sufficient to violate White's right of publicity.[154] In this situation, the defendant took very little from the celebrity's image, yet the court viewed an appropriation of her typical surroundings as use of the celebrity's persona.[155] Moreover, the defendant's use of Vanna White's persona arguably did not suggest her endorsement of their product, as the defendant produced a series of similar advertisements, all of which played on events which are common

149 *Id.*

150 *Id.* at 809-810.

151 *Id.* at 809.

152 *Id.*

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

154 *Id.*

155 *White*, 989 F.2d at 1514. The dissent views the majority's opinion as creating a new tort for reminding the public of a celebrity. "Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses the product; but simply to evoke the celebrity's image in the public's mind." *Id.* (Kozinski, J., dissenting). The dissent continues to explain that now, "[i]nstead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the public of her. After all, that's all Samsung did: It used an inanimate object to remind people of White . . ." *Id.* at 1515.

in the 1990's and portrayed them in a humorous manner without explicitly stating sponsorship.[156]

Hence, it is obvious that courts' determinations of when a character may receive right of publicity protection, which aspects of the character are protected, and how much a defendant is required to take in order to claim a violation of the right of publicity varies significantly in case to case. Since the right of publicity is a state-based law that may be either common law or statutorily based, it is obvious that states' treatment of these causes of action will differ. However, if the right of publicity is to function both to preserve the celebrity's reputation and to deter would-be infringers from appropriating the celebrity's identity, it is essential that the doctrine is applied with uniformity, at the very least, in the determination of what interests are protected under the right. The third and final part of this Case Note will set forth a proposal whereby courts must recognize the right of public's protection as encompassing an actor's portrayal of a character in certain situations. This final section will also recommend a test to determine which characters may receive this protection, and additionally, will list factors to aid in such an analysis.

PART III. A PROPOSED TEST TO DETERMINE WHEN AND WHAT TYPE OF PROTECTION SHOULD BE AFFORDED CHARACTERS UNDER THE RIGHT OF PUBLICITY

Nearly every state recognizes the right of publicity, as either a common law or statutory claim.[157] Since each state's cause of

156 The dissent argues that Samsung's use of White's persona constituted a parody and did not imply White's endorsement of the product. *Id.* at 1517-1520. *See also* Braatz, supra note 76; Steven R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 Tort & Ins. L.J. 635 (1995). Both authors support the dissent's view that Samsung's use constituted a parody which is protected by the First Amendment. Moreover, Barnett notes that the decision has caused a chilling effect among the advertising community, who lack the resources and interest in asserting their free speech rights and attempting to shape the law to protect those rights.

157 *See* Madow, supra note 13, at FN 23. In only two states, Nebraska and New York, courts have rejected the common law right of publicity. However, New York's privacy statute provides for some aspects of the right of publicity. *See also* Roberta Rosenthal Kwall, *The Right of Publicity vs. The First*

action under the doctrine contains different elements and theories, the courts' evaluations of such claims are not uniform as each court must adhere to its state laws and precedent. These contrasting analyses impede the goal of the doctrine, which is to prevent unauthorized commercial exploitation of a person's identity.[158] This disparity in states' right of publicity laws results in a lack of uniform protection of individuals from appropriation of their identities; insufficient notice as to what constitutes infringing behavior; and allows infringers to "shop" for a state with less protective right of publicity laws. It is neither practical nor probable that states will unify their statues and approaches to these state based claims; therefore, this proposition is contingent upon the enactment of a federal right of publicity statute. While the elements and factors set forth in this proposal could serve as a basis by which courts may assess state law claims, this approach cannot effectively provide characters with right of publicity protection without implementation of a federal statute to produce state uniformity.

This proposed test encompasses each of the issues addressed in the previous section by viewing the degree of protection to be afforded a character pursuant to a sliding scale approach. The sliding scale is representative of the spectrum set forth in Part I of this Case Note, with characters belonging in the first tier of the spectrum protected by the right of publicity absent the requirement of a high associative value between the actor and the character, and continuing to the final tier, which necessitates a showing of a high associative value in order to receive protection. The test also proposes that commercial use of any aspect of the character which identifies the celebrity is actionable and the degree to which a defendant must use these aspects should be assessed on a case by case determination. However, before setting forth the elements of the test, it is necessary to address the preemption issue which has

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Amendment: A Property and Liability Rule Analysis, 70 Ind. L.J. 47, FN 26 (1994).

158 *Haelan Laboratories, Inc.*, 202 F.2d at 870.

been raised in the cases of *Fleet v. CBS, Inc.*[159] and *Baltimore Orioles v. Major League Baseball Players.*[160]

A. The Right of Publicity in a Character is not Preempted by the Federal Copyright Act

The supremacy clause of the United States Constitution provides a state statute is subject to preemption if it "'actually conflicts with a valid federal statute' or 'stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.'"[161] Relying on the Constitution and §106 of the Federal Copyright Act, *Fleet*, California's controlling authority, has held that right of publicity claims brought under California's statute are preempted by the Federal Copyright Law when the claim involves a copyrighted work.[162]

In *Fleet*, the Court of Appeals upheld the trial court's holding that right of publicity claims for appropriation of an actor' performance violated the Copyright Act's prohibition of states from legislating in the area of copyright law, in that "once [an actor's] performances [are] put on film, they [become] 'dramatic work[s]' 'fixed in [a] tangible medium of expression' that could be 'perceived, reproduced, or otherwise communicated' through 'the aid of a machine or device.'"[163] The appellants, the parents of a young actor, entered an agreement conveying to CBS the copyright to the motion picture, White Dragon, including the theme, title and

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159 50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645 (1996).

160 805 F.2d 663, 677 (7th Cir. 1986).

161 *Fleet*, 50 Cal. App. 4th at 1918, *quoting Edgar v. MITE Corp.*, 457 U.S. 624 (1982).

162 *Id.* at 1924. §301 of the Federal Copyright Act provides: "On and after January 1, 1978, 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, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to nay such right or equivalent right in any such work under the common law or statutes of any State." 17 U.S.C. §301 (1976).

163 *Id.* at 1919, *quoting* 17 U.S.C. §102(a).

characters of the motion picture.[164] After a controversy regarding the salaries owed to the actors, the appellants informed CBS that since they did not receive compensation for their work, CBS was forbidden from using their "names, pictures, or likenesses in conjunction with any exploitation of the film."[165] Nonetheless, CBS released the film on videotape and allegedly included a picture of Stephan Fleet on the box.[166]

Rather than looking at the contractual language and addressing the case as a contract dispute, the court broadly held "[b]ecause a performance is fixed in a tangible form when it is recorded, a right of publicity in [such] performance . . . is subject to preemption."[167] The plaintiffs' claim involved the reproduction and distribution of copyrighted performances; therefore, *Fleet* held the plaintiffs claimed a right equivalent to the exclusive rights provided in §106 of the Federal Copyright Act.[168] The court based its decision in part on the Seventh Circuit's similar decision of *Baltimore Orioles*, as well as several district court decisions,[169] which held that right of publicity claims are preempted in copyrighted performances.[170]

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164 *Id.* at 1914. The terms of the distribution agreement were, in pertinent part, as follows:

> The "Licensor hereby grants to Distributor [CBS Productions] the exclusive right and License for the 'Distribution Term' . . . to exercise all rights of distribution in all media (including, without limitation, theatrical, non-theatrical, free television, pay television, cable television, and videocassette exhibition) with respect to the Picture throughout the 'Territory' . . . in and to that certain theatrical motion picture entitled White Dragon . . . including all contents thereof, all present and future adaptations, versions and translations thereof and the theme, title and characters thereof, and in and to all copyrights thereon and renewals and extensions of copyright therein." *Id.* at FN 1.

165 *Id.* at 1914.

166 *Id.* at 1914-1915.

167 *Id.* at 1924, *quoting Baltimore Orioles v. Major League Baseball Players*, 805 F.2d at 677.

168 *Id.* at 1918-1919.

169 *Fleet* 50 Cal. App. 4th at 1923. The *Fleet* court referred to the cases of *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166 (D.D.C. 1992)(James Brown's right of publicity claim for displaying a clip of his performance of the song "Please, Please, Please" in a 1991 movie was preempted because the performance was copyrighted.); *Rooney v. Columbia*

Although *Fleet* and its predecessors assert that right of publicity claims are preempted in copyrighted works, the situations in which these cases find preemption are in situations where the actual performances have been appropriated.[171] These cases do not address instances where the character itself is taken from the actual performance and appropriated in a different medium of expression, such as the situation in *Wendt*. In discussing this issue, the *Wendt* court held that *Fleet* is controlling authority only in the situation where "the only claimed exploitation occurred through the distribution of the actor's performance in a copyrighted movie."[172] Therefore, the court found the actors' claims were not preempted by federal copyright law as they did not relate to the appropriation of the original works in which the actors appeared.[173] Additionally, the court found the plaintiffs asserted rights not protected by federal law.[174]

Therefore, the holdings of *Fleet* and *Baltimore Orioles* do not suggest that the examples cited throughout this Case Note, where the character is appropriated in a medium other than the original

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Pictures Industries, Inc., 538 F. Supp. 211 (S.D.N.Y. 1982)(Actor Mickey Rooney's right of publicity claims were waived by granting defendants the copyrights to his pre-1960 films.); *Muller v. Walt Disney Productions*, 871 F. Supp. 678 (S.D.N.Y. 1994)(The conductor in Walt Disney's Fantasia gave up all rights by granting Disney the right to control the distribution, exploitation, and exhibition of the film.).

170 *Id.* at 677. The court held that the Baltimore Orioles baseball players could not assert a right of publicity in their performances because the baseball games are copyrightable, thus preempting a cause of action under the right of publicity. The court held that "[b]y virtue of being videotaped . . . the players' performances are fixed in tangible form, and any rights of publicity in their performances that are equivalent to the rights contained in the copyright of the telecast are preempted." *Id.* at 675.

171 *See* supra notes 161 through 170 and accompanying text.

172 *Wendt*, 125 F.3d at 810.

173 *Id.*

174 *Id.* The court explains that "'claims are not preempted by the federal copyright statute so long as they contain elements, such as the invasion of personal rights . . . that are different in kind from copyright infringement.'" *Id. (quoting Wendt v. Host*, 1995 WL 115571 at *1 (9th Cir. 1995)) (*quoting Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992)) (*citing* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 132 (1976)).

work, pose a preemption problem. However, consider the hypothetical where the character of Elaine Benes from *Seinfeld*, played by Julia Louis-Dreyfus, is appropriated by using a clip of the series where Elaine searches all of New York City to find Mr. Pitt the perfect pair of socks. Obviously, Castle Rock could sue for copyright infringement; however, pursuant to *Fleet* and *Baltimore Orioles*, Louis-Dreyfus has no means by which to seek redress for appropriation of her character since the exploitation occurred through use of a copyrighted work. This distinction seems quite arbitrary as the unauthorized use of the Elaine character in a copyrighted work is no less identifying of Louis-Dreyfus than the use of Elaine in a different medium. In fact, actual copying should present an even stronger case for celebrity exploitation as the appropriation is an exact replica of the character and consequently, the individual. Moreover, claims under the right of publicity doctrine contain elements beyond the scope of protection provided by the Federal Copyright Act. Nonetheless, *Fleet* and *Baltimore Orioles* present obstacles to persons seeking redress for appropriations of their characters in original works while in both California and the Seventh Circuit. Hopefully, these decisions will be reversed in the near future but, until that time, the following proposal is limited to appropriations of characters outside of their original works in disputes arising these jurisdictions.[175]

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175 Shortly before this Case Note went to press, the Central District of California's decision of *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (1999) came out. In this decision, the district court held that right of publicity claims for appropriation of an actor's image appearing in a copyrighted work were not preempted by the Federal Copyright Act because the right to protect the use of one's own name an image is separate from the copyright interest of the copyright holder. Thus, the decision completely opposed the opinions stated in *Fleet*, although the court did not even mention the *Fleet* decision. The court held that the defendant, Los Angeles Magazine, violated Dustin Hoffman's right of publicity, as well as federal and state unfair competition claims, by publishing a still frame from the motion picture Tootsie whereby Hoffman was clad in a gown and shoes advertised by the magazine. Therefore, the decision further supports the views advanced in this Case Note by providing right of publicity protection for misappropriation of Hoffman's character.

After addressing this preliminary matter, the remainder of Part III will set forth a proposed test for extending the protection afforded by the right of publicity to characters.

B. The Sliding Scale Test for Determining which CharactersReceive Protection Under the Right of Publicity

Right of publicity protection should be extended to any character that is "so associated with [the actor] that [the character] becomes inseparable from the actor's own public image."[176] However, the "associative value" test, as set forth in *McFarland*, should be applied as a sliding scale which, pursuant to the spectrum set forth in Part I, provides protection to a character at the top tier of the spectrum without requiring a showing of association and requires a high association level for characters in the bottom tier. The purpose for the progressive level of proof of association rests in the acknowledgement that celebrities in the first tier of the spectrum (i.e., talk show hosts), are implicitly associated with their characters as they convey their personality into their screen personification. Conversely, an actor who portrays a character in a bottom tier of the spectrum (i.e., an actor who portrays a character unique from the actor personally) must establish that he or she has imparted some level of creativity or originality in the character in order to elicit public recognition of the actor upon exploitation of the character.

Celebrities can prove their associative value with their character by utilizing the fact finding techniques which demonstrate consumer confusion in both right of publicity and trademark infringement analyses. Such evidence includes surveys,[177]

176 *McFarland*, 14 F.3d at 920.

177 Although survey evidence has been attacked as providing unreliable evidence through poor questions (*See, e.g., Sears, Roebuck & Co. v. Allstate Driving School, Inc.*, 301 F. Supp. 4 (E.D.N.Y. 1969) and methodology (*See, e.g., Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F/2d 794 (9th Cir. 1970). Nonetheless, survey evidence can explain what the public is thinking at the time of litigation. Therefore, surveys are usually admissible as indicators of the public's opinion, provided that:

> ". . . (1) the 'universe' was properly defined, (2) a representative sample of that universe was selected, (3) the questions to be asked of interviewees were framed in a clear, concise and nonleading manner,

statistical data,[178] individual accounts[179] and expert testimony.[180] Moreover, much like courts' analyses of §43(a) of the Lanham Act claims,[181] the 'universe' of such data should only encompass the relevant audience, rather than drawing samples from the public at large. The evidence should demonstrate that, like *McFarland*, the actor has acquired a general identification with his or her character throughout the public; however, a finding of widespread notoriety can exist in situations where the character is not an American Classic, as was Spanky McFarland. Additionally, evidence of character merchandising that exploits the image of the actor supports a finding that the actor is associated with the character.[182]

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(4) sound interview procedures were followed by competent interviewers who had no knowledge of the litigation or the purpose for which the survey was conducted, (5) the data gathered was accurately reported, (6) the data was analyzed in accordance with accepted statistical principles and (7) objectivity of the entire process was assured."

Schieffelin & Co. v. The Jack Company of Boca, 850 F. Supp. 232, 235 (S.D.N.Y. 1994).

178 *See, e.g., McDonald's Corp. v. Druck and Gerner, DDS., P.C.*, 814 F. Supp. 1127 (N.D.N.Y. 1993), where plaintiff presented evidence that 30% of the population surveyed associated defendant's name, McDental, with plaintiff's family of marks. *Id.* at 1130.

179 *See, e.g., Lois Sportswear v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986), where the court assessed both statistical evidence as well as individual accounts to determine that the appellant's back pocket stitching on its jeans caused consumer confusion. *Id.* at 869-870.

180 *See, e.g., Computer Assocs. Int., Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992); *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). Expert testimony may be relied on if needed to aid in the analysis. However, courts are hesitant to allow such testimony, as factual issues (such as the issue of copyright infringement in these cases) should ultimately be determined by the trier of fact.

181 *See, e.g., Jim Beam Brands Co. v. Beamish & Crawford Ltd.*, 937 F.2d 729 (2d Cir. 1991). The relevant inquiry in a consumer confusion inquiry is the determination of whether the potential consumers will be confused by the defendant's use of the mark. *Id.* at 733. In *Beam*, the court held that evidence of consumer confusion within the public at large was insufficient to demonstrate actual confusion as "consumers of alcoholic beverages [possessed] a high awareness of the mark . . ." *Id.*

182 This was the situation in *Lugosi*, where Bela Lugosi's heirs brought suit for appropriation of the actor's image in merchandising of the Count Dracula

Finally, the court must determine on a case by case basis whether, in the situation where the actor becomes highly associated with another character after already establishing a proprietary interest in a previously portrayed character, the public at large continues to associate the actor with the original character.

C. The Elements Which are Portrayed Must be Viewed as a Whole to Determine Whether They Identify the Character

In light of the expanding protection provided individuals for exploitation of their personas, the right of publicity as applied to characters should also embody this expansive view, thus concentrating not on how the celebrity's identity was appropriated, "but whether the defendant has done so."[183] A character is comprised of a "name, physical appearance, attributes, mannerisms, speech and expression, habits, attire, setting, and locale."[184] Therefore, the court must determine which of the character's attributes are the most distinctive, consequently identifying the celebrity when used by the defendant.[185]

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character, in that the merchandise was in the likeness of Bela Lugosi as Count Dracula. *Lugosi*, 25 Cal. 3d at 817.

183 This is the approach set forth in *White*, 971 F.2d at 1398. The court explains the approach as follows:

> Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. The right would fail to protect those plaintiffs most in need of its protection. Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater visibility for the product. *The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness or voice. Id.*at 1399 (emphasis added).

184 Niro, supra note 3, at 360.

185 The *White* court, in its adoption of this test, explained the following hypothetical to illustrate its application:

> Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed,

Although many scholars dispute the *White* holding,[186] critics of the decision did not claim that the advertisement failed to elicit public recognition of Vanna White. Rather, a common argument set forth is a defendant should not be prohibited from simply "reminding" the public of a celebrity.[187] However, the right of publicity's expansion beyond appropriations of an individual's name and likeness is premised on the acknowledgment that traits other than a name or likeness may identify, or remind, the public of a celebrity.[188] Consequently, a defendant's display of a location that is associated with a character, while not "belonging" to the actor, may in fact appropriate his or her image.

D. Infringing Uses Must Be Determined on a Case By Case Basis

As discussed in Part II, courts have protected celebrity identities from misappropriation in a variety of contexts and uses by defendants, each case depending upon a factual determination of whether the defendant's action evoked recognition of the celebrity's identity. This test proposes that the defendant's activities should be viewed as a whole, and courts should not limit their analyses to looking at one factor of the appropriation in isolation.[189] Beyond this, violations of the right of publicity must be found on a case by case basis, as "[a] rule which says that the right of publicity can be infringed only through the use of nine

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> legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that nay sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.

White, 971 F.2d at 1399.

186 *See* Barnett and Braatz, supra notes 142 and 156, respectively.

187 *See* supra note 155.

188 *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988). This court held that the right of publicity protects the identity of the celebrity, rather than a mere "laundry list" of particular means of appropriation. *Id.* at 463-464.

189 This approach conflicts from that taken in *Wendt*. *See* supra note 151 through 152 and accompanying text.

different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth."[190]

CONCLUSION

Americans place great value on both individual achievement and the right to receive compensation for those achievements.[191] Additionally, Americans revere fame and those who achieve such status.[192] The right of publicity provides protection of these values by preventing the unauthorized commercial exploitation of celebrity personas. Therefore, these values which underlie the doctrine's protection are furthered by the recognition that an individual possesses many attributes, and dependent upon the distinctiveness of these characteristics, exploitation of a single element of an individual's persona may elicit recognition of his or her identity.

This Case Note recognizes the existence of this phenomenon, and acknowledges in certain situations a celebrity's identity may be exploited by an appropriation of an entity which the celebrity does not own, such as a character which the actor has portrayed. It is contrary to the goals of the right of publicity to withhold protection from such individuals merely because of lack of ownership in the exploited entity. Indeed, such a denial or protection would serve as a disincentive for actors to develop their characters in such a distinctive way as to create an association of the character with the actor. Like copyright and patent law, the right of publicity serves to protect these "performances, inventions and endeavors [which] enrich our society."[193] Therefore, it is essential to the function of the doctrine, to provide protection from all unauthorized appropriations of an individual's identity.

Angela D. Cook

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

191 Nimmer, *The Right of Publicity*, 19 Law & Contemp. Prob. 203, 216 (1954).

192 *See* Kwall, supra note 14.

193 *Lugosi*, 25 Cal.3d at 840 (Bird, C.J., dissenting).