1982

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THE RIGHT OF PUBLICITY: A "HAYSTACK IN A HURRICANE"

Richard Ausness*

INTRODUCTION

Over the years, entertainers, athletes and other celebrities have sought legal protection for a variety of occupationally related injuries. By virtue of being in the public eye, celebrities often complain that their private lives have somehow been invaded. This concept of invasion of privacy involves damages for mental anguish suffered by virtue of the unwarranted disturbance. However, performers may also suffer injury of an economic, rather than personal, nature. For example, an individual's performance may be used without his or her consent. People will normally pay to watch that entertainer, but where the performance is misappropriated, he is unable to reap the benefits of his talent and capitalize upon the public demand for his performance.¹ This economic interest may be referred to as “performance value.” The other economic interest important to celebrities, somewhat analogous to a business organization’s interest in its name and goodwill, is “recognition value.” As the name implies, this is derived from the public’s recognition of a celebrity’s name or likeness.² The celebrity exploits this recognition through endorsements and other forms of advertising where the goodwill associated with his persona is transferred to a collateral product, thereby increasing its acceptance by the public.³ In addition, popular interest in the celebrity creates a market for products such as posters, statues, tee-shirts

¹ The most important means of protecting performing values is contractual. Generally, the contract will specify the extent to which rights in the performance are retained by the performer and the extent to which they are assigned to others. However, although the contract provides the performer with a remedy against parties to the agreement, it does not protect him against third parties. Silverberg, Authors’ and Performers’ Rights, 23 LAW & CONTEMP. PROBS. 125 (1958); Comment, The Twilight Zone: Meanderings in the Area of Performers’ Rights, 9 U.C.L.A. L. REV. 819, 819-20 (1962). For this reason, the state must protect the performer by preventing unauthorized persons from recording, duplicating, broadcasting, or otherwise disseminating the performance, thereby depriving the performer of the benefits of his effort. Id. at 820.


and other memorabilia which carry his name or likeness. Like the performance interest, however, recognition values have little utility unless the legal order acknowledges the exclusive nature of the celebrity’s interest in his persona by enabling him to prevent others from exploiting it without his permission.

In the past, various legal theories, including privacy and unfair competition, have been invoked to protect performance and recognition values. Recently, however, performers and other celebrities have been utilizing another doctrine known as the right of publicity to prevent unauthorized exploitation of these interests. According to this concept, the intangible values generated by the activities of entertainers and celebrities are characterized as a species of property which can be licensed or assigned to others. Within the last two or three years, courts have decided cases involving such celebrities as Elvis Presley, Laurel & Hardy, Muhammad Ali, Bela Lugosi, Agatha Christie and the Marx Brothers. Litigation of this nature is likely to continue as other celebrities, or those claiming through them, attempt to capitalize on these publicity rights.

Almost three decades ago a federal court in Ettore v. Philco Television Broadcasting Corp. characterized the state of the law in the field of publicity rights as a “haystack in a hurricane.” Today, the law of publicity remains even more unsettled as new controversies have arisen. Perhaps the most significant issue is whether publicity rights survive the death of those who create them. Another area of uncertainty is the extent to which publicity rights are preempted

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6. See notes 13-74 infra and accompanying text for a discussion of the right of privacy and the law of unfair competition.


by federal copyright legislation. Finally, the impact of the first amendment on the right of publicity is in need of clarification.

This article will address each of these matters. Part I examines the nature and scope of the right of publicity as well as its relation to privacy and unfair competition. Part II considers whether the right of publicity should survive death while Part III deals with the federal preemption issue. Finally, constitutional limitations on the exercise of publicity rights are analyzed in Part IV.

I. PUBLICITY, PRIVACY AND UNFAIR COMPETITION

Until the emergence of the right of publicity, entertainers and celebrities were forced to rely on the right of privacy or the law of unfair competition to prevent others from impairing their performance or recognition values. However, neither of these concepts provided satisfactory protection for the economic interests at stake.

A. The Right of Privacy

The concept of the right of privacy was first proposed by Warren and Brandeis in 1890. Today, almost all jurisdictions recognize some form of privacy interest; most have done so by judicial decision, but seven states enacted statutes to protect the right of

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According to Dean Prosser, there are four distinct types of invasion of privacy: intrusion upon physical solitude; public disclosure of private facts; false light in the public eye; and appropriation of name or likeness. Intrusion upon the plaintiff's physical solitude or seclusion includes trespasses to land, illegal personal searches, eavesdropping and other unacceptable forms of prying into another's private affairs. Public disclosure of private facts involves the dissemination of information about a person which although true, is embarrassing or highly personal. The facts disclosed must be private ones; matters of public record or public knowledge, such as criminal convictions, are normally not within the scope of this action. False light privacy actions arise where false information or impressions are given about the person. While these false impressions need not be defamatory, they must be offensive to a person of ordinary sensibilities. Consequently, defamation and false light often overlap. Appropriation of name or likeness involves the use of a person's name, picture or photograph in a manner that is likely to be offensive. Use of the plaintiff's picture in connection with advertising is a common example of appropriation, although it covers other situations as


The appropriation theory\textsuperscript{26} has generally been used when celebrities have invoked the law of privacy to protect themselves from unauthorized exploitation by others. For example, a professional golfer recovered when the defendant obtained newsreel motion pictures of him giving an exhibition of trick shots and used them without permission in a movie entitled \textit{Golfing Rhythm}.\textsuperscript{28} Fred Astaire obtained injunctive relief against the use of his name and photograph in an advertisement for "Swank" jewelry.\textsuperscript{27} In the same manner an actor was able to prevent his picture from being used for advertising purposes by the Postal Telegraph Company\textsuperscript{28} and a baseball player also secured an injunction when his photograph was placed on popcorn packages without his consent.\textsuperscript{29}

These cases, however, were not common-law privacy actions, but rather, were brought under the New York Civil Rights Act, a statute which allows "any person whose name, portrait or picture is used . . . for advertising purposes or for the purposes of trade" to sue for damages or injunctive relief.\textsuperscript{30} In a common law privacy action, most courts regard injury to personal feelings as the primary element of damages.\textsuperscript{31} Celebrities and entertainers who have actively sought publicity cannot honestly claim to be offended by public exposure alone. Consequently, the courts have frequently limited celebrities to nominal damages\textsuperscript{32} or denied recovery altogether\textsuperscript{33} when

\begin{itemize}
  \item 25. The term "appropriation" in this article is used in connection with the right of privacy, while the term "misappropriation" is usually associated with a form of unfair competition. Missappropriation is discussed \textit{infra} notes 57-74.
  \item 28. Sinclair v. Postal Tel. & Cable Co., 72 N.Y.S.2d 841, 842 (Sup. Ct., New York County 1935).
\end{itemize}
they have merely sought to vindicate economic interests and failed to show mental distress. Thus, the plaintiff in *Gautier v. Pro-Football, Inc.* was denied relief when a television network broadcasted an animal act performed by the plaintiff during half-time ceremonies at a Washington Redskin football game. The court declared that "the recovery is grounded on the mental strain and distress, on the humiliation, and on the disturbance of the peace of mind suffered by the individual affected." Perhaps the plaintiff would have recovered if he had eschewed the privacy claim and sued on the basis that his contract did not allow a telecasting of his performance.

Recovery was also denied in *O'Brien v. Pabst Sales Co.* O'Brien, a well-known college quarterback, was chosen as a member of Collier Magazine's All-American Football Team in 1938. Although he had allowed his picture to be used in sports journals and similar media, O'Brien objected when the defendant published a promotional calendar which carried his picture along with those of other All-Americans. Having sought publicity, the court reasoned, the plaintiff could hardly be offended by Pabst's actions. As in *Gautier*, the Fifth Circuit refused to use the right of privacy as a vehicle for redressing economic injury, rather than mental distress. These cases suggest that the right of privacy does not protect those economic interests covered by the right of publicity.

There are other aspects of the right of privacy that make it an unsuitable vehicle for protecting the economic interests of entertainers and celebrities. First, because the interest protected is a personal one, the right of privacy cannot be assigned. Thus, although an individual can release another from liability, he cannot grant an ex-


35. 278 A.D. at 439, 106 N.Y.S.2d at 561.

36. Id. at 438, 106 N.Y.S.2d at 560.

37. Id. at 439, 106 N.Y.S.2d at 561.

38. 124 F.2d 167 (5th Cir. 1942).

39. Id. at 170.

40. Id. Cf. Sharman v. C. Schmidt & Sons, Inc., 216 F. Supp. 401, 405 (E.D. Pa. 1963) (professional basketball player who posed for pictures for advertising purposes could not recover under invasion of privacy when one of these pictures was used to promote beer).

exclusive right to make commercial use of his name or likeness which is enforceable under a privacy theory. In addition, an action for invasion of privacy, like defamation, can only be maintained by a living person. The cause of action will not survive death because the gist of a privacy action is injury to hurt feelings—something manifestly inapplicable to a dead person.

B. Unfair Competition

Unfair competition embraces a wide variety of objectionable business practices. It evolved as an equitable principle to provide relief wherever, by reason of an unjustifiable act, the goods of the defendant were accepted by purchasers as those of the plaintiff. This facet of unfair competition, known as “passing off,” requires public deception. Another theory of unfair competition is “misappropriation,” under which liability will attach where the defendant appropriates for commercial advantage a benefit arising from the efforts of another. Therefore, passing off focuses upon the injury to the public, while misappropriation emphasizes the pecuniary loss sustained by the plaintiff. One feature they have in common, however, is a requirement that some form of competition exist between the plaintiff and the defendant. Generally speaking, the courts have taken a liberal view of what constitutes competition, and have al-

42. See Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868-69 (2d Cir. 1953) (exclusive right for commercial use derived from statute). See also Nimmer, note 13 supra, at 209.
46. See Comment, note 1 supra, at 841.
49. Comment, note 1 supra, at 842-43.
50. But see Vassar College v. Loose-Wiles Biscuit Co., 197 F. 982 (W.D. Mo. 1912) (no competition between Vassar College and defendant company which sold “Vassar Chocolates”—seal on candy boxes closely resembled the seal of Vassar College; also, boxes pictured a lady wearing a mortar-board). See also Smith v. Suratt, 7 Alaska Rep. 416 (1926) (court refused to enjoin defendant news service from taking unauthorized photographs of plaintiff’s expedition to North Pole because it was “heroic adventure,” not commercial undertaking).
allowed indirect competition to suffice.  

When there is deception, the passing off theory of unfair competition may be successfully employed to protect entertainers and celebrities. For example, in *Chaplin v. Amador*, comedy Chaplin enjoined another actor from imitating his name, dress and performing style in a movie called *The Race Track*. The court found that the defendant's impersonation was calculated to deceive the public and work a fraud upon both the public and the plaintiff. Comedy Bert Lahr also recovered where a "Lestoil" television commercial featured an animated cartoon duck which imitated his distinctive voice. The defendant's actions not only deceived the public into thinking that Lahr had done the commercial, but also reduced the potential market for his services from other commercial advertisers. On the other hand, singer Nancy Sinatra was unable to prevent Goodyear from using the lyrics to *These Boots Are Made for Walkin'* in a television commercial for its tires since the court did not believe that the public would be deceived into thinking the vocalist in the commercial was Sinatra even though their singing styles were similar. Thus, the passing off doctrine falls short of pro-

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51. Indirect competition exists when the defendant commercially exploits the plaintiff's performance in a different manner than that employed by the performer. For example, in *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct., New York County 1950), aff'd, 279 A.D. 632, 107 N.Y.S.2d 795 (App. Div. 1951), the defendant record company recorded the plaintiff's live performance off the air and sold phonograph records of the performances. The opera association was a performer, while the defendant was a record manufacturer and, therefore, they were not in direct competition with each other. Nevertheless, the court granted an injunction against the defendant, declaring that "persons in theoretically non-competitive fields may, by unethical business practices, inflict as severe and reprehensible injuries upon others as can direct competitors." 199 Misc. at 796, 101 N.Y.S.2d at 492. Courts, however, have occasionally refused to find liability in cases where the plaintiff was not trying to exploit his identity or talent for economic gain. Thus, in *Columbia Broadcasting Sys., Inc. v. De Costa*, 377 F.2d 315 (1st Cir. 1967), cert. denied, 389 U.S. 1007 (1968), the plaintiff, who claimed that he had originated the "Paladin" character, was unable to recover under the unfair competition theory because he did not copyright the Paladin name, dress, slogan, or chess piece symbol or use them for commercial purposes. *Id.* at 321.

53. *Id.* at 363, 269 P. at 546.
55. *Id. See also Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977), in which the defendant during a television commercial used an actor conducting an orchestra and provided him with the same gestures, musical beat, and music (*Auld Lang Syne*) with which Guy Lombardo had been associated in the public's mind for several decades. Recovery was allowed under the passing off theory of unfair competition. 58 A.D.2d at 624, 396 N.Y.S.2d at 665 (Hopkins, J., concurring).
56. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971). The same result was also reached in *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969), where TWA used the song *Up, Up and Away* in its commercials. Members of "The Fifth Dimension," which had first recorded the song, sued
tecting publicity interests to the extent that public deception is required in order to recover.

The misappropriation theory originated in *International News Service v. Associated Press*,\(^7\) decided by the United States Supreme Court in 1918. International News Service (INS) obtained news items from Associated Press' (AP) bulletin boards and from wire stories published in eastern newspapers; it then transmitted them to subscribers in the West who were thereby enabled to publish those stories before the plaintiff's customers. INS argued that once AP had published a news item it was placed in the public domain and could no longer be controlled by the plaintiff. The Court, however, recognized the existence of a "quasi property" right in AP, good only against its competitors and based on its expenditures of labor, skill and money.\(^6\) This "property" was protected from misappropriation by a competitor to the extent necessary to give the AP first use of the news it had gathered in all areas of the syndicate's publication.\(^5\) Similarly, the misappropriation concept was invoked in *Pittsburgh Athletic Co. v. KQV*\(^5\) to protect a baseball club against a defendant who had broadcast an account of the games based on reports from observers stationed outside the stadium.\(^6\) The court held that the plaintiff had a legitimate right to capitalize on the news value of its games by selling exclusive broadcasting rights and, consequently, the defendant's attempt to appropriate this value constituted unfair competition.\(^6\)

The misappropriation concept has also been invoked by performers and other public figures. For example, in *Ettore v. Philco Television Broadcasting Corp.*,\(^5\) a former prizefighter sued a television station to recover damages for televising a film of his 1936 fight

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under an unfair competition theory. As in the *Sinatra* case, the defendant had obtained permission to use the song from the composer so that there was no claim of statutory copyright infringement. Although *Up, Up and Away* was associated in the public's mind with The Fifth Dimension, the court felt that no deception of the public would occur. *Id.* at 1146; *see also* *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973) (imitation of television comedy series character).

57. 248 U.S. 215 (1918).
58. *Id.* at 236.
61. *Id.* at 492. *See also* Twentieth Century Sporting Club, Inc., v. Transradio Press Serv., Inc., 165 Misc. 71, 73-74, 300 N.Y.S. 159, 161-62 (Sup. Ct., New York County 1937) (injunction granted to broadcaster to prevent competitor from using information from plaintiff's radio broadcast of prizefight in defendant's account of the fight).
62. 24 F. Supp. at 492.
with Joe Louis on its program *Greatest Fights of the Century*. At the time of the fight Ettore had sold the cinema rights, but remained free to exploit his performance rights through other media such as television. The lower court's judgment for the defendant was reversed on appeal and the case was remanded back to the trial court for a determination of damages. Relief was presumably available even though Ettore was no longer boxing professionally and had not tried to exploit his fight films for commercial purposes.

The misappropriation theory has also been applied where one has made an unauthorized use of the plaintiff's name or likeness in connection with merchandising efforts. Thus, in *Hirsch v. S. C. Johnson & Son, Inc.*, former football player "Crazylegs" Hirsch recovered against the manufacturer of a women's shaving gel called "Crazylegs." The plaintiff was widely known as "Crazylegs" and had done commercials under that name.

There is a strong resemblance between the misappropriation theory of unfair competition and the right of publicity in that both concepts are concerned with preventing unjust enrichment and both characterize the intangible interest created by a person's talent or labor as "property." Nevertheless, the right of publicity is superior to misappropriation in several respects, at least where performers and celebrities are concerned. First, the assignee of a celebrity's right of publicity may enforce his rights against the celebrity himself or against third parties. It is not clear whether an assignee

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64. Id. at 496. *But see* Republic Pictures Corp. v. Rogers, 213 F.2d 662 (9th Cir. 1954), and Autry v. Republic Prod's, Inc., 213 F.2d 667, 669 (9th Cir. 1954), where the court held that the performers' motion picture contracts also authorized exploitation through television.

65. 90 Wis. 2d 379, 280 N.W.2d 129 (1979).

66. Id. at 403, 280 N.W.2d at 140.


71. *See, e.g.*, *Factors I*, 579 F.2d 215, 221 (2d Cir. 1978); Haelan Laboratories, Inc. v.
can maintain a cause of action in his own right under the misappropriation theory as the law of unfair competition does not usually recognize an assignment in gross.\textsuperscript{78} Assignability, however, is essential to the commercial value of most publicity rights since they are generally most useful when licensed or transferred to another for a consideration.\textsuperscript{78} Another advantage of publicity rights over misappropriation is the apparent lack of a competition requirement, which has occasionally been an obstacle to recovery under the misappropriation theory.\textsuperscript{74}

C. The Right of Publicity

The inadequacies of privacy and the traditional theories of unfair competition have led to the development of the right of publicity as a means of protecting performance and recognition values. This right of publicity was first recognized in \textit{Haelan Laboratories v. Topps Chewing Gum, Inc.},\textsuperscript{75} decided in 1953. Topps entered into contracts with a number of major league baseball players for the exclusive right to use their photographs to promote the sale of its chewing gum. Thereafter, another party made similar agreements with the same players and assigned the rights to the defendant.\textsuperscript{75} The defendant argued that since the right of privacy was not assignable, the contracts were no more than releases from the liability which would result from unauthorized use of the players' photographs under the New York privacy statute. Consequently, the defendants maintained that the plaintiff had obtained no property or other interest which could be invaded.\textsuperscript{77} The trial court agreed with this reasoning and dismissed the complaint.\textsuperscript{78} On appeal, the Second Circuit reversed, declaring that celebrities had an assignable property interest in the exploitation of their names and identities for commercial purposes. The court stated:

\begin{quote}
We think that, in addition to and independent of that right of
\end{quote}

\begin{itemize}
\item Topps Chewing Gum, Inc., 202 F.2d 866, 870 (2d Cir.), \textit{cert. denied}, 346 U.S. 816 (1953).
\item \textsuperscript{72} Nimmer, note 13 \textit{supra}, at 210.
\item \textsuperscript{73} Felcher & Rubin, note 10 \textit{supra}, at 1127.
\item \textsuperscript{74} See, e.g., Columbia Broadcasting Sys., Inc. v. De Costa, 377 F.2d 315, 316 (1st Cir. 1967), \textit{cert. denied}, 389 U.S. 1007 (1968).
\item \textsuperscript{75} 202 F.2d 866 (2d Cir.), \textit{cert. denied}, 346 U.S. 816 (1953).
\item \textsuperscript{76} A detailed discussion of the various contracts involved appears in Haelan Laboratories, Inc., v. Topps Chewing Gum, Inc., 112 F. Supp. 904, 906-10 (E.D.N.Y. 1953) (on remand).
\item \textsuperscript{77} 202 F.2d at 867.
\item \textsuperscript{78} 103 F. Supp. 944, 953-54 (E.D.N.Y. 1952).
\end{itemize}
privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may be validly made "in gross" i.e., without any accompanying transfer of a business or anything else. . . . This right may be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements . . . popularizing their countenances. This right of publicity would usually yield no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.79

In the years since Haelan Laboratories was decided, the right of publicity has been recognized by an increasing number of state and federal courts.80

As mentioned earlier, the right of publicity is more practical than the privacy theory because it is expressly concerned with protecting economic interests.81 Moreover, unlike the interests covered by privacy or unfair competition doctrines, publicity rights are capable of being licensed or assigned to third persons.82 Assignability allows a person to grant an exclusive right to another to exploit his performance or recognition values. Typically, the celebrity will license another to perform a specific activity. For example, a rock singer or comedian might permit a film producer to film and record a particular concert. Recognition values can be exploited in a similar manner. An athlete might allow one company to place his name on its sports equipment while also permitting another company to use his name or picture to promote the same of beer or soft drinks.83

79. 202 F.2d at 868.
83. See Cepeda v. Swift & Co., 415 F.2d 1205 (8th Cir. 1969), which provides an interesting example of a dispute between the celebrity and licensee about the scope of the publicity rights transferred. In that case, baseball player Orlando Cepeda granted an exclusive license to Wilson Sporting Goods to use his name and likeness in connection with the sale of sports equipment. Id. at 1206. Wilson then entered into an arrangement with Swift whereby "Orlando Cepeda" baseballs were offered at a special price by Swift to those who sent in a specified number of hot dog wrappers. Id. This promotion was widely advertised by Swift and Cepeda's picture was used in the advertisements. Id. The court held that Wilson could validly
1. Protection of Performance Values

The rationale behind legal recognition of performance values is similar to that which accounts for the protection accorded authors and composers under copyright laws. Entertainers, like authors and composers, produce something of value for society. The development of performing skills and the implementation of creative ideas often requires a substantial investment of time, energy and money. The greater the possibilities for personal profit, the more likely people are to pursue these creative, socially beneficial activities. For this reason the right of publicity can arguably be applied to protect the values that inhere in a particular performance.

The leading case in this area, Zacchini v. Scripps-Howard Broadcasting Co., decided by the United States Supreme Court in 1977, relied on this rationale to uphold the right of performance. The plaintiff, Hugo Zacchini, performed a “human cannonball” act at a local fair in which he was shot from a cannon into a net about 200 feet away. Each performance lasted about fifteen seconds. Zacchini brought suit against the defendants when they filmed the performance without permission and televised it on the evening news. Although it characterized Zacchini’s interest as a right of publicity, the Ohio Supreme Court denied recovery on first amendment grounds. The United States Supreme Court, however, held that Zacchini’s performance values were entitled to protection. In the Court’s words:

The broadcast of a film of petitioner’s entire act poses a substantial threat to the economic value of that performance. As the Ohio court recognized, this act is the product of petitioner’s own talents and energy, the end result of much time, effort, and expense. Much of its economic value lies in the “right of exclusive control over the publicity given to his performance”; if the public can see the act free on television, it will be less willing to pay to see it at the fair.

Accordingly, the state court’s judgment for the defendant was re-
versed and Zacchini’s performance rights were upheld.99

It should be noted that a performer may choose to protect a particular performance through copyright law instead of relying on the right of publicity.90 The present federal Copyright Act extends protection to any original work of authorship fixed in a tangible medium of expression from which it can be perceived, reproduced or otherwise communicated.91 Copyright protection for a live performance, therefore, can easily be secured by videotaping it.92 This protection arises the moment the work is fixed in a tangible medium of expression and no formal registration is required.93 Thus, a simple and inexpensive alternative to protection under state created publicity rights is available to performers under the federal Copyright Act.94

2. Protection of Recognition Values

Publicity values also arise from the goodwill associated with the name or likeness of a famous person. Like performance values, these recognition values are usually created by sacrifice and hard work and, therefore, arguably deserve similar protection.95 Of course, celebrity status is not always based on merit; some acquire fame by fortuitous involvement in a famous event, while others achieve it because of criminal or antisocial acts.96 Moreover, while society benefits directly from the performances of talented persons, it derives no particular benefit from the commercial exploitation of their recognition values.97 On the other hand, protection of recognition values increases the financial rewards to those who choose publicity generat-

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99. For a discussion of the first amendments aspect of the Zacchini decision, see notes 309-25 infra and accompanying text.
90. The interrelationship between copyright and the right of publicity is discussed at notes 236-74 infra and accompanying text.
92. The copyright statute expressly protects works of authorship fixed in such media as motion pictures, audiovisual works, and sound recordings. Id. § 102(a)(6),(7).
93. The copyright owner, however, may voluntarily obtain registration of the copyright claim with the United States Copyright Office. Id., §§ 408-410.
94. Zacchini’s performance, for example, would probably qualify for copyright protection as a pantomime or dance. See id. § 102(a)(4). It could be “fixed” by film or possibly in a system of notation. See id., § 101.
95. Treece, note 3 supra, at 647.
97. Hoffman, note 81 supra, at 118. According to Hoffman, celebrities are already compensated for the activities that generate their publicity values. To the extent this compensation provides them with an adequate rate of return on the time and effort they have invested, less weight need be accorded to their individual interests in reaping additional remuneration for collateral uses of their names and likenesses. Id. at 119-20.
ing careers, and thereby indirectly encourages the production of creative works and noteworthy achievements. Moreover, the rationale underlying the law of unfair competition—to prevent deception and unjust enrichment—supports the protection of recognition values. Advertisements that use a person's photograph or testimonial without his consent to recommend a product not only victimize the individual but also harm the consuming public because an unauthorized endorsement is essentially a false claim about the product.\textsuperscript{98} Even where no deception of the public is involved, protection of recognition values prevents unjust enrichment.\textsuperscript{99} The unauthorized user who "reaps where [he] has not sown"\textsuperscript{100} profits without sharing in the cost of generating the identity values he seeks to exploit and is thereby enabled to compete unfairly with authorized licensees of the celebrity.\textsuperscript{101} Therefore, the right of publicity protects against unauthorized use of the celebrity's name and "likeness" for commercial purposes. The latter category includes drawings, photographs, statues and other representations.

There are no decisions explicitly applying the right of publicity to prevent the unauthorized use of a celebrity's name for commercial purposes. The \textit{Hirsch} case,\textsuperscript{102} however, supports the proposition that one's name is an aspect of one's identity entitled to protection under the publicity concept.\textsuperscript{108} Cases involving celebrities' likenesses, on the other hand, have been plentiful. \textit{Factors Etc., Inc. v. Creative Card Co.}\textsuperscript{104} and \textit{Ali v. Playgirl, Inc.}\textsuperscript{105} are two of the more significant decisions.

In \textit{Factors}, the plaintiff, who claimed an exclusive right to market merchandise bearing the name and likeness of Elvis Presley, sued to prevent the defendant from selling posters which featured photographs of the singer. In holding for the plaintiff, the court distin-

\begin{itemize}
  \item 98. Felcher \& Rubin, note 12 \textit{supra}, at 1600.
  \item 101. Hoffman, note 81 \textit{supra}, at 119.
  \item 102. \textit{Hirsch v. S. C. Johnson \& Son, Inc.}, 90 Wis. 2d 379, 280 N.W.2d 129 (1979), discussed at notes 65-67 \textit{supra} and accompanying text.
\end{itemize}
guished the right of publicity from the traditional invasion of privacy action, emphasizing that commercial exploitation was the interest protected under the publicity concept. A similar result was reached in *Factors Etc., Inc. v. Pro Arts, Inc.*, (Factors I), a companion case, which also involved Elvis Presley posters.

In *Ali*, professional boxer Muhammad Ali obtained injunctive relief and damages against *Playgirl Magazine* when it published a drawing of a nude black man seated in the corner of a boxing ring. The picture was accompanied by some doggerel verse. The federal district court determined that the public would recognize the figure depicted in *Playgirl* as Ali and that *Playgirl*'s action encroached upon his right of publicity.

The publicity theory has also been extended to impersonations of entertainers and imitations of their “acts” or performances. The impersonation cases involve elements of both performance rights and recognition rights. In many instances the defendant closely imitates the plaintiff’s actual performance, simulating gestures, costume, voice, and other aspects of his performing style. At the same time, impersonation goes beyond mere imitation. The defendant is not merely appropriating an idea, but he is also trying to evoke the plaintiff’s identity. In effect, he attempts to capitalize on the goodwill and public interest in the plaintiff. In that sense, impersonation resembles other appropriations of recognition values. Where the impersonation is deceptive, as in *Chaplin v. Amador*, the plaintiff can recover under the traditional theory of unfair competition. However, where the public is not deceived, as in the case of impersonations of entertainers who are deceased, recovery may still be allowed under the publicity theory even though it may have been denied under unfair competition. For example, in *Price v. Worldvision Enterprises, Inc.*, the widows of comedians Stan Laurel and Oliver Hardy sought to enjoin the production and distribution of a television series entitled *Stan 'n Ollie*, in which two actors portrayed the Laurel and Hardy characters. According to the court, the commercial nature of the interest claimed by the plaintiffs was distinguishable from the interest protected under the concept of privacy.

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106. 444 F. Supp. at 283.
and instead was more appropriately characterized as a property interest.\textsuperscript{111} Therefore, like other forms of property, the right of publicity could be assigned and would survive the death of the celebrity.\textsuperscript{113} The court granted the injunction to prevent "the impersonation of their physical likenesses or appearances, costumes and mannerisms, and/or the simulation of their voices."\textsuperscript{119}

In a similar case, \textit{Estate of Presley v. Russen},\textsuperscript{114} the defendant was enjoined from staging an impersonation of Elvis Presley.\textsuperscript{118} The stage production, called \textit{The Big El Show}, featured a performer who wore the same style of clothing and jewelry as Presley, sang songs made popular by Presley, wore a similar hair style and imitated Presley's singing voice, distinctive poses and body movements.\textsuperscript{116} Even more recently, another court declared the Broadway show, \textit{A Day in Hollywood/A Night in the Ukraine} to be an unauthorized appropriation of characters created by the Marx Brothers.\textsuperscript{117} In the second half of the show, three performers enacted a Marx Brothers-like farce dressed as Groucho, Harpo and Chico, simulating their style and mannerisms.

The right of publicity has also been extended to symbols or objects closely identified with the plaintiff. For example, in \textit{Motschenbacher v. R.J. Reynolds Tobacco Co.},\textsuperscript{118} the defendant's television commercial for Winston Cigarettes, featured a race car resembling Lothar Motschenbacher's distinctive vehicle. A federal court, anticipating California law, recognized the plaintiff's proprietary interest in this aspect of his identity.\textsuperscript{119}

Finally, recovery for the right of publicity has been successful when the defendant has benefitted from commercial use of biographical information about celebrities.\textsuperscript{120} For example, in \textit{Palmer v.}
Schonhorn Enterprises, Inc.,\textsuperscript{131} several professional golfers sued the manufacturer of a "Pro-Am Golf Game." Inside the game box on each of twenty-three sheets of paper titled "Profile and Playing Chart," appeared the name of a golfer along with a short biography. Although the defendant did not use the plaintiffs' names or likenesses on the outside of game cartons or in advertisements, the golfers successfully enjoined the sale of the games.\textsuperscript{128}

\textit{Uhlaender v. Henricksen}\textsuperscript{192} is a similar case. Ted Uhlaender sued on behalf of himself and other major league baseball players to prevent the defendant from using their names, statistics and team affiliations in connection with its table baseball game. It was agreed by everyone that the interest involved was solely economic. The plaintiff declared that the Baseball Players' Association had issued twenty-seven licensing contracts, including four or five to game manufacturers, allowing them to use player information. These contracts generated more than $400,000 a year for the players.\textsuperscript{124} Acknowledging that the information the defendant used was readily available in newspapers the court nevertheless concluded that use of this data in a commercial enterprise constituted a misappropriation of the players' identity interest.\textsuperscript{125}

\section*{II. The Survivability Issue}

Although the concept of publicity rights, as an alternative theory to privacy and unfair competition, has received increasing judicial acceptance during the past decade, the controversy over whether such rights can survive after death continues to rage unabated. The stakes involved could be enormous. If the right of publicity survives death, the heirs or assignees of such deceased celebrities as Elvis Presley or John Lennon will receive millions of dollars. If the right of publicity does not survive death, the commercial value of their names and likenesses will be potentially exploitable by anyone. At

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the present time post mortem exercise of publicity rights has been approved by federal courts in New York\textsuperscript{126} and New Jersey\textsuperscript{127} and by the Georgia Supreme Court\textsuperscript{128} but rejected by the Court of Appeals for the Sixth Circuit\textsuperscript{129} and the California courts.\textsuperscript{130} So far all of these cases have involved recognition values, which is no doubt a result of the fact that live performances can only survive the death of an entertainer if they are filmed or recorded and as such fall within the purview of federal copyright law.\textsuperscript{131}

A. Property, Privacy and Defamation Analogies

The courts have often relied on analogies to support their conclusions on the survivability issue. Thus, courts which have upheld the post mortem exercise of publicity rights have frequently emphasized the similarity between such rights and other forms of inheritable property. Courts which have determined that the right of publicity should terminate at death have likened it to either privacy or defamation.

The property analogy supports the notion of a survivable right of publicity in the following manner: under the prevailing view publicity rights are considered to be assignable forms of property.\textsuperscript{132} Thus, exploitable rights in a performance or persona can exist independently of their creators, just as a copyright interest in a written work can be severed from a proprietary interest in the underlying manuscript. Consequently, one can argue that publicity rights, at least when assigned, are not dependent for their existence on whether the performer or celebrity who created them is dead or


\textsuperscript{128} Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Prod’s, 296 S.E.2d 697 (Ga. 1982).


\textsuperscript{131} For a discussion of the applicability of federal copyright law to performance, see notes 251-54 infra and accompanying text.

alive.

The property analogy was utilized in Factors I,133 a case which involved the publicity rights of singer Elvis Presley. Before his death, Presley assigned his publicity rights to Boxcar, a corporation controlled by him and his manager.134 Shortly after Presley's death,
Boxcar transferred to Factors the exclusive right to produce and sell Presley posters and other products. Factors sued to vindicate this right when a competitor began marketing its own Elvis Presley posters. The defendant, Pro Arts, had purchased the copyright to a photograph of Presley taken by a staff photographer of the Atlanta Journal. The offending poster, which appeared three days after Presley's death, was entitled "IN MEMORY" and bore the photograph of Presley along with the dates "1935-1977." A federal district court in New York where the suit was brought, concluded that Factors' rights were protected by a transferable and descendible right of publicity in that state and accordingly granted a preliminary injunction.¹³⁵

On appeal, the circuit court upheld the lower court judgment,¹³⁸ relying heavily on Price v. Hal Roach Studios, Inc.¹³⁷ In Hal Roach, a federal court upheld the claims of the widows of comedians Stan Laurel and Oliver Hardy who had granted to the plaintiff corporation the right to use the names and likenesses of their late husbands. The defendant, Hal Roach Studios, which held the copyrights to the Laurel and Hardy movies, was enjoined from infringing upon their rights to license others to sell Laurel and Hardy memorabilia.¹³⁸ The court in Hal Roach held that the deaths of the actors did not extinguish the right of publicity assigned to the grantee.¹³⁹

The circuit court in Factors I also rejected the notion that the right of publicity was merely a variant of the right of privacy, and therefore, should not survive death. According to the court, privacy and publicity were concerned with protecting two entirely different interests: the right of privacy protected a dignitary interest while the right of publicity was concerned with a pecuniary interest.¹⁴⁰ Since the rationale behind the common law right of privacy and the statute

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¹³⁸ Id. at 847.
¹³⁹ Id. at 844.
which codified the right of privacy in New York\textsuperscript{141} was to prevent injury to feelings, death was a logical cut-off point to any such claim. This was not the case, according to the court, when purely commercial interests were involved. As the court noted, Elvis Presley had assigned to Boxcar a valid property right—the exclusive authority to print, publish and distribute his name and likeness. In return, he was given the right to receive a certain percentage of the royalties which would be realized by Boxcar from its licensees as Presley's recognition values were exploited.\textsuperscript{142} The court reasoned that since Presley's publicity rights could be severed and transferred to Boxcar, the existence of these rights should not depend on whether he was alive.\textsuperscript{143} The death of Presley, who was merely the beneficiary of an income interest in Boxcar's exclusive right, should not in itself extinguish Boxcar's property right. Instead, the court declared, the income interest, continually produced from Boxcar's exclusive right of commercial exploitation, should inure to Presley's estate like any other tangible property interest.\textsuperscript{144}

The court's reasoning in \textit{Factors I} is not entirely convincing. It presupposes that a property interest which is transferrable is therefore automatically survivable. This, of course, is not correct as a general proposition. The holder of a life estate, for example, cannot convey more than an estate \textit{pur autre vie}; when the grantor dies, the grantee's interest is extinguished.\textsuperscript{145} Thus, the fact that publicity rights are assignable during life does not inevitably lead to the conclusion that they are, or should be, survivable. The \textit{Factors} court, having correctly determined that publicity rights were commercial rather than personal in nature, should have upheld the plaintiff's claim on the basis that survivability was essential to the marketability of publicity rights. That is, in order for a celebrity to gain any economic benefit from his right to control, license or assign his publicity rights, they must be capable of surviving the death of the celebrity.

In contrast to \textit{Factors I}, some courts have refused to recognize the right of publicity as an independent concept, but instead have

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\textsuperscript{141} N.Y. Civ. Rights Law §§ 50-52 (Consol. 1982).
\textsuperscript{142} 579 F.2d at 217 n.3.
\textsuperscript{143} \textit{Id.} at 221.
\textsuperscript{144} \textit{Id.} at 221-22.
characterized it as an aspect of the right of privacy. According to this position, the plaintiff's true injury, whether he is a private person or a celebrity, is the loss of his right to control the use of his identity. Legal recognition of this dignitary interest gives rise to a right to demand a price for abandoning one's privacy. When the plaintiff's identity values are wrongfully appropriated, the use to which the name or likeness is put is less significant than the loss of freedom to choose whether his persona will be used in a certain way. It follows, however, that if the interest protected is a personal one, like other forms of privacy, no cause of action should be allowed after the plaintiff's death. This view was adopted by the California Supreme Court in Lugosi v. Universal Pictures, when it refused to recognize a descendible right of publicity. Lugosi involved a suit by the son and widow of actor Bela Lugosi to recover damages against Universal Pictures which had licensed the use of the Count Dracula character for purposes of commercial exploitation. Lugosi, of course, played the celebrated Transylvanian bloodsucker in the 1930 film Dracula. Both parties agreed that the Dracula character, created by Bram Stoker, was in the public domain. However, the plaintiffs contended that the likeness of Lugosi in his role as Dracula was well-recognized by the public and should be included within the concept of publicity. The trial court, relying on the property analogy, held that Lugosi's right to exploit his persona descended to his heirs. This decision was reversed by the intermediate appellate court and the appellate court's decision was affirmed by the California Supreme Court. The supreme court, while conceding that Lugosi might have been able to develop a protectible interest in the Dracula portrayal during his lifetime, refused to classify the interest as a descendible one. In the court's opinion recognition values such as those at stake in Lugosi could only be protected under the concept of privacy and, therefore, could not survive Bela Lugosi's death.

153. Id. at 819, 160 Cal. Rptr. at 326, 603 P.2d at 428.
The Court of Appeals for the Sixth Circuit also refused to recognize a post mortem right of publicity in *Memphis Development Foundation v. Factors Etc., Inc.*, another decision which involved the publicity rights of Elvis Presley. In this case, however, defamation rather than privacy, provided the analogy. The Memphis Development Foundation, a nonprofit corporation, desired to erect a bronze statue of Presley in downtown Memphis. To finance the estimated $200,000 cost of the project, the Foundation proposed to give eight-inch pewter replicas of the bronze statue to each person who contributed twenty-five dollars or more toward the project. When Factors objected to this scheme, the Foundation brought suit to enjoin Factors from interfering with the Foundation's fundraising efforts. Factors counterclaimed for an injunction to prohibit distribution of the pewter statuettes.

As in the previous *Factors I* litigation, the issue centered around whether the right of publicity and Factors' rights as assignee survived the death of Elvis Presley. The district court, applying Tennessee law, rejected the Foundation's contention that the right of publicity was nothing more than a branch of privacy, holding that a descendible right of publicity existed in that state, and enjoined the Foundation from marketing the pewter statuettes. On appeal, the Sixth Circuit declared that it would review the question "in the light of practical and policy considerations, the treatment of other similar rights in our legal system, the relative weight of the conflicting interests of the parties, and certain moral presuppositions concerning death, privacy, inheritability and economic opportunity." The court observed that the law of defamation, which was designed to protect against the destruction of reputation, including the loss of earning capacity associated with it, provided an appropriate analogy to the right of publicity. The court also reasoned that a descendible right of publicity was not necessary to motivate persons to seek excellence in their chosen fields. At the same time, the court expressed concern that such a right would encourage monopolistic practices and reduce economic opportunity for others. Consequently, it reversed the trial court and held that the Foundation was free to market its Presley statuettes.

154. 616 F.2d 956 (6th Cir. 1980).
156. *Id.* at 1330-31.
157. 616 F.2d at 958.
158. *Id.* at 959.
Use of analogies to the law of privacy, property or defamation, however, may lead courts to overlook the policy issues that are involved in the descendibility question. Accordingly, the answer to the descendibility problem lies, not in reliance on analogies, but rather on a consideration of the social policies which either support or militate against survival of publicity rights after death.\textsuperscript{159}

\section*{B. Policy Considerations}

As mentioned earlier, \textit{inter vivos} recognition of publicity rights rests on two bases—the need to allow the celebrity to profit from his achievements so that he will be induced to continue his creative endeavors and the need to prevent unfair competition which occurs when one reaps the benefits of another’s labor. As the Memphis Development court pointed out, however, allowing the celebrity unlimited control over the commercial use of his persona is monopolistic.\textsuperscript{160} In the Factors’ case, for example, Boxcar granted exclusive licenses to other companies to produce and sell Elvis Presley memorabilia. The royalty rate paid to Boxcar by Factors and others no doubt reflected the fact that Boxcar would not license any potential competitors. This lack of competition would presumably allow Boxcar’s licensees to charge higher prices for their products than would be possible in a competitive market. Thus, the profits of Boxcar and its licensees would be maximized at the expense of consumers.

Striking a balance in favor of the celebrity may be appropriate during the celebrity’s lifetime, but once the celebrity has died, the case for allowing his heirs to maximize their profits is less compelling. Insofar as the inducement rationale is concerned, the case for post mortem protection of publicity values is obviously weaker than the case for recognition of such values during the celebrity’s lifetime. As the court in Memphis Development pointed out, noneconomic factors often play a major part in motivating persons to seek excel-

\textsuperscript{159} See Felcher & Rubin, note 10 supra, where the authors state: 

\textit{[A] major difficulty with analogies . . . is that they tend to impose a mature elaborated system on what may be an unformulated situation. The choice of analogy may not be fully justifiable, and the analogy’s application to the situation may carry with it a misleading certainty. In the present case, none of the analogies of privacy, defamation, or property law seems correct to apply to the publicity issue; once one is chosen, however, it resolves the descendibility issue with a force much too decisive for the complex and subtle nature of the problem.}

\textit{Id. at 1127-28.}

\textsuperscript{160} Memphis Dev. Found., 616 F.2d at 959.
lence in a chosen field: “[S]uch needs come from the deep psycho-
logical fact that individuals want the respect and good will of other
persons and ‘enjoy the exercise of their realized capacities . . . and
this enjoyment increases the more the capacity is realized, or the
greater its complexity.’”¹⁶¹ Compared with these psychological fac-
tors, the desire to exploit fame for the commercial advantage of
one’s heirs is generally a weak principle of motivation. Therefore,
according to the Memphis Development court, a descendible right of
publicity would not significantly inspire creative efforts.

It appears, however, that the Memphis Development court un-
derestimated the motivational force of the desire to provide financial
security for family members and other dependents.¹⁶² More impor-
tantly, the court overlooked the impact of a nondescendibility rule on
the value of publicity rights during the celebrity’s lifetime. If the
rights become worthless after the celebrity’s death, the price paid to
the celebrity for such rights will be less.¹⁶³ To this extent, the celeb-
rity is partially deprived of the fruits of his labor and the incentive
to produce things of value for society may be correspondingly
diminished.

The second basis for recognition of publicity rights is the pre-
vention of unfair competition and unjust enrichment. Although
traditional unfair competition, in the sense of passing off, is less
likely in the case of a deceased celebrity, unfair competition might
result with respect to an assignee who has purchased a celebrity’s
publicity rights if a competitor is able to exploit these same values at
no cost.¹⁶⁴ As the Factors I court declared:

To hold that the right did not survive Presley’s death would be to
grant competitors of Factors, such as Pro Arts, a windfall in the
form of profits from the use of Presley’s name and likeness. At
the same time, the exclusive right purchased by Factors and the
financial benefits accruing to the celebrity’s heirs would be ren-
dered virtually worthless.¹⁶⁵

Thus, it appears the considerations that support inter vivos pro-
tection of publicity rights still apply, though with less force, after

¹⁶¹. Id. at 958-59 (quoting J. RAWLS, A THEORY OF JUSTICE 426-27 (1971)).
Chafee relates how Erskine, after his maiden argument at the bar, when asked how he had the
courage to stand up so boldly before the formidable Lord Mansfield, replied, “I could feel my
little children tugging at my gown.”
¹⁶³. Comment, note 82 supra, at 1127.
¹⁶⁴. Note, note 132 supra, at 547; Note, Inheritability of the Right of Publicity Upon
the Death of the Famous, 33 VAND. L. REV. 1251, 1261 (1980).
¹⁶⁵. 579 F.2d at 221.
death. However, the countervailing public interests in providing for free competition in the marketplace must also be taken into consideration. This burden is arguably outweighed during the celebrity's lifetime by the interest in controlling his career. After death, however, the interests of the celebrity are less significant, while the public's interest in free competition remains undiminished. Under these circumstances, some courts would strike the balance in favor of free competition.166

Nevertheless, while acknowledging the merit of the *Memphis Development* court's argument, it is difficult to reconcile its decision with the *post mortem* recognition given to performance rights under federal copyright law.167 Under the statute, the balance is struck in favor of the performer and his monopoly, at least for a time, is allowed to continue after death. Consequently, it can be argued that publicity rights should be allowed to survive the celebrity's death in some circumstances, but durational or other restrictions should be imposed on the exercise of such rights in order to lessen the anti-competitive effects of *post mortem* recognition.

C. Limitations on Survivability

Perhaps in recognition of the divergent interests of the celebrity (and his heirs or assignees) and the public, some courts have limited *post mortem* exercise of publicity rights. The prevailing approach is to allow publicity rights to survive only when the celebrity took steps to exploit them while alive. Their objective is to protect the legitimate expectations of close relatives of the decedent, as well as his assignees, while preventing remote heirs from interfering with the free flow of goods to the public.

The *Lugosi* court expressed the fear that remote heirs would

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166. See, e.g., *Memphis Dev. Found.*, 616 F.2d at 960, where the court stated: It seems fairer and more efficient for the commercial, aesthetic, and political use of the name, memory and image of the famous to be open to all rather than to be monopolized by a few. An equal distribution of the opportunity to use the name of the dead seems preferable. The memory, name and pictures of famous individuals should be regarded as a common asset to be shared, an economic opportunity available in the free market system.

167. Under the 1909 Copyright Act, the copyright term began at the time of publication and lasted 28 years. The author of his heirs or assigns, however, could renew the copyright for another 28 years, making a total potential term of 56 years in all cases. 17 U.S.C. § 24 (1976) (repealed 1976). Thus, the copyright term bore no relation to the life of the author. Under the 1976 Copyright Act, the usual copyright term for works created after 1978, consists of the life of the author plus an additional 50 years. 17 U.S.C. § 302(a) (Supp. V 1981).
attempt to exploit the publicity rights of long-dead celebrities. For example, the court queried, could the descendants of George Washington sue the Secretary of the Treasury for placing his likeness on the dollar bill? Could the descendants of Abraham Lincoln recover damages against the Lincoln National Life Insurance Company for their commercial exploitation of his name and likeness? As a practical matter, however, such lawsuits would seldom succeed because the plaintiff would have to prove that he is the heir of the decedent and not merely a descendant. As Schumann v. Loew's Inc. illustrates, the more remote the relationship, the more difficult the plaintiff’s proof problems will be. In the Schumann case, some of the great-grandchildren of Robert Schumann brought suit against the producers of Song of Love, a movie based on the composer’s life. The plaintiffs objected to the film’s portrayal of Schumann’s mental illness and its suggestion that his insanity was hereditary. The plaintiff’s alleged libel, invasion of privacy and misappropriation. The court rejected the privacy and defamation theories because these actions could not be brought on behalf of a dead person. In dismissing the misappropriation action, the court declared that even if the defendant had misappropriated a property right of Robert Schumann’s, the plaintiffs had failed to establish that they were the appropriate parties to assert this right. The court noted that Schumann had died in Germany in 1856 and the plaintiffs had not produced evidence of whether Schumann had left a will or, if he had died intestate, that the plaintiffs represented all of his descendants who would have been able to claim as his heirs under the German intestacy laws of that time.

1. Inter Vivos Exploitation

One of the most effective ways to prevent heirs of deceased celebrities from playing “dog in the manger” is to allow the right of publicity to survive only if it was exercised during the celebrity’s lifetime. A federal court adopted this view in Hicks v. Casablanca

171. 135 N.Y.S.2d at 365, 368.
172. Id. at 369.
173. See generally Felcher & Rubin, note 10 supra.
Records," a case where the heirs of Agatha Christie tried to enjoin distribution of a book and movie based on a celebrated incident in the mystery writer's life. The court declared that the plaintiff must show that "the decedent acted in such a way as to evidence his or her own recognition of the extrinsic commercial value of his or her name or likeness, and manifested that recognition in some overt manner. . . ." The court then concluded that the decedent had exploited her publicity rights while alive by using the name "Agatha Christie" in connection with the sale of books, plays and movie rights. This approach has been endorsed by other courts as well. For example, in Guglielmi v. Spelling-Goldberg Productions, the court denied recovery in a suit brought by the nephew of Rudolf Valentino against the producers of a motion picture about Valentino's life. In the court's opinion, Valentino had not exploited the publicity values associated with his persona so as to create property of a recognized and inheritable character.

One can justify this inter vivos exploitation requirement on the basis that it ensures that the decedent's intent will be carried out.

175. Id. at 429.
176. Id. at 429-30. The court, however, denied relief on the basis that a fictionalized biography that was not misleading was protected speech under the first amendment. Id. at 433.
179. 140 Cal. Rptr. at 779. See also James v. Screen Gems, Inc., 174 Cal. App. 2d 650, 344 P.2d 799 (1959), and Maritote v. Desilu Prod's, Inc., 345 F.2d 418 (7th Cir.), cert. denied, 382 U.S. 883 (1965), which, although decided under the right of privacy theory, are consistent with this principle. In James, the widow of Jesse James, Jr., son of the famous outlaw, sued the producers of the television play Bitter Heritage, which portrayed her husband as an outcast in the community and one who had been implicated in a bank robbery. The court treated the plaintiff's claim as false light privacy rather than interference with the right of publicity and denied recovery. 174 Cal. App. 2d at 653-54, 344 P.2d at 801.

The very decision to exploit name and likeness is a personal one. It is not at all unlikely that Lugosi and others in his position did not during their respective lifetimes exercise their undoubted right to capitalize upon their personalities, and transfer the value thereof into some commercial venture, for reasons of taste or judgment or because the enterprise to be organized might be too demanding or simply because they did not want to be bothered.
When a celebrity enters into licensing agreements or similar arrange-
ments, it indicates that he intends to capitalize upon the recogni-
tion values with which his identity is imbued. These actions also
suggest that the exploitation of publicity values is a motivating fac-
tor in leading the celebrity to achieve excellence in his chosen field of
endeavor. Moreover, once the celebrity manifests an intent to exploit
his publicity rights for his own benefit, it is reasonable to assume
that he desires to benefit his heirs or legatees as well.181 On the other
hand, two courts appear to have recognized a descendible right of
publicity regardless of whether the celebrity exploited his recognition
values during his lifetime. Price v. Hal Roach Studios, Inc.,182 in-
volved the publicity rights of comedians Stan Laurel and Oliver
Hardy. The defendant argued that Laurel and Hardy's failure to use
their caricatures and imitations during their lifetime constituted an
abandonment of their right of publicity. The court rejected this con-
tention, declaring that “[T]here cannot, therefore, be any necessity
to exercise the right of publicity during one's life in order to protect
it from use by others or to preserve any potential right of one's
heirs.”183 In Martin Luther King Jr. Center for Social Change, Inc.
v. American Heritage Products,184 the Georgia Supreme Court also
rejected the inter vivos exploitation requirement. The defendant in
that case was engaged in selling plastic busts of the late Dr. Martin
Luther King, Jr. Its advertisements contained photographs of Dr.
King and excerpts from his copyrighted speeches. In addition, the
defendant's promotional material also stated that a portion of the
purchase price would be donated to the Martin Luther King, Jr.
Center for Social Change, a nonprofit corporation established to pro-
mote the ideals of Dr. King. Suit was brought in federal court to
enjoin promotion and sale of the busts.185 The district court refused
to enjoin sale of the busts,186 concluding that it would not be neces-

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181. None of the reported cases to date have involved a specific testamentary bequest of
publicity rights. For example, in Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y.
1981), claims were brought by sole beneficiaries or residuary beneficiaries under a will.
183. Id. at 846 (footnote omitted).
185. The plaintiffs included the Center, Coretta Scott King, as administratrix of Dr.
King's estate, and Motown Record Corporation, the assignee of the rights of several of Dr.
King's copyrighted speeches.
186. Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage
from using the Center's name in its advertising. The court found that the defendant had in-
fringed upon the King copyrights and enjoined all further use of copyrighted material. Id. at
sary to determine whether the right of publicity was devisable in Georgia because Dr. King did not commercially exploit this right during his lifetime.\textsuperscript{187} When the plaintiffs appealed, the Court of Appeals for the Eleventh Circuit certified the question to the Georgia Supreme Court. The Georgia Supreme Court held that the right of publicity was recognized in Georgia and that it was inheritable and devisable.\textsuperscript{188} In addition, the court concluded that commercial exploitation\textsuperscript{189} during the celebrity’s life was not necessary for the right of publicity to survive. The court observed that \textit{inter vivos} exploitation requirement, which originated in the \textit{Hicks} decision, was no more than dictum since the case was ultimately decided on other grounds.\textsuperscript{190} The court concluded that it was unfair to protect those entertainers and athletes who exploited their personae during life while denying similar protection to those who achieved fame but did not exploit themselves during life.\textsuperscript{191}

In reaching this conclusion, however, the Georgia court seems to have confused the right of publicity with the right of privacy. It noted that Dr. King had refused to exploit his image commercially because it would have impaired his influence in the civil rights movement. According to the court, Dr. King’s failure to exercise his publicity rights should not “strip his family and estate of the right to control, preserve and extend his status and memory and to prevent unauthorized exploitation thereof by others. Here, they seek to prevent the exploitation of his likeness in a manner they consider unflattering and unfitting.”\textsuperscript{192} It is submitted that the right of publicity is intended to protect economic, not dignitary interests. Therefore, the preservation of a public figure’s “memory” should not be used as a basis for allowing publicity rights to survive death.\textsuperscript{193} Nevertheless,
there are problems with the inter vivos exploitation requirement. In the first place the rule may be unfair to those who were unable to exploit their personae while they were alive. While it can be argued that inter vivos exercise of publicity rights evidences an awareness of their value by the celebrity, failure to exploit them does not necessarily imply the contrary. A celebrity may in fact desire to capitalize upon his publicity values, on his own behalf or for the benefit of his heirs, and yet be forced to wait until he achieves sufficient public recognition to make his identity marketable. This point may not be reached during his lifetime, but rather may be brought about by death.\(^9\) In this situation the inter vivos exploitation requirement is unfair. In addition, it seems anomalous to deny that exploitation is necessary when a living celebrity seeks to vindicate his right of publicity,\(^18\) and yet require it as a condition precedent to survival when a celebrity's heirs are asserting a right of publicity.

Finally, it is difficult to see how inter vivos exploitation can be shown in the absence of a formal assignment or licensing scheme. The issue arose in Groucho Marx Productions v. Day and Night Company, Inc.\(^19\) The defendants, who produced a broadway play which featured actors impersonating the Marx Brothers, contended that exploitation required commercial use which was distinct from the celebrity's main commercial activity. In other words, according to defendants, exploitation of the right of publicity required commercial "tie-up" activities.\(^17\) The court, however, rejected this argument, declaring instead that the celebrity need only act in some way that demonstrated an intent to capitalize on the commercial value of his name and likeness.\(^18\) As the court declared:


\(^{195}\) See Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973). Esquire was found liable for publishing an article on clothing styles in which Cary Grant's head was superimposed upon the torso of the model who had originally posed for the Esquire pictures. The court found that Grant's right of publicity had been infringed upon even though he had disclaimed any desire to exploit it himself. As the court observed: "If the owner of Blackacre decides for reasons of his own not to use his land but to keep it in reserve he is not precluded from prosecuting trespassers." \(^{196}\) Id. at 880.


\(^{197}\) A commercial tie-up means an association of the celebrity's name or likeness with a collateral product. See Nimmer, note 13 supra, at 212. Examples of commercial tie-ups would include endorsements of products and authorizing the sale of memorabilia embodying the licensor's name or likeness.

\(^{198}\) See also Martin Luther King Jr. Center, 508 F. Supp. 854 (N.D. Ga. 1981). In a suit against a defendant who sold plastic busts of Dr. Martin Luther King, the court held that
Every appearance, contract and advertisement involving the Marx Brothers signified recognition by the performers of the commercial value of unique characters they portrayed. To suggest, as defendants do, that the right of publicity was not exploited because the Marx Brothers did not endorse dance studios, candy bars or tee shirts is wholly illogical. 199

Not only does this language indicate that the inter vivos exploitation requirement can be satisfied by something less than a formal assignment of publicity rights, it implies that entertainers will be deemed to have exploited their publicity values simply by pursuing their performing careers. This interpretation would, however, eviscerate the inter vivos exploitation requirement as a meaningful test for survivability, at least where entertainers are concerned.

It may be possible to interpret the Groucho Marx holding somewhat more narrowly. The offending conduct in that case involved an impersonation of the Marx Brothers’ characters and performing style. One can argue that this type of publicity interest is not normally assigned, and therefore, the court was correct in concluding that the Marx Brothers had exploited this aspect of their publicity rights sufficiently to ensure its survival after death. The court, however, did not suggest that the Marx Brothers’ activities were sufficient to enable their heirs or assignees, for example, to prevent a third party from marketing Marx Brothers posters. Therefore, one might argue that inter vivos activities by the celebrity should be sufficient to secure post mortem survival of those same types of publicity rights, but that rights associated with commercial “tie-up” activities should survive death only if the celebrity demonstrated an intent to exercise those rights by entering into contracts to exploit his recognition values in an appropriate manner. 200

Perhaps a better approach, however, would be to allow only assignees who purchased publicity rights from a celebrity during his lifetime to maintain a cause of action after the celebrity’s death. This approach, of course, completely avoids the possibility of remote

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200. In California, the right of publicity, if it descends at all, would probably be so limited. The court in Lugosi acknowledged that the decedent had assigned limited publicity rights to Universal Pictures in connection with the promotion of his movie, Dracula. This, apparently, was not enough to create a descendible right of publicity that would include use of his likeness on such articles as greeting cards, T-shirts, Halloween costumes and masks, wax figurines, mechanical walking toys, picture puzzles, and the like.
heirs asserting a long dormant publicity interest. More importantly, it protects the value of the assignment contract, thereby protecting the assignee's investment and ensuring that the celebrity will receive full value for his publicity rights during his lifetime. Additionally, this approach relieves the parties and the court of the difficult task of determining the extent to which the celebrity may have exploited his publicity rights in the past. The assignment contract itself will specify the nature of the rights conveyed. The publicity right will be limited to the length of the contract, which will typically be for a relatively short term. Moreover, the court can interpret the contract terms narrowly and may invalidate perpetual or unreasonably long contracts on grounds of public policy.

The greatest weakness with this approach is that, although it gives the assignee full protection, the heirs are protected only to the extent that the assignment contract provides for the payment of royalties. The astute celebrity, of course, would seldom make a complete assignment of his publicity rights to another, but will insist on a licensing or royalty arrangement so that he can retain some control over the exploitation of his persona and maximize his profits therefrom. On the other hand, entertainers and athletes at the beginning of their careers might assign their entire publicity interest without intending to do so when such assignments are included as boilerplate provisions in performance contracts. If this sort of contract would be treated as unconscionable when enforced against the celebrity during his lifetime, it would be equally inappropriate to recognize its validity after death.

2. Durational Limits on the Right of Publicity

Quite apart from its inherent weaknesses, it can be argued that the *inter vivos* exploitation rule does not alone provide a rational basis for balancing the rights of the celebrity and those of the public. The rule simply operates to cut off some rights entirely while appar-


202. For example, in the *Factors II* litigation, the Boxcar-Factors contract granted an exclusive license to Factors for 18 months, renewable at the licensee's option for up to four years, to use Presley's name and likeness in connection with the manufacture and sale of any kind of merchandise. Factors agreed to pay a royalty of five percent of sales, subject to a minimum royalty for the first 18 months of $150,000. *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d at 279.

203. Comment, note 82 *supra*, at 1120.
ently allowing others to run indefinitely. Of course, limiting survival of publicity rights to assignees, as suggested earlier, may resolve this problem, but a better approach would be to deal with the balancing issue in another way. The law of copyright provides a useful model.

Like the right of publicity, copyright gives the creator of intellectual property exclusive control over its distribution. The social policy that justifies this sort of monopoly is the same inducement rationale that partially underlies the right of publicity. In the case of copyright law, the balance between public and private interests is struck by allowing monopoly, but limiting its duration. Similarly if a post mortem right of publicity is recognized, a durational limit could be placed on its exercise by heirs or assignees of the decedent. Having reached this point, however, one must contend with the problem that concerned the court in Memphis Development—deciding what durational limit to apply. One solution would allow the courts to set durational limits on publicity rights on an ad hoc basis. Another alternative would be to permit the exercise of publicity rights for the life of the surviving spouse or the surviving spouse and children of the celebrity.

Adopting an express durational limit, however, provides a better means of ensuring that the legitimate expectations of the celebrity, his heirs and those with whom he has contracted are safeguarded, while the public’s interest in free competition is also given appropriate weight. The similarity between publicity rights and the interest protected by a copyright have led some commentators to suggest that the copyright period of life plus fifty years be applied to the right of publicity. Keeping in mind that society does not directly benefit from the protection of publicity values as it does from the

204. The Copyright Act of 1976 gives the copyright holder the exclusive right to reproduce, distribute, perform, or display the copyrighted work or prepare derivative works based on it. 17 U.S.C. § 106 (Supp. V 1981). This right, which may be assigned, now lasts for the life of the author plus an additional 50 years. Id. § 302.


206. In the words of Lord Mansfield:

[W]e must take care to guard against two extremes equally prejudicial; the one that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.


208. Comment, note 4 supra, at 1007.

creative activity protected by copyright,\textsuperscript{210} a shorter limitation period such as twenty years seems more reasonable.\textsuperscript{211} This reflects the fact that recognition values have less social utility than the creative values protected by copyright law, while the opposing public interest in free competition remains the same in each case. Even if a descendible right of publicity motivates creative activity, the reduced incentive to the celebrity is more than offset by the public gain.\textsuperscript{212}

Since courts are usually reluctant to adopt fixed periods with respect to the duration of property rights, a legislative response may be necessary. If this is done at the state level, however, the durational period specified will vary from state to state. The resulting confusion and uncertainty may effectively destroy the efficacy of \textit{post mortem} publicity rights. Consequently, federal legislation would probably be necessary to carry out any workable scheme of fixed-period publicity rights.\textsuperscript{213}

### III. Federal Preemption of Publicity Rights

The preemption doctrine, derived from the Constitution's supremacy clause,\textsuperscript{214} nullifies a state statute or common-law doctrine that interferes with the attainment of federal legislative objectives.\textsuperscript{215} Recently, the growing recognition of publicity rights has given rise to speculation about the preemptive effect of federal copyright legislation on this aspect of state common law. Some commentators have maintained that some publicity rights are inconsistent with federal copyright policies.\textsuperscript{216} While others have contended that publicity rights do not conflict with federal law and, therefore, should not be

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\textsuperscript{210} Hoffman, note 81 \textit{supra}, at 118.

\textsuperscript{211} Where a "joint" right of publicity is involved, as in the case of Laurel and Hardy, Abbott and Costello, the Marx Brothers, or the Three Stooges, the \textit{post mortem} limitation should not begin to run until the death of the last surviving member of the group. This is the approach taken with jointly-held copyrights. \textit{See} 17 U.S.C. \textsection 302(b) (Supp. V 1981).

\textsuperscript{212} As Lord Macaulay once said, a monopoly of 60 years produces three times as much evil as a monopoly of 20 years, but it by no means gives an author three times as much pleasure or three times as much motivation to create. \textit{8 The Works of Lord Macaulay} 199-200 (1866).

\textsuperscript{213} Federal legislation of this nature is proposed in the text following note 284 \textit{infra}.

\textsuperscript{214} U.S. CONSTR. art. VI, cl.2.


\textsuperscript{216} Shipley, note 11 \textit{supra}. 
preempted. In fact, this dispute reflects a broader controversy over whether any form of state protection of intellectual property is compatible with federal patent and copyright legislation.

A. An Overview of the Preemption Controversy

Over the years two opposing views have emerged. Proponents of the broad view of federal preemption argue that federal patent and copyright legislation has occupied the field and left no room for protection of equivalent interests under state law. According to this position, that which is not protected by federal law is placed in the public domain. Under the narrower view of federal preemption, however, the states remain free to protect intellectual property which is not covered by federal law as long as state rights do not conflict with the federal statutory scheme.

The broad theory of federal preemption was reflected in Sears, Roebuck & Co. v. Stiffel Co. and Compco Corp. v. Day-Brite Lighting, Inc. In the Sears-Compco cases, the defendants copied unpatentable industrial designs and were held liable under state unfair competition doctrines. The United States Supreme Court, however, reversed these decisions, holding that such liability conflicted with the federal policy of allowing free access to copy whatever the federal patent and copyright laws left in the public domain. The Sears-Compco decisions apparently led the First Cir-

217. 1 M. Nimmer, Nimmer on Copyrights § 1.01[B] at 1-13-14 n.49.
223. Stiffel Co. v. Sears, Roebuck & Co., 313 F.2d 115, 118 (7th Cir. 1963); Day-Brite Lighting, Inc. v. Compco Corp., 311 F.2d 26, 30 (7th Cir. 1962).
224. Sears, 376 U.S. at 231-32; Compco, 376 U.S. at 237.
cuit in *Columbia Broadcasting Systems, Inc. v. DeCosta* to hold that any creation, whether or not protected under federal law, must comply with requirements of the Copyright Act to avoid falling into the public domain.\(^{228}\)

In *DeCosta*, the plaintiff claimed that CBS had appropriated his "Paladin" character in its television series *Have Gun Will Travel*. DeCosta appeared in parades, rodeos, auctions and horse shows attired in black shirt, pants and hat. The plaintiff also affixed a St. Mary's medal to his hat and carried an antique derringer strapped to his arm. He adopted the name Paladin and passed out cards which featured the symbol of a chess knight and the words "Have Gun, Will Travel, Wire Paladin, N. Court St., Cranston, R.I." DeCosta brought suit against CBS alleging misappropriation, trademark infringement and unfair competition under the passing off theory. The trial court held in DeCosta's favor on the misappropriation count. On appeal, however, this judgment was reversed. The appellate court asserted that the federal policy favoring free dissemination of intellectual creations prohibited the state from extending protection against copying a character that was "so slight a thing as not to warrant protection by any law."\(^{227}\) The court declared that the Paladin character was "ineffable," and therefore neither eligible for copyright protection nor for protection under other state or federal law.\(^{228}\)

A similarly broad reading of the *Sears-Compco* cases led another federal court to deny recovery for misappropriation of the plaintiff's singing style in *Sinatra v. Goodyear Tire and Rubber Co.*\(^{229}\) In the *Sinatra* case, Goodyear produced a television commercial which featured a female vocalist who sang "*These Boots Are Made for Walkin'*." Although Goodyear had obtained permission from the copyright holder to use the song in its commercial, the song

\(^{225}\) 377 F.2d 315 (1st Cir. 1947), cert. denied, 389 U.S. 1007 (1968).
\(^{226}\) Id. at 321.
\(^{227}\) Id. at 320.
\(^{228}\) Id. In *De Costa v. Columbia Broadcasting Sys.*, 520 F.2d 499 (1st Cir. 1975), the court considered the two remaining counts in De Costa's original complaint: common-law trademark infringement and unfair competition. The court acknowledged that Goldstein mandated a retreat from its earlier expansive reading of *Sears* and *Compco*, but, again, held in favor of the defendant, CBS, declaring that the public would not have confused his Paladin character with that of CBS. *Id.* at 514. For a discussion of the Paladin cases, see Laff & Saret, *Further Unraveling of Sears-Compco: Of Patches, Paladin and Laurel & Hardy*, 7 Loy. U. Chi. L.J. 33, 45 (1976).
was widely associated in the public's mind with singer Nancy Sin-
atra and the vocalist in the commercial imitated Sinatra's singing
style. Sinatra admitted that her singing style did not qualify for fed-
eral copyright protection, but argued that Goodyear's commercial
amounted to unfair competition under state law. The trial court held
in favor of the plaintiff. On appeal, however, the Ninth Circuit re-
versed, holding that the use of the doctrine of unfair competition in
this manner was contrary to an overriding federal policy favoring
free competition in ideas which do not merit patent or copyright pro-
tection.\textsuperscript{230} Put another way, that which was excluded from the fed-
eral copyright laws remains in the public domain. In addition, ac-
cording to the court, recognizing Sinatra's interest in her singing
style would undermine the market for the copyrighted song, thereby
impairing the value of the copyright holder's interest. The court con-
cluded that this result would also be contrary to the policy of federal
copyright legislation.\textsuperscript{231}

The \textit{Sears-Compco} holdings, however, were qualified by the Su-
preme Court in \textit{Goldstein v. California}\textsuperscript{232} and \textit{Kewanee Oil Co. v.
Bicron Corp.}\textsuperscript{233} In \textit{Goldstein} the Court upheld California's record
piracy law, holding that the 1909 Copyright Act did not foreclose
state regulation of a category of writings unregulated by Congress,
so long as that regulation did not interfere with federal copyright
policy.\textsuperscript{234} In \textit{Kewanee Oil}, the Court, applying the \textit{Goldstein} ration-
ale, held that federal patent law did not preempt a cause of action
under state law for disclosure of trade secrets.\textsuperscript{235} These cases signal a
retreat from the broad preemption theory of the \textit{Sears-Compco} deci-
sions and suggest that federal controls do not necessarily replace all
state recognition of intellectual property which is potentially eligible
for federal patent or copyright protection. Instead, according to
\textit{Goldstein} and \textit{Kewanee Oil}, state doctrines are preempted only when
they conflict with the objectives of federal law. It is against this
background, therefore, that the scope of federal preemption, particu-
larly under the new Copyright Act, on state-created rights of public-

\textsuperscript{230} 435 F.2d at 717.
\textsuperscript{231} Id. at 718.
\textsuperscript{232} 412 U.S. 546 (1973).
\textsuperscript{233} 416 U.S. 470 (1974).
\textsuperscript{234} 412 U.S. at 560. For a further discussion of the \textit{Goldstein} case, see Brown, \textit{Publication and Preemption in Copyright Law: Elegiac Reflections on Goldstein v. California}, 22
Preemption}, 74 Colum. L. Rev. 960 (1974); Note, \textit{Goldstein v. California: Validity of State
\textsuperscript{235} 416 U.S. at 474.
ity must be examined.

B. Preemption Under the Copyright Act of 1976

In 1976, the 1909 Copyright Act was replaced by a new statute, which creates a system of federal protection for all "original works of authorship," published or unpublished, from the moment they are fixed in a tangible medium of expression. This legislation virtually abolishes the concept of common law copyright. More-


237. 17 U.S.C. § 102(a) (Supp. V 1981). The new act extends copyright protection to a number of mediums of expression, such as phonograph recordings and radio or television broadcasts, which were not included under the original 1909 Copyright Act.

238. See Goldstein, Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright, 24 U.C.L.A. L. REV. 1107, 1110-11 (1977). Common law copyright protected authors and composers of unpublished material who had not obtained a statutory copyright or those whose intellectual or creative products were not entitiled to protection under federal copyright law. Thus, state courts enjoined unauthorized duplication or retransmission of uncopyrightable radio and television broadcasts under the theory that the defendant had infringed upon the common law copyright interest of the broadcaster. See generally Warner, Protection of the Content of Radio and Television Programs by Common-Law Copyright, 3 VAND. L. REV. 209 (1950).

The performer's rights in a live performance also were protected against unauthorized duplication, but the scope of common law copyright in recorded performances was less clear. Phonograph records could not be copyrighted under the 1909 Copyright Act, although the author or composer could obtain statutory protection for the underlying composition by securing a copyright on the script or musical score. See Kaplan, Publication in Copyright Law: The Question of Phonograph Records, 103 U. PA. L. REV. 469, 482-86 (1955). However, the only copyright protection available to the entertainer to protect his performance arose under state law. Frequently, recovery hinged on whether the court regarded the sale of phonograph records as a general publication of the performance. A general publication was an act of the owner whereby the subject matter was made available to the general public under circumstances permitting copies to be made or which indicated an intention of rendering the work common property or implied an abandonment and dedication of the work to the general public. Warner, 3 VAND. L. REV. at 225-26. A limited or qualified publication is one which communicates a knowledge of a work's contents without dedicating it to the public. Nimmer, Copyright Publication, 56 COLUM. L. REV. 185, 200-01 (1956). Mere performance of a play or musical composition was treated as a limited publication, and was, therefore, insufficient to divest the author or composer of his rights under common law copyright. See Ferris v. Frohman, 223 U.S. 424, 435 (1912). By analogy, it was argued that sale of phonograph records of uncopyrighted material did not constitute a general publication insofar as the author or composer was concerned. Comment, note 1 supra, at 823-24.

With regard to the right of performance, the leading case is Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 A. 631 (1937). Fred Waring and his Pennsylvanians had recorded a number of records for RCA. Pursuant to the licensing agreement between Waring and RCA, the records bore the legend "Not licensed for radio broadcast." When the defendant, WDAS, broadcast these records over the air, Waring sought injunctive relief. The court agreed with Waring that he had a common law copyright interest in his performance and that the sale of phonograph records of his performance did not divest him of that interest. Id. at 442, 194 A. at 635. Other courts, however, have reached the opposite conclusion, holding that the sale of phonograph records constituted general publication and destroyed the performer's rights to his performance. See RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 88-89 (2d Cir. 1940). However, the new Copyright Act extends protection to phonograph recordings and ra-
over, section 301(a) of the new act provides that any state law, whether based on common law or statute, is preempted if it creates "legal or equitable rights that are equivalent to any of the exclusive rights within the federal scope of copyright as specified by section 106" and if these rights under state law may be claimed in "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright." In addition, section 301(b) expressly preserves causes of action under state law with respect to "subject matter that does not come within the subject matter of copyright . . . including works of authorship not fixed in any tangible medium of expression." Furthermore, this section provides that state protection of "activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright." is not preempted. Thus, the states remain free to protect rights that are not equivalent to those protected by copyright and, in addition, they may protect noncopyrightable subject matter.

Noncopyrightable subject matter includes works that are not fixed in any tangible medium of expression. A work is "fixed" if it is "sufficiently permanent or stable to permit it to be perceived . . . for a period of more than transitory duration." Rights not equivalent to those granted under copyright law are those that are infringed by more than the mere act of reproduction, performance, distribution or display. Thus, if the act of reproduction, performance, distribution

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239. Id. § 301(a). Section 106 of the Copyright Act provides:

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

1. to reproduce the copyrighted work in copies or phonorecords;
2. to prepare derivative works based upon the copyrighted work;
3. to distribute copies of phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
4. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
5. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

Id. § 106.

240. Id. § 301.

241. Id. § 301(b).

242. Id. § 301(b)(3).

243. Accord Goldstein, note 238 supra, at 1112.


245. Id. § 301(b).
or display is sufficient in itself to infringe upon the state-created right, then it will apparently be pre-empted. However, if some other element is required, the state-created right is not considered to be within the general scope of copyright and, therefore, will not be pre-empted. Thus, traditional privacy actions are not preempted because the essence of the tort lies not in the acts of reproduction and distribution, but in the injury to the plaintiff's right to be left alone. By the same token, actions which involve deception, misrepresentation or passing off are not preempted since essential elements are required in these actions that are not necessary to constitute copyright infringement. The same may be true of actions which are analogous to trademark infringement. Viewed in this light, section 301 represents a legislative vindication of Goldstein and Kewanee Oil. State protection of intellectual property interests that are equivalent to those protected under federal copyright law are preempted because they interfere with the constitutional policy of providing such protection for only a limited time. Thus, section 301 rejects the Sears-Compco theory that all intellectual property not affirmatively covered by federal patent or copyright law must be left in the public domain. Instead, section 301 expressly allows the states to protect property rights, including many forms of publicity rights, which are not already subject to regulation or protection under the Copyright Act.

1. Exploitation of Performance Values

It is clear that a performance that is filmed, recorded or otherwise fixed in a tangible medium of expression by the performer normally falls within the exclusive purview of federal copyright law. The status of a live performance, not fixed in any tangible

246. 1 M. Nimmer, Nimmer on Copyright § 1.01[B][1] at 1-11 (1981). Early versions of § 301 expressly preserved state remedies for breaches of trust and contract, invasions of privacy, defamation, and deceptive trade practices such as passing off and false representation. Prior to final action by the House of Representatives, three additional examples of rights not equivalent to copyright privileges were added to the original bill: misappropriation, trespass, and conversion. The Justice Department objected to inclusion of the common law misappropriation action and, subsequently, all of the examples listed in the proposed § 301(b)(3) were deleted. Id. at 1-13 to 1-14.1. See also Factors II, 496 F. Supp. 1090, 1097 (S.D.N.Y. 1980).

250. Section 102 of the Copyright Act of 1976 provides:
(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated,
medium, is less clear. Arguably, such a performance involves noncopyrightable subject matter. 251 Perhaps one might contend that where an entertainer can easily secure copyright protection for his performance, failure to do so amounts to a dedication of his performance to the public. This conclusion, however, is at variance with the Supreme Court's language in Zacchini. Although the preemption issue was not explicitly raised in that case, the Court noted that Zacchini's claim under a state right of publicity was not preempted by federal copyright law because he had not filmed his performance, as he easily could have done, and thereby secured copyright protection. 252 Recognizing that the right of publicity shares the same objectives as federal patent and copyright laws, the Court, citing Goldstein and Kewanee Oil, went on to declare that the Constitution does not prevent states from also protecting an entertainer's interests in the value of his performance in order to encourage beneficial productivity. 253 This observation by the Court suggests that the performer may choose between federal and state protection by preserving, or declining to preserve, his performance in a tangible medium of expression. 254 In the latter case, the right of publicity fills in the gap left by copyright law.

2. Exploitation of Recognition Values

The preemption issue is particularly unsettled where recognition values are involved. For purposes of analysis, it is helpful to distin-

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either directly or with the aid of a machine or device. Works of authorship include
the following categories:

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

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

251. 1 M. NIMMER, NIMMER ON COPYRIGHT § 1.01[B][2][a] at 1-22 (1981).
also Note, note 99 supra, at 1193 n.26.
253. Zacchini, 433 U.S. at 577 (citing Goldstein, 412 U.S. at 571; Kewanee Oil, 416
U.S. at 470).
254. Of course, it is the plaintiff who must fix the performance in a tangible medium of
expression. It does not matter, as far as preemption is concerned, whether the defendant, as in
Zacchini, fixed the plaintiff's performance.
guish impersonation situations from appropriation of a celebrity's name and likeness. Since performing style and characters created by an entertainer are usually not copyrightable in and of themselves, impersonations, such as those which involved Elvis Presley, Laurel and Hardy, or the Marx Brothers, would probably not fall within the Act's preemption provisions. One commentator has suggested that if a performer's style and character creation are viewed as the oral and visual expression of ideas, then style and character, when developed to the point of being definable in terms of distinctive dress, mannerisms, and vocal characteristics, arguably constitute "writings." Although a performer's character or style is not tangible, his performances can become "works of authorship" fixed by means of films and tapes. However, this appears to be a very expansive interpretation of the term "works of authorship," bearing little resemblance to the examples given in the Copyright Act itself.

Moreover, even if a court did accept such a broad definition of "writings," preemption would still be avoided under the non-equivalent rights theory if the impersonation involved passing off or other deceptive practices. Such deception would probably be found, as in Chaplin v. Amador, if the plaintiff was still professionally active at the time of the impersonation. However, if the performer being impersonated is dead, as in the case of Elvis Presley or the Marx Brothers, it is doubtful that a court would conclude that the impersonation itself was deceptive. In that situation a court might conclude that publicity rights were preempted only by adopting the tenuous theory that the values appropriated by the defendant can be regarded as a writing fixed in a tangible medium of expression. In the absence of the judicial adoption of this theory, however, publicity rights in impersonation cases would not be pre-empted.

The preemption issue is even more troublesome when recognition values are appropriated through the use of the plaintiff's name or likeness. To date only a few courts have considered the preemption issue in this context. The district court in Price v. Hal Roach Studios, Inc. held that federal copyright laws did not preempt a

255. Shipley, note 11 supra, at 718.
256. These examples include literary, musical, dramatic and choreographic works as well as art, sculpture, motion pictures and sound recordings. See 17 U.S.C. § 102 (Supp. V 1981).
258. See, e.g., Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981), where the court found that the performance itself was not deceptive, although some of the advertising in connection with the show was misleading. Id. at 1373-75.
state-based right of publicity. This conclusion was based on the Supreme Court’s language in Goldstein; however, the court in Hal Roach Studios did not explicitly compare the rights protected by the publicity doctrine to those protected by copyright, nor did it analyze their respective objectives and available remedies.\textsuperscript{260}

The preemption issue also arose before the district court in Factors II.\textsuperscript{261} The defendant, in an effort to avoid liability for marketing Elvis Presley posters, contended that Factors could not base its claim on state publicity rights because they were preempted by federal copyright law. The court, however, rejected this argument,\textsuperscript{262} initially noting that section 301 did not apply since the cause of action arose before January 1, 1978, the effective date of the new Copyright Act.\textsuperscript{263} However, the court agreed with Professor Nimmer’s view that the scope of preemption under section 301 was comparable to that under the 1909 Act as interpreted by Goldstein.\textsuperscript{264} According to the Factors II court, the product at issue was a “persona” that had already been profitably marketed. The “separate and intangible property right” which could only survive death if exercised by the celebrity during life, was not equivalent to a copyright.\textsuperscript{265} Accordingly, the court concluded that the right of publicity covered an “area unattended” by federal law.\textsuperscript{266} On appeal, the Second Circuit held for the defendant on other grounds and, therefore, did not consider the preemption issue.\textsuperscript{267} However, Judge Mansfield, in his dissenting opinion, agreed with the lower court’s finding that the right of publicity was not equivalent to any interest within the general scope of federal copyright law.\textsuperscript{268}

The district court’s reasoning in Factors II is open to criticism.\textsuperscript{269} In the case of advertisements where the celebrity is still alive, the use of the plaintiff’s name or likeness suggests an endorsement or an association with the product advertised that is inherently

\begin{itemize}
\item \textsuperscript{260} Shipley, note 11 supra, at 698.
\item \textsuperscript{262} Id. at 1097.
\item \textsuperscript{263} Id. at 1096. Section 301(b)(2) provides that nothing in the act “annuls or limits any rights or remedies under the common law or statutes of any state with respect to . . . any cause of action arising from undertakings commenced before January 1, 1978.”
\item \textsuperscript{264} 496 F. Supp. at 1099 (citing Goldstein, 412 U.S. at 546, 570. \textit{See also} 1 M. Nimmer, NIMMER ON COPYRIGHT § 1.01[B] at 1-7 n.22 (1981).
\item \textsuperscript{265} 496 F. Supp. at 1099-1100.
\item \textsuperscript{266} Id. at 1100.
\item \textsuperscript{267} 652 F.2d at 283 n.8.
\item \textsuperscript{268} Factors II, 652 F.2d 278, 289 (2d Cir. 1981) (Mansfield, J., dissenting).
\item \textsuperscript{269} \textit{See also} Shipley, note 11 supra, at 708-09 & n.252.
\end{itemize}
Consequently, it can be argued that a cause of action brought under the right of publicity against such conduct is not equivalent to copyright infringement and thus should not be pre-empted. The situation is different, however, where posters or memorabilia are involved. Reproduction, distribution or display of the plaintiff's likeness by the defendant is the action which gives rise to liability under state law. Arguably, this is the very same conduct that is protected against under federal copyright law.

Nevertheless, even if the interest protected by the right of publicity is considered to be equivalent to the interest protected by copyright, it is doubtful that the celebrity's identity or “persona”—which is the essence of the right of publicity—qualifies as a “work of authorship” within the meaning of the Copyright Act. This non-qualification, according to Professor Nimmer, prevents a finding of pre-emption even where a particular aspect of the celebrity’s identity is fixed in a tangible medium of expression such as a drawing or photograph.271

Of course, one can argue that a celebrity's “persona” is often an artificial creation, consciously and carefully developed, having little to do with the celebrity's natural appearance or personality. Except where “characters” are concerned, this view cannot be accepted since recognition values are not independent creations, but instead are largely derived from the celebrity's previous performances or achievements.272

The argument for preemption may be stronger in cases like Lugosi273 where the plaintiff has asserted publicity rights in his likeness as a particular character. Unlike one's natural likeness, a stage character is an artificial creation, somewhat resembling a literary character. Therefore, one might reasonably contend that at least some characters would qualify as “writings” and should, therefore, be treated as copyrightable material. Like cartoon characters, which are usually regarded as copyrightable,274 the stage character is visu-

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270. See also Felcher & Rubin, note 12 supra, at 1600; Treece, note 3 supra, at 644.
271. 1 M. NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1] at 1-14 n.49 (1981).
272. See notes 86-87 supra and accompanying text.
ally represented. Where, as in Lugosi, the exploitation involved a stylized depiction of the celebrity's likeness in the guise of a character embodied in various fixed media, preemption may be justified. The general rule, however, should remain one of no preemption.

The preemption provisions of the Copyright Act are quite ambiguous, and the legislative history of section 301 sheds little light on congressional intent in this area. Moreover, it is difficult to see any real conflict between state-created publicity rights and the policies that underlie federal copyright legislation. Consequently, to the extent that plaintiff's publicity interests do not fall within the purview of copyright law, preemption should not apply to the right of publicity.\footnote{275}

C. Other Aspects of Federal Preemption

Although state publicity rights do not appear to be expressly preempted by section 301, the preemption doctrine is still applicable in situations where there is a direct conflict between publicity rights and federal copyright policy. For example, an actor who appeared in a copyrighted motion picture could not assert his right of publicity in such a way as to prevent the copyright holder from exercising the usual rights granted by the Copyright Act,\footnote{276} including the right in some cases to use the actor's name and likeness in derivative works.\footnote{277} A similar conflict would arise if the heirs or assignees of an actor who appeared in a copyrighted film attempted to assert a right of publicity in the work after the copyright had expired. This circumstance would involve a direct clash with federal copyright policy. The Constitution's copyright clause provides that writings may be protected only for "limited times"\footnote{278} and Congress has created the statutory copyright in return for a subsequent dedication of the work

\footnotesize{275. Shipley, note 11 \textit{supra}, at 714-15.}
\footnotesize{276. Of course, the performer would normally assign his performance rights to the movie producer as part of his employment contract. \textit{But see} Ettore v. Philco Television Broadcasting Corp., 299 F.2d 481, 490 (3d Cir.) (telecast of prize fight motion picture without consent held actionable), \textit{cert. denied}, 351 U.S. 926 (1956).}
\footnotesize{277. According to the new Copyright Act, a "derivative work" is "a work based upon one or more pre-existing works, such as a translation, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. \textsection 101 (Supp. V 1981). 1 M. Nimmer, \textit{Nimmer on Copyright} \textsection 3.01 (1980). A poster which displays a single frame from a copyrighted movie would be an example of a derivative work.}
\footnotesize{278. The Constitution declares that "[t]he Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art I, \textsection 8, cl. 8.}
to the public domain upon expiration of the copyright. Clearly, state protection of a work after expiration of the federal copyright could impair this scheme and undermine the policy of allowing everyone to draw freely upon plots, characters and other material in the public domain. Consequently, the right of publicity should be preempted in these circumstances.

Another problem is posed by the wide disparities among states in their treatment of publicity rights. In most instances publicity rights operate in a national market; yet when viewed from a national perspective, the law of publicity continues to resemble a "haystack in a hurricane." Some states have not yet expressly recognized the right of publicity. Even more significantly, there is no agreement among the states as to whether publicity rights survive death, and if so, for how long and under what conditions. As the Factors II litigation illustrates, disputes over post mortem publicity rights give rise to difficult conflicts of law issues. In Factors II, the court and the parties first assumed that New York law applied. Later, the court determined that Tennessee law should control since Boxcar was a Tennessee corporation, Presley was a Tennessee resident and the contract between Boxcar and Factors provided for the application of Tennessee law. However, the injury occurred in New York where the sale of Presley posters took place. The court suggested in dictum, that if publicity rights had been considered survivable under Tennessee law, New York law might have been applied to decide if the defendant's actions were privileged or tortious.

The issue becomes even more complicated if one considers what might happen if a California resident, where, as a result of the Lugosi case, post mortem publicity rights are presumably not recognized, assigns his publicity rights to a New York corporation. Under New York law the right of publicity survives death but, if the assignment contract specifies that New York law will control, will the publicity rights thereby assigned be enforceable against third parties af-

279. Ettore, 229 F.2d at 485.
281. Factors contended that New York law was applicable as the law of the place of the wrong. The court, however, concluded that even if New York law might be applicable to determine if Pro Arts' conduct constituted an infringement of the right of publicity, Tennessee law must be used to determine whether Boxcar had a right of publicity after Presley's death that was capable of being contracted for by Factors. 652 F.2d at 280-81. Cf. Restatement (Second) of Conflict of Laws § 147, comment (i) (1971) (tort conflicts rules apply to issue of conversion of property, but property conflicts rules apply to whether the plaintiff has title to the property allegedly converted).
282. 652 F.2d at 281.
ter the celebrity’s death? Assuming that post mortem publicity rights are valid under New York law, can the assignee of a deceased New York resident enjoin the sale of infringing merchandise in California? What would be the effect of an advertisement on national television that featured an impersonation of a deceased celebrity who had made an inter vivos assignment of publicity rights? Is the advertiser (or perhaps even the network) liable in New York but not in California?

The split of authority among the states concerning post mortem survival of publicity rights significantly undermines the national market for goods and advertisements featuring the names and likenesses of deceased celebrities. Therefore, in these circumstances, the federal government may have the power to regulate the exercise of publicity rights in order to prevent these conflicts from imposing an unreasonable burden on interstate commerce. Given the fact that Congress, under the supremacy clause, has the power to occupy the field to the exclusion of the states, one may ask whether it should do so. Perhaps the ideal solution is for the states themselves to adopt uniform legislation aimed at defining the nature, scope and duration of the right of publicity. However, in view of the widely divergent positions that the states have taken on the survivability issue, it is doubtful whether uniform state legislation will be enacted in the near future. Consequently, some sort of federal response may be necessary. Federal legislation could take one of two routes. The first response would be to prohibit lawsuits based on state rights of publicity as to goods and property such as radio and television transmissions or motion pictures, which utilize interstate commerce. As a result, celebrities and their assignees would be effectively restricted to unfair competition and similar theories as a means of protecting their economic interests from exploitations by third parties. The preferable approach would be to establish a federal statutory right of publicity of limited duration. Although legislation of this sort may be regarded as an unwarranted intrusion by the federal government into an area traditionally occupied by the states, it would impose an element of rationality, fairness, and consistency upon a body of state law that thus far has resisted orderly development.

283. Presumably, one of the parties must have some connection with the state whose law is invoked. The question presented here is whether a California resident can convey something he does not have in California, although he might have it if he lived somewhere else.

284. Of course, living celebrities can often protect themselves, although not their assignees, by means of unfair competition theories.
The first amendment protects the dissemination of ideas and information in the form of news, biography, social or political commentary. Other types of information may also be protected. The first amendment also covers artistic expression which is communicated to the public as art, literature or entertainment. Consequently, courts generally look with disfavor upon state action which seeks to limit free expression.

The United States Supreme Court has often acknowledged the special role of the press as a medium for the dissemination of ideas and information to the public, and has discouraged governmental attempts to restrict newsgathering activities. Thus, for example, the Court struck down laws which prohibited the press from publishing the names of rape victims or juvenile offenders. In these cases, the Court concluded that the social policies which supported nondisclosure failed to outweigh the public's right to receive accurate information about matters of legitimate public concern.

The Court has also recognized the need to protect the press from the consequences of disseminating falsehoods so that it will not be induced to practice self-censorship or shrink from its role in maintaining the "uninhibited, robust, and wide-open" public debate central to the first amendment. Thus, in New York Times v. Sullivan, the Court declared that a public official could not recover damages against a media defendant for a defamatory falsehood relating to his official conduct unless he proved that the statement was made with "actual malice"—that is, with knowledge that it was


290. Id. at 496-97.


292. Id. at 104-05; Cox, 420 U.S. at 495.


294. Id. at 254.
false or with reckless disregard of whether it was false or not. This rule was also applied to “public figures,” who, by their accomplishments, fame, mode of living or calling, give the public a legitimate interest in their activities, affairs or character. The actual malice standard was extended to false light privacy cases by the Court in Time, Inc. v. Hill. The plaintiff in Hill and his family had been held hostage by a group of escaped convicts. When Life magazine published an article about a successful play based on the Hill family’s experience, it incorrectly stated that events depicted in accompanying still shots from the play had actually happened to the Hills. Hill brought suit under the New York privacy statute claiming that Life’s account placed him in a false light in the public eye. Although the trial court held in the plaintiff’s favor, its decision was reversed by the Supreme Court on appeal. The Court declared that the New York Times rule was applicable since the Hill family’s experience was a matter of public interest even though Hill’s involvement was admittedly involuntary. Accordingly, the Court held that the plaintiff must prove that Life magazine knew that the statements it published about him were false or that it acted with reckless disregard of their truth or falsity.

Imposition of an “actual malice” requirement on defamation and false light privacy actions not only demonstrates a strong judicial commitment to ensuring access to a continuing flow of ideas and information, it also implies that public figures, at least as far as their dignitary interests are concerned, are not entitled to the same degree of legal protection as ordinary persons. Having sought and achieved wealth, power or status, celebrities must also accept the disadvan-

295. Id. at 279-80.
297. See Gertz v. Robert Welch, Inc., 418 U.S. 323, 345 (1974). For a while, it appeared that the New York Times rule might be extended to plaintiffs who involuntarily became involved in matters of public interest. See Rosenbloom v. Metromedia, Inc., 403 U.S. 29, 43 (1971) (victim of police raid held to be a public figure). This view, however, was repudiated by the Court in Gertz v. Robert Welch, Inc., 418 U.S. 323 (1974). According to Gertz, the state courts are free to define an appropriate standard of liability for a publisher of defamatory falsehood where a private individual is injured, as long as they do not impose strict liability on the defendant. Id. at 347. Furthermore, an injured party is not to be regarded as a public figure simply because he is involuntarily involved in a matter of general or public interest. Id. at 346. See also Time, Inc. v. Firestone, 424 U.S. 448, 454-55 (1976) (socially prominent woman involved in divorce proceeding not a public figure).
298. 385 U.S. 374 (1967).
299. Id. at 390-91. At the present time, however, it is unclear whether the Hill case has been implicitly overruled by Gertz where private persons are harmed. See Frakt, Defamation Since Gertz v. Robert Welch, Inc.: The Emerging Common Law, 10 RUT.-CAM. L.J. 519, 533 n.82 (1979); Note, Defamation, Privacy and the First Amendment, 1976 DUKE L.J. 1016, 1019.
A. Appropriation and the Right of Publicity

The exploitation of publicity rights by performers and celebrities also limits some forms of expression, thereby coming into potential conflict with the first amendment. To the extent that publicity interests are purely economic, they are weaker than and should be subordinate to the first amendment interest in public information and education. However, the actual malice test of *New York Times* and *Hill* is not directly applicable to publicity cases because, with the possible exception of fictionalized portrayals of celebrities, the truth or falsity of the defendant's publication is not at issue. On the other hand, appropriation of name and likeness is somewhat similar to the right of publicity as far as its impact on free expression is concerned. In fact, some courts have treated appropriation and publicity cases alike for first amendment purposes when celebrities relied on both theories in the same cause of action. Appropriation cases decided under the New York privacy statute are especially useful. In general, the courts in these cases have distinguished use of performance or recognition values to promote the dissemination of information and ideas from use for "advertising purposes" or for "purposes of trade." The former category is treated as protected speech while the latter category is not. This distinction between informative uses and commercial uses can arguably be applied to publicity rights cases as well. In fact, courts have often relied upon the reasoning of these appropriation cases when called upon to resolve similar controversies over publicity rights. For this reason, appro-

301. See Note, note 132 *supra*, at 550.
303. N.Y. *CIV. RIGHTS LAW* § 51 (McKinney 1976). According to the New York statute:

Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person's name, portrait or picture in such manner as is forbidden or declared to be unlawful by the last section, the jury, in its discretion, may award exemplary damages.

304. See, e.g., Hicks v. Casablanca Records, 464 F. Supp. 426, 430 (S.D.N.Y. 1978);
priation cases and publicity rights decisions will be discussed to-
gether in this section.

Factually, these cases seem to fall into four categories: news and
information about matters of public interest, fiction and fictionalized
portrayals of celebrities, impersonations of celebrities, and advertis-
ing and memorabilia.

1. News and Information About Matters of Public Interest

Free expression serves a number of socially useful functions. With-
out question, the most important of these functions is to help
maintain the viability of our political system.806 In the words of one
commentator, "[s]elf-government can exist only insofar as voters ac-
quire the intelligence, integrity, sensitivity, and generous devotion to
the general welfare that, in theory, casting a ballot is assumed to
express."808 Since the free flow of information to members of society
must be maintained if the goals of democratic government are to be
achieved,807 works or activities that disseminate information or ideas
should receive considerable protection against the claims of private
interests.808

Recognizing the overriding nature of the public's right to infor-
mation about matters of current interest, the courts in appropriation
cases have generally allowed the media to use a person's name or
picture without liability in connection with a legitimate news
event.808 This principle is known as the "newsworthiness" or public
interest privilege and, while particularly broad in its application to
public figures, also extends to situations where private persons are
involved in newsworthy events.810 Thus, recovery for invasion of pri-
vacy was denied where a newspaper published the plaintiff's photo-
graph in connection with an account of her father's arrest.811

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Rosemont Enters., Inc. v. Random House, 58 Misc. 2d 1, 4-5, 294 N.Y.S.2d 122, 129 (Sup.
305. A. MEIKLEJOHN, FREE SPEECH AND ITS RELATION TO SELF GOVERNMENT 1-27
(1948); Bork, Neutral Principles and Some First Amendment Problems, 47 IND. L.J. 1, 26
(1971); Emerson, Toward a General Theory of the First Amendment, 72 YALE L.J. 877, 878-
86 (1963).
306. Meiklejohn, The First Amendment is an Absolute, 1961 SUP. CT. REV. 245, 255.
308. See Note, note 184 supra, at 769.
310. E.g., Cohn v. National Broadcasting Co., 67 A.D.2d 140, 143, 414 N.Y.S.2d 906,
908 (1979). (Roy Cohn, an associate of Senator Joseph McCarthy, not allowed to recover
against NBC for portrayal of him by actor in television drama about McCarthy).
The courts have also refused to hold a newspaper liable for a report of the plaintiff's conviction for engaging in an illegal drag race or for a news story about a twelve-year old girl having a baby.

The newsworthiness privilege is not limited to "news," in the sense of current events, but applies to any factual account as long as the story is accurate and deals with a matter of public interest. For example, the use of the plaintiff's name or incidents from his life, in connection with a biography, is privileged as long as the account is substantially correct. In *Rosemont Enterprises v. Random House*, a corporation formed by Howard Hughes to produce his biography sued to prevent the publication of the book *Howard Hughes* by John Keats. The court held that biographical works were not commercial uses and, therefore, were beyond the purview of both the New York privacy statute and the right of publicity. Addressing the right of publicity issue, the court declared that the "same requirement of commercial use which limits the New York right of privacy inheres in the right of publicity."

It has been said that the newsworthiness or public interest privilege “extends far beyond the dissemination of news in the sense of current events and includes . . . even entertainment and amusement, concerning interesting phases of human activity in general.”

316. Thus, for example, recovery was denied in *Klein v. McGraw-Hill*, 263 F. Supp. 919 (D.D.C. 1966). In that case, the plaintiff, a high school student, who made an important contribution to radio communication in connection with the operation of amateur radio equipment in his home, received an award from MIT and a great deal of attendant publicity. The defendant published his picture in a textbook, *Understanding Radio*, along with an account of the plaintiff's achievement. Holding for the defendant, the court concluded that the plaintiff's activities were a genuine matter of public interest. *Id.* at 921-22.
318. *Id.* at 7, 294 N.Y.S.2d at 129. The same result was reached in *Koussevitzky v. Allen, Towne & Health*, 188 Misc. 479, 484, 68 N.Y.S.2d 779, 783-84 (Sup. Ct., New York County 1947), *aff'd*, 272 A.D. 759, 69 N.Y.S.2d 432 (1947), where a prominent orchestra conductor sought to enjoin the publication of an unauthorized biography. The court, denying recovery, pointed out that the plaintiff was a public figure and that the book dealt largely with his musical career which was a matter of public interest. *Id.*
319. 58 Misc. at 6, 294 N.Y.S.2d at 129.
is illustrated by Ann-Margret v. High Society Magazine, Inc.\(^{321}\) In that case "High Society Magazine published a semi-nude photograph of the actress in a feature entitled 'High Society Celebrity Skin.' The photograph was taken from a movie, 'Magic,' in which Ann-Margret had appeared. The plaintiff brought suit against the magazine, alleging both violation of the New York privacy statute and infringement upon her right of publicity. The court remarked that "when an individual consents to be viewed in a certain manner during the course of a public performance, such as in a movie, it cannot then be argued that subsequent faithful reproduction . . . of that appearance constitutes an invasion of privacy."\(^{322}\) Moreover, according to the court, publication of the offending photograph in the defendant's magazine was not considered "advertising" for "purposes of trade" within the meaning of the privacy statute since the nude appearance of Ann-Margret in a movie was a newsworthy event.\(^{323}\) The court added that a right of publicity, if recognized under New York law, could only be asserted against commercial uses, as was the case with the statutory right of privacy.\(^{324}\) Recovery was therefore denied on both counts.

Although reports of newsworthy events are privileged, a publisher may not appropriate the plaintiff's recognition values merely to draw attention to an unrelated article. Thus in Grant v. Esquire, Inc.,\(^{325}\) the defendant was found liable for publishing an article on clothing styles in which Cary Grant's head was superimposed on the torso of a model. Grant had posed for pictures in 1946 for *Esquire* in connection with an article about clothing tastes and habits of Hollywood stars, but the offending article, published some twenty-five years later, had nothing to do with the plaintiff. Grant brought suit on the basis of libel, invasion of privacy and interference with the right of publicity. Overruling the defendant's motion for summary judgment, the court held that the plaintiff's complaint stated a


\(^{322}\) Id. at 405.

\(^{323}\) Id. See also Goelet v. Confidential, Inc., 5 A.D.2d 226, 171 N.Y.S.2d 223 (1958).

\(^{324}\) 498 F. Supp. at 406-07.

cause of action under both the privacy and publicity theories.\textsuperscript{326} In addition, the court rejected the defendant's contention that the magazine article was privileged under the first amendment.\textsuperscript{327} The use of Grant's picture contributed nothing to the informational content of the article but deprived the plaintiff of a valuable economic right. This, the court noted, was a commercial use of Grant's picture: "Mr. Grant's face serves no function but to attract attention to the article. Presumably the model who posed for the torso got a professional fee for his part in the enterprise. The question presented is whether Esquire had the right to compel Mr. Grant to contribute his face for free."\textsuperscript{328}

Information, of course, can be disseminated not only for printed media such as newspapers, books and magazines,\textsuperscript{329} but also by radio and television broadcasts or motion pictures. Consequently, depictions of actual events in these media are also privileged.\textsuperscript{330} However, where performance values rather than publicity values are involved, the courts apparently are willing to extend more protection to the entertainer under the publicity rights theory than under the right of

\begin{quote}
\textsuperscript{326} Id. at 884-85. The court found that the magazine article was not defamatory and, therefore, dismissed the libel action. Id. at 878.

\textsuperscript{327} Id. at 882.

\textsuperscript{328} Id. at 878. A similar result was reached in Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978), a publicity rights case where the defendant published a drawing in its magazine of a nude black man seated in the corner of a boxing ring. The court found that the picture, which accompanied an unrelated doggerel poem, was merely intended to attract attention to the article and had no connection with a legitimate newsworthy event. Id. at 727. See also Lerman v. Chuckleberry Publishing, 496 F. Supp. 1105, 1110 (S.D.N.Y. 1980) (plaintiff, incorrectly identified as participant in "orgy" depicted in defendant's magazine with intent to make commercial use of plaintiff's name, held to have a cause of action under New York privacy statute). New York courts have, however, sometimes allowed the news media to use a person's picture for illustrative purposes in connection with a related news story even though he is not the subject of the article. See, e.g., Murray v. New York Magazine, 27 N.Y.2d 406, 267 N.E.2d 256, 318 N.Y.S.2d 474 (1971), in which a freelance photographer took Murray's picture as he watched a Manhattan St. Patrick's Day parade wearing an "Irish" hat, green tie, and green pin. The defendant purchased the photograph and used it two years later on a magazine cover in connection with an article by Jimmy Breslin entitled \textit{The Last of the Irish Immigrants}. Although the article neither named the plaintiff, nor referred to the cover picture, the court felt that the relationship was close enough for the public interest privilege to apply. Id. at 409, 267 N.E.2d at 258, 318 N.Y.S.2d at 476-770. Accord Lahiri v. Daily Mirror, Inc., 162 Misc. 776, 782-83, 295 N.Y.S. 382, 389 (Sup. Ct., New York County 1937) (use of Hindu musician's photograph in article about Hindu rope trick does not state a cause of action under New York privacy statute).

\textsuperscript{329} Even cartoons have been treated as privileged. Thus, the defendant was privileged to depict in cartoon form the plaintiff's efforts to aid the victims of an airplane which had crashed into the Empire State Building. Molony v. Boy Comics Publishers, 277 A.D. 166, 98 N.Y.S.2d 119 (1950).

\end{quote}
privacy. Thus, in *Man v. Warner Brothers, Inc.*, an appropriation case, the court denied recovery to a musician whose forty-five second rendition of *Mess Hall* on the flugel-horn at the Woodstock Festival was portrayed in the defendant's documentary about Woodstock. The court noted that the first amendment privilege applied to commercial films. The plaintiff's performance was certainly a matter of public interest as one of the events that took place at Woodstock.

In contrast to the *Man* decision, the United States Supreme Court, in *Zacchini v. Scripps-Howard Broadcasting Co.*, restricted the scope of the newsworthiness privilege in situations where the performance values were appropriated by the news media. The plaintiff in *Zacchini* brought suit against a local television station when it broadcast his fifteen-second "human cannonball" act on its evening news program. Reversing the Ohio Supreme Court, which had held that the news media could photograph Zacchini's performance because it was a newsworthy event, the United States Supreme Court ruled that the first amendment did not permit the defendant to broadcast Zacchini's "entire act." The Court began by rejecting the actual malice standard of *Time, Inc. v. Hill*, concluding that the right of publicity was substantially different from the false light privacy tort involved in *Hill*. This conclusion followed from two assumptions. First, performers, unlike plaintiffs in false light cases, did not desire to suppress public scrutiny of newsworthy

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332. *Id.* at 52. The court in *Man* also cited Gautier v. Pro-Football, Inc., 278 A.D. 431, 106 N.Y.S.2d 553 (1951), for the proposition that one who gives a public performance cannot base a claim on invasion of privacy. 317 F. Supp. at 53. Although the court went on to discuss the first amendment issue, it can be argued that the court's conclusion on that issue was not the basis for the holding in the case.
333. 317 F. Supp. at 53. Summary judgment for the defendant in a privacy action, however, was reversed in Taggart v. Wadleigh-Maurice, Ltd., 489 F.2d 434 (3d Cir. 1973), another case involving the Woodstock movie. In that case, the plaintiff was photographed servicing latrines at the Woodstock Festival. The defendant recorded a conversation with him and later edited it in order to achieve a comic effect at the plaintiff's expense. The court distinguished between a privileged action, such as photographing the plaintiff as he went about his business, and "deliberately draw[ing] him out in conversation for the purpose of making him an inadvertant performer in a sequence intended to be exploited for its artistic effect." *Id.* at 438.
336. 433 U.S. at 575.
338. 433 U.S. at 572-73.
activity but merely wished to be paid for it. Second, there were alternative modes of expression available to the press and, therefore, appropriating Zacchini's performance was not necessary in order to inform the public about it. Additionally, the Court observed that the defendant's broadcast posed a substantial threat to the economic value of Zacchini's performance because the public would hardly pay to watch the plaintiff's human cannonball act if it could see the performance for nothing. According to the Court, this went to the heart of Zacchini's ability to make a living as an entertainer.

The right of publicity provided an economic incentive for Zacchini and others to make the necessary investment in time and resources to produce a performance of interest to the public. In the Court's opinion, the "incentive rationale" which lies behind the right of publicity is similar to the policy of encouraging creative endeavors upon which patent and copyright laws are based. Just as this objective justified restrictions on the flow of information by virtue of the protection extended to patent and copyright holders, so also would it permit the states to protect the performer under the publicity rights concept. Accordingly, the Court declared that the first amendment interest of the media was not sufficient to prevent a state, if it chose to do so, from prohibiting the defendant from broadcasting Zacchini's entire act, notwithstanding the newsworthy nature of his performance.

Justice Powell, in a dissenting opinion, concluded that the press could appropriate any portion or all of a performance so long as it broadcast the performance as part of its routine news programs, rather than as commercial entertainment. This approach seem-

339. Id. at 573. In other words, the Court assumed that even if broadcast were essential to public debate on a newsworthy topic, the performer's willingness to bargain for an authorized broadcast of his act undercut the need for constitutional protection. This assumption, however, might not always be correct since the money a broadcaster may be willing to pay may not be enough to offset the loss of revenue from paying customers to a live performance. See Note, note 99 supra, at 1185.

340. 433 U.S. at 574. It is, of course, questionable whether a verbal description of Zacchini's act would be nearly as effective as a motion picture recording of it. See Note, State "Copyright" Protection for Performers: The First Amendment Question, 1978 DUKE L.J. 1198, 1225-26. More importantly, according to one commentator, permitting the plaintiff to restrict the medium of communication might seriously impair the public access to a critical evaluation of the act. See Note, note 99 supra at 1199-1201.

341. 443 U.S. at 576.

342. Id. See also Note, note 148 supra, at 624-25.

343. 433 U.S. at 575. On remand, the Ohio Supreme Court concluded that the defendant had no constitutional right to broadcast the performance, and sent the case back to the trial court for a determination of whether Zacchini's right of publicity had been invaded. 54 Ohio St. 2d 286, 376 N.E.2d 582 (1978).

344. 433 U.S. at 581 (Powell, J., dissenting). For a discussion of the "routine news"
ingly represented an attempt to recast the traditional newsworthiness privilege into a form that would be more appropriate to a performance rights situation.

The majority opinion in *Zacchini* has been generally criticized by legal commentators. Perhaps the greatest problem with the "entire act" test is its vagueness.\(^{345}\) For example, it is not clear whether a discrete unit that is part of a larger whole, would be considered an entire act. In addition, the entire act standard provides very little guidance about the scope of first amendment protection when something less than an entire act is appropriated. Moreover, the test cannot be applied beyond the performance situation.\(^ {346}\) As the *Zacchini* Court suggested, protecting the economic rights of performers will ultimately increase the level of entertainment available to the public, thereby advancing first amendment objectives.\(^ {347}\) Comparable protection of recognition values, however, does not provide the same sort of motivation to produce additional things of value to society.\(^ {348}\) The social interest that justifies the protection of performance values, therefore, does not necessarily justify recognition of a celebrity's right to exploit his name and likeness. The majority opinion in *Zacchini* simply does not address itself to this issue.

The "routine news" test of Justice Powell has received more favorable comment,\(^ {349}\) but it is not entirely satisfactory either. The distinction between routine news and commercial entertainment is difficult to maintain since many news shows are highly commercialized and entertainment-oriented.\(^ {350}\) Conversely, many types of commercial programming, such as sports telecasts, have "news" segments. Thus, in theory, if filmed sports highlights were broadcast on both a local evening news program and a commercial sports program, the former use would be protected under the "routine news" test while the latter might not be protected, though the two uses convey the same information and respond to the same audience interest.\(^ {351}\)

It can be argued that *Zacchini* and *Man* are not entirely inconsistent. In *Zacchini*, the plaintiff's living was based entirely on his

\(345.\) Comment, supra note 120, at 825-27.
\(346.\) Comment, supra note 41, at 606.
\(347.\) 433 U.S. at 575-76.
\(348.\) See Note, note 340 *supra*, at 1222.
\(349.\) *See, e.g.*, Note, note 344 *supra*, at 213-14.
\(350.\) See Note, note 335 *supra*, at 694.
\(351.\) *See Note, note 99 supra*, at 1205.
human cannonball act. The television station not only filmed his entire act, but broadcast it while Zacchini was still performing at the fair. Thus, the plaintiff could plausibly contend, as the Court concluded, that the news broadcast directly threatened his ability to make a living as a performer. On the other hand, the plaintiff in Man gave a brief and spontaneous performance. Even though the plaintiff was a professional musician, the Woodstock movie could hardly have reduced popular demand for his services and interfered in any way with his ability to make a living as a musician. Moreover, the plaintiff's performance was a brief, almost incidental, portion of a two-hour movie, which the court characterized as de minimis.\textsuperscript{352}

2. Fiction and Fictionalized Portrayals of Celebrities

Another purpose of free expression is to communicate and expand our cultural experience.\textsuperscript{353} Therefore, first amendment protection may extend to works that are entertaining as well as informative, not only because they frequently contribute something to the marketplace of ideas, but also because they are legitimate forms of expression in their own right.\textsuperscript{354} Thus, fiction writers who loosely base their characters or plots on actual persons or events are usually protected as long as their portrayals are not false or defamatory. For example, the court refused to find liability under the New York privacy statute against John Hersey for basing the character of Major Victor Joppolo in \textit{A Bell for Adano} on the plaintiff, Toscani.\textsuperscript{355} In addition, at least in New York, incidental mention of actual persons in works of fiction for the purpose of adding verisimilitude to the story is likewise privileged. The same privilege would no doubt apply in other jurisdictions.\textsuperscript{356}

Docudramas and fictionalized accounts of actual events are more difficult to fit into the scheme of first amendment protection. Although the courts have traditionally treated straightforward dram-

\begin{itemize}
\item[352.] \textit{Man}, 317 F. Supp. at 53.
\item[353.] See Felcher & Rubin, note 12 \textit{supra}, at 1597.
\end{itemize}
atization or recital of actual events as privileged, they are less likely to afford protection to the portrayal of speculative or imaginary thoughts or events. Although these productions contain ideas and information, their primary purpose is entertainment. It has been suggested that, where a publisher blends fact and fiction, his primary purpose is to increase circulation. If this commercial purpose is viewed as outweighing any intent to disseminate information, one can perhaps contend that the portrayal is more of a commercial product than a literary creation.

The leading case under the New York privacy statute, Binns v. Vitagraph Co. of America, reflected this view. The defendant produced a motion picture which portrayed the plaintiff, Binns, a hero of a marine disaster which had recently been in the news. The court observed that while the movie plot was based on an actual event, it did not contain "true pictures of a current event but [was] mainly the product of the imagination." Accordingly, the court concluded that the defendant had appropriated the plaintiff's name and likeness for purposes of trade and allowed recovery under the New York privacy statute.

Even today, when a fictionalized portrayal masquerades as fact, courts are unwilling to treat it as protected speech. Instead, at least under the New York privacy statute, courts have invoked the actual malice test of Time, Inc. v. Hill to determine if liability shall be

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357. In Guglielmi v. Spelling-Goldberg Prod's, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979), Chief Justice Bird, in a concurring opinion, declared: Contemporary events and people are regularly used in fictional works. Fiction writers may be able to more persuasively, more accurately express themselves by weaving into the tale persons or events familiar to their readers. The choice is theirs. No author should be forced into creating mythological worlds or characters wholly divorced from reality. Id. at 869, 603 P.2d at 460, 160 Cal. Rptr. at 358 (Bird, C.J., concurring).
359. Even greater conflicts between private rights and first amendment considerations are posed by "psycho-biography" and "psycho-history," that is, reconstruction of the thoughts and psychological character of historical figures. See generally Silver, Libel, the "Higher Truths" of Art, and the First Amendment, 126 U. Pa. L. Rev. 1065 (1978).
361. 210 N.Y. 51, 103 N.E. 1108 (1913).
362. Id. at 56, 103 N.E. at 1110.
imposed on the publisher or producer. The leading case is *Spahn v. Julian Messner, Inc.*,\(^364\) which involved a fictionalized biography of baseball pitcher, Warren Spahn. The *Spahn* court held that true biography was completely protected by the first amendment but that a substantially false biography was only partially protected—the defendant would be held liable if he published with knowledge of its falsity or in reckless disregard of the truth.\(^365\) Applying this standard, the New York Court of Appeals allowed the plaintiff to recover because the biography contained “gross errors of fact and ‘all-pervasive distortions, inaccuracies, invented dialogue, and the narration of happenings out of context.’”\(^366\)

Can the court’s analysis in *Spahn* be applied to cases which involve the right of publicity? *Spahn* was essentially a false light privacy case; although the defendant’s biography was offensive, it apparently did not impair Spahn’s economic interests. Because of the similarity between false light privacy and libel, it seemed appropriate to apply the *New York Times* actual malice standard in *Spahn*; however, as previously noted, publicity cases are clearly distinguishable from either of these torts.

Although no cases have yet been decided where a publicity rights claim was asserted against the publisher for a false and deceptive portrayal of a celebrity, the following analysis is suggested as a way of dealing with such a case. Not every false portrayal, even when made with actual malice, should give rise to a cause of action based on the right of publicity. Relief should be granted under a publicity rights theory only when the plaintiff can demonstrate an economic injury, otherwise he should be restricted to a false light privacy action. Economic injury may be shown, for example, when an unflattering portrayal causes the public to think less of the plaintiff and this loss of “good will” reduces demand for endorsements or memorabilia featuring the celebrity. Once a prima facie case is made out in this fashion, the court must then address itself to the privilege issue. As in false light cases like *Spahn*, one can argue that honest mistakes and perhaps even negligent acts should be protected in order to avoid the “chilling effect” of self-censorship. On the other hand, there is little justification for shielding deliberate or reckless

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365. 21 N.Y.2d at 127, 233 N.E.2d at 842, 286 N.Y.S.2d at 834.
366. 21 N.Y.2d at 127, 233 N.E.2d at 842, 286 N.Y.S.2d at 835.
falsifications which not only injure the plaintiff but also deceive the public. Consequently, it can be argued that the boundary between protected and nonprotected speech reflected by the actual malice standard can, at least in some circumstances, be properly applied to publicity as well as false light privacy cases.

The courts, however, have shown more tolerance for docudramas and other portrayals of celebrities which do not purport to be completely factual. Where the account is an avowed fictionalization, courts seem willing to treat it like any other type of fiction. For example, in Frosch v. Gosset & Dunlap, the estate of Marilyn Monroe sued the publishers of Norman Mailer's biography of the actress. The plaintiffs invoked both the statutory right of privacy and the right of publicity. The trial court dismissed the complaint. The appellate court upheld the dismissal of the privacy claim on the grounds that only living persons could maintain an action under the privacy statute. The appellate court also affirmed the trial court's dismissal of the publicity action. The parties disagreed over whether the biography was factual or fictional, but the court declared that it would be privileged as a "literary work" in either event.

A similar conclusion was reached in Hicks v. Casablanca Records. The Hicks case involved an attempt by the heirs and assignees of mystery writer Agatha Christie to enjoin the defendants from distributing the motion picture Agatha. The plaintiffs also sought to prevent another defendant, Ballantine Books, from selling copies of the novel Agatha. Both the book and the movie involved a fictionalized account of Agatha Christie's eleven day disappearance in 1926, portraying her as an emotionally unstable woman, who engaged in a sinister plot to murder her husband's mistress in order to regain his affections. The court noted that "books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally

368. 75 A.D.2d 768, 427 N.Y.S.2d 828 (1980).
369. Id. at 769, 427 N.Y.S.2d at 829.
370. Id. at 768-69, 427 N.Y.S.2d at 829.
371. Id. at 768, 427 N.Y.S.2d at 829.
372. Id. at 769, 427 N.Y.S.2d at 829.
Acknowledging that there were no decisions on point involving publicity rights, the court turned to the privacy cases for guidance. The first case it examined was *Spahn v. Julian Messner, Inc.*, which had declared that “matters of news history, biography and other factual subjects of public interest” did not fall within the purview of the New York privacy statute even though the defendant made “necessary references to the names, portraits, identities, or histories of living persons.” The court in *Hicks* held that the same privileges and exemptions engrafted upon the privacy statute by *Spahn* also applied to publicity rights.

The court in *Hicks*, however, found that the biography privilege did not apply to *Agatha* because it was a fictionalization, not a factual biography. At the same time the court distinguished *Spahn*, which had held for the plaintiff, on the basis that the book in question was a deliberate falsification of the plaintiff’s life, while *Agatha* was an avowed fictionalization. Because the false light element that figured in the *Spahn* case was absent in *Hicks*, the court looked to another New York privacy case, *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.* The *Notre Dame* case involved the movie *John Goldfarb, Please Come Home*, a comedy in which a football team, identified as that of Notre Dame, appeared. The court found for the defendant since the events portrayed in the movie were not represented as being true and that a viewer of the film would certainly know that they were fictitious. Relying on the reasoning in the *Notre Dame* case, the court in *Hicks* concluded that the avowedly fictionalized account of Agatha Christie’s celebrated disappearance was similarly privileged under the first amendment and, therefore, the defendants were not liable for appropriating her publicity rights.
Frosch, Hicks and the other fictionalization cases are correct even though one might argue that there may be little difference between covert falsification in the manner of Spahn and avowed falsification as illustrated by Frosch or Hicks. Each type of publication reveals the sort of imagination and creativity that might justify first amendment protection, while each displays the same capacity to undermine publicity values. However, there is also a critical difference between the two classes of publication: in one instance the public is deceived, while in the other it is entertained. There is considerable social value in entertainment, but there is none in deception. Thus, the public interest that supports first amendment protection in cases of avowed fictionalization, is absent where fiction is passed off as truth.

3. Impersonations of Celebrities

As discussed earlier, impersonations of celebrities involve an appropriation of both performance values and recognition values. Two publicity rights cases, Groucho Marx Productions, Inc. v. Night & Day Co. and Estate of Presley v. Russen were decided in 1981 by federal district courts, which held that impersonations did not qualify as protected speech. Groucho Marx Productions involved an impersonation of the Marx Brothers by actors in the play A Day in Hollywood/A Night in the Ukraine. The defendants contended that the first amendment protected dramatic performances of literary works such as their play. While acknowledging that entertainment enjoys some first amendment protection, the court declared that the purpose or function of the entertainment must be scrutinized to determine whether it infringed upon the plaintiff's right of publicity. According to the court, works designed primarily to promote the dissemination of ideas or information through news or fictionalization are regarded as protected expression; however, works which make use of the plaintiff's name or likeness for commercial purposes, such as the sale of merchandise, fall outside the scope of any first amendment protection. The court in Groucho Marx Productions...
ductions rejected the notion that the play could be interpreted as a biographical sketch of the Marx Brothers, nor, in the court's opinion, could the play be privileged as entertainment or as satire, parody or burlesque.388 The refusal to extend first amendment protection to A Night in Hollywood was based on the court's view that the Ukraine segment of the play conveyed no ideas and was nothing more than a skillful imitation of the Marx Brothers' performances.389 Quoting from Estate of Elvis Presley, the court declared: "Although entertainment can merit first amendment protection, entertainment that merely imitates 'even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment.'"390 The defendants contended that the play was a parody of the Marx Brothers' performance and a comment "about 1930's Hollywood, its techniques, its stars and its excesses."391 Generally speaking, parody, satire and burlesque are regarded as forms of literary or social criticism and, consequently, are considered protected forms of expression.392 However, while the commentator or parodist is entitled to make use of another's work in order to create a larger presentation,393 he cannot merely imitate another's work without making his own creative contribution. In Groucho Marx Productions, the court found that any literary commentary intended by the author was substantially overshadowed by the wholesale appropriation of the Marx Brothers' characters.394 Accordingly, the court concluded that the play was not privileged and that the defendants had infringed upon the plaintiff's right of publicity.395

388. Id. at 492-93.
389. Id. at 492.
390. Id. at 493 (quoting Presley, 513 F. Supp. at 1359).
394. 523 F. Supp. at 493.
395. Id. The district court's decision in Groucho Marx was reversed by the Court of Appeals for the Second Circuit on September 10, 1982. 689 F.2d 317 (2d Cir. 1982). The court concluded that the descendibility of the Marx Brothers' rights of publicity was governed by California law rather than New York law and that publicity rights did not survive death in California. Id. at 318. Consequently, the court did not have to decide whether the play was protected expression as a literary work. The case, however, was remanded to the district court to consider the plaintiff's claims for false representation in violation of § 43 (a) of the Lanham Act, 15 U.S.C. § 1125(a) (1976), and claims under state law for misappropriation, interference with contractual relations, unfair competition, and infringement of common law copy.
The court reached a similar conclusion in *Estate of Presley v. Russen*, a case which involved an Elvis Presley impersonator. While conceding that the defendant's impersonation was entertaining and perhaps marginally informational in that it illustrated a performance of a legendary figure in the entertainment industry, the court nevertheless found that it was essentially an imitation, rather than a parody, burlesque or other critical commentary on Presley or his music. Thus, in the court's opinion, the primary objective of the show was to exploit the Presley image without contributing anything of substantial value in return.

Although the *Marx Brothers* and *Russen* decisions are similar, the defendant's position on the parody issue seems to have been stronger in the former case. While the performer in *Russen* did nothing to place his imitation of Elvis Presley in some sort of broader context, a great deal of creative effort went into the production of *Day and Night*. The plot and dialogue were original, evoking, rather than slavishly copying, the Marx Brothers' unique style of humor. Furthermore, the "Ukraine" sketch did not stand alone, but was part of a larger scheme. Apparently, the Ukraine portion expanded upon the themes and ideas that had been introduced in the earlier "Hollywood" segment of the play. If this is correct, the Marx Brothers' impersonation, as the defendants maintained, might have been a legitimate device for communicating the play's overall message.

4. Advertising and Memorabilia

Advertising and other commercial uses are inherently exploitative—they convey neither information nor ideas, instead they derive their appeal from the commercial value of the particular celebrity's name, likeness or other attribute. It is this utter dependence upon the celebrity's persona and the absence of socially valuable purposes in first amendment terms, rather than the commercial use per se,
which renders portrayals in this area more vulnerable to liability.\textsuperscript{402} Since advertising is normally considered a commercial use, courts are often willing to impose liability under either publicity or appropriation theories when a person's name or likeness is used without authorization for advertising purposes.\textsuperscript{403} An exception will sometimes be made, however, when factual information is conveyed about the product and no endorsement is suggested by use of the plaintiff's name or likeness. For example, in \textit{Rand v. Hearst Corp.},\textsuperscript{404} the court refused to find liability when the defendant placed on the cover of a book, \textit{Chaos Below Heaven}, by Eugene Vale, an excerpt from a critical review which declared that "Ayn Rand Enjoys . . . the Same Kind of Mystique Analysis as Vale . . . Their Underlying Drive is the Same." The court held that the first amendment protected publication of comments about an author's style and concluded that Ayn Rand's right to control the use of her name did not outweigh the defendant's right to reprint the review in an effort to inform the public of the nature of the book by comparing it to the works of another author.\textsuperscript{405}

A similar result was reached in \textit{Booth v. Curtis Publishing Co.},\textsuperscript{406} where the defendant published a picture of Shirley Booth in \textit{Holiday Magazine}. The magazine did feature a story on the Round Hill resort in the British West Indies and used the plaintiff as an example of the many prominent guests at the hotel. Since this was clearly newsworthy, the plaintiff did not object, but she did bring suit when the defendant published the same photograph in a subscription advertisement for \textit{Holiday} in other magazines. Since the advertisements expressly presented the plaintiff's photograph as a


\textsuperscript{405} Id. at 414, 298 N.Y.S.2d at 412.

sample of Holiday's contents, the court determined that it was merely incidental use and not collateral advertising. Therefore, recovery was denied.\textsuperscript{407} The same conclusion was reached in Namath v. Sports Illustrated.\textsuperscript{408} Photographs of Namath which appeared in 1969 in Sports Illustrated in connection with the New York Jets Super Bowl victory, were used several years later in advertisements to promote subscriptions. The court, relying on the Booth case, found the use to be outside the scope of the New York statute.\textsuperscript{409} This result seems incorrect, however, since the advertisements, which were placed in other magazines, used expressions like “How to get Close to Joe Namath” and “The man you love loves Joe Namath.” This went beyond merely using the photographs as an example of the magazine’s format and content; it involved conscious exploitation of the goodwill associated with Namath’s identity to promote magazine subscriptions.

Of course, advertising is not the only way in which a celebrity’s recognition values can be put to a commercial use. Placing his name or likeness on posters, clothing or other articles is another common form of commercial exploitation. Since these are not conventional media for the communication of ideas, one would expect first amendment protection to be denied in most instances. This is precisely what happened in Factors I,\textsuperscript{410} where the assignee of Elvis Presley’s publicity rights sought to enjoin the defendant, Pro Arts, from selling Elvis Presley posters. The defendant, relying on Paulsen v. Personality Posters,\textsuperscript{411} contended that publication of the Presley memorial poster commemorated a newsworthy event, the death of the singer, and therefore should have been regarded as a form of protected speech.\textsuperscript{412} In Paulsen, comedian Pat Paulsen, who was running a mock campaign for President, sued under the New York privacy statute to prevent the defendant from selling Pat Paulsen campaign posters.\textsuperscript{413} Recovery was denied on the theory that Paulsen’s presidential campaign was a newsworthy event and that the

\begin{itemize}
\item \textsuperscript{407} Id. at 350, 223 N.Y.S.2d at 744.
\item \textsuperscript{408} 80 Misc. 2d 531, 363 N.Y.2d 276, aff’d, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1975), aff’d, 39 N.Y.2d 897, 352 N.E.2d 584, 386 N.Y.S.2d 397 (1976).
\item \textsuperscript{409} Id. at 354-35, 363 N.Y.S.2d at 280.
\item \textsuperscript{410} 579 F.2d 215 (2d Cir. 1978), cert. denied, 440 U.S. 908 (1979).
\item \textsuperscript{411} 59 Misc. 2d 444, 299 N.Y.S.2d 501 (1968).
\item \textsuperscript{412} 579 F.2d at 222.
\item \textsuperscript{413} The plaintiff was depicted on the poster with a banner marked “1968” across his chest. The words “For President” appeared at the bottom. 59 Misc. 2d at 445, 299 N.Y.S.2d at 503.
\end{itemize}
defendant's poster was merely a form of comment about it. The court in Factors I, however, rejected the defendant's argument, holding that the Paulsen case was inapplicable. Accordingly, it concluded that Elvis Presley posters were not protected speech and that their sale by the defendant infringed upon the plaintiff's right of publicity.

The Factors I court was correct in rejecting Paulsen as controlling authority in a publicity case. Paulsen's mock presidential campaign was a satiric comment on the American political process, and therefore, he could hardly object if others took his idea a step further. In contrast, the Elvis Presley poster in Factors carried no social or political message. It was a blatant attempt to capitalize upon the public interest in Presley, which had arisen as the result of his death.

A second case, Current Audio, Inc. v. RCA Corp., also involved Elvis Presley. RCA had an exclusive right to manufacture and sell recordings of Elvis Presley songs as well as the sole right to use the singer's name and likeness in order to advertise its Presley recordings. The cover of Current Audio magazine depicted Elvis Presley at a recent press conference. Inside the magazine was a stereo record which included a two and one-half minute excerpt from the press conference. RCA brought suit against the magazine, alleging that Current Audio had infringed upon publicity rights assigned to it by Presley. Current Audio was a "mixed medium" publication which contained both written material in a conventional magazine format and a stereo record. The written segment of the magazine contained articles about Elvis Presley, Mick Jagger, Senator Edward Kennedy, Angela Davis and Charles Manson. The record, which had a total playing time of about 45 minutes, contained interviews and

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414. Id. at 449-50, 299 N.Y.S.2d at 507-08.
416. 579 F.2d at 222.
417. It should also be noted that Paulsen brought his action under the New York privacy statute. The court observed that since Paulsen had already licensed a company to sell buttons, stickers, and posters in connection with his mock political campaign, he could hardly claim the sort of mental anguish that traditionally was required in privacy actions. 59 Misc. 2d at 446, 451, 299 N.Y.S.2d at 504, 508. The court's refusal in Paulsen to acknowledge the economic nature of the plaintiff's injury which was reminiscent of O'Brien and Gautier, has been criticised by a student commentator. See Note, note 132 supra, at 555. In fairness to the court, however, it did discuss publicity rights and concluded that, as in the case of privacy, Paulsen's publicity interest would have to yield to the first amendment policy of encouraging political debate. 59 Misc. 2d at 450-51, 299 N.Y.S.2d at 508-09.
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comments by and about each of the topics or persons featured in the written sections of the magazine. Denying RCA's request for a temporary injunction, the court in Current Audio held that the right of publicity had no application to the use of a picture or name in connection with the dissemination of news and publications in the public interest, notwithstanding that such activities were carried on for a profit.419 According to the court, the Elvis Presley press conference was a noteworthy event, and, therefore, accounts of it were entitled to the first amendment protection.420 RCA contended that even if a report of the press conference was privileged, the recording in Current Audio was nothing more than a "commodity" and deserved no more protection than products like bubble gum. The court, however, noted the trend toward progressively expanding the ambit of protection to cover new forms of communication. Consequently, it concluded that the recording, like radio, television or a motion picture, was a suitable medium for the dissemination of thoughts, ideas and information about newsworthy events and matters of public concern.421 According to the court, the nature of the medium was not important as long as it had the capacity to disseminate ideas and information.422

If one views Current Audio magazine as a "hybrid medium" consisting of both a magazine and a recording which together communicate ideas and information about newsworthy subjects, it is then possible to distinguish the Current Audio case from Haelan Laboratories423 and Grant.424 Unlike Haelan Laboratories, where the baseball players' recognition values were being exploited to promote the sale of a collateral product, bubble gum, the recording was not used to sell the magazine, but was part of the magazine's medium of communication. The situation in Current Audio can also be distinguished from that in Grant because the subject matter in the recording was directly related to the material in the magazine. In Grant, Cary Grant's picture was used to illustrate an article on men's fashions. Liability was imposed because Grant had no connec-

419. Id. at 835, 337 N.Y.S.2d at 954.
420. Id. at 834, 337 N.Y.S.2d at 953.
421. Id. at 836, 337 N.Y.S.2d at 955.
422. Id. The court also observed that Presley was in no way "performing" at the press conference. The spontaneous give and take of an unrehearsed press conference was in the court's opinion of a wholly different character than the performance of a musical or artistic work. Id. at 834, 337 N.Y.S.2d at 953.
tion with the material in the article. It is probably fair to say, however, that Current Audio, like the Paulsen case discussed earlier, reflects a rather unusual factual situation. Consequently, the court's holding in that case is unlikely to be broadly applied in other publicity cases.

B. A "Fair Use" Analysis

A wide range of activities such as advertising, impersonation, publication of fictional or biographical works, and the manufacture of souvenir merchandise or memorabilia, give rise to potential conflicts between publicity rights and the first amendment. For the most part, there is general agreement at each end of the spectrum: factual accounts of newsworthy events or matters of public interest are privileged, while advertising or promotional uses are not. In the first instance the information content of the defendant's use is high, while in the second example it is not. The problem remains as to what to do about uses which fall between the extremes—those which incidentally disseminate ideas or information or which have some minimal element of creativity or artistic merit, but whose primary purpose is to entertain or amuse. Impersonations of entertainers, filmed recordings of actual performances or events, and perhaps board games fall into this category.

The following approach is suggested as a means of distinguishing between permitted uses of a celebrity's performance and recognition values and those which infringe upon his right of publicity. First, the use in question must have at least some intellectual or creative content. This threshold requirement reflects the underlying purposes of the first amendment—the protection of ideas. Once this threshold requirement is met, one must determine whether the defendant's use substantially impairs the existing or potential value of the plaintiff's publicity rights. The concept of fair use, as associated with the law of copyright, is a useful analytical tool for making such a determination.


Fair use is a privilege which allows others to use copyrighted material in a reasonable manner without the need to obtain the consent of the copyright owner.\(^{428}\) It reflects the notion that society should enjoy free access to copyrighted materials as long as the copyright holder’s right to exploit his copyright interest is not seriously impaired. In this manner the fair use doctrine seeks to support the constitutional policy of promoting the “progress of science and useful arts” by preventing the copyright monopoly from stifling the very creative forces it was intended to foster.\(^{429}\)

Procedurally, fair use is employed as a privilege or defense to a copyright infringement claim. In determining whether to treat the defendant’s action as a fair use in a copyright infringement suit the court generally considers three factors: the purpose and character of the use; the amount and substantiality of the portion used; and the degree to which the defendant’s use may prejudice the sale, diminish the profits, or supersede the objects of the original work.\(^{430}\)

The purpose and character of the offending publication is often a significant factor in determining whether or not it should be deemed a fair use. Thus, criticism, comment, news reporting, teaching, scholarship or research are generally treated as fair uses\(^{431}\) while ordinary commercial uses are seldom protected.\(^{432}\) The amount and substantiality of the portion used in relation to the copyrighted work as a whole is another consideration.\(^{433}\) The effect of the infringing use upon the potential market for, or value of, the copyrighted work


\(^{429}\) Iowa State Univ. Research Found., Inc. v. American Broadcasting Co., 621 F.2d 57, 60 (2d Cir. 1980).

\(^{430}\) See Mathews Conveyer Co. v. Palmer-Bee Co., 135 F.2d 73, 85 (6th Cir. 1943).


\(^{433}\) The question is whether the material used constitutes a substantial portion of the plaintiff’s, not the defendant’s, work. Although the quantitative relation of this material to plaintiff’s entire work is relevant, the qualitative aspects may be even more important. Thus, appropriating even a small amount of the plaintiff’s material may exceed the bounds of fair use if the portion taken is qualitatively significant. 3 M. Nimmer, Nimmer on Copyright § 13.05[A], at 13-61 (1979).
is perhaps the most important item to be weighed in determining fair use. This not only involves consideration of the injury to the plaintiff from the particular activity complained of, but also whether unrestricted and widespread conduct similar to that of the defendant would adversely affect the plaintiff's market.  

Section 107 of the 1976 Copyright Act enumerates some of the situations where fair use may be found. The statutory definition also incorporates a test which determines fair use by examining the nature or function of the use rather than merely focusing on the similarity between the copyrighted work and the defendant's product. According to this function test, if both the plaintiff's and the defendant's works are used for the same purpose, the defense of fair use will not be allowed. However, regardless of medium, if the defendant's work performs a different function from that of the plaintiff's work, the defense of fair use may be applicable even though the works contain substantially similar material. Thus, satire or parody is usually regarded as a fair use since it serves a different function—social commentary or literary criticism of the work upon which it is based. Similarly, conventional reviews, comments and criticisms of copyrighted material serve a different purpose than the original.

434. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1169 n.13 (9th Cir. 1977).
435. Section 107 of the Copyright Act of 1976 provides:

Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction of copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.


Using the same rationale, the fair use defense should be allowed in incidental use cases where quotations from song lyrics or similar copyrighted material are used to evoke the atmosphere of a particular time or place. Reproduction of an entire copyrighted piece, however, even when there is no similarity of function, will not be regarded as a fair use. By incorporating all or substantially all of the copied work, the distinction of function vanishes since verbatim reproduction will serve the function of the plaintiff's work as well as that of the defendant's.

Applying the function test to some of the cases reviewed earlier leads to some interesting conclusions. As one might expect, the approach works especially well where performance rights are involved. In Zacchini, for example, even though the defendant's purpose, dissemination of information, was different from that of the plaintiff, entertainment, the newscast of Zacchini's entire act arguably served the same function as far as audience needs were concerned. If only a portion of Zacchini's performance had been used, however, the broadcaster's case would have been much stronger. The purpose of the use would still have been different, but if only a small portion had been used, the defendant could have plausibly contended that audience interest in the performance itself would not have been diminished.

This analysis is also useful when the plaintiff is impersonated for entertainment purposes. Where the defendant simulates the plaintiff's "act" or performing style his imitation lessens the demand for future performances by the plaintiff. Where the sole purpose of the impersonation is to provide entertainment, it serves the same purpose as similar performances by the plaintiff and, therefore, should not be privileged. However, when the plaintiff is dead or no longer professionally active, impersonations obviously cannot impair


440. Wihol v. Crow, 309 F.2d 777, 780-81 (8th Cir. 1962) (photocopying of musical score for educational purposes not a fair use); Leon v. Pacific Tel. & Tel. Co., 91 F.2d 484, 486-87 (9th Cir. 1937) (use of data in plaintiff's telephone directory by publisher of rival directory not a fair use); Robert Stigwood Group, Ltd. v. O'Reilly, 346 F. Supp. 376, 384-85 (D.C. Conn. 1972) (performance of Jesus Christ Superstar by religious group not a fair use).

441. 3 M. Nimmer, Nimmer on Copyright § 13.05[D], at 13-72.1 (1977).


443. Impersonation of the plaintiff for entertainment purposes should be distinguished from impersonation in commercials. In the latter situation, where the purpose is to sell a collateral product, the defendant's use usually will be regarded as commercial use because it does not communicate ideas or information.
the market for future live performances by the plaintiff and, therefore, only the economic value of past recorded performances would be affected. Where the recorded performances—movies, records, videotape, etc.—are copyrighted, the plaintiff will be required to base his case on copyright infringement, thus allowing the defendant to raise the fair use issue.444 This author contends that the same principle should be applied when the plaintiff bases his action on interference with publicity rights instead of copyright infringement.445

The function test admittedly does not fare as well when other types of recognition values are appropriated by the defendant. The test is better suited to situations where the defendant’s use can be compared with that of the plaintiff in order to determine if they both serve the same function in the market place. In the case of performances or impersonations, the defendant’s product can be compared with the plaintiff’s. When the defendant merely appropriates the plaintiff’s persona, however, a comparison is more difficult because of the intangible nature of the plaintiff’s interest. Therefore, instead of comparing the defendant’s infringing use with a specific work of the plaintiff, the court must inquire as to whether the offending use interferes with the plaintiff’s ability to exploit his recognition values in some traditional manner. This involves a consideration of both the nature and purpose of the defendant’s use as well as its impact on the market for the plaintiff’s persona. The policy behind this approach is the same one that underlies the fair use doctrine; that is, free expression should only be restricted when the plaintiff’s economic interests are directly threatened.446 To some degree, the policy also reflects the unfair competition aspects of the right of publicity. Since recognition values are usually exploited either by advertising or by the sale of posters and other memorabilia, comparable uses by others should generally be regarded as improper.447 Conversely, ac-

444. If the recorded performances were not copyrighted, the plaintiff might invoke the concept of common law copyright; however, the fair use doctrine may perhaps also apply to common law copyright. Cf. Estate of Hemingway v. Random House, Inc., 23 N.Y.2d 341, 244 N.E.2d 250, 296 N.Y.S.2d 771 (1968).

445. Of course, it might make a difference whether the defendant’s impersonation is live or on film. A court might conclude that a filmed impersonation might impair the market for filmed performances of the plaintiff, while finding a dissimilarity of function with respect to a live performance by the defendant.

446. Felcher and Rubin have reached a similar conclusion by arguing that media portrayals of celebrities must cause identifiable harm before relief is granted. Felcher & Rubin, note 12 supra, at 1608-16.

447. Thus, for example, baseball cards, which contain information about the players, might be regarded as commercial when they are used to promote the sale of a collateral product, even though the same pictures and information might be treated as a fair use when merely placed in a book or magazine about baseball.
tivities such as use of the plaintiff’s name or likeness in news accounts, fictional works, or educational works, which do not interfere with the celebrity’s market for advertising or memorabilia, should ordinarily qualify as legitimate uses. Similarly, use of the plaintiff’s likeness in original works of art, such as paintings or statues, should be privileged since recognition values are not typically exploited in this manner. Mass-produced objects, such as posters or the statuettes involved in Memphis Development, however, are conventionally regarded as commercial exploitation and, as such, directly compete with the celebrity’s efforts to capitalize upon his recognition values by marketing similar products.

Board games, such as those involved in the Uhlaender and Palmer cases, are more difficult to evaluate. Although these games no doubt communicate information, their avowed purpose is to entertain. In that sense they are distinguishable from newspapers and magazines, where the informational function is primary rather than merely incidental. Unlike Haelan Laboratories, however, which involved bubble gum cards, the plaintiff’s recognition values are not being used to sell a collateral product. Therefore, one might contend that the defendant’s use is analogous to the incidental use concept in copyright law, permissible as long as player names are simply used to make the game more realistic. In a close case, the issue may turn on whether publicity values are customarily exploited in this particular medium. Thus, as in the Uhlaender case, where the plaintiff and others have already transferred their publicity rights for this purpose, the court might conclude that the defendant’s use of his name and likeness should not be allowed.

The interface between first amendment values and publicity rights is a complex one. It is obvious, therefore, that no single concept can resolve every clash between the social commitment to free expression and the economic interests of performers and celebrities. However, the function test appears to be a useful analytical tool for courts to use in their search for an alternative solution to these conflicts.

450. For a contrary view, see Treece, note 3 supra, at 666-68.
CONCLUSION

After almost thirty years, the law of publicity still resembles a “haystack in a hurricane” and shows no sign of settling down in the near future. Indeed, each new case seems to raise additional problems instead of providing answers to existing ones. In view of this rather discouraging outlook, one might question whether the right of publicity is a useful concept. After making allowances for the restrictions imposed on the right of publicity by federal copyright law and the first amendment, does anything remain which could not be nestled comfortably under the theory of unfair competition?

In this author’s opinion, the right of publicity can be a helpful theory for protecting performance and, particularly, recognition values. Analytically, the right of publicity could be classified as a form of unfair competition. Although it goes beyond the scope of the traditional passing off theory, the right of publicity does strongly resemble the misappropriation doctrine. Nevertheless, it is better to treat the right of publicity as distinct from misappropriation. The misappropriation doctrine is a somewhat discredited concept which has been expressly rejected in a number of jurisdictions. Rather than foreclosing the possibility of protecting publicity rights in those states, the preferable course of action is to disclaim any association with misappropriation, and allow the right of publicity to rest on its own bottom. Another advantage of distinguishing the right of publicity from other forms of unfair competition is that it allows one to emphasize the assignable and descendible nature of the right.

Notwithstanding the conceptual utility of publicity rights, there are serious problems associated with this doctrine that must eventually be resolved. Perhaps the most urgent problem is the survivability issue. From the celebrity’s viewpoint, one of the most significant advantages of the right of publicity over privacy actions and conventional forms of unfair competition is the prospect that the right will survive death and, therefore, serve as a mechanism for benefitting one’s family. For this reason, some post mortem protection of publicity values is justified, but only if reasonable limits are placed on the duration of such rights. To date, the courts have not effectively responded to this concern and in all probability a legislative solution will eventually become necessary.

Given the nature of the market in which publicity rights operate, the lack of uniformity among the states with respect to the na-

ture, scope and duration of publicity rights represents another serious problem. One solution is to reduce the importance of publicity rights by deciding that they have been drastically restricted by the preemption provisions of the 1976 Copyright Act. Although the language of section 301 does not support such an approach, some sort of federal legislative intervention in this area may be necessary to provide an element of uniformity to the law of publicity so that it does not impose an unreasonable burden on interstate commerce.

Finally, more attention needs to be given to the conflict between publicity rights and first amendment considerations. The concepts that have traditionally been employed for this purpose in appropriation cases are helpful; in addition, the function test, derived from the fair use doctrine of copyright law, is another useful concept.

Hopefully, solutions will eventually be found to many of the problems that have been discussed in this article. In the meantime, the right of publicity will no doubt continue to challenge the ingenuity of judges and scholars.