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REBELS WITH A CAUSE: ARTISTS' STRUGGLES TO ESCAPE A PLACE WHERE EVERYBODY OWNS YOUR NAME

*Scott L. Whiteleather**

I. INTRODUCTION

Since its inception, the entertainment industry¹ has utilized every legal vehicle at its disposal to control all aspects of its copyrighted creations. In the early days, the film industry operated under what is often referred to as the “studio system,”² while the recording industry simply signed unsophisticated musicians to complicated contracts that vested all copyright ownership in the record label. With television promising its version of wealth and fame, unsuspecting performers of the 1960’s and 1970’s fell prey to the same contract manipulation, leaving them without ownership of their creative contributions.

Today’s artists have become more powerful, creating their own production companies and record labels, thereby forcing the entertainment industry to become even more creative in its efforts to maintain total control of the final products and associated profits. To this end, the entertainment industry recently attacked a target it has stalked for over seventy years—the artist’s right of publicity.

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1. This Article uses the term “entertainment industry” to refer to the combined businesses of film, television and the recording industry. The following analysis primarily concentrates on the motion picture and television industries.

2. During the early days of the film industry, actors were under contract to their studio. During the term of the contract, artists were expected to make films as directed by the studio. In addition, the artist could be “loaned out” to other studios without receiving additional compensation or approving the project. In this manner, a studio controlled the actor much as one might treat a piece of property. This practice is often referred to as the “studio system.”

This Article asserts that the entertainment industry has historically possessed superior insight into developing technologies, and has used such knowledge to carefully draft form contracts that manipulate artists. Part II examines the contractual language binding such luminaries as Mickey Rooney, Marilyn Monroe, Humphrey Bogart and Judy Garland, and the resulting case law. This section explains how these artists, as well as many others, signed contracts granting broad rights to the respective studios involving technologies then unknown to the general public. Furthermore, this section analyzes Warner Bros.' lawsuit against the James Dean Foundation Trust.³ In that case, the studio was unsuccessful in usurping, in perpetuity, the right of publicity of the late James Dean.⁴ The defeat confirmed that broad, contractual language was no longer enough to destroy a property interest in an individual's persona.

Part III provides a historic overview of copyright law, presents the relevant sections of the Copyright Act of 1976 and introduces right of publicity law. It then examines the industry's most recent attempt to control artists' rights of publicity—copyright preemption. Part IV discusses this approach as taken by Paramount Studios in its litigation with George Wendt and John Ratzenburger of the television show *Cheers*.⁵ Part V suggests the entertainment industry continues to attack performers' struggle for legal control and profit by taking advantage of its superior knowledge of developing technology when drafting standard form contracts. Finally, this section contemplates potential strategies of the entertainment industry, including legislation, which could forever change the artist's role.

II. THE SCRIVENER OFTEN PREVAILS

For years performers have attempted to share in the vast profits generated by their work only to discover that the standard contracts they signed limited compensation to a weekly salary. Motion picture studios in the 1940's and 1950's were able to take advantage of the industry's superior knowledge of technology and the advancements in dissemination that were to come. As such, many seemingly powerful celebrities entered into agreements encompassing the future exhibition of their work in television and videocassettes long before these technologies were fully developed or known to the general public. Not surprisingly, disputes over

3. Warner Bros., Inc. v. Curtis Mgmt. Group, Inc., No. 91-4016, 1995 WL 420043 (C.D. Cal. Mar. 31, 1993).

4. *Id.*

5. *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997).

this contractual language have lead courts to interpret the possible ambiguities related to these rights.

*A. Rooney v. Columbia Pictures Industries, Inc.*⁶

In 1981, Mickey Rooney led a class action lawsuit against eight major motion picture producers and distributors.⁷ Rooney claimed defendants, while having secured the rights to exhibit his pre-1960 films, did not possess the rights to exploit these films in alternative markets.⁸

The complaint alleged that the defendants conspired to restrain trade in violation of § 1 of the Sherman Antitrust Act.⁹ It further alleged defendants “wrongfully have received and continue to receive all of the profits from their commercial exploitation of the intangible property rights owned by [Rooney] and the members of the class.”¹⁰ Additionally, the complaint alleged defendants violated the Lanham Act¹¹ by falsely representing that (a) “pre-1960 films made for exhibition in movie theatres could be commercially exploited in the alternative markets by the industry,” and (b) Rooney and the members of the class “sponsored, endorsed, or approved” use of pre-1960 films in the alternative markets.¹² Finally, the complaint alleged defendants engaged in unfair competition by “misappropriat[ing] the names, likenesses, images, pictures, goodwill, reputations and valuable property rights of [Rooney] and the members of the purported class”¹³

In a pointed opinion, the court carefully reviewed the language in several of Rooney’s contracts.¹⁴ Rooney’s unprecedented pre-1960 career gave the court a unique opportunity to examine standard motion picture

6. 538 F. Supp. 211 (S.D.N.Y. 1982).

7. The defendant motion picture studios included: Columbia Pictures Industries, Inc. (“Columbia”); Metro-Goldwyn-Mayer, Inc. (“MGM”); Paramount Pictures Corp. (“Paramount”); RKO General, Inc. (“RKO”); Twentieth-Century Fox Film Corp. (“Fox”); United Artists Corp. (“United Artists”); Universal City Studios, Inc. (“Universal”); and Warner Bros., Inc. (“Warner Bros.”). *Id.*

8. *Id.* at 213.

9. 15 U.S.C. § 1 (1994 & Supp. IV 1999); *Rooney*, 538 F. Supp. at 213.

10. *Rooney*, 538 F. Supp. at 213.

11. 15 U.S.C. § 1125(a) (1994); *see also Rooney*, 538 F. Supp. at 213.

12. *Rooney*, 538 F. Supp. at 213.

13. *Id.*

14. The court examined numerous contracts between Rooney and MGM, United Artists, Columbia, Fox, Universal, Warner Bros., and Paramount. *See id.* Rooney actually made three films for Fox prior to 1960. *Id.* at 217. The first two films he made while under contract with MGM. *Id.* Rooney’s services were acquired by Fox pursuant to a loan out agreement with MGM. *Id.* Rooney’s made his third film with Warner Bros. pursuant to a loan out agreement with MGM. *Id.* at 219.

agreements between 1933 and 1959. Based on the language in the contracts, the court determined Rooney expressly granted all rights in and to the alternative markets to the respective studios.¹⁵ The court explained:

It is difficult to conceive of contracts which more explicitly and certainly provide the answer to the major issue before this Court than the above-recounted contracts between Rooney and defendants. These agreements make clear that the rights to exhibit Rooney's pre-1960 films in the alternative markets are held by defendants and not by Rooney.¹⁶

Considering the industry's historic control over performers like Rooney and the profits realized from their films, a brief review of the contractual language is instructive.

1. Television Rights in Standard Motion Picture Contracts

On August 29, 1933, at the age of thirteen, Rooney signed an agreement with Metro-Goldwyn-Mayer ("MGM") to act in the photoplay *Fire Chief* for \$300 per week.¹⁷ The contract provided in relevant part:

The term "photoplay" as used in this agreement shall be deemed to include motion pictures produced and/or exhibited with sound and voice recording, reproducing and/or transmitting devices, radio devices, and all other improvements and devices which are now or may hereafter be used in connection with the production and/or exhibition and/or transmission of any present or future kind of motion picture production.¹⁸

Arguably, a thirteen year-old budding actor would have little hope of understanding the vast profits that would ultimately arise from the language "all other improvements and devices which are now or may hereafter be used"¹⁹ to exploit the photoplay.²⁰ It is a fair assumption that even the best lawyers and advisors of the time could not have foreseen the implications

15. *Id.* at 224.

16. *Id.* at 223.

17. *Id.*

18. *Rooney*, 538 F. Supp. at 211.

19. *Id.*

20. As a frame of reference, sound-accompanied motion pictures ("talkies") debuted only several years before 1933. See KENNETH M. CAMERON, *AMERICA ON FILM: HOLLYWOOD AND AMERICAN HISTORY* 50 (1997). Television was still in its experimental form and would not make its debut in the United States until almost the next decade. See *De Forest's Training, Inc. v. FTC*, 134 F.2d 819, 821 (7th Cir. 1943). While this might explain Rooney's willingness to grant such broad rights, no excuse is made for Rooney's lawyers and advisors.

of such language and the resulting disadvantage to their client. Conversely, it fair to assume that a motion picture studio had such visionary power.

Additional evidence of the entertainment industry's far reaching vision appears as early as 1934. In that year, Rooney signed a second contract with MGM binding the actor to "render his services as an actor in television productions; and . . . in connection with the broadcasting and/or transmission of his likeness and/or voice by means of television . . ." ²¹ The appearance of this seemingly innocuous language is extraordinary because at the time, television was only the subject of research and experimentation. ²² In fact, television was not introduced to the public *until five years later* at the 1939 World's Fair in New York. ²³

As such, it is highly unlikely that performers of the period understood the meaning of the terminology, much less the implications of the soon-to-be ubiquitous medium. More importantly for the purposes of this Article, it is essentially irrefutable that the motion picture industry inserted language specifically addressing and garnering all rights to television broadcasts in its standard contracts of this period even before the medium was available on a limited basis. ²⁴ For example, an agreement between Humphrey Bogart and Warner Bros. Inc., dated December 10, 1935, specifically includes television under the definition of "Artists services." ²⁵

By 1950, many performers were aware of the potential profit in television as a commercial medium. ²⁶ For example, early in that decade, both Roy Rogers and Gene Autry sought to prevent the exhibition of their respective work on television without additional compensation. ²⁷ In both cases, the court determined Rogers' and Autry's pre-1950 contracts expressly granted all such rights in perpetuity to the motion picture studio with which they contracted. ²⁸

21. *Rooney*, 538 F. Supp. at 214.

22. *De Forest's Training*, 134 F.2d at 821.

23. *Id.*

24. The 1940 agreement between Loew's Inc. and Judy Garland provides, "The term 'photoplays' as used in this agreement shall be deemed to include, but not be limited to, motion picture productions produced and/or exhibited and/or transmitted with sound and voice recording reproducing and /or transmitting devices, television, radio devices and all other improvements and devices which are now or hereafter may be used in connection with the production and/or exhibition and/or transmission of any present or future kind of motion picture productions. LOEW'S INC. AND JUDY GARLAND AGREEMENT para. 2 (Aug. 31, 1940) (on file with author).

25. HUMPHREY BOGART AND WARNER BROS., INC. AGREEMENT para. 5 (Dec. 10, 1935) (on file with author) [hereinafter BOGART I AGREEMENT].

26. *See Rogers v. Republic Pictures Corp.*, 213 F.2d 662 (9th Cir. 1954); *Autry v. Republic Prod. Inc.*, 213 F.2d 667 (9th Cir. 1954).

27. *See Rogers*, 213 F.2d 662; *Autry*, 213 F.2d 667.

28. *Autry*, 213 F.2d at 668-69 (citing *Rogers*, 213 F.2d at 666).

On March 7, 1960, the issue of television revenues led the Screen Actors' Guild ("SAG"), to strike for the first time in its sixty-year history.²⁹ Led by its president, Ronald Reagan, SAG ended the strike on April 18, 1960 and entered into a collective bargaining agreement with every major studio except MCA and Universal.³⁰ As part of the agreement, the studios consented to pay \$2,625,000 to establish pension, health and welfare plans for the performers.³¹ They further agreed to contribute six percent of the net television revenues of films made after February 1, 1960 to those plans.³² In exchange, SAG agreed not to bring compensation claims for films made prior to February 1, 1960 that were released to free television.³³

In *Rooney*, the Court paid special attention to this collective bargaining agreement³⁴ noting that because he was a member of SAG since 1937, Rooney was "bound by the provisions of all collective bargaining contracts in effect between [SAG] and motion picture producers" ³⁵ Therefore, Rooney was unable to assert any compensation claims.

In a final and harsh rebuke, the Court proclaimed, "Rooney's efforts to avoid the clear meaning of these consequences are many and various, sharing only the common characteristic of being unpersuasive."³⁶ The scrivener had won the war with respect to television.

2. Alternative Means

Rooney sought to limit the broad scope of the standard contract language regarding exhibition via alternative means, such as videocassettes.³⁷ Rooney asserted "exhibition" should be interpreted as exhibition to a mass audience and should not include individuals viewing films on personal playback devices.³⁸ The court, however, determined this argument "strains credulity to such an extent that merely to state the arguments is to refute them."³⁹

29. DENNIS MCDUGAL, *THE LAST MOGUL* 262 (1998). The actors objected to lack of compensation for the television syndication of their old movies. *Id.*

30. *Id.* at 262, 264. Reagan "sold out" SAG to his agent and long-time friend and business partner Lew Wasserman, founder of MCA and Universal. *See generally* MCDUGAL, *supra* note 29, at 262-65 (commenting on the allegation that Reagan "sold out" SAG).

31. *Rooney*, 538 F. Supp. at 221.

32. *Id.*

33. *Id.*

34. *See id.*

35. *Id.*

36. *Id.* at 226.

37. *Rooney*, 538 F. Supp. at 227.

38. *Id.* at 227.

39. *Id.*

There is little doubt “alternative means would include the exhibition of films on video cassette, DVD,⁴⁰ DivX⁴¹ and all other viewing platforms. Nevertheless, there is evidence that as early as 1944, the industry sought to broaden the scope of “alternative means.”⁴² The employment agreement between Ronald Reagan and Warner Bros. states:

It is further agreed that any motion picture in which Artist may appear may be exhibited through or by any and all exhibiting, reproducing and/or transmitting devices, including radio and television and all other improvements and devices which are now being used or may hereafter be used in connection with the exhibition, reproduction and/or transmission of any present or future kind of motion picture production.⁴³

For years, similar language appeared in standard form contracts to control future technological improvements.⁴⁴ While each studio employed slightly different terms, virtually every contract included broad language regarding future developments.⁴⁵

40. Digital versatile discs (“DVDs”), can store more than 4.7 Gigabytes of data. They are used to hold full-length motion pictures in digital format. *Universal City Studios, Inc. v. Reimerdes* 111 F. Supp. 2d 294, 307 (S.D.N.Y. 2000).

41. A DivX is a “compression program available for download over the Internet . . . [that] compresses video files in order to minimize required storage space, often to facilitate transfers over the Internet or other networks.” *Universal City Studios*, 111 F. Supp. 2d at 308. DivX is a digital video format that enables quality, movie-length digital video and sound to fit on a 700 megabyte computer disc (“CD”) as opposed to two gigabyte DVD. Lev Grossman, *Next Up: DVDs*, TIME, July 31, 2000, at 35. The standard was developed by Microsoft but cracked by French hackers, allowing easier trading and copying of digital video over the Internet. *Id.*

42. See *WARNER BROS., INC. AND RONALD REAGAN AGREEMENT* (Nov. 15, 1944) (on file with author) [hereinafter *REAGAN AGREEMENT*].

43. *Id.* at 4, para. 6.

44. Virtually identical language appears in the 1946 employment agreement between Humphrey Bogart and Warner Bros. See *WARNER BROS. PICTURES, INC. AND HUMPHREY BOGART AGREEMENT* at 15 (Dec. 19, 1946) (on file with author) [hereinafter *BOGART II AGREEMENT*]. Similar language is also found in the 1954 agreement between James Dean and Warner Bros. See *WARNER BROS. PICTURES, INC. AND JAMES DEAN AGREEMENT*, at 6 para. 5 (Apr. 7, 1954) (on file with author) [hereinafter *DEAN AGREEMENT*].

45. The 1950 agreement between Marilyn Monroe and Twentieth Century language included, “the present and future developments of the motion picture industry; including talking motion pictures, movietone productions, television productions and all forms of motion pictures and their accompanying devices . . .” *TWENTIETH CENTURY-FOX FILM CORP. AND MARILYN MONROE AGREEMENT* at 5 Seventh Covenant (May 2, 1950) (on file with author) [hereinafter *MONROE AGREEMENT*].

B. "Or Otherwise": Broad Language in Employment Agreements is Not Enough to Secure the Artist's Right to Publicity

In 1992, Warner Bros. sued The James Dean Foundation Trust ("Dean Trust") and its licensing agent, Curtis Management Group ("CMG").⁴⁶ The suit alleged that pursuant to the actor's 1954 employment contract, Warner Bros. acquired sole and exclusive ownership of Dean's right of publicity.⁴⁷ Warner Bros. also asserted the Dean Trust and CMG violated the Racketeer Influenced and Corrupt Organizations Act ("RICO").⁴⁸ Finally, Warner Bros. sought a declaration that: 1) Dean's right of publicity, as set forth in section 990,⁴⁹ did not belong to the Dean Trust, but to Warner Bros.; 2) the Dean Trust and CMG account for all revenues received from the licensing of Dean's name, likeness and image and 3) all revenues obtained by the Dean Trust and CMG should be disgorged.⁵⁰ The Dean Trust and CMG contended the 1954 employment agreement terminated upon Dean's death in 1955, and that his descendible rights passed to his father, Dean's sole lineal heir.⁵¹

Warner Bros.' claim rested on the language of the agreement.⁵² Specifically, Warner Bros. asserted that in paragraph 6(A), Dean granted Warner Bros. the right to photograph his "acts, poses, plays and appearances of any all kinds, and to produce and reproduce the same or any part of them by photography, printing, and all other methods, and to distribute and exploit the same in motion picture films, *or otherwise . . .*"⁵³ According to Warner Bros., the "or otherwise" language included Dean's merchandising rights.⁵⁴

In analyzing the contract language, the court disagreed with Warner Bros., finding the agreement limited paragraph 6(A) to Warner Bros.' right to exploit and advertise Dean's motion pictures.⁵⁵ The court determined that "or otherwise" appearing in paragraph 6(B) of the agreement limited

46. Warner Bros., Inc., v. Curtis Mgmt. Group, Inc., No. 91-4016, 1995 WL 420043 (C.D. Cal. Mar. 31, 1993).

47. *Id.*

48. *Warner Bros.*, 1995 WL 420043, at *1.

49. CAL. CIV. CODE § 990 (West 1982), *amended by* CAL. CIV. CODE § 3344.1 (Supp. 2000).

50. *Warner Bros.*, 1995 WL 420043, at *1.

51. *Id.*

52. *Id.* at *3.

53. *Id.* at *4 (emphasis added) (citing DEAN AGREEMENT, *supra* note 44, para. 6A).

54. *Id.*

55. *Id.*

that paragraph to phonographic records.⁵⁶ Moreover, the court found “nowhere in paragraph 6 (much less the entire 1954 Employment Agreement) are merchandising rights discussed.”⁵⁷

The court contrasted paragraph 6(A) with paragraph 8, which contemplated the use of Dean’s name and likeness “other than in connection with” motion pictures.⁵⁸ In paragraph 8, Dean granted to Warner Bros., for the term of the contract, “the right ‘to use or make use of and control his name’; and ‘to use and/or distribute his pictures, photographs or other reproductions of his physical likeness for advertising, commercial or publicity purposes’”⁵⁹ Unlike the rights granted in paragraph 6, Warner Bros. could exploit the rights conferred in paragraph 8 regardless of whether they were connected with the motion picture, its advertisement, or its publicity. However, Warner Bros. owned the rights for two years beyond the expiration of the agreement.⁶⁰ According to the contract, “thereafter [Dean] shall be privileged to enter into such agreements or transactions with reference to the use of his name and likeness as he may deem proper.”⁶¹

In support of its contention, Warner Bros. produced expert witnesses to confirm the language “or otherwise” was the industry standard and was generally understood to include the right of publicity.⁶² In response, the Dean Trust and CMG produced their own experts to confirm the right of publicity was not a subject of the contract.⁶³ In this instance, the court held a studio could not expand the scope of a forty-five page standard motion picture agreement to subsume the entire body of right of publicity law.⁶⁴ The justices recognized “or otherwise” did not on its face usurp the publicity rights of James Dean.⁶⁵

In reviewing this and other extrinsic evidence, the *Dean Trust* court focused on three main facts.⁶⁶ First, as early as 1937, Warner Bros. used form contracts containing language similar to paragraphs 6 and 8 of the

56. *Warner Bros.*, 1995 WL 420043, at *4.

57. *Id.*

58. *Id.*

59. *Id.* (citing DEAN AGREEMENT, *supra* note 44, para. 8).

60. *Id.*

61. *Warner Bros.*, 1995 WL 420043, at *4.

62. *Id.* This attempt completely failed. *Id.* at *6-7.

63. *Id.*

64. *Id.*

65. *Id.* at *7.

66. *Id.* at *6.

agreement.⁶⁷ However, Warner Bros. did not exploit actors' names and likenesses apart from promotion of motion pictures until the 1950's.⁶⁸ Additionally, Warner Bros. did not launch a merchandising department until 1958.⁶⁹

Second, Warner Bros. had form contracts from the same period containing language identical, or nearly identical, to paragraphs 6 and 8 of Dean's Employment agreement, which also restricted Warner Bros. from using the artist for unrelated commercial purposes and merchandising.⁷⁰ Bogart's 1935 contract with Warner Bros., which included the "or otherwise" language,⁷¹ also specifically included a grant to the studio of the sole and exclusive rights to make use of and control Bogart's name and likeness for advertising and commercial purposes whether or not connected to the film.⁷² This grant was limited to "a reasonable period, not exceeding 2 years after the termination" of the agreement.⁷³

Finally, Warner Bros. used form contracts from the same period that included specific merchandising provisions.⁷⁴ For instance, in Ronald Reagan's 1944 agreement with Warner Bros., Warner Bros. attached a provision specifically withholding Reagan's right to make commercials and to exploit his name and likeness.⁷⁵ This rider expressly limited the use of Reagan's image to advertising and commercial tie-ups directly associated with the motion picture.⁷⁶

Based on such evidence, the court concluded Dean's 1954 employment agreement, read as a whole, did not grant the additional right to exploit Dean's name and likeness,⁷⁷ and that Warner Bros. failed to offer any probative or persuasive extrinsic evidence to prove otherwise.⁷⁸ Had the court determined differently, the effect would have been profound. The interpretation proffered by Warner Bros., would mean all performers

67. *Warner Bros.*, 1995 WL 420043, at *6. Bogart's 1946 contract with Warner Bros., included the "or otherwise" language, and granted the studio the sole and exclusive rights to make use of and control Bogart's name and likeness for advertising and commercial purposes. BOGART II AGREEMENT, *supra* note 44, at 11 para. 7. This type of grant was limited to "a reasonable period, not to exceed two years after the termination" of the agreement. *Id.* at 10 para. 5.

68. *Warner Bros.*, 1995 WL 420043, at *6.

69. *Id.*

70. *Id.*

71. BOGART AGREEMENT, *supra* note 25, para. 10.

72. *Id.* at 7, para. 12.

73. *Id.* at 8, para. 12.

74. *Warner Bros.*, 1995 WL 420043 at *6.

75. REAGAN AGREEMENT, *supra* note 42, at 7 para. 11.

76. *Id.*

77. *Warner Bros.*, 1995 WL 420043, at *9.

78. *Id.* at *11.

working under a standard form contract would relinquish their rights of publicity in perpetuity with respect to the acts, poses, plays, and appearances made while under contract.⁷⁹ Moreover, the motion picture industry would attain an unlimited ability to use performers, living and deceased, in all forms of commercial and merchandising uses.⁸⁰

The resounding defeat in *Dean Trust* signaled an important transition in the entertainment industry's strategy and its pursuit to control every aspect of the performer and the related profits of the performer's work.⁸¹ The industry could no longer rely upon the four corner approach of interpreting an employment contract, its most sacred, battle-tested method of appropriating artists' rights of publicity. Instead, the entertainment industry turned to its next strategy: elimination of the right of publicity altogether.

III. THE PREEMPTIVE STRIKE

As a composer painstakingly places the final note on a page, as a painter, with delicate precision, applies a final brush stroke, as an author types the words "The End," something almost indefinable has taken place. Amid the clanging and chatter of our lives, the composer has heard a whisper of melody. The painter has allowed us a momentary glimpse of the world seen through the eyes of another. By positioning a mirror before our lives, the author has asked us to examine, explore, and sometimes even challenge who we are. Each has been inspired to bring to life an original expression.

79. The court's decision is also supported by the course of dealing between actors and other studios. For example, in a one paragraph letter agreement dated June 12, 1939, Judy Garland's 1935 contract with MGM was forever amended. Letter from Judy Garland and Ethel Gilmore to Loew's Inc. (June 12, 1939) (on file with author). The letter, signed by Ms. Ethel Gilmore and her daughter, assigned, "perpetually, without limit as to time . . . to use my name, photograph, likeness and/or the reproduction of my voice and sound effects in connection with any advertising and/or commercial tie-ups or for any other commercial purposes provided that such tie-ups or other commercial uses refer to said photoplay now entitled the "WIZARD OF OZ. . . ." *Id.* MGM may not have imagined the lasting impact of the Wizard of Oz, but they clearly realized that the rights associated with Judy Garland's persona were not fully acquired in her contract, and hence the letter agreement. *Id.*

80. Performers and their heirs often have strong feelings as to what products make appropriate endorsements. *See generally*, Abdul-Jabbar v. General Motors Corp., 75 F.3d 1391, 1400 (9th Cir. 1996). Abdul-Jabbar objected to the use of his former name, Lew Alcindor, in a GMC commercial. *Id.* at 1393-94. Tobacco and alcohol products are frequently considered unsavory associations based upon personal choices or the public personality of the performer. *See infra* Part III.B. In the case of certain products or services, no amount of money will entice the performers or their heirs. *See infra* Part III.B. Arguably, the executives of a motion picture studio often have interests in direct conflict with the interests of such heirs. *See infra* Part III.B.

81. *See infra* Part III.B.

Inspiration has been defined as, “The creative impulse of an artist, often seen as a supernatural prompting.”⁸² Yet as we clumsily attempt to understand the source of creativity, there is no mistaking the value that society has placed upon the tangible expression of this intangible process.

A. Copyright Law

1. Historical Overview

For nearly five hundred years, laws have protected and encouraged the creative spirit.⁸³ One of the earliest statutes to protect authors states, “[i]t is decreed that henceforth no printer in this city shall dare to print . . . any words . . . unless . . . the author or his heirs . . . have declared their consent and requested the printing.”⁸⁴ In Great Britain, the 1710 Statute of Anne provided protection for authors and booksellers by granting “the sole right and liberty of printing such books for the term of one and twenty years.”⁸⁵

As early as 1672, the Massachusetts Bay Colony statutorily recognized the need to protect authors’ rights to their original works.⁸⁶ The statute provided no printer could reproduce copies “except as agreed upon by the owner or with his consent.”⁸⁷ By 1786, a Continental Congress resolution prompted twelve of the original states to adopt statutes protecting the writings of authors for a limited period of time.⁸⁸ At the Constitutional Convention in 1787, James Madison stated a “Copyright Clause” granting “national” rights⁸⁹ would serve three purposes. First, federally copyrighted material would increase the author’s economic benefit from the copyrighted material.⁹⁰ If only some statutes acknowledged copyright protection, the economic value of an author’s work would be diminished.⁹¹ Second, federal copyright protection would promote uniformity and avoid the practical difficulties of enforcing the

82. WEBSTER’S DICTIONARY page 501 (1988).

83. WILLIAM H. FRANCIS & ROBERT C. COLLINS, PATENT LAW 837 (1995).

84. Frank D. Prager, *History of Intellectual Property from 1545-1787*, 26 J. PAT. OFF. SOC’Y 711, 750 (1944) (citing Sixteenth Century records from Venice).

85. FRANCIS & COLLINS, *supra* note 83, at 837.

86. *Id.*

87. *Id.*

88. *Id.*

89. *Goldstein v. California*, 412 U.S. 546, 556 (1973).

90. *Id.* at 558.

91. *Id.*

divergent laws of each state.⁹² Finally, Madison posited that federal copyright would protect the public welfare by encouraging progress in artists' talents, scientists' inventions and other useful arts.⁹³

Article I, section 8, paragraph 8, of the United States Constitution embodies Madison's reasoning.⁹⁴ The text provides that Congress shall have the power "to promote the Progress of Science and the Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."⁹⁵ Congress utilized this power to enact the 1909 Copyright Act.⁹⁶

Congress has amended the Copyright Act many times in an effort to address an ever-changing society.⁹⁷ In 1976, Congress enacted the most recent, complete revision, which acknowledged that authors continue to find new methods of expression.⁹⁸ New technology, such as phonorecording, rendered the 1909 Act inadequate.⁹⁹ The 1976 revisions were an attempt to resolve such problems.¹⁰⁰ While a complete analysis of Title 17 is beyond the scope of this Article, §§ 102, 106 and 301 demand specific attention.

Section 102 of the Copyright Act discusses the subject matter of copyright protection:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying works;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;

92. *Id.* at 556 n.12.

93. *Id.*

94. U.S. CONST. art. I, § 8, cl. 8.

95. *Id.*

96. See *Goldstein*, 412 U.S. at 563-65.

97. *Id.* at 562.

98. 17 U.S.C. § 102 (1994) (recognizing "any tangible medium of expression, now known or later developed").

99. See *Goldstein*, 412 U.S. at 562-65.

100. 17 U.S.C. § 301 (1994) (citing H.R. REP. NO. 94-1476).

(7) sound recordings

(8) architectural works

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.¹⁰¹

The House Report accompanying the Copyright Act expressly states that the enumerated categories are merely illustrative, and do not exhaust the scope of original works of authorship the bill is intended to protect.¹⁰²

Section 106 enumerates those rights that are the exclusive province of the copyright holder:

Subject to Sections 107 through 120, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.¹⁰³

In addition to addressing advances in technology in the 1976 revision, Congress also sought to harmonize United States copyright law with copyright laws throughout the world.¹⁰⁴ This task, however, required

101. 17 U.S.C. § 102 (1994).

102. *See supra* note 100.

103. 17 U.S.C. § 106 (1994).

104. *See supra* note 100.

addressing a doctrine unique to the United States copyright system, the “common law” copyright.

2. Common Law Copyright

For years, the federal government and sovereign states held concurrent power to enact copyright law.¹⁰⁵ The United States Supreme Court recognized such common law copyrights in *Wheaton v. Peters*.¹⁰⁶ In 1973, the Court held in *Goldstein v. California*¹⁰⁷ that individual states retain the power to grant copyright protection to the works of authors, as long as state protection does not conflict with federal law.¹⁰⁸ For years, the courts construed this concurrent power to mean that federal copyright law protected published works, while unpublished material fell under state common law.¹⁰⁹ As a result, because not all states recognized common law copyright, protection remained inconsistent throughout the country.¹¹⁰

Inconsistencies within the dual system posed various problems. Unpublished works, protected by common law copyright, theoretically maintained protection for eternity if the state’s common law permitted.¹¹¹ The inconsistencies also generated uncertainty, particularly when attempting to determine the scope of protection of any unpublished work.¹¹² Moreover, because the United States was the only country burdened with this dual system, “[i]n an era when copyrighted works can be disseminated instantaneously to every country on the globe,” the United States needed uniform national copyright protection more than ever.¹¹³

3. Section 301 of the 1976 Copyright Act

Exercising power established by the Supremacy Clause of the United States Constitution,¹¹⁴ Congress enacted § 301 of the Copyright Act.¹¹⁵

105. *Goldstein*, 412 U.S. at 553.

106. 33 U.S. (8 Pet.) 591 (1834).

107. 412 U.S. 546 (1973).

108. *Goldstein*, 412 U.S. at 571.

109. 1 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[A] (2000) [hereinafter NIMMER & NIMMER].

110. *Id.*

111. *See id.*

112. *See id.*

113. *See supra* note 109.

114. U.S. CONST. art. VI, § 2 providing:

This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be

Subsection (a) provides that beginning January 1, 1978, those works of authorship within the broader scope of § 106 and specified in §§ 102 and 103 are henceforth covered by § 301; those rights falling within this purview are no longer entitled to state common law copyright protection.¹¹⁶ Subsection (b) provides those rights not falling within the controlling or superceding power of § 301 as enunciated in subsection (a), remain rights and remedies protected under state common law and state statutes.¹¹⁷

It is evident the legislators of the 1976 Act believed § 301 would require minimal interpretation:

The declaration of this principle in § 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between state and Federal protection.¹¹⁸

Section 301 was enacted for the principal purpose of eliminating such dichotomies between state common law protection of unpublished works and federal protection of published works, by establishing clear guidelines regarding when Congress intended federal law to preempt its state law counterparts.¹¹⁹ Under § 301, a work obtains statutory protection upon creation or, as defined in § 101, when it is "fixed in a copy or phonorecord for the first time."¹²⁰ Thus, with § 301, Congress attempted to abrogate common law copyright and eliminate the concept of publication as the dividing line between common law and statutory protection.¹²¹

4. Application of § 301

Preemption under § 301 requires a showing of two elements.¹²² First, the work must be fixed in a tangible medium of expression and fall within the subject matter of copyright as specified by §§ 102 and 103.¹²³ This rule

bound thereby, anything in the Constitution or Laws of any State to the Contrary notwithstanding. *Id.*

115. 17 U.S.C. § 301 (1994).

116. *Id.* § 301(a).

117. *Id.* § 301(b).

118. *Id.* § 301 (citing H.R. REP NO. 94-1476).

119. *Harper & Row Publishers, Inc. v. Nation Enter.*, 723 F.2d 195 (2d Cir. 1983).

120. 17 U.S.C. §§ 101, 301(a).

121. 17 U.S.C. § 301 (citing H.R. REP NO. 94-1476).

122. *Id.*

123. See *Del Madera Props. v. Rhodes & Gardner, Inc.* 820 F.2d 973, 976 (9th Cir. 1987); *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 871 (C.D. Cal. 1999); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 650-51 (Ct. App. 1996).

applies whether the work is published or unpublished.¹²⁴ Second, the law must create legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright, as specified by § 106.¹²⁵

To demonstrate, a work not “fixed in a tangible medium of expression” as required by § 102, such as a speech or live performance not transcribed or captured on videocassette, fails to satisfy the first element.¹²⁶ As the work would not be preempted under § 301 because it is not fixed, common law and state statutes could conceivably protect such works.

Similarly, where a state law affords rights affecting the use of a work falling within the scope of § 102, such rights must be “equivalent” to the federal statute if they are to be preempted.¹²⁷ The state protected right must require proscription of the unauthorized reproduction, performance, distribution or display of the work.¹²⁸

The Supreme Court has held that for a common law right to be equivalent to federal protection, infringement must occur by the mere reproduction, performance, distribution, or display of the protected work.¹²⁹ Where a state law affords rights containing “extra elements” beyond those enumerated in the federal statute, such law will likely escape § 301 preemption.¹³⁰

The 1976 Copyright Act is hardly free from any conceivable misinterpretation. While this most recent revision addressed the question of preemption with respect to state common law copyright protection, the question remains, does § 301 preempt more than common law copyright?

The definition of “equivalent rights” remains a topic of heated debate.¹³¹ Some argue that where competing rights of any kind exist in the same piece of property, preemption is required.¹³² Others contend it is the

124. 17 U.S.C. § 301.

125. *Id.*; see also *Del Madera*, 820 F.2d at 976.

126. See, e.g., *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 13 F. Supp. 2d 1347 (N.D. Ga. 1998) (holding Dr. King’s speech during The March on Washington was so widely reproduced and disseminated that it constituted a general publication, and thus was in the public domain).

127. 17 U.S.C. § 301 (a), (b).

128. *Id.*

129. *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539 (1985).

130. *Hoffman*, 33 F. Supp. 2d at 871.

131. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting).

132. *Id.* at 1518.

nature of the rights in that property that must be equivalent for preemption to occur.¹³³

Those who argue that copyright should preempt the right of publicity often place these two legal theories on a mythical collision course. In order to fully understand the conflict, however, one must explore the history of the right of publicity.

B. *The Right of Publicity*

The right of publicity is the right of every person to “control the commercial use of his or her identity.”¹³⁴ Right of publicity statutes typically prohibit an individual from using another’s name, voice, signature, photograph or likeness in products or advertisements without that person’s permission.¹³⁵

For all of the confusion surrounding this area of law, the right of publicity can be stated as nothing more than the right of every person to control the commercial use of his or her identity.¹³⁶ While this burgeoning legal theory applies to the entire population, there is little wonder why litigation of this type usually involves those in the entertainment industry. An individual whose livelihood depends upon the calculated exploitation of his or her name, image, and likeness will inherently suffer the greater loss by the unauthorized use. Perhaps the greatest asset a celebrity has to sell is his or her “persona.” To fully understand this area of law and the direction in which it is headed, it is critical to examine its history.

1. Transition from the Right to Privacy to the Right of Publicity

The “right of privacy” is not explicit in the United States Constitution.¹³⁷ However, Justice Brandeis acknowledged this right in

133. *Id.*

134. 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.1[A][1] (1999) [hereinafter 1 MCCARTHY].

135. CAL. CIV. CODE § 3344 (West 1997). An individual whose livelihood depends upon the calculated exploitation of his or her name, image, and likeness will inherently suffer the greater loss by author’s unauthorized use of his or her likeness. *See Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983); *see also* David E. Shipley, THREE STRIKES AND THEY’RE OUT AT THE OLD BALL GAME: PREEMPTION OF PERFORMERS’ RIGHTS OF PUBLICITY UNDER THE COPYRIGHT ACT OF 1976, 20 ARIZ. ST. L.J. 369 (1988). The court suggests that a celebrity “persona” is a valuable asset. *Carson*, 698 F.2d at 837.

136. 1 MCCARTHY, *supra* note 134, § 1.1[A][1].

137. *Griswold v. Connecticut*, 381 U.S. 479 (1965).

Olmstead v. United States.¹³⁸ Brandeis argued that despite the lack of specific language in the Constitution, the framers conferred the right to be left alone as the “most comprehensive of rights” and the “right most valued by civilized men.”¹³⁹

In addition to Justice Brandeis’ service on the Court, he also gained notoriety for an 1890 law review article written with his then law partner, Samuel D. Warren.¹⁴⁰ In their article, Brandeis and Warren assert an individual has a common law right to determine “to what extent his thoughts, sentiments, and emotions shall be communicated to others.”¹⁴¹

Initially, the New York courts accepted this new legal theory of a right to privacy.¹⁴² However, in *Roberson v. Rochester Folding Box Co.*,¹⁴³ the court rejected the doctrine.¹⁴⁴ The defendant in *Roberson* used the photograph of an attractive young lady to advertise its product without authorization.¹⁴⁵ In holding no right of privacy existed, the court expressed a fear of the “vast amount of litigation involving not only pictures,” but even “a comment on one’s looks, conduct, domestic relations or habits.”¹⁴⁶

In response to this ruling, the 1909 New York Legislature enacted a statute now known as the New York Civil Rights Law (“Civil Rights Law”).¹⁴⁷ The statute prohibits the use of the name, portrait, or picture of any living person without prior consent for “advertising purposes” or “for the purposes of trade.”¹⁴⁸

138. *Olmstead v. United States*, 277 U.S. 438 (1928) (Brandeis, J., dissenting) (stating wiretapping did not constitute a violation of the Fourth Amendment).

139. *Id.* at 478.

140. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

141. *Id.* at 198. Warren had married Miss Maybel Bayard, daughter of Senator Thomas Francis Bayard, Sr. They set up housekeeping in Boston’s exclusive Back Bay Section and began to entertain elaborately. *The Saturday Evening Gazette*, which specialized in the ‘blue blood items,’ naturally reported their activities in lurid detail. This annoyed Warren, who took up the matter with Brandeis. The article was the result. Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 966 (1964) (quoting ALPHEUS T. MASON, *BRANDEIS: A FREE MAN’S LIFE* 70 (1960)); see also Oliver R. Goodenough, *Go Fish: Evaluating the Restatement’s Formulation of the Law of Publicity*, 47 S.C. L. REV. 709, 721 (1996) (claiming the myth surrounding the article has been dispelled); William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

142. WILLIAM L. PROSSER & W. PAGE KEETON, *PROSSER & KEETON ON THE LAW OF TORTS* § 117 (5th ed. 1984).

143. 64 N.E. 442 (1902).

144. *Id.* at 443.

145. *Id.* at 442.

146. *Id.* at 443.

147. N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1992).

148. *Id.*

However, it would be another fifty years until Justice Jerome Frank formulated the moniker “right of publicity” in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*¹⁴⁹ In that opinion, Justice Frank stated New York law contained a right of publicity distinct from the right of privacy.¹⁵⁰ The right of publicity enabled individuals to protect themselves from unauthorized commercial appropriations of their personas.¹⁵¹ Thus, Justice Frank recognized an independent, common law right protecting economic interests rather than the personal, emotional interests associated with the right of privacy.¹⁵²

The court’s rationale for recognizing the right of publicity reflected concern that prominent persons would no longer receive money for the use of their likenesses in newspapers, magazines, and advertisements.¹⁵³ Such use would only yield money if it resulted in an exclusive grant to the particular advertiser.¹⁵⁴ As such, the right of publicity was necessary to ensure exclusivity.¹⁵⁵

2. From Privacy to Publicity

Since these early decisions, courts and legal scholars have struggled with this “haystack in a hurricane” area of law.¹⁵⁶ In 1960, William L. Prosser identified four torts that fell within the doctrine of the right of privacy: (a) intrusion upon the plaintiff’s seclusion or solitude, or into his private affairs; (b) publication which places the plaintiff in false light in the public eye; (c) public disclosure of true, embarrassing private facts about the plaintiff and (d) appropriation of the plaintiff’s name or likeness for commercial purposes.¹⁵⁷ Prosser’s attempt to link the right of publicity to a right of privacy, however, may have confused the debate.¹⁵⁸ For this reason, opponents to a decedent’s right of publicity continue to point to the limitations of the right of privacy.¹⁵⁹ The two rights are, however, separate and distinct.¹⁶⁰

149. 202 F.2d 866 (2d Cir. 1953).

150. *Id.* at 868.

151. *Id.*

152. *See id.*

153. *Id.*

154. *Id.*

155. *Haelan*, 202 F.2d at 868.

156. *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481, 485 (3d Cir. 1956).

157. PROSSER & KEETON, *supra* note 142, § 117; *see also* Prosser, *supra* note 141, at 389.

158. Prosser, *supra* note 141, at 389.

159. *See* Lugosi v. Universal Pictures, 160 Cal. Rptr. 323, 327–28 (Ct. App. 1979).

160. *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 715 (Ct. App. 2000).

The right of privacy is a personal right.¹⁶¹ As such, actionable damages for an invasion of this right are measured by mental distress.¹⁶² Thus, the injury dies with the plaintiff.¹⁶³ The right of publicity however, is a property right.¹⁶⁴ A violation of this right results in a commercial injury to the business value of one's personal identity.¹⁶⁵ For this reason, damages for infringement are calculated according to the fair market value of the plaintiff's identity, unjust enrichment, the infringer's profits and damage to the business of licensing the plaintiff's identity.¹⁶⁶

The commercial use of an individual's persona is a business.¹⁶⁷ The control of this business is the basis by which famous persons generate income.¹⁶⁸ The Prosser definition of appropriation ignores this distinction.¹⁶⁹

Recognizing the right of publicity as a property right makes this valuable asset descendible and transferable.¹⁷⁰ In this manner, a celebrity's heir may continue to reap the pecuniary benefit of the life-long efforts of their loved one.¹⁷¹ Otherwise, commercial entities could profit from the use of a celebrity's persona instead of the celebrity's heirs.¹⁷² Even worse, a deceased performer's likeness could be used to endorse products that the performer would consider reprehensible.¹⁷³

Copyright law offers no protection against the unauthorized use of an individual's likeness.¹⁷⁴ As such, some scholars insist the right of publicity must be viewed as a separate and distinct area of law. Most notably, Professor J. Thomas McCarthy claims the right to publicity is neither a

161. 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, 134 (1995).

162. *Id.*

163. *See Lugosi*, 160 Cal. Rptr. at 328.

164. McCarthy, *supra* note 161, at 134.

165. *Id.*

166. *Id.*

167. *See* Sheldon N. Halpern, Essay, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 856–57 (1995).

168. *See id.*

169. Prosser, *supra* note 141, at 401–06.

170. Addison E. Dewey, *The Evolving Doctrine of Right of Publicity: Judicial Protection of Celebrity's Pecuniary Interest from Commercial Exploitation of His or Her Identity and Theatrical Style*, 22 CREIGHTON L. REV. 39, 59 (1988).

171. *Id.* at 54, 61.

172. *See id.* at 54.

173. *See id.* at 42–43.

174. *KNB Enters.*, 92 Cal. Rptr 2d at 715.

trademark nor a type of privacy right, but rather an entirely different legal right, despite the similarities.¹⁷⁵

Arguably, the Supreme Court agrees with McCarthy's characterization. In the high court's only foray into this doctrinal jungle, the Court noted:

[p]etitioner's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in the act; the protection provided an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright law long enforced by this court.¹⁷⁶

Justice White's view remains the backbone of the right of publicity.¹⁷⁷

3. The Current State of the Right of Publicity

Currently, twenty-five states recognize a common law right of publicity for living persons.¹⁷⁸ In addition, fifteen states have enacted a statutory right of publicity.¹⁷⁹ Fourteen states also recognize a postmortem right of publicity.¹⁸⁰ However, New York continues to recognize a version of the right of publicity for living individuals under a theory of right of privacy.¹⁸¹ Despite the piecemeal development and evolution of the right of publicity, a patchwork of reasonably consistent precedent has emerged.

175. McCarthy, *supra* note 161, at 131.

176. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

177. *See, e.g., id.* Most recently, American Law Institute's Restatement of Unfair Competition includes unfair competition as a separate legal theory. Goodenough, *supra* note 141, at 714. It is interesting to note, however, that the drafters of the Restatement adopted Prosser's concept of "appropriation." *Id.* at 715. By employing Prosser's terminology, the Restatement may have the unfortunate effect of perpetuating the "personal right" versus the "property right" confusion.

178. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 *IND. L.J.* 47, 52 (1994).

179. CAL. CIV. CODE § 3344 (West 1997); FLA. STAT. ANN. § 540.08 (West 1997); IND. CODE ANN. §§ 32-13-1-1 to -20 (Michie 1995); KY. REV. STAT. ANN. § 391.170 (Michie 1999); MASS. GEN. LAW. ANN. ch. 214, § 3A (West 1989); NEB. REV. STAT. ANN. § 20-202 (Michie 1997); NEV. REV. STAT. ANN. §§ 597.790-.810 (Michie 1999); OKLA. STAT. ANN. tit. 21, §§ 839.1-.2 (West 1983); OKLA. STAT. ANN. tit. 12, §§ 1448-1449 (West 1993) R.I. GEN. LAWS § 9-1-28.1 (Michie 1997); TENN. CODE ANN. §§ 47-25-1101 to -1108 (Michie 1995); TEX. P. CODE ANN. §§ 26.001-.015 (West 2000); UTAH CODE ANN. §§ 45-3-1 to -6 (Lexis 1998); VA. CODE ANN. § 8.01-40 (Michie 2000); WIS. STAT. ANN. § 895.50 (West 1997).

180. Prosser, *supra* note 141, at 386-89.

181. *Id.* at 385.

a) The Use of a Name and Image

In 1909, the Kentucky Supreme Court held that the use of a person's name and picture in an advertisement without consent violated the right of privacy.¹⁸² Similarly, in 1918, the Kansas Supreme Court held that the unauthorized use of a person's photograph in a moving picture theatre for business purposes violated the right of privacy.¹⁸³ In 1938, the North Carolina Supreme Court determined that the unauthorized use of a radio entertainer's photograph in a bread commercial and a commercial for a stage show violated the entertainer's rights of privacy.¹⁸⁴ In each of these decisions, the courts recognized the value inherent in the commercial use of an individual's image.¹⁸⁵ Today, the unauthorized use of a living individual's name or image is generally recognized as an infringement of that individual's rights.¹⁸⁶

b) The Use of a Persona

A persona can be described as attributes that are so inextricably entwined with an individual that the mere presentation of these attributes calls to mind one particular individual.¹⁸⁷ In 1974, a federal court in California determined that a televised cigarette commercial featuring the race car of a famous driver without his permission violated his right of publicity.¹⁸⁸ Although the driver of the car was unrecognizable, the court found the familiar markings of the car would lead people to infer that the plaintiff endorsed the product.¹⁸⁹ Similarly, the Sixth Circuit held that the use of the phrase "Here's Johnny" to advertise a portable toilet, was actionable because the famous introduction was so closely associated with Johnny Carson that its unauthorized use infringed upon Carson's right of publicity.¹⁹⁰ Comparably, the use of a robot dressed and designed to mimic Vanna White to advertise merchandise was actionable in California in

182. *Foster-Milburn Co. v. Chinn*, 120 S.W.2d 364, 366 (Ky. 1909).

183. *Kunz v. Allen*, 172 P. 532, 533 (Kan. 1918).

184. *Flake v. Greensboro News Co.*, 195 S.E. 55, 64 (N.C. 1938).

185. *See Kunz*, 172 P.2d 532; *see also Flake*, 195 S.E. 55.

186. *Sudakshina Sen, Fluency of the Flesh: Perils of an Expanding Right of Publicity*, 59 ALB. L. REV. 739, 742 (1995).

187. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992). Here, even though a robot looked nothing like the celebrity, there was no mistaking the identity of Vanna White in the advertisement. *Id.*

188. *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

189. *Id.*

190. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

1993.¹⁹¹ Analogously, in 1996, the Ninth Circuit held that the use of the birth name of a sports figure to advertise automobiles infringed his right of publicity, even though the sports figure had legally changed his name.¹⁹²

In each of the above cases, the defendants usurped the celebrity's persona for commercial gain.¹⁹³ Essentially, the courts found certain objects, phrases, or characteristics were so closely associated with the particular celebrity as to infringe upon a right of publicity.¹⁹⁴

c) Impersonators

Look-alike performers can also potentially infringe upon entertainers' rights of publicity.¹⁹⁵ The most famous of the impersonator cases concerned singers Bette Midler¹⁹⁶ and Tom Waits.¹⁹⁷ In each, an impersonator mimicked the star's voice for a television commercial.¹⁹⁸ In *Midler v. Ford Motor Co.*,¹⁹⁹ an impersonator was sued after Ms. Midler declined an offer to record the commercial.²⁰⁰ Young & Rubicam, an advertising agency, hired a vocalist who previously worked as a backup singer for Ms. Midler and requested she "sound as much as possible like the Midler record."²⁰¹

In *Waits v. Frito Lay, Inc.*,²⁰² the court recognized Mr. Waits' personal policy that "musical artists should not do commercials because it detracts from their artistic integrity."²⁰³ In addition, the court found defendants produced a second version of the commercial due to concerns that legal action might result because the impersonator sounded too similar to Waits.²⁰⁴

191. *White*, 971 F.2d 1395.

192. *Abdul-Jabbar v. General Motors Corp.*, 75 F.3d 1391, 1400 (9th Cir. 1996).

193. *Carson*, 698 F.2d at 837; *White*, 971 F.2d at 1399; *Abdul-Jabbar*, 75 F.3d at 1400; *Mostchenbacher*, 498 F.2d at 827.

194. *See Carson*, 698 F.2d at 837; *White*, 971 F.2d at 1399; *Abdul-Jabbar*, 75 F.3d at 1400; *Mostchenbacher*, 498 F.2d at 827.

195. *See, e.g.*, *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981); *see also Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 349 (M.D. Tenn. 1993). Not surprisingly, however, the Nevada right of publicity statute specifically exempts impersonators from right of publicity claims by their subjects. NEV. REV. STAT. ANN. § 597.790 (Michie 1999).

196. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

197. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

198. *Midler*, 849 F.2d at 461; *Waits*, 978 F.2d at 1097.

199. *Midler*, 849 F.2d at 461.

200. *Id.*

201. *Id.*

202. *Waits*, 978 F.2d 1093.

203. *Id.* at 1097.

204. *Id.* at 1098.

These cases recognize that celebrity rights of publicity reside in the associative value of their names, likenesses, voices, and images.²⁰⁵ It is the persona of a celebrity that attracts public attention to the advertisement.²⁰⁶ The purpose of a celebrity in an advertisement is to “increase the value or sales of the product.”²⁰⁷ This is accomplished by identifying the celebrity with the product and thereby “siphoning some of the publicity value or good will in the celebrity’s persona into the product.”²⁰⁸ This goodwill or publicity value is a marketable product belonging to the individual.²⁰⁹

With respect to a decedent’s right of publicity, one must reexamine the “personal right” verses “property right” controversy.²¹⁰ States following the Prosser model consider the right of publicity a personal right, and therefore, any claim for such an invasion is said to die with the plaintiff.²¹¹ For example, under the 1903 New York statute, the right to contest the use of an individual’s identity in advertising ends at death.²¹²

4. California Civil Code Section 3344

Enacted in 1982, California Civil Code section 3344 provides in pertinent part:

(a) Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without prior consent . . . , shall be liable.²¹³

Section 3344 specifically exempts the use of a name, voice, signature, photograph, or likeness in connection with news, public affairs, sports broadcast or account, or any political campaign.²¹⁴ Moreover, section 3344 instructs that the issue as to whether a use should be construed as so directly connected with commercial sponsorship that it should be considered within the scope of subsection (a), is a question of fact.²¹⁵

205. See *Midler*, 849 F.2d at 463–64; *Waits*, 978 F.2d at 1104; see also Halpern, *supra* note 167, at 857.

206. Halpern, *supra* note 167, at 857.

207. *Id.* at 856.

208. *Id.*

209. *Id.* at 857.

210. *Id.* at 858–59.

211. See, e.g., N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1992).

212. *Id.*

213. CAL. CIV. CODE § 3344(a) (West 1997).

214. *Id.* at § 3344(d).

215. *Id.* at § 3344(e).

In short, the right of publicity does not prevent the use of a personality's name in news reporting,²¹⁶ and does not preclude the use of identity in an unauthorized biography.²¹⁷ Similarly, it cannot be used to prevent satire or parody, which includes the use of an individual's identity.²¹⁸ Accordingly, the right of publicity applies only to advertising and similar commercial uses.²¹⁹

IV. WHERE COPYRIGHT AND THE RIGHT OF PUBLICITY THEORETICALLY COLLIDE

The right of publicity guards against the unauthorized use of a person's name, image, or likeness, often referred to as one's "persona."²²⁰ Copyright laws, however, protect "original works of authorship fixed in any tangible medium of expression."²²¹ These two rights are separate and distinct.²²²

With all deference to a superior being, a face is not an original work of authorship, and courts would likely loath such an ethereal suggestion.²²³ An individual's name is clearly not dependent upon a tangible means of expression.²²⁴ Moreover, an individual's likeness does not depend on a tangible medium of expression.²²⁵ Why then, should these two seemingly exclusive legal theories raise a discussion, fostering literally thousands of pages of debate?

The industry had determined that the right to an artist's persona would be wrested away through language or otherwise. This time, however, "or otherwise" would require a direct attack on the on right of publicity.

A. Wendt v. Host International, Inc.

Paramount Pictures told America, "You wanna go where everybody knows your name" and for eleven years, the successful television program

216. *Stephano v. News Group Publ'ns, Inc.*, 474 N.E.2d 580, 586 (N.Y. 1984).

217. *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994).

218. 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 8.15[B] (1999) [hereinafter 2 MCCARTHY].

219. *See* 2 MCCARTHY, *supra* note 218, at 130.

220. CAL. CIV. CODE § 3344 (West 1997).

221. 17 U.S.C. § 102(a) (1994).

222. *Wendt v. Host Int'l*, 125 F.3d 806, 811 (9th Cir. 1997).

223. *See, e.g.*, *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, at 715 (Ct. App. 2000).

224. *Wendt v. Host Int'l, Inc.*, 50 F.3d 18, 1995 WL 115571, at *2 (9th Cir. Mar. 16, 1995).

225. *Id.*

“*Cheers*” was just that place.²²⁶ Set in a bar in Boston, the characters became family to their viewing public, largely because the talented ensemble of actors brought the scripts to life.²²⁷ Two characters in particular, Norm, the overweight and usually unemployed accountant, and Cliff, the know-it-all mailman, became fixtures on American television.²²⁸

In 1994, Host International decided to “tap into this keg of goodwill.”²²⁹ Host opened a line of *Cheers* airport bars, after securing a license from Paramount, the copyright holder of the television program.²³⁰ To create a *Cheers*-like atmosphere, Host populated the bars with animatronic figures resembling Norm and Cliff—one of the figures is overweight; the other is dressed as a mailman.²³¹ When the actors, George Wendt and John Ratzenberger, sued Host alleging an infringement of their rights of publicity, Paramount intervened, claiming its copyright preempted any state law claims.²³² The District Court granted summary judgment in favor of Host and Paramount, and the plaintiffs appealed.²³³

In an unpublished opinion of the U.S. Court of Appeals for the Ninth Circuit, the court made its position unequivocal.²³⁴ Citing *Midler*, the Court stated, “at the outset, we wish to make it clear that this is not a preemption case. Plaintiff’s causes of action are not preempted by federal copyright law.”²³⁵ Following the *Waits* decision, the court further concluded that as long as the plaintiff’s action contains elements other than those protected by copyright, there is no federal copyright preemption.²³⁶

On remand, the district court compared photos of the animatronic figures with the actors in person.²³⁷ The court determined the robots were not likenesses of Wendt or Ratzenberger.²³⁸ In fact, the court claimed it could not find any similarity at all.²³⁹

226. Gary Portnory & Judy Hart Angelo, *Theme from Cheers (Where Everybody Knows Your Name)* (Earthtone Recording, Inc.).

227. *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting).

228. *Id.*

229. *Id.*

230. *Id.*

231. *Id.*

232. *Id.*

233. *Wendt*, 197 F.3d at 1285.

234. *Wendt*, 1995 WL 11571, at *1.

235. *Id.*

236. *Id.*

237. *Wendt*, 125 F.3d at 809.

238. *Id.*

239. *Id.*

In its second reversal of the district court in 1997, the Court of Appeals once again held that the causes of action were not preempted by federal copyright law.²⁴⁰ The appellate court held that the district court's comparison of the photographs of Wendt and Ratzenberger with the photographs of the animatronic figures was not sufficient to resolve their claims.²⁴¹ Remanded for a third time, the district court yet again decided for the defendant, Host and Paramount, on summary judgment.²⁴² Once again, Wendt and Ratzenberger appealed. This time, however, the Ninth Circuit voted to deny the petition for rehearing.²⁴³

B. The Wendt Dissent Exposed

Although the Ninth Circuit rejected Paramount's preemption arguments, a vigorous dissent was filed by Justice Kozinski. The *Wendt* dissent suggests this case "pits actor against copyright holder" and that the parties were fighting over the same intellectual property rights—the right to make dramatic representations of the characters.²⁴⁴ The dissent, authored by Justice Kozinski, cites section 301(a) of the Copyright Act, stating federal law preempts any state law providing legal or equitable rights equivalent to exclusive rights within the general scope of federal copyright.²⁴⁵ Moreover, the dissent states, "the presentation of the robots in the *Cheers* bar is a derivative work,²⁴⁶ just like a TV clip, promotion, photograph, poster, sequel or dramatic rendering of an episode."²⁴⁷

The dissent's theory is flawed because its application eclipses not only the right of publicity, but a good portion of trademark law as well. For instance, based upon the dissent, a Wendt robot, eleven inches tall and manufactured by Mattel®, is a derivative work. Additionally, a film clip featuring Wendt and Ratzenberger advertising for Miller Lite, would not

240. *Id.*

241. *See id.* The court further instructed that its previous decision required that any comparison must be determined by a comparison of the actual three dimensional entities and that any comparison must be decided without reference to the context in which the image appears. *Id.* In doing so, the court determined that the question of "likelihood of confusion" was an issue for a jury to decide. *Id.*

242. *Id.* at 809.

243. *Wendt*, 197 F.3d at 1284.

244. *See id.* at 1286.

245. *Id.*

246. 17 U.S.C. § 101 (1994) (defining "derivative work" as work based upon one or more preexisting works or some modification of an original work of authorship).

247. *Wendt*, 197 F.3d at 1286.

infringe on the right of publicity of the actors. Finally, a poster would be beyond the purview of the right of publicity.²⁴⁸

The dissent also attacked the majority opinion in *White*, alleging the decision was a “sweeping standard.”²⁴⁹ In support, the dissent cites the Ninth Circuit case *Lugosi v. Universal Pictures*²⁵⁰ from 1979, and *Stephano v. News Group Publications, Inc.*,²⁵¹ a New York case from 1984. Justice Kozinski incorrectly relies on these cases for two major reasons.

First, *Lugosi* addressed whether the decedent, actor Bela Lugosi, had a right of publicity even though many people prior to Lugosi portrayed the character Dracula.²⁵² The fact that there was not an inextricable connection between Lugosi’s persona and the character was a crucial factor in the court’s holding.²⁵³ Additionally, California first codified the concept of a right of publicity in 1982 and a decedent’s right of publicity was not enacted in California until 1985.²⁵⁴ Thus, the vast majority of the 1979 *Lugosi* decision has been superseded by statute, rendering its persuasive value, and hence Kozinski’s conclusion, dubious.

Second, *Stephano* is a sixteen year-old case from New York, the jurisdiction widely considered the most hostile to the right of publicity. Furthermore, *Stephano*’s facts are not even remotely analogous to *Wendt*.²⁵⁵ *Stephano* addressed whether the use of a photo was for advertising purposes or reporting.²⁵⁶ The court addressed the definition of “trade” and “advertising purposes” under New York Law.²⁵⁷ Citing a litany of New York decisions, the court held a “picture illustrating an article on a matter

248. The logical extension of this argument is that the copyright owner of a photograph, which features a Budweiser billboard advertisement, would be allowed to utilize that photograph on any type of merchandise or product. Coffee mugs, linens, T-shirts and posters would be derivative works, which would escape the purview of the brewer’s trademark rights.

249. *Id.*

250. 160 Cal. Rptr. 323 (1979) (refusing to recognize a right of publicity for decedents).

251. 474 N.E.2d 580 (N.Y. 1984).

252. *Lugosi*, 160 Cal. Rptr. at 325.

253. *Id.* at 343.

254. CAL. CIV. CODE § 990 (West 1982), amended by CAL. CIV. CODE § 3344.1 (Supp 2000).

255. See *Stephano*, 474 N.E.2d 580. Plaintiff, a professional model, brought an action claiming that defendant used a photograph for advertising without his consent and in violation of N.Y. Civil Rights Law sections 50 and 51. *Id.* at 582. Plaintiff posed in a bomber jacket for the photograph and had agreed to the first printing. *Id.* The photo was then printed a second time in a regular column in the same publication which contains new and unusual products available in the metropolitan area. *Id.* Plaintiff contends that the second printing was an advertisement because the column mentioned the approximate price and a variety of locations where the jacket could be purchased. *Id.* at 581.

256. See *id.* at 580.

257. *Id.* at 584.

of public interest is not considered used for the purposes of trade or advertising within the prohibition of the statute.”²⁵⁸ Arguably, even *Wendt*’s counsel would concur with this basic tenet of right of publicity law. The case remains irrelevant to the question in *Wendt*.

Justice Kozinski next asks:

Can Warner Brothers [sic] exploit Rhett Butler without reminding people of Clark Gable? Can Paramount cast Shelly Long in *The Brady Bunch Movie* without creating a triable issue of fact as to whether it is treading on Florence Henderson’s right of publicity? How about *Dracula* and Bela Lugosi? Ripley and Sigmour Weaver? Kramer and Michael Richards?²⁵⁹

In a rather strange and unusual footnote, Kozinski then suggests:

To avoid going to trial in such a situation, producers will have to cast new actors who look and sound very different from the old ones. A *Seinfeld* spin-off thus ends up in a bizarro world where a skinny Newman sits down to coffee with a svelte George, a stocky Kramer, a fat Jerry and a lanky blonde Elaine. Not only is goodwill associated with the old show lost, the artistic freedom of the screenwriters and producers is severely cramped.²⁶⁰

Kozinski’s attempts to blend right of publicity and copyright are quickly resolved by a cursory reading of California Civil Code Section 3344 subsections (a) and (e). The question of Shelly Long’s portrayal of Mrs. Brady would not fall within the definition of products, merchandise, or goods for the purpose of “advertising or selling, or soliciting purchases of, products, merchandise, goods or services.”²⁶¹ As to the questions regarding Clark Gable and Bela Lugosi, the consequence of Kozinski’s scenarios would simply depend upon whether the “exploitation” fell under the rights that are “equivalent” to any of the exclusive rights within the general scope of copyright law.²⁶² If the exploitation was on or in a product or for the purpose of advertising goods and services,²⁶³ it is axiomatic that such exploitation would rest beyond preemption.

258. *Id.* at 585.

259. *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting).

260. *Id.* at 1287 n.6.

261. CAL. CIV. CODE § 3344(a); *see also Wendt*, 197 F.3d at 1286 (questioning whether Florence Henderson’s right of publicity would be violated by casting Shelly Long to portray Mrs. Brady in the *Brady Bunch* movie).

262. *See* U.S.C. § 301(a) (1994); *see also Wendt*, 197 F.3d at 1286.

263. CAL. CIV. CODE § 3344.

Continuing, Kozinski exhorts, “[u]nder the unbounded right of publicity announced in *White*, copyright holders will seldom be able to avoid trial when sued for infringement of the right of publicity.”²⁶⁴ However, *Fleet v. CBS, Inc.*,²⁶⁵ rebuts such a position.

In *Fleet*, a group of actors alleged their rights under California Civil Code section 3344 were infringed when defendant, CBS, Inc., sought to distribute a film in which the actors appeared in a video format.²⁶⁶ The court stated that federal copyright law preempted the right of publicity claims advanced by the actors because the right was not copyrightable.²⁶⁷ Moreover, the court recognized the actors could have protected their rights during the negotiation of their contracts.²⁶⁸ The Court indicated that Clint Eastwood’s likeness in a photograph, Kareem Abdul-Jabbar’s former name, Bette Midler’s original vocal style, and Vanna White’s distinct visual image added an element that made the right of publicity distinct from copyright.²⁶⁹ *Fleet* clearly contradicts Kozinski’s position, as it proposes that performers in a copyrighted film may not use their statutory right of publicity to prevent the exclusive copyright holder from distributing the film.²⁷⁰

Finally, Kozinski argued that the holding in *Wendt* directly conflicts with the *Baltimore Orioles, Inc., v. Major League Baseball Players Association*.²⁷¹ However, the facts of *Baltimore Orioles* are inapposite to an analysis of *Wendt*. In *Baltimore Orioles*, the players attempted to control the defendant’s broadcast of a baseball game by asserting a right of publicity claim.²⁷²

Similar to *Fleet*, *Baltimore Orioles* held that where the plaintiff attempts to control the defendant’s distribution and exhibition of the copyrighted work, federal copyright preempts.²⁷³ The plaintiffs in *Fleet* and *Baltimore Orioles* both tried to control the exhibition of a copyrighted work in which they agreed to appear.²⁷⁴

264. *Wendt*, 197 F.3d at 1287.

265. *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Ct. App. 1996).

266. *Id.* at 647.

267. *Id.* at 650.

268. *Id.* at 651.

269. *Id.* (citing *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983)); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996); *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988)).

270. *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 720–21 (Ct. App. 2000).

271. 805 F.2d 663 (7th Cir. 1986).

272. *Id.* at 665.

273. *Id.* at 679.

274. *Id.* at 668–69; *Fleet*, 58 Cal. Rptr. 2d at 647.

Wendt and Ratzenberger did not attempt to prevent the defendant from broadcasting *Cheers*.²⁷⁵ Certainly under California Civil Code section 3344,²⁷⁶ if Host had elected to exhibit an episode of the program in its bars across the nation, the plaintiffs' right of publicity claims would have been preempted by Paramount's copyright.²⁷⁷ However, Wendt and Ratzenberger never asserted a right of publicity claim in an effort to prevent the exhibition of the program in syndication, on airplanes, or even on video-cassette. All such rights of exhibition are undisputedly the sole property of the copyright holder.²⁷⁸

While *Wendt* wound its way through the federal courts, the question of copyright preemption was thoroughly addressed by the California state courts.²⁷⁹ In *KNB Enterprises v. Matthews*, the plaintiff copyrighted erotic photographs displayed on a web site for promotional purposes.²⁸⁰ The models in the photos had expressly transferred their rights of publicity to the plaintiff copyright holder.²⁸¹ The defendant copied and displayed the plaintiff's photographs on his web site for profit, and without the plaintiff's authorization.²⁸²

In *KNB Enterprises*, the court held federal copyright law does not preempt a plaintiff's right of publicity claim because a "human likeness is not copyrightable even if captured in a copyrighted photograph."²⁸³ To reach this conclusion, the court relied on § 301, noting that two conditions must be met for preemption to occur. First, plaintiff must demonstrate that the "subject of the claim must be a work fixed in a tangible medium of expression and come within the subject matter or scope of copyright protection as described in sections 102 and 103 of 17 United States Code."²⁸⁴ Second, the plaintiff must assert a right that is "equivalent to the exclusive rights contained in section 106."²⁸⁵

The court in *KNB Enterprises* found further guidance from an action by actor Dustin Hoffman against Capital Cities/ABC.²⁸⁶ Hoffman sued under California Civil Code section 3344 after *Los Angeles Magazine*

275. *Wendt*, 125 F.3d at 811.

276. CAL. CIV. CODE § 3344 (West 1997).

277. *Wendt*, 125 F.3d 806.

278. 17 U.S.C. § 106 (1994).

279. *KNB Enters.*, 92 Cal. Rptr. 2d 713.

280. *Id.* at 716.

281. *Id.*

282. *Id.*

283. *Id.* at 715.

284. *Id.* at 718.

285. *KNB Enters.*, 92 Cal. Rptr. 2d at 718.

286. *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (C.D. Cal. 1999).

digitally altered a photograph of the actor from the movie *Tootsie* without his permission.²⁸⁷ The altered photo featured Hoffman's face and the American flag background from the original photo.²⁸⁸ Instead of the long red dress featured in the original, a male model's body in a butter-colored silk gown designed by Richard Tyler and high-heel shoes designed by Ralph Lauren were inserted.²⁸⁹

In response to Capital Cities' preemption argument, the court recognized that Hoffman's name, face, and persona were not writings or works of authorship that come within the subject matter of copyright.²⁹⁰ Thus, his claim failed the first prong of the test under section 301 of the Copyright Act.²⁹¹ Moreover, the district court agreed with Hoffman that his right to protect the use of his own name and likeness was separate from the copyrighted interest of Columbia, the copyright holder in the film.²⁹²

This position is not entirely new. Copyright scholar Melville B. Nimmer has said a persona is not a "writing" of an "author" within the meaning of the copyright clause.²⁹³ Moreover, Nimmer directs that a name and likeness do not become a work of authorship simply because they are embodied in a copyrightable work such as a photograph.²⁹⁴ Furthermore, the rulings in *Midler*, *White*, and *Waits* supported the proposition that the right of publicity is not preempted by copyright.²⁹⁵

The overwhelming support for the proposition that copyright does not preempt the right of publicity is undeniable. Yet, the entertainment industry made a valiant attempt to find a court that would rule otherwise. Such tenacity raises serious concerns for celebrities regarding the current status of their rights. Celebrities must now look ahead and anticipate the next strategy the entertainment industry will employ to wrest all control and future profit from the performer.

V. READY FOR ANOTHER TAKE

The entertainment industry will continue to develop methods of controlling the intellectual property rights associated with their projects.

287. *Id.* at 869–70.

288. *Id.* at 870.

289. *Id.*

290. *Id.* at 871.

291. *Id.*

292. *Hoffman*, 33 F. Supp. 2d at 875.

293. NIMMER & NIMMER, *supra* note 109, § 1.01 [B][1][c].

294. *Id.*

295. *Midler*, 849 F.2d 460; *White*, 971 F.2d 1395; *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

Such efforts will likely target new technologies that offer heretofore undreamed of forms of exhibition. With that in mind, the artist should not be surprised at the entertainment industry's attempts to pass legislation that limit the rights of performers.

A. Technology

As the Internet increasingly becomes the source of entertainment, it will not be long before all television programs, films, and music will arrive in our homes via on-line technology. There is little doubt the entertainment industry has already looked to the language of standard form contracts in an effort to secure their position in this area.²⁹⁶

For example, Bertelsmann Music Group ("BMG") has entered into a partnership with previous arch rival, Napster, taking us one-step closer to all music arriving in the form of a file rather than a CD.²⁹⁷ Such a change in format raises the question of container deductions.²⁹⁸ If packaging no longer exists, it is possible the cost of the computer program development and required hardware will become a deductible expense under the same language.

Moreover, when streaming technology²⁹⁹ advances to the level of sophistication whereby entire films are downloaded on a personal computer, there is little doubt such technology will be addressed by the "future methods" clauses in existence.³⁰⁰ Arguably, this transmission is not "television" as defined by the 1960 SAG settlement.³⁰¹ Therefore, it could be posited that all pre-1960 films are no longer governed by the Reagan/Wasserman settlement.

Moreover, when today's artist participates in a film, often the studio is able to deduct enormous costs of goods related to the production of videotapes and DVDs. Similar to the container deductions taken by the record companies, the language in today's contracts already contemplates

296. Neil Spencer, *Review: The Year in the Arts: Pop 2000: Go On, Take the Money and Hum; Vacuous Hits Ruled the Charts, But There Was Fine Music On the Margins*, THE OBSERVER, Dec. 24, 2000, at 9.

297. *Id.*

298. The packaging of product is considered a customary deduction prior to the calculation of royalties to be paid the artist. DONALD S. PASSMAN, ALL YOU NEED TO KNOW ABOUT THE MUSIC BUSINESS 173 (1997).

299. Sara Steetle, UMG Recordings, Inc. v. MP3.com, Inc.: *Signaling the Need for a Deeper Analysis of Copyright Infringement of Digital Recordings*, 21 LOY. L.A. ENT. L. REV. 31, 35-36 (2000) (defining "streaming technology").

300. Frederick M. Muir, *Movie Artists May Cash in on Videotapes*, L.A. TIMES, Apr. 28, 1988, at 1.

301. See *supra* Part II.A.1.

such deductions if interpreted broadly. As such, the vast cost of technological development could be passed on to the artist through the use of creative accounting and, once again, the visionaries' language.

B. Legislation

Celebrities and their representatives must also remain ever vigilant with respect to new legislation. Recent actions to amend the Copyright Act would have proved disastrous for composers and their heirs.³⁰² Shockingly, such legislation almost became law.

Recently, language was inserted into the Satellite Home Viewer Improvement Act of 1999 which would have rendered all recorded music work-for-hire.³⁰³ In other words, all music recorded for a record label would become the property of the label rather than the creator. This blatant attempt to steal the intellectual property rights from the artist was authored by a Congressional aide named Mitch Glazier and was supported by the RIAA.³⁰⁴

The results of such legislation would have been devastating to the artist. However, it is conceivable that a similar attempt to legislate away the rights of creative individuals will someday find success.

VI. CONCLUSION

For over seventy years, the entertainment industry has made every effort to retain all intellectual property rights associated with their products. Sadly, these efforts are usually at the expense of the artists who created the product itself. Based on this pattern of activity, artists must continue to rebel every time they find themselves lured toward a place where everybody else owns their name.

302. 17 U.S.C. § 119 (1994 & Supp. IV 1999).

303. *Id.*

304. *See News*, available at <http://www.riaa.com/PR> (Feb. 10, 2000). Mr. Glazier has joined RIAA as Senior Vice President of Government Relations and Legislative Counsel. *Id.*

