

# Law & Business For Artists

Richard Dooling

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by Richard Dooling

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### 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. Unlike other personal rights (the right to privacy or the right to protect your reputation), the right of publicity is more about property rights than personality rights. And since it can be sold and licensed to others, some states provide that the right of publicity survives death. Heirs of dead celebrities then inherit the right to control the licensing of the deceased name, image, and likeness.

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 or permission. 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.

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."

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.

The Georgia Supreme 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.

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.

In *Haelan Labs v. Topps Chewing Gum* (2d Cir. 1953), the Second Circuit officially named the new right:

This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ballplayers), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

The *Haelan* case and a famous law review article by [Melville B. Nimmer, \*The Right of Publicity\*](#) (1954), both viewed “right of publicity” as akin to a property interest, rather than a privacy tort.

## Eugene Volokh

### FREEDOM OF SPEECH AND THE RIGHT OF PUBLICITY

The right of publicity ... bars people from “appropriating 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 “using 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](#)
- [Casebrief](#).

James Bolen was the sole proprietor of American Heritage Products a company that wanted to market and sell plastic busts of Dr. Martin Luther King, Jr. Bolen approached the Martin Luther King, Jr. Center for Social Change, Inc. ("King Center") and asked them to endorse the busts and help market them.

The King Center refused Bolen's offer. Bolen went ahead with the project anyway and hired an artist to prepare a mold and an agent to promote the product.

Bolen took out two half-page advertisements in the November and December 1980 issues of Ebony magazine, and offered the bust for sale 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 King 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."

The King Center refused to accept the money offered by Bolen, and instead 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 his company.

**Who Owns Martin Luther King's Publicity Rights?** Pause here and consider who is likely to win this lawsuit? Is it lawful for a sculptor to create and sell an image of Dr. King? Would it be lawful for an author to write a book about Dr. King? As you read excerpts from the case, keep in mind that the right of PUBLICITY is a subspecies of the right of PRIVACY. It's the privacy right that is most like a property right, like intellectual property.

### Excerpts From The Case

The right of publicity may be defined as a celebrity's right to the exclusive use of his or her name and likeness.... 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... [Shortly after the New York Court of Appeals’ denied the right of privacy in its controversial 1902 opinion in] [*Roberson v. Rochester Folding Box Co.*]([http://scholar.google.com/scholar\\_case?case=894920](http://scholar.google.com/scholar_case?case=894920)) 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 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.

*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 ... 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 cannot, 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.* Finding no violation of the first three rights of privacy, the court found a violation of the fourth, saying (*Id.*):

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*):

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...

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*.

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...

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...

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.**

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)

- [Zacchini on Google Scholar](#)

- [Zacchini 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 appro-

priation, 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 station 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...

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.*

### Notes On *Zacchini*

In *Zacchini*, the United States Supreme Court told the Ohio Supreme Court it could rule in favor of the TV station and against Zacchini, but don't rely on the First Amendment to do it.

The Ohio Supreme Court recognized that Zacchini had a state law publicity right, but also found that the TV station had a First Amendment privilege to report on such a "matter of legitimate public interest." After all, Zacchini's act was first and foremost NEWS. Indeed the Ohio Supreme Court cited *Time, Inc.*

*v. Hill* for the proposition that the press has a privilege to report news, even if the reporting intrudes on privacy.

The United States Supreme Court observed that the *Hill* case was a false light PRIVACY case, NOT a right of publicity or intrusion case. The Hill family were not celebrities or performers with “publicity rights,” or with names that have commercial value. Defamation and false light cases involve damage to reputation or mental distress. Zacchini’s interest was proprietary and analagous to the sort of interest protected by the patent or copyright laws, 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 (privacy v. publicity) “differ in the degree to which they intrude on dissemination of information to the public.”

In “false light” cases, the plaintiff wants to “minimize publication of the damaging matter.” In “right of publicity” cases, it’s all about 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.

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

Court of Appeals, 6th Circuit (1983)

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

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.* (S.Ct. 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

toilet company'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. . . . "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 Carson's claim based on the right of publicity because the toilet company does not use Carson's name or likeness. . . . 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." . . . 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.

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, the toilet company'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 plaintiff, 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 the toilet company had appropriated Carson's identity in connection with its corporate name and its product...

Although this opinion holds only that Carson's right of publicity was invaded because the toilet company 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...

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.

*White v. Samsung Electronics America, Inc.*

US Court of Appeals, 9th Circuit (1992)

- [case on Google Scholar](#)
- [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 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.... [T]he 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.

The district court dismissed White’s claim for failure to satisfy the 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....

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 likeness.” *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....

[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 Kozinsky'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 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 Skywalker, 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](#)
- [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.” 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.*” 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 history. *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....

This is a notion so engrained in our First Amendment jurisprudence that last Term we found it so "obvious" as to not require explanation. ... 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." ...

In the context of financial regulation, it bears repeating ... 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.... The First Amendment presumptively places this sort of discrimination beyond the power of the government. ...

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....

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."

## 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.'"

"'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.

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,"... 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." ... 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)

Now that we have discussed the right of publicity, take a look at [this image of the famous Three Stooges](#). What do you suppose would happen if an artist made this sketch, put it on T-shirts and sold them?

We'll work on this one in class. Together!

## Other Cases Covered In Class

### *Parks v. LaFace Records*

(6th Cir. 2001)

- [case on Wikipedia](#)

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

(6th Cir. 2003)

- [Art on Trial](#).

## Trademark (Lanham Act) Language

Lanham Act 43(a)

1. Any person who . . . uses in commerce any word, term, name, symbol, or device . . . or any false designation of origin, false or misleading description of fact . . . which—
  - (a) is *likely to cause confusion* . . . mistake . . . or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship or approval of his or her goods, services or commercial activities . . .
  - (b) . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.



### Volokh Right-Of-Publicity Speech Categories

1. Works that refer to a person but fall within certain favored genres, defined as “news reporting, commentary, entertainment, works of fiction or non-fiction” (Restatement) or “news, public affairs, or sports, or any political campaign” (California Civil Code).
  - Commercial speech? No.
  - Infringement? No.
2. Advertisements for category 1 speech.
  - Commercial speech? Yes.
  - Infringement? No.
3. Advertisements for other products (VCRs, cars, snacks, and whatever else) that refer to a person.
  - Commercial speech? Yes.
  - Infringement? Yes.
4. Works, other than advertisements, that refer to a person and fall outside the favored genres in item 1, such as sculptures, T-shirts, or prints, or, in California, songs, movies, and other entertainment.
  - Commercial speech? No.
  - Infringement? Yes.

### Reference/Footnote Cases

- [\*Matthews v. Wozenkraft\*, 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

- [‘Call of Duty’: Can Rudy Giuliani Beat Manuel Noriega, the Three Stooges and Gwen Stefani?](#)
- [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?