They Can't Take That Away from Me: Protecting Free Trade in Public Images from Right of Publicity Claims

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THEY CAN'T TAKE THAT AWAY FROM ME:¹
PROTECTING FREE TRADE IN PUBLIC IMAGES
FROM RIGHT OF PUBLICITY CLAIMS

*Ira J. Kaplan*

PROLOGUE

In ancient society, a hero was a person of apparently superhuman powers, valor, or achievements who was deified or regarded as a demigod after death.² The hero’s larger-than-life persona, it may be supposed, made the hero suitable for epic poetry and drama. More accurately, classical authors manipulated the image of these heroes to help make their stories larger than life. By attributing certain characteristics to the hero, classical authors were able to create a model for individual behavior and an ideal for society.

One result of this manipulation is that the study of ancient mythology is said to provide the modern reader greater insight into the ancient mind than into the details of ancient history.³ So, although the heroic drama has been received as a popular and valuable means of social discourse, that value has not come from an objective or detached portrayal of the hero, but by virtue of the story the author told with the heroic image. That is, the value comes from the meaning imparted by the author’s depiction of virtue, as if it was encoded in the character like so much cultural DNA.

¹ IRA GERSHWIN, They Can’t Take That Away from Me (Gershwin Publ’g Corp. 1937).
² WEBSTER’S NEW TWENTIETH CENTURY DICTIONARY 852 (2d ed. 1983).
³ “The tales [of Gods and Heroes], though not to be trusted for their facts, are worthy of all credit as pictures of manners; and it is beginning to be held that the manners and modes of thinking of an age are a more important part of its history than the conflict of its peoples . . . .” THOMAS BULFINCH, BULFINCH’S MYTHOLOGY viii (Avenel Books 1979).
Heroes in modern society, whether they are athletes, entertainers, business people, or presidents, are also models. Their images provide us with a shorthand guide to behavior in a changing world. Instead of preaching new notions of female sexuality, Madonna sets the example. Instead of lamenting the rise in crime and the powerlessness of the individual, Clint Eastwood fights back. Think of Ginger Rogers and Fred Astaire displaying grace, or Michael Jordan, tenacity. They, or at least their images, have become synonymous with the ideal they portray.

The fiction of heroism allows the users of heroic images to evoke an ideal easily, quickly, and effectively. The ability to quickly evoke an ideal makes the use of heroic images to convey media messages particularly effective given the time constraints on television and radio and space limitations in newspapers and magazines. The communicative value of heroic images is particularly well adapted to advertising where the use of celebrity endorsements is a multibillion-dollar industry. By associating their product with a hero's image, companies endeavor to create an image for their product with which consumers will seek to identify and ultimately purchase.

In ancient Rome, wealthy patrons supported those writers whose heroic dramas earned popular acclaim. Doubtless, the association enriched the patron's social stature. Yet the value drama held for ancient viewers as a model of virtue, or for us as inheritors of that legacy, is not diminished by the fact that the author received compensation for his work. Nor is the heroic depiction diminished because it is an appropriation of the fame of the hero without consent and without compensation to the hero's estate.

4. Here, I use the word "hero" in a decidedly modern manner. A modern-day hero need not be a moral exemplar but only possess fame. Thus, O.J. Simpson, Tonya Harding, Mike Tyson, Howard Stern, and Dennis Rodman qualify in this respect.


7. See, e.g., Joseph Pereira, *Fila Scores on an Assist from Grant Hill*, WALL ST. J., Nov. 5, 1996, at B1 (concerning the effect of basketball star Grant Hill on Fila shoe sales). After signing Mr. Hill to promote their sneakers, Fila's sales rose 37% to $532 million in 1995, vaulting Fila to number three in sneaker sales in the United States. [The key to the strategy, say Fila officials and marketing experts, was the signing of Mr. Hill, a Detroit Piston with a "nice guy" image that appeals to the current sensibilities of middle America. "Grant Hill could determine the destiny of our company," says Howe Burch, vice president of advertising at Fila. [In exchange for promoting sneakers bearing his name] Mr. Hill gets about $6 million a year from Fila—$1 million plus 5% of the revenue from the sale of his shoes.

*Id.*
For the ancient hero, greatness and the fame that accompanied greatness provided ample compensation. The highest station a Roman citizen could attain was to be in excelsa aetatem (in the limelight). But while the ancient hero and the hero’s heirs did not seek pecuniary reward for the manipulation of a heroic image, heroes today are protected from the economic exploitation of their heroic value by the right of publicity.

I. INTRODUCTION

The right of publicity is an intellectual property right that protects against the appropriation of one’s name or likeness by providing a right to sue for any unauthorized commercial use. The right is now recognized in twenty-five states by statute, common law, or a combination of both. It was endorsed by the recent Restatement (Third) of Unfair Competition.

8. The means of appropriation covered by the right of publicity vary from state to state. The California statute, CAL. CIV. CODE § 3344 (West Supp. 1996), provides a cause of action against the unpermitted use of a person’s “name, voice, signature, photograph or likeness.” In addition, the California courts have adopted a distinct common law right of publicity that also protects against look-alikes and sound-alikes. See Eastwood v. Superior Court, 149 Cal. App. 3d 409 (1983).


9. Commercial use has been categorically defined to include merchandise bearing a name or likeness, and uses advertising a separate product or service. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). But see Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959, 970 (10th Cir. 1996) (holding that there is “no principled distinction between speech and merchandise”); see also discussion infra Part IV.B.2.

In addition, some non-commercial uses have been held to be violations, most notably the use in a news broadcast. The Supreme Court recognized the right of publicity in Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1976). Certain uses that would otherwise be considered commercial have been exempt from the right of publicity either by decision, Montana v. San Jose Mercury News, Inc., 34 Cal. App. 4th 790 (1995) (exempting advertisement for newspaper) or by statute, IND. CODE ANN. § 32-13-1-1(c) (Michie 1994) (exempting use that communicates information about an event or topic of general or public interest).

10. For a survey of state rules, see J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY §§ 6.1[B], at 6-6, 9.5[A], at 9-31 (1996) [hereinafter MCCARTHY].

11. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). According to the Restatement, the right of publicity subjects to liability one who “appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade . . . .” Id.
Typically, the right of publicity is invoked by celebrities who wish to protect their own "publicity" value by limiting their exposure or seeking compensation for the use of some aspect of their identity. As a property right, the right of publicity has been held to be assignable and descendible in most jurisdictions where it is recognized.

When enforcing the right of publicity, courts typically consider only that something was taken from the person depicted. Rarely do courts give consideration to that which is taken from the public discourse. The goal of this Article is to find the proper balance between protecting the ability of individuals to control and profit from their own images, and the freedom of others to invoke those images.

The current conflict among jurisdictions—half the states do not recognize a right of publicity, and the twenty-five that do are at odds over what is protected—decreases clarity. The lack of clarity in the law leads to a chilling effect upon those who wish to evoke any public persona. Because right of publicity claims against the national media may be brought in any state recognizing the right, the rule of the jurisdiction that is the most protective of publicity values tends to set that standard for the nation. Only by clearly delineating what uses of a person's persona are prohibited and what uses are allowed can any borderline reference be made without fear of liability.

This Article reviews the justifications for the right of publicity and examines recent decisions expanding the franchise to prohibit look-alikes, sound-alikes, and references where no endorsement is implied.

12. See, e.g., Bi-Rite Enter. v. Button Master, 555 F. Supp. 1188 (S.D.N.Y. 1983). The Bi-Rite court stated:

   Unlike privacy rights, which protect personality and feelings and are therefore not assignable, the right of publicity gives rise to a 'proprietary' interest in the commercial value of one's persona which is assignable and may be freely licensed. . . . This proprietary interest is much like a copyright . . . . [I]t embodies a bundle of exclusive marketing rights which its holder may transfer in its entirety by an assignment or in part by exclusive licenses. Holders of exclusive licenses gain standing to protect their interests against all who would encroach on the exclusive rights embodied in the licenses.

_id. at 1199–1200 (citations omitted).

13. MCCARTHY, supra note 10, § 9.5[B], at 9-32.


17. See, e.g., White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992), reh'g denied, 989 F.2d 1512 (9th Cir. 1993); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir.
The justification given for decisions where a right of publicity violation is found, without an endorsement, either express or implied, is that the attention-getting value of the person evoked is enough of an appropriation to merit compensation. This Article challenges that theory for failing to adequately account for countervailing First Amendment interests.

Section II places the right of publicity in perspective relative to other intellectual property rights. Section III is a discussion of the forty-year history of the right of publicity. Section IV is an examination of the right of publicity as a doctrine that curtails a common yet exceptionally rich brand of speech—simply because it is commercial. Section V develops a free speech defense to right of publicity claims. Section VI is a critical analysis of the broader justifications given for the right of publicity. This section concludes that giving up the right to criticize or revere our heroes is too high a price to pay, especially when a reference to them is not deceptive.

II. DISTINGUISHING THE RIGHT OF PUBLICITY FROM OTHER INTELLECTUAL PROPERTY RIGHTS

Originally, the right of publicity was rooted in the right of privacy. Where the right of privacy protects against harm to a person’s dignity, the right of publicity protects the commercial value of one’s identity.


18. Professor McCarthy claims that merely attracting attention to a product benefits an advertiser and thus there is no requirement of falsity or deception, only identifiability. McCarthy, supra note 10, § 5.4[A], at 5-24; cf. Allen, 610 F. Supp. at 627 n.8 (rejecting defendant’s argument in a look-alike case that there was no inference of endorsement by the plaintiff, and stating that “[w]hen a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement”). McCarthy, supra note 10, § 5.4[D], at 5-38; see also Rogers v. Grimaldi, 875 F.2d 994, 1004 (2d Cir. 1989).

19. See discussion infra Part III.

20. Confusion arises from the wide acceptance of Dean Prosser’s fourth tort of privacy—appropriation—which included both economic and emotional harms caused by an unauthorized exploitation of the plaintiff’s identity. William L. Prosser, Privacy, 48 CAL. L. REV. 383, 489 (1960). In some states, such as New York, the right of publicity is encompassed within the statutory right of privacy. See N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1992 & Supp. 1996). Some decisions suggest that an unauthorized use of a person’s identity for purposes of trade injures only commercial interests if the plaintiff is a celebrity and only dignitary interests if the plaintiff is not well known. See, e.g., Brewer v. Hustler Magazine, Inc., 749 F.2d 527 (9th Cir. 1984). Professor McCarthy believes that the famous and the not so famous have recourse to both dignitary and economic harms under the two separate theories of privacy and publicity. See McCarthy, supra note 10, § 11.8[B], at 11-35. The reality may be that although celebrities may not be precluded from obtaining damages for emotional loss, nor are the less well known precluded from obtaining commercial damages, the relative fame of the plaintiff will be reflected in damages. Unwanted publicity produces greater harm to the private person’s
In addition to requiring a lack of consent prior to finding a violation to the right of publicity, states also require some showing of identifiability.\(^{21}\) In *Cohen v. Herbal Concepts, Inc.*,\(^{22}\) a man was able to recognize his wife and daughter pictured from behind in a photographic advertisement. The New York Court of Appeals held that a photograph that did not show facial features could nevertheless reveal a person's identity.\(^{23}\) The court further held that it was sufficient that "someone familiar with the persons in the photograph could identify them by looking at the advertisement."\(^{24}\) Although only one person may need to identify the plaintiff to establish liability,\(^{25}\) the number of people who recognize or identify the plaintiff is relevant to the issue of damages.\(^{26}\)

Most courts interpret right of publicity statutes broadly so that the depiction need not be an authentic reproduction to be actionable.\(^{27}\) When a celebrity is not actually depicted in a photograph or heard in a recording, courts have had to determine whether attenuated representations of their identity were protected. For example, an illustration that was "somewhere between representational art and cartoon" was found to satisfactorily interest in maintaining his or her cherished obscurity, while uncompensated publicity hurts the public person's greater expectation of financial compensation for the use of his or her cultivated image. See *Restatement (Third) of Unfair Competition* § 46 cmt. a (1995).

At the borderline of publicity and privacy claims are cases where one's celebrity value is injured by excessive and abusive portrayals, particularly when the context of the unconsented use is repugnant to the pirated personality. See, e.g., Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974); Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129, 138 (Wis. 1979); see also *Restatement (Third) of Unfair Competition* § 49 cmt. a (1995). Because of the different nature of the claims, one commentator believes that right of privacy claims for dignitary harm should receive only injunctive relief, whereas right of publicity claims for economic harm require only compensatory damages. See Roberta R. Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994).

21. The California statute states: "A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use." CAL. CIV. CODE § 3344 (b)(1) (West Supp. 1996).
23. Id. at 309.
24. Id.
25. But see J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 135 (1995) (describing the law as requiring that "more than a de minimis number of ordinary viewers identify the plaintiff by looking at (or listening to) the defendant's advertisement").
identify Muhammed Ali.\textsuperscript{28} In \textit{White v. Samsung Electronics America, Inc.},\textsuperscript{29} the Ninth Circuit Court of Appeals held that the image of a robot dressed in a blonde wig and turning letters on a set resembling that of the \textit{Wheel of Fortune} television game show created a triable issue of fact for a jury to determine whether the advertisement improperly used Vanna White's "identity."\textsuperscript{30} The court noted that with greater fame came greater recognizability: "The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice."\textsuperscript{31} However, as Judge Kozinski noted, using the ability to evoke an identity as the standard for finding liability may mean that "every famous person now has an exclusive right to anything that reminds the viewer of her."\textsuperscript{32}

One commentator criticized the \textit{White} decision by pointing out that "[a] celebrity's free-floating 'identity' may be nothing more than the 'idea' of the celebrity. This may be particularly true when the 'identity' being conveyed transcends that of the individual celebrity and evokes a more general type, or 'generic celebrity,' that the individual has come to signify."\textsuperscript{33} A classic example was the case brought by the heirs of Bela Lugosi to obtain the profits gained from appropriations of "his" role as Count Dracula.\textsuperscript{34} In the brightly illuminated world of Hollywood stardom, it is no wonder that some confuse mortal actors with their larger-than-life legacies.

The legal theory behind the right of publicity is claimed to be analogous to that supporting other intellectual property rights such as misrepresentation and misappropriation.\textsuperscript{35} In \textit{International News Service v. Associated Press} ("INS"),\textsuperscript{36} involving news stories pirated from one news wire service by another, the Supreme Court held that although factual information contained in an article is not subject to copyright protection,\textsuperscript{37} the literary aspect of an article is protected under the elastic

\begin{thebibliography}{99}
\bibitem{29} 971 F.2d 1395 (9th Cir. 1992).
\bibitem{30} Id. at 1399.
\bibitem{31} Id.
\bibitem{32} White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1515 (9th Cir. 1993) (Kozinski, J., dissenting).
\bibitem{34} Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979).
\bibitem{35} MCCARTHY, supra note 10, § 1.1(C), at 1-7.
\bibitem{36} 248 U.S. 215 (1918).
\bibitem{37} But see MCCARTHY, supra note 10, § 8.5[A][2], at 8-28 (noting that in the Gay Olympics case "[t]he majority rejected the argument by the defendant organizers of the ‘Gay Olympic Games’ that a prohibition on their use of the word ‘Olympic’ offended first amendment
theory of misappropriation. In the course of his opinion, Justice Pitney compared misrepresentation, or passing off (the selling of one's inferior goods under the name of another) with misappropriation (the selling of another's goods, such as news stories written by another, under one's own name). According to the Court, both were deceptive and both amounted to unfair competition.

Elements of both misrepresentation and misappropriation appear in right of publicity claims. The only difference is that the "goods" being sold are people's images. When an impersonator is used to evoke someone else, such use is a type of misrepresentation. In other words, the impersonator is being passed-off as someone else, particularly if confusion is likely. Preventing deception protects the public from false endorsements and the person portrayed from unwanted associations. Although a legitimate concern, false endorsements may be adequately prevented by trademark law.

When someone's name or likeness is used in a commercial setting, such use, by itself, has been called a form of misappropriation. But unlike the misappropriation of news reportage work-product that occurred in INS, the property taken when someone's name or image is used is neither a stylistic nor substantive creation of a work. Just as the daily events that comprise the essence and the object of news reporting cannot be stolen, the "essence" of public heroes is beyond appropriation. Like ideas, the essence of heroes may only be described in context and it is only this description that may be copyrighted or, the work performed in its creation, appropriated. In addition, like the expression of an idea, there is nothing intrinsically deceptive about the depiction of an image.

Yet most jurisdictions have held that under the right of publicity a use need not be deceptive to be actionable. Proof that the identified person is perceived to be associated with or endorses the user's goods or services is not required for the imposition of liability. Merely attracting the attention of potential consumers and thereby gaining a commercial advantage upon the notoriety of another is sufficient to create a violation policies because it prohibited defendant from using the only word that could succinctly convey defendant's political message that homosexual men and women can participate in athletics at an Olympic level of proficiency").

38. But misappropriation law has been criticized for creating a common law vehicle to limit speech without protecting the public interest in access to works as in copyright's balance between ideas and expressions. See International News Serv., 248 U.S. at 250 (Brandeis, J., dissenting) ("T]he noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use.").

39. MCCARTHY, supra note 10, § 5.6[B], at 5-55.

of the right of publicity.\footnote{Id. § 47 cmt. c.} Even an advertisement expressly disclaiming endorsement, for example, one that says "Bill Clinton doesn't chew Day's Work tobacco but you should" would be actionable. Thus, the right of publicity applies to a mere evocation unlike misappropriation or misrepresentation law which both require a showing of deception.

Under copyright law, only those fixed and unique components of the author's original work, though they make use of ideas or factual information, are given legal protection. The Supreme Court has noted that "[t]o this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work."\footnote{Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349–50 (1991). In setting a balance between ideas and expressions, the Copyright Act, 17 U.S.C. §§ 101–1010, 1001–1010 (1994), codifies the constitutional provision to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.} Thus, a photograph of a model, the recording of a live musical performance, or a biography of a president are all covered by copyright. However, the unfixed object of the photograph, recording, or biography is more akin to an idea, which, because it is ephemeral, cannot be copied. Thus, the essence of the living object upon which the expression was based remains outside the reach of copyright law. Right of publicity law, on the other hand, makes people's images into "things."

In addition, a transformative use such as parody that uses the original work, while also adding something new, may be considered fair use and not an infringement of the prior copyrighted work.\footnote{The fair use exception, section 107 of the Copyright Act of 1976, provides a framework for making a determination concerning the use of a copyrighted work. \textit{See} 17 U.S.C. § 107 ("The fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research, is not an infringement of copyright."); \textit{see}, e.g., Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 576 (1994).} The public interest in critical commentary is reflected in the rule that copyright holders do not retain licensing control over critical derivative works. In such cases the new work may be copyrighted as an original work.\footnote{17 U.S.C. § 103.}

advertising[,] ... non-commercial use of a mark ... [and] all forms of news reporting and news commentary."47 Therefore, deceptive uses, those likely to confuse consumers, are prohibited, while honest references are protected even if motivated by a quest for commercial gain as in comparative advertising.

One court, in recognizing a parody defense to a right of publicity claim, held that if a reference is made to a person and there is no deception causing confusion either as to identity or endorsement, the right of publicity ought not apply.48 And some commentators have argued an analogy to the proposition presented under copyright law that "[n]o author may copyright his ideas or the facts he narrates."49 The information provided by a mere reference to someone, particularly someone in the public eye, they contend, should also be considered within the public domain and exempt from the right of publicity.50

III. HISTORY OF THE RIGHT OF PUBLICITY

With only forty years of case law,51 one anomalous U.S. Supreme Court case endorsing it,52 and various standards among the states, the right of publicity has not yet solidified. However, an examination of its history can help explain how the law has developed.

A. The Right of Privacy Protects Against Dignitary Harms

The foundation for the right of privacy was laid by the famous 1890 essay *The Right to Privacy* written by Samuel Warren and Louis

47. 15 U.S.C. § 1125(c) (4). *But see* Nike, Inc. v. "Just Did It" Enters., 6 F.3d 1225, 1228 (7th Cir. 1993) ("[P]arody is not an affirmative defense but an additional factor in the analysis.").


51. The seminal right of publicity case was *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). In *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580 (N.Y. 1984), the court limited assignability rights (a key holding in *Haelan*) by finding statutory preemption against a common law right of publicity. Thus, Professor Barnett refers to the seminal case as a bad seed. *See* Barnett, *supra* note 33, at 596 n.18.

The essence of the article was that an intrusive press was "overstepping in every direction the obvious bounds of propriety and of decency" in its search for sensation. In doing this, the press was invading what amounted to a right to privacy—the right to be left alone. It should be noted that the harm addressed was not economic, but arose from the affront to human dignity caused by public disclosure of private facts.

In 1902, the New York Court of Appeals, in Roberson v. Rochester, rejected a claim for emotional distress resulting from the unauthorized use of the plaintiff's portrait on 25,000 copies of an advertisement for flour. The court refused to accept such a right for fear of restricting the press based on a mere "comment on one's looks." The court refrained from engaging in any line-drawing between protected and non-protected speech and expressly deferred to the legislature. Accepting this invitation, the New York legislature enacted a statute imposing criminal and civil liability for the unauthorized use of a person's name, portrait, or picture for "advertising purposes or for the purposes of trade."

Soon after Roberson, the Georgia Supreme Court took the step that the New York court resisted and recognized the right of privacy in Pavesich v. New England Life Ins. Co. Pavesich involved the unauthorized use of the plaintiff's photograph in an advertisement for life insurance. The advertisement compared the photographs of two men, one appearing down on his luck (suggesting he had not purchased a New England Life insurance policy), and the other showing the plaintiff with the caption: "In my healthy and productive period of life I bought insurance in the New England Mutual Life Insurance Co., of Boston,
Mass., and to-day [sic] my family is protected and I am drawing an annual dividend on my paid-up policies."

The statement attributed to Pavesich was untrue and damaging to his reputation because it painted him as a liar (for saying he had life insurance when in fact he did not) and thus the advertisement likely amounted to libel. In addition, if the same testimonial was printed today it would likely be actionable as a false endorsement under the Lanham Act. Whether called libel, false endorsement, or a violation of his right to privacy, the use of the statement wrongly attributed to Pavesich was appropriately considered an infringement because it was not truthful. Preventing deception is a legitimate reason for curtailing speech, particularly speech about private figures.

However, the Pavesich court went further and wholly rejected the idea that a threat to free speech was posed by granting a right of privacy. Instead, it held that limiting such a right to commercial uses would avoid any unconstitutional deprivation: "There is in the publication of one's picture for advertising purposes not the slightest semblance of an expression of an idea, a thought, or an opinion, within the meaning of the constitutional provision which guarantees to a person the right to publish his sentiments on any subject."

Two subsequent developments in First Amendment law severely limit this rationale, especially when the advertisement in question concerns a public figure. First, since 1976, the U.S. Supreme Court has consistently held that non-deceptive commercial speech is protected expression under the First Amendment. Second, since 1964, libel law has given greater deference to speech about public figures. An expectation that public figures should withstand a greater degree of public scrutiny is the basis for the "actual malice" standard. The standard, which is often difficult to prove, requires a plaintiff to show that the defendant knew the falsity of the libelous statement or showed a reckless disregard for the truth. The standard reflects the need to give adequate breathing space to speech and

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63. Id. at 68–69.
64. Id. at 81.
65. Id. at 74.
66. Id. at 80.
69. Sullivan, 376 U.S. at 280.
less deference to the dignitary concerns of public figures even when the offending speech is not political.  

The actual malice standard, adopted by the U.S. Supreme Court in *New York Times Co. v. Sullivan*, resulted from a newspaper advertisement that sought to raise funds for the civil rights movement. The plaintiff claimed that the advertisement made false and disparaging references about him in his official capacity as an Alabama city commissioner. By finding for the newspaper, the Court afforded free speech protection even though the challenged expression was in the form of an advertisement. Although the "product" advertised in *Sullivan* was the civil rights movement, the nature of the product does not, under most right of publicity statutes, protect an advertiser from a right of publicity claim. It would be disturbing indeed to find that even an oblique reference to Sullivan might now allow him to succeed under a right of publicity claim. Commercial speech provides a forum for the depiction of public figures. Whether used to cast derision or to laud their accomplishments, commercial speech concerning public figures ought to receive First Amendment protection as long as it is not deceptive.

**B. Extending Protection to Economic Harms**

Originally, public figures, at least while portrayed in their public roles, were not protected by the right of privacy because the right was limited to remedying dignitary harms resulting from unauthorized use. Public figures, it was reasoned, could not seek publicity and then sue for the harm publicity caused. Their foray into the public limelight was considered an implied consent. In *O'Brien v. Pabst Sales Co.*, a famous football player sued the Pabst Beer Company for their use of his photograph on the 1939 Pabst Blue Ribbon beer calendar. The plaintiff was particularly upset because, at the time, he was actively advocating against the use of alcohol. The Fifth Circuit Court of Appeals rejected his

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70. The actual malice standard has also been invoked for evaluating and ultimately dismissing claims of dignitary harm brought under an action for intentional infliction of emotional distress and invasion of privacy resulting from a mock advertisement in *Hustler Magazine v. Falwell*, 485 U.S. 46, 52 (1988).
72. *Id.* at 256–57.
73. *Id.*
74. See infra note 96 (discussing exemptions from the right of publicity for news and the arts); see also Beverley v. Choices Women's Med. Ctr., Inc., 587 N.E.2d 275 (N.Y. 1991) (involving the successful right of publicity claim brought against a women's health clinic).
76. 124 F.2d 167 (5th Cir. 1941).
right of privacy claim, holding that the calendar was not an endorsement.\textsuperscript{77} Furthermore, the court held that as a public person O'Brien could not be injured by "the publicity . . . which he had been constantly seeking and receiving."\textsuperscript{78} By seeking fame, this celebrity had waived his right of privacy. To overcome the limitations posed by the emerging right of privacy, a new legal theory was required. In \textit{Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.},\textsuperscript{79} which involved rival baseball card manufacturers' use of player photographs, Judge Jerome Frank created the "right of publicity" to provide a remedy for the economic damage done by an unauthorized use, not for the dignitary harms dealt with by the right of privacy. Judge Frank stated that:

In addition to and independent of [the] right of privacy . . . a man has a right in the publicity value of his photograph, \textit{i.e.}, the right to grant the exclusive privilege of publishing his picture and that such a grant may validly be made "in gross," \textit{i.e.}, without an accompanying grant of a business or of anything else. . . . This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses \textit{[sic]}, trains and subways.\textsuperscript{80}

\textbf{C. Protecting the Assignee}

So prominent persons would not feel "sorely deprived" because they had not received payment for authorized advertisements, the \textit{Haelan} court provided "an exclusive grant which barred any other advertiser from using their pictures."\textsuperscript{81} Although, the injured party in \textit{Haelan} was not an abused ballplayer but a rival card manufacturer, the argument was that endorsements would yield no value to the celebrity if the assignee could not enforce the exclusive right to exploit them. However, denial of the right of publicity for any truthful reference would not destroy the endorsement market. Instead, compensation could be limited to endorsements and not extend to mere references. Courts would have to

\textsuperscript{77} \textit{Id}. at 170.  
\textsuperscript{78} \textit{Id}.  
\textsuperscript{79} 202 F.2d 866 (2d Cir. 1953).  
\textsuperscript{80} \textit{Id}. at 868.  
\textsuperscript{81} \textit{Id}.  
decide, on a case-by-case basis, whether an endorsement was improperly implied. If obtained without consent, a photograph of Michael Jordan holding a box of Wheaties would be actionable if it created a false impression of endorsement. Alternatively, a poster showing Michael Jordan dunking a basketball ought not be actionable, much like a poster of the Statue of Liberty or Yosemite National Park. These are national treasures and references to them ought to be a protected part of our shared cultural lexicon.

The interests of assignee-sponsors are an integral element of, and powerful political force behind, the right of publicity. By omitting this aspect of right of publicity jurisprudence, its supporters maintain a false vigil in support of the "used" individual. A more accurate definition of the right of publicity when assigned to a third party might be "the right to purchase from an individual the ability to prevent any reference to that individual by anyone else in any commercial context."

IV. THE RIGHT OF PUBLICITY LIMITS COMMERCIAL SPEECH

Professor McCarthy, author of a leading treatise on the subject, defines the right of publicity as "the inherent right of every human being to control the commercial use of his or her identity." However, the right to control the use of one's name or likeness, whether the use is obvious or obscure, cannot be inherent, innate, intrinsic, or essential as long as "use" means speech and the First Amendment applies. Sometimes speech is not "speech." Obscenity, for example, has been held to be outside the scope of First Amendment protection. But over the last twenty years, the U.S. Supreme Court has consistently held that the First Amendment protects non-deceptive commercial speech. A state may only restrict commercial speech if it can show that the restriction directly and materially advances a substantial state interest in a manner no "more

82. MCCARTHY, supra note 10, § 1.1[A][1], at 1-2.
83. The First Amendment only protects speech from regulation by the government. Application of a state right of publicity statute has been deemed sufficient state action to allow a First Amendment defense. See Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 968 (10th Cir. 1996). Of course, courts need not reach the issue of state action if they hold that the scope of First Amendment protection is not broad enough to apply to commercial appropriations of another's persona. See MCCARTHY, supra note 10, § 8.6[B], at 8-22 n.30.
85. See In re R.M.J., 455 U.S. 191, 203 (1982) ("Truthful advertising related to lawful activities is entitled to the protections of the First Amendment. But when the particular content or method of the advertising suggests that it is inherently misleading or when experience has proved that in fact such advertising is subject to abuse, the States may impose appropriate restrictions.").
extensive than is necessary to serve that interest."\textsuperscript{86}

Once it is accepted that commercial speech is "speech," any right to control speech that evokes one's identity must be balanced against the right of others to evoke that identity. To paraphrase Justice Holmes' description of libel, it may be said that what we give to the right of publicity we take from the freedom of speech.

\textbf{A. Rationale for First Amendment Protection of Non-Commercial Speech Concerning Celebrities}

Contrary to Professor McCarthy's contention that control of identity is an inherent human right, the need for balancing the control of speech evoking a persona with the interests guaranteed by the First Amendment is an assumption in Professor McCarthy's own definition of the right of publicity. If the right to control the use of one's identity was a fundamental inalienable right,\textsuperscript{87} it would not be necessary to limit such control to commercial use. Yet, Professor McCarthy's definition, and much right of publicity law, expressly exempts "non-commercial" speech from right of publicity actions. As expressed in the Restatement (Third) of Unfair Competition, "[t]he name, likeness, and other indicia of a person's identity are used 'for purposes of trade' [only] if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user."\textsuperscript{88} If control of identity was a fundamental right, it would not be consistently overcome by the broad variety of speech defined as "non-commercial."

With very few exceptions,\textsuperscript{89} right of publicity claims have been denied when use was made of a person's identity in books, newspaper or magazine articles, on television or radio shows, in films or plays, and sometimes in advertising incidental to such permitted uses.\textsuperscript{90} In fact, almost any non-commercial use will be allowed without violating the right of publicity no matter how much the medium depends for its success on the attention-getting ability of the used persona. The rationale behind the


\textsuperscript{87} "The most persuasive rationale which gave rise to and continues to provide reasoned support for the Right of Publicity is that human identity is a natural and self-evident property right." MCCARTHY, supra note 10, § 4.8[D], at 4-47.

\textsuperscript{88} RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995).


\textsuperscript{90} See, e.g., IND. CODE ANN. § 32-13-1(c) (Michie 1994).
exemption from right of publicity claims for non-commercial uses is that
the benefit to social discourse outweighs the economic burden to the
exploited individual.

The value of speech rationale has been construed quite broadly. Courts, for good reason, are reluctant to weigh the value of speech in a
particular case. People Magazine and Entertainment Tonight are two
obvious, but not unique, examples of speech protected by the First
Amendment that are sold solely upon the attention-getting value of
celebrities. Arguably, the images presented in these venues are more than
attention-getting ploys and do have independent expressive value. But
even if an empirical examination could reveal some value, advertisements,
it must be admitted, are at least as valuable. One distinction between
advertising and non-commercial speech, it has been argued, is that
advertising is concerned primarily with selling something, and therefore, is
intrinsically less valuable and less deserving of First Amendment
protection.91 However, bright-line distinctions based upon the speaker’s
identity and intent have led to incongruous results.

In Montana v. San Jose Mercury News, Inc.,92 former San Francisco
Forty-Niner quarterback Joe Montana sued the San Jose Mercury News for
printing an artistic rendition of him in a special section of the newspaper
and then selling the portrait separately in poster form. The court held that
the poster and the newspaper publication were both protected by the First
Amendment “because Montana was a major player in contemporaneous
newsworthy sports events.”93 Yet if the poster had been printed by a
poster company, the newsworthiness defense probably would not have
prevailed.94 Thus, the same message may be permitted or prohibited
depending on the messenger and the messenger’s perceived intention.

However, the motives of the news media are not so pure. The news
media promote themselves by exploiting images of personalities. Acknowledging that the newspaper appropriated Montana’s identity for
self-promotion, the court held that a newspaper has a constitutional right to
promote itself by reproducing its news stories as long as the advertising
does not create the impression that the person endorses the news
medium.95 In so doing, the court overlooked the appropriation claim and

91. See McCarthy, supra note 10, § 8.11[B][3], at 8-84 (contending that the primary
message of the advertisement in the White case is “buy Samsung VCR’s”).
93. Id. at 794.
the commercial context in favor of the expressive element of the publication as a traditional forum for news.

Once it is accepted that some speech outweighs right of publicity claims, the tough question is to decide how to properly balance the competing interests. In Montana, the court felt that only deception should limit bona fide expression evoking public persons. But if the media are protected by the newsworthiness of a portrayal because speech about public figures is important, it would seem that the same ability to commend or castigate public figures ought to extend to non-media speakers as well.

**B. Developing First Amendment Protection For Commercial Speech Concerning Celebrities**

The argument given in favor of the almost complete First Amendment protection for non-commercial uses is that public policy favors the dissemination of a broad range of ideas, including references to individuals, particularly those in the public spotlight, whether the use is in the form of news or entertainment. The argument is roughly analogous to the justification behind libel law which gives greater protection to a defendant who impugns the reputation of a public figure. The aim of both is to encourage public discourse on a wide range of public issues. The corollary of this argument presented by Professor McCarthy is that because commercial speech is given the "lowest level of constitutional weight," it serves no such public interest. To bolster his argument, Professor McCarthy describes a three-part hierarchy of speech. At the top is news ("information about the real world"), next are stories (fiction and entertainment), and at the bottom is advertising ("a context that neither informs nor entertains, but sells"). Yet if an advertisement neither informs nor entertains it is doubtful that it can sell.

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96. The California statute limits right of publicity claims by creating exceptions for "news, public affairs, or sports broadcast, or account, or any political campaign. . . ." CAL. CIV. CODE § 3344(d) (West Supp. 1996). Nevada provides no violation where the likeness is used in connection with news or art, is an impersonation in a live performance, or is without relation to commercial sponsorship. NEV. REV. STAT. ANN. § 597.790(2)(a)-(e) (Michie 1994). Indiana exempts uses in literary, theatrical and musical works, film, radio, television programs, fine art, material with political or newsworthy value, advertisements for all such uses (referred to as incidental uses) and reports on topics of general or public interest. IND. CODE ANN. § 32-13-1-1 (Michie 1994).


98. McCarthy, supra note 10, § 8.2[A], at 8-12.

99. Id. at 8-12–8-13.
Professor McCarthy responds that even if a particular advertisement informs or entertains, its "primary" message is still "buy" as revealed by the fact that a commercial seller pays the media to publish or broadcast the message. If advertisements were valuable, McCarthy contends, consumers would pay to see them, and since consumers do not pay, advertisements must not have value. Because the primary message of advertising is "buy," according to Professor McCarthy, its limitation does not curtail any valuable ideas.

Professor McCarthy would have us believe that when balancing freedom of speech and the right of publicity, commercial speech is a class of speech so distinct and so lacking in value that it is automatically and entirely outweighed by the right to control any personal reference. There are two problems with this approach. First, the hazy line between commercial and non-commercial speech does not separate valuable speech from worthless speech. Advertising has a long tradition in this country as an important means of expression. Second, the Supreme Court has held that commercial speech is protected by the First Amendment.

1. Difficulties Distinguishing Commercial Speech from Speech Receiving Greater First Amendment Protection

Professor McCarthy's approach arbitrarily divides the continuum of social speech into two categories: (1) commercial speech, which is considered intrinsically less valuable; and (2) all other speech, which is considered more valuable and therefore deserves greater constitutional protection. The danger, as with any bright-line rule, is that courts automatically grant greater or lesser protection to speech based on mechanical categorizations without considering the rationale from which the categories are derived. Courts ask, "Is this a commercial use? Is this a protected medium?" The answers to these questions hardly prove the value of a given use to the greater social discourse. The result is that references to famous individuals in certain media, or in the marketing of certain goods, are actionable, while other similarly exploitive uses in other media are not.
In *Uhlaender v. Henricksen*, the court prohibited the use of baseball players' names and statistics in a board game while accepting that the use of the same names and information would be protected if in a book. In a similar case involving the use of golfers' names and statistics in a board game, the court said that while use of names in the dissemination of news is proper, use of the same information "for the purpose of capitalizing upon the name by using it in connection with a commercial project" is not. It would seem that if true factual information including names and statistics is valuable to the public and is therefore protected in book form, the same information is just as valuable when presented in a board game and should be equally protected. But in a case brought by Howard Hughes against the makers of "The Howard Hughes Game," a New York court justified the distinction saying that:

In reality, defendants are not disseminating news. They are not educating the public as to the achievements of Howard Hughes. They are selling a commodity, a commercial product, an entertaining game of chance, the outcome of which is determined by maneuvering tokens on a game board by the throw of the dice. The use of plaintiff's name, biographical data etc. in this context is not legitimate to the public interest. It is merely the medium used to market a commodity ...

In other areas of intellectual property law, new uses of facts and ideas are protected regardless of the medium. Under copyright law, the unique ordering of factual information, even in as pedestrian a format as a telephone book, is encouraged by allowing new versions while preventing unauthorized copies of the exact same expression. Similarly, the transformative nature of sports statistics when incorporated into a children's board game builds on a storehouse of shared knowledge to develop a new creation. Restricting this market hurts creators and deprives the public. Some say that payment for the use of facts about athletes should be figured into the costs of production, but, should children, or we as a society, pay professional athletes for the right to speak about them?

Both copyright and trademark protection are intellectual property rights of Constitutional magnitude. They balance property interests against concerns for over-limiting free public use—either as a policy for

107. *Id.* at 462.
109. *Id.* at 146.
allowing greater industry or upon a principle of encouraging the broadest dissemination of expression for its own sake.\textsuperscript{111} That the right of publicity does not have a mandate in the letter of the Constitution should not allow it to ignore the Constitution’s spirit.

Unlike copyright law, where limited monopoly protection of expression is justified to protect the fruits of creation, encourage creation, and reward hard work, such justification does not support the right of publicity. Because endorsement revenue is only tangential to a celebrity’s fame as an actor or athlete (professions which already pay lucrative salaries) there is little risk that a loss of advertising dividends will deprive society of their creativity.\textsuperscript{112}

Moreover, it is possible that the creator of a product or advertisement could express ideas or opinions valuable to the public discourse in addition to any intention to sell or as a means to incite sales. Concern for the bottom line does not preclude creativity. Even if the primary intention is to sell, and a name or likeness is used primarily to stimulate consumer interest, the expression, on its own, can still speak for itself.

In \textit{Beverley v. Choices Women's Medical Center, Inc.}\textsuperscript{113} the defendant medical center created a calendar that illustrated people and events important in the women’s movement. A doctor who appeared at a “Women in Medicine” conference was shown in a photograph in the calendar and sued the medical center. Notwithstanding the informational and historical value of the calendar and the public interest in the promotion of the defendant’s services, the trial court granted summary judgment for the plaintiff.\textsuperscript{114} The New York Court of Appeals, noting that the defendant was not a “media enterprise,”\textsuperscript{115} upheld the lower court’s decision, saying that the defendant “may not unilaterally neutralize or override the long-standing and significant statutory privacy protection by wrapping its advertising message in the cloak of public interest, however commendable the educational and informational value.”\textsuperscript{116}

Thus the appellate court, under the shibboleth that commercial speech is valueless, appears to hold that although this expression was neither deceptive nor valueless, it evaded protection by the First Amendment simply because it was “commercial.” The court stated that “[t]he pervasive and prominent placement of [defendant’s] name, logo,
address and telephone number on each page of the calendar, [and] the wide
scope of distribution . . . leave no doubt that the calendar is commonly
recognized as quintessential advertising material." 117 The protection of a
public person's right to prevent the publication of her photograph at a
public event was thus held more important than the public's interest in the
truthful dissemination of historical events in a particularly accessible
format.

Conversely, in a recent decision by the Tenth Circuit Court of
Appeals, a First Amendment defense to a right of publicity claim
prevailed, in part, because the court held that baseball trading cards were
not commercial speech. 118 In Cardtoons, L.C. v. Major League Baseball
Players Ass'n, 119 which involved the satirical use of baseball players on
trading cards, the court realized that settling a right of publicity claim
involves more than allocating resources. 120 Granting monopoly control
over an image prevents artistic, cultural and political references to those
popular icons we use to describe, applaud and criticize all sorts of social
phenomena: "Because celebrities are an important part of our public
vocabulary, a parody of a celebrity does not merely lampoon the celebrity,
but exposes the weakness of the idea or value that the celebrity symbolizes
in society." 121

In adopting a parody defense resembling the fair use exception of
copyright law, the Cardtoons court recognized that a transformative use
that mocks the original impliedly denies endorsement and that while
making at least a passing reference to the individual parodied, such
commentary "added a significant creative component of its own . . . and
created an entirely new product. Indeed, allowing [the baseball players] to
control or profit from the parody trading cards would actually sanction the
theft of Cardtoons' creative enterprise." 122

The court refused to accept the Major League Baseball Players
Association's argument that trading cards were not a traditional forum for
communication and were thus exempt from First Amendment

117. Id. at 278.

("Cardtoons' trading cards, however, are not commercial speech—they do not merely advertise
another unrelated product. Although the cards are sold in the marketplace, they are not
transformed into commercial speech merely because they are sold for profit.") (citing Virginia
State Bd. of Pharmacy, 425 U.S. at 761).

119. 95 F.3d 959 (10th Cir. 1996).

120. Id. at 974.

121. Id. at 972.

122. Id. at 976.
Citing cases protecting pamphlets, handbills, yard signs, flag burning and nude dancing, the court noted that speech was protected even if it occurred in a non-traditional medium of expression. Baseball cards, the court held, "have been an important means of informing the public about baseball players for over a century." Thus, under *Cardtoons* it seems that as long as a use is transformative, First Amendment protection will extend to posters, buttons, and T-shirts.

Transformative speech, such as parody, is only one example of speech that, since it comments on the original, does not imply an endorsement. If Walmart were to run an advertisement saying, "Shop at Walmart. We don’t sell the works of Madonna because we believe in God and Country," the advertisement could easily be held a violation of the right of publicity. Walmart would be trading on the celebrity value of Madonna to boost sales of their other products. Yet, if the announcement of this corporate boycott is truthful, what right does Madonna have to prevent such an announcement? If she wishes to run an advertisement saying that the CEO of Walmart is a closed-minded opportunist, she should have that right as well. And if the public chooses to frequent or avoid Walmart because of the advertised information, the debate on speech is enlivened and the public enlightened.

The distinction between commercial and non-commercial speech within a single medium seems particularly arbitrary. A right of publicity claim may be brought against the makers of a television commercial but not against the show the commercial sponsors. However, it is doubtful that a court can detect any greater value of speech delivered by programming than from the advertisements that surround it. In some sense, advertisements have greater public speech value—they deliver practical messages about consumer products, they speak to (not at) us, and given time constraints, they must be more effective at communicating than programming.

If there is social meaning in media, Marshall McLuhan contends that advertising is its leading purveyor:

> [Advertising is a] huge educational enterprise... whose twelve-billion-dollar annual budget approximates the national school

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123. Id. at 969.
124. Id.
125. *Cardtoons*, 95 F.3d at 969.
126. The court limited its holding to parodies on merchandise, refusing to extend First Amendment protection to parodies in advertising, thereby not completely disagreeing with the Ninth Circuit's decision in *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992). Id. at 970.
budget. Any expensive ad represents the toil, attention, testing, wit, art, and skill of many people. Far more thought and care go into the composition of any prominent ad in a newspaper or magazine than go into the writing of their features and editorials. . . . [Advertisements] are magnificent accumulations of material about the shared experience and feelings of the entire community . . . . The historians and archaeologists will one day discover that the ads of our time are the richest and most faithful daily reflections that any society ever made of its entire range of activities.\textsuperscript{127}

That images are used to advertise products, or are emblazoned on posters and T-shirts, does not detract from their communicative value. The use of celebrity images in advertising and on goods is a quintessentially American means of expression.\textsuperscript{128} Certainly, mass media has undergone tremendous change in the twentieth century. The real change, as Professor Madow contends, is not technological, but that our modern-day heroes feel a need to be compensated for their social adulation.\textsuperscript{129}

2. Commercial Speech Is Protected by the First Amendment

Although the U.S. Supreme Court has allowed greater regulation of commercial speech, it has not justified such limitations on the lesser intrinsic value of commercial speech but, typically, on a state’s police powers. This sort of time, place, or manner restriction on speech has been justified not as a regulation of speech \textit{qua} speech, but as a regulation of the accompanying action.

\textsuperscript{127} MARSHALL McLuhan, UNDERSTANDING MEDIA: THE EXTENSIONS OF MAN 228–32 (1964).

\textsuperscript{128} See Madow, supra note 50, at 149 (noting the commercialization of the Founders' personae). Madow quotes Benjamin Franklin in a letter to his daughter: [Medallions], pictures, busts, and prints, (of which copies upon copies are spread everywhere) have made your father's face as well known as that of the moon, so that he durst not do any thing that would oblige him to run away, as his phiz would discover him wherever he should venture to show it. It is said by learned etymologists that the name \textit{Doll}, for the images children play with, is derived from the word IDOL [sic]; from the number of dolls now made of him, he may truly be said, \textit{in that sense}, to be \textit{i-doll-ized} in this country. \textit{Id.} (quoting Letter from Benjamin Franklin to Sarah Bache (June 3, 1779), in MR. FRANKLIN: A SELECTION FROM HIS PERSONAL LETTERS 45, 45–46 (Leonard N. Labaree & Whitfield J. Bell, Jr. eds., 1956)).

\textsuperscript{129} See Madow, supra note 50, at 150. Professor Madow's contention is that "the Founders grudgingly sat for portraitists and sculptors as a matter of "patriotic duty," . . . [knowing that] mass-marketed household artifacts and decorative objects . . . helped to establish a genuinely democratic national iconography." \textit{Id.}
In *United States v. O'Brien*, the defendant O'Brien was convicted of illegally burning his draft card in violation of federal law. The Supreme Court held that the law was targeted at the actions of individuals, not the speech in opposition to the draft communicated by burning a draft card and upheld the conviction. The Court based its decision on the grounds that the regulation the government was enforcing served a purpose—"the smooth and proper functioning of the system that Congress has established to raise armies"—unrelated to suppression of expression. The Court held that "when 'speech' and 'nonspeech' elements are combined in the same course of conduct, a sufficiently important governmental interest in regulating the nonspeech element can justify incidental limitations on First Amendment freedoms." To prevent attempts at unconstitutional suppression of the communicative elements of expression, the *O'Brien* Court devised a three part test to guarantee that the government regulation is justified: (1) it must further a substantial government interest; (2) it must be unrelated to the suppression of expression; and (3) the restriction on speech must be no greater than is essential to the furtherance of that interest.

When applied to commercial speech, the Court has found that regulations that protect against deceptive advertising satisfy a legitimate government interest: "In light of the greater potential for deception or confusion in the context of certain advertising messages, . . . content-based restrictions on commercial speech may be permissible." Thus, the potential for deception has created an appearance of a lesser, or at least different, level of protection for commercial speech.

Truthful commercial speech, on the other hand, has been considered important and fully protected by the First Amendment. In *Virginia State*
Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.,\textsuperscript{138} the Court supported First Amendment protection for speech that did no more than propose a commercial transaction. As a policy matter, the Court believed that public interest in the free flow of consumer information might well exceed public interest for political debate, and therefore, unless deceptive, deserved protection.\textsuperscript{139} In addition, the Court saw at least potential value in commercial speech that it did not wish to foreclose, holding that commercial speech could, and often does, contain meaningful expression even though the primary interest of the speaker may be economic: “Obviously, not all commercial messages contain the same or even a very great public interest element. There are few to which such an element, however, could not be added . . . . We see little point in requiring [them] to do so, and little difference if [they do] not.”\textsuperscript{140}

Thus, the only requirements for full First Amendment protection of commercial speech is that the speech be neither illegal nor misleading.\textsuperscript{141} Yet, as currently construed, the right of publicity intrudes on commercial speech that is neither.

V. APPLICATION OF A FIRST AMENDMENT BALANCING TEST TO RIGHT OF PUBLICITY CLAIMS

\textbf{A. Preventing Deception is a Legitimate Aim}

Is it socially desirable to allow public figures the right to censor and to extract pay from those who make references to them and their accomplishments, particularly when our heroes are already paid handsomely for their accomplishments? Should they have monopoly control over their fame or do we, as cultural stockholders, have a share in the currency of their celebrity to spend as we please?

The law should provide for a public use of heroes, whether they are athletes, entertainers, or politicians, if the use is not deceptive or if a false endorsement is not implied. Instead of assuming that every use is a theft,\textsuperscript{142} it might be better to assume that every use is allowed, unless and until it is shown in a particular case that there is some sort of deception.

\textsuperscript{138}425 U.S. 748 (1976).
\textsuperscript{139}Id. at 763.
\textsuperscript{140}Id. at 764–65.
\textsuperscript{141}Central Hudson, 447 U.S. at 566 (“For commercial speech to come within [the First Amendment], it at least must concern lawful activity and not be misleading.”).
\textsuperscript{142}Compare this proposition with the position taken by McCarthy: “why not” protect publicity rights. McCARTHY, supra note 10, § 2.1[B], at 2–4.1.
Analogous limits on the deceptive use of others' identities are set by libel law, trademark law, and unfair competition law. By prohibiting only speech that amounts to a deception, these bodies of law implicitly protect speech that is truthful, factual, and original thereby encouraging fair competition and greater inventiveness. Likewise, in cases where reference is made to an individual, the mere reference should not be enough to trigger liability. Instead, actual confusion as to endorsement should be required. Honest references aid consumers, deception does not.

B. Celebrity Control Creates Deception

The right of publicity provides the assignee control of the hero's image. Once the advertiser obtains the license, the advertiser may say what it wants about the hero and may prevent others from saying what is true or even what the hero himself wishes to allow. Paradoxically, the right of publicity rests on a misperception that the First Amendment tolerates control of commercial speech beyond regulation against deception, so that, the right of publicity creates deception in advertising. Providing assignable ownership to people's images means that the rights to the discourse goes to the highest bidder. Granting image-control to the celebrity, or the assignee, assures that only their approved version is presented.

In *Nature's Way Products, Inc. v. Nature-Pharma, Inc.*, the plaintiff, a well-known herbalist, sold his former business and recipes to the defendant. The plaintiff sought to enjoin the defendant from advertising that the plaintiff had developed the defendant's herbal formulae. The defendant argued that "the right of publicity does not protect dissemination of historical information . . . ." In granting the

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144. Proof of trademark infringement requires proof of a likelihood of confusion between the symbols of two parties. See Lanham Act § 43(a) (1), 15 U.S.C. § 1125(a) (1) (1994). In fact, trademark seems an apt theory of law to protect against unfair appropriations of identity, e.g., a trademark smile. But Professor McCarthy argues that trademark cannot be used to protect publicity interests in an individual's identity because identity "is inherent in being a human being . . . ." MCCARTHY, supra note 10, § 5.2[C][1], at 5-12. This purely personal aspect to the right seems contrary to the notion, which he embraces, of a right of publicity as a freely assignable and descendible property right.

145. See supra notes 35–38 and accompanying text.


148. Id. at 247.

149. Id. at 253.
injunction, the court noted that the defendant was using the historical information to market a product completely different from the historical information itself. However, a consumer choosing between two different brands of herbal remedies should be entitled to this truthful information. By outlawing factual information about the product, the Nature's Way decision gives too much censorial control to the plaintiff.

In Motschenbacher v. R.J. Reynolds Tobacco Co., a famous race car driver successfully sued R.J. Reynolds for the unauthorized use of a picture of his distinctive race car, even though Motschenbacher himself was not recognizable. The court noted that although some minor changes to the car's exterior were made, the markings were "not only peculiar to the [driver's] car but they caused some persons to think the car in question was plaintiff's and to infer that the person driving the car was the plaintiff." Although some could have believed that the race car pictured was the plaintiff's, the mere use of the photograph hardly constituted an endorsement.

In Carson v. Here's Johnny Portable Toilets, Inc., the defendant used the name "Here's Johnny" for a portable toilet service. The court decided that use of the introduction from Carson's late night show was sufficient to identify Johnny Carson and therefore was a violation of Carson's publicity rights. In dissent, Judge Kennedy argued that the term "Here's Johnny" was "more akin to an idea or concept." Thus "[a]part from the possibility of outright federal [copyright] preemption, public policy requires that the public's interest in free enterprise and free expression take precedence over any interest Johnny Carson may have in a phrase associated with his person." In addition to the proprietor's interest in linking a celebrity's persona with his product, the public also has an interest in hearing commentary on public heroes, especially when it is factual, creative or humorous and where no endorsement could reasonably be implied.

150. Id.
151. 498 F.2d 821 (9th Cir. 1974).
152. Id. at 822.
153. Id. at 827.
154. 698 F.2d 831 (6th Cir. 1983).
155. Id. at 836.
156. Id. at 841.
157. Id.
C. Impersonations

In cases where a celebrity’s identity is evoked by an impersonator, a violation of the right of publicity often results. For example, in Onassis v. Christian Dior-New York Inc., the plaintiff sued Dior for using a Jackie Onassis look-alike in an advertisement. The defendants argued that they had not used a picture or portrait of Jackie Onassis as expressly prohibited by the New York privacy statute. However, the court held that the statute’s protections were broader, stating that “[n]o one is free to trade on another’s name or appearance and claim immunity because what he is using is similar to but not identical with the original.” Likewise, a federal court applying the New York statute held that when “the look-alike seems indistinguishable from the real person and the context of the advertisement clearly implies that he or she is the real celebrity, . . . the look-alike’s [depiction can be considered] a picture or portrait” of the celebrity and thus be an infringement of the right of publicity.

The same rationale has been applied in two California “sound-alike” cases. In Midler, an advertising agency hired a former backup vocalist for Midler and instructed her to “sound as much as possible like the Bette Midler record.” In establishing a common law action for sound-alikes, the Ninth Circuit emphasized that “[a] voice is as distinctive and personal as a face . . . . To impersonate her voice is to pirate her identity.” Although a court could reasonably interpret this type of imitation as deceptive, it is still unclear how dissimilar a style must be to avoid suit. Unfortunately, courts have gone further by allowing actions against impersonators where there was no likelihood of confusion and thus no deception.

159. Id.
160. Id. at 258.
161. Id. at 261.
164. Midler, 849 F.2d at 461.
165. Id. at 463.
Just because an impersonator evokes a celebrity's identity does not mean the celebrity should succeed in a claim against the impersonator. The performance of a successful impersonator, like Rich Little imitating President Richard Nixon, or Dana Carvey imitating H. Ross Perot, is the result of talent and hard work and presents the viewer with the persona of the impersonator as much as that of the impersonated. Thus, the appropriate standard should be the likelihood-of-confusion test. Imposing this standard would dispose of the numerous cases brought against Elvis impersonators, unless the fact-finder believes that Elvis lives.

D. Transformative Uses

In cases where a transformative use is made of an original work, and the new use makes reference to a public person, the transformative use should be protected by the First Amendment. Although the transformative use borrows from the original creation, it is nevertheless a work of its own.

In White v. Samsung Electronics America, Inc., a Samsung advertisement depicted a robot dressed in a gown, wig, and jewelry intending to imitate the game show hostess Vanna White. Samsung argued unsuccessfully that the advertisement was a "spoof" and should be protected under a theory analogous to that provided by the fair use doctrine of copyright law.

One justification for intellectual property protection is to have the public profit from the availability of creative works. Copyright law seeks to achieve this goal by providing sole license power as an incentive to the creator of the original work while allowing other fair use of that work.

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168. 971 F.2d 1395 (9th Cir. 1992).
169. Id. at 1399.
170. Id. Under copyright law, a parody is a permissive fair use of the original work if it meets the requirements set forth in section 107 of the Copyright Act of 1976. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994). This provision allows fair use of a copyrighted work for purposes such as criticism, comment, news reporting, teaching, scholarship, or research. It lists four factors for courts to weigh in determining whether a use falling within the general scope of fair use is in fact fair:
   (1) the purpose and the character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;
   (2) the nature of the copyrighted work;
   (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
   (4) the effect of the use upon the potential market for or value of the copyrighted work.
Disagreeing with the Ninth Circuit panel majority's decision in *White*, Circuit Judge Alex Kozinski argued that the majority's decision undermined the public's access to creative works by giving the artist too much control. Judge Kozinski asked where would it have led "[i]f every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically."  

Another justification for granting protection to the celebrity is to prevent unjust enrichment of the appropriator. Like any other artist, a parodist has invested time and labor to create the parody, and thus deserves the profit he has earned. In the *White* case, the unjust enrichment argument hardly justifies the result. Vanna White is a game show hostess. She did not create the show. The defendant's allusion to the show on which she appeared may have used some concepts from the show, but they clearly added something original.

When analyzing the applicability of the fair use defense, courts examine whether parody takes the place of the original work. If the audience of a parody does not have an interest in the original work, then the parody will not affect the market for the original work. Clearly, Vanna White was not displaced by a robot impersonator. Furthermore, no consumer would have confused the robot with Vanna White or believed Vanna White endorsed the product. As long as the work is clearly recognizable as a parody, there should be no right of publicity violation.

E. Non-Commercial Violations

Contrary to the categorical approach to application of the First Amendment are cases where non-commercial speech has been found to violate one's right of publicity. Instead of accepting that these are merely exceptions to the rule, it may be argued that the nature of the appropriation (i.e., was the use deceptive or so extensive as to be a theft, or, alternatively, was the use informational or transformative?) is more

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172. *Id.* at 1516.
174. *See*, e.g., *Campbell*, 510 U.S. at 591–92.
important than simply applying the commercial/non-commercial test to any use.

In Zacchini v. Scripps-Howard Broadcasting Co., the only U.S. Supreme Court case to recognize the right of publicity, the Court focused not on the medium but on the nature and extent of the use. In Zacchini, the entire performance of a circus performer known as the human cannonball, was recorded and replayed on a television news program against the express request of the performer. The Court held that even a presentation which could be labeled "news" was actionable because it "poses a substantial threat to the economic value" of the plaintiff's publicity rights. Thus, the Court did not accept a First Amendment defense based on the defendant's status as a member of the media or that the use was confined to a news program. Instead, the court looked to the nature of the particular expression and decided it was more theft than news.

However dangerous this opinion seems to First Amendment principles—setting the courts loose as censors upon non-commercial speech—the holding returns to a case-by-case balancing approach. It can be argued that Zacchini is consistent with the idea that all references are protected by the First Amendment as long as there is not wholesale theft or deception. Whatever threat to First Amendment principles the Zacchini decision holds as precedent for right of publicity cases is limited by the unusual facts of the case, specifically, that Zacchini's entire act was taken. Although not fixed by the performer, the taped broadcast of a performance tangibly appropriates the creative effort and the product of the performer. The contours of the performance are distinguishable both in kind and by degree from an idea or a reference to a free-floating image. As such, Zacchini may be considered a right of performance case better handled by common law copyright than a right of publicity case.

Thus, it may be said that the Supreme Court has not approved any typical right of publicity cases. In fact, in approving the right of

177. Id. at 578–79.
178. Id. at 563–64.
179. Id. at 575.
180. Id.
181. Id. at 576.
183. Professor McCarthy accepts that the Zacchini decision protects performance values and not recognition values, which are the essence of the right of publicity. McCARTHY, supra note 10, § 8.12[A], at 8-92.
publicity in *Zacchini*, the Court relied heavily on the “economic incentive” argument as the necessary impetus for an entertainer “to make the investment required to produce a performance of interest to the public.”\(^{184}\) The Court noted that the economic incentive rationale is much more compelling when a performer’s entire act has been appropriated than it is in the typical right of publicity case:

> [T]he broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade . . .

Thus, in this case, Ohio has recognized what may be the strongest case for a “right of publicity”—involving, not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.\(^{185}\)

Thus, *Zacchini* is the rare case that, if overly relied upon, makes bad law. Although recording and replaying an entire performance without consent probably should be actionable, any offhand reference should not be.

Posing a much greater threat to free speech than the few cases that ultimately succeed against non-commercial uses are the numerous cases in which celebrity plaintiffs evade summary judgment.\(^{186}\) When courts decide that a triable issue of fact exists for uses that arise in non-commercial settings, parties with deep pockets are able to inhibit performers and the press by nevertheless litigating a losing case.\(^{187}\) Such cases illustrate the advantages to maintaining bright-line rules. Without them, courts would be forced to balance an individual’s property interest in her identity against the value of the trespasser’s use. Having judges decide what speech is valuable enough to be protected by the First Amendment is contrary to a free-marketplace-of-ideas approach and could introduce an open season on commercial and non-commercial speech.

Although a strict bright-line rule exempting all non-commercial users might solve this problem, such a solution might continue to limit all uses deemed commercial, regardless of their merits or whether they were deceptive, while permitting the type of wholesale theft that occurred in *Zacchini*. An alternative solution similar to that adopted under a copyright


\(^{185}\) Id.


fair use analysis would be to weigh the non-commercial nature of a use as merely on factor in favor of immunity from a right of publicity claim.¹⁸⁸

VI. CHALLENGING THE JUSTIFICATIONS FOR THE RIGHT OF PUBLICITY

A. Just Desserts

One justification for limiting the free use of a celebrity's image is that the image is a product of the celebrity's skill and hard work. Applying Locke's theory of property, it has been said that "image" is something the celebrity has invested labor to create, thereby gaining a property interest in his or her image.¹⁸⁹ Once the celebrity acquires the right to prevent people from using the image without consent, the celebrity also obtains an opportunity to receive consideration in exchange for the consent, thus rewarding the celebrity for creating the image.

Yet, because a heroic image is so artfully crafted, it is possible to mistake the creation for the creator. As with an actor speaking a writer's lines upon a director's instruction, the image created may be the product of several people, but the right of publicity credits only the actor with the persona created. Giving the hero sole credit for the image means accepting heroic fiction as fact. As a result, the personal property right in the image is given to the object of creation, rather than to those actually responsible for a shared creation. Thus, to the extent that the right of publicity vests in the hero, the hero obtains undue control over use of the image and unjust enrichment by receiving the rights and benefits for an image the hero is only partly responsible for creating. As the Ninth Circuit held in White, the property value in one's image may be just the result of "dumb luck."¹⁹⁰

Even if the celebrity has gained fame through skill and hard work, this effort does not entitle the celebrity to complete control over the use of the public image. The argument, which amounts to a defense against the right of publicity, is that having thrust themselves into the public spotlight, celebrities must bear a greater burden of public comment. As the majority in Cardtoons noted: "[F]ame is a double-edged sword."¹⁹¹

¹⁸⁹. See, e.g., McCarthy, supra note 10, § 2.1[D], at 2-8.
B. Unjust Enrichment

Even if the just desserts argument fails in White, as Vanna White did not (exclusively) create her own image, the response is: “Why should Samsung benefit from Vanna White’s fame?” Although Samsung obtains some value from its game show depiction of Vanna White without providing her compensation, Samsung’s ability to depict her without fear of liability outweighs Vanna White’s interest. Courts should consider society’s entitlement to Samsung’s creation. The hero’s ability to control his or her own image must be balanced against society’s ability to use heroic images as a means of public discourse.

The public media, as a forum for transmitting images for public consumption, and as a commercial enterprise, relies on heroes to tell stories, to educate, to titillate, to attract an audience, and to sell newspapers, magazines, radio shows, television programming, movies, and web sites. Besides purveying public images, the media is itself manipulated by the public. The media acts as a proxy for public views. The media is a market that reflects consumer interest and creates fame. The public creates its heroes, and thus should have a right to use them short of deception or wholesale theft.

C. Media and Heroes Sell

Conveniently, heroes seeking publicity and the media trading on public interest in the portrayal of public images are engaged in a mutually beneficial relationship. To a great extent they are engaged in a singular commercial enterprise. The celebrity persona helps sell newspapers and newspapers help “sell” a celebrity’s persona. From People Magazine to The National Enquirer, from CBS Evening News to Entertainment Tonight, from up-close and in-person Olympic vignettes to locker-room interviews, from fireside chats to political convention speeches, from sneaker advertisements to infomercials, heroic images are constantly being manufactured and “sold.”

While the media merely provides interesting images to build an audience, heroes would like greater control of their public images. So, although they share an enterprise, there is conflict between the purveyors and the purveyed. The battle between them has led the law to impose several different types of limits on what can be said about heroes. If the image presented is untrue and damaging, the hero may claim defamation. For public figures, the courts have set higher standards of proof for defamation. Not only has the hero voluntarily thrust him or herself into the vortex of public affairs, but the ability to speak freely about public
figures without fear of litigation has been considered essential to the First Amendment value of encouraging free discourse and wide-ranging public debate. The public uses heroes to help describe and define our world. It is as if by protecting our right of hero depiction we achieve a greater freedom of cultural self-definition. Since the stock in trade of images is both commercially and intellectually valuable, it should only be restrained to prevent outright falsity.

The sale of media images differs from the sale of goods. By their nature, images are not tangible, so they are difficult to sell on their own. Thus, the sale of an image is usually linked to the sale of something else. For example, the television-viewing public creates a market in images (programming) that allows a sponsor to subsidize the broadcast in return for the opportunity to present advertising. The “sale” of programming to the viewer represents value that is then resold to sponsors according to demand. Thus, the sale of programming to the public is indirect and is paid for in the cost of the sponsor’s products. Similarly, celebrity images presented in ads sell interest in consuming (watching) the ad and in consuming (purchasing) the product.

Although images are intangible, and their sale is often indirect, they are still commodities and their exchange must be considered as “commercial” as any more tangible commodities. Moreover, it cannot be claimed that there is a distinction between the message of the commercial and the message of the surrounding television program. The medium is the message and, to some extent, the message of both is “buy.” Nothing prevents the characters in a situation comedy from dropping their roles and expressing their affection for dish soap and urging its consumption, as they sometimes do. It might be unseemly for Peter Jennings to unabashedly plug products, but cynics would say that he refrains from such blatant commercialism only because of the damage it would do to his image of dignity and journalistic detachment, an image that must be maintained in order to better sell dish soap.

Certainly, it can be said that the aim of the media is to sell, even if selling is not its only aim. The media sells images by educating and

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192. The print media, although its product is more tangible than that of the electronic media and can be purchased directly by the public, also derive the major portion of their income from advertising. Traditionally, in television and radio, consumption could only be measured by viewer or listener ratings, but cable television alters this equation when charging viewers directly. The question with the Internet remains, “Who pays?”

193. See generally EDWARD J. EPSTEIN, NEWS FROM NOWHERE (1973) (analyzing television broadcast companies as business organizations composed of employees whose primary motivation is the perpetuation of the organization and their own careers, and who therefore make broadcasting decisions based on what sells).
entertaining, and so do commercials. The appropriation of heroic images is not degraded by selling something in addition to an ideal. There is nothing inherently evil in linking a heroic image with a sale, whether offered by ancient authors or Madison Avenue ad writers.

Speech contains a mixture of motives. If the use of public figures for commentary is valuable and mass media is our forum for public discourse in advertisements as well as shows, then the forum needs protection. Selling does not preempt creativity and social commentary. In fact, because there is selling, the advertiser must speak to the viewer to hold his attention. Even if an empirical survey of advertising reveals that nothing of value is being said, why preclude this format from the meaning that commentary on public figures can impart?

VII. CONCLUSION

As with ancient heroes, to a great extent modern heroic images are manipulations used to help tell stories and to sell those stories. But modern heroes, perhaps because they are alive, have images that change. Their images are not fixed upon creation, but reflect an on-going public dialogue about good and evil. We create and re-create our heroes as they move before a backdrop of changing social ideals. In heroic images we see images of ourselves and images of perfection. Only by protecting the ability to freely evoke heroic images without assigning censorship control to the hero can we as a society aspire to virtue—on baseball cards and portable toilets.