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## Toward a Limited Right of Publicity: An Argument for the Convergence of the Right of Publicity, Unfair Competition and Trademark Law

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# Toward a Limited Right of Publicity: An Argument for the Convergence of the Right of Publicity, Unfair Competition and Trademark Law

## **Cover Page Footnote**

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## Toward a Limited Right of Publicity: An Argument for the Convergence of the Right of Publicity, Unfair Competition and Trademark Law

Andrew Beckerman-Rodau\*

*The right of publicity—the most recently developed type of intellectual property—allows a person to control commercial use of his or her identity. The scope of the right has expanded significantly since its inception because many courts and commentators have misinterpreted it, viewing it as a pure property right justified by a labor or unjust enrichment theory. Rather, this article contends that it should be evaluated in light of the utilitarian justification for intellectual property law. Rewarding people by allowing them to monetize their public persona is not the goal of the right of publicity. The goal should be to incentivize individuals to engage in creative endeavors for the benefit of the public. Accordingly, a right of publicity action should only be available if commercial use of an individual's persona will result in the likelihood that consumers will be misled into thinking the individual endorsed or approved of the use of his or her identity. However, such confusion-based conduct is already actionable under trademark and unfair competition law. Therefore, I argue that any use of a person's persona that creates an association with the person but does not create a likelihood that consumers will think the person endorsed or approved of the commercial use should only be actionable if the person is famous. This is consistent with trademark dilution law, which limits association-based trademark actions to famous trademarks. This approach places the right of publicity within the domain of intellectual property law and preserves the existing balances between*

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*protecting property rights, preventing free riding, and preserving robust free speech rights.*

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## INTRODUCTION

The right of publicity is a relatively new body of law designed to protect the legal right of a person to control commercial use of his or her identity.<sup>1</sup> It is viewed by courts and commentators as

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<sup>1</sup> See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003) (“The right of publicity is an intellectual property right of recent origin which has been defined as the inherent right of every human being to control the commercial use of his or her identity.”); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (“The theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the

part of the body of intellectual property law, which includes patent, copyright, trademark, and trade secrets law.<sup>2</sup>

Over the last few decades, intellectual property law has seen a significant expansion of protected subject matter.<sup>3</sup> More recently, however, legislative and judicial efforts have signaled—at least in

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unauthorized commercial exploitation of that identity.”); J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 at 3 (2012 ed.).

<sup>2</sup> See ROGER SCHECHTER & JOHN THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* § 1.1 at 1 (2003); MCCARTHY, *supra* note 1, § 1:3 at 3. Patent law protects particular embodiments of certain new inventions. See 35 U.S.C. § 101 (2012). Copyright law, codified at 17 U.S.C. §§ 101–1332, protects the form of expression of aesthetic creations such as literary and artistic works. See SCHECHTER & THOMAS, *supra*. Trademark law, which protects the mental association created in the mind of consumers when a word, phrase, device, or other commercial symbol is used to trigger an association with a product or service, is a composite of state common law, state statutory law, and federal statutory law. See 15 U.S.C. §§ 1051–1141 (2012) (Federal Trademark statute called the Lanham Act); PAUL GOLDSTEIN & R. ANTHONY REESE, *COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES* 167 (6th ed. 2008). See, e.g., Ohio Rev. Code §§ 1329.54–1329.67 (state trademark statute); see also *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (trademarks are used “to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears”). Trade secrets law protects commercial information or know-how, which provides a competitive marketplace advantage as a consequence of being maintained as a secret. Trade secrets law has common law origins. Schechter & Thomas, *supra*, § 24.1 at 529. Today most states have adopted a version of the Uniform Trade Secrets Act (1985), available at [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=130067](http://www.wipo.int/wipolex/en/text.jsp?file_id=130067) (last visited October 15, 2012). For information on the states that have adopted the Act see <http://uniformlaws.org/Act.aspx?title=Trade%20Secrets%20Act> (last visited June 1, 2012). Additionally, a federal trade secrets law called the Economic Espionage Act allows the government to bring civil and criminal actions for trade secret misappropriation. See 18 U.S.C. §§ 1831–39 (2006); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995) (“A trade secret is any information that can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.”); see also Uniform Trade Secrets Act § 1(4) (1985), available at [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=130067](http://www.wipo.int/wipolex/en/text.jsp?file_id=130067) (last visited October 15, 2012), which states:

“Trade secret” means information, including a formula, pattern, compilation, program, device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

<sup>3</sup> See, e.g., Andrew Beckerman-Rodau, *The Problem with Intellectual Property Rights: Subject Matter Expansion*, 13 *YALE J.L. & TECH.* 36, 39 (2010).

the area of patent law—a desire to restrict or limit the domain of protectable intellectual property.<sup>4</sup> Similarly, early right of publicity cases greatly expanded the scope of the right,<sup>5</sup> while some recent cases have reversed this trend.<sup>6</sup>

This Article will briefly review the history and development of the right of publicity. It will examine the underlying justifications for this right because its scope can best be determined in light of its reasons for existence. Furthermore, this Article will argue that many courts and commentators have misinterpreted the right of publicity by viewing it as a pure property right justified by a labor or unjust enrichment theory. Instead, I argue that the right of publicity should be evaluated in light of the utilitarian justification for intellectual property law generally. This Article will argue that the right is a species of intellectual property law rather than a pure freestanding property right. As such, rewarding people by allowing them to monetize their public persona is not the right of publicity's aim. Rather, the aim should be to incentivize individuals to engage in creative endeavors for public benefit, echoing the broader utilitarian goals of intellectual property law.<sup>7</sup> Also, because of the communicative aspects involved, the right must be balanced against First Amendment free speech requirements—just as trademark and copyright rights are balanced.<sup>8</sup> Accordingly, this Article will argue that the right of publicity provides excessive and unwarranted legal protection especially in light of the expansive protection provided by trademark and unfair competition law today. This supports an argument for greatly restricting the right of publicity.

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<sup>4</sup> See, e.g., *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1297 (2012); *Bilski v. Kappos*, 130 S. Ct. 3218, 3221 (2010).

<sup>5</sup> See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397–98 (9th Cir. 1992); *Carson*, 698 F.2d at 835.

<sup>6</sup> See, e.g., *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (“[S]ome courts have indicated that the right of publicity is intended to promote only economic interests and that noneconomic interests are more directly served by so-called rights of privacy. . . . We see merit in this approach.”).

<sup>7</sup> See Beckerman-Rodau, *supra* note 3, at 47–48.

<sup>8</sup> See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996).

Violations of the right of publicity based merely on a showing that an unauthorized third party used a person's identity in a commercial context should not be actionable. Such association-based uses should be within the public domain. In contrast, if the use of someone's persona will result in a likelihood that consumers will be confused with regard to whether the person endorsed or approved of the use of his or her identity in the commercial activity, then it should be actionable. Reliance on a likelihood of confusion standard is consistent with existing trademark and unfair competition law,<sup>9</sup> and it reflects the careful balance developed between protecting intellectual property rights and conflicts with the First Amendment when communicative conduct is involved.<sup>10</sup>

The expanded nature of modern trademark and unfair competition law can provide adequate relief for confusion-based actions for the use of someone's persona. The additional protection for mere association-based use of a person's identity is generally not justified in light of the utilitarian objectives of intellectual property law and First Amendment concerns. Analogous to existing trademark dilution law, I propose that a person should only be able to assert a right of publicity action based on an association-use of his or her persona if the person is famous. The article concludes with a proposed framework which places the right of publicity within the domain of intellectual property law. This encourages in the right of publicity context the striking of the same balance utilized in intellectual property law generally—a balance between protecting property rights, preventing free riding, and preserving a robust public domain for speech.

#### I. THE RIGHT OF PUBLICITY'S DEVELOPMENT

The right of publicity is rooted in privacy law.<sup>11</sup> Aspects of a legal right to protect individual privacy can be traced back to ancient Talmudic and Roman law.<sup>12</sup> Nevertheless, as late as 1890

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<sup>9</sup> See *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 627 (S.D.N.Y. 1985).

<sup>10</sup> See *Cardtoons*, 95 F.3d at 976.

<sup>11</sup> See MCCARTHY, *supra* note 1, § 1:7 at 9.

<sup>12</sup> See *id.* § 1:9 at 13.

a right of privacy was unrecognized under English or United States common law.<sup>13</sup> In 1890, Warren and Brandeis published their famous article, which argued in favor of adopting a common law right of privacy.<sup>14</sup> Initially, some courts rejected adopting such a right<sup>15</sup> while other courts favored the idea.<sup>16</sup> Nevertheless, privacy law continued to be an amorphous area of law until an influential law review article authored by William Prosser in 1960 categorized privacy law into four distinct torts: intrusion, public disclosure of private facts, false light in the public eye, and appropriation.<sup>17</sup>

Intrusion was defined as an invasion of a person's privacy that a reasonable person would find objectionable or offensive.<sup>18</sup> For example, surreptitiously peering into a private residence to take a picture of a person would be an intrusion,<sup>19</sup> but taking a picture of that person in a public area would be permissible.<sup>20</sup>

Public disclosure of private facts, in contrast to intrusion, was designed to protect an individual's reputation.<sup>21</sup> Prosser saw it as an extension of defamation law.<sup>22</sup> But unlike defamation law—where the truthfulness of publicly disseminated information was a complete defense—the truth or falsity of the facts was not the controlling issue of the right of privacy.<sup>23</sup> Public disclosure of

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<sup>13</sup> W. PAGE KEETON, DAN B. DOBBS, ROBERT E. KEETON & DAVID G. OWEN, PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 849 (5th ed. 1984).

<sup>14</sup> Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 196 (1890).

<sup>15</sup> See, e.g., *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 556 (N.Y. Ct. of App. 1902) (“An examination of the authorities leads us to the conclusion that the so-called ‘right of privacy’ has not as yet found an abiding place in our jurisprudence, and, as we view it, the doctrine cannot now be incorporated without doing violence to settled principles of law by which the profession and the public have long been guided.”).

<sup>16</sup> See, e.g., *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 73 (Ga. 1905) (“[A] violation of the right of privacy is a direct invasion of a legal right of the individual.”).

<sup>17</sup> William Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

<sup>18</sup> *Id.* at 390–91; see also MCCARTHY, *supra* note 1, § 1:20 at 33–34.

<sup>19</sup> See Prosser, *supra* note 17, at 392.

<sup>20</sup> *Id.* at 391.

<sup>21</sup> See *id.* at 398.

<sup>22</sup> *Id.*

<sup>23</sup> See *id.*; MCCARTHY, *supra* note 1, § 1:22 at 37 (observing that falsity of disclosed information is an element of a defamation action but not an element of a right of privacy action based on public disclosure of private facts).



truthful facts that were private in nature could be actionable if a reasonable person would find such disclosure objectionable.<sup>24</sup> For example, public disclosure of a person's tax returns, which are confidential records, could be actionable.<sup>25</sup> In contrast, public disclosure of a person's birth date or admission to the bar would not be actionable since that is public information.<sup>26</sup>

False light in the public eye, unlike public disclosure of private facts, involves publication of information that may injure a person's reputation by implying something that is untrue.<sup>27</sup> Like the other privacy actions discussed above, the offense must consist of something an ordinarily reasonable person would find objectionable under the circumstances.<sup>28</sup> For example, using the picture of a person to illustrate an article on illegal criminal activity when the person pictured has no involvement in the activity is actionable because it can falsely imply to the public that the person is involved in such activity.<sup>29</sup> Prosser viewed a false light action as overlapping and including defamation.<sup>30</sup> However, his view was that such an action could also cover conduct beyond the narrow scope of defamation.<sup>31</sup>

Appropriation was defined as the unauthorized use of a person's name or likeness.<sup>32</sup> For example, if the picture of a celebrity is used without permission to advertise a product or service, that celebrity may have an action for appropriation.<sup>33</sup>

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<sup>24</sup> See Prosser, *supra* note 17, at 396; see also MCCARTHY, *supra* note 1, § 1:21 at 36–37 (observing that public disclosure of private facts provides an action for public disclosure of private information that is embarrassing to a person of ordinary sensibilities).

<sup>25</sup> Prosser, *supra* note 117, at 395–96.

<sup>26</sup> *Id.* at 396.

<sup>27</sup> *Id.* at 400.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 399.

<sup>30</sup> *Id.* at 400; see also MCCARTHY, *supra* note 1, § 1:22 at 37 (nebulous areas of law that extends defamation law).

<sup>31</sup> Prosser, *supra* note 17, at 400–01. *But see* MCCARTHY, *supra* note 1, § 1:22 at 38 (noting it is not clear the U.S. Supreme Court sees a distinction between defamation and false light actions).

<sup>32</sup> Prosser, *supra* note 17, at 401–02; see also MCCARTHY, *supra* note 1, § 1:23 at 39 (most appropriation cases involve commercial use of a person's name or picture).

<sup>33</sup> Prosser, *supra* note 17, at 401–02.

Prosser noted that at least one court had called a right of privacy action by appropriation a right of publicity action.<sup>34</sup> He also suggested that this action was really an economic right that allowed a person to control the use of his name or likeness in the commercial context.<sup>35</sup> In contrast, intrusion, public disclosure of private facts, and false light involve actions to protect privacy and reputation.<sup>36</sup>

The appropriation action identified by Prosser appears to have been the basis for the right of publicity,<sup>37</sup> initially enunciated by the United States Court of Appeals for the Second Circuit in 1953.<sup>38</sup> Subsequently, a 1954 law review article by Melville Nimmer provided a theoretical framework for differentiating the right of privacy from the right of publicity.<sup>39</sup> Other commentators also asserted the notion that right of privacy actions based on intrusion, public disclosure of private facts, and false light were distinguishable from a right of privacy action based on appropriation.<sup>40</sup> Subsequent case law, including one United States Supreme Court decision, recognized the right of publicity as a valid state law cause of action.<sup>41</sup>

Today, the right of privacy and the right of publicity have become separate causes of action despite having a common ancestor.<sup>42</sup> The right of privacy protects the right to be left alone

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<sup>34</sup> *Id.* at 406–07.

<sup>35</sup> *Id.* at 406.

<sup>36</sup> *Id.*

<sup>37</sup> See MCCARTHY, *supra* note 1, § 1:23 at 39.

<sup>38</sup> See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

<sup>39</sup> See generally Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204–10 (1954) (discussing the inadequacies of privacy law in protecting the values of publicity).

<sup>40</sup> See, e.g., 1 FOWLER V. HARPER & FLEMING JAMES, JR., THE LAW OF TORTS § 9.7, at 689–91 (1956) (asserting that appropriation actions involve financial considerations unlike typical privacy actions which involve emotional distress, humiliation, and interference with personal dignity).

<sup>41</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 567 (1977).

<sup>42</sup> In *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983), the court stated that right of privacy actions based on intrusion, public disclosure of private facts, and false light generally protect the right to be left alone while the appropriation action—which it called the right of publicity—protects a celebrity's monetary interest in exploiting his or her identity. “Thus, the right of privacy and the

and the right to be free from third parties obtaining and publicizing personal information.<sup>43</sup> Remedies for privacy violations are tortious in nature and focus on compensation for resulting mental and emotional injuries as well as injury to reputation.<sup>44</sup> In contrast, an appropriation action has been generally renamed a right of publicity action,<sup>45</sup> which protects intangible property.<sup>46</sup> Remedies for violation of the right of publicity are typically property-based remedies that focus on recovering the economic value of a persona when, for example, it is used without consent in a commercial context—such as enhancing or promoting the sale of a product by associating it with a well-known person.<sup>47</sup> Although right of publicity actions are often deemed tort actions, the tortious conduct is interference with a person's property per se.<sup>48</sup>

By the 1980s, the recognition of a property-based right of publicity action was well accepted.<sup>49</sup> As a result, the majority of

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right of publicity protect fundamentally different interests and must be analyzed separately.” *Id.* See also *State ex rel. Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89, 95 (Tenn. Ct. App. 1987) (courts view right of publicity as distinct from right of privacy).

<sup>43</sup> See *Carson*, 698 F.2d at 834.

<sup>44</sup> MCCARTHY, *supra* note 1, §§ 11:26–27 at 736–37 (describing damages based on resulting mental distress flowing from privacy violation).

<sup>45</sup> *Carson*, 698 F.2d at 834.

<sup>46</sup> See *e.g.*, JESSE DUKEMINIER, JAMES E. KRIER, GREGORY S. ALEXANDER & MICHAEL H. SCHILL, PROPERTY 66 (7th ed. 2010) (explaining that the right of publicity is a property interest that includes typical attributes of property such as right to both inter vivos and testamentary transfers); see also *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003) (holding right of publicity a type of property); *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 325 (6th Cir. 2001) (holding right of publicity is a property right that can extend beyond death); *Hart v. Elec. Arts Inc.*, 808 F. Supp. 2d 757, 773 (D.N.J. 2011) (noting right of publicity is property right); *Crowell*, 733 S.W.2d at 97 (holding right of publicity is intangible personal property); Marshall Leaffer, *The Right of Publicity: A Comparative Perspective*, 70 ALB. L. REV. 1357, 1361, 1367 (2007) (treating right of publicity treated as pure property right).

<sup>47</sup> See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (“Publicity rights . . . are meant to protect against the loss of financial gain, not mental anguish.”). See generally MCCARTHY, *supra* note 1, §§ 11:30–31 at 751–52 (discussing that damages for violation of the right of publicity are based on commercial injury, not mental or emotional injury).

<sup>48</sup> See MCCARTHY, *supra* note 1, § 1:3 at 3 (explaining that infringement of right of publicity is a tort action based on interfering with a property right).

<sup>49</sup> See MCCARTHY, *supra* note 1, § 1:31 at 64 (“By the mid 1980s, the initial phase of questioning what the right of publicity was and why it should exist passed largely into

states recognize the right of publicity today via case law, statute or both, although the scope and duration of the right varies from state to state.<sup>50</sup> The development of the law then shifted to defining the scope of the right of publicity.<sup>51</sup>

## II. THE CHANGING SCOPE OF THE RIGHT OF PUBLICITY

Some early decisions broadly construed the right of publicity<sup>52</sup> while some more recent decisions have significantly narrowed the scope.<sup>53</sup> Arguably, this reflects the typical development of a new area of law. A new right slowly expands until it creates unintended consequences such as invading the scope of a competing right.<sup>54</sup> Then, one right preempts the conflicting right or judicial theories must be developed to balance the competing rights so they can coexist.<sup>55</sup>

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history.”); *id.* § 10:7 at 506–10 (stating that courts uniformly hold that right of publicity is a property interest).

<sup>50</sup> *See id.* §§ 6:1–8 at 854–72 (providing detailed state-by-state overview of the right of publicity); *see, e.g.*, FLA. STAT. ANN. § 540.08(5) (West 2012) (stating Florida right of publicity statute provides for rights to last forty years after death); IND. CODE ANN. § 32-36-1-8 (West 2012) (stating Indiana right of publicity statute provides for rights to last one hundred years after death); DONALD S. CHISUM, TYLER T. OCHOA, SHUBHA GNOSH & MARY LAFRANCE, UNDERSTANDING INTELLECTUAL PROPERTY § 6G [6], at 766 (2d ed. 2011) (asserting New York and Wisconsin do not recognize any postmortem right of publicity). *See generally* MEDIA LAW RESOURCE CENTER, INC., MEDIA PRIVACY AND RELATED LAW 2008–09 (2008) (providing detailed state-by-state overview of both the right of privacy and the right of publicity).

<sup>51</sup> *See* MCCARTHY, *supra* note 1, § 1:31 at 64.

<sup>52</sup> *See, e.g.*, *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992) (reasoning that the common law right of publicity is not confined to the appropriation of name or likeness); *Carson v. Here’s Johnny Portable Toilets*, 698 F.2d 831, 837 (6th Cir. 1983) (“[A] celebrity’s legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes.”).

<sup>53</sup> *See, e.g.*, *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (holding “CBC’s first amendment rights in offering its fantasy baseball products supersede the players’ rights of publicity”).

<sup>54</sup> *See e.g.*, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–69 (1995) (taking an expansive view of what could be registered as a trademark under federal law, the court created the potential for trademark rights to unfairly interfere with competition).

<sup>55</sup> *See id.* (expanding the functionality doctrine to enable a court to deny trademark rights to something serving a trademark function if it created a non-reputational marketplace advantage which could interfere with competition); *see, e.g.*, *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 32–33 (2001) (restating the Court’s holding in *Qualitex* by distinguishing between cases of aesthetic functionality rather than functional design).

A. *Broad Interpretation of the Scope of the Right of Publicity*

In *Carson v. Here's Johnny Portable Toilets, Inc.*,<sup>56</sup> the well-known entertainer Johnny Carson sued a Michigan portable toilet company whose corporate name was Here's Johnny Portable Toilets, Inc.<sup>57</sup> The company's founder adopted the name knowing it was the slogan used to introduce Mr. Carson on his television program *The Tonight Show*.<sup>58</sup> He combined the phrase with a second phrase—"The World's Foremost Comedian"—to create "a good play on a phrase."<sup>59</sup> Mr. Carson, however, objected to the business of renting or selling portable toilets under the name "Here's Johnny."<sup>60</sup> He sued the company, asserting, among other things, unfair competition, trademark infringement, and violation of his right of publicity.<sup>61</sup> The trial court dismissed all the claims.<sup>62</sup> It held that although the founder intended to free ride on the popularity of the phrase, he did not intend to deceive the public.<sup>63</sup> Additionally, the court found that the evidence failed to demonstrate any likelihood of consumer confusion from the use of the phrase to sell portable toilets.<sup>64</sup> In light of the absence of a likelihood of confusion, the court found the unfair competition claim invalid.<sup>65</sup> Likewise, the court dismissed the right of publicity claim holding that it only applied to the use of a person's name or likeness and that neither was being used to sell portable toilets.<sup>66</sup> On appeal the trial court's dismissal of the unfair competition claim was upheld in light of Mr. Carson's failure to

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<sup>56</sup> 698 F.2d 831.

<sup>57</sup> *Id.* at 833.

<sup>58</sup> *See id.* at 833, 836 (asserting that President and owner of the company admitted that the phrase "Here's Johnny" would not have been adopted to sell portable toilets if public didn't associate phrase with Mr. Carson).

<sup>59</sup> *Id.* at 833.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> *Id.* at 834.

<sup>64</sup> *Id.*

<sup>65</sup> *Id.* at 833. Although the *Carson* court did not specifically discuss the trademark infringement claim, the absence of any likelihood of confusion would negate a trademark infringement claim as well as an unfair competition claim. *See GMC v. Keystone Auto. Indus.*, 453 F.3d 351, 354 (6th Cir. 2006) (explaining that test for trademark infringement and for unfair competition is likelihood of consumer confusion).

<sup>66</sup> *Carson*, 698 F.2d at 833.

show likelihood of confusion.<sup>67</sup> However, the dismissal of the right of publicity claim was vacated and remanded<sup>68</sup> based on the appellate court's holding that Mr. Carson's right of publicity was violated.<sup>69</sup>

The appellate court determined that the right of publicity was not limited to the use of a person's name or likeness,<sup>70</sup> concluding that anything intentionally used in a commercial context that creates an association with a celebrity can amount to commercial exploitation of the celebrity's identity.<sup>71</sup> In *Carson*, the appellate court determined that use of the phrase "Here's Johnny" in selling portable toilets could support Mr. Carson's claim because it creates an association with him in the minds of consumers even though a consumer would not think he endorsed or was affiliated with the portable toilet business.<sup>72</sup> The decision therefore distinguishes between commercial use that merely creates an association-based relationship with a celebrity and commercial use that creates a confusion-based relationship with a celebrity, which may cause consumers to incorrectly believe the celebrity endorsed or is affiliated with the product.<sup>73</sup> This distinction is clearly illustrated by *Carson* when the appellate court held that a right of publicity claim was viable<sup>74</sup> despite an express finding that consumers were unlikely to believe Mr. Carson endorsed or had any connection with the portable toilet business.<sup>75</sup>

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<sup>67</sup> *Id.* at 834.

<sup>68</sup> *Id.* at 837.

<sup>69</sup> *Id.* at 836.

<sup>70</sup> *Id.* at 835.

<sup>71</sup> *See generally id.* at 835 ("If the celebrity's identity is commercially exploited, there has been an invasion of his right [of publicity] whether or not his 'name or likeness' is used.").

<sup>72</sup> *Id.* at 836.

<sup>73</sup> *See generally* Parks v. LaFace Records, 329 F.3d 437, 460 (6th Cir. 2003) (noting that false advertising action requires a likelihood of consumer confusion, but a right of publicity claim does not require any likelihood of consumer confusion).

<sup>74</sup> *Carson*, 698 F.2d at 836.

<sup>75</sup> *See id.* at 834. *See generally* Cairns v. Franklin Mint Co., 107 F. Supp. 2d 1212 (C.D. Cal. 2000) (noting that unfair competition action requires likelihood of consumer confusion, but right of publicity action does not require any likelihood of confusion).

Nine years later, the Ninth Circuit issued an equally broad decision in *White v. Samsung Electronics America, Inc.*<sup>76</sup> This case involved an advertisement for Samsung video cassette recorders.<sup>77</sup> The advertisement showed a robot dressed up in a wig, gown, and jewelry on a television set that was similar to that of the game show *Wheel of Fortune*.<sup>78</sup> Although the robot did not use the face or likeness of the show's host, Vanna White,<sup>79</sup> the overall appearance of the robot, including how it was posed and its location on what appears to be the show's set, was intentionally designed to make viewers think of Ms. White.<sup>80</sup> Ms. White sued Samsung, asserting violation of the California right of publicity statute,<sup>81</sup> the California common law right of publicity,<sup>82</sup> and the federal unfair competition statute.<sup>83</sup>

The trial court granted summary judgment against Ms. White on all causes of action.<sup>84</sup> The appellate court affirmed the trial court with regard to the California statutory right of publicity action<sup>85</sup> because the statute only applies if specific characteristics, such as name or likeness, are used.<sup>86</sup> Also, the district and appellate courts agreed that neither Ms. White's name nor her likeness were used in the Samsung advertisement.<sup>87</sup> The appellate court reversed the trial court with regard to the common law right of publicity action<sup>88</sup> after concluding that, unlike the statutory cause of action, the common law action was not limited to appropriation of specific celebrity characteristics such as a name or likeness.<sup>89</sup> With regard to the unfair competition cause of action,

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<sup>76</sup> 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993).

<sup>77</sup> *Id.* at 1396.

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 1397.

<sup>80</sup> *Id.* at 1396.

<sup>81</sup> *Id.* at 1395. *See* CAL. CIV. CODE § 3344 (West 2012).

<sup>82</sup> *White*, 971 F.2d at 1396.

<sup>83</sup> *Id.* at 1395. *See* 15 U.S.C. § 1125(a) (2006).

<sup>84</sup> *White*, 971 F.2d at 1396–97.

<sup>85</sup> *Id.* at 1397.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 1399.

<sup>89</sup> *Id.* at 1397.

the court reversed and remanded to the trial court.<sup>90</sup> This action turns on whether the advertisement created a likelihood of consumer confusion,<sup>91</sup> which was an issue of fact to be determined by a jury.<sup>92</sup> This broad view of the common law right of publicity is consistent with the result in the *Carson* case. Additionally, the independent treatment of the common law right of publicity action and the unfair competition action means the *White* court made the same distinction the *Carson* court made between an association-based commercial use of a celebrity's persona and a confusion-based commercial use.

*B. Narrowing Interpretation of the Scope of the Right of Publicity*

Several grounds for narrowing or limiting the right of publicity have been asserted in court. These include preemption based on federal copyright law<sup>93</sup> and interference with First Amendment considerations.<sup>94</sup> Preemption arguments have generally been unsuccessful<sup>95</sup> but some courts have found that First Amendment considerations provide fertile ground for restraining the right of publicity.<sup>96</sup>

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<sup>90</sup> *Id.* at 1401.

<sup>91</sup> *Id.* at 1399–1400.

<sup>92</sup> *Id.* at 1401.

<sup>93</sup> 17 U.S.C. § 301 (2006).

<sup>94</sup> See generally *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003) (“There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment.”).

<sup>95</sup> See *MCCARTHY*, *supra* note 1, § 11:50 at 832 (stating how the majority rule is that federal copyright law does not preempt state-based right of publicity); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 225–26 (2002) (nothing that few courts have found right of publicity preempted by copyright law); see, e.g., *Dryer v. Nat'l Football League*, 689 F. Supp. 2d 1113, 1121 (D. Minn. 2010) (rejecting argument that federal copyright law preempted state right of publicity action). But see *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134, 1138 (N.D. Ill. 1997) (holding federal copyright law does preempt right of publicity action).

<sup>96</sup> See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (finding that First Amendment considerations outweighed right of publicity rights). See generally *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 769 (D.N.J. 2011) (describing how courts use a balancing test to determine if First Amendment free speech rights limit a right of publicity action).



In the video game market, information about actual athletes has been incorporated into games without the athlete's consent.<sup>97</sup> Electronic Arts, Inc. produces a series of video games based on college football, which allows users to simulate collegiate football games.<sup>98</sup> One of the players depicted in the game asserted that virtual players in the game utilized characteristics of actual players in order to achieve realism.<sup>99</sup> The player sued for violation of his right to publicity.<sup>100</sup> In response to a motion to dismiss,<sup>101</sup> the trial court held that the First Amendment did not bar a right of publicity action.<sup>102</sup>

In another video game case, *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*,<sup>103</sup> an Internet-based fantasy baseball league operated a for-profit business that used the names, biographical data, and performance statistics of actual Major League Baseball players without permission.<sup>104</sup> The court concluded that the baseball players depicted in the game met the prima facie elements necessary to sustain a right of publicity action.<sup>105</sup> However, the court then held that those rights were superseded by the First Amendment.<sup>106</sup> Despite reliance on the First Amendment, the court's reasoning largely focused on an analysis of the underlying purposes or justifications for the existence of the right of publicity.<sup>107</sup> The court noted that the justifications include

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<sup>97</sup> Keller v. Elec. Arts, Inc., No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719, at \*7 (N.D. Cal. 2010).

<sup>98</sup> *Id.* at \*6.

<sup>99</sup> *Id.*

<sup>100</sup> *Id.* at \*7-8.

<sup>101</sup> *Id.* at \*5.

<sup>102</sup> *Id.* at \*12. *See also* Dryer v. Nat'l Football League, 689 F. Supp. 2d 1113, 1121 (D. Minn. 2010) (holding, on a motion for judgment on the pleadings, the right of publicity action by football players included in NFL promotional videos was not outweighed by First Amendment). However, in *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 794 (D.N.J. 2011), after the court engaged in a lengthy discussion of the interaction of the right of publicity and the First Amendment, the court found that the First Amendment trumped the right of publicity with regard to the same video game at issue in *Keller*.

<sup>103</sup> 505 F.3d 818 (8th Cir. 2007).

<sup>104</sup> *See id.* at 820.

<sup>105</sup> *Id.* at 822-23.

<sup>106</sup> *Id.* at 823.

<sup>107</sup> *Id.* at 824.

allowing an individual to gain the economic benefit of his or her endeavors, incentivizing a person's productive activities, protecting natural rights, and rewarding celebrity labor.<sup>108</sup> The court then determined that none of these justifications would be interfered with by denying a right of publicity action in this case because Major League Baseball players are already well paid and can earn substantial additional income via sponsorship agreements and endorsements.<sup>109</sup> This view of the right to publicity was also discussed in *Cardtoons, L.C. v. Major League Baseball Players Association*,<sup>110</sup> where the court stated that most celebrities with commercially valuable identities are well compensated for the activities that gave rise to their fame.<sup>111</sup> Hence, according to that court, the right of publicity is not necessary to induce people to engage in activities leading to fame and public notoriety.<sup>112</sup>

*C.B.C. Distribution and Marketing, Inc.* and *Cardtoons* held that First Amendment considerations outweighed right to publicity actions, with *Cardtoons* in particular taking a critical view of the utilitarian justifications for a right to publicity action.<sup>113</sup> This may represent a judicial trend away from the broad application of the right of publicity, such as in the *Carson* and *White* cases, in favor of narrowing application of the right.

### III. JUSTIFICATIONS FOR THE RIGHT OF PUBLICITY

Once the law designates something as property, the traditional “bundle of rights” attaches to that property.<sup>114</sup> Those rights typically include the right to exclude, the right to possess, the right to use, and the right to transfer.<sup>115</sup> However, the threshold question

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<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> 95 F.3d 959 (10th Cir. 1996).

<sup>111</sup> *Id.* at 973–74.

<sup>112</sup> *Id.* at 974.

<sup>113</sup> *See id.* at 971–72; *C.B.C. Distribution & Mktg., Inc.*, 505 F.3d at 823.

<sup>114</sup> *See United States v. Craft*, 535 U.S. 274, 278–79 (2002) (noting that state law determines “which sticks are in a person’s bundle”).

<sup>115</sup> *See Kaiser Aetna v. United States*, 444 U.S. 164, 176 (1979) (“[O]ne of the most essential sticks in the bundle of rights that are commonly characterized as property—the right to exclude others.”); JOHN G. SPRANKLING & RAYMOND R. COLETTA, *PROPERTY: A CONTEMPORARY APPROACH* 25–26 (2d ed. 2012); *see also Moore v. Regents of the Univ.*

is whether to designate something as property in the first place. Under U.S. law this is usually a policy-based determination.<sup>116</sup> Therefore, it is imperative that the relevant underlying rationales or policy objectives be carefully examined. Legal rights typically do not exist in a vacuum. They exist to further both general<sup>117</sup> and specific rationales.<sup>118</sup> Additionally, the unintended consequences or externalities that result from any legal right create collisions with competing rights.<sup>119</sup> Therefore, the rationales for the right of publicity must be critically explored to ascertain if the right furthers or satisfies the justifications advanced for it, and to determine how to treat competing policies.

#### A. *Labor Theory & Unjust Enrichment Justifications*

Allowing someone to keep the fruits of their efforts is a viscerally compelling justification for allowing a person—

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of Cal., 51 Cal. 3d 120, 165 (Cal. 1990) (Mosk, J., dissenting) (describing bundle of rights as including rights to possess, to use, to exclude and to dispose of property).

<sup>116</sup> *Moore*, 51 Cal. 3d at 165 (Mosk, J., dissenting) (“For a variety of policy reasons, the law limits or even forbids the exercise of certain rights over certain forms of property.”); *see also* SPRANKLING & COLETTA, *supra* note 115, at 1–8 (discussing various different theories used to justify existence of property law). *See generally* DUKEMINIER ET AL., *supra* note 46, at 50 (noting that utilitarian theory is dominant view of property today).

<sup>117</sup> *State v. Shack*, 277 A.2d 369, 372 (N.J. 1971) (“Property rights serve human values.”); RICHARD POSNER, *ECONOMIC ANALYSIS OF LAW* 10–13 (1972) (“[T]he legal protection of property rights has an important economic function: to create incentives to use resources efficiently.”).

<sup>118</sup> *See, e.g., Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) (“[T]he ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.”); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992) (explaining that trademarks identify goods and services to consumers); Adam D. Moore, *A Lockean Theory of Intellectual Property*, 21 *HAMLIN L. REV.* 65, 69 (1997) (arguing that intellectual property laws are based on policy that granting property rights to authors and inventors maximizes incentives to pursue creative endeavors).

<sup>119</sup> *See generally Bonito Boats*, 489 U.S. at 146 (“The Patent Clause [U.S. CONST. art I, § 8, cl. 8] . . . reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the ‘Progress of Science and the useful Arts.’”); PAUL GOLDSTEIN, *GOLDSTEIN ON COPYRIGHT* § 1.14, at 1:41–1:42 (3d ed. 2012) (discussing balance between providing enough rights to incentivize creators with maximizing public benefit from such creations in context of copyright law); HOWARD C. ANAWALT, *IDEA RIGHTS: A GUIDE TO INTELLECTUAL PROPERTY* 9 (2011) (noting conflict between intellectual property rights and the benefits of competition and the free flow of information).

especially a celebrity—to control the commercial use of his or her persona.<sup>120</sup> The main reason the name or likeness of a celebrity is used in a commercial context is to gain an economic advantage from the association with a celebrity.<sup>121</sup> For example, famous sports personalities are used to sell products because the use of such a person to pitch a product to the public can positively affect the public's perception of the product, which can translate into increased sales.<sup>122</sup> However, it is typically the celebrity that invested the time and effort into becoming well known, so it can be argued that the advertiser should pay for using that celebrity status.<sup>123</sup> It can be further argued that celebrity status is merely a raw material used by an advertiser to sell a product, much like a musician uses an instrument created by a third party to make music. Even though the musician may create music that has independent economic value, he or she must still pay the person who created the musical instrument for the time and effort utilized to make the instrument.

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<sup>120</sup> *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 975 (10th Cir. 1996). See generally *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (“The theory of the right [of publicity] is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.”).

<sup>121</sup> MCCARTHY, *supra* note 1, § 5:31 at 47–49 (discussing empirical evidence that shows celebrity product endorsement can alter consumer perception of a product); see also Leah W. Feinman, *Celebrity Endorsements in Non-Traditional Advertising: How the FTC Regulations Fail to Keep Up with the Kardashians*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 97, 101 (2011) (“Celebrity endorsements can improve brand recognition and recall . . . .”); Consuelo Lauda Kertz & Roobina Ohanian, *Recent Trends in the Law of Endorsement Advertising: Infomercials, Celebrity Endorsers and Nontraditional Defendants in Deceptive Advertising Cases*, 19 HOFSTRA L. REV. 603, 650 (1991) (describing how celebrity endorsements give credibility to products). See generally C. ROBERT CLARK & IGNATIUS J. HORSTMANN, A MODEL OF ADVERTISING FORMAT COMPETITION: ON THE USE OF CELEBRITIES IN ADS (2009), available at <http://dx.doi.org/10.2139/ssrn.1333208> (last visited October 16, 2012) (discussing value of celebrity endorsements in advertising).

<sup>122</sup> The importance of endorsements by sports figures has reached the point where many top athletes earn far more from endorsements than from playing sports. See Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete’s Right of Publicity*, 10 MARQ. SPORTS L.J. 23, 23 (1999).

<sup>123</sup> *Cardtoons*, 95 F.3d at 974–75.

Basic fairness is another theory that has been asserted for treating the value of a person's persona as a type of property.<sup>124</sup> Arguably, fairness should support applying the property label to a celebrity's identity because he or she invested the time and effort in creating its economic value.<sup>125</sup> Therefore, unauthorized third party use would amount to the third party free riding on the economic value of the celebrity's efforts without paying for what is used. An unjust enrichment theory would provide legal support for an action based on unfairness.<sup>126</sup>

Despite the appeal of a labor theory and an unjust enrichment theory, property rights are often subject to uncompensated limitations based on the public interest.<sup>127</sup> Resale restrictions apply to food, firearms, pharmaceuticals, alcoholic beverages, and flammable materials.<sup>128</sup> Similarly, real property rights can be subject to uncompensated limitations.<sup>129</sup> For example, zoning law, nuisance law, historic preservation laws, and endangered species laws can limit or restrict many potential uses of real property with significant negative economic effects.<sup>130</sup> Intellectual property rights are also subject to limitations.<sup>131</sup> The fair use doctrine immunizes certain activities from copyright infringement.<sup>132</sup> The use of valuable trademarks in comparative advertising<sup>133</sup> or news

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<sup>124</sup> See generally MCCARTHY, *supra* note 1, § 2:2 at 88–94 (discussing fairness as a justification for the right of publicity in the context of a natural rights theory).

<sup>125</sup> *Cardtoons*, 95 F.3d at 975 (“People deserve the right to control and profit from the commercial value of their identities because, quite simply, they’ve earned it.”). See generally MCCARTHY, *supra* note 1, § 2:2 at 88–94 (discussing fairness as a justification for the right of publicity in the context of a natural rights theory).

<sup>126</sup> See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (finding that unjust enrichment is rationale for right of publicity); *Cardtoons*, 95 F.3d at 976 (noting that one justification for right of publicity is prevention of unjust enrichment); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (noting that right of publicity prevents unjust enrichment).

<sup>127</sup> *Moore v. Regents of the Univ. of Cal.*, 51 Cal. 3d 120, 165–66 (Cal. 1990) (Mosk, J., dissenting).

<sup>128</sup> *Id.* at 165 n.7 (Mosk, J., dissenting).

<sup>129</sup> *Id.* at 165–66.

<sup>130</sup> *Id.* at 165 n.6.

<sup>131</sup> *Cardtoons*, 95 F.3d at 970–71 (discussing limitations placed on intellectual property rights with regards to parody, criticism, and comment).

<sup>132</sup> 17 U.S.C. § 107 (2006).

<sup>133</sup> “It is well settled that the use of a trademark in a truthful comparative advertisement to refer to another company is entirely permissible.” SCHECHTER & THOMAS, *supra* note

reporting<sup>134</sup> is not actionable by the trademark owner. Likewise, property rights based on the right of publicity should also be subject to appropriate policy based restrictions like other forms of property.

### B. Utilitarian Justification

Today, commentators<sup>135</sup> and courts<sup>136</sup> view the right of publicity as a species of intellectual property law. Accordingly, it makes sense to apply the underlying justification for intellectual property law to the right of publicity. Intellectual property law, like property law generally, is typically justified under a utilitarian theory.<sup>137</sup> The underlying policy justification for intellectual property law is a desire to benefit society generally by encouraging creativity and innovation in its many forms.<sup>138</sup> The granting of property rights is not the ultimate goal. Instead, granting such rights is viewed as a method of incentivizing individuals and enterprises to spend time, money, and effort on creative and innovative endeavors that ultimately enrich the public.<sup>139</sup> Hence, granting property rights would be inconsistent with this

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2, § 31.2.2 at 743; *see also* 15 U.S.C. § 1125(c)(3)(A)(i) (2006) (excluding use of trademark in comparative advertising as actionable for trademark dilution).

<sup>134</sup> CRAIG ALLEN NARD, MICHAEL J. MADISON, MARK P. MCKENNA & DAVID W. BARNES, *THE LAW OF INTELLECTUAL PROPERTY* 1115 (3d ed. 2011); *see also* 15 U.S.C. § 1125(c)(3)(B) (excluding use of trademark in news reporting as actionable for trademark dilution). *See generally* 15 U.S.C. § 1115(b)(4) (2006) (codifying fair use defense to trademark infringement).

<sup>135</sup> *See, e.g.*, MCCARTHY, *supra* note 1, § 1:3 at 3; SCHECHTER & THOMAS, *supra* note 2, § 1.1 at 1.

<sup>136</sup> *See, e.g.*, *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003); *see also* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977) (noting that the goal of right of publicity action is closely analogous to the purpose of patent and copyright law, which is to encourage creativity by allowing person to economically benefit from his or her endeavors).

<sup>137</sup> *See* DUKEMINIER ET AL., *supra* note 46, at 50 (utilitarian theory is dominant view of property); Abraham Bell & Gideon Parchomovsky, *A Theory of Property*, 90 CORNELL L. REV. 531, 542 (2005) (noting most scholars rely on a utilitarian property theory); *see also* Adam D. Moore, *A Lockean Theory of Intellectual Property*, 21 HAMLINE L. REV. 65, 65 (1997) (intellectual property law based on utilitarian policy that granting property rights to inventors and authors maximizes incentives to engage in creative activities).

<sup>138</sup> *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

<sup>139</sup> *Cartoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996); *see also* *Zacchini*, 433 U.S. at 576-77.

justification if it did not incentivize action that furthered the ultimate goal of providing societal benefits.<sup>140</sup>

The determinative question then becomes whether the right of publicity is necessary to incentivize individuals to pursue the economic benefits of fame and fortune. Celebrity compensation provides incentives for individuals to strive for fame in various endeavors.<sup>141</sup> Professional athletes can earn far more than the average person even if they are only moderately successful.<sup>142</sup> In some industries the mere potential for above-average compensation can provide adequate incentives. For example, minor league baseball players earn subsistence salaries while pursuing a mere chance to play major league ball with its attendant high salaries and perks.<sup>143</sup> Median salaries for entertainers are likewise minimal but many still pursue fame and fortune in the industry.<sup>144</sup> Typically, an individual will not have the opportunity to gain an economic benefit from his or her right of publicity until they have become a celebrity,<sup>145</sup> so the rewards of becoming a celebrity are sufficient inducement to pursue such a path.

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<sup>140</sup> In *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007), the court denied a right of publicity action for professional baseball players, in part, because it concluded the right of publicity was not necessary to incentivize baseball players to excel.

<sup>141</sup> See Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 955 (2006).

<sup>142</sup> See, e.g., Jarrett Bell, *Money Management a Difficult Lesson for NFL's Rookie Class*, USA TODAY (Aug. 21, 2010, 7:37 PM), [http://usatoday30.usatoday.com/sports/football/nfl/2010-07-29-nfl-rookies-money-bankruptcy\\_N.htm](http://usatoday30.usatoday.com/sports/football/nfl/2010-07-29-nfl-rookies-money-bankruptcy_N.htm); MLBPA INFO Frequently Asked Questions, MLBPLAYERS.COM, <http://mlb.mlb.com/pa/info/faq.jsp#minimum> (last visited July 26, 2012) (noting that minimum salary for a major league baseball player in 2011 was \$480,000).

<sup>143</sup> See Garrett Broshuis, *Playing for Peanuts*, BASEBALL AMERICA (Mar. 31, 2010), <http://www.baseballamerica.com/today/minors/season-preview/2010/269689.html>.

<sup>144</sup> See, e.g., *Musicians and Singers: Occupational Outlook Handbook*, United States Bureau of Labor Statistics (Mar. 29, 2012), <http://www.bls.gov/ooh/Entertainment-and-Sports/Musicians-and-singers.htm> (demonstrating that the median wage in 2009 for singers and musicians was \$22.36 per hour with full-time employment being rare).

<sup>145</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 572 (1977); see *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834-35 (6th Cir. 1983) (arguing that the "right of publicity has developed to protect the commercial interest of celebrities in their identities" and the right of privacy and the right of publicity protect fundamentally different rights, with the former protecting the "right to be let alone" and

Furthermore, if the right of publicity is a species of intellectual property law, it must be balanced against competing interests. Therefore, the right of a person to retain the economic value of his or her public persona is not unlimited.<sup>146</sup> It must be balanced against the competing goals of promoting competition, insuring the existence of a robust public domain, and protecting First Amendment rights of free expression.

Judge Alex Kozinski, in an opinion highly critical of the *White* case, stated the following in emphasizing the importance of balancing the right of publicity against maintaining a vigorous public domain:

Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, like nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.<sup>147</sup>

In *Cardtoons v. Major League Baseball Players Association*,<sup>148</sup> the court was required to balance First Amendment rights in the form of parodies against the right of publicity. The court had to determine if parody baseball trading cards, which referred to active professional baseball players, violated the players' right of publicity.<sup>149</sup> The court, which concluded that the right of publicity was not violated, stated:

One of the primary goals of intellectual property law is to maximize creative expression. The law attempts to achieve this goal by striking a proper balance between the right of a creator to the fruits of his labor and the right of future creators to free

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the latter protecting "the celebrity's pecuniary interest in the commercial exploitation of his identity"); see also Franke, *supra* note 141, at 952.

<sup>146</sup> See Leaffer, *supra* note 46, at 1363.

<sup>147</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting to order rejecting en banc rehearing).

<sup>148</sup> 95 F.3d 959 (10th Cir. 1996).

<sup>149</sup> *Id.* at 962.



expression. Underprotection of intellectual property reduces the incentive to create; overprotection creates a monopoly over the raw material of creative expression. The application of the . . . publicity rights statute to . . . [parody baseball] trading cards presents a classic case of overprotection. Little is to be gained, and much lost, by protecting [the baseball players'] right to control the use of [the players'] identities in parody trading cards. The justifications for the right of publicity are not nearly as compelling as those offered for other forms of intellectual property, and are particularly unpersuasive in the case of celebrity parodies. The cards, on the other hand, are an important form of entertainment and social commentary that deserves First Amendment protection.<sup>150</sup>

Judge Kennedy's dissenting opinion in the *Carson* cases approves of the existence of a right of publicity action to protect the economic value of a celebrity's persona.<sup>151</sup> However, Judge Kennedy is troubled by extending the scope of the right beyond specific individual identifiers such as name or likeness.<sup>152</sup> She fears that such a broad view of the right of publicity has the potential to interfere with the public domain by preventing certain common words or phrases from being freely used by the public.<sup>153</sup> She also noted that "commercial and competitive interests are potentially compromised by an expansive approach to right of publicity."<sup>154</sup> Finally, Judge Kennedy opines that the right of

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<sup>150</sup> *Id.* at 976.

<sup>151</sup> *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983) (Kennedy, J., dissenting).

<sup>152</sup> "I do not believe that the common law right of publicity may be extended beyond an individual's name, likeness, achievements, identifying characteristics or actual performances, to include phrases or other things which are merely associated with the individual . . . ." *Id.* Judge Alex Kozinski shares the same view as Judge Kennedy. *See White*, 989 F.2d at 1514.

<sup>153</sup> *Carson*, 698 F.2d at 837.

<sup>154</sup> *Id.* at 840.

publicity may be preempted by federal copyright law,<sup>155</sup> but even if preemption is not applicable, First Amendment freedom of speech concerns should limit broad interpretation of the right of publicity.<sup>156</sup>

Although most judicial decisions have rejected a copyright preemption argument,<sup>157</sup> the First Amendment has been generally recognized by courts as a constitutional limitation on the right of publicity.<sup>158</sup> As a general rule, the reporting of newsworthy information<sup>159</sup> or information of great public interest,<sup>160</sup> as well as parodies,<sup>161</sup> are insulated by the First Amendment from a right of publicity action. Despite agreement that the First Amendment can

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<sup>155</sup> *Id.* at 839–40.

<sup>156</sup> *Id.* at 841.

<sup>157</sup> MCCARTHY, *supra* note 1, § 11:50 at 832 (noting the majority rule is that federal copyright law does not preempt state-based right of publicity); *see also* Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 225–26 (2002) (noting that few courts have found right of publicity preempted by copyright law).

<sup>158</sup> *See, e.g.*, *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 567–68 (1977) (discussing interaction of state-based right of publicity action and First Amendment); *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (holding that First Amendment rights outweighed right of publicity); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003) (“There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment.”); *see also* *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003).

<sup>159</sup> *See, e.g.*, *Toffoloni v. LFB Publ'g Group*, 572 F.3d 1201, 1208 (11th Cir. 2009) (finding First Amendment freedom of the press outweighs right of publicity with regard to publication of newsworthy information); *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790, 792 (Cal. Ct. App. 1993) (finding the right of publicity does not bar reporting newsworthy facts); *see also* *Apple Corps Ltd. v. Leber*, No. C 299149, 1986 WL 215081, at \*1017 (Cal. Super. Ct. Jun. 3, 1986) (describing how “newsworthy matters or matters of legitimate public interest” are outside the domain of the right of publicity). Some right of publicity statutes provide exceptions for conduct such as reporting news or information about public affairs. *See, e.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 311–13 (Cal. Ct. App. 2001).

<sup>160</sup> *See, e.g.*, *Browne v. McCain*, 611 F. Supp. 2d 1062, 1071 (C.D. Cal. 2009) (finding a public interest defense can bar a right of publicity action); *Rosemont Enter., Inc. v. Random House, Inc.*, 294 N.Y.S.2d 122, 129 (N.Y. Sup. Ct. 1968) (describing how a right of publicity action may be barred if it “conflicts with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest”).

<sup>161</sup> *See, e.g.*, *Cardtoons*, 95 F.3d 959, 976 (holding First Amendment right to parody athlete outweighs athlete’s right of publicity action).

limit the right of publicity, courts have developed a variety of tests for drawing a line between the property rights encapsulated in the right of publicity and the free speech rights enshrined in the First Amendment.<sup>162</sup> As suspected, these tests are not always consistent.<sup>163</sup> Moreover, some courts find First Amendment interests outweigh the property rights under the right of publicity without articulating any specific test.<sup>164</sup>

In *Comedy III Productions, Inc. v. Saderup, Inc.*,<sup>165</sup> the defendant made a charcoal drawing of the Three Stooges that he sold on t-shirts and as lithographs.<sup>166</sup> Although the drawings were original artistic works created by defendant, they were very lifelike in nature.<sup>167</sup> Therefore, selling them on shirts and as lithographs clearly implicated the right of publicity.<sup>168</sup> Nevertheless, according to the court, the underlying property interest embodied in the right of publicity was inseparable from the defendant's First Amendment right to freely create original artistic works.<sup>169</sup> The California Supreme Court, noting the conflict between the right of publicity and the First Amendment, articulated what was to become known as the transformative use test:

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<sup>162</sup> Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 769 (D.N.J. 2011) (describing how courts use several balancing tests to determine if First Amendment free speech rights limit a right of publicity action); see also Franke, *supra* note 141, at 963 (describing how the transformative test and the predominant use test are most commonly used tests); W. Webner & Leigh Lindquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171, 185 (2004) (quoting *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001)) (noting that state's interest in protecting labor of performing artist must be balanced against promoting free expression).

<sup>163</sup> See CHISUM ET AL., *supra* note 50, § 6G[4][c] at 758 (noting recent case law inconsistent with regard to interaction of First Amendment and right of publicity); see also Hart, 808 F. Supp. 2d at 774 (describing how general consensus does not exist with regard to how to balance First Amendment free speech rights with the property rights protected by right of publicity).

<sup>164</sup> See, e.g., *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823–24 (8th Cir. 2007).

<sup>165</sup> 21 P.3d 797 (Cal. 2001).

<sup>166</sup> *Id.* at 800–01.

<sup>167</sup> *Id.* at 811.

<sup>168</sup> *Id.* at 802.

<sup>169</sup> *Id.* at 802–03.

A California statute grants the right of publicity to specified successors in interest of deceased celebrities, prohibiting any other person from using a celebrity's name, voice, signature, photograph, or likeness for commercial purposes without the consent of such successors. The United States Constitution prohibits the states from abridging, among other fundamental rights, freedom of speech. In the case at bar we resolve a conflict between these two provisions. . . . We formulate . . . what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.<sup>170</sup>

The transformative use test<sup>171</sup> is borrowed in part from the fair use test utilized in copyright law<sup>172</sup> to determine when the perpetrators of certain infringing actions should be exempted from liability in light of First Amendment concerns.<sup>173</sup> Application of the test in this case was relatively easy because defendant's drawings were very lifelike renderings of the Three Stooges.<sup>174</sup> The difficult issue for future courts will be to determine how transformative a work must be to outweigh a right of publicity claim because this test is inherently vague and uncertain.<sup>175</sup>

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<sup>170</sup> *Id.* at 799.

<sup>171</sup> See *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 407 (Cal. Ct. App. 2011) (noting that, under the transformative use test, the question is whether the work at issue has been so transformed that it is predominantly defendant's expression rather than merely a celebrity likeness); see also Donna Cunningham, *Political Parody Collides with the Right of Publicity: The Case of the Bobblehead Governor*, 21 *MIDWEST L.J.* 119, 126–27 (2007) (discussing the transformative use test).

<sup>172</sup> 17 U.S.C. § 107 (2006).

<sup>173</sup> See *Comedy III Prods., Inc.*, 21 P.3d at 807–08 (rejecting wholesale adoption of the fair use test while adopting the first factor of the four-factor fair use test, which requires an analysis of the “the purpose and character of the use” and is codified in the copyright law at 17 U.S.C. § 107(1)).

<sup>174</sup> *Id.* at 811.

<sup>175</sup> See generally Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 *HOUS. L. REV.* 903, 916–25 (2003) (critical discussion of the transformative use test).

In *Doe v. TCI Cablevision*,<sup>176</sup> a professional hockey player named Tony Twist objected to defendant's use of a comic book character sharing his name.<sup>177</sup> The Missouri Supreme Court, noting the conflict between the right of publicity and the First Amendment,<sup>178</sup> indicated that a balancing test should be used to determine which right prevails.<sup>179</sup> The court rejected the transformative use balancing test adopted by the California Supreme Court in *Comedy III Productions, Inc.* in favor of the predominant use test.<sup>180</sup> Under this test, the court sought to determine whether the predominant use of the Mr. Twist's identity in defendant's comic books sought to exploit the commercial value of his identity, triggering a right of publicity action<sup>181</sup> or whether the predominant use was as expressive content—such as a parody—which is constitutionally-protected speech that trumps the right of publicity.<sup>182</sup> The court concluded:

[T]he . . . reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.<sup>183</sup>

*ETW Corp. v. Jireh Publishing, Inc.*<sup>184</sup> involved an artist, Rick Rush, who created paintings of famous athletes and sporting events.<sup>185</sup> The defendant was authorized to produce and sell limited edition prints made from Mr. Rush's paintings.<sup>186</sup>

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<sup>176</sup> 110 S.W.3d 363 (Mo. 2003) (en banc).

<sup>177</sup> *Id.* at 365.

<sup>178</sup> *See id.* at 372 (noting that this conflict has been a difficult issue and that courts have generally struggled with it).

<sup>179</sup> *See id.* at 373–74 (discussing the different balancing tests available).

<sup>180</sup> *See id.* at 374.

<sup>181</sup> *Id.*

<sup>182</sup> *Id.* at 375.

<sup>183</sup> *Id.* at 374.

<sup>184</sup> 332 F.3d 915 (6th Cir. 2003).

<sup>185</sup> *Id.* at 918.

<sup>186</sup> *Id.*

Specifically, these were prints of a painting commemorating the famous golfer Tiger Woods' victory at the Masters Tournament in Augusta, Georgia.<sup>187</sup> In contrast to the drawing in *Comedy III Productions, Inc.*, which only contained a realistic likeness of the Three Stooges,<sup>188</sup> the print included more than a mere likeness of Mr. Woods. It included other individuals and references to the Masters Tournament and the Augusta golf course on which it is played.<sup>189</sup> Overall it portrayed a historic event in the sports world.<sup>190</sup> The court noted the tension between the right of publicity and the First Amendment<sup>191</sup> and identified the Restatement (Third) of Unfair Competition<sup>192</sup> as providing the test for balancing these rights.<sup>193</sup> Under this approach, the First Amendment prevails if a person's identity is primarily used to communicate information or ideas such as for news reporting, biographies, novels, plays, or movies.<sup>194</sup> In contrast, the right of publicity prevails if a person's name or likeness is used solely to attract attention to a work that is unrelated to the person, or if the work at issue contains substantially false information.<sup>195</sup> The court also noted that despite its reliance on the Restatement, the transformative use test utilized in *Comedy III Productions, Inc.* could be helpful, though not controlling.<sup>196</sup> Ultimately, the court concluded that the artist's First Amendment rights outweighed Mr. Woods' right of publicity.<sup>197</sup> This result seems consistent with both the Restatement and the transformative use test since the artist added substantial original work to the painting such that it was significantly transformative.<sup>198</sup> The painting was clearly communicating that Mr. Woods won the Masters Tournament,

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<sup>187</sup> *Id.*

<sup>188</sup> *See id.* at 936.

<sup>189</sup> *Id.*

<sup>190</sup> *Id.*

<sup>191</sup> *Id.* at 931.

<sup>192</sup> *See id.*; RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46–48.

<sup>193</sup> *ETW Corp.*, 332 F.3d at 931.

<sup>194</sup> *Id.* at 930.

<sup>195</sup> *Id.* at 930–31.

<sup>196</sup> *See id.* at 936.

<sup>197</sup> *Id.* at 938.

<sup>198</sup> *Id.*

which is a historic event in the sports world and thus argues for a broader range of permissible uses of an individual's persona.<sup>199</sup>

Additionally, other policy concerns outweigh application of the labor and unjust enrichment theories in intangible property law. Under the common law, a novel idea is generally not legally protectable from unauthorized third party use unless it is a "well-developed" idea.<sup>200</sup> This requirement is typically described as the concrete or concreteness requirement.<sup>201</sup> Under this approach, a purely abstract idea is usually not entitled to property protection regardless of its value or the effort entailed in developing it.<sup>202</sup> Some courts have even held that an abstract idea cannot be the subject of a contractual agreement.<sup>203</sup>

An identical result is reached under patent law.<sup>204</sup> There, an abstract idea is likewise not eligible to be considered for utility patent protection.<sup>205</sup> For example, even if a researcher spent years and millions of dollars developing a mathematical formula that describes previously unknown relationships in physics, it would not be eligible for patent protection<sup>206</sup>—even if the potential economic value of the formula was significant.<sup>207</sup> However, a

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<sup>199</sup> *Id.*

<sup>200</sup> *See Tate v. Scanlan Int'l, Inc.*, 403 N.W.2d 666, 671 (Minn. Ct. App. 1987) (legal protection only extended to ideas that are both novel and well-developed); *see also Sellers v. Am. Broad. Co.*, 668 F.2d 1207, 1210 (11th Cir. 1982) (action for misappropriation of idea only allowed if idea is both novel and concrete).

<sup>201</sup> *Scanlan Int'l, Inc.*, 403 N.W.2d at 672 (concrete requirement satisfied if idea sufficiently complete so that it can be used without the need for any significant development before it can be implemented).

<sup>202</sup> *See Smith v. Recrion Corp.*, 541 P.2d 663, 669 (Nev. 1975) (legal protection only extends to abstract ideas that are both novel and concrete). *See generally Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 460 (6th Cir. 2001) (typically ideas must be both novel and concrete in order to be protected as property).

<sup>203</sup> *See, e.g., Scanlan Int'l, Inc.*, 403 N.W.2d at 671 (idea must be both novel and concrete to be subject of a contract).

<sup>204</sup> *See generally Jennings v. Brenner*, 255 F. Supp. 410 (D.D.C. 1966) (a contract cannot consist of an abstract idea).

<sup>205</sup> *Id.* at 412.

<sup>206</sup> *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) ("Einstein could not patent his celebrated law that  $E=mc^2$ ; nor could Newton have patented the law of gravity.").

<sup>207</sup> *See Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U.S. 364, 384 (1942). *See Diamond*, 447 U.S. at 309 ("The laws of nature, physical phenomena, and abstract ideas have been held not patentable."); *In re Fisher*, 421 F.3d 1365, 1371, 1373 (Fed. Cir.

machine that utilizes the formula to complete a specific task would be patent-eligible.<sup>208</sup>

By contrast, copyright law denies protection to all ideas and information, not just abstract ideas.<sup>209</sup> This is reflected in the delineation between ideas, which go unprotected, and copyright law's protection of original means of expressing ideas.<sup>210</sup> A news organization, for example, may spend substantial money maintaining an overseas news bureau. Based on substantial expenditures, the news organization publishes a series of articles that reveal previously secret information about governmental activities. Anyone is free to use the information disclosed in the articles even though such use potentially amounts to free riding or unjust enrichment.<sup>211</sup> Copyright law does not protect such information.<sup>212</sup> Only the form of expression of the information in the articles is protected.<sup>213</sup> Therefore, a third party could not copy the articles verbatim, but they could extract and use the information in the articles.<sup>214</sup> A competing news organization may even be able to freely use the information in its original news stories.<sup>215</sup>

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2005) (basic scientific discoveries that are only useful for engaging in further research are ineligible for patent protection).

<sup>208</sup> See generally *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. 498, 507 (1874) (“An idea of itself is not patentable, but a new device by which it may be made practically useful is.”).

<sup>209</sup> 17 U.S.C. § 102(b) (2006); *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1234 (3d Cir. 1986) (ideas not protected by copyright).

<sup>210</sup> See *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (copyright law protects expression of an idea but not the idea itself); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (copyright only protects form of expression of idea but not idea itself).

<sup>211</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

<sup>212</sup> *Id.*

<sup>213</sup> *Id.*

<sup>214</sup> *Id.*

<sup>215</sup> See *id.* at 353–54. Although copyright law may be inapplicable in this situation, the Supreme Court did enjoin one news-gathering organization from free riding on the work of a competing news-gathering organization under a common law unfair competition theory generally referred to as a misappropriation action. *Int'l News Serv. v. Associated Press*, 248 U.S. 215 (1918). However, this theory has rarely been successful in subsequent disputes. See Andrew Beckerman-Rodau, *Ideas and the Public Domain: Revisiting INS v. AP in the Internet Age*, 1 N.Y.U. J. INTELL. PROP. & ENT. LAW 1, 15



Trademark law recognizes and protects investments in marketing and branding efforts that infuse a trademark with a substantial mental association.<sup>216</sup> For example, the law protects the mental association that exists when a consumer sees the word “Coke” or “Toyota” on an appropriate product.<sup>217</sup> Nevertheless, in the interest of promoting competition, unauthorized use of a trademark is permitted in comparative advertising.<sup>218</sup> Unauthorized use of a trademark is also permitted for purposes of social commentary,<sup>219</sup> parody,<sup>220</sup> artistic expression,<sup>221</sup> and news reporting<sup>222</sup> consistent with First Amendment rights. Finally, unauthorized third party commercial use of a trademark is generally permissible if such use does not result in a likelihood of confusion among the intended consumer group.<sup>223</sup>

Likewise, trade secrets law does not rely exclusively on a labor or unjust enrichment theory for its justification. Although it allows protection for a broad range of information that provides an economic advantage over competitors,<sup>224</sup> it also allows free riding

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(2011) (critical discussion of *International News Service* advocating elimination of the misappropriation action).

<sup>216</sup> See, e.g., *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987) (trademark law protects property interest in a trademark).

<sup>217</sup> See, e.g., *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (“A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he had been led to believe he wants . . .”).

<sup>218</sup> See *SSP Agric. Equip., Inc. v. Orchard-Rite, Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979) (using competitor’s trademark in a comparative advertisement is allowable absent consumer confusion or misrepresentations).

<sup>219</sup> See *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 44 (2d Cir. 1994).

<sup>220</sup> See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490 (2d Cir. 1989) (finding the use of trademark in parody of Cliffs Notes study guide not actionable under trademark law).

<sup>221</sup> See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1281 (11th Cir. 2012) (finding the use of trademarks in original paintings of college football players not actionable under trademark law).

<sup>222</sup> Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT’L L. 405, 413 (2010).

<sup>223</sup> See *Int’l Jenson, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 827 (9th Cir. 1993). See generally *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (noting that trademark law protects consumers from confusion, but if a trademark enters the common vocabulary and becomes a cultural reference it is no longer serving a trademark function and First Amendment rights then trump trademark rights).

<sup>224</sup> See Uniform Trade Secrets Act § 1(4) (1985); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995) (“A trade secret is any information that can be used in

under certain circumstances.<sup>225</sup> For example, a company may spend millions of dollars developing a new product line, but each individual product might sell for only a few hundred dollars. A competitor could buy the product, reverse engineer it and, based on its findings, it could then manufacture and sell a copy of the product.<sup>226</sup> This might allow the competitor to free ride by avoiding the costly research and development work done by the original company that created the product. Such action is legally permissible despite the fact that it ultimately amounts to free riding.<sup>227</sup>

The above approaches under the common law, patent law, copyright law, trademark, and trade secrets law may seem unfair from the perspective of a labor and unjust enrichment theory. Without negating the value of these theories, the question then becomes whether there are competing underlying policies that weigh against the labor and unjust enrichment theories. In general, the importance of allowing abstract ideas and information to be part of the public domain traditionally has been viewed as a competing and superseding policy.<sup>228</sup> Sometimes this policy is

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the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.”).

<sup>225</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 cmt. a (1995) (“The freedom to compete in the marketplace includes, in the absence of patent, copyright, or trademark protection . . . the freedom to copy the goods, methods, processes, and ideas of others.”).

<sup>226</sup> Reverse engineering is the process of “starting with the known product and working backward to divine the process which aided in its development or manufacture.” *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 476 (1974).

<sup>227</sup> See *id.* (noting that reverse engineering is legally permissible under trade secrets law).

<sup>228</sup> In *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting), Judge Kozinski stated:

[I]t may seem unfair that much of the fruit of a creator’s labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system’s very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means by which intellectual property law advances the progress of science and art. We give authors certain exclusive rights, but in exchange we get a richer public domain.

*Id.*

found in the critical importance of the First Amendment freedom of speech rights, which must be strongly protected in a democracy.<sup>229</sup> In the commercial context, the desire to promote competition may also provide justification for treating some things as part of the public domain and therefore denying them property protection.<sup>230</sup> Finally, the importance of information to the public generally may sometimes outweigh giving private ownership to intangibles.<sup>231</sup> Nevertheless, such concerns should never totally outweigh intangible property rights, which are also critical to the existence of both a democracy and a free enterprise economic system.<sup>232</sup> The issue then becomes how to provide property protection for a person's persona without overreaching and interfering with these competing concerns.

#### IV. ASSOCIATION-BASED RELATIONSHIPS VS. CONFUSION-BASED RELATIONSHIPS

As previously discussed, right of publicity actions can be viewed on a continuum that includes both confusion-based and association-based relationships. Confusion-based relationships include situations where a person's name or likeness is used in commercial advertising, creating a likelihood that consumers will

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<sup>229</sup> See *U.S. v. Carrier*, 672 F.2d 300, 305 (2d Cir. 1982) (free dissemination of ideas is an essential element of democracy). See also *Palko v. Conn.*, 302 U.S. 319, 326–27 (1937) (Cardozo, J.) (noting freedom of thought and speech are indispensable to nearly every other form of freedom).

<sup>230</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 1 cmt. a (1995) (“Freedom to engage in business and to compete for the patronage of prospective customers is a fundamental premise of the free enterprise system.”).

<sup>231</sup> See, e.g., *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (mathematical formulas such as  $E=mc^2$  or the discovery of a new mineral or plant are not patentable subject matter); see also *Parker v. Flook*, 437 U.S. 584, 585 (1978) (discovery of new and useful mathematical formula not patent-eligible subject matter); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (scientific truth even if expressed as a mathematical formula not patentable); see also *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293(2012) (laws of nature, natural phenomena, mental processes, and abstract ideas not eligible for patent protection). *Accord Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010).

<sup>232</sup> See generally *White*, 989 F.2d at 1517 (Kozinski, J., dissenting) (noting importance of balances built into intellectual property law between what a creator owns and what portion of such creations are free for everyone to use as part of the public domain).

believe the person endorses or approves of the advertised product.<sup>233</sup> Typically, the use of the name or picture of a celebrity in an advertisement without any type of disclaimer will per se cause consumers to believe the person endorses or approves of the product in the advertisement.<sup>234</sup> Such a result should be actionable. In contrast, mere references that conjure associations with a person do not automatically create a likelihood that consumers will be confused as to whether the person endorses or approves of the product.<sup>235</sup> However, if such likelihood is shown to exist, then a confusion-based action should be permitted.<sup>236</sup>

Further along the continuum are association-based relationships where commercial advertising causes consumers to associate the product or the advertisement with a celebrity but such consumers do not believe the celebrity endorsed or approved of the advertised product.<sup>237</sup> For example, in the previously discussed *Carson* case the court concluded that selling portable toilets with the advertising phrase “Here’s Johnny” could cause consumers to make an association with Mr. Carson even though consumers would not think he endorsed or was affiliated with the business in any way.<sup>238</sup> Likewise, David Letterman has made his humorous top ten lists famous.<sup>239</sup> As a result, using a top ten list in advertising could create a mental association with Mr. Letterman.<sup>240</sup> For example, LexisNexis produced the following advertising brochure:

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<sup>233</sup> See e.g., *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983).

<sup>234</sup> See *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 627 n.8 (S.D.N.Y. 1985) (“When a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement.”).

<sup>235</sup> See generally *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (noting that the Sixth Circuit has created an eight-factor test to determine the likelihood of confusion).

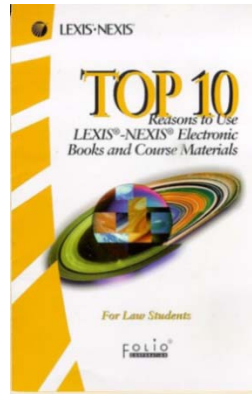
<sup>236</sup> *Id.* at 925–26.

<sup>237</sup> See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149–50 (9th Cir. 2002).

<sup>238</sup> *Carson*, 698 F.2d at 836.

<sup>239</sup> An archive of Mr. Letterman’s Top Ten lists is available at [http://www.cbs.com/late\\_night/late\\_show/top\\_ten/](http://www.cbs.com/late_night/late_show/top_ten/) (last visited Oct. 7, 2012).

<sup>240</sup> Numerous websites and books dedicated to top ten lists exist. See, e.g., *The Top Tens*, available at <http://www.the-top-tens.com/> (last visited Oct. 7, 2012); *Top Tenz*, available at <http://www.toptenz.net/> (last visited Oct. 12, 2012).



The above advertisement is likely to produce, at most, an association-based relationship with Mr. Letterman rather than a confusion-based relationship. Such a relationship should not be barred by a potential right of publicity action.

The following advertisement for a 2004 Michael Moore film<sup>241</sup> may have also created an association-based relationship—but not a confusion-based relationship—with Ray Bradbury, author of the famous book *Fahrenheit 451*.<sup>242</sup> Nevertheless, this should not be a basis for a right of publicity action by Mr. Bradbury. Likewise, President George W. Bush should not have a right of publicity action merely because his picture was used in an advertisement to commercialize a movie. It is unlikely that consumers will believe President Bush would have endorsed a movie critical of his presidency.

<sup>241</sup> [HTTP://WWW.FAHRENHEIT911.COM/ABOUT/POSTER/](http://www.fahrenheit911.com/about/poster/) (last visited Oct. 12, 2012). See <http://www.michaelmoore.com/books-films/fahrenheit-911> (last visited Oct. 7, 2012).

<sup>242</sup> RAY BRADBURY, *FAHRENHEIT 451* (1953).



Moreover, confusion-based relationships do not need protection via the right of publicity; such relationships are already protected generally by trademark and unfair competition law.<sup>243</sup> Today, the scope of subject matter protectable as a trademark or service mark is very broad.<sup>244</sup> For example, it is possible for a celebrity to register his or her name as a trademark and/or service mark under federal trademark law.<sup>245</sup> Unfair competition actions

<sup>243</sup> See J. Thomas MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 28.14 (4th ed. 2012) (noting that falsity is not a necessary element of infringement of the right of publicity, where this could easily be proven via trademark infringement).

<sup>244</sup> See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (green-gold color of press pads used by dry cleaners can be a trademark); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (pink color of fiberglass insulation recognized as a trademark); Registration No. 2,007, 624 (mark for goats on a roof of grass for restaurant services); Registration No. 3,155,702 (sensory or touch trademark registered for the feel of a velvet-textured covering on a bottle of wine); GOLDSTEIN & REESE, *supra* note 2, at 256–57 (three-dimensional product packages can be protected as trademarks); Douglas D. Churovich, *Scents, Sense or Cents?; Something Stinks in the Lanham Act: Scientific Obstacles to Scent Marks*, 20 ST. LOUIS U. PUB. L. REV. 293, 294–95 (2001) (discussing trademark registration of a scent that was applied to thread and yarn). See generally Gary Myers, *Statutory Interpretation, Property Rights, and Boundaries: The Nature and Limits of Protection in Trademark Dilution, Trade Dress, and Product Configuration Cases*, 23 COLUM.-VLA J.L. & ARTS 241 (2000) (discussing expansion of trademark rights today).

<sup>245</sup> See 15 U.S.C. § 1052(e)(4), (f) (2006) (allowing surname to be registered as trademark provided it has acquired distinctiveness); see also Russell Jacobs, *Recapturing Rareness: The Significance of Surname Rareness in Trademark Registration Determinations*, 50 IDEA 395 (2010) (discussing registering names as trademarks). The

are also permitted and have been broadly construed under federal trademark law such that they apply even in the absence of an existing trademark.<sup>246</sup> Both trademark infringement actions and unfair competition actions, which are also available under state law, are premised on protecting the consuming public from actual or potential deception.<sup>247</sup> As a general rule, the legal standard used in such actions under both federal and state law is whether a substantial number of people in the intended consumer market are likely to be confused with regard to some aspect or characteristic of the product or service being sold.<sup>248</sup> This includes creating a likelihood that someone—typically a celebrity—endorses or approves of a product or service when in reality that is untrue.<sup>249</sup> Hence, any use of a celebrity's name or likeness would be actionable as trademark infringement or unfair competition if members of the intended consumer market are likely to incorrectly believe the celebrity endorses or supports the product or services

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musicians Beyoncé Knowles and Jay-Z filed trademark application for the name of their daughter, Blue Ivy Carter. Although the trademark application has initially been rejected by the Patent and Trademark Office, it is still pending. See Roxanne Roberts & Amy Argetsinger, *The Reliable Source*, WASHINGTON POST (Feb 3, 2012, 1:39 PM), [http://www.washingtonpost.com/blogs/reliable-source/post/blue-ivy-the-trademark-feds-move-fast-on-rights-to-beyonce-and-jay-zs-babys-name/2012/02/03/gIQAOTDGNQ\\_blog.html](http://www.washingtonpost.com/blogs/reliable-source/post/blue-ivy-the-trademark-feds-move-fast-on-rights-to-beyonce-and-jay-zs-babys-name/2012/02/03/gIQAOTDGNQ_blog.html).

<sup>246</sup> See *Kournikova v. Gen. Media Commc'ns, Inc.*, No. CV 02-3747 GAF, 2002 U.S. Dist. LEXIS 25810, at \*17 (C.D. Cal. Aug. 9, 2002) (“A celebrity may bring a false endorsement claim for the unauthorized use of her identity if such use is likely to confuse consumers as to the celebrity’s sponsorship or approval of the product.”). See generally *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (unfair competition action under 15 U.S.C. § 1125(a) is a new federal tort what covers more than trademark infringement and it should be construed broadly to remedy unfair competitive actions).

<sup>247</sup> See *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2007).

<sup>248</sup> See *Ga. Pac. Consumer Prods., LP v. Von Drehle Corp.*, 618 F.3d 441, 449 (4th Cir. 2010) (“[T]he tests for trademark infringement and unfair competition under the Lanham Act are essentially the same as that for common law unfair competition . . . ; all focus on the likelihood of confusion as to the source of the goods involved.”); see also *Karl Storz Endoscopy-Am., Inc. v. Surgical Techs., Inc.*, 285 F.3d 848, 854 (9th Cir. 2002) (test for trademark infringement is whether consumers will be likely to be confused as to source or origin of relevant product or service); *Storball v. Twentieth Century Fox Film Corp.*, 1993 U.S. Dist. LEXIS 20455, at \*4 (C.D. Cal. Nov. 8, 1993) (unfair competition claim based on false endorsement requires showing a likelihood that consumers will be confused “as to the origin, approval, or endorsement of the product”).

<sup>249</sup> See generally MCCARTHY, *supra* note 243, § 28.15.

his name or likeness is associated with.<sup>250</sup> This same standard should apply even if the name or likeness of the celebrity is not used, such as in the *Carson* case.<sup>251</sup> The ultimate controlling issue should be whether consumers are likely to be confused.

Therefore, neither trademark infringement nor unfair competition law would render the use of a person's name or likeness actionable in the absence of any likelihood of consumer confusion.<sup>252</sup> Typically, the line is drawn to support a robust public domain, to engender free competition, and to accommodate First Amendment free speech considerations.<sup>253</sup> This means a certain amount of free riding must be tolerated without the ability to bring legal action barring it.<sup>254</sup> For example, one common over-the-counter painkiller is better known via its trademark or brand name, *TYLENOL*,<sup>255</sup> than by its generic product name, acetaminophen or paracetamol.<sup>256</sup> This is a consequence of substantial advertising and marketing expenditures by the maker of the *TYLENOL* brand of acetaminophen.<sup>257</sup> Hence, some

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<sup>250</sup> See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992).

<sup>251</sup> See *MCCARTHY*, *supra* note 243, § 28.15.

<sup>252</sup> See *Kournikova v. Gen. Media Commc'ns, Inc.*, No. CV 02-3747 GAF, 2002 U.S. Dist. LEXIS 25810, at \*17 (C.D. Cal. Aug. 9, 2002) (“A celebrity may bring a false endorsement claim for the unauthorized use of her identity if such use is likely to confuse consumers as to the celebrity’s sponsorship or approval of the product.”).

<sup>253</sup> See *generally* *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1402 (9th Cir. 1992) (Alarcon, J., dissenting) (noting that when protecting intellectual property, the court must balance competing interests between protecting the creation and investment of intellectual property while preventing monopolies that would inhibit creative expressions).

<sup>254</sup> See *generally* *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting) (noting careful balances built into intellectual property law which allow the public to use things created by others).

<sup>255</sup> See *Too Much Acetaminophen over Time May Damage Liver*, USA TODAY, Nov. 23, 2011, available at <http://www.usatoday.com/news/health/story/health/story/2011-11-23/Too-much-acetaminophen-over-time-may-damage-liver/51369772/1>.

<sup>256</sup> See Acetaminophen, PUBMED HEALTH, <http://www.ncbi.nlm.nih.gov/pubmedhealth/PMH0000521/> (last visited June 22, 2012) (for information on acetaminophen).

<sup>257</sup> See Jerry Knight, *Tylenol’s Maker Shows How to Respond to Crisis*, WASH. POST, Oct. 11, 1982. See *generally* *At 50, Tylenol Brand Still Gaining Steam*, ASSOCIATED PRESS, available at [http://www.msnbc.msn.com/id/9879888/ns/health-health\\_care/t/tylenol-brand-still-gaining-steam/](http://www.msnbc.msn.com/id/9879888/ns/health-health_care/t/tylenol-brand-still-gaining-steam/) (last visited June 22, 2012) (discussing success of brand).



competitors, as shown below, who are free to make and sell generic versions of acetaminophen, place labels on their products which inform consumers that their product is equivalent to or should be compared to **TYLENOL**.<sup>258</sup>



Such conduct allows the above sellers to free ride on the value of the **TYLENOL** brand without the costs of creating the strong mental association with that brand. However, as long as the labeling is true and it does not cause a likelihood of consumer confusion, such free riding is not actionable under unfair competition law, nor is it trademark infringement because it only creates an association-based relationship between the product and the **TYLENOL** brand.<sup>259</sup> Despite any unjust enrichment from such free riding, it can be justified on the basis of enhancing competition among acetaminophen makers.<sup>260</sup> Furthermore,

<sup>258</sup> For Equate image see <http://www.walmart.com/ip/Equate-Extra-Strength-Value-Pack-Acetaminophen-Non-Aspirin/10324477> (last visited July 27, 2012); for Walgreens image see <http://www.drugstore.com/walgreens-childrens-pain-reliever-acetaminophen-meltaways-bubble-gum/qxp369209> (last visited July 27, 2012).

<sup>259</sup> See *SSP Agric. Equip., Inc. v. Orchard-Rite, Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979) (using competitor's trademark in a comparative advertisement is allowable absent consumer confusion or misrepresentations).

<sup>260</sup> See *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1408 (9th Cir. 1992) (Alarcon, J., dissenting) (noting that when protecting intellectual property, the court must balance competing interests between protecting the creation and investment of intellectual property while preventing monopolies that would inhibit creative expressions).

prohibiting the generic makers from marking their product as being comparable or equivalent to TYLENOL would amount to barring truthful commercial speech.<sup>261</sup>

The above types of association-based relationships should not be actionable.<sup>262</sup> Under this approach, Mr. Carson could not have pursued a right of publicity action in the *Carson* case.<sup>263</sup> Likewise, Ms. White would be unable to pursue a right of publicity action in the *White* case absent a showing that a confusion-based relationship existed which caused consumers to be likely to believe the advertisement's use of a robot on a television game show set to sell Samsung products was endorsed by Ms. White.<sup>264</sup>

Limiting the right of publicity to confusion-based relationships may render the cause of action redundant and therefore unnecessary because, as noted above, trademark law and unfair competition law generally already make such conduct actionable. Additionally, this approach allows application of the previously-developed delineation in intellectual property law between marketplace conduct that is permissible, and conduct that is impermissible trademark infringement or unfair competition.

The effect of this approach is actually limited because many right of publicity disputes involve confusion-based relationships, so a trademark or unfair competition theory could often have provided relief in lieu of the right of publicity.<sup>265</sup> It is only conduct that would allow a right of publicity action for an association-based relationship that would be eliminated.

For example, Bette Midler was involved in a right of publicity action that involved a sound-alike singer imitating Ms. Midler's voice without her permission in a Ford automobile commercial.<sup>266</sup>

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<sup>261</sup> See generally Leaffer, *supra* note 46, at 1364 (arguing a right of publicity action should be based on unfair competition or trademark theory rather than a property misappropriation theory).

<sup>262</sup> *Id.* at 1373.

<sup>263</sup> See *supra* text accompanying notes 56–75.

<sup>264</sup> See *supra* text accompanying notes 76–92.

<sup>265</sup> *Id.* at 1364.

<sup>266</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 460 (9th Cir. 1988).

The song involved—“Do You Want to Dance?”<sup>267</sup>—was protected via copyright and it was used pursuant to a license from the copyright owner.<sup>268</sup> The company used the sound-alike singer after Ms. Midler refused an offer to participate in the commercial.<sup>269</sup> The evidence established that the sound-alike singer sounded enough like Ms. Midler to cause some consumers to believe Ms. Midler performed for the commercial.<sup>270</sup> This is an example of a confusion-based relationship that should be actionable under an unfair competition theory<sup>271</sup> and possibly also

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<sup>267</sup> BETTE MIDLER, *Do You Want to Dance?*, on THE DIVINE MISS M (Atlantic Records 1972).

<sup>268</sup> *Midler*, 849 F.2d at 462.

<sup>269</sup> *Id.* at 461.

<sup>270</sup> *Id.* at 461–62.

<sup>271</sup> However, the court appeared to deny an unfair competition action due to a lack of economic injury to Ms. Midler. The court stated “we do not find unfair competition here. One-minute commercials of the sort the defendants put on would not have saturated Midler’s audience and curtailed her market. Midler did not do television commercials. The defendants were not in competition with her.” *Id.* at 462–63. Interestingly, Ms. Midler subsequently changed her mind and did a car commercial for Honda in 2011. See YOUTUBE, <http://www.youtube.com/watch?v=GhyLD2tWcKU> (last visited on June 25, 2012). The court’s requirement that Ms. Midler must be a competitor who suffers economic damages is contrary to other unfair competition actions, which frame the controlling issue as a question of whether consumers are likely to be confused. See, e.g., *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (one purpose of unfair competition action under federal Lanham Act, 15 U.S.C. § 1125(a), is to protect consumers from wide variety of untrue representations about goods and services provided in commerce). Consequently, if a likelihood of consumer confusion exists with regard to whether Ms. Midler was actually singing in the commercial, then she should be able to assert unfair competition, and her remedy should be damages and possibly an injunction barring playing the commercial in the future. See generally *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (finding singer Tom Waits successfully asserted an unfair competition claim for unauthorized use of a sound-alike in a radio commercial). Although the remedy available for unfair competition has traditionally been damages and/or injunctive relief, that may be different today following the Supreme Court decision *eBay, Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837 (2006). In *eBay*, the Court overruled precedent which held that a patent owner was entitled to a permanent injunction against continuing infringement after a trial on the merits found infringement. *Id.* at 1840–41. The Court held that a patent owner was entitled to damages but that injunctive relief was up to the discretion of the trial judge. *Id.* at 1839. See generally Andrew Beckerman-Rodau, *The Supreme Court Engages in Judicial Activism in Interpreting the Patent Law in eBay, Inc. v. MercExchange, L.L.C.*, 10 TUL. J. TECH. & INTELL. PROP. 165, 166 (2007) (critical analysis of the *eBay* decision). Although the *eBay* decision arose in the context of a patent infringement dispute, its holding is not limited to patent law disputes. See Mark P. Gergen, John M. Golden & Henry E. Smith,

under a trademark infringement action.<sup>272</sup> Nevertheless, the court utilized a right of publicity theory and treated the sound of Ms. Midler's voice as a pure common law property right.<sup>273</sup> This gave her the right to control who used it without regard to countervailing considerations.<sup>274</sup>

In a similar case, a singer who sounded like Tom Waits was used in a radio commercial to sell SalsaRio Doritos, a snack food.<sup>275</sup> Like Ms. Midler, Mr. Waits is a well-known singer who had a policy of not doing commercials.<sup>276</sup> In both cases, evidence of actual confusion existed.<sup>277</sup> Based on the distinctive voice of Mr. Waits, which was captured by the sound-alike singer, a jury found liability under a right of publicity theory and a federal unfair competition theory.<sup>278</sup> As for the federal unfair competition claim,

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*The Supreme Court's Accidental Revolution? The Test for Permanent Injunctions*, 112 COLUM. L. REV. 203, 205 (2012). The trend in favor of damages in lieu of injunctive relief has also been seen in real property disputes. For example, a permanent injunction was the traditional remedy for interference with the use and enjoyment of real property due to a finding that a neighboring landowner was engaged in a nuisance. *See* *Boomer v. Atl. Cement Co., Inc.*, 257 N.E.2d 870, 872 (N.Y. Ct. App. 1970) (noting rule that injunction was traditional remedy for an ongoing nuisance); *see also* *Morgan v. High Penn Oil Co.*, 77 S.E.2d 682 (N.C. 1953) (remedy for nuisance was permanent injunction). Nevertheless, some judicial decisions have awarded damages in lieu of a permanent injunction thereby allowing the unwanted condition to continue subject to payment for such conduct. *See, e.g., Boomer*, 257 N.E.2d at 873 (overruling the traditional remedy and allowing the party creating the nuisance to continue the activity upon payment of monetary damages for present and future nuisance).

<sup>272</sup> In light of *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 171–73 (1995), almost anything that is source-indicating can be registered as a trademark today. This includes music and other sounds that have been registered as trademarks under federal law. *See, e.g., THE SOUND OF THE FAMOUS TARZAN YELL*, Registration No. 2,210,506; *see also* *Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, 75 U.S.P.Q.2d 1269, 1274 (E.D. Pa. 2005) (noting sound can be a trademark); Melissa E. Roth, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 469 (2005) (sound trademarks registerable in the United States). *See generally* Rita Heimes, *Trademarks, Identity, and Justice*, 11 J. MARSHALL REV. INTELL. PROP. L. 133, 137 (2011) (colors, sounds, smells, and product packaging can be trademarks).

<sup>273</sup> *Midler*, 849 F.2d at 463.

<sup>274</sup> *Id.* at 463–464.

<sup>275</sup> *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096 (9th Cir. 1992).

<sup>276</sup> *Id.* at 1097.

<sup>277</sup> *Id.* at 1111.

<sup>278</sup> *Id.* at 1096.

the court rejected any requirement that Mr. Waits be in competition with regard to the sale of Doritos.<sup>279</sup> Instead, the court styled the claim as a false endorsement claim<sup>280</sup> and upheld the jury's finding that in light of all the circumstances "consumers were likely to be misled by the commercial into believing that [Mr.] Waits endorsed SalsaRio Doritos."<sup>281</sup> Interestingly, the court found some of the damages awarded for the right of publicity action and the unfair competition claim to be duplicative, so a portion of the damages were vacated.<sup>282</sup>

In *Allen v. National Video, Inc.*,<sup>283</sup> the defendant, a person who looked like the well-known filmmaker and actor Woody Allen, was used in advertisements to take advantage of his resemblance to Mr. Allen.<sup>284</sup> Mr. Allen brought an action asserting unfair competition and violation of his right to publicity.<sup>285</sup> The court declined to resolve the right of publicity action because it concluded that the dispute could be resolved under unfair competition law.<sup>286</sup> The court held that an unfair competition action available under federal law<sup>287</sup> should be broadly construed to protect consumers from misrepresentations about products and services made available in commerce.<sup>288</sup> Additionally, the unfair competition action should cover unfair competitive practices that cause actual or potential consumer deception.<sup>289</sup> The court enjoined use of defendant's image in the advertisements at issue after finding a violation of the federal unfair competition statute.<sup>290</sup> The court's holding rested on a finding that the advertisements

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<sup>279</sup> *Id.* at 1110.

<sup>280</sup> *Id.* at 1106–11.

<sup>281</sup> *Id.* at 1111.

<sup>282</sup> *Id.* at 1112. Nevertheless, the court upheld an award of \$2.6 million that was comprised of compensatory damages, punitive damages, and attorney fees. *Id.* at 1096.

<sup>283</sup> 610 F. Supp. 612 (S.D.N.Y. 1985).

<sup>284</sup> *Id.* at 618.

<sup>285</sup> *Id.* at 617, 632.

<sup>286</sup> *Id.* at 625. It should be noted that a right to publicity action in the relevant jurisdiction in this case—New York—was constrained by statute such that it was more narrowly applied than in other jurisdictions. *Id.* at 624 n.5.

<sup>287</sup> *Id.*; 15 U.S.C. § 1125(a) (2006).

<sup>288</sup> *Allen*, 610 F. Supp. at 625.

<sup>289</sup> *Id.*

<sup>290</sup> *Id.* at 630.

would be likely to confuse consumers into believing that Mr. Allen was either appearing in the advertisements or that he endorsed or approved of the advertisement with defendant's image.<sup>291</sup> The court noted that it was relying on the well-established likelihood of confusion analysis utilized in federal trademark infringement actions<sup>292</sup> because this analysis is "the heart of a successful claim"<sup>293</sup> under both federal and state trademark infringement actions and even under state unfair competition law actions.<sup>294</sup>

In *Wendt v. Host International, Inc.*,<sup>295</sup> the owner of the intellectual property rights to the television show *Cheers*

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<sup>291</sup> *Id.* at 628–30.

<sup>292</sup> This analysis requires the court to consider the following factors in deciding if a likelihood of confusion exists:

- 1) the strength of plaintiff's marks and name;
- 2) the similarity of plaintiff's and defendant's marks;
- 3) the proximity of plaintiff's and defendant's products;
- 4) evidence of actual confusion as to source or sponsorship;
- 5) sophistication of the defendant's audience; and
- 6) defendant's good or bad faith.

*Id.* at 627 (applying the above factors, the court substituted the likenesses of defendant and Mr. Allen for the references to marks in the factors). Most courts apply the same or similar factors in analyzing likelihood of confusion. *See, e.g.,* AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir. 1979) (factors considered in determining likelihood of confusion in trademark infringement action: strength of the mark; proximity of the goods; similarity of the marks; evidence of actual confusion; marketing channels used; type of goods and the degree of care likely to be exercised by the purchaser; defendant's intent in selecting the mark; and likelihood of expansion of the product lines); *Naked Cowboy v. CBS*, 2012 U.S. Dist. LEXIS 23211, at \*15 (S.D.N.Y. Feb. 23, 2012) (factors considered in federal trademark infringement action and federal unfair competition action: the strength of plaintiff's mark; the similarity of the parties' marks; the proximity of the parties' products in the marketplace; the likelihood that the prior user will bridge the gap between the products; actual confusion; the defendant's good or bad faith in adopting the mark; the quality of defendant's product; and the sophistication of the relevant consumer group); *see also* *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983).

<sup>293</sup> *Allen*, 610 F. Supp. at 627 (quoting *Standard & Poor's Corp. v. Commodity Exchange, Inc.*, 683 F.2d 704, 708 (2d Cir. 1982)).

<sup>294</sup> *See id.*; *accord* *Food Scis. Corp. v. Nagler*, No. 09-1798, 2010 U.S. Dist. LEXIS 112072, at \*5 (D.N.J. 2010). *See generally* *Summit Entertainment, LLC v. B.B. Dakota Inc.*, 2011 U.S. Dist. LEXIS 151582, at \*20 (C.D. Cal. 2011) (noting the same likelihood of confusion test applies to federal and state trademark infringement and unfair competition actions).

<sup>295</sup> 125 F.3d 806 (9th Cir. 1997).

authorized the creation of airport bars that resembled the bar in the television show.<sup>296</sup> Additionally, animatronic robotic figures that resembled Norm and Cliff, two characters on the show, were placed in the bars,<sup>297</sup> although the figures were called Bob and Hank.<sup>298</sup> George Wendt and John Ratzenberger were the actors who played the Norm and Cliff characters in the television show.<sup>299</sup> They brought an action arguing that the use of the Bob and Hank robots in the bars violated their rights of publicity and their federal unfair competition rights<sup>300</sup> despite the fact that the facial features of the robots were totally different than the facial features of Mr. Wendt and Mr. Ratzenberger.<sup>301</sup> The appellate court reversed the trial court's dismissal of the action on a motion for summary judgment.<sup>302</sup> The appellate court held that the right of publicity action involved factual questions that a jury must decide.<sup>303</sup> Additionally, the appellate court, consistent with the decisions discussed above, held that the federal unfair competition action was a false endorsement claim<sup>304</sup> that should be analyzed under the traditional test for likelihood of confusion<sup>305</sup> to determine if consumers would believe, based on the robotic figures in the bars, that Mr. Wendt and Mr. Ratzenberger endorsed the airport bars based on the *Cheers* television show.<sup>306</sup>

In light of the above discussion, it is clear that a person should have a legal cause of action when his or her persona is used commercially to create a confusion-based relationship between a

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<sup>296</sup> *Id.* at 809.

<sup>297</sup> *Id.*

<sup>298</sup> *Id.* at 811.

<sup>299</sup> *Id.*

<sup>300</sup> *Id.* at 809.

<sup>301</sup> *See id.* (finding no similarity between the robots and Mr. Wendt and Mr. Ratzenberger and noting they had totally different facial features).

<sup>302</sup> *Id.* The case was subsequently settled and it is presumed Mr. Wendt and Mr. Ratzenberger were compensated in return for ending the litigation. *See* ERIC FREYFOGLE & BRADLEY KARKKAINEN, PROPERTY LAW: POWER, GOVERNANCE, AND THE COMMON GOOD 426 (2012).

<sup>303</sup> *Wendt*, 125 F.3d at 810–12.

<sup>304</sup> *Id.* at 812.

<sup>305</sup> *Id.*

<sup>306</sup> *See id.* at 812–13 (“The issue is whether a consumer would be confused as to Wendt and Ratzenberger’s association with or sponsorship of [the airport] bars.”).

good or service and the person. However, a cause of action should not typically be available if only an association-based commercial relationship is created. This negates the need for the right of publicity cause of action in many contexts because an unauthorized confusion-based relationship is already actionable under an unfair competition or trademark infringement action.

Additionally, commercial speech likely to confuse or mislead consumers is not typically entitled to First Amendment protection.<sup>307</sup> Therefore, limiting the right of publicity to confusion-based relationships greatly minimizes the need for courts to resolve the difficult conflicts between the right of publicity, which usually involves commercial speech, and the First Amendment.

Nevertheless, a right of publicity action may be viable in the limited context when a famous persona is involved.

## V. RIGHT OF PUBLICITY AND TRADEMARK DILUTION

Dilution law provides an exception to the distinction between commercial conduct that creates a confusion-based relationship<sup>308</sup> and commercial conduct that merely creates an association-based relationship.<sup>309</sup> It allows a cause of action for trademark dilution in situations where an infringement action is not viable.<sup>310</sup> Dilution

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<sup>307</sup> *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001).

<sup>308</sup> A trademark infringement action represents a confusion-based relationship. *See* 15 U.S.C. § 1114(1)(2006) (providing for trademark infringement action under federal trademark law based on certain conduct that “is likely to cause confusion, or to cause mistake, or to deceive”).

<sup>309</sup> *See id.* § 1125(c) (providing a federal cause of action for trademark dilution); *see also* 54 PA. CONSOL. STAT. § 1124 (2012) (providing a state statutory cause of action for trademark dilution under Pennsylvania law). Some states recognize a common law dilution action. *See, e.g., Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 424 (6th Cir. 1999) (“Ohio courts recognize a common law cause of action for dilution.”).

<sup>310</sup> In contrast to trademark infringement actions, trademark dilution actions do not require any consumer confusion. *See* 15 U.S.C. § 1125 (c)(1) (stating no actual or likelihood of confusion necessary for dilution under federal law). In *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 167 (4th Cir. 2012), the court noted that the purpose of trademark infringement law is to prevent consumer confusion but this is not the premise for dilution actions. *See also PPG Indus., Inc. v. Clinical Data, Inc.*, 620 F. Supp. 604, 606–07 (D. Mass. 1985) (finding consumer confusion not necessary for dilution under Massachusetts state dilution law). *See generally* I.P. Lund Trading ApS v. Kohler Co.,



actions are based on the existence of an unauthorized association-based commercial relationship.<sup>311</sup> Arguably, a dilution action recognize a property right in a trademark per se, in contrast to trademark infringement law which typically only recognizes a property right in the mental association created in the minds of the intended consumers when they see a trademark affixed to a product.<sup>312</sup> The broad range of protection provided by dilution is mitigated by a requirement that such a cause of action is only available for a limited number of trademarks<sup>313</sup>—only famous

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163 F.3d 27, 48–49 (1st Cir. 1998) (describing how dilution can occur absent any consumer confusion and even if non-competing goods are involved).

<sup>311</sup> See generally 15 U.S.C. § 1125(c)(1), which states:

[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, *regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.* *Id.* (emphasis added).

<sup>312</sup> See generally Matthew Slowik, *Ahead of the Curve? The Effect of the Trademark Dilution Revision Act of 2006 on the Federal Circuit*, 18 FED. CIR. B.J. 349, 362 (2008) (describing how many commentators concerned about dilution right becoming a per se property right in trademark).

<sup>313</sup> In *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 169–70 (Cal. Ct. App. 2010) (quoting *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999)), the court stated:

[D]ilution is a cause of action invented and reserved for a select class of marks—those marks with such powerful consumer associations that even non-competing uses can impinge on their value. Dilution causes of action, much more so than infringement and unfair competition laws, tread very close to granting “rights in gross” in a trademark. In the infringement and unfair competition scenario, where the less famous a trademark, the less the chance that consumers will be confused as to origin, a carefully-crafted balance exists between protecting a trademark and permitting non-infringing uses. In the dilution context, likelihood of confusion is irrelevant. If dilution protection were accorded to trademarks based only on a showing of inherent or acquired distinctiveness, we would upset the balance in favor of over-protecting trademarks, at the expense of potential non-infringing uses.

We view the famousness prong of both dilution analyses [i.e., under federal law and California law] as reinstating the balance—by carefully limiting the class of trademarks eligible for dilution protection, Congress and state legislatures granted the most potent

trademarks are entitled to dilution protection.<sup>314</sup> “Famous” trademarks are, quite simply, marks that are widely known by the general public.<sup>315</sup> Additionally, the traditional remedy permitted is injunctive relief<sup>316</sup>—in contrast to trademark infringement law, which allows both monetary damages and injunctive relief.<sup>317</sup> This dilution action can be viewed as an attempt to protect the trademark owner’s investment in his or her mark, when the investment has resulted in the trademark becoming very strong and widely known to consumers.<sup>318</sup>

By analogy, the analysis that justifies a trademark dilution action should apply to a right of publicity action. Only celebrities who have become famous (in the trademark law sense that they are widely known by the general consuming public) should be able to assert a right of publicity action based on showing an unauthorized association-based commercial transaction.<sup>319</sup> A lesser-known

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form of trademark protection in a manner designed to minimize undue impact on other uses.

Therefore, to meet the “famousness” element of protection under the dilution statutes, “a mark [must] be truly prominent and renowned.”

*Id.*

<sup>314</sup> See 15 U.S.C. § 1125(c)(1) (2006); see also *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012) (noting that whether a trademark is famous is a threshold question for purposes of a federal dilution action).

<sup>315</sup> See 15 U.S.C. § 1125(c)(2)(A) (“A mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”).

<sup>316</sup> See *Greater Lansing Ass’n of Realtors v. Mentzer-Amundson*, No. 210504, 2000 Mich. App. LEXIS 1236, at \*18 (Mich. Ct. App. 2000); see also 15 U.S.C. § 1125(c)(1) (stating the remedy for dilution under federal law is injunctive relief).

<sup>317</sup> See *id.* §§ 1114, 1116 (permitting damages for trademark infringement and allowing injunctive relief for trademark infringement).

<sup>318</sup> Christopher R. Perry, *Trademarks as Commodities: The “Famous” Roadblock to Applying Trademark Dilution Law in Cyberspace*, 32 CONN. L. REV. 1127, 1130–31 (2000) (noting that the purpose of trademark infringement action is to protect consumers from being confused but purpose of trademark dilution action is to protect investment of trademark owner in famous trademark).

<sup>319</sup> Disagreement exists with regard to whether a right of publicity action is available to everyone or only to celebrities. The leading commentator on the right to publicity believes all people should have the right. See MCCARTHY, *supra* note 1, § 4:3 at 205–06. However, not all commentators agree. See *id.* §§ 4:14–16 at 219–26. Likewise, judicial decisions are also split. See *Curran v. Amazon.com, Inc.*, No. 2:07-0354, 2008 U.S. Dist. LEXIS 12479, at \*14–15 (S.D.W.Va. 2008). Compare, e.g., *Donchez v. Coors Brewing*

celebrity would be limited to asserting a trademark infringement or unfair competition action based on an unauthorized confusion-based commercial transaction. This would enable a celebrity who has invested sufficient time, energy, and money to become widely known to the general public to protect that investment.

## VI. PROPOSED FRAMEWORK FOR THE RIGHT OF PUBLICITY

Courts generally disagree on the *prima facie* elements of a common law right of publicity action.<sup>320</sup> However, the leading commentator states the following elements:

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Co., 392 F.3d 1211, 1220 (10th Cir. 2004) (indicating right of publicity action not available to a non-celebrity), *with* *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d, 713, 717 (Cal. Ct. App. 2000) (indicating California right of publicity statute not limited to celebrities).

<sup>320</sup> *See, e.g.*, *Abdul-Jabbar v. Gen. Motors Corp.*, 75 F.3d 1391, 1398 (9th Cir. 1996) (stating that under California law, *prima facie* elements are “(1) the defendant’s use of plaintiff’s identity; (2) the appropriation of plaintiff’s . . . [identity] to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury”); *Blair v. Nev. Landing P’ship*, 859 N.E.2d 1188, 1191–92 (Ill. App. Ct. 2006) (stating that under Illinois law, a plaintiff must show “an appropriation of one’s name or likeness, without one’s consent, for another’s commercial benefit”); *Brasel v. The Hair Co.*, 976 So. 2d 390, 392 (Miss. Ct. App. 2008) (stating that under Mississippi law, “a plaintiff must show that the defendant: (1) appropriated his name or likeness, (2) without consent, (3) for use in a commercial enterprise”); *Arnold v. Treadwell*, No. 283093, 2009 WL 2136909, at \*4 (Ct. App. Mich. 2009) (stating that under Michigan law, “a plaintiff must prove (1) that she has a pecuniary interest or significant commercial value in her identity, and (2) that the defendants engaged in commercial exploitation of her identity”); *Brill v. Walt Disney Co.*, 246 P.3d 1099, 1102 (Okla. Civ. App. 2010) (stating that under Oklahoma law, which adopted the Restatement (Second) of Torts definition, “[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy”); *Henley v. Dillard Dept. Stores*, 46 F. Supp. 2d 587, 590 (N.D. Tex. 1999) (stating that under Texas law, *prima facie* elements are “(1) the defendant appropriated the plaintiff’s name or likeness for the value associated with it, and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) there was some advantage or benefit to the defendant”). Likewise, the *prima facie* elements of a statutory right of publicity action also vary. *See, e.g.*, *Blair*, 859 N.E.2d at 1192 (Ill. App. Ct. 2006) (applying the Illinois statute which states: “[a] person may not use an individual’s identity for commercial purposes during the individual’s lifetime without having obtained previous written consent from the appropriate person or persons”); *Molina v. Phoenix Sound Inc.*, 747 N.Y.S.2d 227, 230 (App. Div. 2002) (stating that under New York’s statute, a plaintiff must show “(i) usage of plaintiff’s name, portrait, picture, or voice, (ii) with the state of New York, (iii) for purposes of advertising or trade, (iv) without plaintiff’s written consent”); *Brill*, 246 P.3d at 1103 (stating that under Oklahoma’s statute a plaintiff must

- (1) *Validity* Plaintiff owns an enforceable right in the identity or persona of a human being; and
- (2) *Infringement* (A) Defendant, without permission, has used some aspect of identity or persona in such a way that plaintiff is identifiable from defendant's use; and (B) Defendant's use is likely to cause damage to the commercial value of that persona.<sup>321</sup>

Typically, the third element above is presumed when some identifiable aspect of a person's persona is used in a commercial context without permission.<sup>322</sup> Usually, the traditional remedy of injunctive relief has been available.<sup>323</sup> Recovery of damages generally requires proof of appropriate commercial injury.<sup>324</sup>

Generally, when the name or likeness of a celebrity is used without permission with regard to the sale of a product or service an unfair competition claim can also be brought.<sup>325</sup> Under federal

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establish "(1) Defendants knowingly used [plaintiff's] name or likeness, (2) on products, merchandise or goods, (3) without [plaintiff's] prior consent").

<sup>321</sup> MCCARTHY, *supra* note 1 § 3:2, at 120–21.

<sup>322</sup> *Id.* § 3:2, at 122.

<sup>323</sup> *Id.*

<sup>324</sup> *Id.* § 3:2, at 122–23. Typically, appropriate damages for a right of publicity action are commercial in nature. For example, such damages could include the typical rate paid to a particular celebrity for use of his or her image in an advertisement, lost licensing opportunities, or the profits earned by an infringer. *See generally id.* §§ 11:30–11:35 at 751–73 (detailed discussion of damages). Nevertheless, in *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1103 (9th Cir. 1992), the court noted that in an appropriate case, in addition to commercial damages, mental distress damages as a result of causing humiliation or embarrassment are recoverable. And, punitive damages may also be awarded. *Id.* at 1104–06.

<sup>325</sup> Just as disagreement exists with regard to whether a right of publicity action is limited to celebrities, the same issue arises with regard to whether a false endorsement claim under 15 U.S.C. § 1125(a)(1)(A) is limited to celebrities. *See, e.g.*, *Uhlig LLC v. Shirley*, 2011 U.S. Dist. LEXIS 31833, at \*19 (D. S.C. 2011) (false endorsement action only available to celebrity). *But see* *Arnold v. Treadwell*, 642 F. Supp. 2d 723, 735 (E.D. Mich. 2009) (celebrity status not a requirement for false endorsement action). A trademark infringement action may also be available if the celebrity has registered their name or other characteristic as a trademark or service mark. The elements of a trademark infringement action are: (1) plaintiff must show ownership of the mark; and (2) consumer confusion is likely to result from defendant's use of the mark. *Rearden LLC v. Rearden Commerce Inc.*, 103 U.S.P.Q.2d 1161, 1168–69 (9th Cir. 2012).

law such claims are typically referred to as false endorsement actions<sup>326</sup> and require the plaintiff to establish:

- (1) its mark is legally protectable;
- (2) it owns the mark;
- (3) the defendant's use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff's sponsorship or approval of those goods or services.<sup>327</sup>

Additionally, the mark must be used in interstate commerce<sup>328</sup> for the above action, although analogous state-based actions are available when purely intrastate commerce is involved.<sup>329</sup>

Based on the statute<sup>330</sup> and its judicial interpretation, the word *mark* is broadly construed to include "any word, term, name, symbol, or device, or any combination thereof."<sup>331</sup> This includes both registered and unregistered marks as well as the use of a person's name, likeness, or any other indicia that identifies the person.<sup>332</sup> Often, any unauthorized reference to a celebrity in a commercial context will trigger a successful false endorsement claim because such use will generally make it likely that consumers believe the celebrity endorses or approves of the product or service and therefore a confusion-based association will exist.<sup>333</sup> Of course, relying on a false endorsement action eliminates the small number of disputes where only an associational connection is made by consumers between the

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<sup>326</sup> 15 U.S.C. § 1125(a)(1)(A) (2006).

<sup>327</sup> *Facenda v. Nat'l Football League*, 542 F.3d 1007, 1014 (3d Cir. 2008).

<sup>328</sup> *Uhlig LLC v. Shirley*, 2011 U.S. Dist. LEXIS 31833, at \*19 (D. S.C. 2011).

<sup>329</sup> *See, e.g., Hubbs Mach. & Mfg. v. Brunson Instrument Co.*, 635 F. Supp. 2d 1016, 1019 (E.D. Mo. 2009) (stating that under Missouri law: "[u]nfair competition is a species of commercial hitchhiking which the law finds offensive, and, therefore, prohibits. The law of unfair competition is but a reaffirmation of the rules of fair play. It aims to effect honesty among competitors by outlawing all attempts to trade on another's reputation—it gives the crop to the sower and not to the trespasser. In so doing it strives to protect the buying public from deception").

<sup>330</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>331</sup> 15 U.S.C. § 1125(a)(1).

<sup>332</sup> *Facenda*, 542 F.3d at 1014; *see also Amazon, Inc. v. Cannondale Inc.*, No. 99 N 571, 2000 U.S. Dist. LEXIS 17864, at \*18–19 (D. Colo. 2000) (noting that celebrity persona is the mark at issue in a false endorsement claim).

<sup>333</sup> *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 939 (6th Cir. 2003).

product or service and the celebrity.<sup>334</sup> Under this approach, an unfair competition action, such as a false endorsement action, can substitute for a right of publicity action whenever a confusion-based association is created by a commercial use of a person's persona.<sup>335</sup>

Commercial use of a person's persona should typically not be actionable if only an association-based connection exists between the person and the product or service he or she is associated with. This approach preserves a robust public domain where references to celebrities and others can be made freely as long as there is no likelihood of consumer marketplace confusion. This result simplifies to some extent the difficulty of distinguishing between a person's reputational interests and First Amendment free speech considerations since little justification exists for cloaking misleading and confusing commercial speech with First Amendment protection.<sup>336</sup> However, one exception to this limitation can be gleaned or borrowed from trademark dilution law.

Under dilution law,<sup>337</sup> a limited number of trademarks that are deemed famous<sup>338</sup> are granted an extra layer of protection.<sup>339</sup> This protection arises from a commercial use that creates an association-based relationship even if no confusion-based relationship exists.<sup>340</sup> To be famous, the trademark must be

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<sup>334</sup> 15 U.S.C. § 1125(a)(1)(A); *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 156 (Cal. Ct. App. 2010) (denying motion for preliminary injunction because there was insufficient information to prove false endorsement even though there was an associational connection).

<sup>335</sup> *ETW Corp.*, 332 F.3d at 924.

<sup>336</sup> *See generally* *Kasky v. Nike, Inc.*, 45 P.3d 243, 251 (Cal. 2002) (finding that misleading or deceptive speech entitled to little of any First Amendment protection).

<sup>337</sup> 15 U.S.C. § 1125(c) (federal dilution). State dilution statutes also exist. *See, e.g.*, FLA. STAT. § 495.151 (2012); OR. REV. STAT. § 647.107 (2012).

<sup>338</sup> 15 U.S.C. § 1125(c)(1).

<sup>339</sup> *See id.*

<sup>340</sup> *See* *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 170 (Cal. Ct. App. 2010) (noting that likelihood of confusion is not relevant in a dilution action). Federal law makes a dilution action available "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." 15 U.S.C. § 1125(c)(1). Dilution actions apply to a very limited class of trademarks that have such strong consumer associations that unauthorized non-competing uses by a third

“widely recognized by the general consuming public.”<sup>341</sup> If a celebrity reaches this status, a right of publicity action should be available even if commercial use of the celebrity persona only creates an association-based relationship. Arguably, this provides an extra level of legal protection for a limited number of celebrities, just as dilution law provides an extra level of protection for the limited number of trademarks that have attained an unusually high level of marketplace recognition.

Admittedly, this approach will make it virtually impossible for non-celebrities to successfully assert an action because they will be unable to satisfy the famous requirement. They will also be unlikely to demonstrate any likelihood of confusion as required by an unfair competition action.<sup>342</sup> Nevertheless, non-celebrities would still have the option of asserting a right of privacy action in appropriate cases to protect their personas from public humiliation or emotional distress.

Analogizing to unfair competition and trademark law allows courts to apply the rich body of precedent that exists in those areas of law. This will create more certainty with regard to what are protectable property interests and what should be freely available in the public domain. Finally, it will allow the right of publicity to fit within the genus of intellectual property law by applying the same balancing of competing interests that is endemic to the other species of intellectual property law.

#### CONCLUSION

The right of publicity represents the newest species of intellectual property. However, its parameters can best be described as a work in progress over the past several decades. Some judicial decisions greatly expanded the right by focusing primarily on protecting celebrities from unauthorized free riding. This has included commercial use of a person’s name, likeness, or anything that conjures up an association with the celebrity even if

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party can negatively affect the mark’s value. See *Franklin Mint Co.*, 109 Cal. Rptr. 3d at 169–70 (quoting *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999)).

<sup>341</sup> 15 U.S.C. § 1125(c)(2)(A).

<sup>342</sup> 15 U.S.C. §§ 1114(1), 1125(a)(1)(A) (2006).

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consumers would be unlikely to believe the person approved of or endorsed the product or service involved. Other judicial decisions recognized that the right must be balanced against competing concerns such as promoting competition, accommodating freedom of speech concerns, and maintaining a robust public domain comprised of things that are free for all to use. Such balancing has long been a part of the traditional bodies of intellectual property law. This well-developed balancing approach should be adopted and made applicable to the interest protected by the right of publicity by utilizing the traditional likelihood of consumer confusion standard applied in trademark and unfair competition actions. This would allow right of publicity actions when a person's persona is used in a confusion-based commercial activity but not when only an association-based commercial relationship is involved. Additionally, in light of the broad scope of modern trademark law and the broad application of unfair competition actions, virtually any confusion-based commercial activity could be redressed under trademark law and/or unfair competition law using a likelihood of confusion standard in lieu of a right of publicity action. This approach is consistent with the underlying utilitarian justification for intellectual property law, which primarily seeks to enlarge the public domain by incentivizing innovators and creators by providing limited property rights for a variety of creative products. By analogy to the rights granted to famous trademarks pursuant to dilution theory, additional protection for association-based commercial use of a person's persona should be limited to famous individuals who are widely known by the general public.