

PUBLICITY RIGHTS REVISITED

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It has been ten years since Washington's legislature adopted a statutory right of publicity, RCW 63.60.010, *et seq.* As yet, there are no published opinions under the Washington statute, and only one unreported decision, *Dale v. Coors Brewing Co.*, 113 Wn. App. 1017 (Div. I 2002), affirming a trial court's decision that the plaintiff failed to establish liability or any damages and awarding defendant Coors Brewing Co. \$40,671 in attorney fees in defending the claim. This result might well have a chilling effect.

Nevertheless there have been interesting developments in the right of publicity area both in the Ninth Circuit and elsewhere.

There have been substantial damage awards for infringement of rights of publicity. In 2005, a California jury awarded Russell Christoff \$15.6 million for the use of his picture on the label of Taster's Choice Coffee. In 2006, in *John Doe a/k/a Tony Twist v. Todd McFarlane and Todd McFarlane Productions, Inc.*, 207 S.W.3d 52 (Mo. App. E.D. 2006), the Missouri Court of Appeals affirmed a jury award to former professional hockey player Tony Twist for use of his name for a character in the "Spawn" comic book series.

There have been clarifications of what constitutes identity, the First Amendment defense and copyright preemption. In what was perhaps the most watched publicity rights case in 2007, a federal circuit court of appeals rejected publicity rights claims of major league baseball players, holding that their publicity rights in their names and statistics as used in fantasy baseball are trumped by First Amendment free speech interests. *C.B.C. Distrib. and Mktg., Inc. v. Major League Baseball Advanced Media L.P.*, 505 F.3d 818 (8th Cir. 2007). Other circuits also have rejected players' publicity rights claims on different theories. In *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), the court found that the players' rights were preempted by copyright law because their performances were works for hire within their scope of employment and were embodied within a fixed tangible form. In *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996), the court held that a set of collectible trading cards with parody cartoons of major league baseball players accompanied by humorous text were protected by the First Amendment.

In the legislative arena, California has passed into law effective January 1, 2008, a controversial bill granting retroactive rights of publicity to dead celebrities. (Previously,

California granted rights of publicity only to celebrities who died after December 31, 1984.) The law was intended to give Marilyn Monroe's estate and the beneficiaries of other California celebrities who died within the last 70 years commensurate protections. New York has proposed but failed to pass similar legislation. The legislation abrogates 2007 federal court decisions in California and New York that rejected celebrity rights of publicity for Marilyn Monroe who died in 1962 when neither state recognized postmortem rights of publicity. *See Shaw Family Archives Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309 (S.D.N.Y. 2007), and the pending *The Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, No. 2:05-CV-2200 (C.D. Cal., filed March 25, 2005). The California legislation promises to spawn more litigation.

These and other developments warrant a review of publicity rights.

I. DEFINITIONS AND DESCRIPTIONS.

A right of publicity is the right of each person to control the commercial use of his or her identity and persona, such as name, voice, signature, photograph and likeness.

In this context, "right of persona," "right of personality" and "right of publicity" are used interchangeably. What is at issue is the right to control whatever commercial or "publicity" value might attach to or be derived from a person's identity, personality or persona.

II. LEGAL ANTECEDENTS.

A. Right of Privacy.

Most states recognize, in some form, most or all of the four rights of privacy, the fourth of which is the right to be free from the unauthorized use of one's identity for the benefit of another person. *See* William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960). Violation of this right, which was adopted by the RESTATEMENT (SECOND) OF TORTS, is frequently called the tort of "appropriation." This tort is generally thought to be the principal antecedent of the right of publicity. *See* 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §§ 1:15, 28:6 (Rev. 2007). The RESTATEMENT (SECOND) OF TORTS § 652C (1977) provides that: "One who appropriates to his own use or benefit the names or likeness of another is subject to liability to the other for invasion of his privacy."

Washington courts have recognized and articulated the four distinct privacy rights first enunciated by Prosser. *See, e.g., Eastwood v. Cascade Broadcasting Co.*, 106 Wn.2d 466, 722 P.2d 1295 (1986); *Mark v. Seattle Times*, 96 Wn.2d 473, 635 P.2d 1081 (1981), *cert. denied*, 457 U.S. 1124, 102 S. Ct. 2942, 73 L. Ed. 2d 1339 (1982); *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 A.D. 459, 7 N.Y.S.2d 845 (1st Dep't 1938); *Marcraft Recreation Corp. v. Francis Devlin Co., Inc.*, 506 F. Supp. 1081 (S.D.N.Y. 1981).

B. The Right to the Publicity Value of a Performance.

In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977), the Court rejected an argument that under the First and Fourteenth Amendments

to the U.S. Constitution, the defendant enjoyed a constitutional privilege to film and broadcast a performer's entire act in violation of Ohio's common-law right of publicity. While recognizing, explicitly, that the right of privacy was a state law, the opinion analogized Ohio's right of publicity, as applied in that case, to federal patent and copyright laws.

C. Copyright and Trademark Concepts.

The right of publicity laws of states such as California reflect copyright principles. Other states such as Tennessee incorporate trademark concepts in their laws.

III. WASHINGTON LAW.

Washington courts have generally recognized the existence of common-law privacy rights, the fourth of which is the right not to have one's identity misappropriated for commercial purposes without authorization. Nevertheless, Washington courts never recognized a right of "publicity" under Washington law. *See, e.g., Joplin Enterprises v. Allen*, 795 F. Supp. 349, 351 (W.D. Wash. 1992):

This court is not willing to extrapolate, from Washington's recognition of a right to privacy, a descendible right of publicity applicable to this case or a remedy for interference with such a right under Washington law, especially given the fact that the Washington State Constitution places an even higher value upon the principle of free speech than the Federal Constitution.

A. Principal Provisions of RCW 63.60.

Every natural person has a property right in the use of his or her name, voice, image or other specified indicia of his or her unique persona. This right is an intangible personal property right that is freely transferable by *inter vivos* or testamentary transfer. The right survives the person's death regardless of whether it was exploited during his or her lifetime. RCW 63.60.010, .020 and .030.

For most persons, the right lasts for ten years after the person's death. However, for individuals whose "personas" have commercial value, the right lasts for 75 years after death. RCW 63.60.040.

Any person who, without consent, uses or authorizes the use of a natural person's name, voice, signature, photograph or likeness on tangible products or to advertise tangible products or services, or for fund raising or solicitation of donations, has infringed the right. In order to preclude an argument that has surfaced in other jurisdictions, Washington law makes it clear that a charitable purpose does not excuse an otherwise infringing use or activity. RCW 63.60.050.

Washington's Superior Courts are authorized to grant injunctions against infringement and have available a broad array of non-exclusive remedies for infringement, including destruction of the infringing material and statutory damages of \$1,500. Reasonable attorneys' fees, expenses and court costs may be recovered by the prevailing party. RCW 63.60.060.

There are several defenses (including comment, criticism, satire and parody, relating to matters of cultural, historical, political, religious, educational, newsworthy or public interest) that accommodate the freedom of expression guarantees of the United States and Washington constitutions. Adapting one of the holdings of *New York Times Co. v. Sullivan*, 376 U.S. 254, 266, 84 S. Ct. 710, 11 L. Ed. 2d 686 (1964), RCW 63.60.070 makes it clear that protected expression does not lose its protection merely because it is presented in the form of a paid advertisement. RCW 63.60.070(2).

RCW 63.60.070(2) elaborates upon certain of these defenses and specifies several highly specific “safe harbors”: Single and original works of fine art not published in more than five copies and advertisements and sales of rare or fine products are excluded from the Act’s reach. Thus, an oil portrait of Elvis Presley, a sculpture of John Denver or a photograph of Ken Griffey Jr. (not published in more than five copies) would not be subject to the Act and therefore would not require the subject’s consent or constitute an infringement if published without consent. Similarly, literary works, theatrical works, musical compositions, films, radio, online and television programs, magazine articles, news stories, public affairs reports, sports broadcasts and accounts and political campaigns also are excluded from the Act’s ambit, so long as the use of the indicia of personality does not inaccurately claim or suggest an endorsement. An advertisement for any of the foregoing is also not subject to a claim of infringement.

RCW 63.60.070(3) precludes class actions. RCW 63.60.070(4) provides media protection and RCW 63.60.070(5) and (6) provide defenses for merely descriptive and/or incidental uses.

Washington law does not expressly address a number of important issues such as: (1) which states’ substantive law should be selected when a non-resident files an infringement claim in Washington; (2) how courts should decide whether protected indicia of persona are single or community property; (3) the relationship among Washington personality rights and copyright, trademark and unfair competition laws; (4) whether an alleged infringement that is outside the explicit safe harbors of RCW 63.60.070(2) may nevertheless be defended under the broad defenses of RCW 63.60.070(1); and (5) how courts should decide (a) whether an allegedly infringing use is “merely descriptive and used fairly and in good faith only to identify or describe something other than the individual or personality,” *see* RCW 63.60.070(5); (b) whether the allegedly infringing use is an “insignificant, de minimus, or incidental use,” *see* RCW 63.60.070(6); (c) whether an indicia of persona that is asserted to be part of an infringing use is in fact identifiable with the plaintiff; (d) whether the principal purpose of an advertisement is to “comment” on a matter of protected speech; or (e) whether RCW 63.60.070(1) provides a defense to an advertisement for an Elvis Presley imitation.

Answers to these and other questions will undoubtedly be addressed over time by the courts.

IV. HOW DOES WASHINGTON’S STATUTE COMPARE WITH THE LAWS OF OTHER STATES?

More than half of the states have some form of statutory and/or common-law protection for the right of publicity; eighteen have some form of statutory protection: California (enacted

1972, revised 1985, 2007 (effective January 1, 2008)); Florida (enacted 1967); Illinois (enacted 1999); Indiana (enacted 1994); Kentucky (enacted 1984); Massachusetts (enacted 1974); Nebraska (enacted 1979); Nevada (enacted 1989); New York (enacted 1903, revised 1983); Ohio (enacted 1999); Oklahoma (enacted 1955, revised 1986); Rhode Island (enacted 1972, revised 1980); Tennessee (enacted 1984); Texas (enacted 1987); Utah (enacted 1909, revised 1981); Virginia (enacted 1904, revised 1977); Washington (enacted 1998); Wisconsin (enacted 1977).

There is no federal statute.

Substantial differences are apparent in the ways various states deal with the following issues: protected indicia; effect on non-famous persons; exploitation requirement; registration requirement; transferability; coverage of prior deceased; duration; type of consent required; prohibited uses; defenses and exemptions; and remedies. Some of these issues are highlighted below.

- **Duration.**

The duration of post mortem rights vary, ranging up to 100 years (Indiana and Oklahoma). Tennessee law protects publicity rights indefinitely, so long as continuous commercial use is made of the persona. Washington law provides a 10 year post mortem right for individuals and 75 years for those whose persona rights have commercial value. While there is no requirement of exploitation during a lifetime, as a practical matter, demonstrating commercial value may be easier if there is a track record.

- **Retroactivity.**

Indiana is the most generous state on this point, giving protection to persons who died at the beginning of last century. Washington's statute applies retroactively to persons who died within 50 years prior to enactment.

- **Damages.**

Most states that statutorily protect publicity rights provide for punitive, exemplary or treble damages; these states include California, Florida, Indiana, Massachusetts, Nevada, New York, Oklahoma, Rhode Island, Texas, Utah and Virginia. *See, e.g., Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (under California law, \$2.5 million in damages were awarded for the use of a sound-alike of singer Tom Waits in a Frito-Lay commercial), *cert. denied*, 506 U.S. 1080, 113 S. Ct. 1047, 122 L. Ed. 2d 355 (1993). Washington provides for minimum or statutory damages of \$1,500, but not for punitive damages. Comparable damage provisions in other states range from \$750 in California and Nevada to \$2,500 in Texas.

- **Registration.**

Washington makes no provision for registration of rights of publicity. Four other states (California, Oklahoma, Nevada and Texas) provide for registration of the publicity rights of

deceased individuals, thereby permitting registrants to put the public on notice as to who claims ownership of the rights and from whom consent must be obtained.

- **Consent.**

In every state, a person who wishes to use another's name, likeness, or other aspect of identity can do so if he or she obtains that person's consent, and most statutes specify the type of consent required in that jurisdiction. Nine states (Indiana, Kentucky, Massachusetts, Nevada, New York, Rhode Island, Texas, Virginia and Wisconsin) require written consent. Seven states (California, Indiana, New York, Oklahoma, Tennessee, Virginia and Wisconsin) require that the consent be prior to the otherwise infringing use. Washington is one of only three states (the others being Utah and Nebraska) in which there is no statutory requirement that the consent be either in writing or prior to the allegedly infringing use.

No state other than Washington statutorily provides that consent that is only "implied" or "oral" is adequate. One consequence, albeit unintended, might be complaints by persons who do not actually object to a particular unconsented use of their persona, but fear that inaction might be subsequently construed as "implied" consent to something to which they do object.

- **Defenses.**

Throughout the country, wherever there are disputes about publicity rights, one of the most uncertain and controversial areas of dispute involves the assertion of First Amendment defenses to claims of infringement. Usually, the courts conduct a fact-specific balancing test that compares the competing interests of the person's right of publicity with the public's right to be informed. The outcome often depends upon where the use falls on the continuum ranging from "news" (like current events and political commentary) and "public interest" (like fiction or satire), to "commercial speech" (like advertising). Most courts will focus on the primary message of the work in question; if the purpose of the reference is to sell or advertise an unrelated product, it is likely the work will be considered commercial speech and granted little or no First Amendment protection. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (trier of fact could reasonably conclude that rapper's song bearing as its title the name of civil rights icon Rosa Parks was a "disguised commercial advertisement"), *quoting Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989); *White v. Samsung Electronics Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied en banc*, 989 F.2d 1512 (9th Cir. 1993), *cert. denied*, 508 U.S. 951, 113 S. Ct. 2443, 124 L. Ed. 2d 660 (1993). In contrast, if the principal purpose of the reference seems to be art, parody or political speech, rather than to advertise an unrelated product, the courts are more likely to find that the First Amendment prevails. *See, e.g., ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003) (Tiger Woods' right of publicity yields to artist's First Amendment right to sell limited edition prints "The Masters of Augusta"); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (parody baseball cards protected by First Amendment); *Frazier v. Boomsma*, No. CV07-08040-PHX-NVW, 2007 WL 2808559, 84 U.S.P.Q.2d 1779 (D. Ariz. Sept. 27, 2007) (sale of t-shirts, buttons, magnets and bumper stickers expressing views on political topics protected by First Amendment notwithstanding the fact they bore names of soldiers killed in Iraq and that the Arizona legislature had passed special right of publicity protections for deceased American soldiers).

News media have been given particularly wide latitude in publishing people's names and likenesses in contexts that have any arguable connection with news gathering and reporting. *See, e.g., Walter v. NBC Television Network, Inc., et al.*, 27 A.D.3d 1069 (2006) (newsworthiness exception should be broadly construed in a comedy routine – in this case, the “headlines” segment of *The Tonight Show* – “may fall within the ambit of the newsworthiness exception”); *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 40 Cal. Rptr. 2d 639 (1995); *Namath v. Sports Illustrated*, 80 Misc.2d 531, 363 N.Y.S.2d 276 (1975). There is, however, no First Amendment right to sell photographs of naked news anchors. *Bosley v. Wildwett.com*, 310 F. Supp. 2d 914 (N.D. Ohio 2004).

The following are examples of cases in which the First Amendment trumped the plaintiff's right of publicity: *C.B.C. Distrib. and Mktg., Inc. v. Major League Baseball Advanced Media L.P.*, 505 F.3d 818 (8th Cir. 2007); *New Kids on the Block v. News America Pub., Inc.*, 745 F. Supp. 1540 (C.D. Cal. 1990), *aff'd*, 971 F.2d 302 (9th Cir. 1992) (the use by a newspaper and magazine of the “New Kids on the Block” trademark in connection with a “900-number” phone service to conduct polls regarding readers' favorite and “sexiest” members of the musical group); *Elvis Presley Enterprises, Inc. v. Capece*, 950 F. Supp. 783 (S.D. Tex. 1996) (use of the trade name “The Velvet Elvis” by a nightclub, and its selling of frozen drinks called “Love Me Blenders” and a food item named “Your Football Hound Dog”); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978) (a fictionalized account of the life of Agatha Christie); *Jackson v. MPI Home Video*, 694 F. Supp. 483 (N.D. Ill. 1988) (a videotape of a speech by Jesse Jackson); *Stern v. Delphi Internet Services Corp.*, 165 Misc.2d 21, 626 N.Y.S.2d 694 (N.Y. Sup. Ct. 1995) (defendant was allowed to use an outlandish photograph of the backside of controversial talk-show host Howard Stern in an advertisement for online bulletin board service); *Frosch v. Grosset & Dunlap, Inc.*, 75 A.D.2d 768, 427 N.Y.S.2d 828 (1980) (a photo biography of Marilyn Monroe by Norman Mailer).

In other cases, the court has rejected a First Amendment defense: *Zacchini v. Scripps-Howard Broadcasting*, 433 U.S. 562, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977) (use of a person's entire performance as a human cannonball in a news program); and *White v. Samsung Electronics Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied en banc*, 989 F.2d 1512 (9th Cir. 1993), *cert. denied*, 508 U.S. 951, 113 S. Ct. 2443, 124 L. Ed. 2d 660 (1993) (an advertisement showing a robot dressed in a costume and wig resembling Vanna White posing next to a game board like that of the renowned *Wheel of Fortune* game show).

Most states that statutorily protect publicity rights also provide for some type of media or constitutionally required defenses: California, Florida, Indiana, Nebraska, Nevada, Oklahoma, Tennessee, Texas and Wisconsin. However, no state other than Washington has such a long list of statutory defenses and express safe harbors. Similarly, although courts in other jurisdictions have dismissed claims of infringement on the grounds that the alleged infringing use was merely “incidental,” no state other than Washington makes “incidental use” a statutory defense to an infringement claim. This is also true of the “merely descriptive” defense of RCW 63.60.070(5) which is derived in part from established defenses to claims of trademark infringement.

V. PREEMPTION BY COPYRIGHT LAW.

Since the right of publicity arises under state laws, and often appears in connection with the reproduction or distribution of pictures or performances, or in other contexts in which the law of copyright applies, an interesting and sometimes difficult body of case law has developed that addresses the potential preemption by the federal Copyright Act of state right of publicity claims. Under the supremacy clause of the U.S. Constitution, if there is a direct conflict between federal law and state law, then federal law controls. U.S. CONST., art. VI. In most cases, right of publicity claims have survived the challenge that they are preempted by the provisions of the Copyright Act, but a few courts have held that certain claims are preempted by federal law.

A. The Statutory Standard.

When Congress amended the Copyright Act in 1976, it enacted Section 301(a) and (b) to provide for the explicit preemption of certain types of state law claims that are related to copyright. Section 301(a) of the Copyright Act provides a two-level test for preemption of state claims; there is preemption if: (1) the state right is “equivalent” to the exclusive rights of a federal copyright; *and* (2) the state right is “within the subject matter of copyright” as defined by the [Copyright] Act. 17 U.S.C. § 301. Application of the standard is fact specific.

1. Use of Names.

A claim for violation of a right of publicity in connection with use of an individual’s name should not be subject to preemption. *See Ippolito v. Ono-Lennon*, 139 Misc.2d 230, 526 N.Y.S.2d 877, 882 (N.Y. Sup. Ct. 1988) (holding no preemption because claim under New York’s right of privacy/publicity statute involved “something more than rights equivalent to those under the Federal Copyright Act”), *aff’d*, 150 A.D.2d 300, 542 N.Y.S.2d 3 (App. Div. 1989).

2. Use of Still Images.

Similarly, claims arising from use of a photograph, likeness or other still image should not be subject to preemption by the Copyright Act. *See, e.g., Shamsky v. Garan, Inc.*, 167 Misc. 2d 149, 632 N.Y.S.2d 930 (1995) (holding that copyright law does not preempt claims of athletes against the unauthorized use of their photos on jerseys); *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005) (copyright did not preempt Ms. Toney’s claim that defendants continued to use her image beyond the expiration of their license).

3. Use of Voices.

The Ninth Circuit has held in two notable cases that the right of publicity claim of a distinctive singer against those who use sound-alike performers in recorded music is not preempted by the Copyright Act. *See Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (holding that Bette Midler’s common law claim was not preempted, as her voice *per se* was not copyrightable); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (following *Midler*, and holding the Tom Waits’s claim was not preempted, because the elements of his claim were

different in kind from a copyright infringement case challenging the unauthorized use of a song or recording). *But see Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134 (9th Cir. 2006) (California statutory right of publicity preempted by the Copyright Act as applied to the particular facts because subject matter of a right of publicity in one's voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording). In *Laws*, the court distinguished *Midler* and *Waits* as cases in which the licensing party obtained only a license to the song and then imitated the artist's voice, rather than obtaining a license to use the artist's recording itself.

4. Use of "Performance Values."

In the controversial *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), major league baseball players claimed that although the baseball teams owned the copyright to the telecasts of the games, broadcast of the players' performance without their express written consent violated their rights of publicity in their performances. The Seventh Circuit held that both conditions of preemption under § 301 of the Copyright Act, were satisfied; the claimed right was equivalent to the rights encompassed in a copyright, and the claimed right fell within the subject matter of copyright.

In *Stanford v. Caesars Entertainment, Inc.*, 430 F. Supp. 2d 749 (W.D. Tenn. 2006) the court held that Crisper Stanford's right of publicity claims were preempted because it was not the plaintiff's image, voice, likeness and persona that were at issue, but rather plaintiff's role as the fictional character "Loose Slot Louie." Plaintiff's performance as this character was a dramatic work fixed in a tangible medium of expression and fell squarely within the ambit of copyright law and thus, the subject matter and equivalency requirements of preemption were met.