COMMENTS

How Far Is Too Far? The Extension of the Right of Publicity to a Form of Intellectual Property Comparable to Trademark/Copyright

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I. INTRODUCTION

Recently, the news has been inundated with celebrities suing everyone from cosmetics companies to T-shirt designers. This caused me to wonder whether celebrities were using the right of publicity to create actions strikingly similar to the actions brought under copyright or trademark law, thereby making their names and likenesses into something that could almost be characterized as a trademarked or copyrighted work. Therefore, I felt that I needed to analyze this idea of the "right to publicity" more closely.

Right of publicity protection is granted based on whether the act in question is of a commercial nature.[1] But these days, the line between commercial and noncommercial is less defined.[2] Courts have been trying to delineate protected aspects from nonprotected aspects, and in so doing, they are asserting when the First Amendment can stand as a bar to the protection that the right of publicity affords a person.[3] The cases discussed below will show some of the hardships that courts are facing, as well as the tests and rules presented to conquer the problem of what the right of publicity should protect and when such protection should be afforded.

II. WHAT IS THE RIGHT OF PUBLICITY?

A. The Right of Publicity Defined

The right of publicity is simply defined as "the right of every person to prevent the unauthorized commercial use of his or her identity."[4] The right of publicity was first recognized in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*[5] One commentator characterized it as "evolving from the common law of privacy and its tort for the appropriation of a person's name or likeness for the benefit or advantage of another."[6] The right of publicity is said to serve two purposes: (1) it protects individuals from the distress that may result from the unwanted use of their identity and (2) it protects the property interests of those

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1. *See* Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, 1207 PLI/Corp 159, 182 (2000).
2. *See id.*
3. *See* Lauryn Guttenplan Grant, *Restricted Images: Who Owns Einstein? The Emerging Right of Publicity and the Conversion of Public Images to Private Property*, C479 ALI-ABA 669, 671 (1990).
4. Keller, *supra* note 1, at 161.
5. 202 F.2d 866 (2d Cir. 1953).
6. Grant, *supra* note 3, at 671.

individuals in their identities.[7] The right of publicity also allows individuals to transfer their rights by contract, sale, assignment, gift, and, in some cases, by inheritance and will.[8]

B. Historical Background of the Right of Publicity

As noted earlier, the right of publicity was first recognized in the *Haelen* case. The right evolved from the right of privacy, which is an individual's personal right to be left alone and to prevent others from invading his or her privacy.[9] There are four ways that an individual's privacy rights can be violated: intrusion, disclosure, false light, and appropriation.[10] The right of publicity arises from the appropriation violation.[11]

One of the first cases to introduce the problem of appropriation was *Roberson v. Rochester Folding Box Co.*, where the plaintiff sued the defendants for using her portrait in an advertisement without her permission.[12] The court rejected the plaintiff's claim that the defendants had violated her right of privacy, and determined that it was the legislature's job to define the right of privacy to see if it afforded a remedy to a person who did not consent to have her picture used for an advertisement.[13] The New York legislature responded to the court's decision by enacting the 1903 New York Laws chapter 132, sections 1 through 2, which later evolved into the current sections of the New York Civil Rights Law,[14] which prohibit the "use of name, portrait, picture, or voice of living person for advertising or purposes of trade without written consent."[15]

C. How It Protects

Most states recognize some form of the right of publicity.[16] Causes of action arise under statute, common law, or both.[17] Even though there is no federal statute granting a right of publicity, something similar to right-of-publicity claims may be brought as false endorsement claims

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7. *See* Keller, *supra* note 1 at 161.
8. *See* Grant, *supra* note 3, at 671.
9. *See id.*
10. *See id.*
11. *See id.*
12. 64 N.E. 442 (N.Y. 1902).
13. *See id.* at 443.
14. N.Y. Civil Rights Law §§ 50-51 (2003).
15. Keller, *supra* note 1, at 162; N.Y. Civil Rights Law § 50.
16. *See* Keller, *supra* note 1, at 164.
17. *See id.*

under the Lanham Act of the Trademark Act.[18] The false endorsement cause of action "prohibits the use in commerce of a symbol or device likely to deceive consumers as to the sponsorship or approval of goods or services."[19]

1. Duration of the Right of Publicity

The right of publicity protects all persons from the time of birth to the time of death or beyond.[20] In many states, the right of publicity continues after the death of the person.[21] The right can also be descendible property, which can pass intestate to one's heirs or to others by will.[22] When the right of publicity descends after death, it is called the post-mortem right of publicity.[23] In some states, the post-mortem right of publicity only lasts for a certain number of years, while other states' statutes are silent as to the duration of the right, and some courts have even recommended that the right last for a period similar to that of copyright.[24]

Generally, the post-mortem right of publicity is conditionally available based on the exploitation of the right during life; however, there are exceptions to this rule.[25] One such exception was found in *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.*, in which the court rejected the principle that descendability of the right of publicity was conditioned upon lifetime commercial exploitation.[26]

2. The Scope of the Right of Publicity

The right of publicity not only protects celebrities and public figures because they are in the public eye, but it is, in fact, a right that all people possess. The right of publicity and the right of privacy are inverse rights—the more famous a person is, the greater the right of publicity in his name or likeness and the more interest the public has in that person's activities, thereby, affording a lesser right of privacy.[27] "The Right of Publicity protects anything by which a certain human being can be

18. *See id.* at 170; 15 U.S.C. § 1125(a) (2002).
19. Keller, *supra* note 1, at 170.
20. *See* Grant, *supra* note 3, at 672.
21. *See id.*
22. *See id.*
23. *See id.*
24. *See id.* at 673.
25. *See id.*
26. 694 F.2d 674 (11th Cir. 1983); *see also* Grant, *supra* note 3, at 673.
27. *See* Grant, *supra* note 3, at 672.

identified: personal names, nicknames, stage names, pen names, pictures, vocal style . . . and even a persona in a certain role."[28] The right also extends to protect objects and actions by which a person can be identified.[29]

D. The Elements of a Right of Publicity Claim

Though the elements of a right of publicity claim differ from state to state, the most common are: use of identity, ownership of the right of publicity, commercial use of the identity, lack of consent, and some form of harm in each state's form of the right of publicity.[30] One of the most critical issues in determining if one receives right of publicity protection is determining which state's law to apply.[31] Since the right is a state law right and because many of its violators are nationwide, courts often have to apply conflict of laws rules.[32]

1. Identity Use

The statutory laws of some states only afford protection for specific elements of identity. New York, for example, extends statutory protection in name, likeness, or voice.[33] But, under the common law, almost anything that triggers a thought of a particular person is protectable under the broader interpretation of identity.[34] For example, in *Carson v. Here's Johnny Portable Toilets, Inc.*, the court found that Johnny Carson had a right of publicity in the phrase, "Here's Johnny."[35]

2. Valid Ownership of the Right of Publicity

One who is claiming violation of the right of publicity must be able to show that he or she holds a valid ownership interest in the right of publicity in question.[36] The person whose identity is being used, his or her heirs, his or her assignees, and/or his or her exclusive licensees can bring a suit for violation of that person's right of publicity.[37] For example, in *Estate of Presley v. Russen*, the court determined that Elvis Presley's

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28. *Id.*
29. *See id.*
30. *See* Keller, *supra* note 1, at 171-83.
31. *See id.* at 172.
32. *See id.*
33. *See id.*
34. *See id.* at 172-73.
35. 810 F.2d 104, 105 (6th Cir. 1987).
36. *See* Keller, *supra* note 1, at 179.
37. *See id.* at 179-81.

daughter had standing to sue for violation of her father's right of publicity in the state of New Jersey.[38]

3. Commercial Use of Identity

The key to a successful claim for violation of the right of publicity is the type of commercial use of the identity in question. The majority of the right of publicity laws state that no liability can be found without some commercial use.[39] This element is one of the most difficult to analyze because of the increasingly blurred lines between what constitutes advertising and what constitutes free speech comment.[40] In *Eastwood v. Superior Court*, the court had to decide whether the use of actor Clint Eastwood's photo, name, and likeness in the National Enquirer constituted a commercial use.[41] In looking at the commerciality issue, the court stated that because the Enquirer used Eastwood's persona to attract readers, they had gained a commercial advantage, and this action allowed Eastwood to claim that the Enquirer's use was for a commercial purpose.[42]

4. Lack of Consent

There can be no suit for violation of a person's right of publicity if that person consents to allow someone to use that person's identity.[43] Therefore, courts are strict on this requirement, and some actually require that consent must be in writing.[44]

5. Reparable Injury

Finally, there must be some sort of reparable injury, meaning that if the violation does not result in damage or harm to the person whose identity is being used, then there can be no redress to that person. The person whose identity has been used does not need to show specifically how much harm occurred or will occur.[45] The calculation of damages depends on the type of redress sought by the person whose identity is being used.[46] If the person is seeking redress for their dignitary rights,

38. 513 F. Supp. 1339, 1350-51 (D.N.J. 1981).
39. *See* Keller, *supra* note 1, at 182.
40. *See id.*
41. 198 Cal. Rptr. 342, 347 (Ct. App. 1983).
42. *See id.* at 347-49.
43. *See* Keller, *supra* note 1, at 183.
44. *See id.*; *see also* N.Y. Civ. Rights Law § 50 (2003).
45. *See* Keller, *supra* note 1, at 183.
46. *See id.*

then there is no recognized means of calculating damages; but if the person is seeking redress for their property interest in their identity, then the damages are calculated based on the value of that person's persona.[47]

One can seek redress in several ways. One can seek equitable relief, compensatory damages, punitive damages, and even attorney's fees.[48] In granting equitable relief, "court[s] may issue a nationwide injunction, limit an injunction only to those states that provide a right of publicity protection, or limit an injunction only to the forum state."[49] Compensatory damages can generally be given when the market value of the defendant's use of the identity is known.[50] Punitive damages are typically not awarded unless the conduct of the defendant was willful or malicious.[51] Only a few states provide for the recovery of attorney's fees in their right of publicity statutes, and generally, one will not receive them "absent 'extraordinary circumstances.'"[52]

E. Defenses to the Right of Publicity

Generally, defendants will assert some affirmative defense when they are accused of violating a person's right of publicity. Some of the affirmative defenses that can be asserted follow below.

1. First Amendment

An effective defense to a right of publicity claim is the First Amendment.[53] Courts attempt to "balance the scope of the Right of Publicity against societal interests in free expression."[54] Generally, a person is allowed to use another's name, likeness, image, or other characteristics to convey newsworthy events and matters of public interest.[55] This even includes using a person's name or likeness in historical, educational, or factual materials as well as parodies, satire, and unauthorized biographies.[56] A plaintiff can sue if information contained within one of these materials is inaccurate, but only under a claim of defamation or false light.[57]

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47. *See id.*
48. *See id.* at 194-98.
49. *Id.* at 194.
50. *See id.* at 195.
51. *See id.* at 196.
52. *See id.* at 198.
53. *See* Grant, *supra* note 3, at 673.
54. *Id.*
55. *See id.*
56. *See id.*
57. *See id.*

In *Rogers v. Grimaldi*, the court protected filmmaker Fellini's use of Ginger Rogers' first name in his movie entitled "Ginger and Fred."[58] The court drew an analogy between titles of films and titles of musical works:

> Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined.[59]

Though the First Amendment protects many things, it does not protect advertisements that use a person's likeness or name for commercial reasons.[60] The determination of whether a claimed violation is commercial or newsworthy can present a challenge to courts.[61]

In *White v. Samsung Electronics America, Inc.*, Vanna White sued Samsung, alleging that Samsung had used her likeness when it created a commercial that contained a robot that looked very similar to White.[62] The defendants in the case affirmatively argued against the claim, using the parody defense of the First Amendment, in which they stated that the robot ad was protected speech.[63] The court rejected the parody defense because the primary purpose of the ad was to sell televisions, and therefore, was found to be a commercial use rather than a protected newsworthy use.[64]

In *Hoffman v. Capital Cities/ABC, Inc.*, actor Dustin Hoffman sued *Los Angeles Magazine* after it published a picture of him as his character in the film "Tootsie."[65] The trial court found that use of Hoffman's name and likeness was a commercial use, not entitled to First Amendment protection.[66] The magazine appealed, claiming that the First Amendment protected its use of the picture.[67] The Court of Appeals for the Ninth Circuit held that the magazine's use of the picture was noncommercial speech that was protected by the First Amendment, and as such, the trial court's judgment was reversed.[68]

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58. 875 F.2d 994, 996 (2d Cir. 1989).
59. *Id.* at 998.
60. *See* Grant, *supra* note 3, at 673.
61. *See* Karen Frederiksen & A.J. Thomas, *Celebrities Testing Limits of Right of Publicity Laws*, 20 COMPUTER & INTERNET L. 11, 11 (2003).
62. 971 F.2d 1395, 1396 (9th Cir. 1992).
63. *See id.* at 1401.
64. *See id.*
65. 255 F.3d 1180, 1183 (9th Cir. 2001).
66. *See id.*
67. *See id.* at 1183-84.
68. *See id.* at 1189.

Despite the fact that First Amendment protection is nationwide, several states have enacted right of publicity statutes that expressly authorize the use of a person's identity in newsworthy events or matters of public interest.[69] These statutes sometimes give less protection than that afforded by the First Amendment.[70]

2. First Sale Doctrine

The first sale doctrine is found in section 109 of the Copyright Act, and states that once the owner of the right sells a good containing a right, the buyer may resell that good, disregarding the original owner's rights.[71] Therefore, a person cannot claim a violation of his publicity rights when he sells goods conveying those rights to a third party who then sells that right to another person.[72] For example, in *Allison v. Vintage Sports Plaques*, the court rejected a professional athlete's right of publicity in trading cards when those cards were resold and placed on plaques.[73] The court stated that if it were to grant the player a right of control over the reselling of the cards, it would create "a monopoly to celebrities over their identities."[74]

3. The Person's Identity Is Not Used

In order for a plaintiff to assert that his right of publicity has been violated, he must show that his identity was used. If the plaintiff cannot show that the act in question identifies him or her, then there is no cause of action against the defendant.

In *Cohen v. Herbal Concepts, Inc.*, the plaintiffs brought an action against a photographer for pictures he took of them in the nude and used in an advertisement.[75] The defendants requested summary judgment, arguing that "since their faces were not depicted, it was impossible to identify them."[76] The court precluded the defendants from receiving summary judgment because there was a triable issue of fact on whether they were identifiable in the advertisement.[77]

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69. *See* Keller, *supra* note 1, at 186.
70. *See id.* at 186-87.
71. *See* 17 U.S.C. § 109 (2003); *see also* Keller, *supra* note 1, at 185.
72. *See* Keller, *supra* note 1, at 185.
73. 136 F.3d 1443, 1444-45 (11th Cir. 1998).
74. *Id.* at 1449.
75. 473 N.Y.S.2d 426, 427-28 (App. Div. 1984).
76. *Id.* at 428.
77. *See id.* at 431-32.

4. *De Minimis* Use

Some uses of a person's identity have such insignificant commercial value that to allow an action against one who uses the identity for that purpose would not be proper.[78] Several cases have rejected right of publicity claims for *de minimis* use.[79]

In one such case, *D'Andrea v. Rafla-Demetrious*, the court determined that a former hospital resident whose unidentified photo appeared in a hospital recruiting brochure could not succeed under his right of publicity claim because it was such a minor use.[80] The court stated that "[i]n order to establish liability, plaintiff must demonstrate a 'direct and substantial connection between the appearance of the plaintiff's name or likeness and the main purpose and subject of the work.'"[81] The court found that the photo of D'Andrea was incidental to the main purpose of the brochure, which was to provide information of the programs the hospital offered for prospective interns and residents.[82]

5. Preemption

Because the right of publicity is a state law claim, federal law such as copyright can preempt the right if the right of publicity claim is substantially similar to a claim that could be brought under federal law.[83]

In *Toney v. L'Oreal USA, Inc.*, the United States District Court for the Northern District of Illinois found that the plaintiff's claim for right of publicity should be preempted and, therefore, dismissed the case because it asserted an equivalent right of protection under the federal Copyright Act.[84] Plaintiff's claim stated that L'Oreal had violated her right of publicity by distributing her photograph on hair care products after her contract was finished. The court determined that distribution rights were one of the exclusive rights under section 106 and, therefore, her right of publicity claim was preempted by the Copyright Act.[85]

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78. *See* Keller, *supra* note 1, at 184.
79. *See generally id.* at 184-85.
80. 972 F. Supp. 154, 157-58 (E.D.N.Y. 1997).
81. *Id.* at 157 (quoting Preston v. Martin Bregman Prods., Inc., 765 F. Supp. 116, 120 (S.D.N.Y. 1991)).
82. *See id.*
83. *See* Keller, *supra* note 1, at 193.
84. 2002 WL 31455975, at *3 (N.D. Ill. Nov. 1, 2002).
85. *See id.* at *2-*3.

6. No Prior Commercial Exploitation

Some courts require a plaintiff to prove prior commercial exploitation of his or her right of publicity.[86] In these states, the courts will not find a right of publicity violation if there is no prior commercial exploitation.[87]

7. Plaintiff Has No Valid Right of Publicity

Finally, the plaintiff may have no right of publicity. There are several reasons for this, but the main reason is that the plaintiff is not a natural person.[88] The right of publicity only vests in a natural person.[89] In *University of Notre Dame du Lac v. Twentieth Century-Fox Film Corp.*, the court noted that the right of publicity "protect[s] only a 'living person,'" and, therefore, the court held that the university, as a corporation, could not avail itself to the right of publicity.[90]

III. CONFLICTS BETWEEN THE RIGHT OF PUBLICITY AND OTHER FORMS OF INTELLECTUAL PROPERTY

A. Trademark

> A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others. A service mark is a trademark that is used in connection with services.[91]

Trademark, like the right of publicity, protects the name of a person. Trademark law has always been thought to be closely analogous to the right of publicity.[92] Both trademarks and the right of publicity are forms of intellectual property that are placed within the common sphere of unfair competition.[93] The requirement that one must prove damage to his ability to use his persona in order to establish an infringement of his right of publicity is analogous to trademark law's likelihood of confusion test. The likelihood of confusion test states that if the alleged infringing mark is so similar as to cause consumer confusion as to who or what the source

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86. *See* Keller, *supra* note 1, at 185.
87. *See id.*
88. *See id.* at 194.
89. *See id.*
90. 256 N.Y.S.2d 301, 305 (App. Div. 1965).
91. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995).
92. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:8 (4th ed. 2003).
93. *See id.*

is, then there is a valid claim of trademark infringement.[94] Trademark law and the right of publicity are also alike in that they both can be used for quality assurance purposes for the consumer.[95] For example, both a celebrity who markets a particular product, as well as the company producing that product, seek to disallow others from defrauding consumers into believing that a similar product is endorsed by that celebrity or that the company made that similar product. Similarly, both the right of publicity and trademark distinguish between commercial and noncommercial uses of the mark to determine infringement, where marks or identities that are used for commercial purposes are infringing uses.[96]

However, trademark and the right of publicity are not the same. In fact, the two have significant differences.[97] The primary purpose of trademark law is to prevent the consumer from being defrauded.[98] The primary purpose of the right of publicity, as seen earlier, is to protect a person from the unwanted use of his or her identity and to protect that person's property interest in that identity.[99] A trademark identifies and distinguishes a commercial source of a good or service whereas the right of publicity protects the persona of a person, which identifies only that person.[100] Another major difference between the right of publicity and trademark is that the right of publicity is an inherent right that is given to all natural persons whereas a trademark must be acquired after satisfying specific requirements.[101] One commentator explains how both the right of publicity and trademark law can work together despite their differences:

> Obviously, a given person's name, likeness, voice, etc. can be used as a trademark or service mark under the authorization of that person. If these indicia are in fact used to perform the trademark function, then they become protectable as a "trademark" or "service mark." But even if they do achieve trademark status, this does not mean that they cease to identify the persona of that person. Rather, they continue to identify the persona of

94. *See* Jennifer A. Lee, Note, Comedy III Productions, Inc. v. New Line Cinema, 16 BERKELEY TECH. L.J. 183, 187 (2001).

95. *See* Jonathan L. Faber & Wesley A. Zirkle, *Spreading Its Wings and Coming of Age: With Indiana's Law as a Model, the State-Based Right of Publicity Is Ready to Move to the Federal Level*, 45 RES GESTAE, Nov. 2001, at 31-32.

96. *See* Lee, *supra* note 94, at 187.

97. *See* MCCARTHY, *supra* note 92.

98. *See* Lee, *supra* note 94, at 185.

99. *See* Keller, *supra* note 1, at 161.

100. *See* MCCARTHY, *supra* note 92.

101. *See* J. Thomas McCarthy, *Protection of Names and Likenesses as Rights of Publicity or Trademarks: A Comparison*, 8 ENT. L. REP., Nov. 1986, at 3-4.

> that person and also continue to be protectable under the right of publicity.[102]

Many celebrities are using their names as trademarks, and as such, when someone uses their name in an unauthorized manner, these celebrities have the advantage of taking action under both the doctrines of the right of publicity as well as trademark. Because of this, the lines between the right of publicity and trademark blur, causing the courts to apply tests demarcated for trademark to the right of publicity cases. For example, in *Lugosi v. Universal Pictures*, the California Supreme Court found that the right of publicity could only pass to a person's descendants if it acquired secondary meaning, which is a trademark requirement to establish infringement.[103]

B. Copyright

The right of publicity has also been compared to copyright law. The law of copyright is derived from the constitutional right of Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[104] By granting this right, the government seeks to give authors the incentive to create works that enable them to receive a profit.[105] However, copyrights are limited by the First Amendment doctrines of balancing, fair use, and first sale. It is in these limits that copyright looks very similar to the right of publicity.

The First Amendment limit on copyright is similar to the First Amendment limit on the right of publicity. In both areas, the First Amendment will not allow a newsworthy, historical, or expressive piece to be claimed as an infringing use. For instance, there are several musical works that have been parodied by Weird Al Yankovic, but those who own the copyright in these songs cannot win a copyright infringement suit against Weird Al for making a parody of their songs because Weird Al's works are expressive and, therefore, are protected by the First Amendment.[106] This is similar to the right of publicity in that one cannot sue for infringement because someone wants to use his or her identity in a newsworthy manner that is protected by the First Amendment.

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102. MCCARTHY, *supra* note 92, § 28:10.
103. 603 P.2d 425, 430-31 (Cal. 1979).
104. U.S. CONST. art. 1, § 8, cl. 8.
105. *See* Lee, *supra* note 94, at 184.
106. 76 F. Supp. 2d 775, 779-80 (E.D. Mich. 1999).

The First Amendment also allows for the doctrine of fair use. Fair use is a limit on exclusive rights granted copyright owners in the Copyright Act.[107] One aspect of fair use is the ability to use copyrighted material without infringing the copyright holder's copyright because the use qualifies as newsworthy and is, therefore, protected by the First Amendment. Some California courts have used the fair use doctrine to balance the competing interests of the right of publicity with the First Amendment in analyzing right of publicity claims.[108] In so doing, these courts have placed the burden on the defendants by analyzing the First Amendment fair use issue as an affirmative defense to the plaintiff's prima facie case.[109] Two recent decisions in which the court has done this are *Comedy III Productions v. Gary Saderup, Inc.*,[110] and *Winter v. DC Comics*.[111] In *Comedy III Productions*, the plaintiff, who held the licenses to the Three Stooges, sued Gary Saderup, claiming that he violated California Civil Code section 990, which prohibits the use of another's name, photograph, or likeness for commercial purposes.[112] The court construed section 990 as exempting expression that was protected by the First Amendment.[113] In analyzing the First Amendment issue, the court went to the fair use doctrine of copyright and inquired as to whether Mr. Saderup's work was transformative, meaning that it added something new to the original work in question.[114] In so doing, the court tried to establish a correlation between the right of publicity and copyright law by stating "[t]he right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility."[115] In looking at the fair use doctrine, the court focused on the first factor, which examines the character of the use and the purpose of the use.[116] The court offered two alternative inquiries to determine if the use was transformative:

> Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a

107. 17 U.S.C. § 107 (2003).

108. *See* Robert J. Bernstein & Robert W. Clarida, *California's New 'Copyright of Publicity'*, N.Y.L.J., Nov. 15, 2002, at 3.

109. *See id.*

110. 21 P.3d 797 (Cal. 2001).

111. 121 Cal. Rptr. 2d 431 (Ct. App. 2002), *rev'd by* 69 P.3d 473 (Cal. 2003).

112. 21 P.3d at 800-01.

113. *See id.* at 803.

114. *See id.* at 807-08.

115. *Id.* at 804.

116. *See id.* at 808.

> product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness.[117]

The court in *Comedy III Productions* held that the dispositive factor on the issue of whether the work was an infringement was not the type of work created, but rather what the work communicates: the artist's own message or a direct exploitation of the artist's likeness.[118] Because the court determined that Mr. Saderup's work was not transformative, it found that he was liable for infringement of Comedy III Productions' right of publicity license for the Three Stooges.[119]

In *Winter v. DC Comics*, the court again incorporated the transformative factor from the fair use doctrine to balance the competing interests between the First Amendment and the right of publicity.[120] The court then reversed the summary judgment issued by the trial court since there was a triable issue of fact in the question of whether the work was transformative, and remanded the case.[121]

Courts have also adopted the first sale doctrine from the law of copyrights. The first sale doctrine states that one who has purchased a good from the copyright holder can resell that good without concern about possible infringement suits.[122] In *Allison v. Vintage Sports Plaques*, as seen above, the court used the first sale doctrine to prohibit the grant of a monopoly to baseball players who had consented to the use of their images on baseball cards, yet had not consented to those very same baseball cards being framed and sold by another.[123]

IV. RECENT DEVELOPMENTS IN THE RIGHT OF PUBLICITY AREA

Recently, there have been several lawsuits filed over a celebrity right of publicity. Some of these suits cover other areas of intellectual property and suggest that celebrities are pushing the envelope in hopes of making the right of publicity into one of the most powerful forms of intellectual property. Not only is the right of publicity for life, and usually descendible to heirs, thereby removing time constraints, but the right also allows one to receive incentives and rewards just by satisfying the simple requirement of birth as a human being. Because of this, the

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117. *Id.* at 809.
118. *Id.* at 799.
119. *See id.* at 811.
120. 121 Cal. Rptr. 2d 431, 439-40 (Ct. App. 2002), *rev'd by* 69 P.3d 473 (Cal. 2003).
121. *See id.* at 442.
122. *See* Keller, *supra* note 1, at 185.
123. 136 F.3d 1443, 1448-49 (11th Cir. 1998).

right of publicity has become an alternative source of intellectual property rights.

For example, in January 2003, Sarah Jessica Parker and Matthew Broderick made headlines when they decided to sue the cosmetics company Sephora after it ran pictures of the couple in a magazine spread that sought to assign them particular fragrances that matched their respective personalities.[124] Both asserted the common law right of publicity and said that Sephora was violating this right by using their identities for a commercial purpose; i.e., to sell their products.[125]

Another case involved dressmaker Elizabeth Emanuel, who created Princess Diana's wedding gown. Emanuel went bankrupt in 1997, and at the time, entered into a venture with Shami Ahmed, another clothing designer.[126] In this business transaction, Emanuel conveyed all of her interest in the Elizabeth Emanuel company, including her name, to Ahmed.[127] In 2002, Emanuel sued Ahmed for her name back under the law of trademark.[128] Emanuel lost, and Ahmed was able to keep Emanuel's name and in part, her identity as a dressmaker and clothing designer.[129]

Additionally, Victoria Beckham, also known as Posh Spice from the 1990s singing group *The Spice Girls*, decided to sue a soccer team known as the Posh.[130] Beckham brought suit in England to stop the team from using the name on commercial products, invoking the U.S. doctrine of right of publicity.[131]

Similarly, Arnold Schwarzenegger and Fred Astaire's widow, Robyn Astaire, have also instituted actions, both claiming violations of the right of publicity. Schwarzenegger is suing an Ohio car dealership for using his photo in an advertisement without his consent.[132] Schwarzenegger is asking the dealership for $20 million in damages.[133]

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124. *Broderick, Parker Sue Cosmetics Firm*, GLOBE & MAIL, Jan. 24, 2003, at R2.

125. *See id.*

126. *See* Eloise Napier, *Elizabeth Emanuel—I've Lost My Home, Cash and Name but Never My Spirit*, THE EXPRESS, Oct. 19, 2002, at P32, *available at* 2002 WL 101786009.

127. *See id.*

128. *See id.*

129. *See id.*

130. *See* Geoff Baker, Posh Spice v. The Posh*: Victoria Beckham Starts Legal Action over Nickname*, TORONTO STAR, Nov. 8, 2002, at C03, *available at* 2002 WL 101966965.

131. *See id.*

132. *See* Matea Gold, *California Schwarzenegger Isn't Buying It Actor Goes After an Ohio Car Dealer for Using His Likeness Without Permission*, L.A. TIMES, Jan. 22, 2003, at B1, *available at* 2003 WL 2379759.

133. *See id.*

In the Astaire suit, Robyn Astaire, the widow of Fred Astaire, is suing Best Film & Video Corp. for using her late husband's image in an instructional dance video.[134] This suit could have severe implications for the industry if the court disallows this use.[135] Several films have used images of dead actors, and a ruling disallowing the use of these images could have detrimental effects on the cost of movies and the time it takes to make a movie.[136]

V. CONCLUSION

The right of publicity is a form of intellectual property, even if it is not one of the traditional forms, such as copyright or trademark, that arose from the right of privacy and the tort of misappropriation. The right protects all natural persons from unauthorized uses of their names, likenesses, voices, and other characteristics. Because the right is not a federal right, each state determines the scope of the right and can also rely on the common law right of publicity. The right endures for a longer period of time than either copyright or trademark in that it lasts for the life of the person and descends to that person's heirs and/or assignees or licensees. Despite this fact, the right of publicity is similar to both copyright and trademark in several ways, and some courts have recognized this similarity by using traditional trademark concepts, as well as traditional copyright concepts, to decide right of publicity cases. Because of this, right of publicity cases are commonplace and the right of publicity is becoming an alternative to acquiring trademark and/or copyright protection in names, likenesses, and other identifying characteristics. In looking to some of the recent cases that have been filed over right of publicity infringement claims, one can see that the right of publicity will play a significant role in the coming years given the new technologies such as digital imaging as seen in the Astaire lawsuit. The right of publicity has been ever expanding since its inception in the *Haelen* case, and it shows no signs of receding. Because of this, the right of publicity will likely become a more renowned form of intellectual property than copyright, trademark, or even the ever popular patent.

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134. *See Astaire Video Battle Splits Hollywood/Celebrities, Studios Square Off over Rights to Artist's 'Persona'*, HOUS. CHRON., May 17, 1996, at 2, *available at* 1996 WL 5600069; *see also* Astaire v. Best Films, 116 F.3d 1297 (9th Cir. 1997), *cert. denied*, 525 U.S. 868 (1998).

135. *See Astaire Video Battle Splits Hollywood/Celebrities, Studios Square Off over Rights to Artist's 'Persona'*, HOUS. CHRON., May 17, 1996, at 2, *available at* 1996 WL 5600069.

136. *See id.*