Loyola of Los Angeles Entertainment Law Review

Volume 18
Number 3 *Symposium: International Rights of Publicity*

Article 1

3-1-1998

Foreword: The Right of Publicity—Towards a Comparative and International Perspective

F. Jay Dougherty

Follow this and additional works at: https://digitalcommons.lmu.edu/elr

 Part of the Law Commons

Recommended Citation

F. Jay Dougherty, *Foreword: The Right of Publicity—Towards a Comparative and International Perspective*, 18 Loy. L.A. Ent. L. Rev. 421 (1998).
Available at: https://digitalcommons.lmu.edu/elr/vol18/iss3/1

This Symposium is brought to you for free and open access by the Law Reviews at Digital Commons @ Loyola Marymount University and Loyola Law School. It has been accepted for inclusion in Loyola of Los Angeles Entertainment Law Review by an authorized administrator of Digital Commons@Loyola Marymount University and Loyola Law School. For more information, please contact digitalcommons@lmu.edu.

SYMPOSIUM

FOREWORD: THE RIGHT OF PUBLICITY—TOWARDS A COMPARATIVE AND INTERNATIONAL PERSPECTIVE

F. Jay Dougherty[*]

I. INTRODUCTION

The initial impetus for this symposium was to inform U.S. attorneys of the existence or non-existence of a right to control the commercial exploitation of one's name or likeness under foreign laws in view of the scarcity of information in English regarding the right of publicity. Comparative law perspectives are "needed now more than ever because of the expansion of international transactions; the globalization of legal culture; and the movements for unification, federation, and law reform around the world."[1] The "merchandising" of U.S. celebrities is a huge international business.[2] Many advertisements are internationally distributed. The internet is the ultimate borderless medium, incorporating both content and advertising. Because of personal jurisdiction and choice of law issues,[3] it may be necessary to pursue claims in foreign courts.[4] As a result, U.S. attorneys will greatly benefit from a knowledge of comparative right of publicity laws.

---

* Visiting Associate Professor of Law, Loyola Law School of Los Angeles. The author would like to thank Professor Edith Friedler and Professor Lawrence Helfer for their helpful suggestions in connection with this ariticle, and the editors and staff of the *Loyola of Los Angeles Entertainment Law Journal* for thier tireless work in preparing this Foreword and the other contributions to the Symposium. Of course, any opinions, expressed or implied, or any errors made in this article are the responsibility of the author.

1. P. John Kozyris, *Comparative Law for the Twenty-First Century: New Horizons and New Technologies*, 69 TUL. L. REV. 165, 178 (1994).

2. *See* Benjamin Barber, *The Saturday Essay: Disneyfication that Impoverishes Us All*, INDEP., Aug. 29, 1998, at 7; Roberto Muller, *Play Ball: Could You Be Contender in the Global Sports Market?*, MINORITY BUS. ENTREPRENEUR, Oct. 31, 1997, at 64; Keith Damsell, *Glitz Alone Fails to Keep Planet Hollywood Aloft*, FIN. POST, Feb. 12, 1997, at 23.

3. *See* discussion *infra* Part IV.B.

4. *See* discussion *infra* Part IV.A.

With the increasing incorporation of intellectual property into the domain of world trade, a true "international law" concerning the right of publicity is likely.[5] If there is going to be a "harmonization" of this right, scholars and legislators should have an understanding of what is to be harmonized.[6]

There are two overarching issues in this Foreword and the articles it introduces. First, many important right of publicity issues, including choice of law, assignability, inheritability, etc., turn on the characterization of the right as either privacy-based or property-based. Sometimes opposite results occur due to these opposing characterizations. Second, this forward will explore the extent to which the disjointed American right of publicity has affected, as well as whether it should affect, the right of publicity jurisprudence in other countries.

This Foreword discusses the right of publicity and conflict of laws in the U.S., briefly summarizes the right of publicity and conflict of laws in other countries placing the Articles which follow in a global perspective, and provides an overview of the current policy debate concerning right of publicity. This commentary suggests, by reference to copyright law, that although there may be benefits to an international proprietary right of public-

5. The basis for a true international law concerning right of publicity is illustrated in several international treaties and instruments providing for recognition of a right to privacy, such as Article 12 of the Universal Declaration of Human Rights, Article 8 of the European Convention on Human Rights, Article 5 of the American Declaration on Human Rights and Duties of Man, and Articles 16 and 17 of the International Covenant on Civil and Political Rights. *See, e.g.*, Elisabeth Logeais, *The French Right of Image: An Ambiguous Concept Protecting the Human Persona*, 18 LOY. L.A. ENT. L.J. 511, 513–15 (1998). These provisions have been a source of support for development of the law in many countries. *See id.*; Guillermo Cabanellas, *The Right of Publicity Under Argentine Law*, 18 LOY. L.A. ENT. L.J. 449, 452–53 (1998). The importance of limits on these rights is also reflected in these treaties' provision for freedom of expression. *See* Universal Declaration of Human Rights, Art. 19; International Covenant on Civil and Political Rights, Art. 19; Art. 10 of the European Convention on Human Rights; Art. IV of the American Declaration of Human Rights and Duties of Man; *see, e.g.*, Logeais, *supra* note 5, at n. 104 and accompanying text; *cf.* Neil Weinstock Netanel, *Asserting Copyright's Democratic Principles in the Global Arena*, 51 VAND. L. REV. 217, 296–307 (1998) (discussing international free speech law as it may be implicated in the expansion of copyright globally).

6. In addition to the articles and materials cited elsewhere in this Foreword, the following are additional resources in English regarding the right of publicity and similar rights in other countries: Julius C.S. Pinckaers, *The Right of Persona: A New Intellectual Property Right for the US and EU*, 68 COPYRIGHT WORLD 26 (1997); Silvio Martuccelli, *An Up-and-coming Right—The Right of Publicity: Its Birth in Italy and its Consideration in the United States*, 4 ENT. L. REV. 109 (1993); Elisabeth Logeais, *The French Right to One's Image: A Legal Lure?*, 5 ENT. L. REV. 163 (1994); Jukka V. Muhonen, *Right of Publicity in Finland*, 3 ENT. L. REV. 103 (1997); B. St. Michael Hylton and Peter Goldson, *The New Tort of Appropriation of Personality: Protecting Bob Marley's Face*, 55 CAMBRIDGE L.J. 56 (1996) (discussing the development of the tort of appropriation of personality in Jamaica); Frits Oppenoorth, *Facets of Dutch Portrait Law*, 28 COPYRIGHT WORLD 38 (1993).

ity, one should be cautious of advocating "transplantation" of the U.S. right into other countries.

II. THE RIGHT OF PUBLICITY IN THE U.S.

The right of publicity, the recognition of a property right in the commercial use of a person's indicia of identity[7], appears to be an invention of U.S. judges and lawmakers.[8] Initially based on a perceived "natural right" of privacy[9] and nurtured by judicial concern for deterring unfair competition through consumer deception,[10] the recognition of the right of publicity as "property" is usually attributed[11] to *Haelen Laboratories v. Topps Chewing Gum.*[12] The *Haelen* decision posited that the right should be recognized as something different from those sources (as it turns out mistakenly interpreting New York law)[13] and should be treated as "property"—exclusive, assignable, and descendible.[14]

The right of publicity is a matter of state law in the United States. Although a proprietary right of publicity seems well-established in the U.S., it is not necessarily uniformly recognized. There is no federal right of publicity, and determining how many states recognize the right is complicated by several factors. First, some states protect the commercial right, but under a rubric of invasion of privacy.[15] Second, many states have not directly addressed the question.[16] Third, many of the courts that have addressed the

---

7. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

8. *See generally,* Roberta Rosenthal Kwall, *Fame,* 73 Ind. L.J. 1 (1997). "Lawmakers" refers to courts and legislatures. *See, e.g.,* Pavesivich v. New England Life Ins. Co., 122 Ga. 191 (1904); Roberson v. Rochester Folding Box Co., 71 N.Y.S. 876 (1901); N.Y. CIV. RTS. LAW §§ 50-51 (1998).

9. *See generally,* Pavesevich v. New England Life Ins. Co., 122 Ga. 191 (1904) (justifying recognition of a right of privacy by analogy to a human being's natural right to control one's body).

10. *See generally* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, §§ 5.2–5.4 (1995); *see, e.g.,* Allen v. National Video Inc., 610 F. Supp. 612 (S.D.N.Y. 1985) (using a Woody Allen look-a-like in advertisement violates Lanham Act § 43(a)); Estate of Elvis Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (impersonating Elvis Presley violated right of publicity, infringed upon trademarks, and constituted unfair competition).

11. *See* MCCARTHY, *supra* note 10, § 1.7; Melville B. Nimmer, *The Right of Publicity,* 19 LAW & CONST. PROBLEMS 203, 204 (1954).

12. 202 F.2d 866 (2d Cir. 1953). Trading cards still provide a source of much case law in connection with the right of publicity. *See, e.g.,* Allison v. Vintage Sports Plaques, 136 F.3d 1443 (11th Cir. 1998); Block v. Major League Baseball, 65 Cal. App. 4th 538 (1998); Barnett v. Topps Co., 1998 WL 257859 (E.D. Pa. 1998).

13. *See* Stephano v. News Group Publications, Inc., 64 N.Y.2d 174 (1984).

14. *See* Haelen Lab., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).

15. *See* MCCARTHY, supra note 10, § 6.1.

16. *Id.*

question are federal courts surmising what they believe to be the applicable state law, and in some cases, the applicable state's courts later rejected the right of publicity.[17] Professor McCarthy, author of the major treatise on rights of publicity,[18] finds that as of June, 1997, twenty-five states recognize the right either by statute or in common law,[19] and only fourteen of those states provide for a post-mortem right.[20] The U.S. may be "the leading proponent of publicity rights,"[21] but the process of recognizing the right continues to involve debate as to the proper subject matter and scope of the right.[22]

III. THE RIGHT OF PUBLICITY—AN "AMERICAN" RIGHT?

One recent U.S. article justifies the right of publicity by referring to our cultural fabric and history and our legal conceptions of property.[23] While finding the roots of a legal right in the history, sociology, and culture of a society is fascinating as a hypothetical explanation,[24] this approach seems less useful when viewed as *justification* for that right. Cultural analysis may explain the differences between the California approach and the French approach, but can it explain the differences between the treatment in Georgia (the first state to recognize commercial appropriation privacy at common law) and South Carolina (which has not yet addressed the question)? However, the position of current U.S. law instead results from the existence of interest group power in a particular state (California has many successful celebrity citizens) and the happenstance of the location of risk-

17. *Id.*

18. *See* MCCARTHY, *supra* note 10, at 1; *see also,* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, *supra* note 7, Reporter's Note (describing McCarthy's as the "leading treatise").

19. *See* MCCARTHY, *supra* note 10, § 6.1[B].

20. Assignability and descendibility are two "property" characteristics that seem to differentiate a "right of publicity" from a "right of privacy."

21. Kwall, *supra* note 8, at 15.

22. *See generally* Stephen R. Barnett, The Right of Publicity Versus Free Spech in Advertising: Some Counter Points to Professor McCarthy, 18 HASTINGS COMM. & ENT. L.J. 593 (1996); Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 127 (1993).

23. *See id.*

24. It has been said:

> [Y]ou cannot truly pursue the comparative method through the study of formal legal texts alone. It is necessary to get to know what is behind the texts and also, even more important, how they function. This requires understanding the legal culture that produced the laws, and more broadly, the social and economic structures and the ethical and political values that support them. Laws cannot be grasped in an idealized form outside the context of the society that created them.

Kozyris, *supra* note 1, at 168.

taking potential defendants and proactive plaintiffs,[25] in addition to cultural factors.[26]

Furthermore, suggesting that the U.S. "stands in the forefront among nations" or that it "is a leader among nations in protecting publicity rights" may be understood to imply that other nations should follow our "lead."[27] But, "[b]efore a legal model can be transplanted, the conditions in the two societies—the one from which it comes and the one to which it goes—must be taken into account."[28] The right of privacy, from which the right of publicity was born, has been described a "uniquely American,"[29] but other nations recognize rights protecting similar interests, and their roots may precede those of the U.S. right. For example, the French courts recognized the right of privacy as early as the *Rachel* case in 1858.[30] Moreover, the right of privacy developed vigorously in France as it was less proscribed by freedom of speech and the press.[31] German law recognized a "portrait right"[32] as early as 1907,[33] commercial exploitation as a violation of personal rights in the *"Graf Zeppelin"* case in 1910, and protection of commercial interests

25. *See generally* Pavesich v. New England Life Ins., Co., 122 Ga. 191 (1904).

26. Cultural studies provide a stimulating and provocative description behind the development of the law. The collapse of monarchy and the growth of democracy did not give birth to fame, but made it available to everyone. *See* LEO BRAUDY, THE FRENZY OF RENOWN: FAME & ITS HISTORY 18 (Oxford University Press 1986). Is propertizing fame an instinctive attempt to make it impervious to the audience? Does it take celebrity back from the general public and create a new elite, resembling monarchy? There are intriguing areas for further research and thought.

27. The U.S. is probably a "net exporter" of celebrity. *See Symposium, Identity Crisis: A Vision for the Right of Publicity in the Year 2020*, 20 COLUM.-VLA J.L. & ARTS 1, 33 (1995).

28. Kosyris, *supra* note 1, at 169.

29. MCCARTHY, *supra* note 18, at § 1.2.

30. *See* Logeais, *supra* note 6, at 164.

31. *See generally* Jeanne M. Hauch, *Protecting Private Facts in France: The Warren & Brandeis Tort is Alive and Well and Flourishing in Paris*, 68 TUL. L. REV. 1219 (1994) (describing the origins and nature of the right of privacy in France).

32. This term generally refers to the right, found usually in a nation's copyright law, of the subject of a portrait to prohibit the making or exploitation of the portrait. *See* Frits Oppenorth, *Facets of Dutch Portrait Law*, 28 COPYRIGHT WORLD 38, 38-39 (1993). While there is no such provision in U.S. copyright law, the owner of copyright in a photograph of an identifiable human subject does not have the right to use that likeness in advertising or on products, because to do so would violate the subject's rights of publicity (and possibly, privacy). *See, e.g.*, Michaels v. Internet Entertainment Group, Inc., 5 F. Supp. 2d 823 (C.D. Cal. 1998) (holding that a publicity claim regarding mere reproduction of video is preempted by Federal copyright law, but not regarding use of names and likenesses in advertising); Ainsworth v. Century Supply Co., 295 Ill. App.3d 644 (1998) (using an authorized video in an ad may exceed consent and violate a right of publicity). Such a use might also constitute unfair competition, if the use would be likely to cause confusion as to source, sponsorship or approval. *See* Rhodes v. Sperry & Hutchinson Co., 193 N.Y. 233 (1908), *aff'd sub nom., Sperry & Hutchinson Co. v. Rhodes*, 220 U.S. 502 (1911); MCCARTHY, *supra* note 10, § 11.14[B].

33. *See* KUG § 22 (German law of artistic creations); MCCARTHY, *supra* note 10, § 6.25[A].

in the *Paul Dahlke* case in 1956.[34] Recognition of the interests protected by the right of publicity may in some countries be influenced by U.S. case law, legislation, and commentary, but to conclude that the U.S. leads and others follow may be mistaken. Such a conclusion may inadvertently imply that the U.S. approach to this legal problem is the best one for other societies.

IV. CONFLICTS OF LAW AND PERSONAL JURISDICTION

Choice of law jurisprudence generally has been described as "confused and conflicting"[35] and "in considerable disarray."[36] In the U.S., various methods used by the several states to determine choice of law in approaching a multistate exploitation of publicity rights has been called "inherently arbitrary."[37] Some advocates cite a need for a uniform federal right of publicity statute.[38] In an international context, there are very few right of publicity cases discussing choice of law. U.S. reported cases mainly concern the exploitation in the U. S. of the persona of an individual (or musical group) domiciled in another country.[39] In those cases the courts applied either the law of the state where the infringement occured, or the law of the state where the licensee was domiciled.[40]

A. Choice Of Law Theories

The U.S. applies various choice of law theories to cases which include:[41] (1) the "Vested Rights Theory;"[42] (2) the "Most Significant Relationship" approach;[43] (3) "Governmental Interest Analysis;"[44] (4) Professor

---

34. Christof Kruger, *Right of Privacy, Right of Pesonality and Commercial Advertising*, 13 ILC 183, 184 (1982); *see also* W. Van Caenegem, *Different Approaches to the Protection of Celebrities against Unauthorized Use of their Image in Advertising in Australia, the United States and the Federal Republic of Gemany*, 12 EIPR 452 (1990).

35. Richard Cameron Cray, Comment, *Choice of Law in Right of Publicity*, 31 UCLA L. REV. 640, 651 (1984).

36. W. RICHMAN & W. REYNOLDS, UNDERSTANDING CONFLICT OF LAWS § 70a (1984).

37. Cray, *supra* note 35, at 641.

38. *See, e.g.*, J. Eugene Salomon, Note, *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 SO. CAL. L. REV. 1179 (1987); Cray, *supra* note 35, at 641.

39. *See* discussion *infra* Part IV.A.

40. *See id.*

41. *See Hataway v. McKinley*, 830 S.W.2d 53 (Tenn. 1992) (adopting the "most significant relationship" approach to tort actions, and discussing the various other approaches and states which follow each).

42. RICHMAN & REYNOLDS, *supra* note 36, §§ 51-56.

43. RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 153 (1971); *see* RICHMAN & REYNOLDS, *supra* note 39, § 60. This approach looks first to whether there is a determinative statutory choice of law rule. If there is no such statutory rule, it sets forth presumptive rules for

Leflar's "Choice Influencing Considerations" approach;[45] (5) the law of the forum state ("*lex fori*"); and (6) some combination of theories.[46]

Each of these theories has its advantages and disadvantages when applied to interstate or international right of publicity claims. The Vested Rights Theory, applied in approximately one-third of the states,[47] seems particularly ill-suited to the right of publicity because it has characteristics of both property and tort, and because it may implicate contractual transfers.[48] This approach also fails to expressly consider the real underlying policy interests at stake regarding right of publicity claims, although judicial "escape devices" have been used to avoid results judges felt would be unfair.[49] The Most Significant Relationship approach,[50] used by almost half the states, permits a court to expressly consider policy,[51] but it is criticized

---

different issues and types of claims, but ultimately looks to the law of the state of the most significant relationship to the occurrence and the parties, determined by application of a set of general principles set forth in § 6. Included among those principles is consideration of underlying policies.

44. *See* MCCARTHY, *supra* note 10, § 11.3[D][3][b]. In this approach, the court looks carefully at the policies of the forum and those of any other interested states. If only one state's policies are implicated in the actual dispute, there is a "false conflict," and the interested state's law applies. If more than one state's policies would be furthered, there is a "true conflict." In that event, the court should examine the issue more carefully to try to avoid the conflict, but, if that cannot be achieved, the court should apply the forum law. *See* RICHMAN & REYNOLDS, *supra* note 32, § 63. Strictly speaking, this approach does not involve the balancing of competing policies, although variations of this approach, such as the "comparative impairment" approach used in California, do attempt to weigh competing policy interests. *Id.* § 64.

45. Under this approach, courts apply five "considerations:" predictability of result, maintenance of interstate and international order, simplification of the judicial task, advancement of the forum's interests, and the better rule of law. The last consideration reflects the observation that judges consider "socio-economic jurisprudential standards" to achieve what they consider a just result in the particular case. RICHMAN & REYNOLDS, *supra* note 32, § 66; Robert A. Leflar, *Choice-Influencing Considerations in Conflicts Law*, 41 N.Y.U. L. REV. 267 (1966). *Id.*

46. *See* Hataway v. McKinley, 830 S.W.2d 53, 55 (Tenn. 1992).

47. MCCARTHY *supra* note 10, at § 11.3 [A].

48. *Id.*; Cray, *supra* note 35, at 655; *see* Allison v. Vintage Sports Plaques, 136 F.3d 1443, 1445 (11th Cir. 1998) (examining Alabama law).

49. *See* RICHMAN & REYNOLDS, *supra* note 32, at 153–54.

50. The Restatement Second Conflict of Laws contains rules for addressing commercial appropriation privacy, although not expressly pertaining to the right of publicity. RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 152 ("Right to Privacy") § 153 ("Multistate Invasion of Privacy"). In a multistate invasion of privacy, § 153 would follow a single publication rule, applying the local law of the state that has the most significant relationship to the occurrence and the parties under the general principles in § 6. Section 153 states that that state most often will be the plaintiff's domicile, if the offending material was published in that state. *Id.* § 153. Section 10 indicates that these rules would generally apply to a case with elements in several foreign nations as well, although noting that there may be factors in such a case which would lead to a different result that if the case had been an interstate matter. Among such factors would be differences in political, social and legal institutions, and concerns arising from the lack of Constitutional safeguards. *Id.* § 10, comment d.

51. *See Hataway*, 830 S.W.2d at 57–58.

for its complexity. In permitting almost anything to be considered, this approach is difficult to predict.[52] The Governmental Interests approach has similar difficulties to the Most Significant Relationship approach. The Governmental Interests approach fails to provide a basis for choice where more than one state has a strong interest, and it permits a court to favor the forum state law.[53] The Choice Influencing Considerations approach likewise permits forum favoritism.[54] The *lex fori* approach has predictability, but it is inherently arbitrary in the context of multiple-state infringements and it permits forum-shopping.[55] A commentator has recommended a state of "greatest infringement" approach,[56] which has been criticized as "unpredictable in a multistate infringement case."[57] Ultimately, as Professor McCarthy noted, which choice of law rule is best will depend on "whose ox is being gored."[58]

There are at least two relevant types of cases where the law of the domicile of the plaintiff seems to be applied. First, as to the right of privacy, whether a state applies a Vested Rights approach (which would look to the place where the injury occurs) or a Most Significant Relationship approach, the law of domicile of the plaintiff would be the usual rule, assuming that the offending material was exploited in that state.[59] Second, although there are no reported cases dealing with the issue as to a non-U.S. celebrity,[60] there is case law to support the proposition that the applicable law as to descendibility of the right of publicity should be the law of the state where the celebrity was domiciled at the time of death.[61] Following this

---

52. MCCARTHY, *supra* note 10, § 11.3[A]

53. *See Hataway*, 830 S.W.2d at 58.

54. *See* RICHMAN & REYNOLDS, *supra* note 36, § 66[b].

55. MCCARTHY, *supra* note 10, § 11.3[D][2].

56. Cray, *supra* note 35, at 662.

57. MCCARTHY, *supra* note 10, § 11.3[D][2].

58. *Id.* § 11.3[E]

59. RESTATEMENT (SECOND) OF CONFLICT OF LAWS, 153; *see* MCCARTHY, *supra* note 10, §11.3[B].

60. As this Foreword was going to press, an Order was issued in the case of *Cairns v. Franklin Mint Company*. Cairns v. Franklin Mint Co., No. CV 98-3847 RAP (C.D. Cal. filed Oct. 16, 1998). Among other things, the court dismissed a right of publicity claim by the executors of the Estate of Diana, Princess of Wales, against a company producing and advertising various merchandise depicting Princess Diana. *Id.* at 6. The claim was dismissed based on the analysis that Cal.Civ.Code § 3344 and California choice of law rules dictate that the law of domicile at time of death determines whether the decedent's right of publicity survives death. *Id.* at 8–22. Because Princess Diana was domiciled in England, which does not recognize a right of publicity, no such right descended to her estate. *Id.* The author wishes to thank Doug Mirell, Esq. of Loeb & Loeb for providing a copy of the Order.

61. Cairns v. Franklin Mint Co., No. CV 98-3847 RAP (C.D. Cal. filed Oct. 16, 1998); *see* Factors Etc., Inc. v. Pro Arts, Inc., 652 F.2d 278 (2d Cir. 1981); Groucho Marx Prods., Inc. v. Day

approach, a U.S court (particularly in the Second Circuit) would deny a claim by heirs of Princess Diana against a defendant who exploited her likeness on merchandise, because she was domiciled in the U.K. at the time of her death, and the U.K. does not presently recognize a right of publicity.[62]

There are very few reported cases dealing with the appropriation of persona of a foreign person in the U.S. In *Bi-Rite Enters. v. Button Master*,[63] the plaintiffs, a company licensed to use the likenesses of English artists, claimed trademark infringement, unfair competition, and a right of publicity violation against defendant's unauthorized manufacturing/distribution of buttons and similar items.[64] The U.S. District Court for the Southern District of New York held that a New York state court would apply a "property" rule to a right of publicity claim, which would look to the "situs" of the property. In the case where the artists resided in the U.K., the "situs" of the property would be the state of domicile of the exclusive merchandising agent. The English artists did not have a claim under the law of their domicile, England, but they did have a claim under the law of Georgia, the state of incorporation of their exclusive representative. There is a level of unreality to determining the "situs" of such intangible property. If it is situated anywhere, one would think it would be the domicile of the persons whose personality was exploited. The same outcome could have been reached in this case by applying the law of the place where the exploitation took place. To the extent that this rule is applied in the future, it demonstrates the potential for manipulating outcomes by incorporating a merchandising agent in a state with strong rights of publicity.

Bi-Rite Enters. v. Bruce Miner Co.[65] applied the Most Significant Relationship analysis in a similar situation, and reached the same result as *Bi-Rite Enters. v. Button Master Co.*[66] *Bruce Minor* involved unauthorized posters of popular musical artists.[67] The sole issue on appeal was whether

---

& Night Co., 689 F.2d 317 (2d Cir. 1982); Acme Circus Operating Co., v. Kuperstock, 711 F.2d 1538 (11th Cir. 1983); MCCARTHY, *supra* note 10, § 11.3[D][3][a]. In *Acme Circus*, the 11th Circuit attempted to determine what rule California state courts would apply to this issue. The court concluded that California courts would apply California Civil Code § 946 to find the law of domicile applicable, and it did not have to determine whether the same result would obtain under California's governmental interests analysis. *Acme*, 711 F.2d, at 1540–41.

62. *See, e.g.*, Groucho Marx Prods., Inc. v. Day & Night Co., 689 F.2d 317 (2d Cir. 1982).

63. 555 F. Supp. 1188 (S.D.N.Y. 1983). *Button Master* was a suit by a manufacturer/distributor of buttons, posters and other novelty items bearing the marks of various musical artists and groups. *Id.* at 1191. Since the artists were "public figures" and could demonstrate no harm to their feelings, their privacy actions were denied. *Id.* at 1198. Summary judgement was granted to most of the artists, however, on the right of publicity claims. *Id.* at 1201.

64. *Id.* at 1191.

65. 757 F.2d 440 (1st Cir. 1985).

66. 555 F. Supp. 1188 (S.D.N.Y. 1983).

67. *Bi-Rite Enters.*, 757 F.2d at 441.

the court should apply the law of the artists' domicile or the law of the residence of the artist's exclusive licensee and merchandising representative (Connecticut, Illinois and Georgia, all of which recognize a right of publicity).[68] All the artists in this case resided in England, but the court, applying Massachusetts' Most Significant Relationship analysis, decided that "[t]he law of the United States governs."[69]

The court considered the factors set forth in section 6 of the Restatement Second Conflicts of Laws.[70] First, the court looked at the "needs of the interstate and international system."[71] Because of the "[p]ervasive and much prized" trade between Great Britain and the U.S. in the popular music industry which the court determined would be nurtured by giving "[t]he same commercial rights to foreigners as nationals"[72] this court favored applying U.S. substantive law.

Second, the court looked at the "relevant policies of the forum," and compared it to the laws of Illinois, Connecticut, Georgia, and England.[73] The court determined that the states policies are to prevent unjust enrichment and provide economic incentive to invest in a "[p]erformance of interest to the public."[74] Britain's policy was assumed to be "[a] policy choice favoring unrestricted competition in the area of commercial exploitation of names and likenesses."[75] However, the court found that Britain's interest and its public would not be harmed by allowing performers to restrict exploitation of their names and likenesses in the U.S.[76]

Third, the court looked at the protection of expectations. The court stated that the copyrights of the photographs from which the posters were made were licensed to the defendant. The court went on to state the defendant's contention that the photographers who took the publicity photos at "unrestricted photosessions" expected to have a broad range of rights.[77] However, the court rejected defendant's broad argument and its assumption that as a result of "unrestricted photosessions," performers expected to convey U.S. publicity rights.[78]

---

68. *Id.* at 442.

69. *Id.* at 446.

70. *See* RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 6 (1971).

71. *Bi-Rite Enters.*, 757 F.2d at 441.

72. *Id.* at 444.

73. *Id.*

74. *Id.* (*citing* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977)). *See* discussion of these policies *infra*, at 119–20.

75. *Bi-Rite Enters.*, 757 F.2d at 445.

76. *Id.*

77. *Id.*

78. *Id.* at 446.

Finally, the court found that "certainty, predictability, and uniformity" would be served by applying U.S. state law.[79] The court concluded that Georgia's law, the state of incorporation of the exclusive merchandising representative, would apply to the claims of the individual artists, presumably because this was the situs of the "property."[80] Based on the foregoing, the court affirmed the grant of preliminary injunction to the plaintiffs.[81]

But certainty and predictability could be better served by a simpler rule, such as applying the law of the state where the infringing acts took place. The *Bruce Miner* court could have reached the same outcome on that basis.

In *Nice Man Merchandising v. Logocraft*,[82] a case by a Minnesota corporation against a U.K. company with offices in Pennsylvania, the court purported to follow *Bruce Miner's* analysis. However, it applied the law of the forum and where the infringement occurred, rather than that of the domicile of the plaintiff licensee.[83]

These cases leave great uncertainty as to what law a U.S. court will apply. It does seem clear, however, that where (i) there is a licensee domiciled in a state which recognizes the right, (ii) the forum recognizes the right,

---

79. *Id.*

80. *Id.*; *see* MCCARTHY, *supra* note 10, § 11.3[D][1].

81. *Bi-Rite Enters.*, 757 F.2d at 446; *accord*, Nice Man Merchandising, Inc. v. Logocroft Ltd., No.CIV.A..91-7475, 1992 WL 59133, at *1 (E.D. Pa. Mar. 18, 1992) (applying Pennsylvania conflict of laws rules, which permits an analysis of the policies and interests underlying a particular issue); Apple Corps. v. Button Master, P.C.P., Inc., No.CIV.A.96-5470, 1998 WL 126935, at *1 (E.D. Pa. Mar. 19, 1998) (allowing summary judgment for plaintiff exclusive licensee against unauthorized manufacturer/distributor of buttons featuring name, likeness and registered trademarks of The Beatles). Note that the items sold by the defendant in both *Bi-Rite Enters.*, and *Logocraft* were not "bootlegs" manufactured by the defendant, but apparently purchased abroad where they may not have been unlawful. There is very little case law as whether a "first sale doctrine" applies in right of publicity actions, so that items sold with the consent of the person depicted could be resold without liability. The Eleventh Circuit recently held that it does. Allison v. Vintage Sprots Plaques, 136 F.3d 1443 (11th Cir. 1998). The first sale doctrine applies in connection with copyrights, patents and trademarks. *Id.* at 1448. The *Bi-Rite Enters.* opinion effectively rejects the first sale doctrine under its facts. *See Bi-Rite Enters.*, 757 F.2d, at 445–46. *Nice Man* enjoined the sale of unused but presumably authorized European promotional posters including names and likenesses of musical artists in the U.S., as a violation of the artists' rights of publicity and Lanham Act § 43(a), without addressing the first sale issue. *Nice Man*, 1992 WL 59133, at *6.

82. No. CIV.A. 91-7475, 1992 WL 59133, at *1 (E.D. Pa. Mar. 18, 1992)

83. *Id.* at *4–5. The plaintiff was a Minnesota corporation. Neither Minnesota nor Pennsylvania have a right of publicity statute, but there are federal court cases in each state predicting that the state courts would recognize a right of publicity. The court did not indicate which state's law it was applying, but cited one Eastern District of Pennsylvania case, and no Minnesota (or federal courts situated in Minnesota) cases, so it appears they applied Pennsylvania law. *Id.* at *5. The court was also unclear as to what extent it granted relief under Lanham Act § 43(a) or under the right of publicity. *Id.* at *5–6.

and (iii) exploitation occurred in the forum state, a U.S. court will accord rights of publicity—even to a plaintiff domiciled in a country that does not recognize the right of publicity.

Even where the licensee is not domiciled in a state that recognizes the right the Restatement Second of Conflicts of Law approach (and the other interest balancing approaches) could support applicability of the law of the place of infringement or even of the forum state to find a violation of the right.[84] Of course, those states that apply a lex forum approach would also find liability in such circumstances. Similarly, a state that does not recognize the right of publicity could, under each of these approaches, refuse to enforce another state's right of publicity.[85]

It is submitted that, perhaps, international right of publicity actions should be treated like international copyright claims, where courts apply the law of the "protecting country," i.e., the country where the infringing act took place.[86] One potential objection is that this copyright-type rule could lead to a multiplicity of actions.[87] However, the rule has proved to be relatively workable and predictable.

---

84. MCCARTHY, *supra* note 10, § 11.3[E].

85. *Id.* § 11.3[B].

86. There is some ambiguity whether the law of "the country where protection is claimed," which is the applicable law pursuant to Art. 5(2) of the Berne Convention, refers to the law of the forum, or the law of the country where the infringing acts took place. *See* The Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971), Art. 5(2) [hereinafter Berne Convention]; EUGEN ULMER, INTELLECTUAL PROPERTY RIGHTS AND THE CONFLICT OF LAWS 10–11 (Kluwer 1978) (suggesting it is most likely to mean the latter); *see also,* Paul Edward Geller, *Conflicts of Law in Cyberspace: Rethinking International Copyright,* 44 J. OF THE COPYRIGHT SOC'Y 103, 106 (1996).

Note, a rule mandating that courts apply the law of the protecting country could be subject to a limitation that no greater rights be accorded than those recognized under the law of the domicile of the person whose persona was used. This proposed exception, which seems analogous to the "rule of the shorter term" permitted under the Berne Convention, would function to assure that important limitations on the right, particularly those protecting freedom of expression, could not be avoided. Berne Covnention at Art. 7(8). Without such an exception, expressive works which are distributed multinationally would have to comply with the law least protective of speech in order to avoid potential liability in a foreign forum. The exception is fair because the plaintiff should not reasonably expect greater protection in a foreign forum than she would receive in her domestic forum. Moreover, if plaintiffs believe their domicile forum rule is overly permissive, they are in a position to influence domestic legislation to modify the rule.

87. This potential problem has been recently discussed in the context of uses of copyright in cyberspace. *See* Jane C. Ginsburg, *Global Use/Territorial Rights: Private International Law Questions of the Global Information Infrastructure,* 42 J. OF THE COPYRIGHT SOC'Y 318 (1995) (suggesting a Restatement Second Conflict of Laws type approach to multinational copyright infringement claims); Geller, *supra* note 86, at 106 (suggesting "localizing" infringing acts in the country where the remedy for the act takes effect).

B. Personal Jurisdiction

Although personal jurisdiction was not a disputed issue in the above cases, it can be a determinative problem in international right of publicity cases. In the recent case *Noonan v. Winston Company,*[88] claims for right of publicity under Massachusetts law against a British publisher, a French advertising agency, and French cigarette company were dismissed for lack of sufficient minimum contacts. An unauthorized photo of the plaintiff, a Boston policeman who strongly opposed smoking, was taken by an employee of the British publisher. It was licensed to the French advertising agency, which used the photo in an advertisement for Winston cigarettes. Sufficient contacts for due process purposes requires "purposeful availment of the privilege of conducting activities in the forum state." This requirement was not met for the advertising agency and RJR France. As to the British publisher, which solicited business in Massachusetts, there was jurisdiction under the Massachusetts long-arm statute, but the contacts were not sufficiently "continuous and systematic" to constitute minimum contacts required under the Constitution.

The plaintiff in *Noonan* might have had a claim under French law, and jurisdiction could be obtained in France. This case is an example of the importance for U.S. attorneys to be familiar with other countries' protection of similar interests.

V. OVERVIEW OF THE RIGHT OF PUBLICITY AND CONFLICTS OF LAW UNDER NON-U.S. LAW

As sparse as U.S. law is with regard to right of publicity claims by foreign nationals, there is even less applicable law in this area in other countries. International conflicts of law in connection with right of publicity (and analogous rights) is at least as uncertain as U.S. law.[89]

A. United Kingdom

The right of publicity is not recognized in the U.K.[90] Unfair competition law in the form of "passing off" is a possible cause of action but is

88. 135 F.3d 85 (1st Cir. 1998).

89. *See, e.g.*, Mathias Reimann, CONFLICT OF LAWS IN WESTERN EUROPE; A GUIDE THROUGH THE JUNGLE, 37 (Transnational Publishers, 1995).

90. Hayley Stallard, *The Right of Publicity in the United Kingdom*, 18 LOY. L.A. ENT. L.J. 565, 565 (1998); *see also*, Catherine Louise Buchanan, *A Comparative Analysis of Name and Likeness Rights in the United States and England*, 18 GOLDEN GATE U.L. REV. 301 (1988).

traditionally limited in its application. In one well-known English case, *Lyngstad v. Anabas Prods. Ltd.*,[91] the Swedish band Abba filed a passing-off claim against an unauthorized distributor of merchandise featuring the name and likeness of the band. The U.K. court applied U.K. law to the claim without discussing conflict of law issues.[92] Abba's request for a preliminary injunction was denied because the group didn't sell competing merchandise and, therefore, under the restrictive U.K. view, there could be no "passing off."[93] It would appear that other countries which use an unfair competition approach, such as Australia, would also apply their local law to the claim.[94] Because unfair competition claims are tort claims, local law is applied to such a claim consistent with the concept that courts apply the law of the place where the wrongdoing occurred.

If the *Noonan* case had been brought against the U.K. publisher in the U.K., there would have been personal jurisdiction, but, because the U.K. does not recognize a right of privacy or publicity and "passing off" does not appear to be involved, it seems unlikely that a claim would be successful. Query whether a U.K. court would permit a claim for invasion of privacy, applying Massachusetts law, on the argument that the applicable choice of law should be the domicile of the plaintiff.[95]

A Human Rights Bill that would incorporate the European Convention on Human Rights directly into British law is pending in Parliament.[96] That Convention provides, among other things that "[e]veryone has the right to respect for his private and family life, his home and his correspondence."[97] It also provides for a balancing of freedom of expression against the right of privacy.[98] While the introduction of a legal right to privacy in England is highly controversial, this bill would seem to indicate a move in that direction.

---

91. 3 F.S.R. 62 (1977).

92. *Id.* at 66–68.

93. *Id.* at 69.

94. *See* John McMullan, *Personality Rights in Australia*, 8 AUSTL. INTELL. PROP. J. 86, 86-87 (1997).

95. This seems unlikely under U.K. choice of law analysis. *See* Robert G. Howell, *Intellectual Property, Private International Law, and Issues of Territoriality*, 13 CAN. INTELL. PROP. REV. 209, 212–13 (1997).

96. *See* Human Rights Bill, as approved by the House of Lords, 577 PARL. DEB., H.L. (5th Ser.) 1726 (1997), introduced into the House of Commons, Geb. 6, 1998, 663 PARL. DEB., H.L. (5th ser.) 31 (1998), *available in United Kingdom Parliament* (visited Apr. 10, 1998) <http://www.parliament.the-stationery-office.co.uk/pa/cm199798/cmbills/119/1998119.htm> (on file with the *Loyola of Los Angeles Entertainment Law Journal*).

97. *Id.* art. 8, § 1.

98. *Id.* art. 8, § 2.

B. France

The French law for violation of the "right of image" is derived from the general tort action under Article 1382 of the French Civil Code.[99] The approach to appropriation of persona disputes in France has its roots in the right of privacy, but there is ongoing controversy as to whether it is solely a personal right or also a property right.[100] Even though the U.S. Restatement Second Conflict of Laws would generally apply the law of the plaintiff's domicile in right of privacy cases,[101] French courts apply French law to events occurring in France.[102] As such, where an offending publication originated in another country, a French court would not give relief except as to harm occurring in France.[103]

C. Italy

Italy protects a right of image under several sections of its Civil Code, as expanded in recent case law.[104] Foreign citizens have the right to initiate legal proceedings in Italian courts.[105] The right is viewed as a "personality right," and Italian choice of law would apply the law of the foreign plaintiff's domicile.[106]

D. Argentina

Argentina does not recognize a right of publicity per se, but may protect similar interests as "highly personal rights," which are derived from a diverse body of law, including several international human rights treaties and instruments.[107] Generally, Argentina courts would apply Argentine law to both civil and criminal claims (where the wrong occurred in Argentina). However, Argentina is moving toward a "most significant contacts" ap

---

99. C. CIV. ART. 1382 (Fr.).

100. Logeais, *supra* note 6, at 164.

101. *See* RESTATEMENT (SECOND) OF CONFLICT OF LAWS, §§ 150 (cmts. c and e), 153 (cmts. c and d) (1971); MCCARTHY, *supra* note 10, § 11.3[B].

102. Logeais, *supra* note 5, at 541.

103. *Id.*

104. Silvio Martucelli, *An Up-and-coming Rights—The Right of Publicity: Its Birth in Italy and its Consideration in the United States*, 4 ENT. L. REV. 163, 109–11 (1993); Silvio Martucelli, *The Right of Publicity Under Italian Civil Law*, 18 LOY. L.A. ENT. L.J. 543 (1998).

105. *Id.* at 114.

106. *Id.*

107. Cabanellas, *supra* note 5, at 450.

proach which might lead to the application of foreign law under appropriate circumstances.[108]

E. Brazil

Like Argentina, Brazil protects interests similar to the right of publicity under several bodies of law, including its constitution, copyright and neighboring rights laws.[109] Although there does not appear to be any relevant caselaw, the constitutional provisions apply to "foreigners living in" Brazil[110] and copyright treaties generally require "national treatment" whereby a foreign national would receive protection under local copyright law. Since neighboring rights are sometimes subject to "reciprocity,"[111] it is not clear the extent to which a foreigner would be entitled to such protection under a neighboring rights theory in Brazil.

F. Canada

Unlike the U.S., Canada's sources for a right of publicity are in unfair competition law.[112] Four Canadian provinces have a statutory right of privacy which, like N.Y. Civil Rights Law sections 50 and 51, encompass commercial appropriation.[113] Ontario has developed a "commercial appropriation of personality" tort at common law.[114] Thus, the common law provinces of Canada seem closest to the U.S.

There has been no case law specifically addressing choice of law in this area in Canada.[115] Although it is not clear what choice of law rules the various Canadian courts would apply, if the wrong is viewed as an economic "tort," it seems likely that they would apply the substantive law of the

---

108. *Id.* at 462.

109. Deborah Fisch Nigri & Silvia Regina Dain Gandelman, *The Right of Publicity in the Brazilian Legal System*, 18 LOY. L.A. ENT. L.J. 469 (1998).

110. CONSTITUIÇÁ DA REPÚBLICA FEDERATIVA DO BRASIL [Constitution] art. 5 § X (Braz.). *see also*, Nigri & Gandleman, *supra* note 109, at 474.

111. *See* STEPHAN M. STEWART & HAMISH SANDISON, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS, 224–25, 227 (2d Ed., Butterworth & Co., 1989).

112. Robert G. Howell, *Publicity Rights in the Common Law Provinces of Canada*, 18 LOY. L.A. ENT. L.J. 487 (1998).

113. *See* David Vaver, *What's Mine is Not Yours: Commercial Appropriation of Personality Under the Privacy Acts of British Columbia, Manitoba and Saskatchewan*, 15 U.B.C.L. REV. 241, 247 (1981).

114. *Id. at* 262.

115. *See* Howell, *supra* note 95, at 212–13. That article discusses the recent Canadian Supreme Court case, *Tolofson v. Jensen* [1994] 3 S.C.R. 1022, which diverged from the older U.K. approach and said that *lex loci delecti* should be applied in tort cases but that in international cases it might apply Canadian law to avoid injustice. *Id.* at 215.

province where the infringing conduct took place. Similarly, provinces following a "passing off" approach would, like the U.K., apply their local law to a claim by a domiciliary of another state (or province) for wrongs occurring in their province.

In this symposium, Professor Robert Howell addresses the law in the common law provinces of Canada. Quebec is a civil law jurisdiction, which views the right to image as an element of "privacy" law.[116] A Quebec court might follow the French approach and apply its own law to exploitation of persona in Quebec.

G. Australia

There is no general right of publicity in Australia.[117] Australian claims with respect to unauthorized use of a celebrity name or likeness proceed under a "passing off" theory under either common law or sections 52 and 53 of the Trade Practices Act. Unlike English cases, however, some relatively recent Australian cases have appeared to relax the "common field of activity"

---

116. *See* Howell, *supra* note 112, at 487–88 n.4; Susan H. Abramovitch, *Publicity Exploitation of Celebrities: Protection of a Star's Style in Quebec Civil Law*, 32 CAHIERS DE DROIT 301 (1991). In Aubry v. Editions Vice-Versa, Inc., 78 C.P.R.3d 289 (1998), a photograph of a 17 year old girl taken in public was published in an art magazine, and she sued for damages for infringement of her right of privacy under the Quebec Charter of Human Rights and Freedoms. *Id.* The Canadian Supreme Court affirmed an award of $2,000 in damages even though there was no harm to her reputation, no commercial use, and minimal evidence as to any damage (she testified that some of her friends laughed at her). *Id.* at 313. The Court acknowledged that the freedom of expression in Quebec includes freedom of artistic expression, but found that the public's interest in seeing this work of art did not outweigh the girl's interest in her privacy. *Id.* at 300. This was not a case of information about a public figure, or an incidental appearance of a person in a photo taken in a public place, in both of which cases, the freedom of expression would have prevailed. The Court's discussion also points to a current debate in French law as to "whether the right to one's image is a separate right of personality or an element of the right to privacy." *Id.* at 298–99. In Quebec, the right to one's image is an element of right to privacy under the Quebec Charter, but it has both an "extrapatrimonial" and a "patrimonial" aspect, meaning a personal and a proprietary aspect. *Id.* at 299. As to damages, with regard to the "extrapatrimonial" wrong, "moral prejudice" (i.e. non-monetary damage) is not presumed, but "may consist simply in the annoyance felt by a person at becoming a 'celebrity.'" *Id.* at 311. Even the taking of the photograph of a person in a public place may apparently be recognized as causing such damage. *Id.* The evidence of "moral" damage here was minimal, but sufficient to support the damages award. *Id.* at 312. As to the "patrimonial aspect of invasion of privacy," the Court found that "commercial or promotional exploitation of an image, even of a private individual can cause the victim material prejudice" (i.e., monetary damage). *Id.* at 313. The girl could have claimed damages measured by what would have been paid to her as a model. *Id.* Note that the new Civil Code of Quebec, which was not applicable in the *Aubry* case, provides in Art. 36 that the use of a person's name, image, likeness or voice for a purpose other than the legitimate information of the public is an invasion of privacy. C. CIV. art. 36 (Que.).

117. *See* McMullan, *supra* note 94, at 86–87; S. Ricketson, *Character Merchandising in Australia: Its Benefits and Burdens*, 1 INTELL. PROP. J. 191 (1990) (Aust.).

requirement thereby giving plaintiffs a better chance to succeed on a "passing off" claim against defendants.[118] For example, in *Pacific Dunlop Ltd. v. Hogan*[119] the court found "passing off" when there was a likelihood that a substantial number of viewers of an advertisement featuring a "Crocodile Dundee" type character were misled that there was an approval of the product by Paul Hogan. Section 53 of the Trade Practices Act has also been successfully used against unauthorized merchandise featuring Bruce Springsteen,[120] Dire Straits,[121] and INXS.[122] However, Olivia Newton-John was not able to stop an advertisement for makeup that said "Olivia? No—Maybelline!"[123] Hence, uncertainty remains as to what extent deception or confusion is required. It appears that Australian courts would apply Australian law to this kind of claim.[124]

Although the Australian courts seem to reject a pure "appropriation of personality" type of action, in a recent case involving a well-known swimmer, the Court of Appeal reversed a lower court decision and granted an injunction, noting the plaintiff's potential loss of opportunity to exploit his commercial advantage, and awarding $15,000 damages when his likeness was used in an advertisement without his consent.[125] Thus, it is possible that Australian courts will move toward recognizing a cause of action without a showing of deception.

H. Japan

Japan recognized a right of privacy in the *After the Party* case.[126] Famous Japanese right-wing author Mishima wrote a novel which included a thinly fictionalized characterization of a real person, Mr. Noguchi, who was a former foreign minister and Communist Party member.[127] The fictional character, Noguchi, was portrayed as having questionable financial activities

---

118. *See* Caenegem, *supra* note 34, at 454.

119. (1989) 14 I.P.R. 398.

120. Claim abandoned after judge ordered interlocutory relief. *See* SAMUEL K. MURUMBA, COMMERCIAL EXPLOITATION OF PERSONALITY, 124 (Law Book Co. Ltd., 1986).

121. *See id.*

122. *See* Hutchence (trading as INXS) v. South Sea Bubble Co., Pty. (1986) 6 I.P.R. 544.

123. Olivia Newton-John v. Scholl-Plough (1986) No. NSW G208, 68.

124. *See generally* Pacific Dunlop Ltd., v. Hogan (1989) 14 I.P.R. 398; *Hutchence*, 6 I.P.R. 544, *Newton-John* No. NSW G208.

125. *See* Talmax Pty. Ltd. v. Telstra Corp. (1996) 36 I.P.R. 46.

126. *See* Tokyo Dist. Ct., 28 September 1964, 15-9 Ge-Minshu 2317-1370.

127. *Id.*

and ties to a red-light district.[128] Noguchi sued and won 800,000 Yen in damages.[129]

The right of publicity as distinct from privacy was first recognized in Japan in *Mark Lester v. Tokyo Daiichi Film*.[130] Film footage of English actor Mark Lester was used in a TV advertisement for Lotte chocolate without his consent along with the phrase in the soundtrack "Mark Lester likes it, too."[131] The court awarded Lester 500,000 Yen for economic loss and an equal amount for harm to his reputation. In the subsequent *Steve McQueen*[132] case, the Tokyo District Court denied judgment for McQueen because even though footage of his performances were used in an advertisement without his consent, there was no implication that he endorsed the products. The court seemed to deny a proprietary right of publicity type approach. Note that in both of these cases, the plaintiff was a non-Japanese national. Japanese courts apparently apply Japanese law to a claim involving violation of these rights in Japan.

Even more recently, the Tokyo High Court recognized the right of publicity as a property right. In the *"Oniyanki Club"* case,[133] a group of popular television actors' likenesses were used in a calendar without their consent. The court reversed the lower court's finding of an infringement of privacy since there was no showing of harm to the actors' reputation or personality, but granted an injunction and damages for the economic harm, saying that, "analogous to property rights, it should be the artists' exclusive right to be in control of the commercial exploitation of the benefits and value of their attraction to consumers."[134] Although many questions remain unanswered, it appears that the right is considered available only to "famous artists," which may survive the death of such an artist.[135] All of the above cases were brought under Article 709 of the Japanese Civil Code, which provides liability for damages for intentional or negligent acts.

---

128. *Id.*

129. *Id.*

130. *See* Tokyo Dist. Ct., 29 June 1976, 817 Hanrei Jiho 23.

131. *See id.*

132. *See* 10 November 1980, 981 Hanrei Jiho 19.

133. *See* Tokyo High Court, 26 September 1991, 1400 Hanrei Jiho 3-14.

134. *See Id.*

135. *See Doi Bansui*, Tokyo district Court, 4 June 1992, 788 Hanrei Times 207 (reporting a claim by heirs of deceased poet against Prefecture's placing of sign outside residence, on basis that he was not such an "artist").

VI. RIGHT OF PUBLICITY POLICY AND THE INTERNATIONAL ARENA

Several theories have been proposed for why the law should recognize an exclusive right to control the commercial use of identity. These theories include natural rights theories and economic theories. There are, however, countervailing policies surrounding the right of publicity which concern the negative impact of the right upon free speech.

A. Natural Rights Theories

1. Unjust Enrichment

Professor McCarthy argues that the right of publicity is a natural right based upon "widely held perceptions of unfair conduct."[136] This appears to be the most commonly asserted judicial theory for recognizing the right of publicity in the U.S..[137] However, scholars resist relying on this theory because it rests on intuition rather than analysis.[138] Even advocates of this approach recognize there is circularity in calling the use of a persona a "misappropriation"—it is, only if a court says that it is.[139]

Professor Madow rejects this rationale for several reasons.[140] First, there is no requirement of "originality" in the right of publicity. Celebrities "borrow" from other sources—prior celebrities, their character roles—in developing their persona.[141] Therefore, it is disingenuous to say that one who uses a derivative persona has misappropriated it. Second, many commercial activities involve profiting from others' work, and there is a presumption of permissibility, absent countervailing interests. Third, some unauthorized appropriators transform what they use by adding expressions of their own, which is of value to society.[142]

Professor McCarthy responds to that critique by arguing that the burden of proof as to the right should be on those who oppose it.[143] Professor Kwall adds that, "[o]ther types of property are subject to individual owner-

136. *See* MCCARTHY, *supra* note 10, § 2.1[A].

137. Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 109 (1994). *But see* Cardtoons, L.C. v. Major League Baseball Players Ass'n., 95 F.3d 959, 975 (10th Cir. 1996) ("[B]lind appeals to first principles carry no weight in our balancing analysis.").

138. *See* MCCARTHY, *supra* note 10, § 2.1[A].

139. *Id.*

140. See Madow, supra note 22, at 196–205.

141. *See* Braudy, *supra* note 26, at 3–4.

142. Cardtoons, L.C. v. Major League Baseball Players Assn., 95 F.3d 959, 976 (10th Cir. 1996).

143. *See* MCCARTHY, *supra* note 10, § 2.1[B].

ship despite the existence of multiple influences in its creation,"[144] such as items of cultural property and trademarks. Furthermore, she argues, all creators "borrow" and other works derive value and meaning from their audiences, yet the law recognizes proprietary rights in such works, so why shouldn't the same apply to celebrity persona?[145]

Those counter-arguments are unpersuasive when applied to right of publicity issues. Arguments as to burden of proof do not advance the analysis of the issue. Professor Kwall backs off from her own argument in noting that cultural property should probably be owned by the cultural group from which it originated. In addition, her analogy to trademarks ignores the basic concept that the agencies whose efforts create secondary meaning are just that—agents whose acts are attributed to the principal. This seems easily distinguishable from the prior celebrities, screenwriters, directors, and others from whom value is taken by celebrities.

The analogy to copyrights also seems misplaced in this connection. Although both persona and works may be "texts" gaining meaning only through the perception of the viewer,[146] on a continuum, copyrightable works have more inherent content than celebrity likenesses. Moreover, copyrights don't extend to ideas and are only protected if original and embodying at least a modicum of creativity. Ultimately, the unjust enrichment rationale merely reflects the viewpoint of commentators and judges and does not seem to provide either a justification for the right or predictive value as to the outcome of any particular case.

2. Labor Theory

Another proposed natural rights rationale is a Lockean "labor theory," which holds that a person is entitled to own the fruits of her labor.[147] The labor theory was proposed as a rationale for recognizing a right of publicity by Professor Nimmer in his seminal article on the subject.[148]

Madow raises numerous counter-arguments to this rationale.[149] First, he questions whether a person has a natural right to the full market value of a product of her labor (thus appropriating not only the "value added," but

144. Kwall, *supra* note 8, at 44.

145. *Id.* at 45.

146. *See generally* Robert H. Rotstein, *Beyond Metaphor: Copyright Infringement and the Fiction of the Work*, 68 CHI.-KENT L. REV. 725, 727 (1993) (discussing modern literary criticism that sees material as "texts" resulting from the interaction between the "artifact" and the audience).

147. Kwall, *supra* note 8, at 39; *see* Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287 (1988).

148. *See* Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

149. *See* Madow, *supra* note 140, at 181–96.

that which was removed from the commons).[150] Second, he argues that "[C]elebrities do not create commercially marketable public images in anything like the way carpenters make chairs."[151] Associative value derives from semiotic power, not labor.[152] Fame is conferred by others, it is largely the result of chance[153] and the need of modern media for subjects to attract viewers.[154] Even in the current world of spin-doctors and carefully constructed images, "[T]he media and the public always play a substantial part in the image-making process."[155] Thus, he concludes any moral claim by a celebrity to her image is unconvincing.

Professor Kwall's response to those arguments is set forth above. Ultimately, both she and Professor McCarthy conclude that a celebrity's effort often merits legal protection. This rationale has some persuasiveness and is often referred to by U.S. courts that recognize the right.[156] Interestingly, Locke's home country, England, does not seem persuaded, and Lockean theories seem to have more influence in the U.S. than in the U.K.

3. Personality Theory

A third type of natural rights rationale is a Hegelian "personality theory" of property, whereby property is owned because it is the extension of the creator's personality.[157] It has been suggested that this rationale is particularly appropriate as applied to the right of publicity, because an individual's persona is the direct embodiment of her personality.[158] Countries like France, which view the right of image as a personality right, rely primarily on this rationale,[159] although this approach has not been generally accepted as the rationale for copyright in Anglo-Saxon jurisprudence. Critics of the right of publicity have not attacked it to the extent they have other rationales.

---

150. *Id.* at 175 n.239, 183–84.

151. *Id.* at 184.

152. *Id.* at 185.

153. *See* Hughes, *supra* note 147, at 341 n.220.

> Indeed, it is difficult to fit personas into both the labor and personality theories of intellectual property. They are sometimes the result of hard work toward securing a public image based on an internal vision. But quite often they are creations of pure chance, perhaps the only 'intellectual property' without intentionality. *Id.*

154. *Id.*

155. Madow, *supra* note 140, at 193.

156. *Cardtoons, L.C.*, 95 F.3d at 975 (noting that this rationale may be more persuasive as to athletes, whose "athletic success is fairly straightforwardly the result of an ahtlete's natural talent and dedication.").

157. Kwall, *supra* note 8, at 39–40.

158. Hughes, *supra* note 147, at 329.

159. Logeais, *supra* note 5, at 513.

However, although the personality theory rationale supports a personal right such as the commercial appropriation form of *privacy*, it does not provide a rationale for a *property* type right which is assignable and descendible—in other words a right of publicity, as understood in U.S. jurisprudence.[160] Other rights exist to protect injury to feelings.[161] France's reliance on this rationale explains some of its difficulty in conceiving a proper basis for the right "on" the image—an assignable, descendible right.

B. Economic Theories

1. Utilitarian/Incentive Theories

Another rationale analogizes the right of publicity to traditional U.S. copyright policy reflected in the constitutional intellectual property clause,[162] and proposes that creation of celebrity is valuable to society, and economic incentives are necessary to encourage such creation.[163] The U.S. Supreme Court has recognized this rationale, at least in the context of protection for an entertainer's performance,[164] and it is a familiar one in U.S. courts.[165]

Madow argues that there is no reason to believe that the incentive provided by the right of publicity is anything but marginal.[166] The primary activity that generates fame would still be compensated without right of publicity.[167] Individuals who are famous enough to get significant compensation from a right of publicity are already highly paid, for those primary activities.[168] Even without the right of publicity, celebrities would be paid for endorsements and for authorizing merchandise. After noting that there is no evidence that the primary activities would be reduced if there were no right of publicity, he speculates that rejecting the right of publicity might lead to more productive primary activities, because celebrities that do not bother performing on account of merchandising income might be encouraged to perform more.[169] The right of publicity generates more income to those who

160. *Cardtoons L.C.*, 95 F.3d, at 976 ("Publicity rights, however, are meant to protect against the loss of financial gain, not mental anguish.").

161. *Id.*

162. U.S. CONST. art. I, § 8, cl. 8.

163. *See* MCCARTHY, *supra* note 10, § 2.2; Kwall, *supra* note 8, at 35; *see also*, Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977).

164. *Zacchini*, 433 U.S. at 576–77.

165. *But see Cardtoons L.C.*, *95* F.3d, at 973–974.

166. Madow, *supra* note 140, at 206–16.

167. *Cardtoons L.C.*, 95 F.3d, at 973.

168. *Id.* at 974.

169. *See* Madow, *supra* note 140, at 212.

need it least—those who are already successful. Finally, there are "uniquely important noneconomic motivations" for fame.[170]

While acknowledging that the incentive rationale would not apply in some cases, proponents of the right of publicity counter those arguments by pointing out that if individuals could not control commercial exploitation of their persona after it became valuable, they might refrain from doing socially valuable things for fear of the consequences of fame—the crass exploitation—that might result.[171] McCarthy also argues that, like in the case of copyright law, the issue is not whether the existence of the right motivates any particular work, but that the system of incentives motivates productivity generally.[172] Kwall also argues that there are significant costs to celebrity status, such as reduced privacy and personal freedom, which are counterbalanced in part by the incentives provided through a right of publicity.[173]

2. Consumer Protection Arguments

Some have argued that the right of publicity protects consumers from being misled as to the source of goods or the association of persons with commodities.[174] This is the basis for "passing off" and related theories. Madow argues that consumers are not so easily misled[175] and that a right of publicity precludes even non-misleading advertising.[176] Both Madow and McCarthy ultimately note that a right of publicity is not necessary to protect against consumer deception because other legal theories are available to achieve that goal.[177] In fact, Australian and Canadian law protect interests similar to the right of publicity through an extended version of the U.K. "passing off" approach. However, unlike the U.K., Australian and Canadian law recognize, more so than U.K. courts have generally been willing to do, that there can be an appropriation of associative value even if the plaintiff is not trying to sell goods competitive with the defendant's.

---

170. *See* Madow, *supra* note 22, at 214.

171. *See* MCCARTHY, *supra* note 10, § 2.2; Kwall, *supra* note 8, at 36–37.

172. *See id.*, § 2.2.

173. *See* Kwall *supra* note 8, at 37.

174. *See* MCCARTHY, *supra* note 10, § 2.4; James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637 (1973).

175. *See* Madow, *supra* note 140, at 230. Note that the Australian courts in the Hogan cases also made that observation, but gave relief based on the more subtle associative effects of use of celebrity persona.

176. *Id.* at 231–32.

177. *Cardtoons L.C.*, 95 F.3d at 975.

3. Allocative Economic Theory

Modern neoclassical economic theory asserts that granting exclusive alienable property rights leads to the most efficient allocation of resources by facilitating market transactions through which the rights are ultimately allocated to their highest valued use.[178] While many scholars and those interests which stand to gain by the existence of vigorous exclusive rights are enthusiastic about this approach, courts generally are not persuaded by this approach.[179] Madow challenges the "tragedy of the commons" rationale as it might be applied to celebrity—even if a given celebrity's persona was used until is was worthless because it was "free," celebrity is not a "nonrenewable natural resource."[180] As a social creation, there will always be a fresh supply of a new and existing personalities to exploit.[181]

Moreover, transaction costs preclude optimal allocation. He observes that, although some scholars favor the approach, no court has ever justified a right of publicity by reference to this rationale.[182] Finally, celebrities would not necessarily act to maximize economic value, but rather might act to "suppress criticism, and thus permanently remove a valuable source of information about their identity from the marketplace."[183]

Madow's broader critique of the economic analysis approach is perhaps more relevant to the discussion of international rights of publicity. He notes that economic analysis does not help us evaluate what legal rules a culture should choose, what should a celebrity's role be in society, and to what extent a culture's choice of legal rules, such as those involving right of publicity, contribute to its implementation.[184] Are Americans too obsessed with celebrities? What are the implications for a democratic society? Madow raises these fascinating broader questions, but does not draw a conclusion, except that, in his opinion, the case for the right of publicity has not been proved.

Professor Kwall's recent article on "Fame," examined these broader issues and the "[s]ociological and cultural influences that have prompted the

---

178. *See* MCCARTHY, *supra* note 10, § 2.3; Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393 (1978); *see generally* Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 306-324 (1996) (discussing the neoclassicist approach to copyright).

179. *See* Grady, *supra* note 137, at 106; MCCARTHY, *supra* note 10, § 2.4. *But see Cardtoons, L.C.*, 95 F.3dat 975 (implying this rationale has some persuasiveness as to advertising uses, but not other commercial or speech uses).

180. Madow, *supra* note 140, at 224.

181. *Id.*

182. *Id.* at 225.

183. *Cardtoons, L.C.*, 95 F.3d at 975.

184. Madow, *supra* note 140, at 225.

doctrine's initial recognition and increasing application,"[185] concluding that "[t]he right of publicity is entirely consistent with our history and the very essence of our cultural fabric . . . [f]rom a doctrinal as well as a sociological perspective, the right of publicity is justifiably treated as a property right in our society."[186] Professor Kwall addresses the status of rights of publicity internationally, and contrasts that with the U.S. and international treatment of moral rights. In spite of the critics, such as Professor Madow, Kwall professes enthusiasm for popular culture and fame, and vigorously defends the right of publicity as a property right, which suggests that she would support the implementation of a similarly strong right of publicity, at least in other modern industrial societies.

C. Countervailing Policies

In addition to the counterarguments to the rationales discussed above, it is important to consider the potential impact of the right of publicity on freedom of speech and expression.[187] There are many ways in which a person's likeness may be used implicate speech. Even "commercial speech" is subject to constitutional protection under U.S. law.[188] As the scope of the right of publicity expands, U.S. courts are increasingly having to balance proprietary persona rights as a restriction on speech against constitutionally recognized speech interests.[189] Through a variety of legal mechanisms, the laws of the countries considered in this symposium also seek to balance speech interests against persona rights, although not always reaching the same result as would be reached under U.S. law.[190] As American scholars advocate the spread of a broad proprietary right of publicity throughout the world, it is important to also recognize the importance of limitations on the

185. Kwall, *supra* note 8, at 2.

186. *Id.* at 57.

187. *See generally* MCCARTHY, *supra* note 10, Chapter 8; *see also* Roberta Rosenthall Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994).

188. *See* Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of New York, 447 U.S. 557 (1980); Stephen R. Barnett, *The Right of Publicity Versus Free Speech in Advertising: Some Counter-Points to Professor McCarthy*, 18 HASTINGS COMM. & ENT L.J. 593 (1996).

189. *See Cardtoons, L.C.*, 95 F.3d 959; New York Magazine v. Metropolitan Transportation Authority, 136 F.3d 123 (2d Cir. 1998).

190. *See* Jeanne M. Hauch, *Protecting Private Facts in France: The Warren & Brandeis Tort is Alive and Well and Flourishing in Paris*, 68 TUL. L. REV. 1219 (1994). After reviewing several French cases dealing with docudramas and fictionalized accounts of newsworthy events, Ms. Hauch states that "EC law's analogue to the First Amendment will be unable to act as a brake on the powerful engine of French privacy law." *Id.* at 1286.

rights which protect fundamental democratic values.[191] As noted intellectual property scholar, Professor Sam Ricketson, said in his article considering the expansion of these rights in Australia:

> Public figures and images, whether real or fictional, already command high respect and influence in our society: comprehensive protection for such things may therefore represent too great an imposition for a free market and a community committed to free speech to bear. These burdens may become intolerable if such protection is extended to names and images in general, so as to safeguard the interests of private individuals.[192]

VII. CONCLUSION

In concluding this Foreword, a preliminary observation in that connection bears mention. Like copyright, persona can be an important vehicle of expression and it can serve as a valuable communicative function in a democratic civil society. Also like copyright, limitations on the exclusive rights to persona are extremely important, particularly limitations that support freedom of expression and of the press. We are at a moment in history where intellectual property rights, including the right of publicity, are becoming currency in the system of world trade, and are, in general, being strengthened substantially. In considering whether vigorous copyright protection should be implemented worldwide, Neil Netanel has recently suggested that implementation of U.S. style copyright may not necessarily be the best strategy to foster the development and growth of democracy in all societies.[193] Before advocating that other nations recognize a U.S. style property right in persona, one should similarly consider the expressive component of image and the specific contours of other societies, paying particular attention to their implementation of protections for freedom of expression. Considering various market sectors, local conditions, and policy questions,[194] one might conclude that a different scheme of protection might better further demcratic social interests.

---

191. *See* Netanel, *supra* note 5, at 329.

192. *See* Ricketson, *supra* note 117, at 208.

193. *See* Netanel, *supra* note 5, at 329.

194. *Id.*