

# Entertainment Law

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## Lawyers For The Talent

by Richard Dooling

### Right of Publicity

Appropriation/Celebrity/Publicity Rights

One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy.

[Restatement 2nd of Torts 652C: Appropriation of Name or Likeness](#)

The right of publicity, also known by far too many other names (personality rights, celebrity rights, publicity rights, appropriation of name or likeness), is the right of an individual to control the commercial use of his or her name, image, likeness, or other unequivocal aspects of one's identity. It is generally considered a property right as opposed to a personal right, and as such, the validity of the right of publicity can survive the death of the individual (to varying degrees depending on the jurisdiction).

Personality rights are generally considered to consist of two types of rights:

1. The right of publicity, or to keep one's image and likeness from being commercially exploited without permission or contractual compensation, which is similar to the use of a trademark;
2. The right to privacy, or the right to be left alone and not have one's personality represented publicly without permission.

[Wikipedia: Personality Rights](#)

### Early “right of publicity” cases

Early right of publicity cases followed the lead of the Brandeis “Right Of Privacy” article, which spoke of compensating “injury to the feelings.” For instance, in *Roberson v. Rochester Folding Box Company*, a 1902 New York case, Abigail Roberson’s picture was reproduced on 25,000 copies of a poster advertising flour without her knowledge. She sued the flour company claiming, not that she should have been paid for the use of her image, but that use of the image without her permission had injured her:

That those 25,000 likenesses of the plaintiff ... have been conspicuously posted and displayed in stores, warehouses, saloons and other public places; that they have been recognized by friends of the plaintiff and other people with the result that plaintiff has been greatly humiliated by the scoffs and jeers of persons who have recognized her face and picture on this advertisement and her good name has been attacked, causing her great distress and suffering both in body and mind; that she was made sick and suffered a severe nervous shock, was confined to her bed and compelled to employ a physician.

The court went on to observe that this was a brand new cause of action, and that it was different than other torts:

It will be observed that there is no complaint made that plaintiff was libeled by this publication of her portrait. The likeness is said to be a very good one, and one that her friends and acquaintances were able to recognize; indeed, her grievance is that a good portrait of her, and, therefore, one easily recognized, has been used to attract attention toward the paper upon which defendant mill company’s advertisements appear. Such publicity, which some find agreeable, is to plaintiff very distasteful, and thus, because of defendants’ impertinence in using her picture without her consent for their own business purposes, she has been caused to suffer mental distress where others would have appreciated the compliment to their beauty implied in the selection of the picture for such purposes; but as it is distasteful to her, she seeks the aid of the courts to enjoin a further circulation of the lithographic prints containing her portrait made as alleged in the complaint, and as an incident thereto, to reimburse her for the damages to her feelings, which the complaint fixes at the sum of \$ 15,000.

When Roberson lost her case because the New York Court of Appeals held that the facts of her case stated no known cause of action, the ensuing public

outrage led the New York state legislature to create the state's first right of privacy statute.

Likewise, three years later, in *Pavesich v. New England Mutual Life Insurance*, (GA 1905), Atlanta artist Paolo Pavesich sued when his photo was used (without his permission) in a newspaper ad for life insurance. The ad featured a photo of Pavesich, a prosperous, happy, contented person who wisely purchased life insurance, opposite a photo of a thin, haggard looking man who had not bought insurance. Georgia became the first state to recognize the right of privacy in common law when they awarded Pavesich \$25,000 in personal damages due to the invasion.

Pavesich, an artist by profession, sued claiming that he "never has had a policy of life insurance with the defendant company," and that the publication "tends to bring plaintiff into ridicule before the world, and especially with his friends and acquaintances, who know that he has no policy in the defendant company."

The publication is a "trespass upon plaintiff's right of privacy, and was caused by breach of confidence and trust reposed" in the defendant Adams. The prayer was for damages in the sum of \$25,000. The petition was demurred to generally, and specially on the grounds that there was a misjoinder of defendants and causes of action, that no facts were set forth from which malice can be inferred, and that no special damages were alleged. The court sustained the general demurrer, and the plaintiff excepted.

Eventually, this "likeness" branch of the "right of privacy" was refined. The notion of "hurt feelings" caused by gossip or intrusive technology persisted in other branches of the privacy tort (intrusion, false light, publication of private facts), but the right of publicity took a different turn. An individual's name, image, and likeness became a species of property to be licensed.

## Eugene Volokh

### FREEDOM OF SPEECH AND THE RIGHT OF PUBLICITY

The right of publicity, in the words of the Restatement (Third) of Unfair Competition section 46, bars people from "appropriat[ing] the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade." Similarly, statutes such as California Civil Code section 3344 bar "us[ing] another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services."

Under standard First Amendment doctrine, this definition can't be accepted at face value—and in fact many lower courts have held that the First Amendment precludes right of publicity liability in many cases. For instance, an unauthorized biography is certainly a “product” and an item in “trade” that benefits from the “commercial value of [its subject's] identity”; it uses the subject's name and often his photograph in goods (the biography itself); and yet unauthorized biographies are constitutionally protected from liability. Likewise for magazine or newspaper articles that focus on or mention unconsenting subjects, and that may often even include the subject's name and likeness on the front page as a means of capitalizing on the “commercial value” of the subject's identity.

Eugene Volokh, *Freedom of Speech and the Right of Publicity*, Houston Law Review 40 (2003)

## Major Right Of Publicity Cases

### *ML King Jr. Center v. American Heritage Products*

Georgia Supreme Court (1982)

- [case on Google Scholar](#)
- [case on Westlaw](#)
- [Casebrief](#).

HILL, Presiding Justice.

[American Heritage Products and its sole proprietor James Bolen developed the concept of marketing a plastic bust of Dr. Martin Luther King, Jr. Although Bolen sought the endorsement and participation of the Martin Luther King, Jr. Center for Social Change, Inc., in the marketing of the bust, the Center refused Bolen's offer. Bolen pursued the idea, nevertheless, hiring an artist to prepare a mold and an agent to handle the promotion of the product. Defendant took out two half-page advertisements in the November and December 1980 issues of Ebony magazine, which purported to offer the bust as “an exclusive memorial” and “an opportunity to support the Martin Luther King, Jr., Center for Social Change.” The advertisement stated that “a contribution from your order goes to the King Center for Social Change.” Out of the \$29.95 purchase price, defendant Bolen testified he set aside 3% or \$.90, as a contribution to the Center. The advertisement also offered “free” with the purchase of the bust a booklet about the life of Dr. King entitled “A Tribute to Dr. Martin Luther King, Jr.”]

[Instead of accepting the monies offered by Bolen, the Martin Luther King, Jr. Center for Social Change (the Center), Coretta Scott King, as administratrix of Dr. King's estate, and Motown Record Corporation, the assignee of the rights to several of Dr. King's copyrighted speeches filed suit against Bolen and American Heritage Products.]

The right of publicity may be defined as a celebrity's right to the exclusive use of his or her name and likeness. *Price v. Hal Roach Studios*, (S.D.N.Y. 1975); *Estate of Presley v. Russen*, (D.N.J. 1981), and cases cited. The right is most often asserted by or on behalf of professional athletes, comedians, actors and actresses, and other entertainers. This case involves none of those occupations. As is known to all, from 1955 until he was assassinated on April 4, 1968, Dr. King, a Baptist minister by profession, was the foremost leader of the civil rights movement in the United States. He was awarded the Nobel Prize for Peace in 1964. Although not a public official, Dr. King was a public figure, and we deal in this opinion with public figures who are neither public officials nor entertainers. Within this framework, we turn to the questions posed.

### **1. Is the "right of publicity" recognized in Georgia as a right distinct from the right of privacy?**

Georgia has long recognized the right of privacy. Following denial of the existence of the right of privacy in a controversial decision by the New York Court of Appeals in *Roberson v. Rochester Folding Box Co.*, (1902), the Georgia Supreme Court became the first such court to recognize the right of privacy in *Pavesich v. New England Life Ins. Co.*, (1905).

In *Pavesich v. New England Life Ins. Co.*, *supra*, the picture of an artist was used without his consent in a newspaper advertisement of the insurance company. Analyzing the right of privacy, this court held: "The publication of a picture of a person, without his consent, as a part of an advertisement, for the purpose of exploiting the publisher's business, is a violation of the right of privacy of the person whose picture is reproduced, and entitles him to recover without proof of special damage." If the right to privacy had not been recognized, advertisers could use photographs of private citizens to promote sales and the professional modeling business would not be what it is today.

In the course of its opinion the *Pavesich* court said several things pertinent here. It noted that the commentators on ancient law recognized the right of personal liberty, including the right to exhibit oneself before the public at proper times and places and in a proper manner. As a corollary, the court recognized that the right of personal liberty included the right of a person not to be exhibited before the public, saying: "The right to withdraw from the public gaze at such times as a person may see fit, when his presence in public is not demanded

by any rule of law is also embraced within the right of personal liberty. Publicity in one instance and privacy in the other is each guaranteed. If personal liberty embraces the *right of publicity*, it no less embraces the correlative right of privacy; and this is no new idea in Georgia law." (Emphasis supplied.) *Pavesich*.

Recognizing the possibility of a conflict between the right of privacy and the freedoms of speech and press, this court said: "There is in the publication of one's picture for advertising purposes not the slightest semblance of an expression of an idea, a thought, or an opinion, within the meaning of the constitutional provision which guarantees to a person the right to publish his sentiments on any subject." *Id.* The defendants in the case now before us make no claim under these freedoms and we find no violation thereof.

Observing in dicta that the right of privacy in general does not survive the death of the person whose privacy is invaded, the *Pavesich* court said: "While the right of privacy is personal, and may die with the person, we do not desire to be understood as assenting to the proposition that the relatives of the deceased can not, in a proper case, protect the memory of their kinsman, not only from defamation, but also from an invasion into the affairs of his private life after his death. This question is not now involved, but we do not wish anything said to be understood as committing us in any way to the doctrine that against the consent of relatives the private affairs of a deceased person may be published and his picture or statue exhibited." *Id.*

Finding that *Pavesich*, although an artist, was not recognized as a public figure, the court said: "It is not necessary in this case to hold, nor are we prepared to do so, that the mere fact that a man has become what is called a public character, either by aspiring to public office, or by holding public office, or by exercising a profession which places him before the public, or by engaging in a business which has necessarily a public nature, gives to everyone the right to print and circulate his picture." *Id.* Thus, although recognizing the right of privacy, the *Pavesich* court left open the question facing us involving the likeness of a public figure...

In *Palmer v. Schonhorn Enterprises*, (N.J.Sup.Ct. 1967), Arnold Palmer, Gary Player, Doug Sanders and Jack Nicklaus obtained summary judgment against the manufacturer of a golf game which used the golfers' names and short biographies without their consent. Although written as a right of privacy case, much of what was said is applicable to the right of publicity. In its opinion the court said (*Id.*):

It would therefore seem, from a review of the authorities, that although the publication of biographical data of a well-known figure does not per se constitute an invasion of privacy, the use of that same data for the purpose of capitalizing upon the name by using it in

connection with a commercial project other than the dissemination of news or articles or biographies does.

The names of plaintiffs have become internationally famous, undoubtedly by reason of talent as well as hard work in perfecting it. This is probably true in the cases of most so-called celebrities, who have attained national or international recognition in a particular field of art, science, business or other extraordinary ability. They may not all desire to capitalize upon their names in the commercial field, beyond or apart from that in which they have reached their known excellence. However, because they presently do not should not be justification for others to do so because of the void. They may desire to do it later. . . . It is unfair that one should be permitted to commercialize or exploit or capitalize upon another's name, reputation or accomplishments merely because the owner's accomplishments have been highly publicized."

In *Haelan Laboratories, supra*, the court was concerned with whether a celebrity has the right to the exclusive use of his or her name and likeness. In *Palmer, supra*, the court was concerned with whether a person using the celebrity's name for the user's commercial benefit has the right to do so without authorization. At this point it should be emphasized that we deal here with the unauthorized use of a person's name and likeness for the commercial benefit of the user, not with a city's use of a celebrity's name to denominate a street or school...

The right of publicity was first recognized in Georgia by the Court of Appeals in *Cabaniss v. Hipsley, (1966)*. There the court held that the plaintiff, an exotic dancer, could recover from the owner of the Atlanta Playboy Club for the unauthorized use of the dancer's misnamed photograph in an entertainment magazine advertising the Playboy Club. Although plaintiff had had her picture taken to promote her performances, she was not performing at the Playboy Club. The court used Dean William L. Prosser's four-pronged analysis of the right of privacy, saying: ". . . there are four distinct kinds of invasion of four different interests of plaintiff; that there are four disparate torts under a common name. These four torts may be described briefly as:

1. intrusion upon the plaintiff's seclusion or solitude, or into his private affairs;
2. public disclosure of embarrassing private facts about the plaintiff;
3. publicity which places the plaintiff in a false light in the public eye;
4. appropriation, for the defendant's advantage, of the plaintiff's name or likeness."

*Id.* at 370. Finding no violation of the first three rights of privacy, the court found a violation of the fourth, saying (*Id.* at 377):

Unlike intrusion, disclosure, or false light, appropriation does not require the invasion of something secret, secluded or private pertaining to plaintiff, nor does it involve falsity. It consists of the appropriation, for the defendant's benefit, use or advantage, of the plaintiff's name or likeness. . . . "The interest protected (in the 'appropriation' cases) is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity."

Although Ms. Hipsley was an entertainer (i.e., a public figure), the court found she was entitled to recover from the Playboy Club (but not from the magazine which published the Club's ad) for the unauthorized use of her photograph. However the court noted a difference in the damages recoverable in traditional right of privacy cases as opposed to right of publicity cases saying (*Id.* at 378):

Recognizing, as we do, the fundamental distinction between causes of action involving injury to feelings, sensibilities or reputation and those involving an appropriation of rights in the nature of property rights for commercial exploitation, it must necessarily follow that there is a fundamental distinction between the two classes of cases in the measure of damages to be applied. In the former class (which we take to include the intrusion, disclosure, and false light aspects of the privacy tort), general damages are recoverable without proof of special damages. *Pavesich v. New England Life Ins. Co.*, *supra*. In the latter class, the measure of damages is the value of the use of the appropriated publicity.

In *McQueen v. Wilson*, reversed on other grounds, 224 Ga. 420 (1968), the Court of Appeals upheld the right of an actress, Butterfly McQueen, who appeared as "Prissie" in the movie *Gone With the Wind*, to recover for the unauthorized use of her photograph, saying: "Both before and since *Pavesich* it has been recognized that the appropriation of another's identity, picture, papers, name or signature without consent and for financial gain might be a tort for which an action would lie. . . ."

Thus, the courts in Georgia have recognized the rights of private citizens, *Pavesich*, *supra*, as well as entertainers, *Cabaniss* and *McQueen*, *supra*, not to have their names and photographs used for the financial gain of the user without their consent, where such use is not authorized as an exercise of freedom of the press. We know of no reason why a public figure prominent in religion



and civil rights should be entitled to less protection than an exotic dancer or a movie actress. Therefore, we hold that the appropriation of another's name and likeness, whether such likeness be a photograph or sculpture, without consent and for the financial gain of the appropriator is a tort in Georgia, whether the person whose name and likeness is used is a private citizen, entertainer, or as here a public figure who is not a public official.

In *Pavesich*, *supra*, 122 Ga. 190, this right not to have another appropriate one's photograph was denominated the right of privacy; in *Cabaniss v. Hipsley*, *supra*, 114 Ga. App. 367, it was the right of publicity. Mr. Pavesich was not a public figure; Ms. Hipsley was. We conclude that while private citizens have the right of privacy, public figures have a similar right of publicity, and that the measure of damages to a public figure for violation of his or her right of publicity is the value of the appropriation to the user...

## **2. Does the "right of publicity" survive the death of its owner (i.e., is the right inheritable and devisable)?**

Although the *Pavesich* court expressly did not decide this question, the tenor of that opinion is that the right to privacy at least should be protectable after death. *Pavesich*, *supra*, 122 Ga. at 210 (50 SE at 76).

The right of publicity is assignable during the life of the celebrity, for without this characteristic, full commercial exploitation of one's name and likeness is practically impossible. *Haelan Laboratories v. Topps Chewing Gum*, *supra*. That is, without assignability the right of publicity could hardly be called a "right." Recognizing its assignability, most commentators have urged that the right of publicity must also be inheritable.

The courts that have considered the problem are not as unanimous. In *Price v. Hal Roach Studios*, *supra*, the court reasoned that since the right of publicity was assignable, it survived the deaths of Stanley Laurel and Oliver Hardy. Other decisions from the Southern District of New York recognize the descendibility of the right of publicity, which has also been recognized by the Second Circuit Court of Appeals.

In *Factors Etc., Inc. v. Pro Arts, Inc.*, (2d Cir. 1978), Elvis Presley had assigned his right of publicity to Boxcar Enterprises, which assigned that right to Factors after Presley's death. Defendant Pro Arts published a poster of Presley entitled "In Memory." In affirming the grant of injunction against Pro Arts, the Second Circuit Court of Appeals said (*Id.* at 221):

The identification of this exclusive right belonging to Boxcar as a transferable property right compels the conclusion that the right survives Presley's death. 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 income interest, continually produced from Boxcar's exclusive right of commercial exploitation, should inure to Presley's estate at death like any other intangible property right. 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...

In *Lugosi v. Universal Pictures*, (1979), the Supreme Court of California, in a 4 to 3 decision, declared that the right of publicity expires upon the death of the celebrity and is not descendible. Bela Lugosi appeared as Dracula in Universal Picture's movie by that name. Universal had acquired the movie rights to the novel by Bram Stoker. Lugosi's contract with Universal gave it the right to exploit Lugosi's name and likeness in connection with the movie. The majority of the court held that Lugosi's heirs could not prevent Universal's continued exploitation of Lugosi's portrayal of Count Dracula after his death. The court did not decide whether Universal could prevent unauthorized third parties from exploitation of Lugosi's appearance as Dracula after Lugosi's death...

For the reasons which follow we hold that the right of publicity survives the death of its owner and is inheritable and devisable.

**WELTNER, Justice, concurring specially.**

I concur specially because, although this matter is one of certified questions, I believe that the complaint states a claim upon which relief can be granted. I disagree most decidedly with the substantive portion of the majority opinion, for reason that it generates more unsettling questions than it resolves.

In this opinion, we have taken the "right of privacy" as enumerated in *Pavesich*, *supra*, and added thereto a new thing, now called a "right of publicity." That seems to me to be more an exercise in verbal juxtaposition than a careful examination of legal issues and practical results.

At heart, the whole body of tort law is but an expression of what the community perceives to be the civil, as opposed to moral or ethical, responsibility of its members to each other. That concept changes with the cumulative experiences and assessments of succeeding generations, through constitutional, legislative, and judicial pronouncement. And well it should, for, in Thomas Jefferson's words, "Laws and institutions must go hand in hand with the progress of the human mind."

*Pavesich*, as example, found that it was contrary to good conscience (the conscience, that is, of the community as delineated and declared by this Court) that New England Life Insurance Company, for financial gain, might expropriate an

aspect of the personality of Paolo Pavesich by the unauthorized publication of his photograph. That conduct did not meet community standards, as assayed by our Court in the year 1905. Because a remedy must need be provided, we became the first high court in the Republic to “discover” a new right — the right to privacy...

Our ancient maxim — “for every right a remedy” — is, in truth, stated hind part before. The *reality* of the judicial process is this: wherever there *ought* to be a remedy, the Court will declare a corresponding right...

Why, then, this exercise?

Because in proclaiming this new “right of publicity,” we have created an open-ended and ill-defined force which jeopardizes a right of unquestioned authenticity — free speech...

But the majority says that the fabrication and commercial distribution of a likeness of Dr. King is not “speech,” thereby removing the inquiry from the ambit of First Amendment or Free Speech inquiries.

To this conclusion I most vigorously dissent. When our Constitution declares that anyone may “speak, write and publish his sentiments, on all subjects” it does not confine that freedom exclusively to verbal expression. Human intercourse is such that oftentimes the most powerful of expressions involve no words at all, e.g., Jesus before Pilate; Thoreau in the Concord jail; King on the bridge at Selma.

Do not the statues of the Confederate soldiers which inhabit so many of our courthouse squares express the sentiments of those who raised them?

Are not the busts of former chief justices, stationed within the rotunda of this very courthouse, expressions of sentiments of gratitude and approval?

Is not the portrait of Dr. King which hangs in our Capitol an expression of sentiment?

Manifestly so.

If, then, a two-dimensional likeness in oil and canvas is an expression of sentiment, how can it be said that a three-dimensional likeness in plastic is *not*?

But, says the majority, our new right to publicity is violated only in cases involving financial gain.

Did the sculptors of our Confederate soldiers, and of our chief justices, labor without gain? Was Dr. King’s portraitist unpaid for his work?

If “financial gain” is to be the watershed of violation *vel non* of this new-found right, it cannot withstand scrutiny. It is rare, indeed, that any expression of sentiment beyond casual conversation is not somehow connected, directly or indirectly, to “financial gain.” For example, a school child wins a \$25 prize for the best essay on Dr. King’s life. Is this “financial gain?” Must the child then account for the winnings?

The essay, because of its worth, is reprinted in a commercial publication. Must the publisher account?

The publication is sold on the newsstand. Must the vendor account?

The majority will say “free speech.” Very well. The same child wins a \$25 prize in the school art fair. His creation — a bust of Dr. King.

Must he account?

The local newspaper prints a photograph of the child and of his creation. Must it account?

UNICEF reproduces the bust on its Christmas cards. Must it account?

Finally, a purely commercial venture undertakes to market replicas of the bust under circumstances similar to those of this case. Must it account?

Obviously, the answers to the above questions will vary, and properly so, because the circumstances posited are vastly different. The dividing line, however, cannot be fixed upon the presence or absence of “financial gain.” Rather, it must be grounded in the community’s judgment of what, *ex aequo et bono*, is unconscionable.

Were it otherwise, this “right of publicity,” fully extended, would eliminate scholarly research, historical analysis, and public comment, because food and shelter, and the financial gain it takes to provide them, are still essentials of human existence.

Were it otherwise, no newspaper might identify any person or any incident of his life without accounting to him for violation of his “right to publicity.”

Were it otherwise, no author might refer to any event in history wherein his reference is identifiable to any individual (or his heirs!) without accounting for his royalties.

A careful analysis of the right of free speech yields conclusions not inconsistent with the above. *All* speech is not “free,” in the sense of being immune from all consequence.

### **Zacchini v. Scripps-Howard Broadcasting Co.**

United States Supreme Court (1977)

- [Case on Google Scholar](#)
- [Case on Westlaw](#)
- [Case on Wikipedia](#)

[In the following excerpts, “Petitioner” has been changed to “Zacchini,” and “Respondent” has been changed to “the TV station.” - RD]

MR. JUSTICE WHITE delivered the opinion of the Court.

Petitioner, Hugo Zacchini, is an entertainer. He performs a “human cannon-ball” act in which he is shot from a cannon into a net some 200 feet away. Each

performance occupies some 15 seconds. In August and September 1972, Zacchini was engaged to perform his act on a regular basis at the Geauga County Fair in Burton, Ohio. He performed in a fenced area, surrounded by grandstands, at the fair grounds. Members of the public attending the fair were not charged a separate admission fee to observe his act.

On August 30, a freelance reporter for Scripps-Howard Broadcasting Co., the operator of a television broadcasting station and respondent in this case, attended the fair. He carried a small movie camera. Zacchini noticed the reporter and asked him not to film the performance. The reporter did not do so on that day; but on the instructions of the producer of respondent's daily newscast, he returned the following day and videotaped the entire act. This film clip, approximately 15 seconds in length, was shown on the 11 o'clock news program that night, together with favorable commentary.

Zacchini then brought this action for damages, alleging that he is "engaged in the entertainment business," that the act he performs is one "invented by his father and . . . performed only by his family for the last fifty years," that the TV station "showed and commercialized the film of his act without his consent," and that such conduct was an "unlawful appropriation of plaintiff's professional property." The TV station answered and moved for summary judgment, which was granted by the trial court.

The Court of Appeals of Ohio reversed. The majority held that Zacchini's complaint stated a cause of action for conversion and for infringement of a common-law copyright, and one judge concurred in the judgment on the ground that the complaint stated a cause of action for appropriation of petitioner's "right of publicity" in the film of his act. All three judges agreed that the First Amendment did not privilege the press to show the entire performance on a news program without compensating petitioner for any financial injury he could prove at trial.

Like the concurring judge in the Court of Appeals, the Supreme Court of Ohio rested Zacchini's cause of action under state law on his "right to publicity value of his performance." The opinion syllabus, to which we are to look for the rule of law used to decide the case, declared first that one may not use for his own benefit the name or likeness of another, whether or not the use or benefit is a commercial one, and second that the TV station would be liable for the appropriation, over Zacchini's objection and in the absence of license or privilege, of Zacchini's right to the publicity value of his performance. The court nevertheless gave judgment for the TV station because, in the words of the syllabus:

"A TV station has a privilege to report in its newscasts matters of legitimate public interest which would otherwise be protected by an individual's right of publicity, unless the actual intent of the TV sta-

tion was to appropriate the benefit of the publicity for some non-privileged private use, or unless the actual intent was to injure the individual." *Ibid.*

We granted certiorari ... to consider an issue unresolved by this Court: whether the First and Fourteenth Amendments immunized the TV station from damages for its alleged infringement of Zacchini's state-law "right of publicity." Insofar as the Ohio Supreme Court held that the First and Fourteenth Amendments of the United States Constitution required judgment for the TV station, we reverse the judgment of that court.

## I

...

[In deciding the crucial question of whether the TV station had a privilege to film and televise Zacchini's performance, the Ohio Supreme Court relied on *Time, Inc. v. Hill*, (S.Ct. 1967), a case involving First Amendment limitations on state tort actions. It read both *Hill* and *New York Times Co. v. Sullivan*, (S.Ct. 1964), to stand for the proposition that "the press has a privilege to report matters of legitimate public interest even though such reports might intrude on matters otherwise private," and concluded, therefore, that the press is also "privileged when an individual seeks to publicly exploit his talents while keeping the benefits private." The privilege thus exists in cases "where appropriation of a right of publicity is claimed." The Ohio Supreme Court concluded that "since the gravamen of the issue in this case is not whether the degree of intrusion is reasonable, but whether *First Amendment principles* require that the right of privacy give way to the public right to be informed of matters of public interest and concern, the concept of privilege seems the more useful and appropriate one."]

## II

The Ohio Supreme Court held that the TV station is constitutionally privileged to include in its newscasts matters of public interest that would otherwise be protected by the right of publicity, absent an intent to injure or to appropriate for some nonprivileged purpose. If under this standard the TV station had merely reported that Zacchini was performing at the fair and described or commented on his act, with or without showing his picture on television, we would have a very different case. But Zacchini is not contending that his appearance at the fair and his performance could not be reported by the press as newsworthy items. His complaint is that the TV station filmed his entire act and displayed that film on television for the public to see and enjoy. This, he claimed, was

an appropriation of his professional property. The Ohio Supreme Court agreed that Zacchini had “a right of publicity” that gave him “personal control over commercial display and exploitation of his personality and the exercise of his talents.” This right of “exclusive control over the publicity given to his performances” was said to be such a “valuable part of the benefit which may be attained by his talents and efforts” that it was entitled to legal protection. It was also observed, or at least expressly assumed, that Zacchini had not abandoned his rights by performing under the circumstances present at the Geauga County Fair Grounds.

The Ohio Supreme Court nevertheless held that the challenged invasion was privileged, saying that the press “must be accorded broad latitude in its choice of how much it presents of each story or incident, and of the emphasis to be given to such presentation. No fixed standard which would bar the press from reporting or depicting either an entire occurrence or an entire discrete part of a public performance can be formulated which would not unduly restrict the ‘breathing room’ in reporting which freedom of the press requires.” 47 Ohio St. 2d, at 235. Under this view, the TV station was thus constitutionally free to film and display Zacchini’s entire act.

The Ohio Supreme Court relied heavily on *Time, Inc. v. Hill*, (S.Ct. 1967), but that case does not mandate a media privilege to televise a performer’s entire act without his consent. Involved in *Time, Inc. v. Hill* was a claim under the New York “Right of Privacy” statute that Life Magazine, in the course of reviewing a new play, had connected the play with a long-past incident involving Zacchini and his family and had falsely described their experience and conduct at that time. The complaint sought damages for humiliation and suffering flowing from these nondefamatory falsehoods that allegedly invaded Hill’s privacy. The Court held, however, that the opening of a new play linked to an actual incident was a matter of public interest and that Hill could not recover without showing that the Life report was knowingly false or was published with reckless disregard for the truth—the same rigorous standard that had been applied in *New York Times Co. v. Sullivan*, (S.Ct. 1964).

*Time, Inc. v. Hill*, which was hotly contested and decided by a divided Court, involved an entirely different tort from the “right of publicity” recognized by the Ohio Supreme Court. As the opinion reveals in *Time, Inc. v. Hill*, the Court was steeped in the literature of privacy law and was aware of the developing distinctions and nuances in this branch of the law. The Court, for example, cited Prosser . . . [and] divided privacy into four distinct branches. The Court was aware that it was adjudicating a “false light” privacy case involving a matter of public interest, not a case involving “intrusion,” “appropriation” of a name or likeness for the purposes of trade, . . . or “private details” about a non-newsworthy person or event, *id.* It is also abundantly clear that *Time, Inc.*



*v. Hill* did not involve a performer, a person with a name having commercial value, or any claim to a “right of publicity.” This discrete kind of “appropriation” case was plainly identified in the literature cited by the Court and had been adjudicated in the reported cases.

The differences between these two torts are important. First, the State’s interests in providing a cause of action in each instance are different. “The interest protected” in permitting recovery for placing the plaintiff in a false light “is clearly that of reputation, with the same overtones of mental distress as in defamation.” Prosser, *supra*. By contrast, the State’s interest in permitting a “right of publicity” is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. As we later note, the State’s interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation. Second, the two torts differ in the degree to which they intrude on dissemination of information to the public. In “false light” cases the only way to protect the interests involved is to attempt to minimize publication of the damaging matter, while in “right of publicity” cases the only question is who gets to do the publishing. An entertainer such as Zacchini usually has no objection to the widespread publication of his act as long as he gets the commercial benefit of such publication. Indeed, in the present case Zacchini did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages.

Nor does it appear that our later cases, such as *Rosenbloom v. Metromedia, Inc.*, (S.Ct. 1971); *Gertz v. Robert Welch, Inc.*, (S.Ct. 1974); and *Time, Inc. v. Firestone*, (S.Ct. 1976), require or furnish substantial support for the Ohio court’s privilege ruling. These cases, like *New York Times*, emphasize the protection extended to the press by the First Amendment in defamation cases, particularly when suit is brought by a public official or a public figure. None of them involve an alleged appropriation by the press of a right of publicity existing under state law.

Moreover, *Time, Inc. v. Hill*, *New York Times*, *Metromedia*, *Gertz*, and *Firestone* all involved the reporting of events; in none of them was there an attempt to broadcast or publish an entire act for which the performer ordinarily gets paid. It is evident, and there is no claim here to the contrary, that Zacchini’s state-law right of publicity would not serve to prevent the TV station from reporting the newsworthy facts about Zacchini’s act. Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer’s entire act without his consent. The Constitution no more prevents a State from requiring the TV station to compensate Zacchini for broadcasting his act on television than it would privilege the TV station to film and broadcast a copyrighted dramatic work without



liability to the copyright owner ... or to film and broadcast a prize fight ... or a baseball game ... where the promoters or the participants had other plans for publicizing the event. There are ample reasons for reaching this conclusion.

The broadcast of a film of Zacchini'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 Zacchini'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. The effect of a public broadcast of the performance is similar to preventing Zacchini from charging an admission fee. "The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." *Kalven, Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 *Law & Contemp. Prob.* 326, 331 (1966). Moreover, the broadcast of Zacchini's entire performance, unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press, goes to the heart of Zacchini's ability to earn a living as an entertainer. Thus, in this case, Ohio has recognized what may be the strongest case for a "right of publicity"—involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.

Of course, Ohio's decision to protect Zacchini's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court. As the Court stated in *Mazer v. Stein*, (S.Ct. 1954):

"The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered." These laws perhaps regard the "reward to the owner [as] a secondary consideration," *United States v. Paramount Pictures*, (S.Ct. 1948), but they were "intended definitely to grant valuable, enforceable rights" in order to afford greater encouragement to the production of works of benefit to the public. *Washingtonian Publishing Co. v. Pearson*, (S.Ct.

1939). The Constitution does not prevent Ohio from making a similar choice here in deciding to protect the entertainer's incentive in order to encourage the production of this type of work.

There is no doubt that entertainment, as well as news, enjoys First Amendment protection. It is also true that entertainment itself can be important news. *Time, Inc. v. Hill*. But it is important to note that neither the public nor the TV station will be deprived of the benefit of Zacchini's performance as long as his commercial stake in his act is appropriately recognized. Zacchini does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it. Nor do we think that a state-law damages remedy against the TV station would represent a species of liability without fault contrary to the letter or spirit of *Gertz v. Robert Welch, Inc.*, (S.Ct. 1974). The TV station knew that Zacchini objected to televising his act but nevertheless displayed the entire film.

We conclude that although the State of Ohio may as a matter of its own law privilege the press in the circumstances of this case, the First and Fourteenth Amendments do not require it to do so.

*Reversed.*

***Carson v. Here's Johnny Portable Toilets, Inc.***

Court of Appeals, 6th Circuit (1983)

- [case on Google Scholar](#)
- [case on Westlaw](#)
- [Hollywood Reporter on Carson litigation](#)

BAILEY BROWN, Senior Circuit Judge.

[A Michigan toilet company began began selling and renting portable toilets under the name Here's Johnny Portable Toilets, Inc. Famous talk show host Johnny Carson sued for unfair competition and invasion of the right of privacy and the right of publicity.]

[John W. Carson (Johnny Carson) was the host and star of "The Tonight Show," a well-known television program broadcast five nights a week by NBC from 1962-1992. Carson was also an entertainer in night clubs and theaters around the country. Since Carson began hosting "The Tonight Show" in 1962, Carson's straight man, Ed McMahon, has introduced the talk show host with the phrase "He-e-e-e-re's Johnny," using a distinctive drawl.]

[The television viewing public associated the phrase "Here's Johnny" with Johnny Carson. In 1967, Carson authorized a business venture to form a chain of restaurants called "Here's Johnny Restaurants" and later licensed his name and picture to Johnny Carson Apparel, Inc., which used "Here's Johnny" on its

clothing labels and in advertising campaigns. Later Carson licensed Marcy Laboratories to sell "Here's Johnny" mens toiletries. The phrase "Here's Johnny" has never been registered by Carson as a trademark or service mark.]

[Here's Johnny Portable Toilets, Inc., is a Michigan corporation founded by Earl Braxton. In 1976, the company began renting and selling "Here's Johnny" portable toilets. Braxton was aware when he formed the corporation that "Here's Johnny" was the introductory slogan for Carson on "The Tonight Show." He said that he had coupled "Here's Johnny" with "The World's Foremost Comedian," to make "a good play on a phrase."]

### Right of Publicity

[Carson claims that the toilet company's use of the phrase "Here's Johnny" violates the common law right of privacy and right of publicity. The confusion in this area of the law requires a brief analysis of the relationship between these two rights. Michigan law, which governs these claims, has not yet clearly addressed the right of publicity. But the general recognition of the right . . . suggests to us that the Michigan courts would adopt the right. Michigan has recognized a right of privacy. *Beaumont v. Brown*, (MI 1977).]

In an influential article, Dean Prosser delineated four distinct types of the right of privacy: (1) intrusion upon one's seclusion or solitude, (2) public disclosure of embarrassing private facts, (3) publicity which places one in a false light, and (4) appropriation of one's name or likeness for the defendant's advantage. . . . This fourth type has become known as the "right of publicity." *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 572, 97 S.Ct. 2849, 2855, 53 L.Ed.2d 965 (1977). Henceforth we will refer to Prosser's last, or fourth, category as the "right of publicity."

Dean Prosser's analysis has been a source of some confusion in the law. His first three types of the right of privacy generally protect the right "to be let alone," while the right of publicity protects the celebrity's pecuniary interest in the commercial exploitation of his identity. *Zacchini, supra*, . . . . Thus, the right of privacy and the right of publicity protect fundamentally different interests and must be analyzed separately.

We do not believe that Carson's claim that his right of privacy has been invaded is supported by the law or the facts. Apparently, the gist of this claim is that Carson is embarrassed by and considers it odious to be associated with the appellee's product. Clearly, the association does not appeal to Carson's sense of humor. But the facts here presented do not, it appears to us, amount to an invasion of any of the interests protected by the right of privacy. In any event, our disposition of the claim of an invasion of the right of publicity makes it

unnecessary for us to accept or reject the claim of an invasion of the right of privacy.

The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. In *Memphis Development Foundation v. Factors Etc., Inc.*, (6th Cir. 1980), we stated: "The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality."

The district court dismissed appellants' claim based on the right of publicity because appellee does not use Carson's name or likeness. 498 F.Supp. at 77. It held that it "would not be prudent to allow recovery for a right of publicity claim which does not more specifically identify Johnny Carson." 498 F.Supp. at 78. We believe that, on the contrary, the district court's conception of the right of publicity is too narrow. The right of publicity, as we have stated, is that a celebrity has a protected pecuniary interest in the commercial exploitation of his identity. If the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his "name or likeness" is used. Carson's identity may be exploited even if his name, John W. Carson, or his picture is not used.

In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, (9th Cir.1974), the court held that the unauthorized use of a picture of a distinctive race car of a well known professional race car driver, whose name or likeness were not used, violated his right of publicity. In this connection, the court said:

We turn now to the question of "identifiability." Clearly, if the district court correctly determined as a matter of law that plaintiff is not identifiable in the commercial, then in no sense has plaintiff's identity been misappropriated nor his interest violated.

Having viewed a film of the commercial, we agree with the district court that the "likeness" of plaintiff is itself unrecognizable; however, the court's further conclusion of law to the effect that the driver is not identifiable as plaintiff is erroneous in that it wholly fails to attribute proper significance to the distinctive decorations appearing on the car. As pointed out earlier, these markings were not only peculiar to the plaintiff's cars but they caused some persons to think the car in question was plaintiff's and to infer that the person driving the car was the plaintiff.

*Id.* at 826-827 (footnote omitted).

In *Ali v. Playgirl, Inc.*, (SDNY 1978), Muhammad Ali, former heavyweight champion, sued Playgirl magazine under the New York “right of privacy” statute and also alleged a violation of his common law right of publicity. The magazine published a drawing of a nude, black male sitting on a stool in a corner of a boxing ring with hands taped and arms outstretched on the ropes. The district court concluded that Ali’s right of publicity was invaded because the drawing sufficiently identified him in spite of the fact that the drawing was captioned “Mystery Man.” The district court found that the identification of Ali was made certain because of an accompanying verse that identified the figure as “The Greatest.” The district court took judicial notice of the fact that “Ali has regularly claimed that appellation for himself.”

In *Hirsch v. S.C. Johnson & Son, Inc.*, (WI 1979), the court held that use by defendant of the name “Crazylegs” on a shaving gel for women violated plaintiff’s right of publicity. Plaintiff, Elroy Hirsch, a famous football player, had been known by this nickname. The court said:

The fact that the name, “Crazylegs,” used by Johnson, was a nickname rather than Hirsch’s actual name does not preclude a cause of action. All that is required is that the name clearly identify the wronged person. In the instant case, it is not disputed at this juncture of the case that the nickname identified the plaintiff Hirsch. It is argued that there were others who were known by the same name. This, however, does not vitiate the existence of a cause of action. It may, however, if sufficient proof were adduced, affect the quantum of damages should the jury impose liability or it might preclude liability altogether. Prosser points out “that a stage or other fictitious name can be so identified with the plaintiff that he is entitled to protection against its use.” He writes that it would be absurd to say that Samuel L. Clemens would have a cause of action if that name had been used in advertising, but he would not have one for the use of “Mark Twain.” If a fictitious name is used in a context which tends to indicate that the name is that of the plaintiff, the factual case for identity is strengthened.

280 N.W.2d at 137.

In this case, Earl Braxton, president and owner of Here’s Johnny Portable Toilets, Inc., admitted that he knew that the phrase “Here’s Johnny” had been used for years to introduce Carson. Moreover, in the opening statement in the district court, appellee’s counsel stated:

Now, we’ve stipulated in this case that the public tends to associate the words “Johnny Carson”, the words “Here’s Johnny” with plain-

tiff, John Carson and, Mr. Braxton, in his deposition, admitted that he knew that and probably absent that identification, he would not have chosen it.

That the “Here’s Johnny” name was selected by Braxton because of its identification with Carson was the clear inference from Braxton’s testimony... The proof showed without question that appellee had appropriated Carson’s identity in connection with its corporate name and its product. [See also Prosser, *supra* (“It is the plaintiff’s name as a symbol of his identity that is involved here, and not as a mere name.”)]

Although this opinion holds only that Carson’s right of publicity was invaded because appellee intentionally appropriated his identity for commercial exploitation, the dissent, relying on its interpretation of the authorities and relying on policy and constitutional arguments, would hold that there was no invasion here. We do not believe that the dissent can withstand fair analysis...

With respect to the dissent’s general policy arguments, it seems to us that the policies there set out would more likely be vindicated by the majority view than by the dissent’s view. Certainly appellant Carson’s achievement has made him a celebrity which means that his identity has a pecuniary value which the right of publicity should vindicate. Vindication of the right will tend to encourage achievement in Carson’s chosen field. Vindication of the right will also tend to prevent unjust enrichment by persons such as appellee who seek commercially to exploit the identity of celebrities without their consent.

The dissent also suggests that recognition of the right of publicity here would somehow run afoul of federal monopoly policies and first amendment proscriptions. If, as the dissent seems to concede, such policies and proscriptions are not violated by the vindication of the right of publicity where the celebrity’s “name, likeness, achievements, identifying characteristics or actual performances” have been appropriated for commercial purposes, we cannot see why the policies and proscriptions would be violated where, as here, the celebrity’s identity has admittedly been appropriated for commercial exploitation by the use of the phrase “Here’s Johnny Portable Toilets.”

The judgment of the district court is vacated and the case remanded for further proceedings consistent with this opinion.

CORNELIA G. KENNEDY, Circuit Judge, dissenting.

I respectfully dissent from that part of the majority’s opinion which holds that appellee’s use of the phrase “Here’s Johnny” violates appellant Johnny Carson’s common law right of publicity. While I agree that an individual’s identity may be impermissibly exploited, I do not believe that the common law right of publicity may be extended beyond an individual’s name, likeness, achievements, identifying characteristics or actual performances, to include phrases or

other things which are merely associated with the individual, as is the phrase “Here’s Johnny.” The majority’s extension of the right of publicity to include phrases or other things which are merely associated with the individual permits a popular entertainer or public figure, by associating himself or herself with a common phrase, to remove those words from the public domain.

### Policies Behind Right of Publicity

The three primary policy considerations behind the right of publicity are succinctly stated in [Hoffman, \*Limitations on the Right of Publicity\*](#). First, “the right of publicity vindicates the economic interests of celebrities, enabling those whose achievements have imbued their identities with pecuniary value to profit from their fame.” [Zacchini](#). Second, the right of publicity fosters “the production of intellectual and creative works by providing the financial incentive for individuals to expend the time and resources necessary to produce them.” *Id.* Third, “[t]he right of publicity serves both individual and societal interests by preventing what our legal tradition regards as wrongful conduct: unjust enrichment and deceptive trade practices.” *Id.*

None of the above-mentioned policy arguments supports the extension of the right of publicity to phrases or other things which are merely associated with an individual. First, the majority is awarding Johnny Carson a windfall, rather than vindicating his economic interests, by protecting the phrase “Here’s Johnny” which is merely associated with him. In *Zacchini*, the Supreme Court stated that a mechanism to vindicate an individual’s economic rights is indicated where the appropriated thing is “the product of . . . [the individual’s] own talents and energy, the end result of much time, effort and expense.” [Zacchini, supra](#). There is nothing in the record to suggest that “Here’s Johnny” has any nexus to Johnny Carson other than being the introduction to his personal appearances. The phrase is not part of an identity that he created. In its content “Here’s Johnny” is a very simple and common introduction. The content of the phrase neither originated with Johnny Carson nor is it confined to the world of entertainment. The phrase is not said by Johnny Carson, but said of him. Its association with him is derived, in large part, by the context in which it is said — generally by Ed McMahon in a drawn out and distinctive voice after the theme music to “The Tonight Show” is played, and immediately prior to Johnny Carson’s own entrance. The toilet company’s use of the content “Here’s Johnny,” in light of its value as a double entendre, written on its product and corporate name, and therefore outside of the context in which it is associated with Johnny Carson, does little to rob Johnny Carson of something which is unique to him or a product of his own efforts.

The second policy goal of fostering the production of creative and intellec-



tual works is not met by the majority's rule because in awarding publicity rights in a phrase neither created by him nor performed by him, economic reward and protection is divorced from personal incentive to produce on the part of the protected and benefited individual. Johnny Carson is simply reaping the rewards of the time, effort and work product of others.

Third, the majority's extension of the right of publicity to include the phrase "Here's Johnny" which is merely associated with Johnny Carson is not needed to provide alternatives to existing legal avenues for redressing wrongful conduct. The existence of a cause of action under section 43(a) of the Lanham Act, 15 U.S.C.A. 1125(a) (1976) and Michigan common law does much to undercut the need for policing against unfair competition through an additional legal remedy such as the right of publicity. The majority has concluded, and I concur, that the District Court was warranted in finding that there was not a reasonable likelihood that members of the public would be confused by appellee's use of the "Here's Johnny" trademark on a product as dissimilar to those licensed by Johnny Carson as portable toilets. In this case, this eliminates the argument of wrongdoing. Moreover, the majority's extension of the right of publicity to phrases and other things merely associated with an individual is not conditioned upon wrongdoing and would apply with equal force in the case of an unknowing user. With respect to unjust enrichment, because a celebrity such as Johnny Carson is himself enriched by phrases and other things associated with him in which he has made no personal investment of time, money or effort, another user of such a phrase or thing may be enriched somewhat by such use, but this enrichment is not at Johnny Carson's expense. The policies behind the right of publicity are not furthered by the majority's holding in this case.

### **Countervailing Interests and Considerations**

The right of publicity, whether tied to name, likeness, achievements, identifying characteristics or actual performances, etc. conflicts with the economic and expressive interests of others. Society's interests in free enterprise and free expression must be balanced against the interests of an individual seeking protection in the right of publicity where the right is being expanded beyond established limits. In addition, the right to publicity may be subject to federal preemption where it conflicts with the provisions of the Copyright Act of 1976.

### **Federal Policy: Monopolies**

Protection under the right of publicity creates a common law monopoly that removes items, words and acts from the public domain. That federal policy favors free enterprise was recently reaffirmed by the Supreme Court in [Na-](#)



*tional Society of Professional Engineers v. United States*, (S.Ct. 1978), in which the Supreme Court indicated that outside of the “rule of reason,” only those anti-competitive restraints expressly authorized by Congress would be permitted to stand. Concern for the impact of adopting an overbroad approach to the right of publicity was also indicated in this Court’s decision in *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.),

In *Memphis Development*, this Court held that the right of publicity does not survive a celebrity’s death under Tennessee law. In so holding, this Court recognized that commercial and competitive interests are potentially compromised by an expansive approach to the right of publicity. This Court was concerned that an extension of the right of publicity to the exclusive control of the celebrity’s heirs might compromise the efficiency, productivity and fairness of our economic system without enlarging the stock or quality of the goods, services, artistic creativity, information, invention or entertainment available and detract from the equal distribution of economic opportunity available in a free market system. *Memphis Development* recognized that the grant of a right of publicity is tantamount to the grant of a monopoly, in that case, for the life of the celebrity.

The majority’s grant to Johnny Carson of a publicity right in the phrase “Here’s Johnny” takes this phrase away from the public domain, giving him a common law monopoly for it, without extracting from Johnny Carson a personal contribution for the public’s benefit. Protection under the right of publicity confers a monopoly on the protected individual that is potentially broader, offers fewer protections and potentially competes with federal statutory monopolies. As an essential part of three federal monopoly rights, copyright, trademark and patents, notice to the public is required in the form of filing with the appropriate governmental office and use of an appropriate mark. This apprises members of the public of the nature and extent of what is being removed from the public domain and subject to claims of infringement. The right of publicity provides limited notice to the public of the extent of the monopoly right to be asserted, if one is to be asserted at all. As the right of privacy is expanded beyond protections of name, likeness and actual performances, which provide relatively objective notice to the public of the extent of an individual’s rights, to more subjective attributes such as achievements and identifying characteristics, the public’s ability to be on notice of a common law monopoly right, if one is even asserted by a given famous individual, is severely diminished. Protecting phrases and other things merely associated with an individual provides virtually no notice to the public at all of what is claimed to be protected. By ensuring the invocation of the adjudicative process whenever the commercial use of a phrase or other associated thing is considered to have been wrongfully appropriated, the public is left to act at their peril. The result is a chilling effect on

commercial innovation and opportunity.

Also unlike the federal statutory monopolies, this common law monopoly right offers no protections against the monopoly existing for an indefinite time or even in perpetuity [citations omitted].

### Free Expression and Use of Intellectual Property

The first amendment protects the freedom of speech, including commercial speech. *Goldfarb v. Virginia State Bar*, (S.Ct. 1975). Strong federal policy permits the free use of intellectual property, words and ideas that are in general circulation and not protected by a valid copyright, patent or trademark... The federal copyright statute only protects original works that fix the author's particular expression of an idea or concept in a tangible form. State statutory or common law protection against activities violating rights that are not equivalent to those granted under copyright law or protection of subject matter which is not copyrightable, including works that are not fixed in any tangible form of expression, are not preempted... Apart from the technical arguments regarding preemption, if federal law and policy does not protect phrases such as "Here's Johnny," which is certainly not an original combination of words, state law should not protect them either under a right of publicity for want of a sufficient interest justifying protection. See U.S. Const., art. I, 8 (purpose of copyright and patent laws is to "promote the Progress of Science and the useful Arts"); *Zacchini, supra*, (purpose of right of publicity is to promote production of works that benefit the public that are product of individual's own talents and energy). In addition, because copyright does not restrain the use of a mere idea or concept but only protects particular tangible expressions of an idea or concept, it has been held not to run afoul of first amendment challenges.

[Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A. L.Rev. 1108 (1970). See *Zacchini, supra*, (right of publicity could not prevent station from producing own human cannonball act).] Apart from the possibility of outright federal preemption, public policy requires that the public's interest in free enterprise and free expression take precedence over any interest Johnny Carson may have in a phrase associated with his person.]

### *White v. Samsung Electronics America, Inc.*

US Court of Appeals, 9th Circuit (1992)

- [case on Google Scholar](#)
- [case on Westlaw](#)
- [Pace Law Review Casenote](#).

GOODWIN, Circuit Judge

This case involves a promotional “fame and fortune” dispute. In running a particular advertisement without Vanna White’s permission, defendants Samsung Electronics America, Inc. (Samsung) and David Deutsch Associates, Inc. (Deutsch) attempted to capitalize on White’s fame to enhance their fortune. White sued, alleging infringement of various intellectual property rights, but the district court granted summary judgment in favor of the defendants. We affirm in part, reverse in part, and remand.

Plaintiff Vanna White is the hostess of “Wheel of Fortune,” one of the most popular game shows in television history. An estimated forty million people watch the program daily. Capitalizing on the fame which her participation in the show has bestowed on her, White markets her identity to various advertisers.

The dispute in this case arose out of a series of advertisements prepared for Samsung by Deutsch. The series ran in at least half a dozen publications with widespread, and in some cases national, circulation. Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by depicting a raw steak with the caption: “Revealed to be health food. 2010 A.D.” Another depicted irreverent “news”-show host Morton Downey Jr. in front of an American flag with the caption: “Presidential candidate. 2008 A.D.”

The advertisement which prompted the current dispute was for Samsung videocassette recorders (VCRs). The ad depicted a robot, dressed in a wig, gown, and jewelry which Deutsch consciously selected to resemble White’s hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: “Longest-running game show. 2012 A.D.” Defendants referred to the ad as the “Vanna White” ad. Unlike the other celebrities used in the campaign, White neither consented to the ads nor was she paid.

Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under: (1) California Civil Code 3344; (2) the California common law right of publicity; and (3) 43(a) of the Lanham Act, 15 U.S.C. 1125(a). The district court granted summary judgment against White on each of her claims. White now appeals.

## I. Section 3344

White first argues that the district court erred in rejecting her claim under section 3344. Section 3344(a) provides, in pertinent part, that “[a]ny person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, . . . for purposes of advertising or selling, . . . without such person’s prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.”

White argues that the Samsung advertisement used her “likeness” in contravention of section 3344. In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir.1988), this court rejected Bette Midler’s section 3344 claim concerning a Ford television commercial in which a Midler “sound-alike” sang a song which Midler had made famous. In rejecting Midler’s claim, this court noted that “[t]he defendants did not use Midler’s name or anything else whose use is prohibited by the statute. The voice they used was [another person’s], not hers. The term ‘likeness’ refers to a visual image not a vocal imitation.” *Id.* at 463.

In this case, Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White’s precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a “likeness,” we agree with the district court that the robot at issue here was not White’s “likeness” within the meaning of section 3344. Accordingly, we affirm the court’s dismissal of White’s section 3344 claim.

## II. Right of Publicity

White next argues that the district court erred in granting summary judgment to defendants on White’s common law right of publicity claim. In *Eastwood v. Superior Court*, (1983), the California court of appeal stated that the common law right of publicity cause of action “may be pleaded by alleging:

1. the defendant’s use of the plaintiff’s identity;
2. the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise;
3. lack of consent; and
4. resulting injury.”

*Id.* at 417.& . . . ; The district court dismissed White’s claim for failure to satisfy *Eastwood*’s second prong, reasoning that defendants had not appropriated White’s “name or likeness” with their robot ad. We agree that the robot ad did not make use of White’s name or likeness. However, the common law right of publicity is not so confined.

The *Eastwood* court did not hold that the right of publicity cause of action could be pleaded only by alleging an appropriation of name or likeness. *Eastwood* involved an unauthorized use of photographs of Clint Eastwood and of his name. Accordingly, the *Eastwood* court had no occasion to consider the extent beyond the use of name or likeness to which the right of publicity reaches. That court held only that the right of publicity cause of action “may be” pleaded by alleging, *inter alia*, appropriation of name or likeness, not that the action may be pleaded *only* in those terms.

The “name or likeness” formulation referred to in *Eastwood* originated not as an element of the right of publicity cause of action, but as a description of the types of cases in which the cause of action had been recognized. The source of this formulation is Prosser, *Privacy*, 48 Cal.L.Rev. 383, 401-07 (1960), one of the earliest and most enduring articulations of the common law right of publicity cause of action. In looking at the case law to that point, Prosser recognized that right of publicity cases involved one of two basic factual scenarios: name appropriation, and picture or other likeness appropriation. *Id.* at 401-02, nn. 156-57.

Even though Prosser focused on appropriations of name or likeness in discussing the right of publicity, he noted that “[i]t is not impossible that there might be appropriation of the plaintiff’s identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy.” *Id.* At the time Prosser wrote, he noted however, that “[n]o such case appears to have arisen.” *Id.*

Since Prosser’s early formulation, the case law has borne out his insight that the right of publicity is not limited to the appropriation of name or likeness. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, (9th Cir. 1974), the defendant had used a photograph of the plaintiff’s race car in a television commercial. Although the plaintiff appeared driving the car in the photograph, his features were not visible. Even though the defendant had not appropriated the plaintiff’s name or likeness, this court held that plaintiff’s California right of publicity claim should reach the jury.

In *Midler*, this court held that, even though the defendants had not used Midler’s name or likeness, Midler had stated a claim for violation of her California common law right of publicity because “the defendants . . . for their own profit in selling their product did appropriate part of her identity” by using a Midler sound-alike. *Id.*

In *Carson v. Here’s Johnny Portable Toilets, Inc.*, (6th Cir.1983), the defendant had marketed portable toilets under the brand name “Here’s Johnny” — Johnny Carson’s signature “Tonight Show” introduction — without Carson’s permission. The district court had dismissed Carson’s Michigan common law right of publicity claim because the defendants had not used Carson’s “name or like-

ness.” *Id.* In reversing the district court, the sixth circuit found “the district court’s conception of the right of publicity ... too narrow” and held that the right was implicated because the defendant had appropriated Carson’s identity by using, *inter alia*, the phrase “Here’s Johnny.”

These cases teach not only that the common law right of publicity reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff’s identity. The right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable. It is noteworthy that the *Midler* and *Carson* defendants not only avoided using the plaintiff’s name or likeness, but they also avoided appropriating the celebrity’s voice, signature, and photograph. The photograph in *Motschenbacher* did include the plaintiff, but because the plaintiff was not visible the driver could have been an actor or dummy and the analysis in the case would have been the same. Although the defendants in these cases avoided the most obvious means of appropriating the plaintiffs’ identities, each of their actions directly implicated the commercial interests which the right of publicity is designed to protect. As the *Carson* court explained:

[t]he right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.... If the celebrity’s identity is commercially exploited, there has been an invasion of his right whether or not his “name or likeness” is used.

\**Carson*.. It is not important *how* the defendant has appropriated the plaintiff’s identity, but *whether* the defendant has done so. *Motschenbacher*, *Midler*, and *Carson* teach the impossibility of treating the right of publicity as guarding only against a laundry list of specific means of appropriating identity. A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.

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

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.

Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one. Indeed, defendants themselves referred to their ad as the "Vanna White" ad. We are not surprised.

Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof. We decline Samsung and Deutsch's invitation to permit the evisceration of the common law right of publicity through means as facile as those in this case. Because White has alleged facts showing that Samsung and Deutsch had appropriated her identity, the district court erred by rejecting, on summary judgment, White's common law right of publicity claim...

[Court's discussion of Lanham Act claim omitted]

#### IV. *The Parody Defense*

In defense, defendants cite a number of cases for the proposition that their robot ad constituted protected speech. The only cases they cite which are even remotely relevant to this case are *Hustler Magazine v. Falwell*, (S.Ct. 1988) and *L.L. Bean, Inc. v. Drake Publishers, Inc.*, (1st Cir.1987). Those cases involved parodies of advertisements run for the purpose of poking fun at Jerry Falwell and L.L. Bean, respectively. This case involves a true advertisement run for



the purpose of selling Samsung VCRs. The ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: "buy Samsung VCRs." Defendants' parody arguments are better addressed to non-commercial parodies. The difference between a "parody" and a "knock-off" is the difference between fun and profit.

## V. Conclusion

In remanding this case, we hold only that White has pleaded claims which can go to the jury for its decision.

AFFIRMED IN PART, REVERSED IN PART, and REMANDED.

## Dissent

One judge dissented in *White v. Samsung*, but the real attack came in the form of Judge Alex Kosinsky's stinging rebuke issued when a majority of the Ninth Circuit Court of Appeals voted to deny rehearing the case *en banc*.

## White v. Samsung Electronics, Inc.

US Court of Appeals, 9th Circuit (1993)

- [case on Google scholar](#)

KOZINSKI, Circuit Judge, with whom Circuit Judges O'SCANNLAIN and KLEINFELD join, dissenting from the order rejecting the suggestion for rehearing *en banc*.

Something very dangerous is going on here. Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors. But reducing too much to private property can be had medicine. Private land, for instance, is far more useful if separated from other private land by public streets, roads and highways. Public parks, utility rights-of-way and sewers reduce the amount of land in private hands, but vastly enhance the value of the property that remains.

So too it is with intellectual property. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.



The panel's opinion is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority's opinion, it's now a tort for advertisers to *remind* the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright Clause. It raises serious First Amendment problems. It's bad law, and it deserves a long, hard second look...

The district judge quite reasonably held that, because Samsung didn't use White's name, likeness, voice or signature, it didn't violate her right of publicity. Not so, says the panel majority: The California right of publicity can't possibly be limited to name and likeness. If it were, the majority reasons, a "clever advertising strategist" could avoid using White's name or likeness but nevertheless remind people of her with impunity, "effectively eviscerat[ing]" her rights. To prevent this "evisceration," the panel majority holds that the right of publicity must extend beyond name and likeness, to any "appropriation" of White's "identity" — anything that "evoke[s]" her personality. *Id.*

But what does "evisceration" mean in intellectual property law? Intellectual property rights aren't like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant. They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation. I can't publish unauthorized copies of, say, *Presumed Innocent*; I can't make a movie out of it. But I'm perfectly free to write a book about an idealistic young prosecutor on trial for a crime he didn't commit. So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I "eviscerated" Scott Turow's intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy.

The majority isn't, in fact, preventing the "evisceration" of Vanna White's existing rights; it's creating a new and much broader property right, a right unknown in California law. It's replacing the existing balance between the interests of the celebrity and those of the public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to *anything that reminds the viewer of her*. After all, that's all Samsung did: It used an inanimate object to remind people of White, to "evoke [her identity]."

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It's not the robot's wig, clothes or jewelry; there must be

ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White's. It's that the robot is posed near the "Wheel of Fortune" game board. Remove the game board from the ad, and no one would think of Vanna White. But once you include the game board, anybody standing beside it — a brunette woman, a man wearing women's clothes, a monkey in a wig and gown — would evoke White's image, precisely the way the robot did. It's the "Wheel of Fortune" set, not the robot's face or dress or jewelry that evokes White's image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.

This is entirely the wrong place to strike the balance. Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.

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

The intellectual property right created by the panel here has none of these essential limitations: No fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of "appropriation of identity," claims often made by people with a wholly exaggerated sense of their own fame and significance.... Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own. The public will be robbed of parodies of celebrities, and our culture will be deprived of the valuable safety valve that parody and mockery create.

Moreover, consider the moral dimension, about which the panel majority seems to have gotten so exercised. Saying Samsung "appropriated" something of White's begs the question: *Should* White have the exclusive right to something

as broad and amorphous as her “identity”? Samsung’s ad didn’t simply copy White’s schtick — like all parody, it created something new. True, Samsung did it to make money, but White does whatever she does to make money, too; the majority talks of “the difference between fun and profit,” but in the entertainment industry fun *is* profit. Why is Vanna White’s right to exclusive for-profit use of her persona — a persona that might not even be her own creation, but that of a writer, director or producer — superior to Samsung’s right to profit by creating its own inventions? Why should she have such absolute rights to control the conduct of others, unlimited by the idea-expression dichotomy or by the fair use doctrine?

To paraphrase only slightly *Feist Publications, Inc. v. Rural Telephone /bin/bash: /opt/local/bin/fortune: No such file or directory Service Co.*, (S.Ct. 1991), it may seem unfair that much of the fruit of a creator’s labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system’s very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means by which intellectual property law advances the progress of science and art. We give authors certain exclusive rights, but in exchange we get a richer public domain. The majority ignores this wise teaching, and all of us are the poorer for it.

The panel, however, does more than misinterpret California law: By refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act. Samsung didn’t merely parody Vanna White. It parodied Vanna White appearing in “Wheel of Fortune,” a copyrighted television show, and parodies of copyrighted works are governed by federal copyright law.

Copyright law specifically gives the world at large the right to make “fair use” parodies, parodies that don’t borrow too much of the original. *Fisher v. Dees* (9th Cir.1986). Federal copyright law also gives the copyright owner the exclusive right to create (or license the creation of) derivative works, which include parodies that borrow too much to qualify as “fair use.” See *Acuff-Rose Music, Inc. v. Campbell* (6th Cir. 1992). When Mel Brooks, for instance, decided to parody *Star Wars*, he had two options: He could have stuck with his fair use rights under 17 U.S.C. 107, or he could have gotten a license to make a derivative work under 17 U.S.C. 106(b) from the holder of the *Star Wars* copyright. To be safe, he probably did the latter, but once he did, he was guaranteed a perfect right to make his movie.

The majority’s decision decimates this federal scheme. It’s impossible to parody a movie or a TV show without at the same time “evok[ing]” the “identit[ies]” of the actors. You can’t have a mock *Star Wars* without a mock Luke Sky-

walker, Han Solo and Princess Leia, which in turn means a mock Mark Hamill, Harrison Ford and Carrie Fisher. You can't have a mock *Batman* commercial without a mock Batman, which means someone emulating the mannerisms of Adam West or Michael Keaton. See Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial*, L.A. Times, Jan. 18, 1990, at B3 (describing Adam West's right of publicity lawsuit over a commercial produced under license from DC Comics, owner of the Batman copyright). The public's right to make a fair use parody and the copyright owner's right to license a derivative work are useless if the parodist is held hostage by every actor whose "identity" he might need to "appropriate."

Our court is in a unique position here. State courts are unlikely to be particularly sensitive to federal preemption, which, after all, is a matter of first concern to the federal courts. The Supreme Court is unlikely to consider the issue because the right of publicity seems so much a matter of state law. That leaves us. It's our responsibility to keep the right of publicity from taking away federally granted rights, either from the public at large or from a copyright owner. We must make sure state law doesn't give the Vanna Whites and Adam Wests of the world a veto over fair use parodies of the shows in which they appear, or over copyright holders' exclusive right to license derivative works of those shows. In a case where the copyright owner isn't even a party — where no one has the interests of copyright owners at heart — the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit. .

## Criminal Celebrities

*Simon & Schuster, Inc. v. Members of NY State Crime Victims Bd.*

**United States Supreme Court (1991)**

- [Case on Google Scholar](#)
- [Case on Westlaw](#)
- [Casebrief](#)

Justice O'Connor delivered the opinion of the Court.

New York's "Son of Sam" law requires that an accused or convicted criminal's income from works describing his crime be deposited in an escrow account. These funds are then made available to the victims of the crime and the criminal's other creditors. We consider whether this statute is consistent with the First Amendment.

**I.A.**

In the summer of 1977, New York was terrorized by a serial killer popularly known as the Son of Sam. The hunt for the Son of Sam received considerable publicity, and by the time David Berkowitz was identified as the killer and apprehended, the rights to his story were worth a substantial amount. Berkowitz's chance to profit from his notoriety while his victims and their families remained uncompensated did not escape the notice of New York's Legislature. The State quickly enacted the statute at issue...

The statute was intended to "ensure that monies received by the criminal under such circumstances shall first be made available to recompense the victims of that crime for their loss and suffering." Assembly Bill Memorandum Re: A 9019. As the author of the statute explained:

It is abhorrent to one's sense of justice and decency that an individual . . . can expect to receive large sums of money for his story once he is captured—while five people are dead, [and] other people were injured as a result of his conduct.

Memorandum of Sen. Emanuel R. Gold, reprinted in New York State Legislative Annual, 1977.

The Son of Sam law, as later amended, requires any entity contracting with an accused or convicted person for a depiction of the crime to submit a copy of the contract to respondent New York State Crime Victims Board (Board), and to turn over any income under that contract to the Board. This requirement applies to all such contracts in any medium of communication:

"Every person, firm, corporation, partnership, association or other legal entity contracting with any person or the representative or assignee of any person, accused or convicted of a crime in this state, with respect to the reenactment of such crime, by way of a movie, book, magazine article, tape recording, phonograph record, radio or television presentation, live entertainment of any kind, or from the expression of such accused or convicted person's thoughts, feelings, opinions or emotions regarding such crime, shall submit a copy of such contract to the board and pay over to the board any moneys which would otherwise, by terms of such contract, be owing to the person so accused or convicted or his representatives."

The Board is then required to deposit the payment in an escrow account "for the benefit of and payable to any victim . . . provided that such victim, within five years of the date of the establishment of such escrow account, brings a civil

action in a court of competent jurisdiction and recovers a money judgment for damages against such [accused or convicted] person or his representatives.” *Ibid.* After five years, if no actions are pending, “the board shall immediately pay over any moneys in the escrow account to such person or his legal representatives.” 632—a(4). This 5-year period in which to bring a civil action against the convicted person begins to run when the escrow account is established, and supersedes any limitations period that expires earlier...

Subsection (10) broadly defines “person convicted of a crime” to include “any person convicted of a crime in this state either by entry of a plea of guilty or by conviction after trial *and any person who has voluntarily and intelligently admitted the commission of a crime for which such person is not prosecuted.*” 632—a(10)(b) (emphasis added). Thus a person who has never been accused or convicted of a crime in the ordinary sense, but who admits in a book or other work to having committed a crime, is within the statute’s coverage...

Since its enactment in 1977, the Son of Sam law has been invoked only a handful of times. As might be expected, the individuals whose profits the Board has sought to escrow have all become well known for having committed highly publicized crimes. These include Jean Harris, the convicted killer of “Scarsdale Diet” Doctor Herman Tarnower; Mark David Chapman, the man convicted of assassinating John Lennon; and R. Foster Winans, the former Wall Street Journal columnist convicted of insider trading. Ironically, the statute was never applied to the Son of Sam himself; David Berkowitz was found incompetent to stand trial, and the statute at that time applied only to criminals who had actually been convicted.... According to the Board, Berkowitz voluntarily paid his share of the royalties from the book *Son of Sam*, published in 1981, to his victims or their estates.

This case began in 1986, when the Board first became aware of the contract between petitioner Simon & Schuster and admitted organized crime figure Henry Hill.

## **I.B.**

Looking back from the safety of the Federal Witness Protection Program, Henry Hill recalled: “At the age of twelve my ambition was to be a gangster. To be a wiseguy. To me being a wiseguy was better than being president of the United States.” N. Pileggi, *Wiseguy: Life in a Mafia Family* 19 (1985) (hereinafter *Wiseguy*). Whatever one might think of Hill, at the very least it can be said that he realized his dreams. After a career spanning 25 years, Hill admitted engineering some of the most daring crimes of his day, including the 1978-1979 Boston College basketball pointshaving scandal, and the theft of \$6 million from Lufthansa Airlines in 1978, the largest successful cash robbery in American his-

tory. Wiseguy 9.

Hill was arrested in 1980. In exchange for immunity from prosecution, he testified against many of his former colleagues. Since his arrest, he has lived under an assumed name in an unknown part of the country.

In August 1981, Hill entered into a contract with author Nicholas Pileggi for the production of a book about Hill's life. The following month, Hill and Pileggi signed a publishing agreement with Simon & Schuster, Inc. Under the agreement, Simon & Schuster agreed to make payments to both Hill and Pileggi. Over the next few years, according to Pileggi, he and Hill "talked at length virtually every single day, with not more than an occasional Sunday or holiday skipped. We spent more than three hundred hours together; my notes of conversations with Henry occupy more than six linear file feet." App. 27. Because producing the book required such a substantial investment of time and effort, Hill sought compensation. *Ibid.*

The result of Hill and Pileggi's collaboration was *Wiseguy*, which was published in January 1986. The book depicts, in colorful detail, the day-to-day existence of organized crime, primarily in Hill's first-person narrative. Throughout *Wiseguy*, Hill frankly admits to having participated in an astonishing variety of crimes. He discusses, among other things, his conviction of extortion and the prison sentence he served. In one portion of the book, Hill recounts how members of the Mafia received preferential treatment in prison:

The dorm was a separate three-story building outside the wall, which looked more like a Holiday Inn than a prison. There were four guys to a room, and we had comfortable beds and private baths. There were two dozen rooms on each floor, and each of them had mob guys living in them. It was like a wiseguy convention—the whole Gotti crew, Jimmy Doyle and his guys, 'Ernie Boy' Abbamonte and 'Joe Crow' Delvecchio, Vinnie Aloï, Frank Cotroni.

It was wild. There was wine and booze, and it was kept in bath-oil or after-shave jars. The hacks in the honor dorm were almost all on the take, and even though it was against the rules, we used to cook in our rooms. Looking back, I don't think Paulie went to the general mess five times in the two and a half years he was there. We had a stove and pots and pans and silverware stacked in the bathroom. We had glasses and an ice-water cooler where we kept the fresh meats and cheeses. When there was an inspection, we stored the stuff in the false ceiling, and once in a while, if it was confiscated, we'd just go to the kitchen and get new stuff.

We had the best food smuggled into our dorm from the kitchen. Steaks, veal cutlets, shrimp, red snapper. Whatever the hacks could buy, we ate. It cost me two, three hundred a week. Guys like Paulie spent five hundred to a thousand bucks a week. Scotch cost thirty dollars a pint. The hacks used to bring it inside the walls in their lunch pails. We never ran out of booze, because we had six hacks bringing it in six days a week. Depending on what you wanted and how much you were willing to spend, life could be almost bearable." Wiseguy 150-151.

Wiseguy was reviewed favorably: The Washington Post called it an "amply detailed and entirely fascinating book that amounts to a piece of revisionist history," while New York Daily News columnist Jimmy Breslin named it "the best book on crime in America ever written." App. 5. The book was also a commercial success: Within 19 months of its publication, more than a million copies were in print. A few years later, the book was converted into a film called *Goodfellas*, which won a host of awards as the best film of 1990.

From Henry Hill's perspective, however, the publicity generated by the book's success proved less desirable. The Crime Victims Board learned of Wiseguy in January 1986, soon after it was published.

### I.C.

On January 31, the Board notified Simon & Schuster: "It has come to our attention that you may have contracted with a person accused or convicted of a crime for the payment of monies to such person." App. 86. The Board ordered Simon & Schuster to furnish copies of any contracts it had & into entered with Hill, to provide the dollar amounts and dates of all payments it had made to Hill, and to suspend all payments to Hill in the future. Simon & Schuster complied with this order. By that time, Simon & Schuster had paid Hill's literary agent \$96,250 in advances and royalties on Hill's behalf, and was holding \$27,958 for eventual payment to Hill...

### II.A.

A statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech. *Leathers v. Medlock*, (S.Ct. 1991). As we emphasized in invalidating a content-based magazine tax: "[O]fficial scrutiny of the content of publications as the basis for imposing a tax is entirely incompatible with the First Amendment's guarantee of freedom of the press." *Arkansas Writers' Project, Inc. v. Ragland*, (S.Ct. 1987).



This is a notion so engrained in our First Amendment jurisprudence that last Term we found it so “obvious” as to not require explanation. \**Leathers*, *supra*. It is but one manifestation of a far broader principle: “Regulations which permit the Government to discriminate on the basis of the content of the message cannot be tolerated under the First Amendment.” *Regan v. Time, Inc.*, (S.Ct. 1984). See also *Police Dept. of Chicago v. Mosley*, (S.Ct. 1972). In the context of financial regulation, it bears repeating, as we did in *Leathers*, that the government’s ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace. *Leathers*. The First Amendment presumptively places this sort of discrimination beyond the power of the government. As we reiterated in *Leathers*: “‘The constitutional right of free expression is . . . intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us . . . in the belief that no other approach would comport with the premise of individual dignity and choice upon which our political system rests.’” *Id.*, at 448-449 (quoting *Cohen v. California*, (S.Ct. 1971)).

The Son of Sam law is such a content-based statute. It singles out income derived from expressive activity for a burden the State places on no other income, and it is directed only at works with a specified content. Whether the First Amendment “speaker” is considered to be Henry Hill, whose income the statute places in escrow because of the story he has told, or Simon & Schuster, which can publish books about crime with the assistance of only those criminals willing to forgo remuneration for at least five years, the statute plainly imposes a financial disincentive only on speech of a particular content.

The Board tries unsuccessfully to distinguish the Son of Sam law from the discriminatory tax at issue in *Arkansas Writers’ Project*. While the Son of Sam law escrows all of the speaker’s speech-derived income for at least five years, rather than taxing a percentage of it outright, this difference can hardly serve as the basis for disparate treatment under the First Amendment. Both forms of financial burden operate as disincentives to speak; indeed, in many cases it will be impossible to discern in advance which type of regulation will be more costly to the speaker. . . .

The Son of Sam law establishes a financial disincentive to create or publish works with a particular content. In order to justify such differential treatment, “the State must show that its regulation is necessary to serve a compelling state interest and is narrowly drawn to achieve that end.” *Arkansas Writers’ Project*,.

## II.B.

The Board disclaims, as it must, any state interest in suppressing descriptions of crime out of solicitude for the sensibilities of readers. As we have often had occasion to repeat: “[T]he fact that society may find speech offensive is not a sufficient reason for suppressing it. Indeed, if it is the speaker’s opinion that gives offense, that consequence is a reason for according it constitutional protection.” *Hustler Magazine, Inc. v. Falwell*, (S.Ct. 1988) (quoting *FCC v. Pacifica Foundation*, (S.Ct. 1978)). “‘If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.’” . . . The Board thus does not assert any interest in limiting whatever anguish Henry Hill’s victims may suffer from reliving their victimization.

There can be little doubt, on the other hand, that the State has a compelling interest in ensuring that victims of crime are compensated by those who harm them. Every State has a body of tort law serving exactly this interest. The State’s interest in preventing wrongdoers from dissipating their assets before victims can recover explains the existence of the State’s statutory provisions for prejudgment remedies and orders of restitution. We have recognized the importance of this interest before, in the Sixth Amendment context. See *Caplin & Drysdale, Chartered v. United States*, (S.Ct. 1989).

The State likewise has an undisputed compelling interest in ensuring that criminals do not profit from their crimes. Like most if not all States, New York has long recognized the “fundamental equitable principle,” *Children of Bedford v. Petromelis*, that “[n]o one shall be permitted to profit by his own fraud, or to take advantage of his own wrong, or to found any claim upon his own iniquity, or to acquire property by his own crime.” *Riggs v. Palmer*, (S.Ct. 1889). The force of this interest is evidenced by the State’s statutory provisions for the forfeiture of the proceeds and instrumentalities of crime.

The parties debate whether book royalties can properly be termed the profits of crime, but that is a question we need not address here. For the purposes of this case, we can assume without deciding that the income escrowed by the Son of Sam law represents the fruits of crime. We need only conclude that the State has a compelling interest in depriving criminals of the profits of their crimes, and in using these funds to compensate victims.

The Board attempts to define the State’s interest more narrowly, as “ensuring that criminals do not profit from storytelling about their crimes before their victims have a meaningful opportunity to be compensated for their injuries.” Here the Board is on far shakier ground. The Board cannot explain why the State should have any greater interest in compensating victims from the proceeds of such “storytelling” than from any of the criminal’s other assets. Nor can the Board offer any justification for a distinction between this expressive activity

and any other activity in connection with its interest in transferring the fruits of crime from criminals to their victims. Thus even if the State can be said to have an interest in classifying a criminal's assets in this manner, that interest is hardly compelling....

In short, the State has a compelling interest in compensating victims from the fruits of the crime, but little if any interest in limiting such compensation to the proceeds of the wrongdoer's speech about the crime. We must therefore determine whether the Son of Sam law is narrowly tailored to advance the former, not the latter, objective.

## II.C.

As a means of ensuring that victims are compensated from the proceeds of crime, the Son of Sam law is significantly overinclusive. As counsel for the Board conceded at oral argument, the statute applies to works on *any* subject, provided that they express the author's thoughts or recollections about his crime, however tangentially or incidentally. In addition, the statute's broad definition of "person convicted of a crime" enables the Board to escrow the income of any author who admits in his work to having committed a crime, whether or not the author was ever actually accused or convicted.

These two provisions combine to encompass a potentially very large number of works. Had the Son of Sam law been in effect at the time and place of publication, it would have escrowed payment for such works as *The Autobiography of Malcolm X*, which describes crimes committed by the civil rights leader before he became a public figure; *Civil Disobedience*, in which Thoreau acknowledges his refusal to pay taxes and recalls his experience in jail; and even the *Confessions of Saint Augustine*, in which the author laments "my past foulness and the carnal corruptions of my soul," one instance of which involved the theft of pears from a neighboring vineyard. Amicus Association of American Publishers, Inc., has submitted a sobering bibliography listing hundreds of works by American prisoners and ex-prisoners, many of which contain descriptions of the crimes for which the authors were incarcerated, including works by such authors as Emma Goldman and Martin Luther King, Jr. A list of prominent figures whose autobiographies would be subject to the statute if written is not difficult to construct: The list could include Sir Walter Raleigh, who was convicted of treason after a dubiously conducted 1603 trial; Jesse Jackson, who was arrested in 1963 for trespass and resisting arrest after attempting to be served at a lunch counter in North Carolina; and Bertrand Russell, who was jailed for seven days at the age of 89 for participating in a sit-down protest against nuclear weapons. The argument that a statute like the Son of Sam law would prevent publication of *all* of these works is hyperbole—some would have been written

without compensation—but the Son of Sam law clearly reaches a wide range of literature that does not enable a criminal to profit from his crime while a victim remains uncompensated.

Should a prominent figure write his autobiography at the end of his career, and include in an early chapter a brief recollection of having stolen (in New York) a nearly worthless item as a youthful prank, the Board would control his entire income from the book for five years, and would make that income available to all of the author's creditors, despite the fact that the statute of limitations for this minor incident had long since run. That the Son of Sam law can produce such an outcome indicates that the statute is, to say the least, not narrowly tailored to achieve the State's objective of compensating crime victims from the profits of crime.

### III

The Federal Government and many of the States have enacted statutes designed to serve purposes similar to that served by the Son of Sam law. Some of these statutes may be quite different from New York's, and we have no occasion to determine the constitutionality of these other laws. We conclude simply that in the Son of Sam law, New York has singled out speech on a particular subject for a financial burden that it places on no other speech and no other income. The State's interest in compensating victims from the fruits of crime is a compelling one, but the Son of Sam law is not narrowly tailored to advance that objective. As a result, the statute is inconsistent with the First Amendment.

The judgment of the Court of Appeals is accordingly  
*Reversed.*

## Transformation

### Comedy III Productions v. Gary Saderup, Inc.

California Supreme Court (2001)

MOSK, J.

A California statute grants the *right of publicity* to specified successors in interest of deceased celebrities, prohibiting any other person from using a celebrity's name, voice, signature, photograph, or likeness for commercial purposes without the consent of such successors. . . . The United States Constitution prohibits the states from abridging, among other fundamental rights, freedom of speech. In the case at bar we resolve a conflict between these two provisions. The Court of Appeal concluded that the lithographs and silkscreened T-shirts in question here received no First Amendment protection simply because they were reproductions rather than original works of art. As will appear, this was

error: reproductions are equally entitled to First Amendment protection. We formulate instead what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation. Applying this test to the present case, we conclude that there are no such creative elements here and that the right of publicity prevails. On this basis, we will affirm the judgment of the Court of Appeal.

## I. The Statute

In this state the right of publicity is both a statutory and a common law right. The statutory right originated in Civil Code section 3344 (hereafter section 3344), enacted in 1971, authorizing recovery of damages by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent. Eight years later, in *Lugosi v. Universal Pictures (Lugosi)*, we also recognized a common law right of publicity, which the statute was said to complement... But because the common law right was derived from the law of privacy, we held in *Lugosi* that the cause of action did not survive the death of the person whose identity was exploited and was not descendible to his or her heirs or assignees.

In 1984 the Legislature enacted an additional measure on the subject, creating a second statutory right of publicity that *was* descendible to the theirs and assignees of deceased persons. The statute was evidently modeled on section 3344: many of the key provisions of the two statutory schemes were identical. The 1984 measure is the statute in issue in the case at bar. At the time of trial and while the appeal was pending before the Court of Appeal, the statute was numbered section 990 of the Civil Code.

Section 990 declares broadly that:

Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the person or persons specified in subdivision (c), shall be liable for any damages sustained by the person or persons injured as a result thereof... The amount recoverable includes "any profits from the unauthorized use," as well as punitive damages, attorney fees, and costs.

The statute defines "deceased personality" as a person "whose name, voice, signature, photograph, or likeness has commercial value at the time of his or

her death,” whether or not the person actually used any of those features for commercial purposes while alive.

The statute further declares that “The rights recognized under this section are property rights” that are transferable before or after the personality dies, by contract or by trust or will. Consent to use the deceased personality’s name, voice, photograph, etc., must be obtained from such a transferee or, if there is none, from certain described survivors of the personality. Any person claiming to be such a transferee or survivor must register the claim with the Secretary of State before recovering damages.

The right to require consent under the statute terminates if there is neither transferee nor survivor ... or 50 years after the personality dies.

The statute provides a number of exemptions from the requirement of consent to use. Thus a use “in connection with any news, public affairs, or sports broadcast or account, or any political campaign” does not require consent. Use in a “commercial medium” does not require consent solely because the material is commercially sponsored or contains paid advertising; “Rather it shall be a question of fact whether or not the use ... was so directly connected with” the sponsorship or advertising that it requires consent. Finally, subdivision (n) provides that “[a] play, book, magazine, newspaper, musical composition, film, radio or television program” ... work of “political or newsworthy value” ... “[s]ingle and original works of fine art” ... or “[a]n advertisement or commercial announcement” for the above works ... are all exempt from the provisions of the statute.

## II. Facts

Plaintiff Comedy III Productions, Inc. (hereafter Comedy III), brought this action against defendants Gary Saderup and Gary Saderup, Inc. (hereafter collectively Saderup), seeking damages and injunctive relief for violation of section 990 and related business torts. The parties waived the right to jury trial and the right to put on evidence, and submitted the case for decision on the following stipulated facts:

Comedy III is the registered owner of all rights to the former comedy act known as The Three Stooges, who are deceased personalities within the meaning of the statute.

Saderup is an artist with over 25 years’ experience in making charcoal drawings of celebrities. These drawings are used to create lithographic and silkscreen masters, which in turn are used to produce multiple reproductions in the form, respectively, of lithographic prints and silkscreened images on T-shirts. Saderup creates the original drawings and is actively involved in the ensuing lithographic and silkscreening processes.

Without securing Comedy III's consent, Saderup sold lithographs and T-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing he had made. These lithographs and T-shirts did not constitute an advertisement, endorsement, or sponsorship of any product.

Saderup's profits from the sale of unlicensed lithographs and T-shirts bearing a likeness of The Three Stooges was \$75,000 and Comedy III's reasonable attorney fees were \$150,000.

On these stipulated facts the court found for Comedy III and entered judgment against Saderup awarding damages of \$75,000 and attorney fees of \$150,000 plus costs...

The Court of Appeal affirmed the judgment ... upholding the award of damages, attorney fees, and costs. In so doing, it rejected Saderup's contentions that his conduct (1) did not violate the terms of the statute, and (2) in any event was protected by the constitutional guaranty of freedom of speech.

We granted review to address these two issues.

### III. Discussion

#### A. The Statutory Issue

Saderup contends the statute applies only to uses of a deceased personality's name, voice, photograph, etc., for the purpose of advertising, selling, or soliciting the purchase of, products or services. He then stresses the stipulated fact (and subsequent finding) that the lithographs and T-shirts at issue in this case did not constitute an advertisement, endorsement, or sponsorship of any product. He concludes the statute therefore does not apply in the case at bar. As will appear, the major premise of his argument—his construction of the statute—is unpersuasive.

As noted above, the statute makes liable any person who, without consent, uses a deceased personality's name, voice, photograph, etc., "in any manner, *on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services...*" Saderup's construction reads the emphasized phrase out of the statute. Yet the Legislature deliberately inserted it, as the following sequence of events demonstrates. When first enacted in 1971, section 3344—the companion statute applying to living personalities—contained no such phrase: the statute simply made liable any person who uses another's identity "in any manner, for purposes of advertising products, merchandise, goods or services, or for purposes of solicitation of such purchases. ... The Legislature inserted the phrase, "*on or in products, merchandise, or goods, or,*" when it amended section 3344 in 1984.... And



in the very same legislation, the Legislature adopted section 990 and inserted the identical phrase in that statute as well.

We therefore give effect to the plain meaning of the statute: it makes liable any person who, without consent, uses a deceased personality's name, voice, photograph, etc., either (1) "on or in" a product, *or* (2) in "advertising or selling" a product. The two uses are not synonymous: in the apt example given by the Court of Appeal, there is an obvious difference between "placing a celebrity's name on a 'special edition' of a vehicle, and using that name in a commercial to endorse or tout the same or another vehicle."

Applying this construction of the statute to the facts at hand, we agree with the Court of Appeal that Saderup sold more than just the incorporeal likeness of The Three Stooges. Saderup's lithographic prints of The Three Stooges are themselves tangible personal property, consisting of paper and ink, made as products to be sold and displayed on walls like similar graphic art Saderup's T-shirts are likewise tangible personal property, consisting of fabric and ink, made as products to be sold and worn on the body like similar garments. By producing and selling such lithographs and T-shirts, Saderup thus used the likeness of The Three Stooges "on ... products, merchandise, or goods" within the meaning of the statute...

### ***B. The Constitutional Issue***

Saderup next contends that enforcement of the judgment against him violates his right of free speech and expression under the First Amendment. He raises a difficult issue, which we address below...

As the trial court found, Saderup's portraits of The Three Stooges are expressive works and not an advertisement for or endorsement of a product. Although his work was done for financial gain, "[t]he First Amendment is not limited to those who publish without charge.... [An expressive activity] does not lose its constitutional protection because it is undertaken for profit." (*Guglielmi v. Spelling-Goldberg Productions* (1979) (*Guglielmi*).)

The tension between the right of publicity and the First Amendment is highlighted by recalling the two distinct, commonly acknowledged purposes of the latter. First, "'to preserve an uninhibited marketplace of ideas' and to repel efforts to limit the 'uninhibited, robust and wideopen' debate on public issues.'" *Guglielmi supra*,.) Second, to foster a "fundamental respect for individual development and self-realization. The right to self-expression is inherent in any political system which respects individual dignity. Each speaker must be free of government restraint regardless of the nature or manner of the views expressed unless there is a compelling reason to the contrary."

The right of publicity has a potential for frustrating the fulfillment of both these purposes. Because celebrities take on public meaning, the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And because celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity images can be an important avenue of individual expression. As one commentator has stated:

Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and of consumption. Whether or not celebrities are 'the chief agents of moral change in the United States,' they certainly are widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.

(Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights* (1993) 81 Cal. L.Rev. 125, 128 (Madow, italics and fns. omitted.)

As Madow further points out, the very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the celebrity's meaning... A majority of this court recognized as much in *Guglielmi*: "The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment."

For similar reasons, speech about public figures is accorded heightened First Amendment protection in defamation law. As the United States Supreme Court held in *Gertz v. Robert Welch, Inc.* (S.Ct. 1974) public figures may prevail in a libel action only if they prove that the defendant's defamatory statements were made with actual malice, i.e., actual knowledge of falsehood or reckless disregard for the truth, whereas private figures need prove only negligence... The rationale for such differential treatment is, first, that the public figure has greater access to the media and therefore greater opportunity to rebut defamatory statements, and second, that those who have become public figures have done so voluntarily and therefore "invite attention and comment." Giving broad scope to the right of publicity has the potential of allowing a celebrity to accomplish through

the vigorous exercise of that right the censorship of unflattering commentary that cannot be constitutionally accomplished through defamation actions.

[Even though Saderup's creations were for "entertaining rather than informing" and even though they consisted of "nonverbal, visual representation" on T-shirt the Court held that they were clearly protected expression under the First Amendment and indeed would be protected even if they conveyed "no discernable message."]

But having recognized the high degree of First Amendment protection for noncommercial speech about celebrities, we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. "Often considerable money, time and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. [Citations.] For some, the investment may eventually create considerable commercial value in one's identity." *Lugosi supra*.

The present case exemplifies this kind of creative labor. Moe and Jerome (Curly) Howard and Larry Fein fashioned personae collectively known as The Three Stooges, first in vaudeville and later in movie shorts, over a period extending from the 1920's to the 1940's...

In sum, society may recognize, as the Legislature has done here, that a celebrity's heirs and assigns have a legitimate protectible interest in exploiting the value to be obtained from merchandising the celebrity's image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging creative work. (See 1 McCarthy, *The Rights of Publicity and Privacy* (2d ed.2000) 2.2-2.7, pp. 2-1 to 2-22 (McCarthy).) Although critics have questioned whether the right of publicity truly serves any social purpose (see, e.g., Madow, *supra*, 81 Cal. L.Rev. at pp. 178-238), there is no question that the Legislature has a rational basis for permitting celebrities and their heirs to control the commercial exploitation of the celebrity's likeness.

Although surprisingly few courts have considered in any depth the means of reconciling the right of publicity and the First Amendment, we follow those that have in concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment.

[The Court reviewed *Zacchini*, and found two principles applicable to this case: (1) state law may validly safeguard forms of intellectual property not covered under federal copyright and patent law as a means of protecting the fruits of a performing artist's labor; and (2) the state's interest in preventing the outright misappropriation of such intellectual property by others is not automati-

cally trumped by the interest in free expression or dissemination of information; rather, as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake.]

*Guglielmi* adopted a similar balancing approach. The purported heir of Rudolph Valentino filed suit against the makers of a fictional film based on the latter's life. *Guglielmi* concluded that the First Amendment protection of entertainment superseded any right of publicity. This was in contrast to the companion *Lugosi* case, in which Chief Justice Bird concluded in her dissenting opinion that there may be an enforceable right of publicity that would prevent the merchandising of Count Dracula using the likeness of Bela Lugosi, with whom that role was identified. *Lugosi*. *Guglielmi* proposed a balancing test to distinguish protected from unprotected appropriation of celebrity likenesses: "an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression in this context." (*Guglielmi supra*, 25 Cal.3d at p. 871, 160 Cal.Rptr. 352, 603 P.2d 454.)

[The Court exhaustively cited cases balancing First Amendment rights against publicity rights.]

It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. Certainly, any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope. The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the "name, voice, signature, photograph, or likeness" of the celebrity. ( 990.)

Beyond this precept, how may courts distinguish between protected and unprotected expression? Some commentators have proposed importing the fair use defense from copyright law (17 U.S.C. 107), which has the advantage of employing an established doctrine developed from a related area of the law... Others disagree, pointing to the murkiness of the fair use doctrine and arguing that the idea/expression dichotomy, rather than fair use, is the principal means of reconciling copyright protection and First Amendment rights...

We conclude that a wholesale importation of the fair use doctrine into right of publicity law would not be advisable. At least two of the factors employed

in the fair use test, “the nature of the copyrighted work” and “the amount and substantiality of the portion used” (17 U.S.C. 107(2), (3)), seem particularly designed to be applied to the partial copying of works of authorship “fixed in [a] tangible medium of expression” (17 U.S.C. 102); it is difficult to understand why these factors would be especially useful for determining whether the depiction of a celebrity likeness is protected by the First Amendment.

Nonetheless, the first fair use factor—“the purpose and character of the use” ... does seem particularly pertinent to the task of reconciling the rights of free expression and publicity. As the Supreme Court has stated, the central purpose of the inquiry into this fair use factor “is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’ Although such transformative use is not absolutely necessary for a finding of fair use, [citation] the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works.” (*Campbell v. Acuff-Rose Music, Inc.* (S.Ct. 1994).

This inquiry into whether a work is “transformative” appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment. As the above quotation suggests, both the First Amendment and copyright law have a common goal of encouragement of free expression and creativity, the former by protecting such expression from government interference, the latter by protecting the creative fruits of intellectual and artistic labor.... The right of publicity, at least theoretically, shares this goal with copyright law.... When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. *Zacchini supra*.

On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity. As has been observed, works of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect. See *Cardtoons, L.C. v. Major League Baseball Players Association* (10th Cir. 1996).) Accordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity. The right-of-publicity holder continues to enforce the right to monopolize the pro-

duction of conventional, more or less fungible, images of the celebrity.

*Cardtoons, supra*, cited by Saderup, is consistent with this “transformative” test. There, the court held that the First Amendment protected a company that produced trading cards caricaturing and parodying well-known major league baseball players against a claim brought under the Oklahoma right of publicity statute. The court concluded that “[t]he cards provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball,” and that “[t]he cards are no less protected because they provide humorous rather than serious commentary.” The *Cardtoons* court weighed these First Amendment rights against what it concluded was the less-than-compelling interests advanced by the right of publicity outside the advertising context—especially in light of the reality that parody would not likely substantially impact the economic interests of celebrities—and found the cards to be a form of protected expression. While *Cardtoons* contained dicta calling into question the social value of the right of publicity, its conclusion that works parodying and caricaturing celebrities are protected by the First Amendment appears unassailable in light of the test articulated above.

We emphasize that the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms....

Another way of stating the inquiry is whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. And when we use the word “expression,” we mean expression of something other than the likeness of the celebrity.

We further emphasize that in determining whether the work is transformative, courts are not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully qualify for First Amendment protection. (See, e.g., *\*Hustler Magazine v. Falwell, supra*; see also *Campbell v. Acuff—Rose Music, Inc., supra*.) On the other hand, a literal depiction of a celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge. The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.

Furthermore, in determining whether a work is sufficiently transformative, courts may find useful a subsidiary inquiry, particularly in close cases: does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted? If this question is answered in the negative, then there would generally be no actionable right of publicity. When the



value of the work comes principally from some source other than the fame of the celebrity—from the creativity, skill, and reputation of the artist—it may be presumed that sufficient transformative elements are present to warrant First Amendment protection. If the question is answered in the affirmative, however, it does not necessarily follow that the work is without First Amendment protection—it may still be a transformative work.

In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.

Turning to the present case, we note that the trial court, in ruling against *Saderup*, stated that “the commercial enterprise conducted by [*Saderup*] involves the sale of lithographs and T-shirts which are not original single works of art, and which are not protected by the First Amendment; the enterprise conducted by [*Saderup*] was a commercial enterprise designed to generate profits solely from the use of the likeness of The Three Stooges which is the right of publicity ... protected by section 990.” Although not entirely clear, the trial court seemed to be holding that *reproductions* of celebrity images are categorically outside First Amendment protection. The Court of Appeal was more explicit in adopting this rationale: “Simply put, although the First Amendment protects speech that is sold [citation], reproductions of an image, made to be sold for profit do not per se constitute speech.” But this position has no basis in logic or authority. No one would claim that a published book, because it is one of many copies, receives less First Amendment protection than the original manuscript. It is true that the statute at issue here makes a distinction between a single and original work of fine art and a reproduction. ( 990, subd. (n)(3).) Because the statute evidently aims at preventing the illicit merchandising of celebrity images, and because single original works of fine art are not forms of merchandising, the state has little if any interest in preventing the exhibition and sale of such works, and the First Amendment rights of the artist should therefore prevail. But the inverse—that a reproduction receives no First Amendment protection—is patently false: a reproduction of a celebrity image that, as explained above, contains significant creative elements is entitled to as much First Amendment protection as an original work of art. The trial court and the Court of Appeal therefore erred in this respect.

Rather, the inquiry is into whether *Saderup*'s work is sufficiently transformative. Correctly anticipating this inquiry, he argues that all portraiture involves creative decisions, that therefore no portrait portrays a mere literal likeness, and that accordingly all portraiture, including reproductions, is protected by the First Amendment. We reject any such categorical position. Without denying



that all portraiture involves the making of artistic choices, we find it equally undeniable, under the test formulated above, that when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity. As is the case with fair use in the area of copyright law, an artist depicting a celebrity must contribute something more than a "merely trivial" variation, [but must create] something recognizably "his own" *L. Batlin & Son, Inc. v. Snyder*), in order to qualify for legal protection.

On the other hand, we do not hold that all reproductions of celebrity portraits are unprotected by the First Amendment. The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself... Such expression may well be entitled to First Amendment protection. Although the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence. (See, e.g., *Miller v. California* (1973) [requiring determination, in the context of work alleged to be obscene, of "whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value"].)

Turning to Saderup's work, we can discern no significant transformative or creative contribution. His undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame. Indeed, were we to decide that Saderup's depictions were protected by the First Amendment, we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.

Moreover, the marketability and economic value of Saderup's work derives primarily from the fame of the celebrities depicted. While that fact alone does not necessarily mean the work receives no First Amendment protection, we can perceive no transformative elements in Saderup's works that would require such protection.

Saderup argues that it would be incongruous and unjust to protect parodies and other distortions of celebrity figures but not wholesome, reverential portraits of such celebrities. The test we articulate today, however, does not express a value judgment or preference for one type of depiction over another. Rather, it reflects a recognition that the Legislature has granted to the heirs and assigns of celebrities the property right to exploit the celebrities' images, and that certain forms of expressive activity protected by the First Amendment fall

outside the boundaries of that right. Stated another way, we are concerned not with whether conventional celebrity images should be produced but with who produces them and, more pertinently, who appropriates the value from their production. Thus, under section 990, if Saderup wishes to continue to depict The Three Stooges as he has done, he may do so only with the consent of the right of publicity holder.

#### IV. Disposition

The judgment of the Court of Appeal is affirmed.

#### Cases Covered In Class

##### *Parks v. LaFace Records*

(6th Cir. 2001)

- [case on Westlaw](#)
- [case on Wikipedia](#)

##### *ETW Corp. v. Jireh Publishing*

(6th Cir. 2003)

- [case on Westlaw](#)
- [Art on Trial](#).

#### Reference/Footnote Cases

- *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994).
- [Texas Right of Publicity Law](#), citing *Matthews*.
- *Comedy III Productions v. Gary Saderup, Inc.*, 21 P.3d 797 (CA 2001).
- [Juris Notes](#).
- *Zacchini v. Scripps-Howard Broadcasting*, 433 US 562 (1977). [Wikipedia](#).
- *Hicks v. Casablanca Records*, 464 F.Supp. 426 (SDNY 1978).
- *Keenan v. Superior Court Los Angeles County*, 40 P.3d 718 (2002). [Reporters Committee For Freedom of the Press](#).

#### Totally Optional Readings & Viewings

- [Katherine Heigl Sues Duane Reed Drug Stores Over Photo](#)
- [Katherine Heigl Ends Lawsuit Over Duane Reade Tweet \(Exclusive\)](#)

- [Lindsay Lohan is suing the makers of Grand Theft Auto V](#)
- [James Franco Sued for Violating Film Rights to Charles Bukowski Novel](#)
- Bing Crosby's First Wife Denied Value of His [Publicity Rights](#): Are likeness rights community property in a marriage?