

# THE RIGHT OF PUBLICITY AND CYBERSPACE

By Jonathan S. Jennings

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## Introduction

The right of publicity is recognized in twenty-eight states. The scope of these laws varies widely from state to state. In general, the right protects against the unauthorized commercial use of an individual's identity (e.g., name, image, voice) and is a property right that can be assigned or licensed. In many, but not all states, the right extends post-mortem for a defined period of time.

Because the Internet is a medium that does not recognize state boundaries, it is a challenge under the current state-based regime for individuals to protect against the unauthorized use of their identities and for companies to use these identities in advertising without facing potential liability. A federal statute governing the right of publicity such as the one being proposed by the Intellectual Property Section of the American Bar Association, but not yet adopted by the ABA as a whole, would help to address these concerns by bringing uniformity and clarity to this area of law.

This paper begins with a brief overview of the development of right of publicity law over the last fifty years. Then follows a discussion of the challenges in protecting one's right of publicity in the Internet era under the current state-based regime, including a review of right of publicity litigation involving the Internet, and a summary of practical tips for using individuals' identities in cyberspace without incurring substantial risk. The paper concludes with a brief description of how a federal statute would help in protecting and clarifying the application of right of publicity law in cyberspace.

## Background On The Right Of Publicity

The right of publicity is “the right of every person to control the commercial use of his or her identity.”<sup>1</sup> The property aspect of this right is the principal distinguishing feature from the right of privacy, which is a personal right. For example, the right of privacy protects an individual's dignity interests and is never descendible. By contrast, the majority of states that have addressed the right of publicity have recognized that, as a property right, it does extend post-mortem.

The right of publicity was first recognized in 1953 by the Second Circuit interpreting New York law in *Haelan Laboratories v. Topps Chewing Gum*.<sup>2</sup> The dispute in *Haelan* involved the plaintiff gum company's claim that defendant, also a chewing gum company, had improperly induced professional baseball players to breach their contracts with plaintiff. In these contracts,

the players had granted the plaintiff gum company the exclusive use of their photographs in connection with the sale of baseball cards with gum and had agreed not to grant similar rights to other gum companies. Defendant challenged the validity of the contracts on the grounds that they were merely waivers of right of privacy liability, and that the right of privacy itself was nontransferable. The court disagreed and coined a “right of publicity” that exists apart from the right of privacy. A person has an alienable right to the publicity value of one’s photo, the court explained.<sup>3</sup> The court in *Haelen* did not label the right of publicity a property right, but it clearly distinguished this right from the right of privacy and rights conferred by trademark law.

Six years later, Professor Prosser clarified this distinction when he published his influential article, “Privacy,”<sup>4</sup> organizing the right of privacy doctrine into four distinct torts: (1) unreasonable intrusion upon another’s seclusion; (2) public disclosure of private facts; (3) false light invasion of privacy; and (4) appropriation of another’s name or likeness. This was an important article because it recognized “identity appropriation,” otherwise known as one’s “right of publicity,” as a separate cause of action protecting both commercial and personal interests.

In the 1970’s state codification of the right of publicity progressed rapidly. California enacted its statute in 1971.<sup>5</sup> Rhode Island adopted the right in 1972.<sup>6</sup> Massachusetts followed in 1973.<sup>7</sup> Virginia revised its 1907 appropriation statute in 1977.<sup>8</sup> Other state statutes enacted around this time include: Wisconsin in 1977,<sup>9</sup> and Nebraska in 1979.<sup>10</sup>

In 1977, the United States Supreme Court first acknowledged the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>11</sup> Though a narrow holding on the scope of this right under Ohio common law, *Zacchini* does differentiate the right of publicity from false light invasion of privacy and from defamation, and notes that state-law publicity rights create an economic incentive for performers. The Court in *Zacchini* also held that there is no inherent conflict between the right of publicity and the First Amendment.<sup>12</sup>

The number of reported cases dealing with a right of publicity grew steadily during the 1980s and 90s. In 1982, the Georgia Supreme Court considered whether the estate of Martin Luther King, Jr. could recover for the unauthorized production and sale of busts crafted in King’s image.<sup>13</sup> The court held that the right of publicity was descendible, extended to celebrities and non-celebrities alike, and protected public and political figures in commercial uses not otherwise protected by the First Amendment. This case is an important example of how the right of publicity and First Amendment principles coexist.

In 1983, the Sixth Circuit in *Carson v. Here’s Johnny Portable Toilets*<sup>14</sup> upheld the dismissal of unfair competition and invasion of privacy claims, but reversed the district court’s finding that defendant’s use of “Here’s Johnny” for portable toilets did not use Carson’s name or likeness in a way that would specifically identify Carson. The Sixth Circuit, applying Michigan law, reversed the district court’s overly narrow definition and held that “a celebrity’s legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes.”<sup>15</sup> The court in this case recognized that someone can be identified even when an entire name is not used.

The Ninth Circuit in 1988 concluded in *Midler v. Ford Motor Co.* that California law protected against voice misappropriation.<sup>16</sup> The court reversed summary judgment for Ford, stating that Ford’s use of a Midler sound-alike in its commercials – after Midler turned down the job – helped to show that Midler’s identity had been misappropriated. With this case, the identity right, this time in the form of one’s distinctive voice, expanded even further.

In 1992, the Ninth Circuit in *White v. Samsung Elec. Am., Inc.*, determined that under California common law, but not statutory law, the right of publicity protected a combination of

elements – namely, a robot wearing a wig, dress, and using gestures evocative of plaintiff Vanna White, in a set much like the *Wheel of Fortune* set—that were “meant to depict” her.<sup>17</sup> Defendant Samsung used the image of the robot to advertise its VCRs in a humorous manner meant to show what the future would be like and to indicate that Samsung VCRs would still be around. This case has been criticized as an unreasonable expansion of the identity right on the grounds that the robot at issue merely evoked rather than identified Vanna White and the robot itself could not be connected to Vanna White without including the set and wheel.<sup>18</sup> By stretching the concept of identity so far, the court arguably unduly restricted the possibilities for legitimate commercial parodies.

Robots returned in a case involving defendants’ use of robots in bars that resembled plaintiff actors who had portrayed characters in the sitcom *Cheers*.<sup>19</sup> Plaintiffs in that case conceded that they had no rights to the *Cheers* characters; rather they claimed that the robots appropriated their personal rather than fictional identities. The court remanded the case to the district court for a determination of whether the robots indeed looked like the plaintiffs. Ultimately, the case settled. Distinguishing between an individual's own identity and the role the individual may play is a difficult task.<sup>20</sup> Nonetheless, like the Vanna White case, this decision has been criticized as stretching the identity right too far in recognizing a potential cause of action when the fictional character was not owned by the plaintiffs.

A few courts have found the right of publicity to be preempted by copyright law in certain circumstances.<sup>21</sup> Most courts, however, have not found this to be the case, because the right of publicity, with its focus on protecting someone's persona, is a separate right distinguishable from the scope of copyright law which protects works fixed in a tangible medium.<sup>22</sup> Nevertheless, this remains an issue that might be raised in a dispute over the use of someone's identity on the Internet.

Earlier this year, Spike Lee obtained a preliminary injunction against the use of "Spike TV" for a television network on the basis that this name identified him,<sup>23</sup> and Tiger Woods lost in his attempt to stop a sports artist from selling thousands of copies of his image.<sup>24</sup> These cases show the range of results that occur when an individual's identity is used in more traditional media – a spectrum that is magnified on the Internet.

Overall, the history of the right of publicity indicates a steady growth in its adoption and enforcement over the last fifty years, beginning with *Haelen* and extending through *Wendt* and other cases discussed below. However, the right has grown in fits and starts, is still not recognized in many states, and has resulted in a confusing patchwork. This patchwork becomes more difficult to navigate when the identity right at issue is used on the Internet.

## **Right of Publicity Problems In The Internet Era**

The Internet poses a challenge to the current right of publicity regime because this regime is based on individual state statutory and common law rights. Currently, 18 states have codified the right and an additional 10 states recognize the right solely under common law; 22 states either do not recognize the right at all or have not addressed the subject. No state currently rejects the right of publicity on policy grounds and the clear trend among states is to adopt the right.<sup>25</sup> Thus, the right of publicity is well established.<sup>26</sup>

The problem is that state laws vary widely, leaving some individuals with extensive rights and others that are similarly situated with no rights. For example, some state laws require commercial value to inhere in the appropriated image before one can bring suit.<sup>27</sup> The majority

rule, however, is that such value is either unnecessary or presumed.<sup>28</sup> Even within a single state, such as California, there are differences in the scope of the common law and statutory right of publicity that can lead to different results under each set of laws.<sup>29</sup>

The differences among state laws are even more pronounced when considering post-mortem rights. There is no standard duration for post-mortem rights of publicity under current state statutes: either 10 years or—if continuously used in commerce—eternally,<sup>30</sup> 20 years,<sup>31</sup> 50 years,<sup>32</sup> 60 years,<sup>33</sup> 70 years,<sup>34</sup> and even 100 years.<sup>35</sup> Further, the common law in some states recognizes the survivability of the right, but does not specify its duration.<sup>36</sup> In New York and Wisconsin, the right covers only living persons.<sup>37</sup> In states that have not addressed the subject, the scope of post-mortem rights is anyone's guess. Currently, some otherwise similarly situated individuals have no post-mortem rights, some have uncertain rights, and still others have extensive rights depending upon which state's law applies to them.

Some state statutes also are complicated by reach-back provisions that extend the post-mortem right of publicity for a certain period of time prior to the enactment of the statute to cover those who died before it came into effect. For example, Washington's statute "reaches back" 10 years to cover personalities that had no commercial value at the time of death, but 75 years if they had such value.<sup>38</sup> Texas<sup>39</sup> reaches back for 50 years. California<sup>40</sup> reaches back 70 years, and Indiana<sup>41</sup> arguably reaches back a whopping 100 years to potentially cover the heirs of Mark Twain/Samuel Clemens, who died in 1910! Illinois,<sup>42</sup> by contrast, does not have a reach-back provision for its post-mortem right. Long reach-back provisions make determining the disposition of post-mortem rights difficult because a long deceased individual probably made no estate plans for a right that may not have existed during his or her lifetime. Additionally, over time, records concerning heirs are lost.

The differences in state right of publicity laws governing post-mortem rights and the impact of cyberspace are exacerbated by the differing state conflict of laws rules. For example, the law of the state of the decedent's domicile at death generally determines whether a post-mortem right of publicity exists.<sup>43</sup> Other states, however, have applied the law of the state in which the tort occurred.<sup>44</sup> Therefore, determining which state's laws apply to a deceased individual is an uncertain process made more difficult if that individual, as many celebrities do, owned many residences in different states and countries at the time of his or her death. The Internet also raises right of publicity choice of law questions on an international level because, of course, Web sites bearing someone's identity can be seen anywhere. For example, the trustees of the Diana Princess of Wales Memorial Fund brought a right of publicity action, *inter alia*, to enforce Princess Diana's post-mortem rights based on the defendant's sale of jewelry, plates, and dolls bearing the Princess's name and likeness. Applying California law, the Ninth Circuit affirmed the finding that the claim failed because Great Britain, the Princess's domicile at the time of her death, did not recognize a post-mortem right. While this was not an Internet case, it illustrates the complexities of jurisdictional and choice of law issues that are commonly faced in cases involving Internet usage. Even when a court decides which state's law applies, it usually struggles over the scope of the injunction. Even within the same circuit, courts have differed about the scope of injunctions in right of publicity cases.<sup>45</sup> As noted by Eric J. Goodman in his article entitled *A National Identity Crisis: The Need For a Federal Right of Publicity Statute*:

There is also a question of whether an injunction issued under one state's law will have any effect on activities in another state. An injunction may easily be obtained in Tennessee, but it is not clear how far that injunction will reach. In New York, for

example, courts have held that the state's publicity law does not extend to violations involving out-of-state sales. Lawyers cannot give their clients anything even resembling an unqualified opinion under the current scheme of various state laws.<sup>46</sup>

Overall, the disparity in state law impacts potential defendants as much as potential plaintiffs. With national advertising and the Internet, the right of publicity laws of all states come into play. Consider a firm preparing a national marketing campaign. Not only must that firm review potential liability along the axis of states that do and do not recognize the right, but it also must consider how the variation in the contours of the right from state to state impacts that potential liability, and then consider how states' different conflict of laws rules further complicate the matter. "It has become very difficult for lawyers to properly advise their clients on right of publicity matters because parties tend to forum shop."<sup>47</sup> Given this complexity, companies and advertising firms face unpredictable outcomes in potential litigation over the use of names, photographs, voices, or other indicators of an individual's identity when they have not sought the individual's consent. This is especially so when identities are used on the Internet where it is often unclear what state's laws apply.

### **Right of Publicity Litigation Involving The Internet**

The ease of establishing a Web presence has increased the possibilities for more individuals to exploit their identity rights for commercial gain while also leaving them vulnerable to having others exploit them as well. Most of the reported cases do not involve the right of publicity on the Internet directly, but raise issues that affect the use of identity rights in any media. One fairly straightforward case that did involve the right of publicity on the Internet is *Perfect 10, Inc. v. Talisman Communications Inc.*<sup>48</sup> In that case, the court entered a default judgment and found that the defendant violated the plaintiff's right of publicity under the California statute when it posted nude photographs of models from plaintiff's magazine onto defendant's pornographic Web site. The models had all assigned their publicity rights in the photographs to Perfect 10. (The issue of assignments and licenses is covered in more detail below).

The development of computer animation and other methods of altering images using computers raises fundamental questions about whether someone is identifiable on the Internet and whether the right of publicity is implicated. *Pesina v. Midway Manufacturing Co.* was an early case involving computer animation in which the plaintiff brought an action based on the use of his distinctive martial arts style.<sup>49</sup> The plaintiff had modeled his moves, which were captured on a computer, for an arcade game. The arcade game was later reformatted for in-home versions and the plaintiff brought suit alleging the violation of his right of publicity. The court granted the defendant's summary judgment motion on the grounds that plaintiff's likeness lacked commercial value prior to the defendant's use, and that the likeness was not sufficiently recognizable. Even though *Pesina* was unsuccessful, it is easy to imagine a case in which the use of animation strays across the line and constitutes unlawful use of a person's identity. The ability to alter an individual's image also raises challenges in determining whether someone is identifiable on a Web site. The risk of liability often can be lessened by altering someone's image so that it is unrecognizable as long as that alteration in turn does not violate some other law or right, e.g., copyright, moral rights, false light right of privacy, contractual right, etc.

In the context of the Internet, when Web sites are linked, framed, or hosted with a range of ever-changing content, there also exists the potential for "secondary liability" under right of publicity law. For instance, two years after the *Talisman* case, Perfect 10 was back in the Central District of California with another case in which it sued for a violation of its models' rights of publicity that it had obtained through assignments.<sup>50</sup> In particular, Perfect 10 was suing a party that operated an adult verification system, which allowed users to access, for a fee, thousands of third-party pornographic sites on the Internet. The defendant was not sued for a direct violation of the plaintiff's right of publicity. Instead, Perfect 10 asserted that the defendant was guilty of aiding and abetting the infringement under a theory of secondary liability because some of the Perfect 10's models' pictures were posted on the third-party Web sites without Perfect 10's permission. The court granted a preliminary injunction based on a "strong likelihood that Perfect 10 [would] succeed on its unfair competition claim to the extent it predicated liability on an aiding and abetting theory for the violation of Perfect 10's rights of publicity."<sup>51</sup> An interesting aspect of this case was that Perfect 10 was found to have standing to assert the rights of publicity for third-party celebrities who had not assigned their rights to Perfect 10 but who had complained to the defendant about the unauthorized posting of fake nude pictures. The court noted the competition between Perfect 10 and the defendant as one of the factors considered in arriving at this decision.<sup>52</sup> The court also found that Perfect 10 could enjoin defendant over the third-party rights because the interests of Perfect 10 and the third parties were sufficiently aligned and Perfect 10 already had identified the offending photographs which would be difficult for the third parties to accomplish on their own.<sup>53</sup>

Finally, while not strictly a right of publicity law, the Intellectual Property and Communications Omnibus Reform Act of 1999, enacted on November 29, 1999, and codified at 15 U.S.C. § 1129, creates a civil action against the act of registering someone else's name as a domain name with the intent to sell that domain name either back to the person with that name or to a third party for a profit. The Act applies only to domain names registered on or after November 29, 1999. If, however, a domain name that is registered before this date is later re-registered to a new entity, the Act will apply.<sup>54</sup>

### **Practical Tips For The Web Site Use Of Individuals' Identities**

The easiest way to avoid problems on the Internet is to obtain the right to use someone's identity through an assignment or license. Assignments and licenses are the means by which celebrities profit from the right of publicity.<sup>55</sup> In drafting any assignment or license agreement concerning the right of publicity,<sup>56</sup> it is important to properly define its scope, including: (1) the territory covered, such as the Internet as a whole or just particular Web sites; (2) the products or services in connection with which the identity can be used; (3) the particular identity right covered—such as voice or just image; (4) the duration of the license, whether it is exclusive, or non-exclusive and whether the licensee can sublicense or assign its rights; and (5) whether the rights involved extend post-mortem. It is also important to specify the state law governing the agreement.

Owners of Web sites that post people's photographs should have a procedure in place to obtain permission from the person photographed (for copyright law, the Web site owner also would need to have the permission of the photographer or owner of the copyright in the photograph). The right of publicity laws of several states require written and signed consents, including Illinois, Massachusetts, New York, Rhode Island, Virginia, and Wisconsin. Apart

from those six states, other states either do not require a signed document for consent or simply have yet to address the issue. Overall, it is advisable to memorialize an agreement in writing to avoid disputes over its scope.

For Web sites that post names, photographs, or other aspects of identity submitted by Internet users, *e.g.*, matchmaking sites, it is particularly important to have an effective consent procedure that is not too cumbersome. A Web site operator can use a click-wrap<sup>57</sup> license/consent form that is electronically signed by those submitting photographs.<sup>58</sup> A verification system that confirms that the person portrayed or named in the photograph is in fact the person submitting the photograph and executing the consent form also will help to lessen the risk of fraudulent submissions. Such verification systems may require credit card information from Internet users and data that links this information to their home addresses. For sites that do not charge a fee, however, an effective verification system can be difficult to implement. Web site operators usually include warranty and indemnity clauses in their terms of use; however, Internet users who submit fraudulent photographs usually are difficult to locate and probably judgment-proof.

A consent verification process probably would not shield a Web site operator from liability if that operator unwittingly posts someone's photograph without consent due to a forged consent form and false statements provided in the verification process. A court nonetheless may recognize the operator's innocent intent as a mitigating factor that will lead to a reduction of any damage award.<sup>59</sup> For example, in *Myers v. U.S. Camera Publishing Corp.*, the court recognized as a mitigating, but not excusing, factor, defendants' assumption that an agent who provided a picture had permission to do so; the court remanded the case to the trial court to determine how the damages should be affected.<sup>60</sup>

A consent verification procedure with obvious flaws, however, will not help. For example, in *Wood v. Hustler Magazine, Inc.*, the court found Hustler liable for an invasion of privacy for the magazine's use of nude pictures which were stolen from the plaintiff's house and subsequently submitted for publication.<sup>61</sup> Although Hustler had an informal consent verification procedure, the court found it to be inherently defective and ineffectively applied. The procedure involved verification by telephone that the person consented to the publication, but the procedure was easy to cheat because the same person who gave the fraudulent consent simply could give his own phone number and confirm that consent. In another Hustler case, although the Seventh Circuit reversed and remanded the case for a new trial, it recognized that plaintiff's right of publicity was violated when nude pictures of her appeared in Hustler instead of Playboy Magazine.<sup>62</sup> The plaintiff had consented to the use of her nude photographs only in Playboy, and Hustler had relied upon a forged release. Although these Hustler cases involved particularly sensitive subject matter, they do underscore the importance of a thorough consent verification system.

Apart from taking steps to avoid the type of fraudulent submissions found in the Hustler cases, it is also important to stay within the scope of a license. If a Web site operator obtains a license for the use of an image on its site, that same license may not permit the use of the image on another site even if there is some type of co-branding arrangement between the Web site operators.

Even with a written consent, absent some type of consideration the consent to use someone's right of publicity probably would be deemed gratuitous. Some courts have held that gratuitous consents are revocable at will.<sup>63</sup> This means that a Web site operator should be ready

to take down a photograph subject to a gratuitous consent as soon as it receives a credible objection to its use.

## **A Federal Right Of Publicity Statute Would Help In Cyberspace**

There is no federal right of publicity law. Such a law would bring uniformity, stability, and predictability to the current state-right regime - an important advancement especially in the Internet era. It also would solve the choice of law and copyright preemption problems encountered with state law.

Scholars have urged the adoption of a federal right of publicity. The leading commentator on right of publicity law and the author of a two volume treatise on the subject, Professor McCarthy, supports a federal right of publicity statute as have other scholars.<sup>64</sup> Courts appear to be hinting at the need for a federal statute. One court, noting the “general constitutional policy of maintaining uniformity in intellectual property laws... [gave] attention to the entire available body of case law” in deciding a right of publicity case.<sup>65</sup>

Finally, the preemption of state law through a federal statute is important. Preemption will create a consistent body of law that will help those who want to use another's identity right understand the risk involved. Without preemption, the addition of a federal right would merely further complicate an already confusing body of law by adding yet another layer to the mix.

## **Conclusion**

The right of publicity has become more of a concern to individuals seeking to protect their identities and for those seeking to use individuals' identities without incurring substantial risk. The Internet has both expanded the possibilities for individuals to exploit their identity rights, while at the same time creating new challenges for enforcement. A federal statute, such as the one being proposed by the Intellectual Property Law Section of the ABA, would help to resolve these problems.

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<sup>1</sup> J. Thomas McCarthy, *The Rights of Publicity and Privacy* 1:3 (2d ed. 2000).

<sup>2</sup> 202 F.2d 866 (2d Cir. 1953), cert. denied, 346 U.S. 816, 98 L. Ed. 343, 74 S. Ct. 26 (1953).

<sup>3</sup> *Id.* at 868.

<sup>4</sup> William L. Prosser, *Privacy*, 48 Calif L. Rev. 383 (1960).

<sup>5</sup> California Civil Code § 3344.

<sup>6</sup> Rhode Island § 9-1-28.

<sup>7</sup> Mass. Gen. Laws Ch. 214 § 3A.

<sup>8</sup> Va. Code Ann. § 8.01-40 (Michie 1999).

<sup>9</sup> Wis. Stat. § 895.50(b).

<sup>10</sup> Neb. Rev. Stat. § 20-202.

<sup>11</sup> 433 U.S. 562 (1977).

<sup>12</sup> 433 U.S. at 579 (holding that while Ohio may provide a privilege for the press in the circumstances at issue, “the First and Fourteenth Amendments do not require it to do so”).

<sup>13</sup> *Martin Luther King, Jr. Ctr. v. Am. Heritage Prods., Inc.*, 250 Ga. 135 (1982).

<sup>14</sup> 698 F.2d 831 (6<sup>th</sup> Cir. 1983).

<sup>15</sup> *Id.* at 837; *see also Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129, 137 (Wis. 1979)

(finding use of the name "Crazylegs" for female shaving gel violated the right of publicity of a professional football player known by that nickname).

<sup>16</sup> 849 F.2d 460 (9<sup>th</sup> Cir. 1988); *See also Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9<sup>th</sup> Cir. 1992).



- <sup>17</sup> *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395 (9<sup>th</sup> Cir. 1992); accord *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6<sup>th</sup> Cir. 2000) (recognizing the expanding scope of the Right that “is now generally understood to cover anything that suggests the plaintiff’s personal identity”).
- <sup>18</sup> See Judge Kozinski’s dissent in *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512 (9<sup>th</sup> Cir. 1992).
- <sup>19</sup> *Wendt v. Host Int’l, Inc.*, 125 F.3d 806 (9<sup>th</sup> Cir. 1997).
- <sup>20</sup> See *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994) (court reversed and remanded case for determination of whether McFarland’s individual identity had become inextricably linked to the character Spanky).
- <sup>21</sup> *Baltimore Orioles, Inc. v. Major League Baseball Player Ass’n*, 805 F.2d 663 (7<sup>th</sup> Cir. 1986); *Toney v. L’Oreal U.S.A., Inc.*, 2002 U.S. Dist. Lexis 21229 (N.D. Ill.).
- <sup>22</sup> See *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9<sup>th</sup> Cir. 2001).
- <sup>23</sup> *Spike Lee v. Viacom, Inc.*, No. 11008003 (New York 2003). This case has settled. See <http://stacks.msnbc.com/935945.asp>.
- <sup>24</sup> *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6<sup>th</sup> Cir. 2003).
- <sup>25</sup> 2 McCarthy Right of Publicity and Privacy § 6:3.
- <sup>26</sup> See *Restatement (Third) of Unfair Competition (1995) §46-49*.
- <sup>27</sup> See, e.g., *Cheatam v. Paisano Publications, Inc.*, 891 F. Supp. 381, 386 (W.D. Ky. 1995) (noting that plaintiffs do not need national celebrity but must show “significant ‘commercial value’”); accord *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6<sup>th</sup> Cir. 2000); *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40, 42 (N.D. Ill. 1996) (“There is no evidence that [plaintiff’s] name, likeness or persona had such [commercial] value prior to the plaintiff’s association with [the video game at issue]....”).
- <sup>28</sup> See, e.g., *Ainsworth v. Century Supply Co.*, 693 N.E.2d 610, 614 (Ill. App. 1998) (finding that plaintiff’s image conferred a benefit on defendant); 1 McCarthy § 4.1[C][3] (“[T]he majority and better view is that everyone, including the non-celebrity, does indeed have a Right of Publicity.”).
- <sup>29</sup> See *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395 (9<sup>th</sup> Cir. 1992) (finding no cause of action under the California statute, but recognizing one under California common law).
- <sup>30</sup> Tenn. Code Ann § 47-25-1101 (1984).
- <sup>31</sup> Va. Code Ann. § 8.01-40 (Michie 1999).
- <sup>32</sup> 765 Ill. Comp. Stat. Ann. 1075/1 et seq. (West 1999).
- <sup>33</sup> Ohio Rev. Code § 2741.01 (2000).
- <sup>34</sup> Cal. Civil Code §§ 3344, 3344.1 (Deering 2000).
- <sup>35</sup> Ind. Code § 32-13-1-8.
- <sup>36</sup> See, e.g., *Jim Henson Prod. v. John T. Brady & Assoc.*, 867 F.Supp. 175 (S.D.N.Y. 1994) (construing Connecticut law); *Martin Luther King Jr. Center v. Am. Heritage Prod., Inc.*, 296 S.E.2d 697 (Ga. 1982); *Nature’s Way Prod., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp. 245 (D. Utah 1990).
- <sup>37</sup> N.Y. Civ. Rights Law §§ 50-51; Wis. Stat. § 895.50; see *Heinz v. Frank Lloyd Wright Found.*, 229 U.S.P.Q. 201, 206 (W.D. Wis. 1986) (construing Wisconsin law).
- <sup>38</sup> Rev. Code Wash § 63.60.040 (2000).
- <sup>39</sup> Tex. Civ. Code Ann. § 26.003.
- <sup>40</sup> Cal. Civ. Code § 990.
- <sup>41</sup> Ind. Code § 32-13-1-8.
- <sup>42</sup> 765 Ill. 1075/1 et seq.
- <sup>43</sup> Restatement (Second) of Conflict of Laws § 260 (1971); *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317 (2d Cir. 1982); *Factors, Inc. v. Pro Arts Inc.*, 652 F.2d 278 (2d Cir. 1981); *Jim Henson Prods. v. John T. Brady & Assoc.*, 867 F. Supp. 175 (S.D.N.Y. 1994); *Joplin Enters. v. Allen*, 795 F. Supp. 349 (W.D. Wash. 1992); *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985).
- <sup>44</sup> See *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994); *Prima v. Darden Rest., Inc.*, 78 F. Supp. 2d 337 (D.N.J. 2000) (same); *Elvis Presley Enterp., Inc. v. Capece*, 950 F. Supp. 783, 800 (S.D. Tex. 1996).
- <sup>45</sup> Compare *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6<sup>th</sup> Cir. 1983) (nationwide injunction), and *Herman Miller v. Palazzetti Imports and Exports*, 270 F.3d 298, 327 (6<sup>th</sup> Cir. 2001) (injunction limited to certain states because of disparities in their laws).
- <sup>46</sup> 9 J. Art & Ent. Law 227, 244 (1999)
- <sup>47</sup> *Id.*
- <sup>48</sup> 2000 U.S. Dist. LEXIS 4564 (C.D. Cal. Mar. 27, 2000).
- <sup>49</sup> 948 F. Supp. 40 (N.D. Ill. 1996).
- <sup>50</sup> *Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146 (C.D. Cal. 2002).

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<sup>51</sup> *Id.* at 1184.

<sup>52</sup> *Id.* at 1185-86.

<sup>53</sup> *Id.* at 1186, fn. 32.

<sup>54</sup> *Schmidheiny v. Weber*, 319 F.3d 581 (3<sup>rd</sup> Cir. 2003).

<sup>55</sup> *See Martin Luther King, Jr., Ctr. for Social Change v. Am. Heritage Prod., Inc.*, 694 F.2d 674, 680 (11<sup>th</sup> Cir. 1983) ("the right of publicity is assignable during the life of the celebrity, for without this characteristic, full commercial exploitation of one's name and likeness is practically impossible.").

<sup>56</sup> Other laws are usually in play when considering right of publicity, such as copyright, right of privacy, including false light, libel, defamation, and unfair competition or trademark laws, that should be considered in drafting agreements or consent forms. The usual boilerplate clauses also should be considered such as those covering royalties or other payments, warranties, insurance, indemnities, termination for breach of contract, etc.

<sup>57</sup> Click-wrap agreements have routinely been upheld as valid contracts. *See Sprecht v. Netscape Communications Corp.*, 150 F. Supp. 2d 585, 593-95 (S.D.N.Y. 2001) (central to the validity of "click-through" agreements is the requirement of some affirmative step expressing a party's assent to an agreement before using software or Internet based-services such as domain name registration); *i.LAN Sys. Inc. v. Netscout Serv. Level Corp.*, 183 F.Supp.2d 328, 336 (D. Mass. 2002) ("If the proper analysis is pursuant to UCC section 2-204, the analysis is simple; i.LAN manifested assent to the clickwrap license agreement when it clicked on the box stating 'I agree,' so the agreement is enforceable.").

<sup>58</sup> In light of the Electronic Signatures in Global and National Commerce Act (the "E-Sign Act"), electronic consent should be sufficient even under the laws of states requiring written and signed consent for the right of publicity and privacy. The E-Sign Act preempts state laws unless (a) the state adopts the Uniform Electronic Transactions Act ("UETA") or (b) enacts its own state legislation regarding electronic transactions which is consistent with the E-Sign Act, does not give greater legal status to specific types of technologies or security measures, and references the E-Sign Act. In either scenario, the basic premise is that electronic consent is legally equivalent to written consent.

<sup>59</sup> For the right of publicity, damages are generally available for lost profits or actual economic harm, and, in egregious cases, for punitive damages and attorneys' fees and costs. Most states recognize the right of publicity even if the individual is not famous. Some states, however, do maintain this fame requirement and others also require that the claimant exploit this fame prior to bringing a suit. Overall, the recovery would be lower for an average person under right of publicity laws.

<sup>60</sup> 167 N.Y.S.2d 771 (N.Y. App. Div. 1957).

<sup>61</sup> 736 F.2d 1084 (5<sup>th</sup> Cir. 1984).

<sup>62</sup> *Douglass v. Hustler*, 769 F.2d 1128 (7<sup>th</sup> Cir. 1985).

<sup>63</sup> *See Durgom v. Columbia Broad. Sys. Inc.*, 214 N.Y.S.2d 752, 754 (N.Y. App. Div. 1961); *Nutrivida, Inc. v. Immuno Vital, Inc.*, 1997 WL 1106569 at \*6 (S.D. Fla. February 28, 1997); *State v. Hinkle*, 229 P. 317 (Wash. 1924).

<sup>64</sup> *See also* Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 Cardozo Arts & Ent. L.J. 183, 201-02 (1998) ("A federal right of public identity statute would benefit the public, the judiciary, and those who invest time, effort, and money in their personal identities."). Some have founded their support on the grounds that it would resolve the copyright preemption problem. *See* Eugene Salomon, *Note: The Right Of Publicity Run Riot: The Case For A Federal Statute*, 60 S. Cal. L. Rev. 1179, 1186 (1987) ("The end result of [a preemption analysis] is always that one party's rights will be enforced at the expense of another's. A federal statute could provide a solution to this all or nothing situation."). Others have focused on the statute's efficiency gains. Eric J. Goodman, *A National Identity Crisis: The Need For a Federal Right of Publicity Statute*, 9 J. Art & Ent. Law 227 (1999) ("Without a standardized federal law on the subject, challenges in licensing the national use of one's likeness requires careful and time consuming analyses of the various laws of the over twenty-five states that offer such protection. Inconsistencies in the various state laws make it both difficult and risky for lawyers and their celebrity clients."); Alice Haemmerli, *Whose Who? The Case For a Kantian Right Of Publicity*, 49 Duke L. J. 383, 410-11 (1999) (declaring that federal statute would greatly reduce transaction costs and other market inefficiencies).

<sup>65</sup> *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623 (6<sup>th</sup> Cir. 2000).