

Right of Publicity Emerges From The Shadow of Copyright Law

The right of publicity protects an individual's ability to control the commercial use of his or her identity, such as one's name, likeness, or voice. It has been recognized by state statute or common law in approximately twenty-eight states but has not received federal statutory recognition. It has become an increasingly important issue for anyone that advertises or operates web sites which post identifying information about individuals. For several years, there has been some confusion over the interplay between right of publicity and federal copyright law especially involving photographed, televised or videotaped images or performances and recorded voices. Because right of publicity is a state law cause of action, copyright law's preemption doctrine under Section 301 has come into play.¹ The Seventh Circuit Court of Appeals in *Toney v. L'Oreal USA, Inc.*² has clarified its own view on this issue which has reaffirmed the right of publicity as an independent and viable cause of action.

Since 1986, the Seventh Circuit's own decision in *Baltimore Orioles v. Major League Baseball Players Ass'n*³ has caused uncertainty over the viability of an individual's right of publicity claim. In *Baltimore Orioles*, the court found that copyright law preempted individual professional baseball players' right of publicity claims to their likeness carried on television coverage of their games. The Seventh Circuit stated that Section "301(a) preempts all equivalent state-law rights claimed in any work within the subject matter of copyright whether or not the work embodies any creativity."⁴ As the *Toney* court would later note, however, *Baltimore Orioles* had been "widely criticized by our sister circuits and several commentators" as standing for the proposition that right of publicity is preempted in all instances.⁵

Model June Toney sued L'Oreal over the use of her image on packaging for its hair product. Initially, the Seventh Circuit in *Toney*⁶ decided to follow *Baltimore Orioles* in upholding the district court's finding that the Copyright Act preempted the plaintiff's claim under the Illinois Right of Publicity Act.⁷ The court then granted a petition for rehearing, and vacated its original decision. This new decision clarified the interplay between right of publicity and copyright law.

In its new decision, the Seventh Circuit analyzed the preemption issue under Section 301 of the Copyright Act and specifically whether Toney's identity could be considered: (1) fixed in a tangible medium; (2) within the subject matter of copyright as

defined in Section 102; and (3) equivalent to the general copyright protections set out in Section 106 of the Copyright Act. The court determined Toney's "identity is not fixed in a tangible medium of expression. There is no 'work of authorship' at issue in Toney's right of publicity claim. A person's likeness—her persona—is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this."⁸ The court went on to find that the rights protected under the Illinois statute are not equivalent to those under Copyright law. On this point, it stated: "Identity, as we have described it, is an amorphous concept that is not protected by copyright law; thus, that state law protecting it is not preempted."⁹

The court also took the opportunity to clarify *Baltimore Orioles*: "The case simply does not stand for the proposition that the right of publicity as protected by state law is preempted in all instances by federal copyright law; it does not sweep that broadly."¹⁰ The court analogized the reach of the preemption doctrine to situations of where a state law attempts to create rights in materials that have fallen into the public domain or that confer copyright-like protections on works that are not sufficiently original. By arguably narrowing the scope of the preemption doctrine to such clearly defined circumstances, the court, in turn, broadened the opportunity for right of publicity claims.

The *Toney* case is certain to have ramifications across the country because many jurisdictions have not considered the question of copyright preemption in the right of publicity context. It has mended the rift with its sister circuits on this subject. As a result of this case, advertisers do not have as broad a shield to raise through the preemption doctrine against potential right of publicity claims. Contracting for the right to use someone's identity before including it in advertising is still the surest way to avoid a dispute.

— Jonathan S. Jennings¹¹

1. 17 U.S.C. §301.
2. 406 F. 3d 905 (7th Cir. 2005).
3. 805 F.2d 663 (7th Cir. 1986).
4. *Id.* at 676.
5. 406 F. 3d at 910.
6. *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486 (7th Cir. 2004).
7. 765 Ill. Comp. Stat. 1075/1-60.
8. 406 F. 3d at 910.
9. *Id.*
10. *Id.* at 911.
11. He helped to draft the Illinois Right of Publicity Act.

Firm Update/Announcements

New Associate

Sapna Kumar ... has joined the firm as an associate in the Chicago office. Sapna is a graduate of the University of Chicago Law School (J.D. 2003). She will continue her practice in trademark and copyright litigation and prosecution.

Reception

Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP ... is co-sponsoring the ABA Section of Intellectual Property Law's reception at the Four Seasons Hotel at the ABA Annual Meeting in Chicago on Saturday, August 6th from 5:30-7:30 p.m.

Presentations

Diana Lee Bixler ... spoke on "Copyright Awareness" at the Whitney Young Magnet High School on March 15, 2005, and at the University of Chicago Lab School on April 7, 2005, on behalf of the Midwest Chapter of the Copyright Society.

Chad J. Doellinger ... spoke on "Trademark Enforcement in Cyberspace" at the Oklahoma Bar Association's Intellectual Property Section's Midyear Meeting June 3-5, 2005.

Jonathan S. Jennings ... is co-chairing the ABA Section of Intellectual Property Law's CLE programs at the ABA Annual Meeting in Chicago and will moderate a timely debate on three significant intellectual property issues from 2-5 p.m. on Saturday, August 6th at the Hyatt Regency Hotel. Entitled "What Should IP Laws Protect Going Forward? A Debate on Perspectives of What Can Be Owned as IP and What Should Remain in the Public Domain or be Free to Use," the program focuses on the recent *Grokster* Supreme Court copyright law decision on file sharing, key word trademark disputes, and the latest patent reform efforts. • **Jonathan** also will speak on "Right of Publicity Developments in the Music Field" to the Music Licensing course at The John Marshall Law School on Tuesday, July 26th.

Mark V. B. Partridge ... spoke on "What to Copyright" for Law Seminars International, Chicago, Illinois, May 23, 2005. • **Mark** will be speaking on "Recent Developments Involving Trademarks, Copyright and the Internet" at the International Trademark Association's Trademarks in Cyberspace Forum 2005 in Vancouver, British Columbia, Canada, September 12-13, 2005. • **Mark** will also be speaking on "Copyright Damages and Fee Awards" for a Law Seminars International program on September 28, 2005, in Philadelphia.

Robert W. Sacoff ... will be speaking on "The Ethics and Implementation of Pretext Investigations" at the International Trademark Association's Trademark Administrators Conference on September 19, 2005, in Chicago, Illinois.

Joseph N. Welch II ... will be speaking at the Chicago Bar Association on "Trademark Protection Principles and Strategies" on September 13, 2005.

Publications

Chad J. Doellinger's paper "Recent Developments in Trademark Law: Confusion, Free Speech and the Question of Use" was published in *The John Marshall Review of Intellectual Property Law*, Volume 4, Issue 3.

Robert W. Sacoff's article entitled "A Consumer's View of UDRP Cases" appears in the ABA Section of Intellectual Property Law's *IPL Newsletter* (Vol. 23, No. 4, Summer 2005).

Sanjiv Sarwate's article on the *MGM v. Grokster* case was published in the Spring 2005 newsletter of the Intellectual Property Committee of the American Bar Association's Tort Trial and Insurance Practice Section. • **Sanjiv** also contributed the latest version of the chapter on Illinois trademark law to the International Trademark Association's *State Trademark and Unfair Competition Law* treatise.

Publications (cont.)

The coursebook *Trademarks and Unfair Competition* (Lexis Publishing, 6th ed. 2005), authored by **Beverly W. Pattishall**, **David C. Hilliard** and **Joseph N. Welch II**, is now available at bookstores as well as online at www.lexisnexis.com. An online version of those three authors' single volume treatise, also entitled *Trademarks and Unfair Competition*, is now available to subscribers to the Lexis legal research service at www.lexis.com.

Appointments

Brett A. August ... has been appointed by Richard M. Daley, mayor of Chicago, to the Board of Directors of the Chicago Sister Cities International Program as Chair of the Paris Committee. **Brett** was featured in the Chicago Daily Law Bulletin's June 13, 2005, edition for his appointment to the Paris Committee. On July 5, 2005, **Brett** spoke on French-American relations at a reception at the French Senate in Paris where in his new capacity he represented the City of Chicago.

Thad Chaloeintiarana ... was appointed chair of the Online Services committee of the ABA Section of Intellectual Property Law.

Chad J. Doellinger ... was appointed co-chair of the Special Committee on Judicial Internship of the ABA Section of Intellectual Property Law.

Jonathan S. Jennings ... was appointed Chair of the Trademark Division of the ABA Section of Intellectual Property Law. • **Jonathan** also has been appointed to the newly formed Strategic Planning Committee of the Chicago Bar Association.

Sanjiv D. Sarwate ... was re-appointed co-chair of the Chicago Bar Association Young Lawyers' Section Creative Arts Committee for 2005-06. • **Sanjiv** was also appointed to the Litigation Committee of the Intellectual Property Owners' Association.

Belinda Scrimenti ... was appointed to the International Trademark Association's Programs Committee Project Team for the 2007 Annual Meeting in Chicago and has been selected as the Group Leader in charge of the Theme and Keynote Presentation.

Joseph N. Welch II ... was appointed co-chair of the newly formed Trademark Litigation committee of the ABA Section of Intellectual Property Law.

Uli Widmaier ... has been appointed co-chair of the Amicus Briefs Committee of the ABA Section of Intellectual Property Law.

Noteworthy

Sanjiv D. Sarwate ... was awarded the distinguished David C. Hilliard Award for Outstanding Committee Service by the Young Lawyers' Section of the Chicago Bar Association for his service as co-chair of the section's Creative Arts Committee during the 2004-05 bar year. Named in honor of the firm's own **David C. Hilliard**, one of the founders of the Young Lawyers' Section, the Hilliard Award is given each year to a Young Lawyers' Section committee chair who has demonstrated exemplary work.

Five **Pattishall McAuliffe** partners were named Illinois Super Lawyers. *Law & Politics* selected the Illinois Super Lawyers by sending a ballot to all active lawyers in the state who have been in practice for five years or more. The ballot asks lawyers to nominate the best attorneys they have personally observed in action. The nominees are grouped into practice areas. A blue ribbon panel reviews and scores the nominees. *Law & Politics* also conducts interviews, independent research and data verification. The **Pattishall McAuliffe** partners singled out in the field of intellectual property were **Brett A. August**, **Raymond I. Geraldson, Jr.**, **Mark V.B. Partridge**, **Robert W. Sacoff** and **Joseph Nye Welch II**.