

**FEET OF CLAY: HOW THE RIGHT OF PUBLICITY EXCEPTION UNDERMINES
COPYRIGHT ACT PREEMPTION**

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Prior to 1978, a dual state and federal system dating back to 1790 governed copyright law in the United States.¹ In an effort to unify copyright law and create a system

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¹ H.R. REP. NO. 94-1476, at 129-33 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5744-49.

compatible with the rest of the world, Congress passed the Copyright Act of 1976² ("Act"). One of the bedrock principles³ of the Act was a provision⁴ that specifically preempted state law copyright actions.

On the West Coast, far from the halls of Congress, an unwanted exception to this preemption provision has slowly developed: the right of publicity. Initially a common law cause of action, it subsequently drew the attention of various state legislatures, which enacted right of publicity statutes. The right of publicity has particularly flowered in California, with constant care and affection from the Ninth Circuit, the so-called "Court of the Stars."⁵ Over time this right has expanded, both geographically and in conceptual scope, with effects felt far beyond California and the Ninth Circuit.

The right of publicity has a role to play in the legal system, independent of that of copyright, and in most circumstances operates in a way that does not conflict with the Act; in certain areas, however, the rights do overlap. Recently, in these areas, some courts have construed the right of publicity to avoid or trump the Act's preemption provision, in effect creating an exception to preemption. This exception limits the ability of copyright holders to fully exploit their copyrights.

The exception has become problematic as a small number of celebrities have invoked the right of publicity to prevent owners of copyrights from effectively licensing these copyrights. If left unchecked, this trend will lead to a multiplicity of rules in an area of the law intended to be uniform, discourage investment in intellectual property due to uncertain legal risks, and chip away at the public domain. The victims of the trend include copyright owners, the general public, and the legislative goals of the Act.

² 17 U.S.C. §§ 101-702 (2002). The Act took effect on January 1, 1978.

³ H.R. REP. NO. 94-1476, *supra* note 1, at 129-33.

⁴ 17 U.S.C. § 301(a).

⁵ Felix H. Kent, *Reviewing 1997: Tobacco Settlement*, N.Y.L.J., Dec.19, 1997, at 3.

Section I of this article outlines the legislative purpose behind preemption and sets forth cases where the Act preempted the right of publicity. Section II analyzes the development and expansion of the right of publicity and its emerging effect and ensuing tension with copyright law. Finally, Section III examines the injuries resulting from the expansion of the right of publicity and considers possible remedies.

I. THE COPYRIGHT ACT OF 1976: UNIFYING A DUAL SYSTEM THROUGH PREEMPTION

In 1976, Congress passed the Copyright Act, creating a unified federal copyright system. The Copyright⁶ and Supremacy⁷ Clauses of the United States Constitution provide the authority for the exclusive federal regulation of copyrights. Pursuant to the constitutional grant of power and its own language, the Act was meant to and in fact does regulate all copyright law in the United States.

According to the Act, an author's original expression is protected by copyright when it is fixed in any tangible medium.⁸ Upon fixation, the author owns certain exclusive rights in the expression. After expiration of a finite copyright term, the work enters the public domain. Thus, the Act seeks to provide a balance between the interests of society and the interests of authors.⁹ Fully to achieve this intended balance requires uniformity in the application of copyright law. One of the ways in which Congress sought to achieve this uniformity was through the development of the Act, which preempted state copyright actions. Sections 102, 103, 106, and 301 of the Act provide the framework for statutory preemption.

A. Statutory Preemption under Section 301(a)

⁶ “The Congress shall have power to . . . promote the progress of science and the useful arts, by securing for limited times to authors . . . the exclusive right to their . . . writings . . .” U.S. CONST., art I, § 8, cls. 1, 8.

⁷ “This Constitution, and the laws of the United States which shall be made in Pursuance thereof . . . shall be the Supreme Law of the land . . .” U.S. CONST., art. VI, cl. 2.

⁸ 17 U.S.C. § 102(a).

⁹ See Aaron A. Bartz, . . . *And Where it Stops, Nobody Knows: California’s Expansive Publicity Rights Threaten the Federal Copyright System*, 27 S.W.U.L. REV. 299, 305 (1997).

The enactment of section 301(a) of the Act¹⁰ constitutes the most fundamental change to copyright law since its inception in the United States.¹¹ This provision largely preempts state common law copyright claims, as the Act protects original works of authorship from the moment of creation.¹² Congress created this section for the principal purpose of eliminating the dual system of state and federal law and replacing it with a unified federal system.¹³ Under section 301(a), there are two necessary conditions for preemption of a state statute or common law cause of action: (1) the work of authorship in question is fixed in a tangible medium of expression and falls within the subject matter of copyright and (2) the state law in question embodies rights that are equivalent to any of the exclusive rights within the general scope of copyright.¹⁴ In other words, section 301(a) preempts the operation of any state law that addresses the subject matter of copyright and presents rights equivalent to those provided by the Act.¹⁵

¹⁰ 17 U.S.C. § 301(a).

¹¹ David E. Shipley, *Publicity Never Dies; It just Fades Away: the Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 701 (1981).

¹² That is, creation by fixation in a tangible medium of expression. “[S]tate common law copyright might play a role when a work is not fixed in a tangible medium of expression. Examples would include an oral interview or jazz improvisation.” MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 41 (3d. ed. 1999).

¹³ See Scott L. Whiteleather, *Rebels With a Cause: Artists' Struggles to Escape a Place Where Everyone Owns Your Name*, 21 LOY. L.A. ENT. L. REV. 253, 268 (2001).

¹⁴ 17 U.S.C. § 301(a) provides:

Preemption with respect to other laws: a) On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

¹⁵ “The two level test of § 301(a) might be viewed as presenting ‘two doors’: (1) nonequivalency to copyright and (2) subject matter different from that of copyright. If a given state right can pass through either of these doors, it will survive federal preemption. If it can pass through neither of the doors, it will be federally preempted by copyright law.” J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 11:46 (2d ed., updated 2003).

Sections 102¹⁶ and 103¹⁷ of the Act outline the requirements of the subject matter of copyright: The work in question must be original, one of the types of works of authorship enumerated in these sections, and fixed in a tangible medium of expression. If this first prong is satisfied, the work falls within the subject matter of copyright and section 301(a) potentially will apply; the next step is to examine whether the state law provides equivalent rights.

To decide whether state rights are equivalent to those provided by the Act necessitates a review of section 106.¹⁸ Section 301(a) provides simply that preemption will occur if the state cause of action addresses legal or equitable rights equivalent to those listed in the Act under section 106. For example, if a state statute were to allow an author to license the production of derivative works based on his original literary work, but for longer

¹⁶ 17 U.S.C. § 102 provides:

Subject matter of copyright: In general: (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: 1) literary works; 2) musical works, including any accompanying words; 3) dramatic works, including any accompanying music; 4) pantomimes and choreographic works; 5) pictorial, graphic and sculptural works; 6) motion picture and other audiovisual works; 7) sound recordings and 8) architectural works.

¹⁷ 17 U.S.C. § 103 provides:

Subject matter of copyright: Compilations and derivative works: (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

¹⁸ 17 U.S.C. § 106 provides:

Exclusive rights and copyrighted works: Subject to section 107 through 120 [sic], the owner of a copyright under this title has the exclusive rights to do and to authorize any of the following: 1) to reproduce the copyrighted work in copies or phonorecords; 2) to prepare derivative works based upon the copyrighted work; 3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease or lending; 4) in the case of literary, musical, dramatic and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; 5) in the case of literary, musical, dramatic, and choreographic works, pantomimes and pictorial, graphic or sculptural works including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and 6) in the case of sound recordings to perform the copyrighted work publicly by means of a digital audio transmission.

than the copyright term authorized in Title 17, section 301(a) would preempt it. The hypothetical statute would protect works of authorship included in sections 102 and 103, and the right to prepare derivative works would clearly be equivalent to the same right enumerated in section 106. By contrast, suppose a state statute were to provide trade secret protection against the unauthorized reproduction of works such as databases or recipes. Section 301(a) would have nothing to say about it, as this protection is not within the subject matter of copyright as specified by sections 102 and 103, even though the protection offered by the statute is equivalent to the section 106 right of reproduction.

The Act also directly expresses the proposition that state rights different from those enumerated in section 106 will not be subject to preemption.¹⁹ A question of statutory interpretation arises when some of the rights provided by a state law are equivalent to those in the Act, but the state law also contains additional protections. These additional rights are sometimes referred to as “extra elements.”²⁰ This Article returns to a discussion of extra elements below, after first outlining the operation of section 301(a) on state rights of publicity.

B. Conflict Preemption under the Supremacy Clause

In addition to section 301(a) express statutory preemption, there is a mechanism contained in the Supremacy Clause for preemption of state rights of publicity implicitly in

¹⁹ 17 U.S.C. § 301(b) provides, in pertinent part:

Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to - (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or . . . (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106[.]

²⁰ “[I]f under state law the act of reproduction, performance, distribution, or display, no matter whether the law includes all such acts or only some, will in itself infringe the state-created right, then such right is pre-empted. But if qualitatively other elements are required, instead of, or in addition to, the acts of reproduction, performance, distribution, or display, in order to constitute a state-created cause of action, then the right does not lie “within the general scope of copyright,” and there is no pre-emption. Thus, the ‘extra element’ test generally furnishes the touchstone here.” MELVILLE NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 1.01[B][1] (rev. ed. 1986, updated 2003).

conflict with the Act. This mechanism can operate in two ways.²¹ In one, known as “exclusion,” or “occupation of the field” preemption, a provision of the Constitution or a piece of federal legislation is read to leave no room for state legislation on that subject matter.²² While one might read in the sweeping language of the Act, or even that of the Copyright Clause, an intent to occupy the entire field, this interpretation is very broad and probably does not fairly apply to the regulation of authors and writings, given the history of copyright law in the United States.²³ The very fact that there is an express statutory preemption test that state laws must pass, as discussed above, seems to rule out exclusion preemption.

The second way, and the one more relevant for present purposes, is generally known as “conflict preemption,” according to which Congress’s action in a particular area implicitly may not coexist with state regulation.²⁴ The two regulations are in conflict, even in the absence of specific statutory language on the matter, where the two cannot be fairly reconciled, and the state regulation yields to the federal pursuant to the Supremacy Clause. It is this theory that applies to the areas of overlap between the right of publicity and the Act. Even where the Act may leave the matter unclear on its face, this application of the Supremacy Clause can void conflicting applications of state rights of publicity.

As the discussion below suggests, it is more desirable from a policy standpoint for courts to read the Act expressly to preempt the problematic applications of the right of publicity than for the courts to rely on implied conflict preemption. This is so because of the greater weight that federal courts generally accord to the principle of *stare decisis* when

²¹ See, e.g., *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 540-545 (2001) (discussing express preemption and the two types of implied preemption).

²² See, e.g., *Fidelity Fed. Sav. & Loan Assn. v. De la Cuesta*, 458 U.S. 141, 153 (1982).

²³ See, e.g., *Goldstein v. California*, 412 U.S. 546 (1973) (construing a state anti-recording piracy statute and holding that Congress has not extinguished all State power to regulate authors and their writings). Though *Goldstein* was decided before the Act took effect, there is no reason to doubt that Congress saw some room for concurrent state regulation, even while it greatly narrowed state power with section 301(a) of the Act.

²⁴ See, e.g., *Geier v. American Honda Motor Co.*, 529 U.S. 861, 869-874 (2000).

construing statutes, as opposed to constitutional provisions. A uniform rule of construction of the Act could thus emerge without the risk of courts later reversing an unpopular constitutional decision. This rule would also more fully accord with the apparent intent of the drafters of section 301(a). It is doubtful that the drafters would have included the section if they intended it to have only a half-hearted scope, leaving the courts to apply conflict preemption only in borderline cases. Nevertheless, conflict analysis remains an alternate theoretical basis for preemption and is discussed below where appropriate.

C. Preemption in Action: Preempting the Right of Publicity

Several courts have preempted right of publicity claims by applying section 301(a) analysis. An early landmark case²⁵ applying section 301(a) preemption to the right of publicity was *Baltimore Orioles, Inc., v. Major League Baseball Players Association*,²⁶ involving a dispute over ownership rights of the broadcasts of baseball players' performances during games.²⁷ For decades, the players and team owners had negotiated over the allocation of revenue stemming from these performances, with the players contending that they were entitled to a share.²⁸ The players argued that telecasts of their performances had been made without their consent and that the owners had misappropriated the players' property rights by broadcasting the games.²⁹ The owners repeatedly disagreed with this position and eventually filed a declaratory judgment action seeking an order stating that they

²⁵ So described in *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911 (1996).

²⁶ 805 F.2d 663 (7th Cir. 1986).

²⁷ *Id.* at 665.

²⁸ *Id.*

²⁹ *Id.* at 666. The only "property rights" the players specifically asserted were their rights of publicity. *Id.* at 667 n.2. The players' claim that the telecasts were made without consent was later held not to be a genuine issue of material fact, with the court finding that the telecasts were made within the scope of the players' employment by the team owners, and that the players were well aware that the television revenues were factors accounted for in the players' salaries. *Id.* at 670.

possessed the exclusive right to broadcast the games and that they owned the exclusive rights to the telecasts.³⁰ The players filed a separate suit that included a right of publicity count.³¹ The two suits were consolidated.

The district court found that the disputed telecasts were copyrightable works, and the Seventh Circuit agreed.³² According to the court, the telecasts were works fixed in a tangible medium of expression, and constituted original works of authorship coming within the subject matter of copyright, pursuant to section 102(a).³³ The players contended that even if the telecasts were copyrightable, the owners had still misappropriated their rights of publicity, because their game performances per se were not fixed in a tangible form and consequently were outside the subject matter of copyright.³⁴ However, the Seventh Circuit affirmed the district court's finding that the Act preempted the players' right of publicity, finding that the players' performances were fixed in a tangible form through the simultaneous recording of the televised broadcast.³⁵

The court reasoned that through the medium of a video recording, live performances can be "perceived, reproduced or otherwise communicated for a period of more than transitory duration."³⁶ Though unrecorded performances, such as extemporaneous speech or

³⁰ *Id.* at 665. The owners alleged that they, as the employers, owned the performances as copyrightable works made for hire by the employee players. *Id.* at 667.

³¹ *Id.* at 665.

³² *Id.* at 668.

³³ *Id.* Professor Nimmer, in critiquing *Baltimore Orioles*, argues that game performances are not protectible works of authorship. 1 NIMMER, *supra* note 21, at § 2.09[F]; *contra* 805 F.2d at 669 n.7 (the telecasts of the games, including the creative contributions of producers, directors, and camerapersons, as well as the players' performances, were the works of authorship for copyright purposes).

³⁴ *Baltimore Orioles*, 805 F.2d at 674.

³⁵ *Id.* at 675.

³⁶ *Id.* (discussing 17 U.S.C. § 101, the Act's fixation provision).

unfilmed choreography,³⁷ are not fixed and are therefore not copyrightable, recording a broadcast of a performance fixes it for purposes of the Act.³⁸ The court held that once the players' performances had been reduced to a tangible form through recordation on videotapes, there was no distinction between the performances and the recording of the performances for purposes of section 301(a) preemption.³⁹

Next, the court applied the equivalency prong of the section 301(a) test. The court reasoned that a right under state law is equivalent to a right within the general scope of copyright if the state right is violated by the exercise of any of the rights enumerated in section 106 of the Act.⁴⁰ The court found the players' right of publicity in their performances, which they claimed allowed them to control the broadcasts, to be equivalent to the copyright holder's right under the Act to perform an audiovisual work. Exercise of this latter right would infringe the publicity rights.⁴¹ Consequently, the two part test in Section 301 was satisfied.

The court noted that the policy of the Act is "to induce individuals to undertake . . . personal sacrifices to create [copyrighted] works" and in return to grant them "a limited monopoly to reap the rewards of their endeavors."⁴² The relevant creators here were the producers of the game telecasts, and the players were their employees. The players were hired to play baseball, and the court refused to make an artificial distinction between the player's performances per se and the performances as part of the recorded game. To have allowed the players to control the copyrighted broadcasts would have turned the policy of the

³⁷ *Id.* at 668.

³⁸ *Id.* at 676.

³⁹ *Id.* at 675.

⁴⁰ *Id.* at 676.

⁴¹ *Id.* at 677.

⁴² *Id.* at 678.

Act upside down—the court essentially asked why the owners would have broadcast the games if the players controlled the broadcasts.⁴³ Allowing the players to have taken control of these performances at the expense of the copyright owner would have limited the scope of the rights granted by the Act and contravened the strong preemptive intent of Congress. The Seventh Circuit thus acknowledged that the state right of publicity granted the players a property interest in their performances, but held that it could not trump the control of the telecasts granted to the copyright owners by federal law.⁴⁴

Eleven years later this question again arose within the Seventh Circuit, this time in connection with performances displayed in video games. In *Ahn v. Midway Manufacturing Company*,⁴⁵ the defendants videotaped images of the plaintiffs' martial arts performances to be incorporated into the successful arcade video games *Mortal Kombat* and *Mortal Kombat II*; these performances were later used in the home and hand-held versions of the games.⁴⁶ The plaintiffs had signed an agreement making the producer of the games the sole owner of "all of plaintiffs' copyrightable expression."⁴⁷ Subsequently, plaintiffs filed suit based on an alleged unauthorized use of their names, personae, and likenesses. The district court, relying on *Baltimore Orioles*, preempted this right of publicity claim. It held that the two-part section 301(a) test had been met: The plaintiffs' performances fell within the subject matter of copyright, because they were original works of choreographic authorship and fixed (by consent) on a videotape. The plaintiffs' rights of publicity were equivalent to the rights specified in the Act, because they were infringed by the distribution, performance, or

⁴³ As the court noted, "the Players have attempted to obtain ex post what they did not negotiate ex ante . . . they seek a judicial declaration that possess a right—the right to control the telecasts of major league baseball games—that they could not procure in bargaining with the Clubs." *Id.* at 679.

⁴⁴ *Id.* at 678-679.

⁴⁵ 965 F. Supp. 1134 (N.D. Ill. 1997).

⁴⁶ *Id.* at 1136.

⁴⁷ *Id.* at 1136.

preparation of derivative works, all of which the defendant game producers had done.⁴⁸ As with *Baltimore Orioles*, the court found that the right of publicity could not supplant or even coexist with the right held by the copyright owner.

Other district court cases within the Seventh Circuit have further developed the *Baltimore Orioles* preemption theory. *Villa v. Brady Publishing*⁴⁹ involved an outdoor muralist with a distinctive style; the defendant publisher reproduced one of his murals, which incorporated his pseudonym, in a book without obtaining permission. The muralist sued, alleging that the appropriation of his pseudonym was a violation of his right to publicity.⁵⁰ The court assumed that the mural was copyrightable and fixed, and applied the equivalence prong of section 301(a).⁵¹ In evaluating equivalence under section 106, the court noted:

A proper assessment of equivalence looks beyond the bare elements of the state-law cause of action to the particulars of each case. A claim escapes the preemption bar only if the rights alleged to have been violated are qualitatively different from those protected by copyright. The labels a plaintiff affixes to a defendant's activities are insignificant if the complaint does not assert rights that fall outside the scope of those listed in § 106.⁵²

The court thus asserted a vigorous and fact-sensitive view of section 301(a) preemption that focuses on the substance of state law claims rather than their form, and implicitly rejected the notion of extra elements that are not actually separable from copyrightable expression. It held that the inclusion of the artwork in the book implicated section 106 rights, and that the

⁴⁸ *Id.* at 1138.

⁴⁹ No. 02 C 570, 2002 U.S. Dist. LEXIS 11753 (N.D. Ill. June 26, 2002).

⁵⁰ The artist had also previously claimed federal copyright infringement, but the court dismissed this claim, as he had not registered with the Copyright Office; the court then dismissed all of the artist's pendent state claims for want of jurisdiction. The procedural posture in the stage of the case discussed here was a motion for leave to amend the plaintiff's complaint to allege diversity jurisdiction over his state law publicity claim. *Id.* at *1-2.

⁵¹ *Id.* at *7-8.

⁵² *Id.* (citations omitted).

incorporation of the pseudonym was incidental.⁵³ The court thus preempted the publicity claim, and the muralist's proper remedy lay in copyright law.

In another case, *Toney v. Loreal USA, Inc.*,⁵⁴ a district court examined the allegations of a model claiming that the defendants used her likeness beyond the period and extent she had authorized in violation of her right of publicity. The defendants and their successors had agreed with the model to use photographs of her on the packaging of a hair relaxer product in order to promote it; the agreement was limited to a five-year period, and the plaintiff claimed defendants continued to use her likeness after the five years had expired.⁵⁵ Using the same rationale as the *Baltimore Orioles, Ahn*, and *Villa* cases, the court held that plaintiff's likeness was fixed in a photograph that came within the subject matter of copyright, and that her publicity rights were equivalent to section 106 rights; the claim could not survive preemption and the court dismissed it.⁵⁶ The state right in Toney's control of the reproduction of her persona presumably constitutes an "extra element," but one that seems inseparable and thus not qualitatively different from any of the rights attached to a copyrightable work in which the persona is embedded.

II. THE RIGHT OF PUBLICITY: CONCEPTUAL AND GEOGRAPHIC EXPANSION

⁵³ *Id.* at *10-11.

⁵⁴ No. 02 C 3002, 2002 U.S. Dist. LEXIS 21229 (N.D. Ill. Oct. 30, 2002).

⁵⁵ *Id.* at *2-4.

⁵⁶ *Id.* at *4-7. *See also, e.g.*, *Glovaroma v. Maljack Prods., Inc.*, No. 96 C 3985, 1998 U.S. Dist. LEXIS 2399, at *15-18 (N.D. Ill. 1998) (preempting Frank Zappa's right of publicity claims in his name, voice, photograph, and likeness, as asserted by his wife and successor-in-interest Gail Zappa, where the works at issue were videotaped performances recorded with Zappa's consent). For criticism of *Toney*, see Ryan S. Hilbert & Maki Kanayama, *Case Note: Toney v. Loreal USA Inc.: The Answer to the Question "What Do Hair Relaxer Products Have to Do With the Seventh Circuit's View on Copyright Preemption and the Right of Publicity?"*, 19 SANTA CLARA COMPUTER & HIGH TECH. L.J. 531 (2003). That article argues for a distinction between the photograph of Toney, which the author concedes is a copyrightable writing, and Toney's persona as captured in the photograph.

The scope of the right of publicity has expanded both conceptually and geographically, with ensuing harmful effects on the policy of the Act in the areas where the two overlap. The conceptual expansion involves an increase in the variety of qualities the right protects. Where these areas intersect with copyright law there has been a repeated tendency by courts, especially the Ninth Circuit applying California law, to allow celebrities to assert right of publicity claims at the expense of copyright owners or licensees. These rulings have limited the utility of the copyrights and hence diminished their value. Geographic expansion has come in tandem, as a number of other jurisdictions have cited to the Ninth Circuit rulings as precedent for allowing right of publicity claims to survive section 301(a) preemption.

A. The Development of the Right of Publicity

The “right of publicity” was first specifically recognized in *Haelan Laboratories, Inc., v. Topps Chewing Gum, Inc.*⁵⁷ In that case a number of professional baseball players had granted Haelan an exclusive right to have their images on baseball cards. Subsequently, Topps induced a number of these players to appear on its baseball cards, despite the players’ agreement with Haelan.⁵⁸ The court held that Haelan could stop Topps because the players had contracted with Haelan and therefore Haelan had received the exclusive right to publish the images.⁵⁹ Haelan asserted the rights of publicity the players had assigned to it.⁶⁰

The right of publicity protects images, likenesses, names, nicknames, voices, slogans, and personae⁶¹ from misappropriation and unauthorized commercial exploitation.⁶² It is

⁵⁷ 202 F.2d 866 (2d Cir. 1953).

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ A concept that sometimes encapsulates the other items in the list.

alienable and in some states inheritable. As discussed below, the right of publicity has expanded from prohibiting the use of someone's name or likeness for advertising purposes to protection against voice imitations, character imitations and virtually anything else that seems to evoke an individual's personality. As a result of this expansion advertisers are reluctant to use anyone in an advertisement who may potentially remind the public of a celebrity.⁶³

In California the right of publicity has found fertile soil. Although the doctrine originally applied only to celebrities, California has extended it to include non-celebrities as long as they allege the statutory minimum damage amount of \$750.00.⁶⁴ Further and also problematic, California allows a plaintiff who is a California resident to file suit in California regardless of where the alleged misappropriation of the right of publicity occurs.⁶⁵ This provision allows the California state courts, and thus federal courts sitting in diversity⁶⁶ and applying California law, to adjudicate matters that have national ramifications.⁶⁷

B. The Unholy Trinity: the *Midler*, *Waits*, and *White* Decisions

In a trilogy of cases⁶⁸ addressing voice and appearance imitations the Ninth Circuit, applying California law, has issued a series of rulings that have had an enormous impact on

⁶² See McCarthy, *supra* note 15, at §§ 1:3, 4:1-86

⁶³ See generally Kent, *supra* note 5.

⁶⁴ Cal. Civ. Code § 3344 (West 1997).

⁶⁵ *Id.*

⁶⁶ 28 U.S.C. § 1332 (2002).

⁶⁷ Bartz, *supra* note 9, at 321.

⁶⁸ *Midler v. Ford Motor Company*, 849 F.2d 460 (9th Cir.1988), *cert. denied*, 503 U.S. 941 (1992); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *White v. Samsung Electronics, Inc.*, 971 F.2d 1395 (9th Cir. 1992).

the Act.

1. *Midler v. Ford Motor Company*

The first major expansion of the right of publicity occurred in *Midler v. Ford Motor Company*.⁶⁹ Bette Midler, a famous singer and actress, sued Ford alleging that her voice had been misappropriated for use in a television commercial without her consent.⁷⁰ In 1973 Midler recorded an album which contained the song "Do You Want to Dance."⁷¹ She did not own the copyright to that song. In 1985 Ford launched "The Yuppie Campaign" which featured popular songs of the seventies played during Ford commercials in an attempt to translate reminiscences of halcyon college days into purchases of Ford vehicles.⁷² Ford contacted Midler in an attempt to get her to do the song for the campaign. Midler declined.⁷³ Not to be deterred, Ford's advertising agency, Young & Rubicam, hired an imitator to sing the song.⁷⁴ The commercial contained an imitator who sounded "exactly" like Midler did in the original recording.⁷⁵ However, in an effort to avoid any problems the advertisement agency secured a license from the copyright owner for the song.⁷⁶

Midler contended that her voice, in and of itself, was not copyrightable because it could not be fixed in a tangible medium of expression and consequently was outside the copyright subject matter.⁷⁷ The court dismissed the statutory right of publicity count because

⁶⁹ 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 503 U.S. 941 (1992).

⁷⁰ *Id.* at 461.

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.* at 461.

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ *Id.* at 462.

⁷⁷ *Id.*

Midler's actual voice had not been used, but found that Midler's common law right of publicity had been violated by the imitation.⁷⁸ The court accepted Midler's logic that her voice was not copyrightable because it was not fixed, despite the fact that the song had been fixed in a sound recording. To arrive at this conclusion the court separated the voice from the song. It found that preemption did not apply since the voice itself was not within the subject matter of copyright preemption. "What [the defendants] sought was an attribute of Midler's identity."⁷⁹ The *Midler* holding expanded the right of publicity to include protection for celebrities against voice imitators.

Numerous problems arise from this ruling. First, the copyright holder owned the song. One right in the bundle held by a copyright owner is the right to license the work.⁸⁰ Here the owner did just that: it granted presumably a non-exclusive license to the advertising agency for Ford. The *Midler* decision prohibited the licensee, the advertising agency, from fully exploiting the license it had obtained for the Midler song by creating liability for hiring an imitator.

Midler argued that a voice itself is not copyrightable because it cannot be fixed. However, what Midler really objected to and sought to prohibit was its usage in a fixed medium, the commercial. The vocal performance of the imitator was a copyrightable work, as was the commercial in which the performance was embedded; the subject matter prong of section 301(a) was apparently met. Moreover, the action involved in this case was the reproduction of a copyrighted work, the licensed song. For Midler's suit to be successful, the act of reproducing the song, allowed by section 106, had to violate her right of publicity. Both prongs of Section 301(a) were arguably fulfilled.

Additionally, the fact situation in *Midler* called for conflict preemption. The Act

⁷⁸ *Id.* at 464.

⁷⁹ *Id.* at 463.

⁸⁰ *See* 17 U.S.C. 201(d).

addresses imitation sound recordings and specifically allows them under section 114(b).⁸¹ Pursuant to this section the Act does not prohibit the duplication of a sound recording composed entirely of an independent fixation of sounds, which was exactly what the advertising agency did. By restricting the rights of copyright holders in sound recordings, Congress signaled its intent that the creation of independently fixed imitations or simulations was permissible activity and that this was an area that should not be regulated by the states. However, the *Midler* court upheld California's regulation and prohibited an imitation of a sound recording by finding that a misappropriation had occurred pursuant to the common law right of publicity.⁸²

2. ***Waits v. Frito-Lay, Inc.***

After *Midler* came *Waits v. Frito-Lay, Inc.*⁸³ Frito-Lay had retained an advertising agency to promote a new snack product.⁸⁴ That agency had recommended using Tom Waits, a reasonably well known singer, for the commercial.⁸⁵ Waits has a distinctive singing voice, described as "like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades Late at night. After not sleeping for three days."⁸⁶ Waits, however, does not do commercials.⁸⁷ Not to be deterred, Frito-Lay decided to have a voice imitator do a song for their commercial that was stylistically similar

⁸¹ 17 U.S.C. 114(b) provides in pertinent part: "The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording."

⁸² Bartz, *supra* note 9, at 318-319.

⁸³ 978 F.2d 1093 (9th Cir. 1992).

⁸⁴ 978 F.2d at 1097.

⁸⁵ *Id.*

⁸⁶ *Id.* (quoting description by an unknown fan).

⁸⁷ *Id.*

to Waits's song "Step Right Up."⁸⁸ The imitator's voice was extraordinarily similar to Waits's.⁸⁹ Waits, apparently not amused and in a refutation of the old adage that imitation is the sincerest form of flattery, filed a voice misappropriation claim based upon the right of publicity.⁹⁰

The court held that Waits's voice misappropriation claim was not preempted by copyright law because the elements of voice misappropriation were different from those in a copyright infringement case.⁹¹ Following the rationale of *Midler*, the court found that a voice per se was not copyrightable, allowing it to escape the subject matter of copyright:

The . . . focus was on the elements of voice misappropriation . . . whether the defendants had deliberately imitated Waits' voice rather than simply his style and whether Waits' voice was sufficiently distinctive and widely known to give him a protectable right in its use. These elements are "different in kind" from those in a copyright infringement case challenging the unauthorized use of a song or recording. Waits' voice misappropriation claim, therefore, is not preempted by federal copyright law.⁹²

As it found that the Waits imitation failed the subject matter prong of section 301(a), the court did not address the question of equivalent rights.

In *Waits*, the court did not address the conflict preemption issue raised by section 114(b) of the Act. Instead, when the court purported to address section 114 it apparently confused that section with section 301,⁹³ and then proceeded to discuss the wrong portion of

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at 1098.

⁹¹ *Id.* at 1100.

⁹² *Id.*

⁹³ "The defendants ask that we rethink *Midler* . . . arguing as the defendants did there that voice misappropriation is preempted by Section 114 of the Copyright Act. Under this provision, a state cause of action escapes Copyright Act preemption if its subject matter 'does not come within the subject matter of copyright . . . including works or authorship not fixed in any tangible medium of expression.' 17 U.S.C. § 301(b)(1)." *Id.*

legislative history.⁹⁴ As a result of this confusion, the allowance for sound recording imitations and simulations in section 114(b) was never addressed. Congress's intention, as expressed in that section, was to allow independently fixed imitations and simulations to remain in the public domain. Though the song in the radio commercial did not exactly imitate a real song, as the imitation in *Midler* had, it did "simulate" the original Waits song. Thus, conflict preemption should also have served as a basis to preempt in this instance.

To allow states to regulate an area designated for the public domain by Congress, as the Ninth Circuit did with the imitation recordings in *Midler* and *Waits*, specifically contradicts the intent of Congress and challenges the Supremacy Clause of the Constitution.

3. *White v. Samsung Electronics, Inc.*

The right of publicity was further expanded in *White v. Samsung Electronics, Inc.*⁹⁵ to protect images and likenesses of identifiable characters. Samsung ran a series of futuristic advertisements for their products containing parodies of various elements of 1980's popular culture.⁹⁶ One commercial portrayed a robot in a gown, with jewelry and a blonde wig turning a game wheel.⁹⁷ Underneath the robot ran a slogan proclaiming "longest-running game show 2012 A.D."⁹⁸ The image and the wheel resembled Vanna White and the *Wheel of Fortune*.⁹⁹ White did not consent to the production of the commercial, nor was she

⁹⁴ "Moreover, the legislative history of section 114 indicates the express intent of Congress that 'the evolving common law rights of "privacy," "publicity," and trade secrets . . . remain unaffected [by the preemption provision] . . . as long as the causes of action contain elements, such as an invasion of personal rights, that are different in kind from copyright infringement.'" *Id.* (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 132, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748) (internal quotation marks and brackets by the court). In fact this section of the House Report discusses section 301, not section 114 of the Act.

⁹⁵ 971 F.2d 1395 (9th Cir. 1992).

⁹⁶ 971 F.2d at 1396.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.*

compensated.¹⁰⁰

White sued Samsung for a California common law right of publicity violation. The District Court granted summary judgment against her.¹⁰¹ The Ninth Circuit reversed.¹⁰² The court conceded that defendants did not use White's name or identity.¹⁰³ However, in order to find for White, the court stretched the right of publicity by finding that White's *identity* had been misappropriated.¹⁰⁴ The court cited a series of older right of publicity cases that allegedly support this ruling.¹⁰⁵ However, the court did not address the issue of preemption and in fact did not even mention the Act.

The holding of this case created a troubling result for the copyright owner of the *Wheel of Fortune* show. A character that is sufficiently delineated in personality or physical traits may be copyrightable. In this instance White was an employee of the show. Furthermore, the concept of Vanna White, as embodied by her outfits, jewelry and makeup, had all been created by the copyright owner of the *Wheel of Fortune* game show, who had also created a physically identifiable character. Thus, White represents an integral part of the copyrightable subject matter of the *Wheel of Fortune* as well as a copyrightable character in her own right, one owned by the copyright holder for the show. Consequently, the Vanna White robot was a derivative work¹⁰⁶ the production of which is a privilege enjoyed solely by the copyright holder; if anyone is entitled to an infringement suit it would be the copyright

¹⁰⁰ *Id.*

¹⁰¹ *Id.* at 1396.

¹⁰² *Id.*

¹⁰³ *Id.* at 1397.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 1397-1399.

¹⁰⁶ 17 U.S.C. 106(b).

holder rather than White.¹⁰⁷

Assuming Samsung did not obtain a license, the copyright owner may have decided not to file suit because the White robot was a parody. After all, the parody defense had successfully been raised in other copyright infringement cases¹⁰⁸ and arguably could have applied in this instance. In any event the issue of whether the robot did or did not constitute a parody may be an academic question, but it does indicate that the copyright holder may have opted not to file suit because of the belief that the Act allows for parodies and would be a defense to the infringing commercial.

Judge Kozinski, in a later proceeding in the case, strongly criticized the majority position.¹⁰⁹ After pointing out that the panel had misinterpreted the California law of publicity in allowing White to claim that her very identity had been misappropriated by the robot that didn't use her name or likeness, Kozinski stated, "By refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act."¹¹⁰ He noted that the Act allowed for parodies, considering them to be in the public interest.¹¹¹ If the White robot had borrowed too much from the original, the copyright owner could have licensed out this creation as a derivative work.¹¹²

The *White* ruling inhibits the ability of advertisers to present parodies of celebrities to the public and also limits a copyright owner's right to license derivative works if they portray a celebrity.¹¹³ The only winner is the lone celebrity. The majority in *White* created a

¹⁰⁷ Bartz, *supra* note 9, at 312.

¹⁰⁸ See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹⁰⁹ See 989 F.2d. 1512 (9th Cir. 1993) (dissenting from the order rejecting the suggestion for rehearing en banc).

¹¹⁰ *Id.* at 1517.

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.* at 1518.

remarkable and dangerous property right for celebrities, a right that devastates the balancing scheme underlying the Act.¹¹⁴ Judge Kozinski points out, “In a case where the copyright owner isn't even a party—where no one has the interests of copyright owners at heart—the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit.”¹¹⁵

Interestingly, a division of the Court of Appeal of California, in contrast to these Ninth Circuit opinions, upheld the rights of copyright holders and their licensees in *Fleet v. CBS, Inc.*¹¹⁶ and preempted a state right of publicity claim. In *Fleet*, a group of actors who appeared in a film were not paid for their work by their production company, Performance Guarantees. In response, the actors filed suit alleging that because they had not been paid by Performance Guarantees, CBS, the licensee who had been given exclusive distribution rights in the film, could not use the actors’ names, voices, photographs, likenesses or performances in the film.¹¹⁷ No one disputed that the film was copyrightable, that CBS had received an exclusive distribution license, or that the actors did not own the copyright.

In its ruling, the court analyzed the issue of “whether the rights appellants claim . . . can coexist with the federal copyright statute.”¹¹⁸ The court found that once the actors' individual performances were put on film, they became “dramatic work[s] fixed in [a] tangible medium” and consequently came within the subject matter of copyright law.¹¹⁹ The court also held that the rights sought by the actors were equivalent to those exclusive rights

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ 50 Cal. App. 4th 1911 (1996).

¹¹⁷ *Id.* at 1916. Plaintiffs' right of publicity allegation was brought forth under California’s right of publicity statute. Cal. Civ. Code Section 3344 (West 1997).

¹¹⁸ *Fleet*, 50 Cal. App. 4th at 1917.

¹¹⁹ *Id.* at 1919 (citation omitted, alterations by the court).

contained in the Act: "A claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted."¹²⁰ The court's message was clear: a party who does not own the copyright in a film cannot prevent the copyright holder from exploiting that right through a state law right of publicity allegation.¹²¹ Actors who wish to protect the use of their images and likenesses contained in fixed dramatic performances should obtain ownership in the copyrights.¹²² Given the preceding series of opinions where Ninth Circuit, applying California law, allowed the right of publicity to coexist with copyright, the *Fleet* case is a surprising result.¹²³

C. The *Wendt* Decision: Unholy Trinity Plus One

As reported in an unpublished opinion in *Wendt v. Host International, Inc.*,¹²⁴ well known *Cheers* actors George Wendt and John Ratzenberger sued Host International alleging a violation of their rights of publicity.¹²⁵ Paramount, which held the copyright for *Cheers*, intervened in the case.¹²⁶ Wendt and Ratzenberger played two of the most famous characters on *Cheers*: Norm and Cliff. The show was extremely popular in the 1980's and

¹²⁰ *Id.* at 1924.

¹²¹ *Id.* at 1923.

¹²² *Id.* at 1921.

¹²³ *Fleet* was distinguished in a recent Ninth Circuit case involving photographs (with accompanying names) of surfers, purchased from the photographer and used to promote clothing in a catalog; the surfers sued for unauthorized appropriation of their names and likenesses in violation of their publicity rights. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001). The court argued in a footnote that *Fleet* involved copyrightable performances in a film, whereas *Downing* involved the non-copyrightable names and likenesses embodied in the photographs. *Id.* at 1005 n.4. The unwritten distinction from performances in films the court operated on seems to be simply that photographs are still and thus cannot contain copyrightable works of authorship such as dramatic performances, even while the court acknowledged that photographs themselves are pictorial works of authorship. *Id.* at 2003.

¹²⁴ Nos. 93-56318, 93-56510, 1995 U.S. App. Lexis 5464 (9th Cir. March 16, 1995).

¹²⁵ *Id.* at *1.

¹²⁶ *Id.*

early 1990's. Given this popularity, defendant, Host decided to create a line of *Cheer's* airport bars.¹²⁷ Host properly secured a license from Paramount for the *Cheers* concept. Two robots were placed at the bars that did not physically resemble Wendt and Ratzenberger, but one was dressed in a postal uniform while the other was overweight.¹²⁸ The two animatronic robots were named "Bob" and "Hank".¹²⁹

The district court granted summary judgment for the defendant. The Ninth Circuit reversed.¹³⁰ At the beginning of its opinion the Ninth Circuit stated "at the outset, we wish to make it clear that this is not a preemption case".¹³¹ In a short and woefully inadequate opinion the court held plaintiffs' cause of action was not preempted.¹³² Specifically, the court ruled, as in *Waits*, the claims contained extra elements (the commercial use of the plaintiffs' identities) that differed from a copyright infringement cause of action.¹³³ After the district court again granted summary judgment for Host the Ninth Circuit in their second opinion¹³⁴ reiterated that the Act did not preempt plaintiffs' claims.

In so doing, the court rejected Host's use of *Fleet v. CBS* as controlling California authority, reasoning that *Fleet* only applies to the distribution of copyrighted films.¹³⁵ This attempt to distinguish *Fleet* is unconvincing: Here Host sought to display licensed copyrighted characters; there, the film licensee sought to display copyrighted performances.

¹²⁷ 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J. dissenting from an order rejecting an en banc hearing).

¹²⁸ *Id.* at 1285.

¹²⁹ *Id.*

¹³⁰ *Wendt*, 1995 U.S. App. Lexis 5464 at *1.

¹³¹ *Id.* at *2.

¹³² *Id.* at *3.

¹³³ *Id.* at *2-3.

¹³⁴ 125 F.3d 806 (9th Cir. 1997).

¹³⁵ *Id.* at 810.

Disregarding an essential California precedent in this fashion may run afoul of the *Erie* doctrine¹³⁶ and presents the curious phenomenon of a federal appeals court giving more heft to state law than the state's own courts. It also leads to the following possibility: Celebrities in California wishing to prevent licensed advertisers or parodists from placing reminders of the celebrities in the public eye may forum shop by alleging a parallel federal statutory claim to obtain federal question jurisdiction (if they cannot allege diversity), and then make a pendent state claim under California law, knowing the federal courts will afford this claim more favorable treatment than the California courts would.

In *White*, Judge Kozinski specifically stated that the broad application of the right of publicity puts state law on a collision course with the federal rights of the copyright holder.¹³⁷ In *Wendt*, this apocalyptic vision came to pass. Kozinski began his scathing dissent from the decision not to hear the case *en banc* with the phrase "Robots Again."¹³⁸ He stated, "The panel holds that *licensed* animatronic figures based on the copyrighted *Cheers* characters Norm and Cliff infringe on the rights of the actors who portrayed them. As I predicted, *White's* voracious logic swallows up rights conferred by Congress under the Copyright Act."¹³⁹ *Wendt* served to confirm that the right of publicity was spreading rapidly out of control like a "kudzu"¹⁴⁰ at the expense of the Act. Judge Kozinski proceeded to provide a colorful portrayal of a "bizarro" world where a copyrighted television show did not have any rights in its characters resulting in *Seinfeld* spin-off where "a skinny Newman sits down to coffee with a svelte George, a stocky Kramer, a fat Jerry and a lanky blonde Elaine."¹⁴¹

¹³⁶ *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938).

¹³⁷ 989 F.2d at 1517-1518.

¹³⁸ 197 F.3d at 1284.

¹³⁹ *Id.* at 1285.

¹⁴⁰ *Id.* at 1289.

¹⁴¹ *Id.* at 1287 n.6.

The *Wendt* decision goes one step beyond even *White* because in *Wendt* the defendant had secured a license from the copyright holder in order to utilize the *Cheers* concept. Unquestionably the parties were fighting over the same bundle of intellectual property rights.¹⁴² The owner of the copyright license was pitted against the actors who were in the copyrighted *Cheers* show:

So who wins? The Copyright Act makes it simple, at least insofar as the plaintiffs interfere with Paramount's right to exploit the *Cheers* characters. Section 301 of the Copyright Act preempts any state law "legal or equitable rights that are equivalent to any of the exclusive rights that are in the general scope of copyright." The copyright to *Cheers* carries with it the right to make derivative works based on its characters. The presentation of the robots in the *Cheers* bars is a derivative work, just like a TV clip, promotion, photograph, poster, sequel or dramatic rendering of an episode. Thus, under federal law, Host has the unconditional rights to present robots that resemble Norm and Cliff.¹⁴³

Instead, the ruling in *Wendt* requires anyone who wants to use any sort of figure, statue, robot, drawing or poster that reminds the public of *Wendt* and *Ratzenberger* to first obtain consent and then pay for the consent.¹⁴⁴ This directly contradicts the rights of the copyright owner. Paramount should be able to reproduce the characteristics of the characters that they created and for which they obtained a copyright.¹⁴⁵ Additionally, this ruling directly contravenes the *Baltimore Orioles* decision,¹⁴⁶ which specifically held that the owners of the telecasts have the copyrights to the performer's performances and that any right to publicity claims are preempted.¹⁴⁷

Interestingly, although Judge Kozinski couched his dissent in terms of a Section

¹⁴² *Id.* at 1286.

¹⁴³ *Id.* (citations omitted).

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ 805 F.2d 663 (7th Cir. 1986).

¹⁴⁷ *Id.*

301(a) preemption analysis he spent very little time analyzing the two conditions necessary for preemption. The dissent focused on the inherent tension between copyright law and the right of publicity. Host properly obtained a license to the *Cheers* concept. Did Host really have to pay for the individual actors' consent? The Ninth Circuit seemed to think so. This trumping of federal law by the right of publicity creates an implicit conflict. Thus, while mentioning Section 301(a), Judge Kozinski was in reality discussing conflict preemption. Here the state law undoubtedly was in conflict with the rights granted in the Act. The stronger argument for preemption in *Wendt* may have actually been preemption pursuant to the Supremacy Clause.

Additionally, *Wendt* has national ramifications because it runs afoul of the “dormant copyright clause.”¹⁴⁸ Arguably California’s right of publicity law is invalid as it substantially interferes with federal copyright law because it will “prejudice the interests of other states.”¹⁴⁹ The California law stops Host from using its license anywhere in the United States, even in states that do not recognize the right of publicity.

D. Beyond The Ninth Circuit

In a disturbing trend, the right of publicity, as interpreted by the Ninth Circuit, is increasingly being applied on a national basis in areas where it overlaps with copyright. Specifically, *Midler*, *Waits*, *White* and *Wendt* are being cited as precedent throughout the country. In *Landham v. Lewis Galoob Toys, Inc.*,¹⁵⁰ the Sixth Circuit found no preemption by the Act. *Landham* involved marketing and licensing 1.5 inch tall toys that were based on a character in the movie *Predator*.¹⁵¹ An actor from the movie, Sonny Landham, filed a right of publicity suit because he never consented to having his character

¹⁴⁸ 197 F.3d at 1288.

¹⁴⁹ *Id.*

¹⁵⁰ 227 F.3d 619 (6th Cir. 2000).

¹⁵¹ *Id.* at 621.

merchandised by defendant.¹⁵² Defendant moved to preempt the right of publicity claim. The Sixth Circuit reversed the district court's summary judgment and found that the Act did not preempt plaintiff's claim.¹⁵³ The court based its ruling, in part, on both *Wendt* and *Midler*, for the proposition that plaintiff's right of publicity claim asserts elements separate from those protected by the Copyright Act.¹⁵⁴

In *Brown v. Ames*,¹⁵⁵ the Fifth Circuit chose not to preempt. The defendants had allegedly misappropriated the names and likenesses of the plaintiffs to market the plaintiffs' musical performances.¹⁵⁶ Plaintiffs sued alleging a violation of their rights of publicity.  facts seemed to indicate that one of the defendants had fraudulently conveyed a license to use the names and likenesses of the plaintiffs (as contained in packaging and promotional materials for musical recordings) to the other defendant.¹⁵⁷ Having found the Ninth Circuit's opinions in *Midler* and *Waits* (both holding that a vocal style was not fixed and therefore not copyrightable) to be persuasive, the Fifth Circuit held that names or likenesses are like vocal styles, and thus a claim for misappropriation of them is not within the subject matter of copyright.¹⁵⁸ Additionally, the court found that conflict preemption was not applicable because the plaintiffs' state law claims did not conflict with the Act.

Both of these propositions were debatable. The names and likenesses of the plaintiffs became fixed once they were placed on the compact disc cover. Further they were also works of authorship since they constituted a pictorial work whether the likenesses were

¹⁵² *Id.*

¹⁵³ *Id.* at 621.

¹⁵⁴ *Id.* at 624.

¹⁵⁵ 201 F.3d 654 (5th Cir. 2000).

¹⁵⁶ *Id.* at 657.

¹⁵⁷ *Id.* at 656.

¹⁵⁸ *Id.* at 658.

drawn or photographed. Additionally, even assuming that the license obtained from the copyright holder to use the names and likenesses was invalid, the issue of the propriety of use of a copyright license arises under federal law, and thus the court should have preempted the state misappropriation claim. Again, as in *Wendt*, conflict preemption may be the stronger basis for preemption.

In *Prima v. Darden Restaurants, Inc.*,¹⁵⁹ the defendant hired a vocalist who did a voice imitation of the singer Louis Prima for an Olive Garden restaurant commercial. Prima's widow filed the lawsuit alleging amongst other things violations of his right of publicity.¹⁶⁰ While New Jersey courts have not expressly decided whether the right of publicity protects a singer's voice from unauthorized commercial exploitation, they acknowledge the trend among other courts that the imitation of another's voice can give rise to a cause of action for infringing the right of publicity.¹⁶¹ The court was persuaded that the *Waits* and *Midler* decisions would cause the New Jersey courts to adopt the rules followed in those cases.¹⁶² Relying heavily on the aforementioned cases the court stated that "while the issue has not been addressed by the Third Circuit, this Court is persuaded by the reasoning that the Copyright Act does not preempt a common law right of publicity for unauthorized use of another's voice."¹⁶³

In *K&B Enterprises v. Matthews*,¹⁶⁴ the California appellate court created a new twist by allowing a copyright owner to file a right of publicity claim rather than a copyright infringement cause of action. The defendant used pictures owned by the plaintiff on its

¹⁵⁹ 78 F. Supp.2d 337 (D.N.J. 2000).

¹⁶⁰ *Id.* at 342.

¹⁶¹ *Id.* at 349.

¹⁶² *Midler*, 849 F.2d 460 (9th Cir. 1988); *Waits*, 978 F.2d 1093 (9th Cir. 1992).

¹⁶³ *Prima*, 78 F. Supp.2d at 352.

¹⁶⁴ 78 Cal. App. 4th 362 (Cal. App. 2000).

website.¹⁶⁵ The plaintiff clearly could have filed a copyright action based upon his copyrightable photographs. Instead, plaintiff opted to file a right of publicity suit, possibly because of greater potential for damages or the lesser likelihood of defenses such as fair use being raised, or even possibly because the state court jurisdiction may have been more favorable than federal court. Whatever the reason, plaintiff clearly preferred the right of publicity claim to the copyright claim. The court did not preempt. The court ruled that the copyrighted photographs contained likenesses of models that were not copyrightable.¹⁶⁶ These likenesses, though depicted in photographs, are outside the subject matter of copyright and cannot be preempted.¹⁶⁷ As the models did not consent to defendant displaying their photographs the plaintiff, through an assignment from the models, can assert their right of publicity claims on their behalf.¹⁶⁸

The facts clearly indicate copyright infringement. Despite plaintiff's attempt to hide the infringement case in a right of publicity cloak, it was still an infringement issue. The plaintiff was the copyright holder in the photos, which indisputably fall within the subject matter of copyright. The plaintiff sought to prevent their reproduction and distribution by the defendant, which were exclusive rights under section 106. Characterizing the issue as a right of publicity issue should not have allowed the plaintiff to avoid section 301 or conflict preemption, given the conflict between the text and goals of the Act and state law.

III. TODAY'S RIGHT OF PUBLICITY: THE LOSERS AND WHERE TO GO

Expansion of the right of publicity fails to balance societal rights and celebrities' rights. Instead it solely seeks to protect the selected rights of an individual, almost always a celebrity, at the expense of society. This expansion resulting from the Ninth Circuit opinions

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* at 715.

¹⁶⁷ *Id.* at 723.

¹⁶⁸ *Id.*

has had deleterious effects on copyright owners, the public, and the Act's policy of uniformity.

A. Results of the Right of Publicity and Preemption Conflict: The Losers

Copyright owners have watched the value of their copyright lessen as a result of recent right of publicity rulings. Specifically, the value of copyright licenses has been reduced in areas where celebrities are involved. The logic limiting the rights of licensees may soon be applied to the copyright owners themselves, thereby limiting their exploitation of their copyrights. The Act provides a balancing between the interests of the public and those of the copyright owner. It seeks to allow the public eventual access to copyrighted works, as well as to protect and provide an incentive to the copyright owners for a limited duration. The right of publicity does not provide this balancing act. Instead the right of publicity protects and enhances the interests of celebrities when they come into conflict with the Act.

One of the rights the Act creates is the ability to license copyrighted materials. This can serve as a source of considerable revenue for the copyright owner. If licensees, such as Host International in the *Wendt* case, seek to use copyrighted materials they now need additional consent from any celebrity involved, or they face the risk a right of publicity suit. Licensees will be much less likely to obtain a license if they are aware of the possibility that a right of publicity suit can occur despite the license. The net result: copyright owners will have more difficulty licensing and will receive less revenue for it.

Further, with the expansion of publicity rights the copyright owners' ability to enforce their rights is diminished. The copyright owners often find themselves in a position where a right of publicity case is taking place involving their copyright and involving what should be their rights. If a right of publicity suit is filed and a potential copyright action exists, as in *White*, it raises questions about what the copyright holder should do. Potentially the copyright owner could be forced into filing a suit prematurely if concerns about the financial viability of the defendant exist and the copyright owner anticipates the filing of a right of

publicity suit. Additionally, similar lawsuits, with similar discovery, could pend in both state and in federal courts creating logistical nightmares.

Additionally the conflicting state and federal statutes burden interstate commerce. In California the jurisdiction for a right of publicity suit is predicated upon the domicile of the plaintiff. This creates strain on interstate commerce as a California state court can render judgment on behalf of its citizens for activity occurring anywhere in the United States.

Finally, the ability to parody, which in certain circumstances is allowable pursuant to the Act, can be restricted by the right of publicity in certain instances such as in the *White* case. Society's ability to parody, particularly of celebrities, could be limited in areas where a right of publicity suit is not preempted, harming the public as a whole and additionally creating First Amendment considerations.

B. Where Do We Go From Here?

California's right of publicity doctrine does have a time and a place. For instance in *Eastwood v. Superior Court*,¹⁶⁹ the National Enquirer allegedly used Clint Eastwood's name and photograph on its newspaper cover without his consent.¹⁷⁰ Looking beyond the issue of the photograph, the usage of his name, without his consent, creates a viable right of publicity claim. This case is also similar to *Abdul-Jabbar v. General Motors, Corp.*,¹⁷¹ wherein the defendants allegedly used the name Lew Alcindor in a television commercial without the plaintiff's consent.

By all means the right of publicity should allow the celebrity and even the non-celebrity to protect their image and likeness. However, once that image or likeness has been expressed in copyrightable terms, it is owned by the copyright owner (who may or may not be the same person). It is up to copyright owners to enforce their copyrights and determine

¹⁶⁹ *Eastwood v. Superior Court*, 149 Cal. App. 3d 409 (1983).

¹⁷⁰ *Id.*

¹⁷¹ *Abdul-Jabbar v. General Motors, Corp.*, 85 F.3d 407 (9th Cir. 1996).

whether their copyrighted materials have been infringed. Concerns about licenses or being associated with various companies should all be negotiated in a contract between the celebrity and copyright owner. In the areas that do not fall within the Act the right of publicity can be and should be applied, but to allow it to conflict with the rights of copyright owners undermines their rights and the policy of the Act.

The recent growth of the right of publicity has developed somewhat like a “haystack in a hurricane.”¹⁷² Unquestionably, the Ninth Circuit has judicially carved out a right of publicity exception to preemption. The situation as it stands and potentially accelerates is undermining the Act in the areas where tension exists between copyright and the right of publicity.

To regain a more balanced approach will require either judicial or legislative intervention. From a judicial standpoint a more vigorous application of section 301 preemption, or in the alternative conflict preemption, would curtail the right of publicity's growth. Congress could amend the Act itself to address some of the issues that have arisen with the recent Ninth Circuit rulings, to make its intent on the matter clear. Another legislative possibility, and perhaps the best option for restoring uniformity and clarity to this area of the law, is a new federal statute defining the permissible scope of the right of publicity (and preempting similar state rights) and harmonizing its relationship with federal copyright.

IV. CONCLUSION

The right of publicity has been expanded by the Ninth Circuit. Through this expansion it has come into conflict with the Act and has repeatedly trumped the Act. As a result, in these areas where tension between the Act and copyright exist, the Act has been undermined, copyright owners have seen their copyrights diminish in strength and value and society has been harmed. The consequences of continuing to travel this route need to be

¹⁷² *Adair v. Falk Television Broadcasting Corp.*, 229 F.2d. 481, 485 (3rd Cir. 1956).

carefully examined, whether through Supreme Court intervention or Congressional action.