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Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media is Merchandiser? Say It Ain't So, Joe

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Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media is Merchandiser? Say It Ain't So, Joe

Darren F. Farrington*

INTRODUCTION

A *Sports Illustrated* clock radio wakes you from a dream of quarterbacking for the Giants or Redskins or Forty-niners. The choice was yours playing "Madden NFL '97" for *SuperNintendo*. You get out of bed, pull off your "NBA on NBC" T-shirt and New York Yankees' "1996 World Series Champions" shorts, and go to the shower. Later, after choosing a suit and dress shirt, you put on a Beatles' *Hard Day's Night* necktie and move to the kitchen for coffee in your Madison Square Garden mug. At your doorstep, you pick up the morning newspaper. The front page features a photo of your favorite sports star scoring the winning basket, or run, or touchdown in last night's game. A flyer falls from inside the paper advertising a poster-size reproduction of the front-page photo, available to the public for five dollars.

In the above scene, the clock, video game, T-shirt, shorts, necktie, coffee mug, and poster are all examples of product merchandise featuring popular figures, franchises, or trade names.[1] Most of such merchandise is licensed by the figure,

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1. *See, e.g.*, *Retail Sales of Licensed Sports Merchandise, By Product Category, U.S.*

franchise, or owner of the name as a source of income.[2] Your favorite sports star, however, might not be too happy about the poster. Because a newspaper is marketing the poster, it might be granted First Amendment protection without the athlete's consent or approval.[3] Moreover, the newspaper's poster might compete with similar posters licensed by the athlete, thereby decreasing sales and affecting the athlete, manufacturer, and merchandiser of the licensed products.[4] If such First Amendment protection attaches to the poster, T-shirts and coffee mugs may soon fall out of newspapers too.

The right which allows a public figure[5] to control the commercial use of his or her name or likeness[6] is the right of

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& Canada, 1995-1996, LICENSING LETTER, Mar. 1, 1997, *available in* WESTLAW, 1997 WL 9041323 (indicating that among categories of merchandise are apparel, electronics, housewares, video games, gifts, and other novelties).

2. Retail sales of licensed merchandise amounted to approximately $69.93 billion in the United States and Canada in 1995. *1995 Shares of Licensed Product Retail Sales, U.S. & Canada, By Product Type*, LICENSING LETTER, Jan. 1, 1996, *available in* WESTLAW, 1996 WL 8313137.

3. The First Amendment allows the media certain uses of a person's name or likeness in reporting newsworthy events and in promoting the media itself. *See infra* part I.C.

4. *See, e.g.*, *Joe Montana and Dwight Clark Featured on Innovative Three-Dimensional Sports Lithograph*, BUS. WIRE, Dec. 12, 1991, *available in* WESTLAW, Allnewsplus File (announcing issue of a lithograph commemorating "The Catch," "the most famous play in San Francisco 49er history"); Tom Graham, *Hey There, Sports Fans!/From Home Plates to Helmet Phones, Furnishings for the Faithful*, S.F. CHRON., Jan. 6, 1993, at 1Z1 (describing various licensed sports products). Sports properties accounted for approximately $13.787 billion in retail sales of licensed merchandise in the United States and Canada in 1996. *Retail Sales of Licensed Sports Merchandise, By Product Category, U.S. & Canada, 1995-1996*, LICENSING LETTER, Mar. 1, 1997, *available in* WESTLAW, 1997 WL 9041323.

5. Definition of the term "public figure" is explored more deeply in case law regarding defamation. *See, e.g.*, Dun & Bradstreet, Inc. v. Greenmoss Builders, 472 U.S. 749, 755-57 (1985); Gertz v. Robert Welch, Inc., 418 U.S. 323, 335-39 (1974). In a case involving the right of privacy, a California Court of Appeal found that a person is a public figure "to the extent that the public has a legitimate interest in his doings, affairs or character." Werner v. Times-Mirror Co., 14 Cal. Rptr. 208, 212 (Ct. App. 1961). Of even more controversy in the area of privacy and publicity rights is the definition of the term "newsworthy." *See infra* part I.C.1.

6. Although the general term "likeness" is used here for simplicity, state statutes differ on what specific representations are actionable. *Compare* CAL. CIV. CODE § 3344(a) (West 1996) ("name, voice, signature, photograph or likeness")

publicity.[7] In several states, a codified right of publicity prohibits merchandising or advertising which uses a person's name or likeness without consent.[8] In other states, the right is included in a codified right of privacy,[9] or may be found in common law.[10] All state rights of publicity, however, are twentieth-century developments[11] and many remain unsettled.[12]

Due to the continuing development of this area of law, both state and federal courts applying either statutory or common law publicity rights have sought guidance from less than analogous cases, and from opinions of other states and federal courts.[13] For this reason, one court's decision

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with N.Y. CIV. RIGHTS LAW § 51 (McKinney 1996) ("name, portrait, picture or voice"). The most extensive protection exists in Indiana, where the state statute defines the use of "personality" as "name; voice; signature; photograph; image; likeness; distinctive appearance; gestures; or mannerism." IND. CODE ANN. § 32-13-1-6 (Burns 1995).

7. The right was first named by the United States Court of Appeals for the Second Circuit, applying New York law, in *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953). *See infra* notes 60-61 and accompanying text (discussing development of the right of publicity). For a comprehensive review of the law of publicity rights, see generally J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY (1987 & Supp. 1996); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46-49 (1995).

8. *See, e.g.*, CAL. CIV. CODE § 3344; IND. CODE ANN. §§ 32-13-1-1 to -20. For a complete list of states protecting the right of publicity, see *infra* note 52.

9. *See, e.g.*, N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1996); R.I. GEN. LAWS §§ 9-1-28 to -28.1 (1985 & Supp. 1996).

10. *See, e.g.*, Eastwood v. Superior Court, 198 Cal. Rptr. 342, 347 (Ct. App. 1983) ("common law cause of action for appropriation of name and likeness may be pleaded"). *But see* Stephano v. News Group Publications, Inc. 474 N.E.2d 580, 584 (N.Y. 1984) ("plaintiff cannot claim an independent common-law right of publicity").

11. *See infra* part I.B.

12. The New York Court of Appeals, for example, has yet to definitively rule on the assignability, transferability, or descendibility of publicity rights. *Compare* Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215, 221 (2d Cir. 1978) (applying New York law) ("The identification of this exclusive right [of publicity] . . . as a transferable property right compels the conclusion that the right survives . . . death.") *with* Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 n.2 (N.Y. 1984) ("we need not consider whether the statute would also control assignment, transfer or descent of publicity rights").

13. *See, e.g.*, Montana v. San Jose Mercury News, Inc., 40 Cal. Rptr. 2d 639, 641 (Ct. App 1995) ("we have been unable to locate any cases directly on point");

may affect the scope of publicity rights in all jurisdictions of the United States.[14]

In a 1995 California case, *Montana v. San Jose Mercury News, Inc.*,[15] a California Court of Appeal affirmed a summary judgment holding that the *Mercury News* had a First Amendment right to reprint and sell poster-size prints of drawings and photographs of professional football player "Joe" Montana that had previously appeared in the newspaper's pages.[16] The court reasoned that the posters "reported on newsworthy events"[17] and that a "newspaper has a constitutional right to promote itself by reproducing its news stories."[18]

By upholding the summary judgment in *Montana*, the California courts did not allow finders of fact to consider whether the *Mercury News*' posters were in fact advertising or a form of product merchandising.[19] Moreover, by holding

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Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215, 220 (2d Cir. 1978) ("we have sought assistance from federal court decisions interpreting and applying New York law, as well as decisions from courts of other states").

14. No federal right of publicity exists. For a discussion of such a proposed right, see generally J. Eugene Salomon, Jr., *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987).

15. 40 Cal. Rptr. 2d 639 (Ct. App. May 3, 1995), *as modified*, (May 30, 1995), *review denied*, (Aug. 17, 1995).

16. *Id.* For a more complete description of the posters, see *infra* text accompanying notes 162-69. Under California law, affirmance of a summary judgment is appropriate only where "the appellate court [has] resolved[d] all doubts in favor of the party opposing the judgment." M.B. v. San Diego, 284 Cal. Rptr. 555, 557 (Ct. App. 1991). To do so, the court must "conduct[] a de novo examination to see whether there are any genuine issues of material fact or whether the moving party is entitled to summary judgment as a matter or law." *Id.* According to the United States Supreme Court, applying the Federal Rules of Civil Procedure, a "genuine issue of material fact" exists where the issue "properly can be resolved only by a finder of fact because [it] may reasonably be resolved in favor of either party." Anderson v. Liberty Lobby, 477 U.S. 242, 251 (1986).

17. *Montana*, 40 Cal. Rptr. 2d at 794.

18. *Id.* at 796.

19. *See Joe Montana Loses Right of Publicity Lawsuit Against San Jose Mercury News Seeking Compensation for Newspaper's Sale of Poster Reproductions of Its Pages Bearing His Name and Likeness*, ENT. L. REP., Aug. 1995, *available in* LEXIS, News Library, Entrep File [hereinafter *Joe Montana loses right*] (noting that many commentators consider posters to be more similar to toys or other products than to

that the posters were not a misappropriation of Montana's name and likeness for merchandising purposes, the California courts have begged the question of whether the news media may merchandise any item, such as a T-shirt or coffee mug, containing newsworthy print or photographs.[20] Such a reading of *Montana* may immunize the media from almost any claim against it based on the right of publicity.

Titan Sports, Inc. v. Comics World Corp.,[21] a 1989 case in which the Second Circuit Court of Appeals applied New York law, concerned a situation closely analogous to *Montana*. There, the media defendants published large "fold-out" posters of professional wrestlers within their magazines' pages.[22] At issue was whether the trial court properly granted summary judgment where such posters might be considered merchandised products separate from the usual content of a magazine.[23] The court ruled that a finder of fact must make that distinction.[24]

This Note argues that courts should not grant the media First Amendment protection to merchandise products, including posters, which appropriate without consent the names or likenesses of public figures. Part I reviews the right of publicity as developed through case law and statutes, focusing on the laws of New York and California. Part II presents the facts and procedural history of the *Montana*

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newspapers, magazines, or books).

20. *Cf. id.* (suggesting that the *Mercury News*' posters are merchandised products). To date, *Montana* has been cited in only two cases. *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 416 (9th Cir. 1996), distinguished *Montana* where General Motors used basketball legend Kareem Abdul-Jabbar's former name, Lew Alcindor, in advertising. *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649 (Ct. App. 1996), cited *Montana* only for the proposition that statutory and common law rights of publicity co-exist in California. *See infra* part I.B.2.a (differentiating California statutory and common law).

21. 870 F.2d 85 (2d Cir. 1989), *rev'g* 690 F. Supp. 1315 (S.D.N.Y. 1988).

22. Titan Sports, Inc., v. Comics World Corp., 690 F. Supp. 1315, 1317 (S.D.N.Y. 1988), *rev'd*, 870 F.2d 85 (2d Cir. 1989). For a more complete description of the posters, see *infra* text accompanying notes 198-204.

23. *Titan Sports*, 870 F.2d at 88-89.

24. *Id.* at 89.

and *Titan Sports* decisions. Part III defines issues that courts must address in cases where the media merchandises products. Part III then analyzes the *Montana* decision of the California Court of Appeal, and, finally, proposes that the California court should have applied the Second Circuit's *Titan Sports* test to *Montana*. Accordingly, this Note concludes that the First Amendment should not protect the media in merchandising products that infringe upon a celebrity's right of publicity.

I. THE RIGHT OF PUBLICITY

The right of publicity protects against the commercial[25] misappropriation of a person's name or likeness[26] without consent.[27] Generally, the right benefits entertainers, athletes, and other celebrities who have developed well-known images with a commercial value.[28] Many state statutes also provide for descendibility of the right.[29]

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25. *See infra* part I.B.1.b (discussing commercial use in New York law).

26. *See supra* note 6 (explaining use of the term "likeness").

27. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) (providing that "[o]ne who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia or identity for purposes of trade is subject to liability").

28. *See, e.g.*, Shamsky v. Garan, Inc., 632 N.Y.S.2d 930 (Sup. Ct. 1995) (former professional baseball players); Titan Sports, Inc. v. Comics World Corp., 870 F.2d 85 (2d Cir. 1989) (professional wrestlers); Eastwood v. Superior Court, 198 Cal. Rptr. 342 (Ct. App. 1983) (actor); Cher v. Forum Int'l, Ltd., 692 F.2d 634 (9th Cir. 1982) (actress and entertainer); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) ("human cannonball"); Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953) (professional baseball players). In some jurisdictions, the right extends to non-celebrities. *See, e.g.*, Dora v. Frontline Video, Inc., 18 Cal. Rptr. 2d 790, 792 n.2 (Ct. App. 1993) ("Although there is a split of opinion among jurisdictions as to whether a 'non-celebrity' should have the right to sue for the commercial value of unpermitted use of personal identity, the case law in California assumes without discussion that the right exists.").

29. *See, e.g.*, CAL. CIV. CODE § 990(g) (West 1996) (separate statute providing for 50 year duration of a post-mortem right of publicity); IND. CODE ANN. § 32-13-1-8 (Burns 1995) (100 years); TENN. CODE ANN. § 47-25-1104(a) (Michie 1995) (10 years). *But see* Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 n.2 (N.Y. 1984) ("[W]e need not consider whether the statute would also control assignment, transfer or descent of the publicity rights."). For a discussion of the survivability of publicity rights, see J. Steven Bingman, *A Descendible Right of*

This part introduces the right of publicity. First, this part briefly reviews the derivation and development of the right. Second, it focuses on the laws of New York and California, the two states in which right of publicity cases are most litigated.[30] Finally, this part presents the conflict between publicity rights and the First Amendment, and the exceptions and defenses created thereby.

A. *Derivation from the Right of Privacy*

The right of publicity derives from the right of privacy, which itself is a modern development of tort law.[31] In fact, not until the late nineteenth century did legal scholars consider the enforceability of a right of privacy.[32] Then, an 1890 article by Samuel Warren and future Supreme Court Justice Louis Brandeis, in the fourth volume of the *Harvard Law Review*, called for legal acknowledgment of the right "to be let alone."[33] Warren and Brandeis voiced the turn of the century concern that "[i]nstantaneous photographs and newspaper enterprise have invaded the sacred precincts of private and domestic life"[34] and advocated that "[p]olitical,

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Publicity: Has the Time Finally Come for a National Standard?, 17 PEPP. L. REV. 933 (1990); Andrew B. Sims, *Right of Publicity: Survivability Reconsidered*, 49 FORDHAM L. REV. 453 (1981).

30. *See* Paul Cirino, *Advertisers, Celebrities, and Publicity Rights in New York and California*, 39 N.Y.L. SCH. L. REV. 763, 768 (1994).

31. *See* Melville B. Nimmer, *The Right of Publicity*, 19 L. & CONTEMP. PROBS. 203, 203-10 (1954).

32. *Id.*

33. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193. Warren and Brandeis cite to THOMAS M. COOLEY, COOLEY ON TORTS 29 (2d ed. 1888), where Cooley used the phrase "to be let alone" in the general sense of being free from injury. Warren & Brandeis, *supra*, at 195.

While the right of privacy is generally traced to Warren and Brandeis, they themselves review the history of the advocacy of privacy rights. *Id.* at 195-96. In 1928, in a criminal law context, Justice Brandeis advocated the right "to be let alone" in a Supreme Court case reviewing the constitutionality, under the Fourth and Fifth Amendments, of wiretapping. Olmstead v. United States, 277 U.S. 438, 478 (1928) (Brandeis, J., dissenting).

34. Warren & Brandeis, *supra* note 33, at 195. Warren and Brandeis commented:

> The press is overstepping in every direction the obvious bounds of pro-

social, and economic changes entail the recognition of new rights . . . ."[35]

In 1903, because the New York Court of Appeals had refused to recognize a right of privacy at common law,[36] the state legislature became the first to codify such a right.[37] The Court of Appeals later noted, "the statute was born of the need to protect the individual from selfish, commercial exploitation of his personality"[38] and has repeatedly held that the right is entirely statutory in New York.[39]

As developed through the twentieth century, the law of privacy has come to refer to a number of overlapping personal interests affiliated only by name and by the fact that each, in its essence, still involves the right "to be let alone."[40] By mid-century, the right to privacy included causes of action for "intrusion" into one's private affairs; "disclosure" of one's embarrassing private facts; publicity placing one in a "false light in the public eye;" and "appropriation," usually

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> priety and of decency. Gossip is no longer the resource of the idle and of the vicious, but has become a trade, which is pursued with industry as well as effrontery. To satisfy a prurient taste the details of sexual relations are spread broadcast in the columns of the daily papers. To occupy the indolent, column upon column is filled with idle gossip, which can only be procured by intrusion upon the domestic circle. The intensity and complexity of life, attendant upon advancing civilization, have rendered necessary some retreat from the world, and man, under the refining influence of culture, has become more sensitive to publicity, so that solitude and privacy have become more essential to the individual; but modern enterprise and invention have, through invasions upon his privacy, subjected him to mental pain and distress, far greater than could be inflicted by mere bodily injury.

Id. at 196.

35. *Id.* at 193.

36. Roberson v. Rochester Folding Box Co., 64 N.E. 442 (N.Y. 1902) (refusing to grant relief to a plaintiff whose picture had been used without consent on flour boxes); *see also* William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 384-86 (1960) (reviewing statutory history of New York Civil Rights Law §§ 50-51).

37. N.Y. CIV. RIGHTS LAW §§ 50-51; *see also* Prosser, *supra* note 36, at 384-86.

38. Gautier v. Pro-Football, Inc., 107 N.E.2d 485, 487 (N.Y. 1952).

39. *See, e.g.*, Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 (N.Y. 1984); Arrington v. New York Times Co., 434 N.E.2d 1319, 1321 (N.Y. 1982); Gautier v. Pro-Football, Inc., 107 N.E.2d 485, 487 (N.Y. 1952).

40. Prosser, *supra* note 36, at 389.

for commercial advantage, of one's name or likeness.[41]

It is appropriation, the last of Prosser's four rights of privacy, which further evolved into the protection provided by the right of publicity.[42]

B. *Right of Publicity Laws*

Before courts formally recognized the right of publicity, one New York Court of Appeals judge distinguished a public figure's claimed right of publicity from the right of privacy by noting that the "grievance here is not the invasion of his 'privacy,' privacy is the one thing he did not want, or need, in his occupation."[43] Hoping to gain or maintain celebrity status, right of publicity claimants therefore do not generally seek to enjoin the use of their name or likeness, but rather ask to be paid for that use.[44] In contrast then to privacy rights, the right of publicity protects celebrities' interests in the use of their names and images as a profitable property right.[45]

Another distinction between privacy rights and the right of publicity is the states' interest in protecting those rights.[46] While the right of privacy protects a private individual from

41. *Id.*; *see also* RESTATEMENT (SECOND) OF TORTS §§ 652A-652I (1977) (classifying the right of privacy into Prosser's four types). Invasion of privacy, as a tort in at least one form, is now recognized, either in statute or common law, by nearly all United States jurisdictions. MCCARTHY, *supra* note 7, § 6.1[A], at 6-4 to -5.

42. MCCARTHY, *supra* note 7, § 1.5[D]-1.7, at 1-24 to -36.

43. Gautier v. Pro-Football, Inc., 107 N.E.2d 485, 489 (N.Y. 1952) (Desmond, J., concurring).

44. *See, e.g.*, Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 578 (1977) ("Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it."); *Gautier*, 107 N.E.2d at 489 (noting that plaintiff's "real complaint . . . is that he was not paid").

45. The classification of the right of publicity as a property right stems from a seminal article by Melville B. Nimmer. Melville B. Nimmer, *The Right of Publicity*, 19 L. & CONTEMP. PROBS. 203 (1954); Floyd A. Gibson & Rachel M. Healey, *The Right of Publicity Comes of Age*, 23 AIPLA Q.J. 361, 365-66 (1995); *see also Zacchini*, 433 U.S. at 573 (protecting "the proprietary interest of the individual in his act").

46. *Zacchini*, 433 U.S. at 573.

public exposure and embarrassment,[47] the right of publicity protects a citizen's investment in his image, and therefore is "closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation."[48] Also analogizing the right of publicity to intellectual property interests, the United States Supreme Court, in its sole case addressing a state right of publicity, compared the right of publicity to the protection provided by unfair competition law.[49] Establishing that the rationale for protecting the right of publicity is the "straightforward one of preventing unjust enrichment," the Court reasoned that "[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value . . . ."[50] Therefore, those states which protect the right of publicity are likely to do so to encourage and reward an investment in one's image and personality.[51]

Currently, twenty-five states recognize the right of publicity either in statute or through common law.[52] Fifteen

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47. Prosser, *supra* note 36, at 392 (noting that the right of privacy has the "same overtones of mental distress as in defamation").

48. *Zacchini*, 433 U.S. at 573.

49. *Id.* at 576. For further discussion of *Zacchini*, see *infra* text accompanying notes 111-15.

50. *Zacchini*, 433 U.S. at 576.

51. Shamsky v. Garan, Inc., 632 N.Y.S.2d 930, 937 (Sup. Ct. 1995) (noting that the right of publicity protects "invested years of practice and competition in a public personality which eventually may reach marketable status").

52. MCCARTHY, *supra* note 7, §§ 6.1-.15, at 6-1 to -85 (compiling state common and statutory law); *see also* CAL. CIV. CODE § 3344 (West 1996); Eastwood v. Superior Court, 198 Cal. Rptr. 342 (Ct. App. 1983) (recognizing California common law right); Jim Henson Prods. v. John T. Brady & Assocs., 867 F. Supp. 175 (S.D.N.Y. 1994) (deciding Connecticut common law); FLA. STAT. ANN. § 540.08 (West 1996); Genesis Publications, Inc. v. Goss, 437 So. 2d 169 (Fla. Dist. Ct. App. 1983) (plaintiff relied solely on Florida common law); Martin Luther King, Jr. Ctr. v. Am. Heritage Prods., 296 S.E.2d 697 (Ga. 1982) (Georgia common law); Fergerstrom v. Hawaiian Ocean View Estates, 441 P.2d 141 (Haw. 1968) (labeling misappropriation as Hawaii common law privacy right); Douglass v. Hustler Magazine, Inc., 769 F.2d 1128 (7th Cir. 1985) (deciding Illinois common law); IND. CODE ANN. §§ 32-13-1-1 to -20 (Burns 1995); KY. REV. STAT. ANN. § 391.170 (Michie 1984); Cheatham v. Paisano Publications, Inc., 891 F. Supp. 381 (W.D. Ky. 1995)

states protect publicity rights statutorily,[53] some through privacy statutes[54] and others through legislation specifically aimed at protecting publicity rights.[55] Common law is the sole protector of the right of publicity in ten states;[56] an additional six states providing statutory protection recognize a common law right as well.[57] These sixteen common law states include those whose own courts have recognized the right,[58] and those in which federal courts, applying state law, have held that a state right exists.[59]

(deciding Kentucky common law); MASS. ANN. LAWS ch. 214, § 3A (Law. Co-op. 1986); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (deciding Michigan common law); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970) (deciding Minnesota common law); Haith v. Model Cities Health Corp., 704 S.W.2d 684 (Mo. Ct. App. 1986) (Missouri common law); NEB. REV. STAT. ANN. §§ 20-201 to -211 (Michie 1991); NEV. REV. STAT. ANN. §§ 597.770-.810 (Michie 1994); Estate of Elvis Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (deciding New Jersey common law); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1996); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (reviewing Ohio common law); OKLA. STAT. ANN. tit. 12, §§ 1448-1449 (West 1993); Gee v. CBS, Inc., 471 F. Supp. 600 (E.D. Pa. 1979) (deciding Pennsylvania common law); R.I. GEN. LAWS §§ 9-1-28 to -28.1 (1996); TENN. CODE ANN. §§ 47-25-1101 to -1108 (1995); TEX. PROP. CODE ANN. §§ 26.001-.015 (West 1996); Kimbrough v. Coca-Cola/USA, 521 S.W.2d 719 (Tex. Civ. App. 1975) (recognizing appropriation as Texas common law privacy right); UTAH CODE ANN. §§ 45-3-1 to -6 (Michie 1993); Nature's Way Prods., Inc. v. Nature-Pharma, Inc., 736 F. Supp. 245 (D. Utah 1990) (deciding Utah common law); VA. CODE ANN. §§ 8.01-40 (Michie 1992); WISC. STAT. ANN. § 895.50 (West 1996); Hirsch v. S.C. Johnson & Sons, 280 N.W.2d 129 (Wis. 1979) (recognizing Wisconsin common law right).

53. *See supra* note 52 ("statutory" states include California, Florida, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Texas, Utah, Virginia, and Wisconsin).

54. *See, e.g.*, N.Y. CIV. RIGHTS LAW §§ 50-51; R.I. GEN. LAWS §§ 9-1-28 to -28.1.

55. *See, e.g.*, CAL. CIV. CODE § 3344; IND. CODE ANN. §§ 32-13-1-1 to -20.

56. *See supra* note 52 ("common law" states include Connecticut, Georgia, Hawaii, Illinois, Michigan, Minnesota, Missouri, New Jersey, Ohio, and Pennsylvania).

57. *See supra* note 52 (additional "common law" states include California, Florida, Kentucky, Texas, Utah, and Wisconsin).

58. *See, e.g.*, Martin Luther King, Jr. Ctr. v. American Heritage Prods., 296 S.E.2d 697 (Ga. 1982).

59. *See, e.g.*, Jim Henson Prods. v. John T. Brady & Assocs., 867 F. Supp. 175, 189 (S.D.N.Y. 1994) ("I hold that Connecticut's high court would recognize the right of publicity.").

1. New York

a. Development of the Right of Publicity

A common law right of publicity, as an enforceable action independent of the right to privacy, was first recognized in a federal court in the Southern District of New York in 1953.[60] There, applying New York law, the court held that, "in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . ."[61]

A common law cause of action for the protection of publicity rights continued in New York until 1984, when the state's high court held that the right of publicity, like the right of privacy,[62] is protected solely by statute in New York.[63] The court found that because the privacy rights statutes, New York Civil Rights Law sections 50 ("section 50")[64] and 51 ("section 51"),[65] are "not limited to situations where the defendant's conduct has caused distress to a person who wishes to lead a private life," relief in publicity right actions, as in privacy actions, is limited to the statutes.[66]

Sections 50 and 51 continue to protect both privacy rights and publicity rights in New York.[67] Although both sections

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60. Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).

61. *Id.*

62. *See supra* note 39 and accompanying text (indicating that the right of privacy is solely statutory in New York).

63. Stephano v. News Group Publications, Inc., 474 N.E.2d 580 (N.Y. 1984).

64. N.Y. CIV. RIGHTS LAW § 50 (McKinney 1996).

65. *Id.* § 51 (McKinney 1996).

66. *Stephano*, 474 N.E.2d at 584.

67. *See* J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 134 (1995) ("[T]he New York Court of Appeals sees the right of publicity as a mere 'aspect' of the New York statutory law of privacy.")
For the past several years, legislation has been proposed which would create a statutory right of publicity in New York, including a posthumous right. *See* Leonard M. Marks & Robert P. Mulvey, *Celebrity Rights Law Needed in New York*, N.Y. L.J., Nov. 6, 1995, at 1; Alan J. Hartnick, *The History of the Right of Publicity in New*

apply to the same acts of a defendant, section 50 is a penal section which classifies infringement of the right as a misdemeanor; section 51 provides a civil cause of action which allows both injunctive relief and monetary compensation.[68] Elements of the action consist of use of a living person's "name, portrait, picture or voice"[69] for "advertising purposes, or for the purposes of trade"[70] and failure to obtain that person's written consent for such use.[71]

b. Commercial Use

In New York, sections 50 and 51 disallow unconsented use of a person's name or likeness for the specific act of "advertising" and, more generally, for "purposes of trade."[72] The New York Court of Appeals has noted that relief is liberally granted when misappropriation occurs for advertising purposes.[73] Claims of use for other commercial purposes,

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York, N.Y. L.J., Apr. 17, 1992, at 5. To date, however, no such legislation has been passed.

68. N.Y. CIV. RIGHTS LAW §§ 50-51.

69. *Id.* § 51. Section 50, however, includes only "name, portrait or picture," thereby excluding misappropriation of "voice" from criminal penalty. *Id.* § 50.

Because no common law right of publicity exists in New York, protection is limited by section 51 to appropriation of only "name, portrait, picture or voice". *See* Gibson & Healy, *supra* note 45, at 385. Some courts applying New York law, however, have expanded the meaning of these terms. *See, e.g.*, Allen v. National Home Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985). In *Allen*, where defendant used a "look-alike" of Woody Allen in an advertisement, the court held that a commercial use "which has no other purpose than to represent its subject, must give rise to a cause of action under the Civil Rights Law, because it raises the obvious implication that its subject has endorsed or is otherwise involved with the product being advertised." *Id.* at 622; *accord* Onassis v. Christian Dior N.Y., Inc., 472 N.Y.S.2d 254 (Sup. Ct. 1983) (involving an advertisement using a look-alike of Jacqueline Kennedy Onassis).

In appropriation cases where an advertiser falsely implies celebrity endorsement, relief may also be available under section 43(a) of the Lanham Act, Trademark Act of 1946 ("Lanham Act"), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A. § 1125(a) (West Supp. 1996)), the federal trademark and unfair competition law, where the standard is not "identifiability," but "likelihood of confusion." *See, e.g.*, *Allen*, 610 F. Supp. at 625-31.

70. N.Y. CIV. RIGHTS LAW §§ 50-51.

71. *Id.*

72. *Id.*

73. *See* Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501, 505 (Sup. Ct.

such as merchandising, are no less actionable.[74]

While the New York legislature did not define "advertising" or "purposes of trade" in the statutes,[75] courts applying New York law have carved out what types of uses are not considered actionable. Such "fair uses"[76] include, generally, reporting of news and public interest stories,[77] and the media's promotion of itself.[78] Fair use in news reporting, however, includes not only "headline" and political news, but also extends to the commentary on social trends and articles of public and consumer interest.[79] Specific cases of fair use in New York have included fashion news in *New York* magazine indicating where a pictured article of clothing could be purchased;[80] the performance of stage plays and films; [81] and the public distribution of calendars[82] and posters.[83]

1968); *see also Stephano*, 474 N.E.2d at 584.

74. *See, e.g.*, Shamsky v. Garan, Inc., 632 N.Y.S.2d 930 (Sup. Ct. 1995) (commercial use on baseball jerseys); Titan Sports, Inc. v. Comics World Corp., 870 F.2d 85 (2d Cir. 1989) (commercial use on posters).

75. *See Stephano*, 474 N.E.2d at 584 (noting that "[t]he statute does not define trade or advertising purposes").

76. "Fair use," a term borrowed from copyright law, Copyright Act of 1976, 17 U.S.C.A. § 107 (West Supp. 1996), is equally applicable to right of publicity jurisprudence. *See, e.g.*, H. Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity*, 17 COLUM.-VLA J.L & ARTS 1, 28-30 (1992).

77. *See infra* part I.C.1.

78. *See infra* part I.C.2.

79. *Stephano*, 474 N.E.2d at 585.

80. *Id.* at 581-82.

81. Hampton v. Guare, 600 N.Y.S.2d 57, 58 (App. Div. 1993). In *Hampton*, an action which involved the play and film *Six Degrees of Separation*, both of which were based on the story of an actual person, the court held that "works of fiction and satire do not fall within the narrow scope of the statutory phrases 'advertising' and 'trade.'" *Id.*

82. Beverley v. Choices Women's Medical Ctr., Inc., 532 N.Y.S.2d 400, 402 (App. Div. 1988) (involving the unauthorized use of a physician's photograph on a medical center calendar).

83. Brinkley v. Casablancas, 438 N.Y.S.2d 1004, 1006 (App. Div. 1981) (involving the retail sale of an unauthorized poster of model Christie Brinkley).

2. California

a. Statutory and Common Law

Unlike New York, California recognizes both a common law and a statutory right of publicity.[84] The statute was enacted in 1971 as California Civil Code section 3344 ("section 3344"),[85] and the common law right was acknowledged in 1979 by a California appellate court.[86]

To plead an infringement of the common law right, a plaintiff must allege: the defendant's appropriation of the plaintiff's name or likeness for the defendant's commercial or other advantage; lack of consent; and resulting injury.[87] Section 3344 requires the additional showing of "knowing use . . . for purposes of advertising or solicitation of purchases."[88] The statute, however, provides that statutory remedies are cumulative and additional to any others provided by common law.[89]

In California, as in New York,[90] an action for misappropriation of a person's name or likeness generally involves some type of commercial use.[91] Section 3344 protects against

84. *See, e.g.*, Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988); Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 (Ct. App. 1983); CAL. CIV. CODE § 3344 (adopted 1971); CAL. CIV. CODE § 990 (West 1990) (protecting a post-mortem right of publicity for 50 years) (adopted 1984).

85. CAL. CIV. CODE § 3344 (West 1996); *see also* Robert B. Miller, *Commercial Appropriation of an Individual's Name, Photograph or Likeness: A New Remedy for Californians*, 3 PAC. L.J. 651 (1972) (tracing California privacy and publicity rights law and culminating with the enactment of section 3344).

86. Lugosi v. Universal Pictures, 603 P.2d 425, 428 (Cal. 1979). The United States Court of Appeals for the Ninth Circuit, however, had recognized a California common law right of publicity in 1974. Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 825 (9th Cir. 1974) (holding that "California appellate courts would, in a case such as this one, afford legal protection to an individual's proprietary interest in his own identity").

87. *Eastwood*, 198 Cal. Rptr. at 347.

88. *Id.*

89. CAL. CIV. CODE § 3344(g).

90. *See supra* part I.B.1.a.

91. *But see Eastwood*, 198 Cal. Rptr. at 347 ("A common law cause of action for appropriation . . . may be pleaded by alleging . . . appropriation . . . *to defendant's advantage, commercially or otherwise*.") (emphasis added).

misappropriation of "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 . . . ."[92] California common law, however, does not require that the use of a person's name or likeness imply an endorsement or any association with the allegedly injured person.[93] The lack of such a requirement results in California common law offering broader protection than section 3344.

b. Broadening of California Common Law

Because California common law is not limited to the statutory appropriations of "name, voice, photograph, or likeness,"[94] the California common law right of publicity is also broader than section 3344 with regard to the aspects of a person which it protects.[95] For example, the United States Court of Appeals for the Ninth Circuit extended the right in 1974 and allowed recovery where cigarette advertisers pictured a race car clearly recognizable as that of the plaintiff, a widely-known professional racer.[96] The court held that the use of the plaintiff's distinctive car was sufficient to evoke the identity of the celebrity driver.[97]

The Ninth Circuit again broadened California common law in 1992 in a case involving game show hostess, Vanna White.[98] There, an advertiser had pictured a robot dressed in a blond wig, a gown, and jewelry, and posed next to the famous Wheel of Fortune game board.[99] The circuit court, reversing a summary judgment against White, found that,

92. CAL. CIV. CODE § 3344(a).
93. *Eastwood*, 198 Cal. Rptr. at 347.
94. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1992).
95. *See* Stephen M. Lobbin, *The Right(s) of Publicity in California: Is Three Really Greater than One?*, 2 UCLA ENT. L. REV. 157, 168 (1995).
96. Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974).
97. *Id.* at 827.
98. *White*, 971 F.2d at 1397-99.
99. *Id.* at 1396.

under California common law, "[i]t is not important how the defendant has appropriated the plaintiff's identity, but whether the defendant has done so."[100] The Ninth Circuit's holding that it is only important *whether* a defendant has appropriated some aspect of a plaintiff's personality, coupled with the fact that the common law infringement does not require "knowing use,"[101] has caused some commentators to infer that the California common law right of publicity is a tort of strict liability.[102]

C. *First Amendment Conflicts with the Right of Publicity*

Despite the relief provided by various common law and statutory rights of publicity, no person can control every use of his or her name or picture.[103] In some circumstances, both publicity and privacy rights must yield to the First Amendment freedoms of speech and press and corresponding state freedoms.[104] Due to those freedoms, a large portion of the

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100. *Id.* at 1398. Additional cases in which plaintiffs have succeeded in California common law actions where their identity was merely evoked include "sound-alike" cases. *See, e.g.*, Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992) (imitation of singer Tom Waits' voice); Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (imitation of singer Bette Midler's voice).

101. *See supra* note 88 and accompanying text (indicating that only CAL. CIV. CODE § 3344 requires "knowing" use).

102. *See* Barbara M. Lange, *Shopping for the California Right of Publicity*, 16 HASTINGS COMM. & ENT. L.J. 151, 165 (1993) ("California common law, unlike section 3344, imposes strict liability on a defendant."); *cf.* Miller, *supra* note 85, at 659 (noting that in privacy actions "courts applied what amounted to strict liability while the new statute [section 3344] appears to require proof of an intentional invasion of privacy"); *see also generally* Linda J. Stack, White v. Samsung Electronics America, Inc.*'s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L. REV. 1189 (1995); Christopher Pesce, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782 (1990).

103. *See supra* notes 76-83 and accompanying text (discussing "fair use").

104. U.S. CONST. amend. I ("Congress shall make no law . . . abridging the freedom of speech, or of the press . . . .").

Some state courts have construed state freedoms of speech and press to provide greater protection than the First Amendment. *See, e.g.*, New Kids on the Block v. News Am. Publishing, Inc., 745 F. Supp. 1540, 1545 n.7 (C.D. Cal. 1990) ("[T]he California Supreme Court has interpreted the California Constitution as providing greater protection to speech than does the First Amendment."); People

right of publicity body of law addresses its interplay with the First Amendment.[105] In *Eastwood v. Superior Court*, the Supreme Court of California weighed both privacy and publicity interests against the First Amendment, and cautioned that "a proper accommodation between these competing concerns must be defined, since 'the rights guaranteed by the First Amendment do not require total abrogation of the right to privacy.'"[106]

In California, an exception exists within section 3344 itself for "news, public affairs, or sports broadcast or account, or any political campaign."[107] In New York, however, neither section 50 nor 51 creates an express privilege for such use; exceptions in New York have developed through court

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v. Schrader, 617 N.Y.S.2d 429, 435 (Crim. Ct. 1994) ("The language of [the New York Constitution's provision for free speech and free press] is not only unique from that of the First Amendment but is also an express grant of the right to speak freely. . . . By comparison, the First Amendment is only a restraint on the government's power to make no laws 'abridging the freedom of speech . . . .'").

The United States Supreme Court has also recognized that states may provide greater freedoms of speech and press than the First Amendment. In *Zacchini v. Scripps-Howard Broadcasting Co.*, the Court, in its only case recognizing publicity rights, held, where the media broadcasted a performer's entire act on television, that "although the [state] may as a matter of its own law privilege the press . . ., the First and Fourteenth Amendments do not require it to do so." 433 U.S. 562, 578-79 (1977).

While this Note refers to the First Amendment freedoms of speech and press, its arguments hold for corresponding state freedoms. This Note also does not differentiate between the First Amendment used as an exception, as an immunity or privilege, or as a defense. Professor J. Thomas McCarthy, the leading scholar on the law of publicity rights, and author of the sole treatise on the subject, suggests that the distinction is not significant in this area of law. *See* MCCARTHY, *supra* note 7, § 8.6[E], at 8-38.2 to .3. The distinction, however, may be significant in determining on which party a burden of proof rests. *Id.*

105. *See* Gibson & Healey, *supra* note 45, at 379 (discussing the First Amendment as a "frequently litigated affirmative defense" in right of publicity cases).

106. Eastwood v. Superior Court, 198 Cal. Rptr. 342, 350 (Ct. App. 1983) (quoting Briscoe v. Reader's Digest Ass'n, Inc., 483 P.2d 34, 42 (Cal. 1971)).

107. The statute provides that "[f]or purposes of this section a use of name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a)." CAL. CIV. CODE § 3344(d).

decisions.[108]

1. Media Reporting and Newsworthiness

First Amendment exceptions to the right of publicity greatly benefit the media.[109] A New York court has observed that "it has consistently been emphasized that [sections 50 and 51 were] not intended to limit activities involving the dissemination of news or information concerning matters of public interest and that such activities are privileged and do not fall within 'the purposes of trade' contemplated by Section 51 . . . ."[110]

In *Zacchini v. Scripps-Howard Broadcasting Co.*,[111] the United States Supreme Court addressed the effect which the First and Fourteenth Amendments had on a state right of publicity. Although the Court held that the Constitution did not allow the media to broadcast a "human cannonball's" entire act on television, the Justices did note that the performer's right of publicity could not prevent the media from reporting newsworthy facts about the act.[112] The Court then held that "[w]herever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."[113] Clearly,

108. *See* Spahn v. Julian Messner, Inc., 260 N.Y.S.2d 451, 455 (App. Div. 1965). According to the *Spahn* court: "Notably, the statute makes no provision for any privileged uses or exemptions. Whatever privileges or exemptions have been developed in the decisional law rest on strong policy considerations and, perhaps to some extent, on constitutional guarantees of free speech and of the press." *Id.*

109. *See* Randy S. Frisch, *New Technologies on the Block:* New Kids on the Block v. News America Publishing, Inc., 10 CARDOZO ARTS & ENT. L.J. 51, 58 (1991) ("The concern over the media's freedom to disseminate news without undue restriction is often held to outweigh the right of publicity.").

110. Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501, 506 (Sup. Ct. 1968).

111. 433 U.S. 562 (1977). *Zacchini* is the sole United States Supreme Court case to address the right of publicity.

112. *Id.* at 573.

113. *Id.* The Court noted also that given important differences between mis-

therefore, First Amendment protection exists for the media to publish newsworthy items despite state law rights of publicity.[114] It appears, however, that unless a performer's "entire act" is appropriated by broadcast media, the extent of the privilege must be determined on a case by case basis.[115]

Both New York and California courts have long recognized "newsworthy" and "public interest" exceptions to the exercise of publicity rights.[116] California courts, in fact, have cited New York law in noting that "it was early held that newspapers, magazines, and newsreels are exempt from the statutory injunction when using a name or picture in connection with an item of news or one that is newsworthy . . . ."[117] The two states have also extended the privilege to books, comic books, radio, television, motion pictures, handbills, and posters.[118] Even Samuel Warren and Justice Brandeis, the first proponents of the right of privacy, acknowledged that use of a name or photo in connection with an item of news is permissible.[119]

Although advocates of the rights of publicity and privacy, such as Warren and Brandeis, recognize a "news" ex-

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appropriation of the right of publicity and other tort actions, holdings in right of privacy cases, such as *Time, Inc. v. Hill*, 385 U.S. 374 (1967), and defamation cases, such as *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964), are not applicable in adjudicating right of publicity appropriation actions. *Id.* at 570-71.

114. *Zacchini*, 433 U.S. at 573.

115. *See* Bridgette Marie De Gyarfas, *Right of Publicity v. Fiction Based Art: Which Deserves More Protection?*, 15 LOY. L.A. ENT. L.J. 381, 386 (1995) ("[I]t is unclear whether the [*Zacchini*] holding provides any guidance to right of publicity cases where the defendant uses less than the performer's entire act.").

116. *See, e.g.*, *Montana*, 40 Cal. Rptr. 2d at 641; *Stephano*, 474 N.E.2d at 584-85 (The terms "advertising" and "purposes of trade" "should not be construed to apply to publications concerning newsworthy events or matters of public interest.").

117. *See, e.g.*, *Montana*, 40 Cal. Rptr. 2d at 641 (quoting *Paulsen*, 299 N.Y.S.2d at 506).

118. *See id.*; *Paulsen*, 299 N.Y.S.2d at 506 (listing privileged communications media, including newspapers, magazines, newsreels, books, comic books, radio, television, motion pictures, posters, and handbills).

119. Warren & Brandeis, *supra* note 33, at 214 ("The right to privacy does not prohibit any publication of matter which is of public or general interest.").

ception, the courts have been responsible for broadening the definition of the term "newsworthy."[120] The New York Court of Appeals, for example, in holding that fashion may be newsworthy, wrote that the "content" of an article determines whether that article is newsworthy.[121] California courts, in examining the content, have considered whether the news or public interest item has "caught the popular imagination"[122] and have noted that "[p]ublic interest attaches to people who by their accomplishments or mode of living create a bona fide attention to their activities."[123] Both New York and California have also held that items of public interest need not be restricted to current events, but may extend to the reprinting of articles and photos concerning past events.[124]

Professor J. Thomas McCarthy, in *The Rights of Publicity and Privacy*, argues that an appropriate test for misappropriation would consider not the newsworthiness or interest of a person, but the "place and context" of the use of that person's name or likeness.[125] McCarthy argues that on products like coffee mugs, a First Amendment defense "rings somewhat hollow" and that "if all it took for a defendant to wrap itself in the first amendment was to add an appropriate 'Express Your Support for _____' slogan on all celebrity merchandise, then the right of a celebrity to control the commercial property value in his or her identity would

120. *See generally* MCCARTHY, *supra* note 7, § 8.8[B], at 8-44 to -52, -47 ("Illustrative List of Items Held Newsworthy").

121. *Stephano*, 474 N.E.2d at 585.

122. Dora v. Frontline Video, Inc., 18 Cal. Rptr. 2d 790, 792 (Ct. App. 1993) (citing Smith v. National Broadcasting Co., 292 P.2d 600 (Cal. Ct. App. 1956)).

123. *Id.* (quoting Carlisle v. Fawcett Publications, Inc., 20 Cal. Rptr. 405 (Ct. App. 1962)).

124. *Montana*, 40 Cal. Rptr. 2d at 640; *see also* Shamsky v. Garan, Inc., 632 N.Y.S.2d 930 (Sup. Ct. 1995) (finding right of publicity for 1969 Mets baseball team).

125. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 7.6[A], at 7-25 (1987 & Supp. 1996).

be destroyed."[126]

Past California cases demonstrate agreement with McCarthy. For example, in *Guglielmi v. Spelling-Goldberg Productions*,[127] the California Supreme Court held that the name and likeness of Rudolph Valentino in a television "factionalization" was allowed by the First Amendment; on the same day however, in *Lugosi v. Universal Pictures*,[128] the court found that the likeness of Bela Lugosi as Count Dracula was not permissible on items such as plastic toy pencil sharpeners, plastic model figures, T-shirts and sweat shirts, soap and detergent products, picture puzzles, candy dispensers, masks, kites, belts and belt buckles, and beverage stirring rods.[129] Thus, the California court distinguished use on merchandise from use for literary or entertainment purposes.[130] Moreover, in *Bolger v. Youngs Drug Products Corp.*,[131] a commercial speech[132] case involving unsolicited mailings, the United States Supreme Court held that "advertising which 'links a product to a current public debate' is not thereby entitled to the constitutional protection afforded noncommer-

126. *Id.* McCarthy's suggestion that merchandisers label their products with "Express Your Support for _____" connotates that the speech would then qualify as political speech, thereby requiring strict scrutiny by courts. *See, e.g.*, Burson v. Freeman, 504 U.S. 191, 198 (1992) ("[A] facially content-based restriction on political speech in a public forum . . . must be subjected to exacting scrutiny . . . ."); *see generally* MCCARTHY, supra note 125, § 8.2[A], at 8-12 to -16 ("The Hierarchy of First Amendment Protection") (distinguishing the levels of constitutional protection, from highest to lowest, given to political speech and news, fiction and entertainment, and commercial speech respectively).

127. 603 P.2d 454 (Cal. 1979).

128. 603 P.2d 425 (Cal. 1979).

129. *Id.* at 435.

130. *See Guglielmi*, 603 P.2d at 463-64 (Bird, C.J., concurring).

131. 463 U.S. 60 (1983) (holding unconstitutional a federal statute which prohibited unsolicited mailing of contraceptive advertisements where a proposed mailing discussed venereal disease and family planning and provided contraceptive product information).

132. Commercial speech is speech which does "no more than propose a commercial transaction." Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations, 413 U.S. 376, 385 (1973). It is the least protected form of expression. *See supra* note 126.

cial speech."[133] Following *Bolger*, an entire item may be categorized as commercial speech, and thereby given a lower level of constitutional protection, despite its containing speech of public interest.[134]

2. Media promotion

A corollary to the freedoms of speech and press is the right of the media to reproduce previously published stories or photographs as advertisements for promotional purposes.[135] These advertisements may appear in the original publisher's own media, in other media, or in "poster, circular, cover or soliciting letter."[136] Both New York and California have acknowledged that such a right is well-established and incidental to the purpose of news reporting itself.[137]

In *Booth v. Curtis Publishing Co.*, a New York appellate court recognized a right of the media to promote itself, and noted that policy reasons allow such use because publications can best demonstrate their quality and content through copies or extractions from past editions.[138] The New York court also relied on the historical argument that the long-

133. *Bolger*, 463 U.S. at 68 (quoting Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557, 563 n.5 (1980)). *But see* Riley v. National Fed'n of the Blind of North Carolina, 487 U.S. 781, 796 (1988) (explaining that where "the component parts of a single speech are *inextricably* intertwined, we cannot parcel out speech, applying one test to one phrase and another test to another phrase. . . . Therefore, we apply our test for fully protected expression.") (emphasis added).

134. *See* Frisch, *supra* note 109, at 57-58 (discussing a "primary nature of the use" test).

135. *See Montana*, 40 Cal. Rptr. 2d at 642-43; Namath v. Sports Illustrated, 371 N.Y.S.2d 10, 11-12 (App. Div. 1975).

136. Booth v. Curtis Publishing Co., 223 N.Y.S.2d 737, 743 (App. Div. 1962).

137. *See Montana*, 40 Cal. Rptr. 2d at 642; *Namath*, 371 N.Y.S.2d at 11. According to the New York courts, in *Humiston v. Universal Film Mfg. Co.*, 178 N.Y.S. 752 (App. Div. 1919), the "principle was laid down that the news disseminator was entitled to display extracts for purposes of attracting users and selling its product. . . . The advertising, which [the poster] was unquestionably, was held to be incidental to the exhibition of the [newsreel] itself." *Booth*, 223 N.Y.S.2d at 741.

138. *Booth*, 223 N.Y.S.2d at 743 and n.4.

standing practice of reproducing extracts from covers and pages of out-of-issue periodicals "is ample recognition that the usage has not violated the sensibilities of the community or the purport of the [right of publicity] statute."[139]

In considering the media's right to promote itself, courts have also held that a "profit motive by the media . . . is irrelevant to the inquiry of whether the content of [its] speech is political or commercial."[140] Therefore, the fact that the media advertises and operates for a profit does not revoke its First Amendment protection.[141] Courts have distinguished, however, cases where a non-media business has reprinted a newsworthy story in order to advertise a product of its own.[142] Such were the facts where a safe manufacturer incorporated into an advertisement a full article from a local newspaper about business records needlessly lost in a fire.[143] There, the reprinted article was not protected as news.[144]

The First Amendment, therefore, protects much of what the media publish when their subjects may be considered newsworthy or of public interest.[145] Appropriations of name, likeness, or other aspects of a person, may nevertheless be actionable when they are used in non-media advertis-

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139. *Id.* at 743.

140. New Kids on the Block v. News Am. Publishing, Inc., 745 F. Supp. 1540, 1544 (C.D. Cal. 1990) (quoting Daily Herald Co. v. Munro, 38 F.2d 380, 384 n.4 (9th Cir. 1988)); *see also generally* MCCARTHY, *supra* note 125, § 8.8[F][1]-[2], at 8-62 to -67 ("Media Profit and Advertising Do Not Remove First Amendment Protection"). In the context of a defamation case, the United States Supreme Court has written that "[i]f a profit motive could somehow strip communications of the otherwise available constitutional protection, our cases from New York Times to Hustler Magazine would be little more than empty vessels." Harte-Hanks Communications v. Connaughton, 491 U.S. 657, 667 (1989).

141. *See Montana*, 40 Cal. Rptr. 2d at 643 n.2.

142. *See, e.g.*, Flores v. Mosler Safe Co., 164 N.E.2d 853 (N.Y. 1959).

143. *Flores*, 164 N.E.2d at 854.

144. *Id.* at 857; *accord* Reilly v. Rapperswill Corp., 377 N.Y.S.2d 488 (App. Div. 1975) (involving the reproduction of a television broadcast concerning the energy crisis in a promotional film to advertise insulation).

145. *See supra* part I.C.1 (discussing First Amendment protection of media reporting and newsworthy items).

ing, merchandising, or for other "purposes of trade."[146] Largely unexamined, however, is an overlapping area where the media merchandise products to promote its publications.

II. *MONTANA* AND *TITAN SPORTS*: CASES INVOLVING MEDIA MERCHANDISING

Three reported cases have involved the media acting as merchandiser. In *Mendonsa v. Time, Inc.*,[147] the court denied the defendant's motion for dismissal for failure to state a claim based on a Rhode Island right to privacy statute.[148] There, the court held that whether the sale of limited-edition photographs constituted use of plaintiff's likeness for "purposes of trade" was "a matter that [had] to be decided after a full development of the facts."[149] However, the court did not indicate how it would make that determination.[150] The remaining cases, *Montana v. San Jose Mercury News, Inc.*[151] and *Titan Sports, Inc. v. Comics World Corp.*,[152] both ended litigation after appeals from granted motions for summary judgment.[153] This part presents the facts, procedural history, and decisions of the *Montana* and *Titan Sports* cases.

A. Montana v. San Jose Mercury News, Inc.

"Joe" Montana played professional football as quarterback for the San Francisco Forty-niners ("49ers") from 1979 to 1992.[154] After playing two additional seasons for the Kansas City Chiefs, Montana announced his retirement in San

146. *See supra* part I.B.1.b (discussing the right of publicity protection against "commercial" use).

147. 678 F. Supp. 967 (D.R.I. 1988).

148. *Id.* at 972.

149. *Id.*

150. *Id.*

151. 40 Cal. Rptr. 2d 639 (Ct. App. 1995), *as modified*, (May 30, 1995), *review denied*, (Aug. 17, 1995).

152. 870 F.2d 85 (2d Cir. 1989), *rev'g* 690 F. Supp. 1315 (S.D.N.Y. 1988).

153. *Montana*, 40 Cal. Rptr. 2d at 640; *Titan Sports*, 870 F.2d at 86.

154. *A Look at Joe's Career*, S.F. CHRON., Apr. 18, 1995, at E2; *see also generally* JOE MONTANA WITH DICK SCHAPP, MONTANA (1995).

Francisco on April 18, 1995.[155] On that day, San Franciscans hailed Montana as "the greatest football player of all time"[156] and someone whose "arrival [in San Francisco] and revival of the 49ers flagging fortunes helped unite, inspire and re-kindle the spirit of our region."[157]

During his sixteen seasons in the National Football League ("NFL"), Montana won more than seventy percent of the games he started, and thirty-one times led his team to victory after trailing in the fourth quarter.[158] He is ranked as an NFL leader in career passing touchdowns, completions, attempts, and yards,[159] and is a three-time Super Bowl Most Valuable Player.[160] During Montana's fourteen seasons in San Francisco, the 49ers competed in and won four Super Bowl championships: in 1982, 1985, 1989, and 1990.[161]

On Monday, January 23, 1989, the day following the 49ers' victory in Super Bowl XXIII, news of the team's championship appeared on the front page of a special section of the *San Jose Mercury News*.[162] Accompanying the story was a color photograph of Montana celebrating the win with three teammates.[163] The following year, the 49ers' victory in Super Bowl XXIV also earned the team a special section of the *Mercury News* on Monday, January 29, 1990.[164] Again, a color photograph accompanying the story pictured Joe Montana "flying high in celebration" with a teammate.[165]

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155. Edward Epstein, *50,000 See Montana Pass Into Retirement/49ers Brass, Ex-Teammates Salute Legend*, S.F. CHRON., Apr. 19, 1995, at A1.

156. *Id.* (quoting former Forty-niners coach, Bill Walsh).

157. *The Montana Era Passes*, S.F. CHRON., Apr. 19, 1995, at A18.

158. MONTANA WITH SCHAPP, *supra* note 154, at 5.

159. *Id.* at 141.

160. *A Look at Joe's Career*, *supra* note 154, at E2.

161. *Id.*

162. *49ers' Fantastic Finish: Montana's Magic Gives S.F. Third Title of 80's with 34 Seconds to Spare, They Win Super Bowl XXIII 20-16*, SAN JOSE MERCURY NEWS, Jan. 23, 1989, at 1SB.

163. *Id.*

164. *The Big Easy: 49ers Breeze Past Broncos 55-10 for Fourth Title*, SAN JOSE MERCURY NEWS, Jan. 29, 1990, at 1SB.

165. *Id.*

Two weeks following the fourth 49ers' Super Bowl victory of the years between 1980 and 1990, the *Mercury News* published a special "Souvenir Section" which the newspaper inserted into its regular Sunday edition on February 4, 1990.[166] The souvenir section, entitled "1980-1990: The Trophy Hunters," was devoted entirely to the 49ers, and included original stories by staff reporters, personal accounts by various 49ers players, season records, previously published photographs of the team and of individual players, and, on the section's cover, an artist's drawing of quarterback Joe Montana.[167]

Within weeks of the original publishings, the *Mercury News* reproduced in poster form 1,000 copies each of the front pages of the January 23, 1989, and January 29, 1990, special sections, and the front page of the February 4, 1990, souvenir section.[168] Approximately 900 copies of these posters were sold for five dollars each, and the remaining posters were distributed free of charge, primarily at charity events.[169]

In 1992, two years after the *Mercury News* printed the last of its posters, Joe Montana filed suit in California Superior

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166. *1980-1990: The Trophy Hunters*, SAN JOSE MERCURY NEWS, Feb. 4, 1990, at 1G.

167. *Id.* Forty-niners players who wrote their recollections for the special edition include Jack "Hacksaw" Reynolds, Bill Ring, Ronnie Lott, and Brent Jones. *Id.*

For a discussion of the First Amendment implications of fine art, such as the artist's rendition of Montana, see generally Amiel B. Weisfogel, *Fine Art's Uncertain Protection: The New York Right of Privacy Statute and the First Amendment*, 20 COLUM.-VLA J.L. & ARTS 91 (1995).

168. *Montana*, 40 Cal. Rptr. 2d at 640; *NFL Notes*, S.F. CHRON., Aug. 18, 1995, at D2.

169. *Montana*, 40 Cal. Rptr. 2d at 640. The Executive Editor of the *Mercury News* said at the time of the suit, and printed in the *Mercury News* itself, "You don't make money [by selling the posters] at $5. We normally price these things to cover our costs. We make a little on one and lose a little on another." Brandon Bailey, *Joe Montana Sues MN Over Super Bowl Posters*, SAN JOSE MERCURY NEWS, Jan. 9, 1992, at 4B. Following the litigation, an attorney for the *Mercury News* stated, "The *Mercury News* regularly does posters of pages of the newspaper as a form of promotion." *Court Sacks Montana*, HOUSTON CHRON., Aug. 18, 1995, at 5.

Court, Santa Clara County, against the San Jose newspaper for common law and statutory misappropriation of his name, photograph, and likeness.[170] The suit requested an injunction against further sale or distribution of the posters, a court order requiring that the newspaper account for profits from the sale of the posters, and that those profits be included in damages paid to Montana.[171] In a motion for summary judgment, the *Mercury News* argued that the First Amendment protected its publication of the posters because the posters depicted newsworthy events.[172]

Diverting focus from the issue of newsworthiness, the plaintiff conceded that he was, in fact, newsworthy.[173] He only agreed, however, that his newsworthiness gave the *Mercury News* the right to print the original photographs and news accounts in 1989 and 1990.[174] Montana also did not dispute the fact that the *Mercury News*' posters advertised the quality and content of its newspaper.[175] His complaint still questioned, however, the right of the newspaper to reproduce pages of newsworthy items as posters.[176] Nevertheless, the trial court granted the *Mercury News*' motion for summary judgment on grounds that the First Amendment barred Montana from suing the newspaper for appropriation of his name and likeness.[177]

At the Court of Appeal for the Sixth District, a three

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170. *Montana*, 40 Cal. Rptr. 2d at 640. A number of journalists criticized Montana for bringing the action against the newspaper. *See, e.g.*, Lew Freedman, *Montana, Barkley Demean Themselves With Petty Lawsuits*, ANCHORAGE DAILY NEWS, Aug. 30, 1995, at 1C; Gerald Z. Marer, *Joe Montana, Litigation All-Pro*, TEX. LAW., June 5, 1995, at 8. *But cf.* MCCARTHY, *supra* note 67, at 139-41 ("Responding to the Critics of the Right of Publicity").

171. Bailey, *supra* note 169, at 4B.

172. *Montana*, 40 Cal. Rptr. 2d at 640. The *Mercury News* also argued that Montana's suit was barred by the applicable state statute of limitations, an issue which the trial court did not reach. *Id.*

173. *Id.* at 641.

174. *Id.*

175. *Id.* at 643.

176. *Montana*, 40 Cal. Rptr. 2d at 641.

177. *Id.* at 640.

judge panel unanimously affirmed the granting of the motion, writing that "Montana's name and likeness appeared in the posters for precisely the same reason they appeared on the original newspaper front pages: because Montana was a major player in contemporaneous sports events."[178] The appellate court then held that the *Mercury News* had the right to reprint and sell the poster-size prints because the posters "reported on newsworthy events"[179] and because a "newspaper has a constitutional right to promote itself by reproducing its news stories."[180] Montana's petition for review by the California Supreme Court was summarily denied with one justice in dissent.[181]

The California Court of Appeal analogized the case to a number of cases among which were several decisions made under New York law and a California case which had considered the newsworthiness of a video documentary.[182] However, the court admitted that it was "unable to locate any cases directly on point."[183] On the issue of newsworthiness, the principal case which the court relied on is *Paulsen v. Personality Posters, Inc.*,[184] in which a New York trial court held that a poster depicting a comedian and the words "FOR PRESIDENT" received First Amendment protection when the comedian had made a public, albeit mock, entry into the 1968 presidential campaign.[185] Additionally the *Montana* appellate court cited *Jackson v. MPI Home Video*,[186] which concerned distribution of a videotaped speech by political leader Jesse Jackson, and *Dora v. Frontline Video, Inc.*,[187] which involved a video documentary of a private individual

178. *Id.* at 641.
179. *Id.* at 640.
180. *Id.* at 642.
181. *See* 1995 Cal. LEXIS 509 (Aug. 17, 1995).
182. *Montana*, 40 Cal. Rptr. 2d at 641-43.
183. *Id.* at 641.
184. 299 N.Y.S.2d 501 (Sup. Ct. 1968).
185. *Id.* at 503-09.
186. 694 F. Supp. 483 (N.D. Ill. 1988).
187. 18 Cal. Rptr. 2d 790 (Ct. App. 1993).

held to be both newsworthy and of public interest as a surfing "legend of Malibu."[188] In *Dora*, however, the plaintiff had questioned his own newsworthiness.[189]

In a footnote, the *Montana* appellate court took notice of *Factors Etc., Inc. v. Pro Arts, Inc.*[190] There, the United States Court of Appeals for the Second Circuit, applying New York law, held that although Elvis Presley's death was a newsworthy event, a poster of Presley including the words "IN MEMORY 1935-1977" did not merit First Amendment protection.[191] The *Factors* court distinguished *Paulsen* and held that "[w]e cannot accept [the] contention that the legend in 'IN MEMORY . . .' placed its poster in the same category as one picturing a presidential candidate."[192]

The California Court of Appeal also cited to a number of cases in its holding that the *San Jose Mercury News* has a right to promote itself by reproducing newsworthy stories and photographs as advertisements.[193] *Cher v. Forum International, Ltd.*[194] involved a tabloid magazine's front cover "advertisements" of the contents of the magazine, and further issues complicated by false light privacy. *Booth v. Curtis Publishing Co.*[195] and *Namath v. Sports Illustrated*[196] both involved defendant magazines reproduction of photographs which had previously been printed either with consent or as newsworthy material. In both *Booth* and *Namath*, publishers had reprinted photographs within their own or other periodicals as part of advertisements to promote subscriptions and sales.[197]

188. *Id.* at 791.
189. *Id.* at 793.
190. *Montana*, 40 Cal. Rptr. 2d at 641 n.1 (citing Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978)).
191. *Factors*, 579 F.2d at 222.
192. *Id.*
193. *Montana*, 40 Cal. Rptr. 2d at 642-43.
194. 692 F.2d 634 (9th Cir. 1982).
195. 223 N.Y.S.2d 737 (App. Div. 1962).
196. 371 N.Y.S.2d 10 (App. Div. 1975).
197. *Booth*, 223 N.Y.S.2d at 740 (involving a photo of Shirley Booth originally

B. Titan Sports, Inc. v. Comics World Corp.

In 1988, Titan Sports, Inc. ("Titan Sports"), corporate owner of both the World Wrestling Federation ("WWF") trademark and the rights in the names and likenesses of many of the WWF's professional wrestlers and managers, brought suit against Comics World Corp., Starlog Group, Inc., and O'Quinn Studios, Inc. for misappropriation of certain wrestlers' names and photographs.[198] At the time of the litigation, these figures included Hulk Hogan, Randy "Macho Man" Savage, and "Captain" Lou Albano.[199] The defendants published magazines which included "Wrestling Poster Magazine," "Wrestling All Stars Super Giant Pin-Ups," and "Superstar Wrestlers Photo Album."[200]

The sole issue in *Titan Sports* was whether the defendants violated sections 50 and 51 of New York Civil Rights Law by including in their magazines "large, [approximately sixteen inches by twenty-two inches] photographic inserts variously known as 'magazine posters,' pin-ups, pullouts, centerfolds, or fold-outs, which are affixed by staples or otherwise to the inside of normal magazines, and often cannot be completely viewed without removing them entirely from the magazine."[201] The "posters" depicted the wrestling stars and were published without either Titan Sports' or the wrestlers' consent.[202] All of the parties did agree that consent had been obtained for the photographs themselves; they also agreed that the wrestlers were both public figures and newsworthy.[203] Titan Sports even conceded that the photographs would not

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printed in *Holiday* and reprinted in the *New Yorker* and *Advertising Age*); *Namath*, 371 N.Y.S.2d at 13 (involving a photo of Joe Namath originally printed in *Sports Illustrated* and reprinted in *Cosmopolitan* and *Life*).

198. Titan Sports, Inc. v. Comics World Corp., 690 F. Supp. 1315, 1316-17 (S.D.N.Y. 1988).

199. *Id.* at 1317 n.3.

200. *Id.* at 1317.

201. *Id.*

202. *Id.*

203. *Titan Sports*, 690 F. Supp. at 1317.

violate section 51 "as long as the photos [did] not exceed the 'normal' page size of defendant's magazines, 8" x 11"."[204]

Prior to trial, both parties moved for summary judgment.[205] The trial court found that the posters were not included for either advertising or trade purposes, because they were related to the publications' subject matter.[206] The court then granted the publishers' motion, denied Titan Sports' motion, and dismissed the complaint with prejudice.[207]

The Second Circuit Court of Appeals reversed.[208] Noting that "it is appropriate for a court to consider 'whether the public interest aspect of the publication is merely incidental to its commercial purpose,'" the court held that summary judgment was inappropriate.[209] The court then proposed a test to be applied in the trial court to determine whether the defendant publishers inserted the posters for commercial purposes, that is a "purpose of trade."[210]

The Second Circuit's *Titan Sports* test suggested that a fact-finder in the trial court consider variable factors, including, but not limited to: "the nature of the item, the extent of its relationship to the traditional content of a magazine, the ease with which it may be detached from the magazine, whether it is suitable for use as a separate product once detached, and how the publisher markets the item."[211] The court then remanded the case to the district court.[212]

III. THE FIRST AMENDMENT SHOULD NOT PROTECT MEDIA

204. *Id.* at 1318 (quoting the Stipulation of Facts for Purposes of the Motion).
205. *Id.* at 1316.
206. *Id.* at 1323.
207. *Id.*
208. *Titan Sports*, 870 F.2d at 86.
209. *Id.* at 87-88 (quoting Davis v. High Soc'y Mag., Inc., 457 N.Y.S.2d 308, 313 (App. Div. 1982)).
210. *Id.* at 88-89. The parties stipulated on appeal that the posters were not used for advertising purposes. *Id.* at 87.
211. *Id.* at 89.
212. *Titan Sports*, 870 F.2d at 89. Research reveals no subsequent history of litigation.

MERCHANDISING WHERE THE RIGHT OF PUBLICITY IS INVOLVED

When an item, such as a poster, may potentially be considered either protected media advertising or unprotected merchandising, courts must consider a number of issues and fully develop an understanding of the item involved.[213] Moreover, an understanding of the item requires a full development of the facts, thereby making summary judgment inappropriate.[214]

This part examines the right of publicity and First Amendment issues which arise when the media acts as merchandiser. It then analyzes the *Montana* decision, separating the courts "newsworthy" and "media promotion" discussions, and argues that the California appellate court incorrectly affirmed summary judgment for the *Mercury News*. Finally, this part suggests that courts should apply the Second Circuit's *Titan Sports* test in cases where promotional items of the media may be considered merchandise. It then applies the *Titan Sports* test to the facts of *Montana*.

A. *Right of Publicity Cases Involving Media Merchandising Require Full Development of Facts*

When an item may be viewed as either protected media advertising or unprotected merchandising, trial courts must decide not only how to determine whether that item more closely resembles advertising or merchandising, but also what that determination will mean to other decisions, such as summary judgment, burdens of proof, and the level of scrutiny to be used in applying First Amendment principles.[215] In New York, courts should also consider whether

213. *See supra* part I.B.1.b (discussing commercial use); part I.C.2 (discussing media advertising).

214. *See supra* note 16 (explaining the standard for affirming summary judgment).

215. *See supra* note 126 (describing the hierarchy of First Amendment protection).

"purposes of trade"[216] requires proof of a defendant's intent that an item be for "purposes of trade" or whether the commercial purpose can be inherent in the item itself.[217] In other words, courts should consider whether an item can be for "purposes of trade" if the merchandiser did not intend to profit from it.[218]

The United States Supreme Court has indicated that where commercial speech is linked to issues of public interest, the commercial speech is not awarded full constitutional protection.[219] Courts have also indicated that a non-media advertiser may not reprint a newsworthy story to promote a product.[220] In a case such as *Montana*, where the issue is not distinguishing commercial speech from noncommercial speech, but rather distinguishing constitutionally protected media advertising from unprotected merchandising, a court should still decide whether one use will "outweigh" the other. That is, the court should decide whether the "advertisement" aspects will be protected despite appearing on a merchandised product, or whether use on a commercial product will defeat the constitutional protection otherwise given to the media's self-promoting advertisement.[221] To correctly consider that issue, the disputed item's advertising

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216. N.Y. CIV. RIGHTS LAW §§ 50-51; *see supra* part I.B.1.b (discussing commercial use).

217. *See supra* part I.B.1.b (discussing commercial use).

218. For example, if the facts surrounding *Montana* had occurred in New York, the proper inquiry would have been whether a "purpose of trade" might be shown by the fact that the *Mercury News*' product competed with other licensed merchandised posters, regardless of whether the newspaper had intended to profit from sale of the posters. *See supra* part I.B.1.b (discussing commercial use and fair use).

California Civil Code section 3344, however, does not use the phrase "purposes of trade," but rather the more specific phrase "on or in products, merchandise, or goods," indicating that the use, not the "purpose" or intent of the user, is more important. CAL. CIV. CODE § 3344. *See supra* part I.B.2 (discussing California law).

219. *See supra* notes 131-34 and accompanying text (discussing *Bolger*).

220. *See supra* notes 142-44 and accompanying text (discussing *Flores*).

221. *See supra* part I.B.1.b (discussing commercial use); part I.C.2 (discussing media advertising).

attributes and product merchandise attributes must be examined and weighed. The necessity for such a "weighing" makes summary judgment inappropriate.[222]

In California, courts have observed that the state's supreme court has subjected the right of publicity to a "narrowing interpretation which accords with First Amendment values."[223] Nevertheless, at least one legal writer has noted that the result in *Montana* was "not a foregone conclusion."[224] While posters may advertise products, as in the cases of film posters or "wild" postings[225] on city streets, other posters may *be* merchandised products with a commercial value and which buyers may frame and hang in their homes.[226] Moreover, some posters may serve as both an advertisement and a product. Because the nature of the poster must be determined, this analysis again reaches the conclusion that summary judgment is not an appropriate disposal of a case involving such an item.[227]

B. *The Montana Court Erred in Applying Distinguishable*

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222. *See supra* note 16 (discussing summary judgment).

223. Cher v. Forum Int'l, Ltd., 692 F.2d 634, 638 (9th Cir. 1982); *see also supra* part I.C (reviewing First Amendment interplay with the right of publicity).

224. *See supra* note 19.

225. "Wild postings" are poster-size advertisements pasted "on walls and fences surrounding construction sites . . . ." *Surf Makes Washday More Colorful; Lever's Detergent Pins Its New Ads to Offbeat Stories*, ADVERTISING AGE, Feb. 19, 1996, at 8.

226. *See supra* notes 1-2, 4 (discussing the licensed merchandise industry). Some legal commentators have suggested that the buyer of a product which depicts the name or likeness of a personality is a First Amendment "speaker." *See, e.g.*, Sims, *supra* note 29, at 494-95 ("The purchase and display of a poster or other form of celebrity memorabilia is a statement by the individual of esteem for—or in some cases, ridicule of—the celebrity subject."). However, McCarthy suggests that such an argument is moot because: (1) in an infringement action, the merchandiser, not the buyer, would be the defendant; (2) the buyer's "speech" is more similar to "symbolic speech" than "pure speech" and would merit a lesser degree of scrutiny; and (3) the potential plaintiff's interest is not in quieting the speech of the buyer, but rather in being compensated by the merchandiser. MCCARTHY, *supra* note 7, § 7.6[B] at 7-27 to -29.

227. *See supra* note 16 (explaining the standard for affirming summary judgment).

Case Law to the Particular Facts of Montana

1. The "Newsworthy" Exception

As noted above, Joe Montana stipulated his own newsworthiness and public interest in recognition of the fact that the *Mercury News* had the right to print the original photographs and news accounts in 1989 and 1990.[228] Finding Montana to be newsworthy, however, should not necessarily have caused his arguments to fail. In right of publicity cases where a person's name or likeness is appropriated for use in advertising or on merchandise, the injured person will most always be newsworthy or a celebrity of public interest. If this were not so, the alleged infringer would have little want or use for the person's name or likeness.[229] Moreover, previous California case law indicates that a finding of newsworthiness does not terminate the case.[230] Such California decisions further imply that a poster, falling somewhere between the cases of clear product merchandising and protected media reporting or entertainment,[231] requires full trial rather than summary judgment.[232] Nevertheless, the court affirmed the summary judgment for the *Mercury News*.[233]

In its opinion, the California Court of Appeal compared the case to a number of less-than-analogous cases, all of

228. *See supra* notes 173-74 and accompanying text (discussing Montana's stipulation of newsworthiness).

229. In right of privacy "appropriation" cases, however, a "private" person's likeness is the subject of a complaint. *See, e.g.*, Roberson v. Rochester Folding Box Co., 64 N.E. 442 (N.Y. 1902) (photo used on flour box); Rubino v. Slaughter, 136 N.Y.S.2d 873 (Sup. Ct. 1954) (photo used on labor union poster); *see also supra* part I.A (reviewing the right of privacy).

230. *See supra* notes 127-30 and accompanying text (discussing *Guglielmi* and *Lugosi*).

231. *See* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 578 (1977) ("There is no doubt that entertainment, as well as news, enjoys First Amendment protection."); *see also supra* notes 111-15 and accompanying text (discussing *Zacchini*).

232. *See supra* note 16 (reviewing the standard for summary judgment).

233. *See supra* note 178 and accompanying text (discussing the *Montana* appellate court's ruling).

them distinguishable.[234] The case upon which the court relied principally, *Paulsen*, which involved a poster of a presidential candidate, concerns political speech, a category of speech which requires stricter scrutiny than lesser-protected commercial speech.[235] Another cited case, regarding videotape distribution of political commentary, again implicated political speech.[236] Moreover, one of only a few California cases cited by the *Montana* court involved a video documentary which the plaintiff agreed was a bona fide news media.[237] There, however, the plaintiff unsuccessfully questioned his own newsworthiness.[238] In *Montana*, the reverse is true; Montana conceded his own newsworthiness, but complained of the products on which photographs of him were reprinted.[239] None of the cited cases, as the court itself noted, is directly on point.[240]

Finally, the court diminished *Factors*, a more closely analogous case, to a footnote.[241] In *Factors*, the United States Court of Appeals for the Second Circuit held that a poster of Elvis Presley did not merit First Amendment protection.[242] While California courts are under no obligation to follow the Second Circuit decision, the *Montana* court's decision to disregard *Factors* and follow *Paulsen*, while the *Factors* court distinguished *Paulsen*,[243] indicates that California equates winning the Super Bowl with political speech, and that Joe

234. *See supra* notes 184-89 and accompanying text (discussing the *Montana* appellate court's analysis of newsworthiness).

235. *See supra* notes 184-85 and accompanying text (discussing *Paulsen*); *supra* note 126 (describing the hierarchy of First Amendment protection).

236. *See supra* note 186 and accompanying text (discussing *Jackson*).

237. *See supra* notes 187-89 and accompanying text (discussing *Dora*).

238. *See supra* notes 187-89 and accompanying text (discussing *Dora*).

239. *See supra* notes 173-76 and accompanying text (discussing Montana's complaint).

240. *See supra* note 183 and accompanying text (discussing the *Montana* appellate court's analysis).

241. *See supra* note 190 and accompanying text (discussing the *Montana* appellate court's taking notice of *Factors*).

242. *See supra* note 191 and accompanying text (discussing *Factors*).

243. *See supra* note 192 and accompanying text (discussing *Factors*).

Montana is "bigger" than Elvis.

2. The Media's Right to Promote Itself

The California Court of Appeal also cited to less than analogous cases in its holding that the *San Jose Mercury News* has a right to promote itself by reproducing its newsworthy stories and photographs as advertisements.[244] *Cher*, where a tabloid magazine's front cover "advertised" the contents of the magazine, is easily distinguishable.[245] Clearly, magazine covers are not independent commercial products, therefore, *Cher* is not applicable to *Montana*.[246]

Two other decisions upon which the *Montana* court relied, *Booth* and *Namath*, are just as inapplicable. In both cases, defendant magazines reprinted previously published photographs within their own or other periodicals as part of advertisements to promote subscriptions and sales.[247] One can hardly argue, as is so with *Montana*'s posters, that the magazine pages or subscription cards were merchandised products independent of their use as advertising.[248] Certainly, no one would expect a magazine reader to frame a subscription card or hang it on a wall as a poster.

As with newsworthiness, Montana had not disputed the fact that one function of the *Mercury News*' posters could have been to advertise the quality and content of its newspaper.[249] However, neither the concession of newsworthiness nor of the possible promotional value of the posters

244. *See supra* notes 193-97 and accompanying text (discussing the *Montana* appellate court's analysis of the media's right to promote itself).

245. *See supra* note 194 and accompanying text (discussing *Cher*).

246. *See* Gibson & Healey, *supra* note 45, at 381 n.78 (opining that the *Montana* court took the *Cher* decision too far).

247. *See supra* notes 195-97 and accompanying text (discussing *Booth* and *Namath*).

248. *See supra* part I.B.1.b (discussing commercial use).

249. *See supra* note 175 and accompanying text (discussing Montana's stipulation that the *Mercury News*' posters advertised the quality and content of the newspaper).

should have concluded the case for Montana.[250] When a right of publicity case involves media "advertising" which may also be considered a product independent of its use to promote the media itself, courts must require a factual determination of whether the advertising use or the use as a separate product predominates.[251] If the merchandising use predominates, the right of publicity should prevail, and the media's product should not be protected by the First Amendment.[252]

C. *The* Montana *Court Should Have Applied the* Titan Sports *Test*

In *Titan Sports*, where magazine publishers inserted poster-size photographs into their periodicals, the Second Circuit proposed a test to determine whether the posters were used for "purposes of trade."[253] Because *Titan Sports* did not involve the issue of the media promoting itself, the sole First Amendment question involved was whether the newsworthy exception applied to the poster-size photographs.[254] Specifically, at issue was whether the conceded newsworthiness of the wrestlers allowed the magazines to fold posters into their publications, or whether the posters were inserted only for their commercial "purposes of trade."[255]

Unlike *Titan Sports*, *Montana* is complicated by the issue of media advertising.[256] While the defendant magazines in *Titan Sports* maintained (and the trial court agreed) that the

250. *See, e.g.*, *supra* notes 198-212 (discussing *Titan Sports*, in which an appellate court reversed an entry of summary judgment for media defendants despite the plaintiff's concession of newsworthiness).

251. *See supra* part I.B.1.b (discussing commercial use); *supra* part I.C.2 (discussing media advertising); *see also supra* note 16 (reviewing the standard for summary judgment).

252. *See supra* part I.B.1.b (discussing commercial use).

253. *See supra* notes 210-11 and accompanying text (discussing *Titan Sports*).

254. *See supra* note 201 and accompanying text (discussing *Titan Sports*).

255. *See supra* part I.B.1.b (discussing the term, "purposes of trade").

256. *See supra* note 180 and accompanying text (discussing *Montana*).

wrestling posters were *part* of the content of the magazines,[257] the *Montana* appellate court held that the *Mercury News*' posters were promotional advertising *incidental* to production of the newspaper.[258] Nevertheless, because *Montana*, like *Titan Sports*, involved posters produced and distributed by the media, *Titan Sports* is the most analogous case to *Montana* and should have influenced the California courts. Instead, the California Court of Appeal cited only to cases more easily distinguishable than *Titan Sports*.[259] None of those cases involved posters printed, produced, distributed, sold, or given away by the media. The California appellate court, therefore, should have applied the *Titan Sports* test to *Montana*.[260]

In applying the *Titan Sports* test to *Montana*, a trier of fact might have considered the history of the *San Jose Mercury News*' advertising itself on posters which it sold or distributed to the public. Because the *Mercury News* did regularly make posters of its pages, that factor might weigh in favor of the newspaper.[261] Other considerations, however, might favor the plaintiff: the posters' distribution rather than "posting" in public locations;[262] the untraditional sale of advertising to the public;[263] the posters' suitability for framing or other use as a separate product; and the posters' competing with products which are traditionally licensed.[264] Further-

257. *See supra* note 206 and accompanying text (discussing the *Titan Sports* trial court's findings).

258. *See supra* note 180 and accompanying text (discussing the *Montana* appellate court's ruling).

259. *See supra* notes 234, 244 and accompanying text (discussing the inapplicability of the *Montana* appellate court's analysis).

260. *See supra* note 211 and accompanying text (discussing the *Titan Sports* test).

261. *See supra* note 169 (noting the *Mercury News*' regular practice of reprinting the newspaper as promotional posters).

262. *See supra* note 169 and accompanying text (discussing the *Mercury News*' distribution of the posters).

263. *See supra* note 169 and accompanying text (discussing the *Mercury News*' sale of the posters).

264. *See supra* note 4 (describing a competing poster of Montana).

more, because the *Mercury News* may continue to advertise, although without using posters portraying unauthorized names or likenesses, no speech will be quieted or "chilled."[265] Given these considerations to be had, summary judgment was an improper disposition in the *Montana* case, just as it was in *Titan Sports*.[266] Because genuine issues of material fact existed,[267] the California appellate court should have reversed the trial court's order for summary judgment.

CONCLUSION

Although well-paid entertainers and athletes are often criticized for capitalizing on their names and likenesses, there are legitimate policy reasons for protecting celebrities' rights. The *Montana* decision, by creating a precedent by which the media may infringe on publicity rights by merchandising products which reprint previously newsworthy articles or photographs, has the potential to erode that right which legislators and courts have found worthy of protection. Contrary to *Montana*, the free speech and free press clauses of the First Amendment should not protect the media's merchandising of products, for whatever reason and regardless of whether or not the media seek a profit, when those products, if not merchandised by the media, would infringe on an individual's right of publicity.

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265. *See supra* part I.C.2 (describing permitted types of media advertising).

266. *See supra* notes 208-09 (discussing the Second Circuit's reversal of *Titan Sports*).

267. *See supra* note 16 (explaining the standard for affirming summary judgment).