

## Rights in People

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## Personality Rights

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One body of intellectual property law – the right of publicity – squarely protects people’s names, appearances, and other aspects of their personal identities. The policies underlying the right of publicity overlap substantially with those of copyright, trademark, and false advertising. It is helpful, therefore, to compare how these other bodies of law deal with personal identity. In addition, the law of naming and name changes sheds light both on right of publicity and trademark, and the tort law of defamation also bears on the issues.

### A Right of Publicity

Two closely related theories of the right of publicity should be familiar. One is that it facilitates contracting over a type of information – people’s fame, talent, and ability to make endorsements – that has significant commercial value. The other is that it incentivizes the creation of these valuable personas in the first place. But the right of publicity is also closely linked to privacy. Historically, it grew out of privacy torts, and it helps to protect people’s interest in not being involuntarily exposed to the public eye.

The leading treatise on the right of publicity is J. Thomas McCarthy, *The Rights of Publicity & Privacy, McCarthy on Publicity*. Another valuable resource is the website Rothman's Roadmap to the Right of Publicity, which includes state-by-state information on statutes and caselaw.

**Eric E. Johnson, *Disentangling the Right of Publicity***  
111 Nw. U. L. Rev. 891 (2017)

According to blackletter law, the right of publicity provides persons with a cause of action against anyone who makes a commercial use of their name, image, likeness, or other indicia of identity. This account, with slight variations in language, is recited by countless courts, but a moment’s reflection demonstrates that it is not true.

Imagine what would happen if people really could recover just because their names are being exploited commercially. Every credit reporting agency would shutter instantly. Every celebrity gossip magazine would be drowned in liability. And every company that sells customer lists to direct mailers and telemarketers would have to

run for the hills. The right of publicity, by its own blackletter terms, should stop all these commercial uses of identity. Yet it does not. One thing is certain: the right of publicity is not what it says it is.

Unlike most legal doctrines, the right of publicity is currently defined negatively. That is, the law lacks a good positive description of what the right of publicity *is*. Instead, the cases are constantly working on the question of what the right of publicity *is not*. Much of the theoretical and practical trouble with the right of publicity can be traced to this doctrinal inversion.

The scope of the right of publicity is mostly defined extra-doctrinally. That is, instead of being self-limiting, the right of publicity, by its own letter, expands far beyond its permissible scope. It is up to other doctrines from other fields – notably the First Amendment and preemption by federal copyright law – to lop off the right of publicity’s doctrinal excess and force it back within intuitive limits.

What courts and commentators have been calling “the right of publicity” is really multiple rights: the endorsement right, the merchandizing entitlement, and the right against virtual impressment. The *endorsement right* is the right to not be featured in advertising in a way that implies an endorsement of a commercial enterprise – featuring a celebrity wearing a brand of shoes in an ad for those shoes would infringe. The *merchandizing entitlement* provides a right to not have one’s name, image, or identity marketed on coffee mugs, lunch boxes, or other merchandise. And the *right against virtual impressment* – which can be perceived only in a limited number of jurisdictions – protects one’s image and identity from being employed, marionette-like, as a virtual actor in a film or video game.

## 1 Ownership

Who has publicity rights? Conceptually, the answer depends on the reason(s) to recognize them. If publicity rights are privacy rights, then arguably ordinary citizens have them but celebrities who have voluntarily stepped out upon the public stage don’t. But if publicity rights are property rights, then arguably celebrities have them but ordinary citizens who have done nothing to monetize their identities don’t. The history of the rise of the right of publicity in the twentieth century shows courts wrestling with both kinds of theories.

### a Privacy Theories

The different paths taken by New York (after *Roberson*) and Georgia (in *Pavesich*) illustrate the two typical routes to the right of publicity in the states that recognize it: by statute and by common law, respectively. (Some states, like California, have both.) *Pavesich* hints and

*O'Brien* confirms that a privacy-focused rationale doesn't work for celebrities.

**Roberson v. Rochester Folding Box Co.**  
64 N.E. 442 (N.Y. 1902)

The complaint alleges that the Franklin Mills Company, one of the defendants, was engaged in a general milling business and in the manufacture and sale of flour; that before the commencement of the action, without the knowledge or consent of plaintiff, defendants, knowing that they had no right or authority so to do, had obtained, made, printed, sold, and circulated about 25,000 lithographic prints, photographs, and likenesses of plaintiff, made in a manner particularly set up in the complaint; that upon the paper upon which the likenesses were printed and above the portrait there were printed, in large, plain letters, the words, 'Flour of the Family,' and below the portrait, in large capital letters, 'Franklin Mills Flour,' and in the lower right-hand corner, in smaller capital letters, 'Rochester Folding Box Co., Rochester, N. Y.'; that upon the same sheet were other advertisements of the flour of the Franklin Mills Company; that those 25,000 likenesses of the plaintiff thus ornamented have been conspicuously posted and displayed in stores, warehouses, saloons, and other public places; that they have been recognized by friends of the plaintiff and other people, with the result that plaintiff has been greatly humiliated by the scoffs and jeers of persons who have recognized her face and picture on this advertisement, and her good name has been attacked, causing her great distress and suffering, both in body and mind; that she was made sick, and suffered a severe nervous shock, was confined to her bed, and compelled to employ a physician, because of these facts; that defendants had continued to print, make, use, sell, and circulate the said lithographs, and that by reason of the foregoing facts plaintiff had suffered damages in the sum of \$15,000. The complaint prays that defendants be enjoined from making, printing, publishing, circulating, or using in any manner any likenesses of plaintiff in any form whatever; for further relief (which it is not necessary to consider here); and for damages.

It will be observed that there is no complaint made that plaintiff was libeled by this publication of her portrait. The likeness is said to be a very good one, and one that her friends and acquaintances were able to recognize. Indeed, her grievance is that a good portrait of her, and therefore one easily recognized, has been used to attract attention toward the paper upon which defendant mill company's advertisements appear. Such publicity, which some find agreeable, is to plaintiff very distasteful, and thus, because of defendants' impertinence in using her picture, without her consent, for their own business purposes, she has been caused to suffer mental distress where



Flour of the Family advertisement

others would have appreciated the compliment to their beauty implied in the selection of the picture for such purposes; but, as it is distasteful to her, she seeks the aid of the courts to enjoin a further circulation of the lithographic prints containing her portrait made as alleged in the complaint, and, as an incident thereto, to reimburse her for the damages to her feelings, which the complaint fixes at the sum of \$15,000. There is no precedent for such an action to be found in the decisions of this court.

Nevertheless the Appellate Division reached the conclusion that plaintiff had a good cause of action against defendants, in that defendants had invaded what is called a 'right of privacy'; in other words, the right to be let alone. Mention of such a right is not to be found in Blackstone, Kent, or any other of the great commentators upon the law; nor, so far as the learning of counsel or the courts in this case have been able to discover, does its existence seem to have been asserted prior to about the year 1890, when it was presented with attractiveness, and no inconsiderable ability, in the Harvard Law Review in an article entitled 'Rights of a Citizen to His Reputation.' The so-called 'right of privacy' is, as the phrase suggests, founded upon the claim that a man has the right to pass through this world, if he wills, without having his picture published, his business enterprises discussed, his successful experiments written up for the benefit of others, or his eccentricities commented upon either in handbills, circulars, catalogues, periodicals, or newspapers; and, necessarily, that the things which may not be written and published of him must not be spoken of him by his neighbors, whether the comment be favorable or otherwise. While most persons would much prefer to have a good likeness of themselves appear in a responsible periodical or leading newspaper rather than upon an advertising card or sheet, the doctrine which the courts are asked to create for this case would apply as well to the one publication as to the other, for the principle which a court of equity is asked to assert in support of a recovery in this action is that the right of privacy exists and is enforceable in equity, and that the publication of that which purports to be a portrait of another person, even if obtained upon the street by an impertinent individual with a camera, will be restrained in equity on the ground that an individual has the right to prevent his features from becoming known to those outside of his circle of friends and acquaintances. If such a principle be incorporated into the body of the law through the instrumentality of a court of equity, the attempts to logically apply the principle will necessarily result not only in a vast amount of litigation, but in litigation bordering upon the absurd, for the right of privacy, once established as a legal doctrine, cannot be confined to the restraint of the publication of a likeness, but must necessarily embrace as well the publication of a word picture, a comment upon

Samuel D. Warren & Louis D. Brandeis,  
*The Right to Privacy*, 4 Harv. L. Rev. 193  
(1890).



one's looks, conduct, domestic relations or habits. And, were the right of privacy once legally asserted, it would necessarily be held to include the same things if spoken instead of printed, for one, as well as the other, invades the right to be absolutely let alone. An insult would certainly be in violation of such a right, and with many persons would more seriously wound the feelings than would the publication of their picture. And so we might add to the list of things that are spoken and done day by day which seriously offend the sensibilities of good people to which the principle which the plaintiff seeks to have imbedded in the doctrine of the law would seem to apply. I have gone only far enough to barely suggest the vast field of litigation which would necessarily be opened up should this court hold that privacy exists as a legal right enforceable in equity by injunction, and by damages where they seem necessary to give complete relief.

An examination of the authorities leads us to the conclusion that the so-called 'right of privacy' has not as yet found an abiding place in our jurisprudence, and, as we view it, the doctrine cannot now be incorporated without doing violence to settled principles of law by which the profession and the public have long been guided. I do not say that, even under the existing law, in every case of the character of the one before us, or, indeed, in this case, a party whose likeness is circulated against his will is without remedy. By section 242 of the Penal Code any malicious publication by picture, effigy, or sign, which exposes a person to contempt, ridicule, or obloquy, is a libel, and it would constitute such at common law. There are many articles, especially of medicine, whose character is such that using the picture of a person, particularly that of a woman, in connection with the advertisement of those articles, might justly be found by a jury to cast ridicule or obloquy on the person whose picture was thus published. The manner or posture in which the person is portrayed might readily have a like effect. In such cases both a civil action and a criminal prosecution could be maintained. But there is no allegation in the complaint before us that this was the tendency of the publication complained of, and the absence of such an allegation is fatal to the maintenance of the action, treating it as one of libel.

### **New York Civil Rights Law**

Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait, picture or voice, to prevent and restrain the use thereof; and may also sue and recover

§ 51

*Action for injunction and for damages*

damages for any injuries sustained by reason of such use.

### **Pavesich v. New England Life Ins. Co.**

50 S.E. 68 (Ga. 1905)

Paolo Pavesich brought an action against the New England Mutual Life Insurance Company, a nonresident corporation, Thomas B. Lumpkin, its general agent, and J. Q. Adams, a photographer, both residing in the city of Atlanta. The allegations of the petition were, in substance, as follows: In an issue of the Atlanta Constitution, a newspaper published in the city of Atlanta, there appeared a likeness of the plaintiff, which would be easily recognized by his friends and acquaintances, placed by the side of the likeness of an ill-dressed and sickly looking person. Above the likeness of the plaintiff were the words: "Do it now. The man who did." Above the likeness of the other person were the words: "Do it while you can. The man who didn't." Below the two pictures were the words: "These two pictures tell their own story." Under the plaintiff's picture the following appeared: "In my healthy and productive period of life I bought insurance in the New England Mutual Life Insurance Co., of Boston, Mass., and to-day my family is protected and I am drawing an annual dividend on my paid-up policies." Under the other person's picture was a statement to the effect that he had not taken insurance, and now realized his mistake. The statements were signed, "Thomas B. Lumpkin, General Agent." The picture of the plaintiff was taken from a negative obtained by the defendant Lumpkin, or some one by him authorized, from the defendant Adams, which was used with his consent, and with knowledge of the purpose for which it was to be used. The picture was made from the negative without the plaintiff's consent, at the instance of the defendant insurance company, through its agent, Lumpkin. Plaintiff is an artist by profession, and the publication is peculiarly offensive to him. He never made any such statement, and has not, and never has had, a policy of life insurance with the defendant company. The publication is malicious, and tends to bring plaintiff into ridicule before the world, and especially with his friends and acquaintances, who know that he has no policy in the defendant company.

The right of privacy has its foundation in the instincts of nature. It is recognized intuitively, consciousness being the witness that can be called to establish its existence. Any person whose intellect is in a normal condition recognizes at once that as to each individual member of society there are matters private, and there are matters public so far as the individual is concerned. Each individual as instinctively resents any encroachment by the public upon his rights which are of a private nature as he does the withdrawal of those of his rights which are of a public nature. A right of privacy in matters purely private is



New England Mutual Life Insurance ad

therefore derived from natural law.

All will admit that the individual who desires to live a life of seclusion cannot be compelled, against his consent, to exhibit his person in any public place, unless such exhibition is demanded by the law of the land. He may be required to come from his place of seclusion to perform public duties – to serve as a juror and to testify as a witness, and the like; but, when the public duty is once performed, if he exercises his liberty to go again into seclusion, no one can deny him the right. One who desires to live a life of partial seclusion has a right to choose the times, places, and manner in which and at which he will submit himself to the public gaze. Subject to the limitation above referred to, the body of a person cannot be put on exhibition at any time or at any place without his consent. The right of one to exhibit himself to the public at all proper times, in all proper places, and in a proper manner is embraced within the right of personal liberty. The right to withdraw from the public gaze at such times as a person may see fit, when his presence in public is not demanded by any rule of law, is also embraced within the right of personal liberty. Publicity in one instance, and privacy in the other, are each guaranteed.

The right of privacy, however, like every other right that rests in the individual, may be waived. This waiver may be either express or implied, but the existence of the waiver carries with it the right to an invasion of privacy only to such an extent as may be legitimately necessary and proper in dealing with the matter which has brought about the waiver. It may be waived for one purpose, and still asserted for another; it may be waived in behalf of one class, and retained as against another class; it may be waived as to one individual, and retained as against all other persons. The most striking illustration of a waiver is where one either seeks or allows himself to be presented as a candidate for public office. He thereby waives any right to restrain or impede the public in any proper investigation into the conduct of his private life which may throw light upon his qualifications for the office, or the advisability of imposing upon him the public trust which the office carries. But even in this case the waiver does not extend into those matters and transactions of private life which are wholly foreign, and can throw no light whatever upon the question as to his competency for the office, or the propriety of bestowing it upon him.

Cases may arise where it is difficult to determine on which side of the line of demarkation which separates the right of privacy from the well-established rights of others they are to be found; but we have little difficulty in arriving at the conclusion that the present case is one in which it has been established that the right of privacy has been invaded, and invaded by one who cannot claim exemption under the constitutional guaranties of freedom of speech and of the press.

The form and features of the plaintiff are his own. The defendant insurance company and its agent had no more authority to display them in public for the purpose of advertising the business in which they were engaged than they would have had to compel the plaintiff to place himself upon exhibition for this purpose. Nothing appears from which it is to be inferred that the plaintiff has waived his right to determine himself where his picture should be displayed in favor of the advertising right of the defendants. The mere fact that he is an artist does not of itself establish a waiver of this right, so that his picture might be used for advertising purposes. If he displayed in public his works as an artist, he would, of course, subject his works and his character as an artist, and possibly his character and conduct as a man, to such scrutiny and criticism as would be legitimate and proper to determine whether he was entitled to rank as an artist, and should be accorded recognition as such by the public. But it is by no means clear that even this would have authorized the publication of his picture. The constitutional right to speak and print does not necessarily carry with it the right to reproduce the form and features of man. The plaintiff was in no sense a public character, even if a different rule in regard to the publication of one's picture should be applied to such characters.

It is now to be determined whether first count in the petition set forth a cause of action for libel. The publication did not mention the plaintiff's name, but it did contain a likeness of him that his friends and acquaintances would readily recognize as his, and the words of the publication printed under the likeness were put into the mouth of him whose likeness was published. These words are harmless in themselves. Standing alone, they contain nothing, and carry no inference of anything that is disgraceful, to be ashamed of, or calculated to bring one into reproach.

It is alleged that the plaintiff did not have, and never had had, a policy of insurance with the defendant company, and that this fact was known to his friends and acquaintances. In the light of these allegations, the words attributed to the plaintiff become absolutely false, and those who are acquainted with the facts, upon reading the statement, would naturally ask, "For what purpose was this falsehood written?" It was either gratuitous, or it was for a consideration; and, whichever conclusion might be reached, the person to whom the words were attributed would become contemptible in the mind of the reader. He would become at once a self-confessed liar. If he lied gratuitously, he would receive and merit the contempt of all persons having a correct conception of moral principles. If he lied for a consideration, he would become odious to every decent individual. It seems clear to us that a jury could find from the facts alleged that the publication, in the light of the extrinsic facts, was libelous, and

the plaintiff was entitled to have this question submitted to the jury.

**O'Brien v. Pabst Sales Co.**  
124 F.2d 167 (5th Cir. 1941)

Plaintiff, in physique as in prowess as a hurler, a modern David, is a famous football player. Defendant, in bulk, if not in brass and vulnerability, a modern Goliath, is a distributor of Pabst beer. Plaintiff, among other honors received during the year 1938, was picked by Grantland Rice on his Collier's All American Football Team. Defendant, as a part of its advertising publicity for 1939, following its custom of getting out football schedule calendars, placed an order with the Inland Lithographing Company, to prepare for and furnish to it, 35,000 Pabst 1939 football calendars. The calendars were to carry complete schedules of all major college games; professional schedules; and pictures of Grantland Rice's 1938 All American Football Team, the Inland Company to furnish photographs and necessary releases.

At the top of the calendar, as thus printed and circulated, were the words "Pabst Blue Ribbon." Directly underneath were the words "Football Calendar, 1939"; to the left of these words was a photograph of O'Brien in football uniform characteristically poised for the throw; to the right of them was a glass having on it the words "Pabst Breweries, Blue Ribbon Export Beer"; and to the right of the glass still, a bottle of beer, having on it "Pabst Blue Ribbon Beer." Directly below these was the intercollegiate football schedule for 1939, and in the center of the calendar were pictures, including that of O'Brien, of Grantland Rice's All American Football Team for 1938. Near the bottom was the schedule of the national football league and on the very bottom margin, were the words "Pabst Famous Blue Ribbon Beer."

Claiming that this use of his photograph as part of defendant's advertising was an invasion of his right of privacy and that he had been damaged thereby, plaintiff brought this suit.

The defenses were three. The first was that if the mere use of one's picture in truthful and respectable advertising would be an actionable invasion of privacy in the case of a private person, the use here was not, as to plaintiff, such an invasion, for as a result of his activities and prowess in football, his chosen field, and their nationwide and deliberate publicizing with his consent and in his interest, he was no longer, as to them, a private but a public person, and as to their additional publication he had no right of privacy. The second defense was that plaintiff, in his own interest and that of Texas Christian University, had posed for and had authorized the publicity department of T. C. U. to distribute his picture and biographical data to newspapers, magazines, sports journals and the public generally, and that the particular picture whose use is complained of had been in due course

obtained from and payment for it had been made to the T. C. U. publicity department. Third, no injury to appellant's person, property or reputation had been or could be shown and there was therefore no basis for a recovery. The testimony fully supported these defenses.

Assuming then, what is by no means clear, that an action for right of privacy would lie in Texas at the suit of a private person, we think it clear that the action fails; because plaintiff is not such a person and the publicity he got was only that which he had been constantly seeking and receiving; and because the use of the photograph was by permission, and there were no statements or representations made in connection with it, which were or could be either false, erroneous or damaging to plaintiff.

### b Property Theories

*Haelan* shows the courts how courts overcame the conceptual obstacles to developing a property theory of the right of publicity that works for celebrities. *Fraleley* shows how they turned it around to work for ordinary people as well.

#### Haelan Laboratories v. Topps Chewing Gum

202 F.2d 866 (1953)

The plaintiff maintains that defendant invaded plaintiff's exclusive right to use the photographs of leading baseball-players. Probably because the trial judge ruled against plaintiff's legal contentions, some of the facts were not too clearly found.

1. So far as we can now tell, there were instances of the following kind:

(a). The plaintiff, engaged in selling chewing-gum, made a contract with a ballplayer providing that plaintiff for a stated term should have the exclusive right to use the ball-player's photograph in connection with the sales of plaintiff's gum; the ball-player agreed not to grant any other gum manufacturer a similar right during such term; the contract gave plaintiff an option to extend the term for a designated period.

(b). Defendant, a rival chewing-gum manufacturer, knowing of plaintiff's contract, deliberately induced the ball-player to authorize defendant, by a contract with defendant, to use the player's photograph in connection with the sales of defendant's gum either during the original or extended term of plaintiff's contract, and defendant did so use the photograph.

Defendant argues that, even if such facts are proved, they show no actionable wrong, for this reason: The contract with plaintiff was no more than a release by the ballplayer to plaintiff of the liability which, absent the release, plaintiff would have incurred in using the ball-



Wes Westrum baseball card

player's photograph, because such a use, without his consent, would be an invasion of his right of privacy under Section 50 and Section 51 of the New York Civil Rights Law; this statutory right of privacy is personal, not assignable; therefore, plaintiff's contract vested in plaintiff no "property" right or other legal interest which defendant's conduct invaded.

Both parties agree, and so do we, that, on the facts here, New York "law" governs. And we shall assume, for the moment, that, under the New York decisions, defendant correctly asserts that any such contract between plaintiff and a ballplayer, in so far as it merely authorized plaintiff to use the player's photograph, created nothing but a release of liability. On that basis, were there no more to the contract, plaintiff would have no actionable claim against defendant. But defendant's argument neglects the fact that, in the contract, the ballplayer also promised not to give similar releases to others. If defendant, knowing of the contract, deliberately induced the ball-player to break that promise, defendant behaved tortiously.

2. The foregoing covers the situations where defendant, by itself or through its agent, induced breaches. But in those instances where [another company] induced the breach, we have a different problem; and that problem also confronts us in instances where defendant, with knowledge of plaintiff's exclusive rights, used a photograph of a ball-player without his consent during the term of his contract with plaintiff.

With regard to such situations, we must consider defendant's contention that none of plaintiff's contracts created more than a release of liability, because a man has no legal interest in the publication of his picture other than his right of privacy, i. e., a personal and non-assignable right not to have his feelings hurt by such a publication.

A majority of this court rejects this contention. We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i. e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i. e., without an accompanying transfer of a business or of anything else. Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolizes the fact that courts enforce a claim which has pecuniary worth.

This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ballplayers), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no

In 1984, the New York Court of Appeals disagreed. "Since the 'right of publicity' is encompassed under the Civil Rights Law as an aspect of the right of privacy, which is exclusively statutory in this State, the plaintiff cannot claim an independent common-law right of publicity." *Stephano*

money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

We think the New York decisions recognize such a right.

Plaintiff, in its capacity as exclusive grantee of a player's "right of publicity," has a valid claim against defendant if defendant used that player's photograph during the term of plaintiff's grant and with knowledge of it. It is no defense to such a claim that defendant is the assignee of a subsequent contract. For the prior grant to plaintiff renders that subsequent grant invalid during the period of the grant to plaintiff.

**Joseph R. Grodin, Note: *The Right of Publicity: A Doctrinal Innovation***  
62 Yale L.J. 1123 (1953)

*Haelan's* right of publicity probably gives a famous person more than the right to assign a protectible interest in his name or picture. By allowing an individual to make a grant of the publicity value of his name or photograph, the *Haelan* case gave protection to persons' commercial interest in their personality independent of their privacy interest. In so doing, *Haelan* implied that such commercial interest, aside from any privacy interest, might justify legal protection of an individual against unauthorized use of his name or picture. While a famous person can generally invoke the right of privacy against an advertiser who appropriates his name or picture without permission, this right may not always afford adequate protection to his commercial interest in his personality. Celebrities complaining of the unauthorized use of their names or likenesses have sometimes been held, in effect, to have waived their right of privacy because they sought and received publicity in the past. And where relief has been granted under the privacy doctrine it is not clear whether plaintiffs have recovered damages for injury to the commercial interest in their popularity. But if the publicity value of a famous person's name or picture is to be shielded without reference to the right of privacy, these celebrities will be fully protected: prior publicity will enhance rather than bar relief. They will be able to obtain an injunction or recover damages commensurate with the advertising value of their names or pictures.

And the right of publicity may be extended beyond advertising cases. A famous person may wish to prevent appropriation of the public appeal of his personality by a telecast reproduction of his performance, a biography, or by use of his photograph for illustrating newspapers or magazines. Here, as in the advertising situation, the right of privacy has sometimes been considered waived because of plaintiff's past exposure in the public limelight, but this would not be a ground for denying relief under the right of publicity. And, where courts have sometimes held that plaintiff's privacy interest was out-



weighed by the public's interest in news or information, the balance may now swing in plaintiff's favor if both his privacy and publicity interests are considered.

In applying the right of privacy, courts have confused commercial interests with privacy interests. The result of making one doctrine do the work of two has been inadequate protection for both these interests in personality. The right of privacy gives inadequate protection to the commercial interest in one's personality because courts have placed upon the right limitations which are appropriate only to the privacy interest. Similarly, in some states the right of privacy gives inadequate protection even to the privacy interest because courts and legislatures have implied that commercial benefit to the defendant is an element of the cause of action. If courts wish to protect both interests to at least some extent, they should do so under separate doctrines, so that limitations appropriate to each interest may be imposed. The *Haelan* case takes a long step in this direction.

**Fraley v. Facebook, Inc.**

830 F.Supp.2d 785 (N.D. Cal. 2011)

At issue here is one of Facebook's advertising practices, "Sponsored Stories," which appear on a member's Facebook page, and which typically consist of another member's name, profile picture, and an assertion that the person "likes" the advertiser, coupled with the advertiser's logo. Sponsored Stories are generated when a member interacts with the Facebook website or affiliated sites in certain ways, such as by clicking on the "Like" button on a company's Facebook page.

In this putative class action, plaintiffs allege that Facebook's Sponsored Stories violate California's Right of Publicity Statute, California's Unfair Competition Law, and the common law doctrine of unjust enrichment.

Here, Plaintiffs allege not that they suffered mental anguish as a result of Defendant's actions, but rather that they suffered economic injury because they were not compensated for Facebook's commercial use of their names and likenesses in targeted advertisements to their Facebook Friends. Defendant does not deny that Plaintiffs may assert economic injury, but insists that, because they are not celebrities, they must demonstrate some preexisting commercial value to their names and likenesses, such as allegations that they previously received remuneration for the use of their name or likeness, or that they have ever sought to obtain such remuneration.

First, the Court finds nothing in the text of the statute or in case law that supports Defendant's interpretation of § 3344 as requiring a plaintiff pleading economic injury to provide proof of preexisting commercial value and efforts to capitalize on such value in order to survive a motion to dismiss. In cases involving celebrity plaintiffs,

Cal. Civ. Code § 3344

Cal. Bus. Prof. Code § 17200,  
which grants broader consumer standing than Lanham Act § 43(a)

the mere allegation that the plaintiff was not compensated has been deemed sufficient to satisfy the injury prong. Nor does the Court find any reason to impose a higher pleading standard on non-celebrities than on celebrities. California courts have clearly held that the statutory right of publicity exists for celebrity and non-celebrity plaintiffs alike.

Although generally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered, the appropriation of the identity of a relatively unknown person may result in economic injury or may itself create economic value in what was previously valueless. Thus, courts have long recognized that a person's name, likeness, or other attribute of identity can have commercial value, even if the individual is relatively obscure. In *Downing v. Abercrombie & Fitch*, the Ninth Circuit sustained the § 3344 claim of a surfer alleging that a clothing retailer had unlawfully used a photograph of him surfing for advertising purposes. As explained by the California appellate court, Although the unauthorized appropriation of an obscure plaintiff's name, voice, signature, photograph, or likeness would not inflict as great an economic injury as would be suffered by a celebrity plaintiff, California's appropriation statute is not limited to celebrity plaintiffs.

*Downing*: 265 F.3d 994 (9th Cir. 2001)

Admittedly, these previous non-celebrity plaintiffs have typically been models, entertainers, or other professionals who have cultivated some commercially exploitable value through their own endeavors. Nevertheless, the Court finds nothing requiring that a plaintiff's commercially exploitable value be a result of his own talents or efforts in order to state a claim for damages under § 3344. In a society dominated by reality television shows, YouTube, Twitter, and online social networking sites, the distinction between a "celebrity" and a "non-celebrity" seems to be an increasingly arbitrary one.

Moreover, even if non-celebrities are subject to a heightened pleading standard under § 3344, the Court finds that Plaintiffs' allegations satisfy the requirements for pleading a claim of economic injury under § 3344. Plaintiffs quote Facebook CEO Mark Zuckerberg stating that "nothing influences people more than a recommendation from a trusted friend. A trusted referral influences people more than the best broadcast message. A trusted referral is the Holy Grail of advertising."

Thus, Plaintiffs have alleged that, in the same way that celebrities enjoy commercially exploitable opportunities among consumers at large, they enjoy commercially exploitable opportunities to advertise among their immediate friends and associates because in essence, Plaintiffs are celebrities – to their friends. While traditionally, advertisers had little incentive to exploit a non-celebrity's likeness because such endorsement would carry little weight in the economy at large,

Plaintiffs' allegations suggest that advertisers' ability to conduct targeted marketing has now made friend endorsements a valuable marketing tool, just as celebrity endorsements have always been so considered.

## 2 Subject Matter

Typically the right of publicity covers at least one's name and likeness. How much further it extends is more controversial.

### **Midler v. Ford Motor Co.** 849 F.2d 460 (2d Cir. 1988)

This case centers on the protectibility of the voice of a celebrated chanteuse from commercial exploitation without her consent. Ford Motor Company and its advertising agency, Young & Rubicam, Inc., in 1985 advertised the Ford Lincoln Mercury with a series of nineteen 30 or 60 second television commercials in what the agency called "The Yuppie Campaign." The aim was to make an emotional connection with Yuppies, bringing back memories of when they were in college. Different popular songs of the seventies were sung on each commercial. The agency tried to get "the original people," that is, the singers who had popularized the songs, to sing them. Failing in that endeavor in ten cases the agency had the songs sung by "sound alike." Bette Midler, the plaintiff and appellant here, was done by a sound alike.

Midler is a nationally known actress and singer. She won a Grammy as early as 1973 as the Best New Artist of that year. Records made by her since then have gone Platinum and Gold. She was nominated in 1979 for an Academy award for Best Female Actress in *The Rose*, in which she portrayed a pop singer. Newsweek in its June 30, 1986 issue described her as an "outrageously original singer/comedian." Time hailed her in its March 2, 1987 issue as "a legend" and "the most dynamic and poignant singer-actress of her time."

When Young & Rubicam was preparing the Yuppie Campaign it presented the commercial to its client by playing an edited version of Midler singing "Do You Want To Dance," taken from the 1973 Midler album, "The Divine Miss M." After the client accepted the idea and form of the commercial, the agency contacted Midler's manager, Jerry Edelstein. The conversation went as follows: "Hello, I am Craig Hazen from Young and Rubicam. I am calling you to find out if Bette Midler would be interested in doing ...? Edelstein: "Is it a commercial?" "Yes." "We are not interested."

Undeterred, Young & Rubicam sought out Ula Hedwig whom it knew to have been one of "the Harlettes" a backup singer for Mi-

bler for ten years. Hedwig was told by Young & Rubicam that “they wanted someone who could sound like Bette Midler’s recording of [Do You Want To Dance].” She was asked to make a “demo” tape of the song if she was interested. She made an a capella demo and got the job.

At the direction of Young & Rubicam, Hedwig then made a record for the commercial. The Midler record of “Do You Want To Dance” was first played to her. She was told to “sound as much as possible like the Bette Midler record,” leaving out only a few “aahs” unsuitable for the commercial. Hedwig imitated Midler to the best of her ability.

After the commercial was aired Midler was told by “a number of people” that it “sounded exactly” like her record of “Do You Want To Dance.” Hedwig was told by “many personal friends” that they thought it was Midler singing the commercial. Ken Fritz, a personal manager in the entertainment business not associated with Midler, declares by affidavit that he heard the commercial on more than one occasion and thought Midler was doing the singing.

Neither the name nor the picture of Midler was used in the commercial; Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler’s voice. The district court described the defendants’ conduct as that “of the average thief.” They decided, “If we can’t buy it, we’ll take it.” The court nonetheless believed there was no legal principle preventing imitation of Midler’s voice and so gave summary judgment for the defendants. Midler appeals.

Nancy Sinatra once sued Goodyear Tire and Rubber Company on the basis of an advertising campaign by Young & Rubicam featuring “These Boots Are Made For Walkin’,” a song closely identified with her; the female singers of the commercial were alleged to have imitated her voice and style and to have dressed and looked like her. The basis of Nancy Sinatra’s complaint was unfair competition; she claimed that the song and the arrangement had acquired a secondary meaning which, under California law, was protectible. This court noted that the defendants “had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements.” To give Sinatra damages for their use of the song would clash with federal copyright law. Summary judgment for the defendants was affirmed. *Sinatra v. Goodyear Tire & Rubber Co.* If Midler were claiming a secondary meaning to “Do You Want To Dance” or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford’s use of “Do You Want To Dance,” and thus her claim is not preempted by federal copyright law. Copyright protects original works of authorship fixed in any tangible medium of

Why couldn't Midler sue for copyright infringement for imitating her recorded version?

If these two cases are indication, Young & Rubicam seems to have had a steady line of business making commercials with sound-alikes of famous female singers.

*Sinatra*: 435 F.2d 711 (9th Cir. 1970)

expression. A voice is not copyrightable. The sounds are not fixed. What is put forward as protectible here is more personal than any work of authorship.

Bert Lahr once sued Adell Chemical Co. for selling Lestoil by means of a commercial in which an imitation of Lahr's voice accompanied a cartoon of a duck. Lahr alleged that his style of vocal delivery was distinctive in pitch, accent, inflection, and sounds. The First Circuit held that Lahr had stated a cause of action for unfair competition, that it could be found "that defendant's conduct saturated plaintiff's audience, curtailing his market." *Lahr v. Adell Chemical Co.* That case is more like this one. But we do not find unfair competition here. One-minute commercials of the sort the defendants put on would not have saturated Midler's audience and curtailed her market. Midler did not do television commercials. The defendants were not in competition with her.

*Lahr*: 300 F.2d 256 (1st Cir. 1962)

California Civil Code section 3344 is also of no aid to Midler. The statute affords damages to a person injured by another who uses the person's "name, voice, signature, photograph or likeness, in any manner." The defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was Hedwig's, not hers. The term "likeness" refers to a visual image not a vocal imitation. The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law.

The companion statute protecting the use of a deceased person's name, voice, signature, photograph or likeness states that the rights it recognizes are "property rights." By analogy the common law rights are also property rights. Appropriation of such common law rights is a tort in California. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, what the defendants used in their television commercial for Winston cigarettes was a photograph of a famous professional racing driver's racing car. The number of the car was changed and a wing-like device known as a "spoiler" was attached to the car; the car's features of white pinpointing, an oval medallion, and solid red coloring were retained. The driver, Lothar Motschenbacher, was in the car but his features were not visible. Some persons, viewing the commercial, correctly inferred that the car was his and that he was in the car and was therefore endorsing the product. The defendants were held to have invaded a "proprietary interest" of Motschenbacher in his own identity.

Cal. Civ. Code. § 990(b)

*Motschenbacher*: 498 F.2d 821 (9th Cir. 1974)

Midler's case is different from Motschenbacher's. He and his car were physically used by the tobacco company's ad; he made part of his living out of giving commercial endorsements. But, as Judge Koelsch expressed it in *Motschenbacher*, California will recognize an injury from "an appropriation of the attributes of one's identity." It was irrelevant that Motschenbacher could not be identified in the ad.

The ad suggested that it was he. The ad did so by emphasizing signs or symbols associated with him. In the same way the defendants here used an imitation to convey the impression that Midler was singing for them.

Why did the defendants ask Midler to sing if her voice was not of value to them? Why did they studiously acquire the services of a sound-alike and instruct her to imitate Midler if Midler's voice was not of value to them? What they sought was an attribute of Midler's identity. Its value was what the market would have paid for Midler to have sung the commercial in person.

A voice is more distinctive and more personal than the automobile accouterments protected in *Motschenbacher*. A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, "the other stands before me.". A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.

D. Ihde, *Listening and Voice* 77 (1976)

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California. Midler has made a showing, sufficient to defeat summary judgment, that the defendants here for their own profit in selling their product did appropriate part of her identity.

**White v. Samsung Electronics America, Inc.**  
971 F.2d 1395 (9th Cir. 1992)

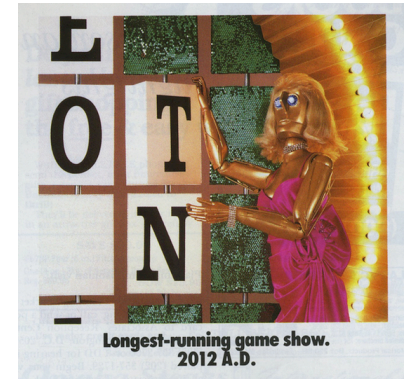
Plaintiff Vanna White is the hostess of "Wheel of Fortune," one of the most popular game shows in television history. An estimated forty million people watch the program daily. Capitalizing on the fame which her participation in the show has bestowed on her, White markets her identity to various advertisers.

The dispute in this case arose out of a series of advertisements prepared for Samsung by Deutsch. The series ran in at least half a dozen publications with widespread, and in some cases national, circulation. Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by de-

picting a raw steak with the caption: "Revealed to be health food. 2010 A.D." Another depicted irreverent "news"-show host Morton Downey Jr. in front of an American flag with the caption: "Presidential candidate. 2008 A.D."

The advertisement which prompted the current dispute was for Samsung videocassette recorders (VCRs). The ad depicted a robot, dressed in a wig, gown, and jewelry which Deutsch consciously selected to resemble White's hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: "Longest-running game show. 2012 A.D." Defendants referred to the ad as the "Vanna White" ad. Unlike the other celebrities used in the campaign, White neither consented to the ads nor was she paid.

Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under: (1) California Civil Code S 3344; (2) the California common law right of publicity; and (3) S 43(a) of the Lanham Act.



Samsung game show ad

#### I. SECTION 3344

White first argues that the district court erred in rejecting her claim under section 3344. Section 3344(a) provides, in pertinent part, that "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, ... for purposes of advertising or selling, ... without such person's prior consent ... shall be liable for any damages sustained by the person or persons injured as a result thereof."

White argues that the Samsung advertisement used her "likeness" in contravention of section 3344. In *Midler*, this court rejected Bette Midler's section 3344 claim concerning a Ford television commercial in which a Midler "sound-alike" sang a song which Midler had made famous. In rejecting Midler's claim, this court noted that "the defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was another person's, not hers. The term 'likeness' refers to a visual image not a vocal imitation."

In this case, Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White's precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a "likeness," we agree with the district court that the robot at issue here was not White's "likeness" within the meaning of section 3344. Accordingly, we affirm the court's dismissal of White's section 3344 claim.

#### II. RIGHT OF PUBLICITY

*Carson*: 698 F.2d 831 (6th Cir. 1983)

In *Carson v. Here's Johnny Portable Toilets, Inc.*, the defendant had marketed portable toilets under the brand name "Here's Johnny" – Johnny Carson's signature "Tonight Show" introduction – without Carson's permission. The sixth circuit held that the right was implicated because the defendant had appropriated Carson's identity by using the phrase "Here's Johnny."

It is not important how the defendant has appropriated the plaintiff's identity, but whether the defendant has done so. *Motschenbacher*, *Midler*, and *Carson* teach the impossibility of treating the right of publicity as guarding only against a laundry list of specific means of appropriating identity. A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.

Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. The right would fail to protect those plaintiffs most in need of its protection. Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.

Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game



show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one. Indeed, defendants themselves referred to their ad as the "Vanna White" ad. We are not surprised.

Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof. We decline Samsung and Deutch's invitation to permit the evisceration of the common law right of publicity through means as facile as those in this case. Because White has alleged facts showing that Samsung and Deutsch had appropriated her identity, the district court erred by rejecting, on summary judgment, White's common law right of publicity claim.

Alcaron, Circuit Judge, concurring in part, dissenting in part

The common theme in these federal cases is that identifying characteristics unique to the plaintiffs were used in a context in which they were the only information as to the identity of the individual. The commercial advertisements in each case showed attributes of the plaintiff's identities which made it appear that the plaintiff was the person identified in the commercial. No effort was made to dispel the impression that the plaintiffs were the source of the personal attributes at issue. The commercials affirmatively represented that the plaintiffs were involved. The proper interpretation of *Motschenbacher*, *Midler*, and *Carson* is that where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an ad, a triable issue of fact has been raised as to whether his or her identity as been appropriated.

The case before this court is distinguishable from the factual showing made in *Motschenbacher*, *Midler*, and *Carson*. It is patently clear to anyone viewing the commercial advertisement that Vanna White was not being depicted. No reasonable juror could confuse a metal robot with Vanna White.

**White v. Samsung Electronics America, Inc.**

989 F.2d 1512 (9th Cir. 1993)

Kozinski, Circuit Judge, dissenting from the order rejecting the suggestion for rehearing en banc

The majority isn't, in fact, preventing the "evisceration" of Vanna White's existing rights; it's creating a new and much broader property right, a right unknown in California law. It's replacing the existing balance between the interests of the celebrity and those of the

public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her. After all, that's all Samsung did: It used an inanimate object to remind people of White, to "evoke [her identity]."<sup>17</sup>

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It's not the robot's wig, clothes or jewelry; there must be ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White's. It's that the robot is posed near the "Wheel of Fortune" game board. Remove the game board from the ad, and no one would think of Vanna White. But once you include the game board, anybody standing beside it – a brunette woman, a man wearing women's clothes, a monkey in a wig and gown – would evoke White's image, precisely the way the robot did. It's the "Wheel of Fortune" set, not the robot's face or dress or jewelry that evokes White's image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.<sup>18</sup>

This is entirely the wrong place to strike the balance. Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have

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<sup>17</sup>Some viewers might have inferred White was endorsing the product, but that's a different story. The right of publicity isn't aimed at or limited to false endorsements; that's what the Lanham Act is for.

<sup>18</sup>Once the right of publicity is extended beyond specific physical characteristics, this will become a recurring problem: Outside name, likeness and voice, the things that most reliably remind the public of celebrities are the actions or roles they're famous for. A commercial with an astronaut setting foot on the moon would evoke the image of Neil Armstrong. Any masked man on horseback would remind people (over a certain age) of Clayton Moore. And any number of songs – "My Way," "Yellow Submarine," "Like a Virgin," "Beat It," "Michael, Row the Boat Ashore," to name only a few – instantly evoke an image of the person or group who made them famous, regardless of who is singing.

See also Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial*, L.A. Times, Jan. 18, 1990, at B3 (Adam West sues over Batmanlike character in commercial); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775, 1989 WL 407484 (C.D. Cal. 1989) (1950s TV movie hostess "Vampira" sues 1980s TV hostess "Elvira"); text accompanying notes 7-8 (lawsuits brought by Guy Lombardo, claiming big bands playing at New Year's Eve parties remind people of him, and by Uri Geller, claiming psychics who can bend metal remind people of him). Cf. *Motschenbacher*, where the claim was that viewers would think plaintiff was actually in the commercial, and not merely that the commercial reminded people of him.

made the world poorer, not richer, culturally as well as economically.

Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own.<sup>21</sup>

### 3 Procedures

There are no procedural prerequisites to owning a right of publicity, other perhaps than the vestigial suggestion (rejected in *Fraley*) that one must have commercially exploited one's likeness to sue for its appropriation. The most interesting procedural issue raised by the right of publicity is its duration.

#### Hebrew University of Jerusalem v. General Motors 903 F. Supp. 2d 932 (C.D. Cal. 2012)

##### I. INTRODUCTION

Defendant General Motors LLC ("GM") used an image of Albert Einstein in a November 2009 advertisement for its 2010 Terrain vehicle. The ad depicted Einstein's face digitally pasted onto a muscled physique, accompanied by the written message "Ideas are sexy too." The ad ran in only one issue of *People* magazine. Plaintiff Hebrew University of Jerusalem ("HUJ"), which claims to own Einstein's right of publicity as a beneficiary under Einstein's will and thus exclusive control of the exploitation of his name and likeness, brought suit against GM for this unauthorized use of Einstein's image.

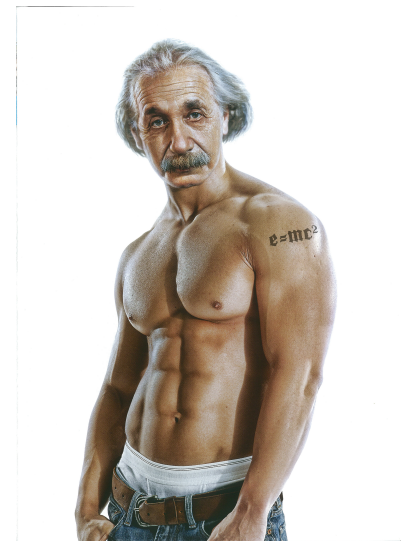
For the reasons set forth below, the Court concludes that the New Jersey Supreme Court would likely find that the postmortem right of publicity endures for no more than 50 years after death.

##### IV. ANALYSIS

J. Thomas McCarthy, the leading commentator on the right of publicity, has characterized the determination of the right's duration as "by nature almost arbitrary." An "almost arbitrary" ruling is unacceptable, however. The following analysis seeks to avoid one.

#### *B. Status of Existing New Jersey Law Concerning the Duration of the Postmortem Right of Publicity*

<sup>21</sup>If Christian Slater, star of "Heathers," "Pump up the Volume," "Kuffs," and "Untamed Heart" – and alleged Jack Nicholson clone – appears in a commercial, can Nicholson sue? Of 54 stories on LEXIS that talk about Christian Slater, 26 talk about Slater's alleged similarities to Nicholson. Apparently it's his nasal wisecracks and killer smiles, *St. Petersburg Times*, Jan. 10, 1992, at 13, his eyebrows, *Ottawa Citizen*, Jan. 10, 1992, at E2, his sneers, *Boston Globe*, July 26, 1991, at 37, his menacing presence, *USA Today*, June 26, 1991, at 1D, and his sing-song voice, *Gannett News Service*, Aug. 27, 1990 (or, some say, his insinuating drawl, *L.A. Times*, Aug. 22, 1990, at F5). That's a whole lot more than White and the robot had in common.



GM Terrain ad

McCarthy S 9:16

*Presley*: 513 F. Supp. at 1339 (D.N.J. 1981)

Only one court in New Jersey, a federal district court, has ever discussed the question of duration, and it did not decide the issue. *Estate of Presley* The primary question in *Presley* was whether New Jersey recognized a descendible, postmortem right of publicity. The court found that it does, holding that "Elvis Presley's right of publicity survived his death and became part of Presley's estate." With respect to the duration of the right of publicity, however, the *Presley* court merely stated that the state legislature should determine that question, although it also noted that the federal Copyright Act, which at that time provided for a copyright term of life plus 50 years, could provide guidance. No state court in New Jersey has ever addressed the issue.

Although the New Jersey Legislature has considered at least two bills that would create a statutory right of publicity, it has thus far not seen fit to enact such a right. See A.3536, 213th Legis. (N.J. 2008) (proposing the "Celebrity Image Protection Act," with a postmortem duration of 70 years); A.4476, 212th Legis. (N.J. 2007) (same). There is nothing stopping HUI from petitioning the New Jersey Legislature to pass a statute, with retroactive applicability, that would create a definitive postmortem right of publicity with the extended duration that HUI seeks here.

### *C. Aspects of the Right of Publicity that Should Affect Its Duration*

#### *1. The Right of Publicity's Origins in the Right of Privacy*

The right of publicity originally developed within the array of privacy rights that are considered personal, are based on dignitary interests and are not descendible.

Now, however, the right of publicity is widely understood, including in New Jersey, to be akin to intellectual property. Additionally, "[w]ith its emphasis on commercial interests, the right of publicity also secures for plaintiffs the commercial value of their fame and prevents the unjust enrichment of others seeking to appropriate that value for themselves."

Restatement (Third) of Unfair Competition § 46 cmt. c.

Notwithstanding the trend toward treating the right of publicity as a commercial property right, HUI contends that the right of publicity is a deeply personal right. It is true that one of the rationales for recognizing a right of publicity remains its protection of an individual's interest in personal dignity and autonomy. Surely, however, the personal interest that is at stake becomes attenuated after the personality dies.

A maximum 50-year postmortem duration here would be a reasonable middle ground that is long enough for a deceased celebrity's heirs to take advantage of and reap the benefit of the personal aspects of the right. See Restatement (Third) of Unfair Competition § 46 cmt.

h (“As a general matter, however, the dignitary and proprietary interests that support the recognition of a right of publicity become substantially attenuated after death. Post mortem uses are also less likely to create a false suggestion of endorsement or sponsorship.”). The obviously humorous ad for the 2010 Terrain having been published 55 years or more after Einstein’s death, it is unlikely that any viewer of it could reasonably infer that Einstein or whoever succeeded to any right of publicity that Einstein may have had was endorsing the GMC Terrain.

## 2. Copyright Law Considerations

HUJ argues that, if the Court must set a limit on the postmortem right of publicity, it should be coterminous with the current federal Copyright Act, which protects copyrights for 70 years after death. This Court disagrees. The purpose of the right and its underlying policies do not warrant a mechanical application of the Copyright Act’s term of life plus 70 years. Indeed, although McCarthy ultimately recognizes that using the federal Copyright Act as a model will “more often than not provide the tie-breaking solution to the problem” of determining the postmortem duration of the right of publicity, it is clear that such an analogy is inconsistent with McCarthy’s own views about the purpose and policies underlying the right. In fact, he would prefer to limit the extent of the right to 10-20 years after death, despite noting that other commentators have proposed longer durations, including a life-plus-50-year term modeled after the former version of the federal Copyright Act.

McCarthy S 9:16

The current 70-year postmortem term was enacted by the 1998 Copyright Term Extension Act, which increased the length of copyright protection from its former duration of life plus 50 years. HUJ acquired Einstein’s right of publicity in 1982, at which time the 1976 Copyright Act was in place – with a 50-year postmortem duration. HUJ’s reasonable expectation at that time, based on the same theory of analogy to copyright that it advocates today, necessarily would have been that any rights it acquired would not last more than 50 years after Einstein’s death. Similarly, when the *Presley* court suggested that the New Jersey Legislature consider the Copyright Act as a guide in setting a postmortem duration for the right of publicity, that statute had only a life-plus-50-year duration. This was approximately one year before HUJ acquired its interest.

There are certain similarities between the goals of copyright and those of the right of publicity. In a sense, both rights evolve from an act of creation, whether it is the creation of a “work” such as a writing or the creation of a cultivated persona. These acts of creation are the product of an individual’s choices and self-expression. Some courts, accordingly, have analogized between copyright and the right of pub-

licity in the context of balancing the interests protected by those rights with the interests protected under the First Amendment.

Despite the intersecting similarities between copyright and the right of publicity, however, that the right of publicity is an outgrowth of the right of privacy suggests that the term of copyright protection is far from a perfect precedent for determining the duration of the right of publicity. First, as HUI itself has argued, the right of publicity is an intensely personal right meant, to some extent, to protect against personal and dignitary harms, such as having one's persona associated with a product or idea of which he disapproves.

Moreover, the protection of copyright is designed to encourage the future creation of works of art, whereas the interest sought to be protected by the right of publicity is usually the byproduct of a different and earlier endeavor. The commercial value of a person's identity often results from success in endeavors such as entertainment or sports that offer their own substantial rewards. Any additional incentive attributable to the right of publicity may have only marginal significance. For this reason, it is questionable whether those interests should be protected for as long a period after the death of the person to whom they belong as are his copyrighted works.

#### D. Other States' Laws

##### 1. Common Law

Looking beyond New Jersey, in none of the five other states that recognize a common law postmortem right of publicity has any court addressed the issue of the right's duration, or even raised it as a question needing to be answered. In none of those cases, however, was the interval between the death of the person whose right of publicity was at stake and the date of the alleged infringement of that right 50 years or longer. Indeed, in most of the cases the period was 10 years or less. See, e.g., *Gignilliat v. Gignilliat, Savitz & Bettis, LLP* (maximum of 7 years at issue); *Jim Henson Productions v. John T. Brady & Assoc.* (maximum of 4 years at issue); *Nature's Way Products, Inc. v. Nature-Pharma, Inc.*; (maximum of 7 years at issue); *Presley* (permitting right of publicity claim brought three years after Elvis's death).

##### 2. Statutes

The majority of states with statutory rights of publicity limit the right's postmortem duration to 50 years or less. Seven states have statutory rights of publicity that permit the right to endure for up to 50 years.

Six states allow the postmortem right of publicity to reach 60 years or more.

Of the states whose statutes were enacted prior to the revision

*Gignilliat*: 684 S.E.2d 756 (S.C. 2009)

*Jim Henson Productions*: 867 F. Supp. 175 (S.D. Neb. 1994)

*Nature's Way*: 736 F. Supp. 245 (D. Utah 1990)

Florida: 40 years

Illinois: 50 years

Kentucky: 50 years

Nevada: 50 years

Pennsylvania: 30 years

Texas: 50 years

Virginia: 20 years

California: 70 years

Indiana: 100 years

Ohio: 60 years

Oklahoma: 100 years

Tennessee: indefinite

Washington: up to 75 years

of the Copyright Act in 1998, only California amended its statute to reflect the extended copyright term.

Thus, of the states with currently enacted statutory rights of publicity, a slight majority limits the duration of that right to 50 years or less. Although this does not provide overwhelming support for such a length of time, it does tip the balance slightly in that direction.

*E. Public Policy Counsels in Favor of Limiting the Postmortem Right of Publicity to Not More Than 50 Years*

One of the overarching policy concerns in enforcing intellectual property rights is the balance that must be struck between protecting an individual's right to reap the benefits of his creative endeavors and the public's freedom of expression. This policy concern extends to the right of publicity.

An open-ended right of publicity, or even a postmortem duration longer than 50 years, raises considerable First Amendment concerns and creates a potentially infinite curb on expression. Additionally, an extended right of publicity may interfere with or decrease the value of copyrighted works, such as photographs, thereby pitting one form of protected property against another.

In addition to First Amendment implications, there is another consideration. In the 57 years since Albert Einstein died, the means of communication have increased and so has the proclivity of people to use them frequently. Journalists, academics and politicians frequently issue pronouncements about the impact on society, both in the United States and around the globe, of the dizzying explosion in the tools of communication. New devices and platforms have been developed, including smart phones, personal computers, social networks, email, Twitter, blogs, etc. These technologies have caused a swift and dramatic, but still developing, impact on ordinary life. It has become a truism that their speed, their accessibility, and their popularity appear to have changed social norms regarding privacy and public expression. But it is not yet clear what this should mean for the protection of such rights as the right of privacy, the right of expression and the right of publicity. For example, on balance should the law increasingly protect people's right of expression, now that we enjoy so many fora in which to broadcast our views? Similarly, should the law value the right of privacy less than before, given that many social media devotees, especially young people, are said to have little compunction about revealing intimate information about themselves? Conversely, should the law afford celebrities greater rights in controlling publicity about themselves, to protect against what appears to be a growing tendency of people to not just exalt but even to exploit the fame and celebrity of others?

The Court does not profess to have answers to these questions,

but what is clear is that since the full impact of these rapid changes remains uncertain, it would be imprudent to issue any ruling that strengthens (or at least lengthens) one right – that of the right of publicity – to the potentially significant detriment of these other rights.

#### V. CONCLUSION

Absent a legislative directive to the contrary, to extend the right of publicity beyond a half century would be inconsistent with the Court's responsibility to balance all of the interests that are at stake. It also would risk having that right treated as an open-ended hereditary right. *See* McCarthy (noting the need "to avoid descendants or heirs unto the nth generation reaping the commercial rewards of a distant and famous ancestor, a 'favored bloodline' concept out of step with a society that has abolished hereditary titles" and that at some point, the interests of free speech outweigh the interests of the heirs and "the person's identity should enter the public domain as a part of history and folklore").

McCarthy S 9:16

A maximum duration of 50 years appropriately reflects the balance between meaningful enforcement of the right of publicity after a famous individual's death and the public's interest in free expression. It aligns with the majority of current state statutes limiting the right's postmortem duration. And it approximates the period evidently contemplated by the *Presley* court – the one court in New Jersey to have discussed the duration of the right – when it encouraged that state's legislature to consider the issue with guidance from the then-current Copyright Act.

Milton H. Greene Archives: 692 F.3d 983  
(9th Cir 2012)

The Ninth Circuit recently noted that Marilyn Monroe considered herself to belong "to the Public and to the world." *Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*. There is no evidence that Albert Einstein saw himself that way, but he did become the symbol and embodiment of genius. His persona has become thoroughly ingrained in our cultural heritage. Now, nearly 60 years after his death, that persona should be freely available to those who seek to appropriate it as part of their own expression, even in tasteless ads.

### 4 Infringement: Similarity

For a use to infringe, the plaintiff must be identifiable. This is effectively a similarity test between the defendant's use and the plaintiff's persona. Also, look back at the subject matter cases and the cases they discuss, especially *Motschenbacher*, which illustrate some variations on identifiability. Have the courts there conflated similarity with subject matter? Or is that precisely the point, that once identifiability is shown, there is no need for limiting subject-matter doctrines?



**Hooker v. Columbia Pictures Industries, Inc.**  
551 F. Supp. 1060 (N.D. Ill. 1982)

Plaintiff is a professional woodcarver from Woodstock, Illinois. Examining the host of exhibits appended to the affidavit which he has submitted, it appears that while plaintiff does carve other birds, he specializes in ducks. Plaintiff's ducks are of the highest quality. Some of them are described as "exquisite" and sell for a great deal of money. Plaintiff's name is T.J. Hooker.

The defendants produce and broadcast a television series about a fictional policeman in California. Never having heard of plaintiff or his celebrated ducks, the defendants happened to name their imaginary policeman "T.J. Hooker." Not surprisingly, the series is also entitled "T.J. Hooker."

Count I of the complaint is based upon the common law tort of appropriation of the plaintiff's name or likeness for the defendants' benefit or advantage. In order to state a claim for relief based on this theory, it is vital that some "appropriation" be alleged. See W. Prosser, *Law of Torts* § 117 (4th ed. 1971). "Appropriation" in this context means more than the mere coincidental use of a name that happens to be the same as that of the plaintiff. Dean Prosser explained this as follows:

It is the plaintiff's name as a symbol of his identity that is involved here, and not as a mere name. Unless there is some tortious use made of it, there is no such thing as an exclusive right to the use of a name; and any one can be given or assume any name he likes. It is only when he makes use of the name to pirate the plaintiff's identity for some advantage of his own, as by impersonation to obtain credit or secret information, or by posing as the plaintiff's wife, or providing a father for a child on a birth certificate, that he becomes liable. It is in this sense that "appropriation" must be understood. It is therefore not enough that a name which is the same as the plaintiff's is used in a novel, or the title of a corporation, unless the context or the circumstances indicate that the name is that of the plaintiff.... Nor is there any liability when the plaintiff's character, occupation, and the general outline of his career, with many real incidents in his life, are used as the basis for a figure in a novel who is still clearly a fictional one.

Similarly, the Restatement of Torts makes it clear that it is not the use of the plaintiff's name which constitutes a tort but rather the appropriation of the value of his name and reputation:

It is not enough that the defendant has adopted for himself

Not to be confused with the *T.J. Hooper*



William Shatner in *T.J. Hooker*

a name that is the same as that of the plaintiff, so long as he does not pass himself off as the plaintiff or otherwise seek to obtain for himself the values or benefits of the plaintiff's name or identity. Unless there is such an appropriation, the defendant is free to call himself by any name he likes, whether there is only one person or a thousand others of the same name. *Until the value of the name has in some way been appropriated, there is no tort.*

Examining Count I in light of the foregoing principles, it is apparent that plaintiff has failed to allege a tortious appropriation of his name. Plaintiff does allege that "[d]efendants' ... use of plaintiff's name appropriates the right of publicity in plaintiff's celebrated name." But this broad, conclusory allegation cannot substitute for allegations of facts showing that the defendants used the name "T.J. Hooker" as a means of pirating plaintiff's identity. By his own admission, the commercial value of plaintiff's name is in the field of wildlife art. Hunters, sportsmen, and collectors identify plaintiff's name with fine carvings of ducks and other fowl. There is nothing in the complaint which can be construed as an allegation that the defendants adopted the name "T.J. Hooker" in order to avail themselves of plaintiff's reputation as an extraordinary woodcarver.

Suppose that the plaintiff were the star of a long-running top-rated reality show about woodcarving. Same result?

Plaintiff admits that the fictional television series at issue here is a "police drama." It is difficult to imagine a subject further removed for the life of T.J. Hooker the artisan. The facts and circumstances alleged by plaintiff provide no basis upon which it can be found that the name "T.J. Hooker," as used in the defendants' fictional television series, in any way refers to the real T.J. Hooker.

There being no well-pleaded allegation of appropriation of the value of plaintiff's name, plaintiff has failed to state a claim upon which relief can be granted.

## 5 Infringement: Prohibited Conduct

### a Direct Infringement

The usual threshold rule is that the right of publicity only applies to commercial and advertising uses. The caselaw is thin on whether violations need to be intentional.

#### **Stephano v. News Group Publications, Inc.**

64 N.Y.2d 174 (1984)

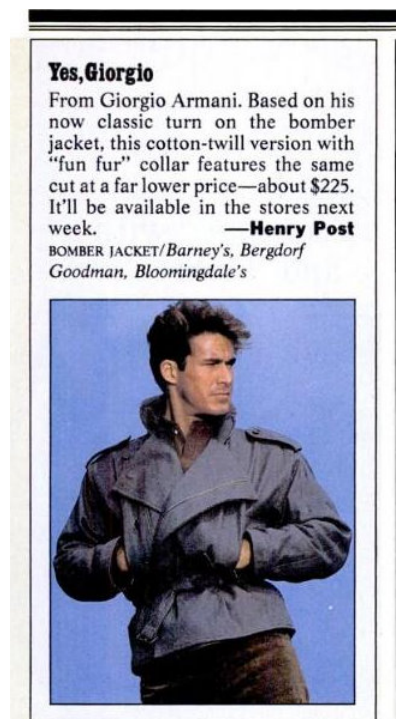
The plaintiff, a professional model, claims that the defendant used his picture for trade or advertising purposes without his consent, and thus violated his statutory right to privacy (Civil Rights Law, § 51), by publishing a picture of him modeling a "bomber jacket" in a mag-

azine article containing information regarding the approximate price of the jacket, the name of the designer, and the names of three stores where the jacket might be purchased. Plaintiff also claims that the defendant's conduct violated a common-law right of publicity. The trial court granted summary judgment to the defendant concluding that the article reported a newsworthy event of fashion news, and was not published for trade or advertising purposes. A divided Appellate Division reversed and denied summary judgment finding that factual questions were presented as to whether the defendant had used the plaintiff's picture for trade purposes and whether the article constituted an advertisement in disguise.

In the summer of 1981 the plaintiff agreed to model for an article on men's fall fashions. The photographic session took place on August 11, 1981. The defendant used two of the photographs taken during that session to illustrate an article entitled "Classic Mixes", which appeared under the heading "Fall Fashions" in the September 7, 1981 issue of New York magazine. Another photograph taken during the session was used, a week earlier, in the August 31, 1981 issue of New York magazine, in a column entitled "Best Bets". That column, a regular feature in the magazine, contains information about new and unusual products and services available in the metropolitan area. One of the items included in the August 31 column was a bomber jacket modeled by the plaintiff. The text above the picture states: "Yes Giorgio — From Giorgio Armani. Based on his now classic turn on the bomber jacket, this cotton-twill version with 'fun fur' collar features the same cut at a far lower price — about \$225. It'll be available in the stores next week. — Henry Post Bomber Jacket/Barney's, Bergdorf Goodman, Bloomingdale's."

It is the plaintiff's contention that he agreed to model for one article only — the September 7, 1981 article on Fall Fashions — and that the defendant violated his rights by publishing his photograph in the August 31 "Best Bets" column.<sup>1</sup> The complaint alleges two causes of action. First the plaintiff claims that the defendant violated his civil rights by using his photograph for trade or advertising purposes without his consent. In his second cause of action the plaintiff claims that the defendant's conduct "invaded plaintiff's right of publicity".

<sup>1</sup>In his brief to this court the plaintiff claims that the defendant's use of his photographs in both articles is in issue because the plaintiff did not give his written consent to use them in either article. It appears that the plaintiff was injured at the photographic session and subsequently refused to sign a release in order to avoid compromising the unrelated action for physical injuries. Nevertheless, in his complaint, he only objected to the August 31 "Best Bets" article. Similarly, in his papers in opposition to the motion for summary judgment, the plaintiff identified that publication alone as the basis for the complaint. Thus the only question properly before us concerns the defendant's liability for publishing the plaintiff's photograph in the "Best Bets" article of August 31, 1981.



The "Best Bets" item featuring Stephano

On each cause of action the plaintiff seeks \$350,000 in compensatory damages and an equal amount in exemplary damages.

The only question is whether the defendant used the plaintiff's picture for trade or advertising purposes within the meaning of the statute when it published his picture in the "Best Bets" column without his consent.

The statute does not define trade or advertising purposes. However, the courts have consistently held, from the time of its enactment, that these terms should not be construed to apply to publications concerning newsworthy events or matters of public interest. The exception reflects Federal and State constitutional concerns for free dissemination of news and other matters of interest to the public, but essentially requires an interpretation of the statute to give effect to the legislative intent. We have recently noted that this exception should be liberally applied.

The newsworthiness exception applies not only to reports of political happenings and social trends but also to news stories and articles of consumer interest including developments in the fashion world. Nevertheless, the plaintiff contends that the photograph in this case did not depict a newsworthy event because it is a posed picture of a professional model taken at a photographic session staged by the defendant. However, the event or matter of public interest which the defendant seeks to convey is not the model's performance, but the availability of the clothing item displayed. A fashion display is, of necessity, posed and arranged. Obviously the picture of the jacket does not lose its newsworthiness simply because the defendant chose to employ a person to model it in a controlled or contrived setting.

The fact that the defendant may have included this item in its column solely or primarily to increase the circulation of its magazine and therefore its profits, as the Appellate Division suggested, does not mean that the defendant has used the plaintiff's picture for trade purposes within the meaning of the statute. Indeed, most publications seek to increase their circulation and also their profits. It is the content of the article and not the defendant's motive or primary motive to increase circulation which determines whether it is a newsworthy item, as opposed to a trade usage, under the Civil Rights Law. It is settled that a picture illustrating an article on a matter of public interest is not considered used for the purposes of trade or advertising within the prohibition of the statute unless it has no real relationship to the article or unless the article is an advertisement in disguise. A contrary rule would unreasonably and unrealistically limit the exception to nonprofit or purely altruistic organizations which are not the only, or even the primary, source of information concerning newsworthy events and matters of public interest.

The plaintiff's primary contention is that his picture was used for

advertising purposes within the meaning of the statute. Although the article was not presented to the public as an advertisement, and was published in a column generally devoted to newsworthy items, the plaintiff claims that it is in fact an advertisement in disguise.

The facts on which the plaintiff relies are entirely circumstantial. He does not claim to have personal knowledge, or direct proof, that this particular article was actually published by the defendant for advertisement purposes. The circumstances on which he bases his claim are (1) the fact that the news column contains information normally included in an advertisement identifying the designer of the jacket, the approximate price, and three places where the jacket may be purchased, and (2) the fact that some or all of those stores mentioned in the article had previously advertised products in the magazine. Those circumstances are not enough to raise a jury question as to whether the article was published for advertising purposes.

The plaintiff does not dispute the fact that the information provided in the article is of legitimate reader interest. Indeed, similar information is frequently provided in reviews or news announcements of books, movies, shows or other new products including fashions. Nor does the plaintiff contend that it is uncommon for commercial publishers to print legitimate news items or reviews concerning products by persons or firms who have previously advertised in the publisher's newspaper or magazine. In short, the plaintiff has not presented any facts which would set this particular article apart from the numerous other legitimate news items concerning new products. He offers only his speculative belief that in this case the information on the jacket was included in the defendant's column for advertising purposes or perhaps, more vaguely, to promote additional advertising. That, in our view, is insufficient to defeat the defendant's motion for summary judgment. The rule exempting articles of public interest from the operation of the Civil Rights Law would, as a practical matter, lose much of its force if publishers of articles which are at least *prima facie* newsworthy were required to incur the expense of a trial to meet such general and insubstantial accusations of disguised advertising. ...

Finally, it should be emphasized that we do not mean to suggest that a publisher who has employed a professional model to pose for pictures to be used in an article may avoid the agreed fee, or otherwise ignore contractual arrangements, if the model's pictures are used to illustrate a newsworthy article or one involving matters of public interest. Although the complaint alludes to an agreement between the parties, the plaintiff has not sought to enforce a contract or recover damages for a breach. Since the plaintiff chose to frame his complaint entirely in terms of rights covered by the Civil Rights Law, which we have concluded is not applicable in this case, the complaint

should be dismissed.

**Washington v. Brown & Williamson Tobacco Corp.**

1984 WL 63629223, U.S.P.Q. 1116 (E.D. Pa. 1984)

Grover Washington, Jr., a well-known jazz saxophonist, alleges an advertising campaign invaded his right of publicity and contains false representation of sponsorship. The advertisements at issue were prepared as part of a “Kool” cigarette campaign and include photographs of an individual whom plaintiff claims looks like him. As a result of this alleged resemblance, it is asserted that the defendants have falsely represented to the public that the plaintiff endorses Kools and have appropriated for themselves the commercial value of plaintiff’s image and likeness. Plaintiff has asserted claims for false representation and designation of sponsorship under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and has also asserted pendent state claims for violation of his right of publicity, unjust enrichment, and quantum meruit.



Grover Washington, Jr.

The gist of the campaign was to display various musicians photographed playing instruments with the Kool logo and advertising copy superimposed upon the photographs. The music theme was selected because of the perception that music conveyed a positive image that would appeal to a broad selection of consumers. In particular, jazz was believed to offer the broadest possible appeal because it allowed the most personal interpretation for the viewer. (Dearth dep. at 33).

After the theme had been decided upon, studio photographs were taken of various musicians playing their instruments. Actual musicians were used, rather than models, because it was believed that musicians would enhance the realism of the advertisements.

Among those picked was Ronald L. Brown, the individual whose photograph the plaintiff alleges bears a likeness to him. Brown is a professional musician who is accomplished in playing the saxophone, among other instruments. He was selected to appear in the advertisements because he looked “appropriate.” [Three employees,] Lewis, Dearth, and Vail, had the primary responsibility for the creation and development of the campaign. None had ever seen Grover Washington or his photographs. In fact, of these three individuals only Lewis had ever heard of the plaintiff prior to the commencement of this litigation.

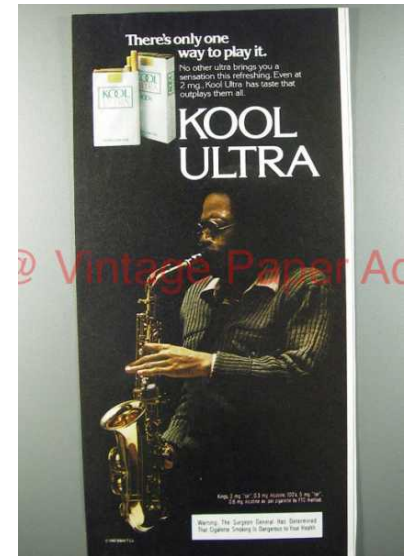
In January, 1982, the defendants began their music campaign nationwide, with advertisements appearing in newspapers, magazines, and on bill boards. The two advertisements at issue were among those initially circulated. These advertisements show a black male, with short hair and a beard playing the saxophone. In one, Brown is photographed from the side and is standing relatively erect in an

open collar white shirt. In the other, he is again photographed from the side, but is bent forward and is wearing a tweed coat. After viewing these advertisements, plaintiff commenced this action.

Defendants have premised their motion for summary judgment upon their assertion that it is undisputed the resemblance between the photograph of Ronald Brown and plaintiff was wholly coincidental because the individuals responsible for the creation and development of the campaign had never seen the plaintiff or his picture prior to the commencement of this litigation. Therefore, they argue, there was no intent to either confuse the public as to the plaintiff's sponsorship of their product or invade plaintiff's right of publicity.

Admittedly, the case at bar presents a close question. In their depositions, Vail, Dearth, and Lewis stated that they had never seen plaintiff or his photograph at the time they were developing the Kool advertising campaign. Not surprisingly, plaintiff has been unable to rebut this assertion directly since information relating to an individual's state of mind is generally within that person's exclusive knowledge. Instead, plaintiff relies upon circumstantial evidence which he contends demonstrates that in fact the defendants intentionally chose Ronald Brown's photograph to lead the public to believe that plaintiff endorsed the advertised products. Specifically, plaintiff points to his solicitation by agents of Brown & Williamson to perform in the Kool Jazz Festival, an alleged pattern of displaying the disputed advertisement in cities in which plaintiff performed during the summer of 1982, and the use of Milt Jackson, another renowned jazz musician, as a model for the advertising campaign, as well as a host of other relatively minor factual issues. However speculative they may be, the inferences to be drawn from such facts are not questions for the court to resolve. The task of making factual inferences must be done by the jury. Moreover, because the issue of intent is a material fact, the jury must be given an opportunity to observe the demeanor of Vail, Dearth, and Lewis to evaluate the credibility of each.

One final issue must be addressed. Defendants argue that the first amendment protects against liability where the cause of action is based on a coincidental, unintended resemblance. Obviously, this begs the question of whether the resemblance is in fact coincidental. If it is ultimately determined that the defendants intentionally chose the photographs of Ronald Brown in an effort to avail themselves of the commercial value of plaintiff's likeness, the first amendment would not provide the absolute protection defendants seek. False or misleading advertising is not within the ambit of absolute first amendment protection.



Kool ad featuring Ronald L. Brown

Compare *Flake v. Greensboro News Co.*, 195 S.E. 55 (N.C. 1938), where the defendant published an ad reading "Keep that Sylph-Like Figure by eating more of Melt's Rye and Whole Wheat Bread, says Mille. Sally Payne, exotic red haired Venus" but by mistake used a photograph of Nancy Flake rather than one of Sally Payne. The court held, "Upon the present record, from which it appears that said photograph was used by mistake and without malice and that the defendants immediately desisted from the use thereof upon the discovery of the mistake and made due apology therefor, the plaintiff would be entitled to a judgment for nominal damages only."



Greensboro Daily News ad misidentifying Nancy Flake as Sally Payne

## b Secondary Liability

As with false advertising, there's not a thick body of caselaw on secondary liability for right of publicity violations, but there is enough to sketch its contours.

### **Perfect 10, Inc. v. Cybernet Ventures, Inc.** 213 F.Supp.2d 1146 (C.D. Cal. 2002)

[Perfect 10 sold "'classy' pictures of nude women without breast implants, cosmetic surgery, or the like" in a magazine and website. Cybernet provided age-verification services for more than 300,000 pornographic websites. According to Perfect 10, approximately 900 of those sites displayed Perfect 10's images without permission. Many of the models in those photographs had assigned their rights of publicity to Perfect 10.

On copyright, the court held that Cybernet did not directly infringe Perfect 10's copyrights but could potentially be liable as a contributory or a vicarious infringer, and that it was unlikely that Cybernet qualified for the § 512(c) safe harbor for various reasons, including that it had failed to reasonably implement a policy to terminate repeat infringers.]

Neither party contests that third parties operating under the Adult Check name have infringed the rights of publicity assigned to Perfect 10 by a number of models. . Nor does either party suggest that direct liability would not be appropriate against those third-parties under either theory. Similarly, Perfect 10 does not assert any direct liability theory against Cybernet. The likelihood of success thus boils down to a question of "aiding and abetting."

California has adopted the joint liability principle laid out in the Restatement (Second) of Torts § 876. Under the Restatement,

For harm resulting to a third person from the tortious conduct of another, one is subject to liability if he:

- a) does a tortious act in concert with the other in pursuit to a common design with him, or
- b) knows that the other's conduct constitutes a breach of duty and gives substantial assistance or encouragement so to conduct himself, or
- c) gives substantial assistance to the other in accomplishing a tortious result and his own conduct, separately considered, constitutes a breach of duty to the third person.

Cybernet argues that there is no case directly recognizing the applicability of this doctrine to the right of publicity torts. The Court finds



this argument unpersuasive, as the Restatement provides a background principle for all tort liability in the state of California.

Nor does the Court find convincing Cybernet's argument that the right of publicity itself contains an actual knowledge requirement. Cybernet's citations refer to the requirement that broadcasters of advertisements must have actual knowledge before they can be held liable. Cybernet does not claim to be a medium used for advertising, and the Court only focuses on rights of publicity infringements located on the websites, not infringements associated with webmaster banner ads. Rather, Cybernet argues that the knowledge requirement of section 3344(f) is a requirement for "aider and abettor" liability under the statute.

The Court concludes otherwise. Although section 3344(f) provides clear evidence that secondary liability can be imposed for violations of publicity rights, it also provides evidence that the California legislature created a heightened knowledge requirement limited to broadcasters of advertisements. The California legislature has not extended this requirement to defendants like Cybernet. The Court therefore defaults to the background assumption that secondary liability applies to right of publicity claims and it is to be found in conformance with the requirements established in the Restatement.

Perfect 10 has primarily focused its secondary theory of liability on the second branch of the Restatement, requiring actual knowledge of the tortious conduct and substantial participation. The Court agrees with Perfect 10 that there is a serious question on the merits of the substantial participation prong. As it stands, in the absence of argument to the contrary, the Court looks to the contributory infringement framework of copyright trademark law, where it has already found just such participation, thus leading the Court to conclude Perfect 10 has established a strong likelihood of success with regard to Cybernet's substantial participation.

The Court recognizes that application of secondary liability principles is particularly applicable for claims of unfair competition, as the California Supreme Court recognized as far back as 1935: "When a scheme is evolved which on its face violates the fundamental rules of honesty and fair dealing, a court of equity is not impotent to frustrate the consummation because the scheme is an original one." *American Philatelic Soc'y v. Claibourne*

*American Philatelic*: 46 P.2d 135 (1935)

In *American Philatelic*, a purveyor of stamps altered his normal stamps to resemble rare perforated stamps. He then sold these stamps to stamp dealers with clear notice that the stamps were not of the rare variety. Nevertheless, his sales brochures and pricing established that he both anticipated and effectively encouraged these dealers to sell the stamps to the public as rare stamps. The California Supreme Court had no problem finding these claims stated a claim

under the unfair competition law. *American Philatelic's* equity language reinforce the Court's conclusion that Perfect 10's theory of aiding and abetting liability for Cybernet based on third-party violations of various rights of publicity has a strong likelihood of success.

## 6 Defenses

The types of defenses to the right of publicity should be familiar by now. First sale applies, but pay attention to the details. And there are also defenses for newsworthy uses and for creative ones. Very, very, very loosely, newsworthiness incorporates some of the same concerns as descriptive and nominative fair uses. Again, pay attention to the details; things may be different here than elsewhere.

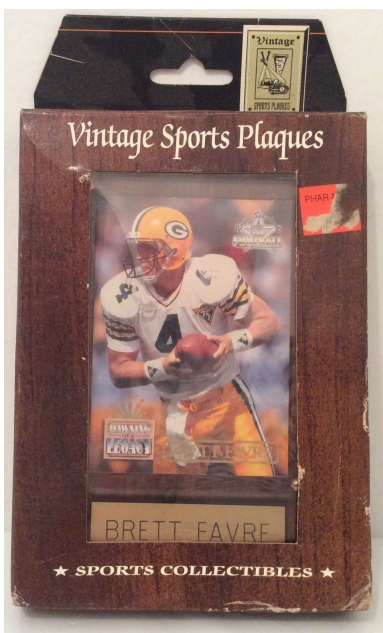
### **Allison v. Vintage Sports Plaques** 136 F.3d 1443 (11th Cir. 1998)

The issue presented in this case is whether the "first-sale doctrine," a well-established limitation on intellectual property rights, applies to the common-law right of publicity. We hold that it does. Accordingly, we affirm the district court, which granted summary judgment to the defendant.

Elisa Allison is the widow of Clifford Allison, a well-known race-car driver. Orel Hershisher is a well-known professional baseball player. [Both Clifford Allison and Hershisher had licensing contacts for trading cards.]

Vintage Sports Plaques ("Vintage") purchases trading cards from licensed card manufacturers and distributors and, without altering the cards in any way, frames them by mounting individual cards between a transparent acrylic sheet and a wood board. Vintage then labels each plaque with an identification plate bearing the name of the player or team represented. In addition to the mounted trading card, some of the plaques feature a clock with a sports motif. Vintage markets each plaque as a "Limited Edition" and an "Authentic Collectible." Vintage is not a party to any licensing agreement that grants it the right to use the appellants' names or likenesses for commercial purposes and has never paid a royalty or commission to the appellants for its use of their names or images. Appellants presumably have received, however, pursuant to their respective licensing agreements, royalties from the card manufacturers and distributors for the *initial* sale of the cards to Vintage.

Appellants argue that we should not apply the first-sale doctrine to common-law actions to enforce the right of publicity. There is virtually no case law in any state addressing the application of the first-sale doctrine to the right of publicity, perhaps because the applicabil-



Vintage Sports Plaque

ity of the doctrine is taken for granted.<sup>8</sup>

Appellants argue that the right of publicity differs from other forms of intellectual property because the former protects "identity," whereas the latter protect "a particular photograph or product." The first-sale doctrine should not apply, they reason, because a celebrity's identity continues to travel with the tangible property in which it is embodied after the first sale. We find two significant problems with appellants' argument. First, the distinction that appellants draw between what is protected by the right of publicity and what is protected by other forms of intellectual property rights, such as copyright, is not sound. Copyright law, for example, does not exist merely to protect the tangible items, such as books and paintings, in which the underlying expressive material is embodied; rather, it protects as well the author's or artist's *particular* expression that is included in the tangible item. The copyright law thus would be violated not only by directly photocopying a protected work, but also by publishing language or images that are substantially similar to that contained in the copyrighted work.

Second, and more important in our view, accepting appellants' argument would have profoundly negative effects on numerous industries and would grant a monopoly to celebrities over their identities that would upset the delicate balance between the interests of the celebrity and those of the public. Indeed, a decision by this court not to apply the first-sale doctrine to right of publicity actions would render tortious the resale of sports trading cards and memorabilia and thus would have a profound effect on the market for trading cards, which now supports a multi-billion dollar industry. Such a holding presumably also would prevent, for example, framing a magazine advertisement that bears the image of a celebrity and reselling it as a collector's item, reselling an empty cereal box that bears a celebrity's endorsement, or even reselling a used poster promoting a professional sports team. Refusing to apply the first-sale doctrine to the right of publicity also presumably would prevent a child from selling to his friend a baseball card that he had purchased, a consequence that undoubtedly would be contrary to the policies supporting that right.

A holding that the first-sale doctrine does limit the right of publicity, on the other hand, would not eliminate completely a celebrity's control over the use of her name or image; the right of publicity protects against unauthorized use of an image, and a celebrity would continue to enjoy the right to license the use of her image *in the first instance* – and thus enjoy the power to determine when, or if, her image will be distributed.

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<sup>8</sup>We note that some states that statutorily have recognized a right of publicity have codified the first-sale doctrine.

The issue before us, then, is whether the district court properly resolved as a matter of law that Vintage's plaques merely are the cards themselves repackaged, rather than products separate and distinct from the trading cards they incorporate. If they are the latter, as appellants contend that they are, then arguably Vintage is selling a product by commercially exploiting the likenesses of appellants intending to engender profits to their enterprise, a practice against which the right of publicity seems clearly to protect.

We conclude that the district court properly determined that, as a matter of law, Vintage merely resells cards that it lawfully obtains. We think it unlikely that anyone would purchase one of Vintage's plaques for any reason other than to obtain a display of the mounted cards themselves. Although we recognize that the plaques that include a clock pose a closer case, we conclude that it is unlikely that anyone would purchase one of the clock plaques simply to obtain a means of telling time, believing the clock to be, for example, a "Hershey Clock" or an "Allison Clock."

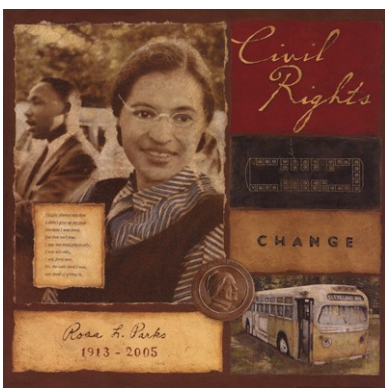
**Rosa and Raymond Parks Institute for Self Development v. Target Corp.**  
90 F. Supp. 3d 1256 (M.D. Ala. 2015)

The Parks Institute is a Michigan 501(c)(3) corporation that owns the name and likeness of the late Rosa Parks. Rosa Parks, who was African-American, became an icon of the Civil Rights movement when she refused to surrender her seat to a white passenger on a racially segregated Montgomery, Alabama bus. Her actions ignited the Montgomery Bus Boycott. Target is a national retail corporation headquartered in Minneapolis, Minnesota. Target operates more than 1,800 retail stores across the United States, as well as an e-commerce website.

Beginning in 2009, Target offered for sale a collage-styled plaque in a limited number of its retail stores. The plaque contained the following images, as described by its creator Stephanie Workman Marrott: (1) a stylized rendering of the phrase "Civil Rights"; (2) an illustrated exhibit submitted in *Browder v. Gayle*, depicting where Rosa Parks was sitting on the bus prior to her arrest; (3) a stylized rendering of the word "Change"; (4) an illustration of the Cleveland Avenue bus; (5) a stylized rendering of Rosa Parks's name and dates of birth and death; (6) a picture of Rosa Parks's Congressional Gold Medal; (7) a photograph of Rosa Parks and Martin Luther King, Jr.; and (8) an inspirational statement made by Rosa Parks. It was this plaque that Elaine Steele, co-founder of the Parks Institute, and Anita Peek, Executive Director of the Parks Institute, discovered when they visited a number of Target retail stores located in the state of Michigan.

Upon realizing that Target was selling a plaque adorned with images of and related to Rosa Parks, the Parks Institute filed this lawsuit

*Browder*: 142 F. Supp. 707 (M.D. Ala. 1956)



Rosa Parks plaque

on November 6, 2013. Following a period of discovery, it became clear that the lawsuit challenged Target's sale of eight items in addition to the plaque: 1) the book *Rosa Parks: My Story*, by authors Rosa Parks and Jim Haskins; 2) the book *Who Was Rosa Parks?*, by author Yona Zeldis McDonough and illustrator Nancy Harrison; 3) the book *Rosa Parks (Childhood of Famous Americans)*, by author Kathleen Kudlinkski and illustrator Maryl Henderson; 4) the book *Rosa Parks*, by author Eloise Greenfield and illustrator Gil Ashby; 5) the book *A Picture Book of Rosa Parks*, by author David A. Adler and illustrator Robert Casilla; 6) the book, *The Rebellious Life of Mrs. Rosa Parks*, by author Jeanne Theoharis; 7) the book *The Story of Rosa Parks*, by author Patricia A. Pingry and illustrator Steven Walker; and 8) the American television movie *The Rosa Parks Story*, written by Paris Qualles and directed by Julie Dash.

Target argues that under Michigan law – and Alabama law – summary judgment is proper as to all of the Parks Institute's claims because the plaque and biographical works are protected fully by the First Amendment as biographical works that concern matters of legitimate public interest. In opposition, the Parks Institute argues that Target's "reliance on the First Amendment as protection for its action in this case is misplaced." Specifically, the Parks Institute avers that there is no legal precedent that would allow Target to exploit Rosa Parks's image or likeness for its own commercial purposes.

Michigan law is fairly limited with regard to actions alleging the unlawful commercial exploitation of a celebrity or public figure's identity. See *Ruffin-Steinback v. dePasse* (discerning how Michigan courts would address a claim for unlawfully depicting a public figure's life story without consent by looking to "all available sources" because the Michigan Supreme Court had not spoken to the issue). In 2000, however, the Michigan federal district court in *Ruffin-Steinback* addressed "state law tort claims for violation of the right of publicity, unjust enrichment, negligence, conspiracy, invasion of privacy, defamation and intentional infliction of emotional distress" brought by the heirs and personal representatives of members of the Temptations music group and associated individuals. In that case, the plaintiffs challenged the National Broadcasting Company's airing of a two-night mini-series covering the story of the Temptations. The mini-series was told from the perspective of Otis Williams, one of the group's founding members, but covered the lives of each of the group's members in detail.

[The *Ruffin-Steinback* court referred to Restatement (Third) of Unfair Competition § 47]:

The name, likeness, and other indicia of a person's identity are used for the purposes of trade under the rule

*Ruffin-Steinback*: 82 F. Supp. 2d 723  
(E.D. Mich. 2000)

stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use for the purposes of trade does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.

The court also noted that comment c to S 47 states that "the right of publicity is not infringed by the dissemination of an unauthorized print or broadcast biography."

After looking to the Restatement, the court surveyed case law and confirmed that courts in various jurisdictions treated unlicensed works of biography similarly. Across jurisdictions, courts had been reluctant "to extend the right of publicity to depictions of life-stories based on First Amendment considerations." *Id.* Accordingly, the court concluded that "Michigan courts would not extend [the] right of publicity tort" to prohibit biographical works and, ultimately, dismissed all of the derivative claims – unjust enrichment, conspiracy, and negligence – finding that they were dependent on the plaintiffs' right of publicity claims.

In this case, the Parks Institute is challenging Target's sale of eight biographical works, the majority of which are simplified accounts of Rosa Parks's life and accomplishments written to educate children about the Civil Rights movement and to demonstrate how one courageous individual can bring about significant change. The Parks Institute does not claim that any of the biographical works cast Rosa Parks in a false or defamatory light – separate causes of action for the dissemination of inaccurate information. Rather, it bases the entirety of its lawsuit on the idea that the First Amendment does not extend to protect the unapproved commercial sale of items that depict the name, likeness, story, or image of Rosa Parks.

For the reasons discussed at length in *Ruffin-Steinback*, however, the Parks Institute is mistaken. The depiction of Rosa Parks's life story without the Parks Institute's consent does not violate the Parks Institute's ownership rights to Rosa Parks's name or likeness. To quote from one of the biographical works at issue, Rosa Parks is perhaps the most iconic heroine of the civil rights movement. And, as both parties agree, one cannot talk about the Civil Rights movement without including Rosa Parks. The importance of her story serves as an apt reminder of why First Amendment protection for biographical works is so vital.

Target's sale of the seven books and one movie does not violate the Parks Institute's ownership rights in Rosa Parks's name or likeness be-

cause they are biographical works. Accordingly, summary judgment is due to be entered in favor of Target as to those eight items on the Parks Institute's right of publicity claim, as well as the unjust enrichment and misappropriation claims since they are derivative causes of action.

Because the collage-styled plaque is less of a biographical work and more akin to a work of art, the legality of Target's sale of the plaque requires a separate analysis. The Michigan Supreme Court has recognized that a plaintiff may bring suit for the misappropriation of his or her name or likeness under its invasion of privacy tort. This cause of action is founded upon the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or to others. Because the tort has the potential to offer a troublingly broad swath of protection, however, courts that have recognized the appropriation tort have also uniformly held that the First Amendment bars appropriation liability for the use of a name or likeness in a publication that concerns matters that are newsworthy or of legitimate public concern.

The question whether a publication is sufficiently a matter of public interest to be protected by the privilege is ordinarily decided by the court as a question of law. To make the decision, a court must examine the nature of the appropriation. For while a defendant can be liable for the tort of misappropriation of likeness if defendant's use of plaintiff's likeness was for a predominately commercial purpose, the First Amendment will protect the appropriation if it has a redeeming public interest, news, or historical value.

No doubt Target's sale of the plaque served a commercial purpose. Michigan courts, however, have applied the legitimate public interest privilege to instances where the misappropriation occurred for the purposes of making a profit. *See, e.g., Battaglieri v. Mackinac Center For Public Policy* (finding that a fundraising letter was within the privilege when it used quotes from the plaintiff without his consent because the quotes spoke to important policy issues). Additionally, the legitimate public interest exception does not merely extend to cover current events, as matters related to education and information are within the scope of legitimate concern. As provided by the Restatement (Second) of Torts:

The scope of a matter of legitimate concern to the public is not limited to "news," in the sense of current events or activities. It extends also to the use of names, likenesses or fact in giving information to the public for purposes of education, amusement or enlightenment, when the public may reasonably be expected to have a legitimate interest

*Battaglieri*: 680 N.W.2d 915 (Mich. Ct. App. 2004)

Restatement (Second) Torts § 652D, comment j

in what is published.

Expanding on this idea, a federal district court applying Michigan law explained that the "First Amendment privilege does not only extend to news in the sense of current events, but extends far beyond to include all types of factual, educational, and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general." *Armstrong v. Eagle Rock Entm't, Inc.*

*Armstrong*: 655 F. Supp. 2d 779 (E.D. Mich. 2009)

Applying these principles, the court found that Eagle Rock Entertainment's decision to use Louis Armstrong's picture on the cover liner of its DVD entitled, "Mahavishnu Orchestra, Live at Montreux, 1984, 1974," without consent was protected by the First Amendment. Specifically, under Michigan law, the court concluded that the DVD and its packaging had an historical and entertainment value for jazz fans everywhere. Michigan law and the First Amendment require a similar determination in this case.

The collage-styled plaque contains several elements reminiscent of the historic Civil Rights movement. In fact, by including a picture of Rosa Parks and Martin Luther King, Jr., alongside stylized renderings of the words "Civil Rights" and "Change," Stephanie Workman Marrott, the plaque's creator, sought to inspire viewers to "stand up for what they believe is right" while telling the important story of Rosa Parks's courage during the Civil Rights movement. There can be no doubt that Rosa Parks and her involvement in the Civil Rights movement are matters of utmost importance, both historically and educationally. Accordingly, just as Louis Armstrong's image is significant to the history of jazz, Rosa Parks's name and image are historically significant to the fight for equality in the South. Because Target's sale of the collage-style plaque is protected by the First Amendment, Target is entitled to summary judgment on all of the Parks Institute's claims regarding the plaque, in addition to the biographical works.

#### **No Doubt v. Activision Publishing, Inc.**

122 Cal. Rptr. 3d 397 (Ct. App. 2011)

The rock band No Doubt brought suit against the video game publisher Activision Publishing, Inc. (Activision), based on Activision's release of the Band Hero video game featuring computer-generated images of the members of No Doubt. Applying the transformative use test first adopted in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, we conclude that the creative elements of the Band Hero video game do not transform the images of No Doubt's band members into anything more than literal, fungible reproductions of their likenesses. Therefore, we reject Activision's contention that No Doubt's right of publicity claim is barred by the First Amendment. In addition, we dis-

*Comedy III*: 21 P.3d 797 (2001)



agree with Activision's contention that No Doubt must demonstrate that Activision used the likenesses of the band members in an "explicitly misleading" way in order to prevail on its unfair competition claim.

#### FACTUAL AND PROCEDURAL BACKGROUND

Defendant Activision is a leading international video game distributor and the creator and owner of the interactive Band Hero video game. The game allows players to simulate performing in a rock band in time with popular songs. By choosing from a number of playable characters, known as "avatars," players can "be" a guitarist, a singer, or a drummer. Some of the available avatars are fictional characters created and designed by Activision while others are digital representations of real-life rock stars. Players can also design their own unique fictional avatars. Represented by the avatars of their choosing, players "perform" in various settings, such as venues in Paris and Madrid, a rock show at a shopping mall, and even outer space.

In addition to allowing players to perform over 60 popular songs, Band Hero permits players to create their own music and then play their compositions using an avatar. As with all the Guitar Hero video games, as players advance in the Band Hero game, they can "unlock" characters and use them to play songs of the players' choosing, including songs the players have composed as well as songs made famous by other artists.

Plaintiff No Doubt is an internationally recognized rock band featuring Gwen Stefani as its lead singer. No Doubt entered into a professional services and character licensing agreement (Agreement) with Activision permitting Activision to include No Doubt as one of the rock bands featured in Band Hero.

As part of the Agreement, Activision agreed to license no more than three No Doubt songs for use in Band Hero, subject to No Doubt's approval over the song choice. (Ultimately, the game included two No Doubt songs.)

Pursuant to the Agreement, the members of No Doubt participated in a full-day motion capture photography session at Activision's studios so that the band members' Band Hero avatars would accurately reflect their appearances, movements, and sounds. No Doubt then closely reviewed the motion capture photography and the details related to the appearance and features of their avatars to ensure the representations would meet their approval.

Approximately two weeks prior to the release of Band Hero, No Doubt became aware of the "unlocking" feature of the game that would permit players to use No Doubt's avatars to perform any of the songs included in the game, including songs that No Doubt main-



Band Hero screenshot

tains it never would have performed. The band also learned that female lead singer Gwen Stefani's avatar could be made to sing in a male voice, and the male band members' avatars could be manipulated to sing songs in female voices. The individual band member avatars could be made to perform solo, without their band members, as well as with members of other groups. No Doubt contends that in the numerous communications with No Doubt, Activision never communicated its intention to permit such manipulations of the No Doubt avatars. Rather, No Doubt insists, Activision represented that No Doubt's likenesses within Band Hero would be used only in conjunction with the selected No Doubt songs.

When No Doubt complained about the additional exploitation of their likenesses, Activision admitted that it had hired actors to impersonate No Doubt in order to create the representations of the band members' performances of the additional musical works other than the No Doubt songs licensed for the game. No Doubt demanded that Activision remove the "unlocking" feature for No Doubt's avatars, but Activision refused. Activision contends that No Doubt's request came only after the programming had been finalized and the manufacturers had approved the game for manufacture.

No Doubt filed a complaint against Activision in superior court, seeking injunctive relief and damages for Activision's allegedly unauthorized exploitation of No Doubt's name, performances and likenesses. No Doubt alleged six causes of action: (1) fraudulent inducement; (2) violation of statutory and common law right of publicity; (3) breach of contract; (4) unfair business practices in violation of Business and Professions Code section 17200; (5) injunctive relief; and (6) rescission.

## II. NO DOUBT'S CLAIMS AROSE FROM PROTECTED ACTIVITY

Video games generally are considered "expressive works" subject to First Amendment protections. Further, Activision's use of No Doubt's likenesses in Band Hero is a matter of public interest because of the widespread fame No Doubt has achieved; there is a public interest which attaches to people who, by their accomplishments, mode of living, professional standing or calling, create a legitimate and widespread attention to their activities. Accordingly, the use of No Doubt's likenesses in the Band Hero video game meets the first requirement of the anti-SLAPP statute.

## III. NO DOUBT'S PROBABILITY OF SUCCESS ON THE MERITS OF THE Claims

### A. Right of Publicity Claim

"Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world). That suffices to confer First Amendment protection." *Brown v. Entertainment Merchant's Ass'n*, 131 S. Ct. 2729 (2011)

No Doubt has alleged a claim for violation of the right of publicity under Civil Code section 3344 as well as under common law. Section 3344 provides in pertinent part: "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 such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof." The common law claim for misappropriation of the right of publicity is similar, except there is no requirement that the misappropriation have been done knowingly.

1. "*Transformative Use*" Defense

Activision contends that its use of No Doubt's likenesses in *Band Hero* constitutes "protected First Amendment activity involving an artistic work," and thus No Doubt's right of publicity claim is completely barred. However, Activision's First Amendment right of free expression is in tension with the rights of No Doubt to control the commercial exploitation of its members' likenesses.

In *Comedy III*, our Supreme Court directly confronted this tension. The court articulated

what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.

[Thus,] when artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

[A celebrity may enforce] the right to monopolize the production of conventional, more or less fungible, images of that celebrity. On the other hand, a work claimed to violate a celebrity's right of publicity is entitled to First Amendment protection where added creative elements significantly transform the celebrity depiction.

Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed

that it has become primarily the defendant's own expression rather than the celebrity's likeness. [The inquiry boils down to] whether the literal and imitative or the creative elements predominate in the work.

The court then applied its newly minted "transformative use" test to the facts before it. The plaintiff was the owner of the rights to the comedy act known as The Three Stooges. The defendant was an artist who sold lithographs and T-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing the artist had created. The owner sued for violation of the right of publicity under Civil Code section 3344.1, the companion statute to section 3344 that extends the right of publicity to the heirs and assignees of deceased personalities.<sup>5</sup>

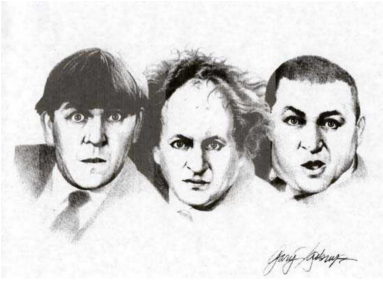
The court rejected the artist's contention that the plaintiff's claim was barred by the First Amendment. The court could "discern no significant transformative or creative contribution" in the artist's literal reproduction of the likenesses of The Three Stooges in its charcoal drawing. The artist's "undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame."

The court was careful to note that, in some circumstances, literal reproductions of celebrity portraits may be protected by the First Amendment. The court used the example of silk screens created by artist Andy Warhol using images of celebrities such as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. "Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself."

The Supreme Court again addressed the balance between the First Amendment and celebrities' rights of publicity in *Winter v. DC Comics* in which the defendant was sued for misappropriation under section 3344 after publishing a series of comic books featuring two villainous half-worm, half-human characters named the "Autumn brothers." The characters were quite obviously based on the musician brothers Edgar and Johnny Winter, sharing their same long white hair and albino features.

Applying the "transformative use" test set forth in *Comedy III*, the court held that the Winter brothers' claim was barred by the First Amendment as a matter of law. The court found that the comic depictions at issue were

not just conventional depictions of plaintiffs but contain

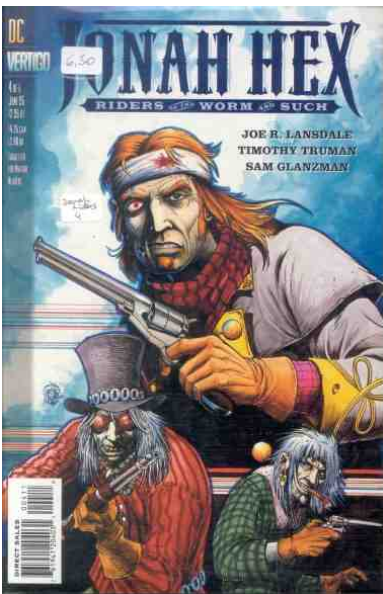


Saderup's Three Stooges drawing



Andy Warhol silkscreen of Marilyn Monroe

*Winter*: 69 P.3d 473 (Cal. 2003)



Jonah Hex cover from *Winter*

<sup>5</sup>The test developed in *Comedy III* applies equally to claims under section 3344.

significant expressive content other than plaintiffs' mere likenesses. Although the fictional characters Johnny and Edgar Autumn are less-than-subtle evocations of Johnny and Edgar Winter, the books do not depict plaintiffs literally. Instead, plaintiffs are merely part of the raw materials from which the comic books were synthesized. To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature. And the Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.

The comic books featured “fanciful, creative characters, not pictures of the Winter brothers,” in stark contrast to *Comedy III*, where the artist “essentially sold, and devoted fans bought, pictures of The Three Stooges, not transformed expressive works by the artist.”

In *Kirby v. Sega of America, Inc.*, the Court of Appeal applied the “transformative use” test in a case involving the alleged use of a celebrity’s likeness in a video game. The plaintiff, Kierin Kirby, achieved fame as the lead singer of the musical group Deee-Lite which was popular in the early 1990’s. Kirby alleged that video game distributor Sega violated her common law and statutory rights of publicity when it released the video game *Space Channel 5* that included as its main character a computer-generated woman named “Ulala” allegedly based on Kirby.

SC5 is set in outer space, in the 25th century, and Ulala is a reporter who is sent to “investigate an invasion of Earth by dance-loving aliens who shoot earthlings with ray guns, causing them to dance uncontrollably.” To advance in the game, players attempt to have Ulala match the dance moves of various aliens and competitor reporters. A Japanese choreographer and dancer created Ulala’s six main dance moves.

Kirby contended that Sega misappropriated her likeness by giving Ulala similar facial features to her own as well as by borrowing her distinctive look that combines retro and futuristic elements, including red or pink hair, platform shoes, brightly colored formfitting clothes, and short skirts. In addition, Ulala’s name is a phonetic variation of “ooh la la,” which Kirby alleged was her “signature” lyrical expression included in three of her songs.

The Court of Appeal concluded that there was a question of fact as to whether Sega had misappropriated Kirby’s likeness in creating the character Ulala. However, the court found that even assuming Sega used Kirby’s likeness, the First Amendment provided a complete defense. “Notwithstanding certain similarities, Ulala is more than a mere likeness or literal depiction of Kirby,” as Ulala’s physique, pri-

*Kirby*: 50 Cal. Rptr. 3d 607 (Ct. App. 2006)



Ulala from *Space Channel 5*

mary hairstyle and costumes, and dance moves differed from Kirby's. "Moreover, the setting for the game that features Ulala—as a space-age reporter in the 25th century—is unlike any public depiction of Kirby. . . . Taken together, these differences demonstrate Ulala is 'transformative,' and respondents added creative elements to create a new expression" such that the First Amendment barred Kirby's claim. Ulala was not merely "an imitative character contrived of minor digital enhancements and manipulations", and unlike the use of the likenesses of The Three Stooges in *Comedy III*, any imitation of Kirby's likeness was not "the sum and substance" of Ulala's character. Rather, like the "Autumn brothers" comic book characters in *Winter*, "Ulala is a "fanciful, creative character" who exists in the context of a unique and expressive video game."

## 2. Use of No Doubt's Likenesses in *Band Hero* Is Not "Transformative"

Activision does not dispute that the avatars of No Doubt are computer-generated recreations of the real band members, painstakingly designed to mimic their likenesses. Indeed, as part of the licensing agreement between Activision and No Doubt, No Doubt posed for motion-capture photography to enable Activision to reproduce their likenesses, movements, and sounds with precision. Activision intentionally used these literal reproductions so that players could choose to "be" the No Doubt rock stars. The game does not permit players to alter the No Doubt avatars in any respect; they remain at all times immutable images of the real celebrity musicians, in stark contrast to the fanciful, creative characters in *Winter* and *Kirby*.

No Doubt asserts that such realistic depictions categorically disqualify their *Band Hero* avatars from First Amendment protection. However, as *Comedy III* held, even literal reproductions of celebrities can be "transformed" into expressive works based on the context into which the celebrity image is placed (noting, for instance, the Warhol silk screens featuring celebrity portraits, through "careful manipulation of context," convey an ironic message about the "dehumanization of celebrity" through reproductions of celebrity images); see also *ETW Corp. v. Jireh Publishing, Inc.* [a painting featuring three literal likenesses of Tiger Woods in different poses in the foreground, with the Augusta National Clubhouse behind him and the likenesses of other famous golfing champions looking down on him, found worthy of First Amendment protection because it was a "panorama" of Woods's historic 1997 victory at the world-famous Masters Tournament and conveyed a message about the significance of Woods's achievement through images suggesting that Woods would eventually join the ranks of the world's best golfers].) Thus, when the context into which a literal celebrity depiction is placed creates something new, with a further purpose or different character, altering the

ETW: 332 F.3d 915 (6th Cir. 2003)



Rick Rush portrait of Tiger Woods from  
ETW

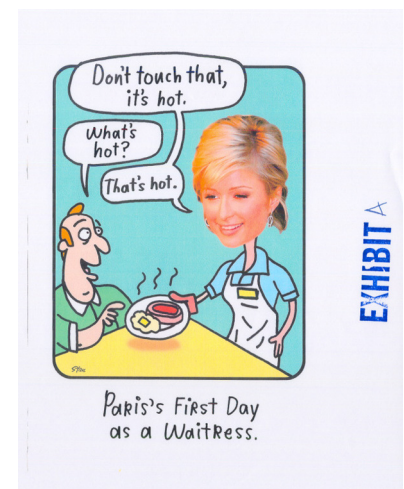
first likeness with new expression, meaning, or message, the depiction is protected by the First Amendment.

Nonetheless, although context may create protected expression in the use of a celebrity's literal likeness, the context in which Activision uses the literal likenesses of No Doubt's members does not qualify the use of the likenesses for First Amendment protection. Activision contends that as in *Kirby*, where Sega used Kirby's likeness in a unique and expressive video game, Activision's use of No Doubt's likenesses in *Band Hero* is transformative because the video game shows the No Doubt avatars "surrounded by unique, creative elements, including in fanciful venues such as outer space . . . and performing songs that No Doubt avowedly would never perform in real life." Indeed, according to Activision, No Doubt's objection that the band can be made to perform songs it would never perform demonstrates that the use of the No Doubt avatars is transformative.

However, that the members of No Doubt object to being shown performing certain songs is irrelevant to whether that element of *Band Hero* combined with others transforms the literal depictions of No Doubt's members into expression that is more Activision's than pure mimicry. In that inquiry, it is the differences between *Kirby* and the instant case, not the similarities, which are determinative. In *Kirby*, the pop singer was portrayed as an entirely new character—the space-age news reporter Ulala. In *Band Hero*, by contrast, no matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame. Moreover, the avatars perform those songs as literal recreations of the band members. That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a video game that contains many other creative elements, does not transform the avatars into anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities. *Hilton v. Hallmark Cards* [Hallmark card featuring Paris Hilton's head on a cartoon waitress's body was not a "transformative use" as in *Kirby* because, despite some differences, the "basic setting" was the same as an episode of Hilton's television show in which she is depicted as "born to privilege, working as a waitress"];<sup>6</sup>

<sup>6</sup> An earlier Ninth Circuit decision, *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), arguably reached a different conclusion on facts somewhat similar to those in *Hilton*. In *Hoffman*, the court found that the First Amendment barred Dustin Hoffman's claim that Los Angeles Magazine had violated his right of publicity when it published an article that included a photographic image of the head of Hoffman in his "Tootsie" character superimposed on the body of a cartoon male who was wearing an evening gown and high heels. The court only briefly ad-

*Hilton*: 599 F.3d 894 (9th Cir. 2010)



Hallmark card from *Hilton*



L.A. Magazine article from *Hoffman*

Moreover, Activision's use of lifelike depictions of No Doubt performing songs is motivated by the commercial interest in using the band's fame to market *Band Hero*, because it encourages the band's sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt. Thus, insofar as the depiction of No Doubt is concerned, the graphics and other background content of the game are secondary, and the expressive elements of the game remain manifestly subordinated to the overall goal of creating a conventional portrait of No Doubt so as to commercially exploit its fame. In other words, nothing in the creative elements of *Band Hero* elevates the depictions of No Doubt to something more than "conventional, more or less fungible, images" of its members that No Doubt should have the right to control and exploit. Thus, the trial court did not err in denying Activision's motion to strike the right of publicity claim based on Activision's assertion of a First Amendment defense.

#### *B. Unfair Competition Claim*

To state a claim for unfair competition under Business and Professions Code section 17200, a plaintiff must show that members of the public are likely to be deceived" by a particular business practice. No Doubt alleges that Activision violated section 17200 by deceiving the public into believing that No Doubt authorized the use of its name and likeness for the unlocking feature of *Band Hero* and that "No Doubt approves and endorses the appearance of its members individually performing songs that are wholly inappropriate and out of character for No Doubt."

When the challenged use of a trademark appears in an artistic work that implicates First Amendment protections, some courts have concluded that the standard "likelihood of confusion" test under the Lanham Act is inadequate to address First Amendment concerns. The seminal case is *Rogers*, in which the Second Circuit developed an alternative to the "likelihood of confusion" test to be used for titles of artistic works that borrow names protected by trademark.

Activision contends that we should construe section 17200 to incorporate the *Rogers* standard as an element of No Doubt's unfair

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dressed the transformative use defense, finding that "even if we were to consider LAM an 'artist' and the altered 'Tootsie' photograph 'artistic expression' subject to the *Comedy III* decision, there is no question that LAM's publication of the 'Tootsie' photograph contained 'significant transformative elements'" because "Hoffman's body was eliminated and a new, differently clothed body was substituted in its place." In *Hilton*, the Ninth Circuit noted that *Hoffman* had not addressed the transformative use defense in great depth because the Supreme Court decided *Comedy III* only after oral argument in the *Hoffman* case had taken place. Thus, *Hilton* concluded that *Hoffman* was not controlling Ninth Circuit authority on the issue of the transformative use defense. We similarly do not find *Hoffman*'s brief discussion or application of the transformative use defense compelling.



competition claim, because the claim is “substantially congruent” to a trademark infringement claim under the Lanham Act, given that for both the “ultimate test” is whether the public is likely to be deceived or confused by the similarity of the marks.

Even if the *Rogers* “explicitly misleading” test might be applied to some section 17200 claims involving the unauthorized use of a celebrity’s likeness (a conclusion we do not reach),<sup>8</sup> the test does not apply to No Doubt’s section 17200 claim. Activision overlooks the overarching conclusion in *Rogers* that the public interest in avoiding consumer confusion must be balanced against the public interest in free expression. The “explicitly misleading” standard comes into play only after a determination has been made that a challenged use of a trademark is worthy of heightened First Amendment protection.

Here, we have already concluded that Activision’s use of No Doubt’s avatars is not “transformative” because the avatars are simply precise computer-generated reproductions of the band members that do not meld with the other elements of Band Hero to become, in essence, Activision’s own artistic expression. In the case of such a “nontransformative” use of celebrity likenesses, the public interest in avoiding consumer confusion outweighs the public interest in free expression, and it would make little sense to require No Doubt to make the almost impossible showing that Activision’s nontransformative use of the No Doubt avatars was “explicitly misleading.” Of course, to prevail on its section 17200 claim, No Doubt will still have to demonstrate that members of the public are likely to be deceived by Activision’s use of the likenesses.

In sum, the trial court did not err in denying Activision’s motion to strike No Doubt’s section 17200 claim based on Activision’s contention that its challenged use of the No Doubt avatars was not explicitly misleading.

## 7 Problems

### Governator Problem

Does this bobblehead doll violate Arnold Schwarzenegger’s right of publicity? (As a reminder, following his action-movie acting career, Schwarzenegger went into politics and served as Governor of California from 2003 to 2011.)

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<sup>8</sup>Although the “explicitly misleading” requirement of the *Rogers* test makes obvious sense when the title of an artistic work is at issue, and thus conventional “speech” is involved, we question whether it should apply when the actionable wrong is the misappropriation of a celebrity’s likeness in a video game.



### Tony Twist Problem

Anthony Rory Twist was a hockey player who played for the St. Louis Blues and the Quebec Nordiques. He was known as an “enforcer” who would pummel players from the opposing team if they disrespected or acted too aggressively toward his teammates.

Antonio Carlo Twistarelli a/k/a Tony Twist is a villain who appears in thirty-six issues of the Spawn comic book series by Todd McFarlane. MacFarlane has sometimes given away copies of Spawn comic books as promotions at hockey games.

Does Anthony Twist have a right of publicity case against McFarlane?



## B Moral Rights

Moral rights give authors strong and often inalienable rights against uses of their works that could be harmful to their reputations that of-

defend their artistic visions. Moral rights are usually described as a part of copyright. In some respects, so they are. But the underlying theory of moral rights derives more from natural-law considerations about personal dignity than from any utilitarian balancing of incentives.

Some countries have well-developed moral rights traditions. The United States does not. The clearest instantiation of something resembling moral rights is in the federal Visual Artists Rights Act and state analogues.

### Peter Baldwin

#### The Copyright Wars: Three Centuries of Trans-Atlantic Battle (2014)

The laws governing how artists, writers, musicians, choreographers, directors, and other authors relate to their works are usually called "copyright." But this one word covers two very different approaches. The very terms used to designate the European "authors' rights" alternative – *Urheberrecht* in German and *droit d'auteur* in French – voice a more encompassing approach.

Seen historically over its long development, copyright has focused on the audience and its hopes for an expansive public domain. Authors' rights, in contrast, have targeted creators and their claims to ensure the authenticity of their works. For its detractors, copyright is philistine and commercial, treating noble creation as a mere commodity. It regards the creator as an entrepreneur and the work as a product. The authors' rights tradition, in turn, valiantly protects the creators vision from commercialization and exploitation.

Authors' rights derive from natural rights. The Continental approach defends creators and their work. In a sense, it seeks no other interest – public or otherwise. Authors' rights, says a distinguished French jurist, seek to protect the author, not society. Because it sets the author before all, writes a French law professor, balancing interests, on the model of the copyright system, is foreign to the French tradition. The author, in the words of a standard French legal textbook, "owes society nothing. He has no more obligations in this respect than the mason who builds or the farmer who ploughs. Quite the contrary, society owes him."

### Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*

38 Vand. L. Rev. 1 (1985)

The moral right doctrine generally is said to encompass three major components: the right of disclosure, the right of paternity, and the right of integrity. Some formulations of the moral right doctrine also include the right of withdrawal, the right to prevent excessive criticism, and the right to prevent assaults upon one's personality. For purposes of illustration, these components will be explored briefly in

the context of the following hypothetical. A playwright, enthralled with the idea of writing a piece poking fun at the evangelical segment of society, suddenly envisions a story line through which she can communicate her ideas. In one day she outlines the plot and sketches some dialogue so that she will have a rough draft which she can develop further when inspiration strikes again. At this point, the playwright's interest in her work would be protected by an aspect of the moral right doctrine known as the right of disclosure or divulgation. Underlying this component of the moral right is the idea that the creator, as the sole judge of when a work is ready for public dissemination, is the only one who can possess any rights in an uncompleted work. Prior to the time the playwright places her work into circulation, therefore, she retains the same right to determine both the form of her play before it is distributed and the timing of public circulation.

Suppose that a few days after the playwright had finished her rough draft, she entered into an agreement with a publisher in which she promised to produce the final publication version of the play within six months. Subsequently, a personal crisis in the playwright's life triggers a deep sense of religious conviction and she no longer wishes to finish the play. In these circumstances her refusal to complete the play would be supported by her right to refuse to disclose, a corollary to the right of disclosure. Application of this right would preclude a judgment ordering the playwright to complete the play, although a court might award the publisher damages for breach of contract.

Some scholars believe that a second component of the moral right doctrine, known as the right of withdrawal, would allow the play in our hypothetical situation to recall all existing copies of her work if, following actual publication, she experienced a radical change of the convictions that originally provided the impetus for the play. Other commentators, however, have expressed doubts regarding the viability of the moral right of withdrawal because of the practical inconsistency in assuming that the public will forget works to which it has already been exposed.

To continue the illustration, now assume that the playwright completes her work and subsequently visits a publisher with her manuscript in hand and offers it to the publisher for \$1500. The publisher conditionally agrees to this arrangement, providing the playwright makes certain revisions. When the playwright tenders the revised manuscript to the publisher, the publisher refuses to publish it with the playwright's name, notwithstanding the appearance of the playwright's name on the original manuscript. In these circumstances the playwright would be protected by another component of the moral right, the right of paternity. As its name suggests, the right of paternity safeguards a creator's right to compel recognition for his

work and prevents others from naming anyone else as the creator. Therefore, the playwright would be able to force publication of the work under her name. Additionally, the right of paternity protects a creator in the event that someone falsely attributes to him a work that is not his creation.

Two other aspects of the moral right doctrine are the creator's right to prevent excessive criticism and the creator's right to relief from other assaults on his personality. To appreciate fully the theoretical basis for these two rights, one must recall that the moral right doctrine safeguards rights of personality rather than pecuniary rights. The creator projects his personality into his work, and thus is entitled to be free from vexatious or malicious criticism and from unwanted assaults upon his honor and professional standing. By virtue of the prohibition against attacks on the creator's personality, the creator also is protected against misuse of his name and work. In the context of our hypothetical situation, such misuse would occur if an antireligious organization claimed that the playwright subscribed to antireligious views solely by virtue of her authorship of the play.

In the hypothetical situation, now suppose the playwright enters into an agreement with a movie producer authorizing the producer to write a screenplay based upon her play. The final version of the screenplay, however, distorts considerably the playwright's theme and mutilates her story line. The component of the moral right doctrine that would grant relief to the playwright in this situation is called the right of integrity. This right lies at the heart of the moral right doctrine. In our hypothetical case the adaptation process naturally would require certain modifications in the playwright's manuscript, but the right of integrity prevents those who make such alterations from destroying the spirit and character of the author's work. Although adaptations of a work from one medium to another present the most obvious potential for violations of a creator's right of integrity, in reality, any modification of a work can be problematic from an integrity standpoint. Any distortion that misrepresents an artist's expression constitutes a violation of the creator's right of integrity.

There is, however, one rather incongruous aspect of the right of integrity. If the artist in our hypothetical situation was a painter rather than a playwright, the right of integrity probably would not allow her to prevent the destruction of one of her paintings by its owner. Perhaps the underlying rationale for this exception is that a work which has been destroyed completely cannot reflect adversely upon the creator's honor or reputation. Nevertheless, some commentators have criticized the destruction exception on the ground that it negates the creator's right of paternity and frustrates the public's interest in enjoying the artist's work.

All nations that have adopted the moral right doctrine statutorily

include at least some of the above protections, but the contours of the doctrine vary among the adhering countries.

### **Berne Convention for the Protection of Literary and Artistic Works (1979)**

- (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.
- (2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed.

**Art. 6bis**  
**Moral Rights**

### **Copyright Act**

- (a) *Rights of Attribution and Integrity.* – Subject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—
  - (1) shall have the right—
    - (A) to claim authorship of that work, and
    - (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;
  - (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and
  - (3) subject to the limitations set forth in section 113 (d), shall have the right—
    - (A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and
    - (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right. ...
- (c) *Exceptions.* –

**17 U.S.C. § 106A**  
**Rights of certain authors to attribution  
and integrity**

- (1) The modification of a work of visual art which is a result of the passage of time or the inherent nature of the materials is not a distortion, mutilation, or other modification described in subsection (a)(3)(A).
- (2) The modification of a work of visual art which is the result of conservation, or of the public presentation, including lighting and placement, of the work is not a destruction, distortion, mutilation, or other modification described in subsection (a)(3) unless the modification is caused by gross negligence.
- (3) The rights described in paragraphs (1) and (2) of subsection (a) shall not apply to any reproduction, depiction, portrayal, or other use of a work in, upon, or in any connection with any item described in subparagraph (A) or (B) of the definition of “work of visual art” in section 101, and any such reproduction, depiction, portrayal, or other use of a work is not a destruction, distortion, mutilation, or other modification described in paragraph (3) of subsection (a).  
...

(e) *Transfer and Waiver.* –

- (1) The rights conferred by subsection (a) may not be transferred, but those rights may be waived if the author expressly agrees to such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver. ...
- (2) Ownership of the rights conferred by subsection (a) with respect to a work of visual art is distinct from ownership of any copy of that work, or of a copyright or any exclusive right under a copyright in that work. Transfer of ownership of any copy of a work of visual art, or of a copyright or any exclusive right under a copyright, shall not constitute a waiver of the rights conferred by subsection (a).

17 U.S.C. § 101  
*Definitions*

A “work of visual art” is—

- (1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or
- (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or



in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include—

- (A) (i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;
- (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;
- (iii) any portion or part of any item described in clause (i) or (ii);
- (B) any work made for hire; or
- (C) any work not subject to copyright protection under this title.

## 1 Integrity

Start with the right of integrity. VARA protects it explicitly, copyright law implicitly.

### **Massachusetts Museum of Contemporary Art Foundation v. Büchel** 593 F.3d 38 (1st Cir. 2010)

Artist Christoph Büchel conceived of an ambitious, football-field-sized art installation entitled “Training Ground for Democracy,” which was to be exhibited at the Massachusetts Museum of Contemporary Art (“MASS MoCA”). Unfortunately, the parties never memorialized the terms of their relationship or their understanding of the intellectual property issues involved in the installation in a written agreement. Even more unfortunately, the project was never completed. Numerous conflicts and a steadily deteriorating relationship between the artist and the Museum prevented the completion of “Training Ground for Democracy” in its final form.

#### I.

MASS MoCA opened in 1999 as a center for the creation and display of contemporary art. The Museum “seeks to catalyze and support the creation of new art, expose [its] visitors to bold visual and performing art in all stages of production, and re-invigorate the life of a region in socioeconomic need.” In its expansive facility in North Adams, Massachusetts, the Museum strives to “make the whole cloth of art making, presentation and public participation a seamless continuum.” Over the last decade, the Museum has hosted the produc-

tion and presentation of over sixty exhibits of visual art, including over 600 works of art by more than 250 individual artists. Some of these works have been displayed in Building 5, the Museum's signature exhibition space, which spans the length of a football field.

Christoph Büchel is a Swiss visual artist who lives and works in Basel, Switzerland. He is known for building elaborate, politically provocative environments for viewers to wander, and sometimes to crawl, through. One critic has stated that "Mr. Büchel's environments are huge in scale," "like bristling three-dimensional history paintings," yet are "so obsessively detailed that they might best be described as panoramic collage."

Büchel proposed, and the Museum agreed to, a project entitled "Training Ground for Democracy." Büchel conceived of the exhibit as "essentially a village, ... contain[ing] several major architectural and structural elements integrated into a whole, through which a visitor could walk (and climb)." According to an affidavit submitted to the district court, Büchel envisioned the work in the following way:

It was to adopt the role-play of U.S. military training for its visitors, who would be given the opportunity to "virtually" change their own various identities in relation to the collective project called "democracy": training to be an immigrant, training to vote, protest, and revolt, training to loot, training iconoclasm, training to join a political rally, training to be the objects of propaganda, training to be interrogated and detained and to be tried or to judge, training to reconstruct a disaster, training to be in conditions of suspended law, and training various other social and political behavior. In August 2006, Büchel spent ten days in residence at MASS MoCA. During this time, he and a partner prepared a basic schematic model of the proposed installation. MASS MoCA agreed to acquire, at Büchel's direction but its own expense, the materials and items necessary for the project.

Unfortunately, the parties never formalized the contours of their relationship or firmly established the project's financial scope and precise specifications by executing any written instrument. The parties set an opening date of December 16, 2006 for the exhibit.

Over the course of the fall, tensions began to develop between the artist and MASS MoCA employees, particularly Joseph Thompson. The museum felt the artist's directions were vague, and his financial and logistical demands were increasingly unreasonable; the artist felt the museum was compromising his artistic integrity and failing to follow his instructions. One frequent source of conflict between the parties was the budget, with the Museum understandably

concerned about keeping its costs for the massive project under control, and Büchel understandably insistent that his vision for "Training Ground" be fully realized.

For our purposes, the key conflict between MASS MoCA and the artist involved Büchel's dissatisfaction with the way in which the Museum was implementing his instructions and procuring the items necessary for the installation. At various points in the development of the installation, Büchel proposed several major components, some but not all of which later became part of the installation "as its elements evolved through discussions with MASS MoCA during the construction process. These major components included a movie theater, a house, a bar, a mobile home, various sea containers, a bomb carousel, and an aircraft fuselage. The Museum had begun seeking out some of these materials and others for potential use in the installation as soon as Büchel left North Adams at the end of August 2006, and continued to do so throughout the fall. One of the Museum's curators described the search for these items (at Büchel's direction) as "the ultimate scavenger hunt." However, problems soon arose, especially between Thompson and Büchel, as to the progress of the project, particularly when, as Thompson explained in an internal Museum email dated October 28, 2006, he had tried to "move the project along" by "making a few decisions in [Büchel's] stead." Thompson noted that Büchel, whom he described as having "clear vision" and "rock solid integrity," had taken "extreme, mortal[] offense" to Thompson's efforts.

Büchel remained onsite at the Museum working on "Training Ground" until December 17, 2006, when he left for the holidays. In Büchel's estimation, "Training Ground" was then only about 40% complete. At the time, he planned to return on January 8, 2007, in order to finish the work in time for a March 3 opening. Meanwhile, the Museum was running out of money for the project. In Büchel's absence, MASS MoCA staff continued to work on the installation. The parties disagree as to whether the employees were merely executing instructions left by the artist or whether their actions represented independent artistic judgment, exercised in direct contravention of Büchel's express wishes.

As the vitriolic exchanges between the parties continued, and negotiations over the project's eventual completion became hopeless, "Training Ground" languished in its unfinished state. It became clear that Büchel would not complete the installation. On May 22, 2007, MASS MoCA announced the cancellation of "Training Ground," and contemporaneously publicized the opening of a new exhibit entitled "Made at MASS MoCA," which was to be "a documentary project exploring the issues raised in the course of complex collaborative projects between artists and institutions." The press release noted



Installation of "Training Ground for Democracy" at MASS MoCA in 2006



Christoph Buchel, "Training Ground for Democracy", installation at Art Basel Miami Beach, 2007

that this lawsuit had been filed the previous day; it also highlighted the Museum's desire to use its "other experiences working with artists" to "provide [its] audience with thought-provoking insights into the complexities of the art-making process." The release further explained that, due to "space constraints imposed by the materials assembled for Training Ground for Democracy," the exhibition would be presented in the Museum's "only remaining available gallery space"; therefore, in order to enter the exhibit, visitors would have to pass through Building 5, "housing the materials and unfinished fabrications that were to have comprised elements of Training Ground for Democracy." The Museum represented that "[r]easonable steps [had] been taken to control and restrict the view of these materials, pending a court ruling."

When "Made at MASS MoCA" opened, many in the art world disagreed with the Museum's handling of its dispute with Büchel, though the parties have different views on whether the Museum's actions ultimately tarnished the artist's reputation. Moreover, the parties differ on whether the "reasonable steps ... taken to control and restrict the view of the[] materials" — the placement of yellow tarpaulins over the unfinished work — actually concealed all of the individual components and vital design elements of "Training Ground," or whether the tarpaulins simply "hid[] an elephant behind a napkin," effectively inviting individuals to peek behind the cloth coverings and view the unfinished work. See Charles Giuliano, Christoph Büchel's Tarp Art at Mass MoCA: Crap Under Wrap (July 31,

The Museum sued Büchel on May 21, 2007, in the United States District Court for the District of Massachusetts. The complaint asserted a single claim for declaratory relief under VARA. The Museum sought a declaration that it was "entitled to present to the public the materials and partial constructions assembled in connection with an exhibit planned with the Swiss artist Büchel." Büchel responded by asserting five counterclaims against the Museum. The first sought a declaratory judgment and an injunction under VARA prohibiting the Museum from publicly displaying "the unfinished Work of Art or any of its component elements." The second sought damages for MASS MoCA's alleged violations of Büchel's VARA rights by "intentionally distort[ing] and modif[y]ing the Work of Art" and allowing members of the public to "see and pass through" the unfinished work, both with and without the yellow tarpaulins. The third, fourth and fifth counterclaims sought damages and injunctive relief under the Copyright Act based on alleged violations of Büchel's right to publicly display and create derivative works from his work.

The district court ruled in favor of the Museum, noting that nothing in VARA prevented MASS MoCA from showing the incomplete

project. Therefore, MASS MoCA was “entitled to present” the unfinished installation to the public as long as it posted a disclaimer that would “inform anyone viewing the exhibit that the materials assembled in Building 5 constitute an unfinished project that [did] not carry out the installation’s original intent.” The court correspondingly denied the artist’s request for injunctive relief barring public display of the unfinished installation, ruling that he had failed to prove a likelihood of success on the merits of his VARA claim.

However, several days after obtaining the ruling in its favor, MASS MoCA changed course. The Museum posted an announcement on its website stating that it had “begun removing materials gathered for Training Ground for Democracy and [would] not permit the public to enter the planned installation.”

## II.

Büchel argues that VARA applies with equal force to incomplete artistic endeavors that would otherwise be subject to VARA protection. The text of VARA itself does not state when an artistic project becomes a work of visual art subject to its protections. However, VARA is part of the Copyright Act. Not surprisingly, based on section 101’s general definitions, courts have held that the Copyright Act’s protections extend to unfinished works. Reading VARA in accordance with the definitions in section 101, it too must be read to protect unfinished, but “fixed,” works of art that, if completed, would qualify for protection under the statute.

## III.

The right of attribution under VARA gives an artist a claim for injunctive relief to, *inter alia*, assert or disclaim authorship of a work. We agree that VARA does not provide a damages remedy for an attribution violation. Where the statutory language is framed as a right “to prevent” conduct, it does not necessarily follow that a plaintiff is entitled to damages once the conduct occurs. The question is whether “doing” the act the artist has a right to prevent also triggers a damages remedy, and the statutory language indicates that Congress answered that question for the attribution right differently from the integrity right.

By dismantling “Training Ground,” the Museum prevented the further use of Büchel’s name in connection with the work, eliminating any basis for injunctive relief, and we therefore do not address the attribution claim in our VARA analysis.

Büchel alleges that MASS MoCA violated his right to integrity in three distinct ways: first, by continuing to work on the installation without his authorization, particularly in early 2007, and by then exhibiting the distorted artwork to the public; second, by using

Did MASS MoCA violate Büchel's VARA right against destruction in § 106A(a)(3)(B)?

tarpaulins to “partially cover” – and thus modify and distort – the installation, and allowing Museum visitors to see it in that condition; and third, merely by showing Büchel’s work in its unfinished state, which he claims was a distortion. Büchel asserts that these actions caused prejudice to his honor or reputation.

As we shall explain, we conclude that summary judgment was improperly granted to MASS MoCA because material disputes of fact exist concerning the first of Büchel’s integrity claims – i.e., that MASS MoCA modified “Training Ground” over his objections, to his detriment. We further conclude that the record contains sufficient evidence to allow a jury to find that MASS MoCA’s actions caused prejudice to Büchel’s honor or reputation. The other integrity claims, however, are unavailing.

### *1. Continuing Work on “Training Ground”*

Büchel asserts that, in the months following his departure from North Adams in December 2006, the Museum encroached on his artistic vision by making modifications to the installation that in some instances were directly contrary to his instructions. In rejecting Büchel’s VARA claims, the district court described the Museum’s actions as perhaps “occasionally misguided” attempts “to implement Büchel’s long-distance instructions.” The court found that these “[f]umbled efforts to assist in creating, or failing to create, a work of art are not equivalent to distortion, modification, or mutilation of the art.”

Although a jury might agree with the court’s assessment, the evidence viewed in the light most favorable to Büchel would allow a finding that at least some of the Museum’s actions violated VARA. The record permits the inference that, even during his time as an artist-in-residence at MASS MoCA, Museum staff members were disregarding his instructions and intentionally modifying “Training Ground” in a manner that he did not approve.

Both in his deposition and in his affidavit, Büchel described ways in which he felt the Museum had knowingly disregarded his specific instructions. For example, MASS MoCA’s decision to build a cinderblock wall through the Cape Codstyle house in the installation, despite Büchel’s expressed desire that the construction await his return, resulted in what Büchel considered a “big distortion of the meaning of that element.” The record is replete with similar allegations concerning other components of the installation, including the cinema, the bomb carousel, the Saddam spiderhole, the police car and the mobile home. Indeed, even the Museum, in its August 31, 2007 memorandum of law in support of its motion for summary judgment, admitted that the installation “[m]aterials as they now stand reflect significant aesthetic and design choices by MASS MoCA per-

sonnel, including with respect to the layout of the [m]aterials, and with respect to the selection and procurement of pre-existing buildings and vehicles that have been modified and incorporated into the [m]aterials.”

The record also contains evidence from which a jury could conclude that the Museum’s alterations had a detrimental impact on Büchel’s honor or reputation. An article in the Boston Globe reported that, in February, Museum officials had shown the unfinished project to a group of Museum directors and curators who were attending an arts conference in the area. Although the commentary generated by these visits is not all negative, there was sufficient evidence for a jury to find that the changes to “Training Ground” caused prejudice to Büchel. The New York Times noted that the exhibition would “certainly give people unfamiliar with his obsessive, history-driven aesthetic an inaccurate sense of his art, and this is indeed a form of damage.” A critic for the Boston Globe similarly observed that “many people are going to judge Büchel and his work on the basis of this experience.” A review published in Berkshire Fine Arts – subtitled “Crap Under Wrap” – concluded that it would be a “huge mistake” to uncover the installation, which offered “virtually nothing of substance or interest.”

In concluding that Büchel has adduced sufficient evidence to support a right-of-integrity claim, we reject the Museum’s assertion that to find a violation of Büchel’s right of integrity in these circumstances would make it impossible for parties to collaborate on large-scale artistic works. The Museum warns that, under Büchel’s interpretation, “no one other than the artist himself ... may ever perform any work in fabricating visual art unless that specific task has been authorized by the artist.” We disagree. Although the artist’s vision must govern, that principle does not prevent collaboration at the implementation level so long as the artist’s vision guides that implementation. Here, Büchel alleges a campaign of intentional distortion and modification to his work in which Museum personnel repeatedly ignored his express wishes. Our holding that the summary judgment record precludes an affirmance of the district court on this claim may serve as a cautionary tale to museums contemplating similar installations in the future — guiding them to document the terms of their relationship and obtain VARA waivers where necessary — but it does not prevent museums or other collaborators from working cooperatively with artists on such non-traditional artworks.

## *2. Showing “Training Ground” Covered with Tarpaulins*

Büchel also claims that MASS MoCA improperly modified and distorted “Training Ground” when it partially covered it with the yellow tarpaulins and displayed it in that condition. He asserts that

the record shows beyond dispute that visitors looked behind the tarps, that the tarp-adorned installation was “judged by others to be Büchel’s work, and that his honor and reputation were harmed by it.” In response, the Museum argues that the yellow tarpaulins were merely functional – a way of keeping people “out” of the installation – rather than an aesthetic modification of the artwork that gave MASS MoCA patrons a distorted view of it.

Although the tarpaulins did prevent visitors to the Museum from seeing the entire unfinished installation, the record shows that a number of people were able to form an impression of “Training Ground” despite the partial covering. For example, according to one observer,

[the tarps] don’t reach the floor, and they rise only about two feet above eye level, so they don’t cover much. You can easily crouch down to slip your head underneath or peek through the slits between the vinyl sheets. Beyond the passageway formed by the tarps, the monumental elements of the installation rise all around you, plain as day – the cinderblock walls, the two-story house, the guard tower, the trailers, the carnival ride, all compacted together in a claustrophobic, politically surreal borough of hell, George Orwell by way of David Lynch.

Thomas Micchelli, Christoph Büchel Training Ground for Democracy, The Brooklyn Rail (September 2007). Another critic noted that the installation “under all the tarps is really kind of a conceptual peep show. It doesn’t take much effort or imagination to see most of the work... Mass MoCA is hiding an elephant behind a napkin,” and called it a “wink, wink, wrap show.” Photographs in the record confirm that the covers did not obscure the general path and layout of the installation. Indeed, given the location of “Training Ground,” visitors to “Made at MASS MoCA” could not avoid seeing the unfinished “Training Ground” bedecked in tarpaulins.

Nonetheless, although the installation unquestionably looked different with the tarpaulins partially covering it, we agree with the district court that the mere covering of the artwork by the Museum, its host, cannot reasonably be deemed an intentional act of distortion or modification of Büchel’s creation. To conclude otherwise would be to say that, even if all had gone well, the Museum would have been subject to a right-of-integrity claim if it had partially covered the work before its formal opening to prevent visitors from seeing it prematurely.

This is not to say that MASS MoCA was necessarily acting with pure intentions when it created “Made at MASS MoCA” in close proximity to the tarped “Training Ground.” It might be a fair inference that the Museum was deliberately communicating its anger with



Büchel by juxtaposing his unfinished work with the successful artistic collaborations depicted in its new exhibition. The partial covering of "Training Ground" may have been intended to highlight, rather than hide, the failed collaboration. The right of integrity under VARA, however, protects the artist from distortions of his work, not from disparaging commentary about his behavior.

### 3. Exhibiting "Training Ground" in Its Unfinished State

Büchel maintains that, even aside from the alleged modifications to "Training Ground," merely exhibiting the work of art in its unfinished state, without the artist's consent, constitutes a distortion. We reject this claim. A separate moral right of disclosure (also known as the right of divulgation) protects an author's authority to "prevent third parties from disclosing [his or her] work to the public without the author's consent," and is not covered by VARA.

Although Büchel proffered an expert who opined that showing an unfinished work without the artist's permission is inherently a distortion, we decline to interpret VARA to include such a claim where a separate moral right of disclosure is widely recognized in other jurisdictions and Congress explicitly limited the statute's coverage to the rights of attribution and integrity. Any right Büchel possesses to withhold display of his artwork must be found outside VARA.

## IV.

We now assess Büchel's challenge to the grant of summary judgment for MASS MoCA on his Copyright Act claims. Büchel's undeveloped argument [that Mass MoCA violated the derivative works right] is so perfunctory that we deem the claim waived. [But his public display claim survived summary judgment.] The record reveals disputed issues of fact with respect to whether the Museum's copy was "lawfully made," as it may have been created in violation of the artist's rights under VARA. Moreover, Büchel introduced evidence to rebut the Museum's assertion that "the installation's various components" all belonged to, or were purchased by, MASS MoCA. Finally, Büchel presented evidence that the Museum understood that the physical copy of the installation belonged to him.

### **Phillips v. Pembroke Real Estate, Inc.**

443 Mass. 110 (2004)

David Phillips is a sculptor who has gained national recognition for his site-specific artwork. In 1999, Pembroke Real Estate, Inc. commissioned Phillips to work on Eastport Park, a public green space in the South Boston waterfront section of Boston. Phillips created approximately twenty-seven sculptures for the park, including abstract bronze and granite works and a dozen realistic bronze sculptures of



David Phillips installation in Eastport Park

hermit crabs, shrimp, and frogs. Phillips was responsible for the design and installation of rough stone walls, split granite paving stones, and other landscape design elements. Most of Phillips's sculpture and landscape elements are organized along a diagonal sight line, or axis, passing through the park, and are unified by a theme of spiral and circular forms. At the center of the axis is a large spherical sculpture entitled "Chords."

Soon after the park was completed in the spring of 2000, Pembroke determined that it was in need of alteration. A redesign scheme was prepared by British landscape architect Elizabeth Banks. It called for the removal and relocation of Phillips's sculptures. Phillips protested and, in January, 2003, Pembroke agreed to retain all but one of Phillips's sculptures. Phillips objected to Pembroke's revised plan and subsequently filed suit in the United States District Court for the District of Massachusetts, seeking injunctive relief under the Federal Visual Artists Rights Act and MAPA.

On August 21, 2003, at the conclusion of a nonevidentiary hearing, the United States District Court judge issued a temporary restraining order enjoining Pembroke from altering the park. Subsequently, Pembroke announced its intention to return to the original redesign scheme, which called for the removal of all of Phillips's sculptures. After a two-day evidentiary hearing, the United States District Court judge issued a memorandum and order in which she found "that the environment of Phillips' integrated sculpture along the axis of the Park is a critical element of those works, and changing the location of the sculpture constitutes an alteration" under MAPA. Accordingly, she ordered that Pembroke "not alter, destroy, move or remove any of the sculptures along the northeast-southwest axis of the Park until the conclusion of this litigation or further order of the Court. With respect to the other sculptures, Defendant may move the sculptures but shall not destroy or alter them."

Both parties filed interlocutory appeals with the United States Court of Appeals for the First Circuit pursuant to 28 U.S.C. § 1292(a)(1) (2000). In the interim, the District Court judge certified the present question:

"Under the facts and circumstances described in the District Court's October 24, 2003 Memorandum and Order, to what extent does the Massachusetts Art Preservation Act protect the placement of 'site specific' art?"

The term "site-specific" art does not appear in any applicable Massachusetts statute. It is a term that has been defined in the art world as art "[that] is conceived and created in relation to the particular conditions of a specific site." *Serra v. United States Gen. Servs. Admin.* (quoting sculptor Richard Serra). It has also been described as

Mass. Gen. Laws ch. 231, § 85S (1984)

*Serra*: 847 F.2d 1045 (2d Cir. 1988)

"a combination of readymade work and a crafted work: the site is the readymade work, from which the artist draws her inspiration, and upon which the artist adds a crafted material. Together, the readymade and the crafted material exist as the artwork." Garson, *Before That Artist Came Along, It Was Just a Bridge: The Visual Artists Rights Act and the Removal of Site-Specific Artwork*, 11 CORNELL J.L. & PUB. POL'Y 203, 230 (2001). The term "site-specific" is also admittedly a sort of catchall phrase for a variety of artworks that elevate, in varying degrees, the importance of the relationship between context and object. In some works of site-specific art, the landscape provides the context necessary to give full meaning to otherwise free-standing crafted objects. In other works, such as "earthworks," the artwork is completely inextricable from its site because it is literally made from and imbedded in nature." The facts of this case present the former and not the latter type of site-specific art.

After considering all the language used in MAPA, construed as a whole, consistent with what we can glean of the Legislature's intentions in its enactment, we answer the question as follows: MAPA does not protect the placement of the type of site-specific art at issue here. Although it prohibits the physical destruction of the crafted components of such art, MAPA does not protect it against the conceptual destruction or decontextualization that may result from the removal of those components from the physical environment in which they have been placed. If the crafted components of site-specific art can be extracted from their surroundings without physical damage to them, the statute is not violated by their removal.

MAPA followed the lead of similar legislation in California and New York in attempting to graft onto a generally inhospitable common law tradition the civil law concept of *droit moral*, whereby a creative artist retains certain inalienable rights with respect to his or her creation before and after publication, display or sale. To accomplish its ends, MAPA protects both an artist's "right of integrity" (an artist's right not to have his or her creations altered), and an artist's "right of paternity" (an artist's right to claim or disclaim authorship of a work of art). The rights of integrity and paternity continue for fifty years after the artist's death and are enforceable by the artist or by his duly authorized representative by an action in the Superior Court.

It is apparent that in drafting the statute, the Legislature was concerned not only with creating new rights for artists, but also with protecting the rights of property owners who commission artworks that become attached to real property. This concern manifests itself in the way § 85S (h) of MAPA addresses "fine art" attached to buildings. If the art can be removed from the building without causing "substantial harm" to the art, the building owner may remove the art after giving the artist notice and ninety days to reclaim and remove it

himself (at his own expense). If the artwork cannot be removed from the building without causing the "substantial physical defacement, mutilation, alteration, or destruction" of the art, the owner may proceed to remove it unless the artist has expressly reserved his rights under the statute "by an instrument in writing signed by the owner of such building and properly recorded, prior to the installation of such art"

This provision serves two purposes. First, it ensures that the owner of a building will be able to remove unwanted art from his property even if the removal would cause physical damage to the art in ways otherwise prohibited by MAPA (unless the property owner has signed a written instrument reserving the artist's rights). Thus, it prevents the artist from holding the building hostage to the artworks. Second, by requiring that any enforceable reservation of rights be "properly recorded," the statute protects the integrity of the real property conveyancing system and guards against the establishment of unnoticed, undetectable, and indeterminate encumbrances.

If the Legislature intended to include the type of site-specific art at issue here within MAPA's protections, it would entail a radical consequence for owners of land, that the Legislature directly averted for owners of buildings. Specifically, rights afforded artists would encumber private and public land with restrictions lasting for the life of the artist plus fifty years, without the need for such restrictions to be recorded in a registry of deeds. We do not lightly read such an intent into a legislative act given the recognized legislative policy of discouraging land restrictions (especially unrecorded ones), the common-law doctrine disapproving the long-term burdening of property, and the corollary judicial practice of construing statutory provisions regarding land restrictions in favor of freedom of alienation.

The failure of the statute to address specifically the removal of fine art from land suggests that the Legislature either did not intend the statute's protection to extend to the land upon which works of art have been placed, or did not perceive the removal of free-standing works of art from their sites as causing their "physical defacement, mutilation, alteration, or destruction." Either way, there was no need for it to consider the possibility that land might be also "held hostage" to attached artworks. Given the Legislature's evident concern that works of fine art not burden buildings, and that restrictions encumbering buildings be properly recorded, it is apparent to us that if the Legislature had understood that MAPA would have that same encumbering effect on the sites of site-specific art, it would have addressed the subject directly.

This interpretation is also consistent with our view that the statutory protection afforded fine art is protection from physical rather

than conceptual harm. In application, moving Phillips's sculptures will not result in their physical destruction, nor will it cause a physical alteration to the actual sculptures. The harm presented is decontextualization. That this harm is significant to Phillips (and possibly to the public) is not to be understated, but it is not the same harm as the actual physical alteration or physical destruction of the artworks crafted by the artist. The balance struck by the Legislature in 1984 deals only with the latter.

### **Clean Flicks of Colorado, LLC v. Soderbergh**

433 F. Supp. 2d 1236 (D. Colo. 2006)

CleanFlicks is a limited liability company in Utah, owned by Ray and Sharon Lines. It has created and publicly distributed copies of the Studios' movies that it altered by deleting "sex, nudity, profanity and gory violence," using its own guidelines. CleanFlicks began editing movies on VHS videocassettes in June, 2000, added DVDs at some time and now does only DVDs. The deletions are from both audio and visual content of the movies. The editing techniques used include redaction of audio content, replacing the redaction with ambient noise, "blending" of audio and visual content to provide transition of edited scenes, cropping, fogging or the use of a black bar to obscure visual content.

CleanFlicks first obtains an original copy of the movie from its customer or by its own purchase from an authorized retailer. It then makes a digital copy of the entire movie onto the hard drive of a computer, overcoming such technology as a digital content scrambling protection system in the acquired DVD, that is designed to prevent copying. After using software to make the edits, the company downloads from the computer an edited master copy which is then used to create a new recordable DVD-R to be sold to the public, directly or indirectly through a retailer. Thus, the content of the authorized DVD has been changed and the encryption removed. The DVD-R bears the CleanFlicks trademark. CleanFlicks makes direct sales and rentals to consumers online through its web-site requiring the purchaser to buy both the authorized and edited copies. CleanFlicks purchases an authorized copy of each edited copy it rents. CleanFlicks stops selling to any retailer that makes unauthorized copies of an edited movie.

The Studios claim that CleanFlicks is infringing their exclusive right to reproduce the copyrighted works under § 106(1), the Studios' right to create derivative works under § 106(2), and the exclusive right of distribution of copies under § 106(3).

[CleanFlicks argued fair use.]

Under the purpose and character of use factor, the counterclaim defendants concede that their use of the copyrighted works is for commercial gain, but argue, correctly, that under *Campbell*, that fact is not



Sign from CleanFlicks' window

determinative. They seek to establish a public policy test that they are criticizing the objectionable content commonly found in current movies and that they are providing more socially acceptable alternatives to enable families to view the films together, without exposing children to the presumed harmful effects emanating from the objectionable content.

The accused parties make much of their public policy argument and have submitted many communications from viewers expressing their appreciation for the opportunity to view movies in the setting of the family home without concern for any harmful effects on their children. This argument is inconsequential to copyright law and is addressed in the wrong forum. This Court is not free to determine the social value of copyrighted works. What is protected are the creator's rights to protect its creation in the form in which it was created.

At 17 U.S.C. § 110(11)

During the pendency of this case Congress enacted the Family Movie Act of 2005, amending § 110 to provide an exemption for the editing of motion pictures by a member of a private household if no fixed copy of the altered version of the motion picture is created. That statute eliminated from this case those parties selling technology enabling such private editing. The legislative history shows that the amendment was not intended to exempt actions resulting in fixed copies of altered works which the House Committee believed illegal. Thus, the appropriate branch of government had the opportunity to make the policy choice now urged and rejected it.

The primary argument on the fair use defense is the fourth statutory factor. The counterclaim defendants contend that there is no adverse effect from their use of the movies on the value of the copyrighted work to the Studios. They suggest that the Studios benefit because they are selling more copies of their movies as a result of the editing parties' practice of maintaining a one-to-one ratio of the original and edited versions. It is assumed that the consumers of the edited versions would not have themselves purchased the authorized versions because of the objectionable content and the Studios do not compete in this alternative market.

The argument has superficial appeal but it ignores the intrinsic value of the right to control the content of the copyrighted work which is the essence of the law of copyright. Whether these films should be edited in a manner that would make them acceptable to more of the public playing them on DVD in a home environment is more than merely a matter of marketing; it is a question of what audience the copyright owner wants to reach.

**Prepared Statement of Taylor Hackford on Behalf of the Directors  
Guild of America**  
Derivative Rights, Moral Rights, and Movie Filtering Technology, Hearing

Before the Subcommittee on Courts, the Internet, and Intellectual  
Property of the Committee on the Judiciary, House of Representatives  
(May 20, 2004)

Directors put their full vision and often years of hard work into the creation of a film. That film is not only their vision, but it carries their name and reflects on their reputation. Their ability to have their names used to identify and market their films is of great economic consequence. No matter how many warnings or disclaimers someone puts on the film, it still has the director's name on it. So directors have great passion about protecting their work, which is their signature and brand identification, against unauthorized editing, and an abiding belief that contracts and the law will prevent others from illegally profiting from or altering their work.

Because directors and their names are inextricably and prominently linked with the movies they direct, the conduct of companies that sell unauthorized software filters or edited versions of movies is particularly harmful to directors. These companies are undoing, undermining and superseding the artistic work in which a director has invested a great deal of effort, and become closely associated by the public. Removing scenes and dialogue from films interferes with the story a director is trying to tell, and in so doing, can take away from the narrative structure and overall vision that audiences associate with a director. This editing can make movies into nonsense, completely changing their meaning. The director's reputation is likely to suffer when people viewing the film may believe they are watching a version of the film that has been edited and authorized for release by the director.

*Proof of Life*, starring Meg Ryan and Russell Crowe, told the story of an American oil executive who was kidnapped for ransom by insurgents in a fictional South American country. At its core, this movie centered on the kidnapping, the struggles of the kidnapped executive, and the impact of the event on his wife (Ryan) and his would-be rescuer (Crowe).

Despite the utter centrality of the kidnapping to the story, I was amazed to learn that at least one company, without any authorization or contractual right to alter the film, removed the entire kidnapping scene when it created a filter specifically designed to alter the viewing of this film. It is important to note that this scene was shown on television and airline versions virtually in its entirety, with only eleven seconds removed. These types of minor, authorized edits are acceptable, because, as the film's director, I agreed to them for a particular use.

In this case, the company had no authorization from the studio or me, yet they unilaterally removed the entire kidnapping scene and altered my film in a way that was extremely harmful to the basic telling

of the story. It also was harmful to the way viewers perceive me as a director. This unauthorized version may lead viewers to believe Taylor Hackford directs movies that just don't make sense. Let me explain why.

First, the subject of kidnapping for ransom is pivotal to the film, and as the film's director, I went to great lengths to portray it as realistically as possible. In the theatrical, airline, and television version of the film, the audience sees how the abduction was carried out, and witnesses the organizational skill of the abductors and the depth of their cruelty. All of these essential details, and the overall tension and desperation of the scene, have been ripped from the film.

Second, the kidnapping scene, which takes place early in the movie, establishes the foundation for the entire story that follows, and is crucial to the overall dramatic purposes of the film. This scene enables the audience to empathize with an ordinary person, who is driving to work thinking about everyday problems on the job and at home. This "everyman" suddenly is wrenched from his daily life and plunged into a nightmare that he had never imagined possible. Removing this scene in its entirety leaves the audience unable to understand the context and meaning of the story, and renders the audience unable to connect emotionally to the character's plight. In short, removing the early kidnapping scene, from a movie about a kidnapping, changes the basic nature of the movie.

## 2 Attribution

Given *Büchel*, VARA's attribution right isn't much good, is it? And given *Dastar*, trademark law isn't much good for attribution either, is it? But there are a few ways in which the law prioritizes attribution: recall 1202

Unsurprisingly, private parties frequently insist on attribution by contract.

### **Williams v. UMG Recordings, Inc.** 281 F. Supp. 2d 1177 (C.D. Cal. 2003)

Plaintiff Kelvin Williams styles himself as "a talented young film director/writer/editor." Defendant Cash Money is a record label [which has a distribution contract with UMG].

In February of 2000, Plaintiff, Panzer and the Cash Money Defendants collaborated on the production of a documentary. A dispute over Plaintiff's compensation subsequently developed, apparently resulting in bad blood between Plaintiff and Panzer. In the meantime, around March 2000, Plaintiff got involved in another project with Panzer and the Cash Money Defendants involving post-production work on a film entitled "Baller Blockin'."



The parties disagree as to the nature and extent of Plaintiff's involvement in the *Baller Blockin'* project. Plaintiff claims that Defendants contracted with him to restructure the entire film. Plaintiff contends that he re-edited and re-scored the entire film and that it incorporates his copyrighted narration script ("Narration Script"). After *Baller Blockin'* was released, Plaintiff discovered his name was not listed in the film's credits and initiated this lawsuit.

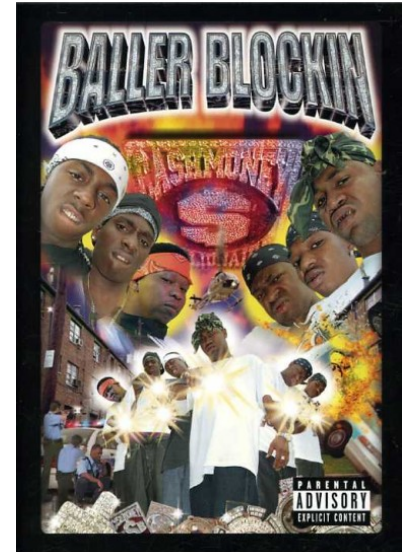
Defendants argue that *Dastar* invalidates Plaintiff's Lanham Act claim. This Court agrees with Defendants. Plaintiff's Lanham Act claim is based on the misattribution of credits for "story/screenplay" and "editing" on the *Baller Blockin'* film. Plaintiff alleges that he should be given credit for "the authoring of the 'Narration Script' . . . , editing film sequences and re-scoring the music." Under *Dastar*, however, the Supreme Court specifically held that the phrase "origin of goods" "refers to the producer of tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods." As such, Plaintiff would have a claim if Defendants purchased copies of Plaintiff's goods (i.e. the film) and repackaged them as their own. By contrast, Plaintiff does not have a claim for his authorship and direction embodied in that film. His claim, therefore, is barred as a matter of law.

Plaintiff then asserts that "[i]f defendants [sic] argument were accepted, a talented director who directs a Summer blockbuster for example can be deprived of the immense value of such a credit in the entertainment industry, simply because the producer decides to name himself as the director .... A reading that the Lanham Act does not protect those people who provide services on films permits a form of anarchy in the entertainment industry, where anybody could be credited for anyone else's work and have their credit obliterated." In Plaintiff's hypothetical, the director has options to protect his interest – obtaining a contractual right to a credit, relying on the regulation of credits in union collective bargaining agreements (e.g., the Directors Guild) or maintaining the copyright in the film. In light of *Dastar*, this hypothetical director cannot bring a claim under the Lanham Act.

**Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution***

95 Geo. L.J. 49 (2006)

Hollywood (both motion picture and television production) has a highly formal attribution system that is thoroughly infused with legally enforceable rules for granting screen credit. Elaborate rules govern whose name will appear and whose will not, who can be listed under which job title (director, screenplay by, key grip, etc.), and the order and size of the print in which names are listed. The



*Baller Blockin'* poster

credit rules are the subject of negotiations between the guilds representing various workers and the production companies, but currently the administration of credit is left entirely to the guilds representing each of the forms of talent. One of the most important things that Hollywood guilds do is to administer the credit system.

The Writers Guild of America (WGA), the union representing 12,000 writers, administers the credit system for screenwriters. The collective bargaining agreement between the WGA and the Alliance of Motion Picture & Television Producers states that “credits for screen authorship shall be given only pursuant to the terms of and in the manner prescribed in” the Theatrical Schedule A, a thirty page addendum to the Basic Agreement. Theatrical Schedule A specifies the criteria for screen credit. Disputes over credit are resolved pursuant to the WGA Credits Manual, which is not part of Theatrical Schedule A but is approved by the WGA’s board of directors and by a vote of the WGA membership. The WGA has a committee that decides which names to submit to the studios to list as screenwriters. Theatrical Schedule A limits screen credit to no more than two writers “except that in unusual cases, and solely as a result of arbitration,” three writers or “two writing teams” (each of which can be no more than two writers) may be credited. It also states, however, that the writers may agree among themselves as to screen credit if they agree unanimously and so long as the number of credited writers and the form of credit are consistent with Theatrical Schedule A. Writers who disagree with the Guild’s determination can seek arbitration. In 2002, 67 of 210 feature film writing credits were arbitrated.

Notwithstanding the formality and legally enforceable nature of screen credit rights, informal norms also play a significant role. Producer credits, one of the most important on a movie, are not governed by collective bargaining agreements because the studios do not recognize the Producers Guild as a union. Therefore, some (including a producer of the 2006 Academy Award winning movie *Crash*) complain that producer screen credits are accorded by the Producers Guild unfairly. Because the guild agreements limit the number of people who can be credited in some roles on any one film, power relations among various possible contenders for credit affect who is listed. Individual workers with significant bargaining power (actors, directors, writers, and producers) negotiate for specific treatment on each project, which may or may not reflect the same level of artistic contribution as compared to others who receive a similar type of credit on a different film or who receive the same credit (or no credit) on the same film.

Other contributors to a project (lawyers, caterers, and animal trainers) may be credited even though they are not subject to guild agreements providing for credit. They may negotiate for credit in

the contract in which they agree to work on the project, or they may be given credit at the whim of the producer or director as a form of thanks. There are significant differences in the processes of credit attribution for star actors, directors, producers, and writers than for the best boys, grips, set painters, and still another set of norms governing credit for caterers, assistants, lawyers, and accountants.

## C People as Trademarks

Trademark law has a few rules that explicitly apply to names and other attributes of personal identity. Are these special rules for special subject matter, or just the predictable application of trademark's usual principles?

### Lanham Act

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

- (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
- (e) Consists of a mark which ... (4) is primarily merely a surname  
... .

35 U.S.C. § 1052 [Lanham Act § 2]  
*Trademarks registrable on principal register; concurrent registration*

### Peaceable Planet, Inc. v. Ty, Inc. 362 F.3d 986 (7th Cir. 2004)

Although cases and treatises commonly describe personal names as a subset of descriptive marks, it is apparent that the rationale for denying trademark protection to personal names without proof of secondary meaning can't be the same as the rationale just sketched for marks that are "descriptive" in the normal sense of the word. Names, as distinct from nicknames like "Red" or "Shorty," are rarely descriptive. "Niles" may evoke but it certainly does not describe a camel, any more than "Pluto" describes a dog, "Bambi" a fawn, "Garfield" a cat, or "Charlotte" a spider. (In the Tom and Jerry comics, "Tom," the name of the cat, could be thought descriptive, but "Jerry," the name of the mouse, could not be.) So anyone who wanted to market a toy camel, dog, fawn, cat, or spider would not be impeded in doing so by having to choose another name.

Both companies sold plush camel toys named "Niles." Trademark litigation ensued, giving Judge Posner an opportunity to discuss the considerations applicable to personal names as trademarks

The reluctance to allow personal names to be used as trademarks reflects valid concerns (three such concerns, to be precise), but they

are distinct from the concern that powers the rule that descriptive marks are not protected until they acquire secondary meaning. One of the concerns is a reluctance to forbid a person to use his own name in his own business. Supposing a man named Brooks opened a clothing store under his name, should this prevent a second Brooks from opening a clothing store under his own (identical) name even though consumers did not yet associate the name with the first Brooks's store? It should not.

Another and closely related concern behind the personal-name rule is that some names are so common — such as “Smith,” “Jones,” “Schwartz,” “Wood,” and “Jackson” — that consumers will not assume that two products having the same name therefore have the same source, and so they will not be confused by their bearing the same name. If there are two bars in a city that are named “Steve’s,” people will not infer that they are owned by the same Steve.

The third concern, which is again related but brings us closest to the rule regarding descriptive marks, is that preventing a person from using his name to denote his business may deprive consumers of useful information. Maybe “Steve” is a well-known neighborhood figure. If he can't call his bar “Steve’s” because there is an existing bar of that name, he is prevented from communicating useful information to the consuming public.

**David B. Findlay, Inc. v. Findlay**

218 N.E.2d 531 (N.Y. 1966)

When should a man's right to use his own name in his business be limited? This is the question before us.

The individual plaintiff David B. Findlay (“David”) and the individual defendant Walstein C. Findlay (“Wally”) are brothers. The Findlay art business was founded in 1870 by their grandfather in Kansas City. Their father continued and expanded the business with a Chicago branch managed by Wally and a New York branch established and managed by David on East 57th Street. In 1936 the Kansas City gallery was closed and in 1938, after a dispute, the brothers separated. By agreement David, as president of Findlay Galleries, Inc., and owner of nearly all of the stock of the original Missouri corporation, sold to Wally individually the Chicago gallery and allowed Wally to use the name “Findlay Galleries, Inc.” in the conduct of his business in Chicago. Wally organized an Illinois corporation under the name “Findlay Galleries, Inc.” in 1938 and has since operated his Chicago gallery. He also opened, in 1961, a Palm Beach, Florida, gallery.

David, since the separation, has operated his gallery on East 57th Street in Manhattan. For many years he has conducted his business on the second floor of 11-13 East 57th Street.

In October, 1963, Wally purchased the premises at 17 East 57th Street and informed David of his plans to open an art gallery. David objected to Wally's use of the name "Findlay" on 57th Street and by letter announced he would "resist any appropriation by you in New York of the name Findlay in connection with a gallery \* \* \* any funds spent by you to establish a gallery at 17 East 57th Street under the name Findlay Galleries, Inc. (or any variation thereof using the name Findlay) are spent at your peril." David also, in self-defense and in an effort to survive, rented additional space at 15 East 57th Street so as to have a street level entrance.

David's objections and pleas seemed to have some effect on Wally. As renovation on the building was carried on from October, 1963 to September, 1964, a large sign proclaimed the coming opening of "W.C.F. Galleries, Inc." There was also a display and listing in the New York Telephone directory under the same name and similar advertisements in other publications. However, in September, 1964 the sign was suddenly changed to announce the imminent opening of "Wally Findlay Galleries" affiliated with "Findlay Galleries, Inc." David immediately sought an injunction. Wally went ahead with his opening and erected a sidewalk canopy from the curb to the building displaying the name "Wally Findlay Galleries."

The trial court made very detailed findings and, based on them, enjoined defendant from using the names "Wally Findlay Galleries", "Findlay Galleries" and any other designation including the name "Findlay" in the conduct of an art gallery on East 57th Street. The Appellate Division has affirmed on the trial court's findings and we find evidence to sustain them.

In his quarter of a century on East 57th Street David has established a valuable good will and reputation as an art dealer. Through hard work, business ability and expenditure of large sums of money, David has reached the level where a significant portion of his business comes from people who have been referred to him by others and told to go to "Findlay's on 57th St."

The effect of Wally's new gallery, with its long canopy, can only be that those looking for "Findlay's on 57th St." will be easily confused and find their way into Wally's rather than David's gallery. Though Wally perhaps did not deliberately set out to exploit David's good will and reputation, the trial court found, and we agree, that such a result would follow if Wally were permitted to operate a gallery under the name "Wally Findlay Galleries" next door to David.

There were numerous instances of people telephoning or asking at David's for personnel of Wally's or for art work exhibited at Wally's. Many regular customers congratulated David on the opening of "his" new gallery next door. Moreover, advertisements frequently appeared on the same pages of the local press for "Findlay

Galleries", "Findlay's", or "Wally Findlay Galleries" thus making it very difficult to tell whose advertisement it was. Even the art editors and reporters referred to Wally as "Findlay Galleries" – the name used for many years by David – or as "the new Findlay Gallery."

It is apparent that confusion has and must result from Wally's opening next to David. This is compounded by the fact that both brothers have for years specialized in French impressionist and post-impressionist painters. Therefore, quite naturally, both brothers have in the past dealt in the works of such famous deceased painters as Modigliani, Degas, Renoir, Gauguin, Bonnard, Braque, Monet and many others.

Although someone seeking a Renoir from David is unlikely to purchase a Degas from Wally, it is likely that with respect to some of the lesser-known impressionists such diversion might happen. More important, someone wishing to own a nude by Modigliani, a dancer by Degas or a portrait of a girl by Renoir would not necessarily have a particular painting in mind and would likely purchase any of these species, whether it be in Wally's or David's. The items sold by the two brothers are not unique, nonsubstitutional works.

Moreover, art, particularly modern art, is sold only to those who see it. Works of art are sold to those who cross the threshold of the art gallery and the more people you get into your gallery, the more art you will sell. To this end David has worked hard to develop the name "Findlay's on 57th St." and bring in customers. Many people who have the finances to purchase art do not necessarily have the knowledge to distinguish between the works of all the various painters represented by galleries such as Wally's or David's. For this reason they rely on the reputation of the gallery. David has spent over 25 years in developing satisfied customers who will tell others to go to "Findlay's on 57th St." This good will brings in customers who look for a work of art that suits their fancy and, if Wally were to continue to use the name Findlay, it is inevitable that some would walk into Wally's by mistake and would have their tastes satisfied there, to David's great harm.

The so-called "sacred right" theory that every man may employ his own name in his business is not unlimited. Moreover, fraud or deliberate intention to deceive or mislead the public are not necessary ingredients to a cause of action.

The present trend of the law is to enjoin the use even of a family name when such use tends or threatens to produce confusion in the public mind. Whether this confusion should be satisfied by misplaced phone calls or confusing advertisements alone we do not decide because there has been a finding that diversion, as well as confusion, will exist if Wally is not enjoined. Thus it is clear that the "confusion" with which we are dealing includes impairment of good

will of a business.

In *Meneely v. Meneely* this court noted that one can use his own name provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead the public.

Thirty-five years later, we noted that, as a general principle of law, one's name is his property and he is entitled to its use. However, it was equally a principle of law that no man can sell his goods as those of another. "He may not through unfairness, artifice, misrepresentation or fraud injure the business of another or induce the public to believe his product is the product of that other." *World's Dispensary Med. Assn. v. Pierce*

*Ryan & Son v. Lancaster Homes* is distinguishable from the present case because there was lacking the crucial finding that in the absence of relief plaintiff would be damaged by confusion and diversion. There was no real competition between the two businesses. Again, unlike the instant case where "Findlay's on 57th St." is synonymous in New York City with quality art galleries, "Homes by Ryan" had not become a trade name with a secondary meaning. The court reviewed the law and cited the rule in *Meneely*. "This rule has been qualified, as we have said, only to the extent that use of a family name will be restricted where such use tends or threatens to induce confusion in the public mind".

In the present case Wally knew that David had conducted his business and built a reputation under the names "Findlay Galleries" and "Findlay's on 57th St." and that many years of effort and expenses had gone into promoting the name of "Findlay" in the art business on 57th Street. He also knew that people would come into his gallery looking for "Findlay Galleries" and even instructed his employees on this matter before he opened. Nonetheless he opened his gallery next door to David dealing in substantially similar works and using the name Findlay. The bona fides of Wally's intentions do not change the applicable principles. The objective facts of this unfair competition and injury to plaintiff's business are determinative, not the defendant's subjective state of mind. Wally's conduct constituted unfair competition and an unfair trade practice, and it is most inequitable to permit Wally to profit from his brother's many years of effort in promoting the name of "Findlay" on 57th Street. Wally should use any name other than "Findlay" in the operation of his business next door to his brother.

In framing its injunction the trial court went no farther than was necessary to avoid the harm threatened. It prevented the use of the name Findlay but limited this to the particular area in which its use would cause confusion and diversion – East 57th Street. It resolved the conflict with as little injury as possible to Wally. The proof

*Meneely*: 62 N.Y. 427 (1875)

*World's Dispensary*: 96 N.E. 738 (N.Y. 1911)

*Ryan & Son*: 205 N.E.2d 859 (N.Y. 1965)

Today, the "Wally Findlay Gallery" and the "David Findlay Jr. Gallery" are under combined ownership and operate from the same address at 724 Fifth Avenue, between 56th and 57th Streets. The business is owned by James Borynack, who bought Wally's gallery after Wally's death in 1996, and bought David Jr.'s gallery from David Jr.'s daughter in 2016.

showed and the trial court found that many, if not most of the leading art galleries, are now located on Madison Avenue and in the area of the 60's, 70's and 80's in New York City. Wally could probably have found an appropriate place for his New York gallery other than at 17 East 57th Street and can now either find such another location or remain where he is under some name such as "W.C.F. Galleries".

The decision in this case is in accord with the directions of our court: "The defendant has the right to use his name. The plaintiff has the right to have the defendant use it in such a way as will not injure his business or mislead the public. Where there is such a conflict of rights, it is the duty of the court so to regulate the use of his name by the defendant that, due protection to the plaintiff being afforded, there will be as little injury to him as possible." *World's Dispensary*

### Hebrew University of Jerusalem v. General Motors LLC

903 F. Supp. 2d 932 (C.D. Cal. 2012)

Plaintiff's First Cause of Action asserts a claim for unfair competition and false endorsement under the Lanham Act. Unlike the broader right of publicity, which is infringed by the unpermitted use of a person's identity containing no false inference that plaintiff endorses or approves the product, § 1125(a) prohibits only false endorsement, not mere use of an image or name. A false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim for it alleges misuse of a trademark which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product. Only uses which suggest sponsorship or approval are prohibited.

Here, as defendant emphasizes, a minimal association exists between Plaintiff and the mark, which greatly reduces the likelihood that consumers viewing the Advertisement will conclude that Plaintiff endorsed the product. "The Advertisement does not state expressly (or even imply) that Dr. Einstein (or HUI) endorsed the Terrain, nor would any reasonable reader reach that conclusion. Instead, the Advertisement uses Dr. Einstein's face, superimposed on someone else's body, as a play on People magazine's "Sexiest Man Alive" edition, and to make a light-hearted point about the smart (but "sexy") features of the Terrain."

Plaintiff fails to point to any evidence in the record that establishes a genuine dispute of material fact regarding consumer confusion. Plaintiff "disputes" the facts relating to the Advertisement merely by citing to the Advertisement itself and claiming that it "implies and creates the false impression that Dr. Einstein's estate and/or [Plaintiff] were associated with the Advertisement." . Even if that is plausible – doubtful – this is a motion for summary judgment, not a motion to dismiss, and the Court will not sift through the record attempting

This is a trademark false-endorsement claim under § 43(a)(1)(A). Why not a false-advertising claim under § 43(a)(1)(B), which would drop the requirement that the defendant use plaintiff's trademark and the likelihood-of-confusion analysis?



to find evidence to support Plaintiff's case.

The Court will assume, for purposes of this analysis, that Einstein's likeness constitutes a strong mark. Since the Advertisement contains a photographic image of Einstein, the marks here are identical. However, Plaintiff has not even shown a tenuous connection between the "goods" at issue. At most, the Terrain draws its value from Einstein's image only indirectly and remotely; the ad was not for an Einstein product. Einstein is famous largely due to his towering intellect, a point emphasized by the " $e = mc^2$ " tattoo sported by the Advertisement's Einstein doppelganger. "So what the Advertisement suggests is that the Terrain vehicle is endowed with "smart (but 'sexy') features." So what? Einstein = smart. Terrain = smart. Ergo, does Einstein = Approval of Terrain? In short, any link between the "hunky" model in the ad, Einstein's image and the vehicle is too weak to create a link between two "goods."

Plaintiff points to no evidence of the strength of association between the mark and The Hebrew University of Jerusalem. Plaintiff points to no evidence regarding the degree of care consumers are likely to exercise when purchasing a car. Plaintiff points to no evidence that Defendant intended to profit by confusing consumers into believing Plaintiff endorsed the Terrain. Plaintiff points to no evidence that it markets products bearing the image of Einstein through the same marketing channels as Defendant or that any of its approved product lines will expand to overlap with Defendant's product lines. Finally, Plaintiff points to no evidence of actual consumer confusion.

Plaintiff has failed to meet its burden of producing evidence sufficient to create a genuine dispute of material fact. Accordingly, Defendant's motion for summary judgment is GRANTED on Plaintiff's claim for unfair competition and false endorsement under the Lanham Act.

### **Brown v. Electronic Arts, Inc.**

724 F.3d 1235 (9th Cir. 2013)

Plaintiff-Appellant James "Jim" Brown alleges that Defendant-Appellee Electronic Arts, Inc. has violated § 43(a) of the Lanham Act, through the use of Brown's likeness in EA's *Madden NFL* series of football video games.

Jim Brown is widely regarded as one of the best professional football players of all time. He starred for the Cleveland Browns from 1957 to 1965 and was inducted into the National Football League Hall of Fame after his retirement. After his NFL career, Brown also achieved success as an entertainer and public servant. There is no question that he is a public figure whose persona can be deployed for economic benefit.

EA is a manufacturer, distributor and seller of video games and



*Madden NFL* screenshot. The player with the ball has Jim Brown's uniform number.

Once the court adopts the *Rogers* test, it's pretty much fourth-and-forty for Brown. But consider *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013), which applied *No Doubt* and the transformative-use test to athletes' right of publicity claims against another EA sports video game and found no transformation because the game replicated their "physical characteristics," "users manipulate the characters in the performance of the same activity for which they are known in real life," and the context was "similarly realistic." Same court, same panel, same day.

Also compare *CBC Distribution & Marketing v. Major League Baseball Advanced Media*, 505 F.3d 818 (8th Cir.), which held that fantasy baseball competitions were shielded by the First Amendment from right of publicity liability when they used actual players' names and statistics.

*LaFace*: 329 F.3d 437 (6th Cir. 2003)

has produced the *Madden NFL* series of football video games since 1989. The *Madden NFL* series allows users of the games to control avatars representing professional football players as those avatars participate in simulated NFL games. In addition to these simulated games, *Madden NFL* also enables users to participate in other aspects of a simulated NFL by, for example, creating and managing a franchise. Each version of *Madden NFL* includes the current year's NFL teams with the teams' current rosters. Each avatar on a current team is designed to mirror a real current NFL player, including the player's name, jersey number, physical attributes, and physical skills. Some versions of the game also include historical and all-time teams. Unlike for players on the current NFL teams, no names are used for the players on the historical and all-time teams, but these players are recognizable due to the accuracy of their team affiliations, playing positions, ages, heights, weights, ability levels, and other attributes. Although EA enters into licensing agreements with the NFL and NFL Players Association for its use of the names and likenesses of current NFL players, Brown, as a former player, is not covered by those agreements and has never entered into any other agreement allowing EA to use his likeness in *Madden NFL*. Brown asserts that EA has used his likeness in several versions of the game dating back at least to 2001 but that he has never been compensated.

A decade ago, we adopted the *Rogers* test as our method for balancing the trademark and similar rights protected by § 43(a) of the Lanham Act against First Amendment rights in cases involving expressive works. We agree with the district court that the use of Brown's likeness is artistically relevant to the *Madden NFL* games. As Brown points out in trying to undermine the status of the games as expressive works, EA prides itself on the extreme realism of the games. As Brown emphasizes in arguing that it is in fact his likeness in the games: "[I]t is axiomatic the '65 Cleveland Browns simply, by definition, cannot be the '65 Cleveland Browns without the players who played for the '65 Cleveland Browns. This fundamental truth applies especially to that team's most famous player, Jim Brown." Given the acknowledged centrality of realism to EA's expressive goal, and the importance of including Brown's likeness to realistically recreate one of the teams in the game, it is obvious that Brown's likeness has at least some artistic relevance to EA's work.

Brown questions the artistic relevance of his likeness to *Madden NFL* in part by pointing us to the Sixth Circuit's decision in *Parks v. LaFace Records*. In *Rosa and Raymond Parks Institute*, civil rights hero Rosa Parks sued the musical duo Outkast under § 43(a) after Outkast released a song called *Rosa Parks*. Partially due to the fact that one of the members of Outkast had said that the song was not "intended ... to be about Rosa Parks or the civil rights movement," the Sixth Cir-

cuit concluded that the district court should have at least considered additional evidence before deciding that the use of Ms. Parks' name was artistically relevant to the song.

One of the Sixth Circuit's animating concerns in *Rosa and Raymond Parks Institute* was that a celebrity's name could be "appropriated solely because of the vastly increased marketing power of a product bearing the name of [the celebrity]." 329 F.3d at 454. This is a legitimate concern, but the facts in *Rosa and Raymond Parks Institute* – specifically, the court's determination that the lyrics of Outkast's song may very well have nothing to do with Rosa Parks or the civil rights movement – made that concern much more realistic in that case than in this one. EA did not produce a game called *Jim Brown Presents Pinball* with no relation to Jim Brown or football beyond the title; it produced a football game featuring likenesses of thousands of current and former NFL players, including Brown. Comparing this case to *Rosa and Raymond Parks Institute* does not further Brown's cause.

[The court found nothing explicitly misleading about *Madden NFL*.]

### Melting Bad Problem, Re-Redux

Walter Blanco from Blancorp is back again with yet more ideas for possible trademarks for his clumpless ice-melter. Give your opinion on the following potential trademarks:

- JONES
- BETTE MIDLER
- JAY Z
- WALTER BLANCO
- ROBIN HOOD
- CALVIN COOL EDGE
- BLANCO'S BLUE

## D Personal Names

Personal names are to the right of publicity as business names are to trademark. The law on permissible personal names is for the most part a free-for-all: you can call yourself almost anything you want. The occasional exceptions express some familiar policies.

**Laura A. Heymann, *Naming, Identity, and Trademark Law***  
86 Ind. L.J. 381 (2011)

Like trademarks, personal names serve denotative, connotative, and associative functions. A name denotes in that it allows us to refer to or identify a particular person who is not immediately present (and

thus could be pointed to), akin to trademark's "source." Indeed, as one court noted, a name is, at root, "the label or appellation which [an individual] bears for the convenience of the world at large in addressing him or in speaking of him or in dealing with him." A personal name also connotes, in that it brings to mind a certain set of qualities or attributes about the individual to whom the name is attached. A personal name suggests that an individual is either male or female, that he or she is of a particular ethnicity or from a particular region, or that he or she is young or old.

Finally, personal names also have an associational function. In the same way the shared mark "Mercedes" can indicate a family of related goods, a surname can indicate a family of related people and an indication of one's social identity. Initiation into other social structures, such as fraternities or gangs, may be accompanied by new names that represent the new associations; indeed, as early as fifteenth-century Italy, virtually the only Tuscan family names were those of a handful of great families whose kin, including affines, adopted the name as a way of claiming the backing of a powerful corporate group.

**Carlton F.W. Larson, *Naming Baby: The Constitutional Dimensions of Parental Naming Rights***

80 *Geo. Wash. L. Rev.* 159 (2011)

In some states, parents may only choose surnames that are directly connected to their own. Louisiana's law is the most restrictive, requiring that a child of a married couple bear the surname of the husband. However, if both the husband and the wife agree, the surname "may be the maiden name of the mother or a combination of the surname of the husband and the maiden name of the mother." Any other surname, such as the surname of the mother's mother, is prohibited.

Although many state laws are silent on this point, I suspect most states would require parents to select a first name and a surname, rather than just one name. Hawaii, for example, requires married parents to select "both a family name and a given name chosen by one of the child's parents."

Curiously, very few states explicitly impose a duty on parents to name their child anything at all. Connecticut is not alone in not requiring a child's name to be entered on the birth certificate. For example, Michigan statutory law does not explicitly require that a child's given name be included on the birth certificate, and indeed a Michigan official has stated that "a child does not have to be given a name at all." Under Nevada law, a birth certificate need not include the child's name, but parents are given a form to submit "as soon as the child shall have been named."

A number of states, either through statute or administrative prac-

*See also* Patrick McKenzie, *Falsehoods Programmers Believe About Names*; Julia Shear Kushner, *The Right to Control One's Name*, 57 *UCLA L. Rev.* 313 (2009)

tice, prohibit the use of ideograms or pictograms as part of a child's name. This would preclude, for example, parents from naming their child using the symbol denoting The Artist Formerly Known as Prince.

As far as I can determine, no state prohibits the use of a numeral if it is spelled out. It would be permissible, for example, to name a child "Eight." But several states prohibit the use of a numerical symbol, which would prohibit naming a child "8." New Jersey, for example, permits the State Registrar to reject names that contain "numerals" or a "combination of letters, numerals, or symbols." In Illinois, administrative practice prohibits numerals when used as the first character in a child's name. Texas prohibits numerals as part of the name or suffix, although Roman numerals may be used for suffixes. Thus, a child could be named "John William Turner III," but not "John William Turner 3" or "John William 3 Turner."

Some states explicitly limit the length of names, whereas others undoubtedly do so informally. Iowa administrative practice, for example, prohibits names over a certain number of characters due to technological limitations associated with its electronic data systems.<sup>52</sup> In Massachusetts, the first, last, and middle names are limited to forty characters because of software limitations.

Prohibitions of accent marks and other diacritical marks are common. For example, the California Office of Vital Records provides a handbook to county vital records departments that states birth names can be recorded using only "the 26 alphabetical characters of the English language with appropriate punctuation if necessary." The handbook further specifies that "no pictographs, ideograms, diacritical marks" (including "é," "ñ," and "ç") are allowed. Hence the prohibition on "Lucía" discussed in the Introduction. In Massachusetts, the "characters have to be on the standard american [sic] keyboard. So dashes and apostrophes are fine, but not accent marks and the such." New Hampshire prohibits all special characters other than an apostrophe or dash. Accordingly, "O'Connor" is a permissible name in New Hampshire, but "Chacón" is not.

At least two states explicitly prohibit obscenities, and I suspect many other states would prohibit obscene names as well. New Jersey statutory law permits the State Registrar to reject any chosen names or surnames that contain an obscenity. Under Nebraska statutory law, the selection of a surname is the "parents' prerogative, except that the department [of Health and Human Services] shall not accept a birth certificate with a child's surname that implies any obscene or objectionable words or abbreviations." The statute is curiously silent with respect to an obscenity in the child's first name.

Some states ostensibly impose no restrictions at all upon parents' choice of names. For example, under Kentucky statutory law, the

*But see Jennifer 8. Lee, Yes, 8 Is My Middle Name, Boston Globe, Aug. 8, 1996*

child's surname is "any name chosen by the parents." A Kentucky official has stated that the mother can give her child "any name she wishes." In response to e-mail inquiries, state officials in Delaware, Maryland, and Montana all asserted that their states imposed no restrictions on parents' choice of names.<sup>65</sup> A Washington statute states that an unmarried mother may "give any surname she so desires to her child." There is no similar statutory language with respect to married parents or with respect to first names. South Carolina formerly required that every child be given the surname of the father; now, however, a state official asserts that the state "does allow a mother to name her child without any restrictions."

Yet one wonders if these statements are literally true. It seems unlikely that state officials would passively accept an expletive, a 700-letter name, or a name written entirely in Greek characters. Put to the acid test, these general statements about parents' unfettered ability to select a name may well prove unreliable.

Many foreign jurisdictions are significantly more restrictive with respect to naming practices. Portugal, for example, requires governmental approval of names; a list of previously approved and rejected names is available on the Internet. It makes for fascinating reading, displaying a relentless enforcement of "authentic" Portuguese names. Not surprisingly, "Svetlana," "Johann," "Ethel," and "Andy" all fail to make the cut, but so do "Carmencita," "Catelina," and "Iglesias." Portugal also prohibits names that "raise doubts about the sex of the registrant." In 2007, Venezuelan lawmakers proposed legislation that would limit parents to 100 approved names, perhaps because at least 60 Venezuelans bore the first name "Hitler." Spain specifically prohibits "extravagant" or "improper" names. French law permits officials to reject first names that are considered contrary to the welfare of the child. One such name was "Fleur de Marie," rejected by French courts as too eccentric. Argentina prohibits names that are "extravagant, ridiculous, contrary to [its] customs, [or] that express or signify political or ideological tendencies." It has in the past also rejected certain non-Spanish names, such as "Malcolm."

The need for further prohibitions is at least debatable. After all, most parents do not give their children ridiculous and hurtful names. But it does happen. When I started researching this topic several years ago, I assumed that no one would name his or her child "Adolf Hitler." But it happened. Indeed, at least sixty Venezuelans of voting age bear the first name "Hitler." Similarly, at least one child is alleged to be named for a venereal disease, and other American children have been named "Satan." Parents in Japan sought to name their child, "Akuma," which means "devil" or "demon." Since 1984, two children in the United Kingdom have been named "Superman," and six have been named "Gandalf." A New Zealand judge ordered a girl

named “Talula Does The Hula From Hawaii” into court guardianship so that her name could be changed. The judge stated, “It makes a fool of the child and sets her up with a social disability and handicap.” Other children in New Zealand have been named “Number 16 Bus Shelter,” and “Violence.” Similarly, Swedish officials have rejected attempts by parents to name children “Metallica” and “Brfxcccxm-npccccllmmnprxvclmncckssqbb11116.” Danish officials rejected the proposed names “Anus” and “Monkey.”

### **In re Mokiligon**

2005-NMCA-021 (N.M. Ct. App. 2005)

Petitioner, acting pro se, appeals the district court’s order denying his request to change his name from “Snaphappy Fishsuit Mokiligon” to “Variable.”

Petitioner argued in his docketing statement that NMSA 1978, § 40–8–1 (1989) grants him the right to change his name. Section 40–8–1 reads, in pertinent part, as follows:

Any resident of this state over the age of fourteen years may, upon petition to the district court of the district in which the petitioner resides and upon filing the notice required with proof of publication, if no sufficient cause is shown to the contrary, have his [or her] name changed or established by order of the court.

We stated in our notice of proposed disposition that although it has been held that a court has discretion to deny a name change under statutes similar to ours, it is generally held that denial is limited to a showing of an “unworthy motive, the possibility of fraud on the public, or the choice of a name that is bizarre, unduly lengthy, ridiculous or offensive to common decency and good taste.”

The court summarily denied Petitioner’s request without providing sufficient factual support for the denial. The docketing statement represented that Petitioner did not receive a hearing, but was informed by mail that his request was denied. Thus, there appears to have been no showing of wrongful or fraudulent purpose, and the name “Variable” does not appear obviously offensive.

We clarify, however, that Petitioner is restricted to using the word ‘variable’ as his legal name. The court is not granting him the power to actually vary his legal name at will and he is limited to using ‘variable,’ unless or until he changes his name again through a recognized legal process.

### **Petition of Variable**

2008-NMCA-105 (N.M. 2008)

Petitioner filed a request in district court to change his name to “Fuck Censorship!” “ The district court denied the request stating that the “proposed name change would be obscene, offensive and would not comport with common decency.”

Petitioner argues on appeal that he is entitled to call himself whatever he wishes. He argues that the First Amendment to the United States Constitution gives him that right and that it is improper government censorship to deny him that right.

We do not believe that the district court’s action infringes on Petitioner’s right to free speech. Petitioner has a right under the common law to assume any name that he wants so long as no fraud or misrepresentation is involved. He may do so without making any application to the state. Thus, under the common law, Petitioner may exercise his right to free speech and use any name at all. However, once Petitioner files an application for a name change and seeks the approval of the courts for a name, it becomes the responsibility of the courts to ensure that there are no lawful objections to the name change.

Petitioner may make a political statement by changing his name, but once he seeks the state’s imprimatur he is subject to the court’s discretion in granting the government’s approval of the name. As the court in *Lee v. Ventura County Superior Court*, stated in denying the petition of Lee to change his name to “nigger,” one has a common law right to assume any name, and a right to engage in a social experiment, but one does not have a right to require the state to participate in the experiment.

*Lee*: 11 Cal. Rptr. 2d 763 (1992)

### **In re Ravitch**

754 A.2d 1287 (Pa. Super. 2000)

On October 26, 1998, Appellant filed a petition to change her name from “Mary Ravitch” to “Mary R.” At the hearing, Appellant testified briefly that she no longer wished to use her ex-husband’s surname “Ravitch” and did not want to revert to her premarital surname “Gon.” Instead, she preferred to assume the “nice and simple” letter “R” as her surname.

The primary purpose of the Judicial Change of Name Statute, other than with regard to minor children, is to prohibit fraud by those attempting to avoid financial obligations. Inquiry extends beyond the intentions of the petitioner, however, and a court may properly exercise its wide discretion to refuse a requested name if the name is bizarre or unduly lengthy or difficult to pronounce or possessive of a ridiculous offensive connotation.

While there is naturally some confusion attendant to all name changes, Appellant’s desired surname is so bizarre that it would likely be met with repeated suspicion and distrust in both business



and social settings. Indeed, far from being a “nice and simple” identifier, an initialized surname has traditionally been used to preserve one’s anonymity in various contexts. We thus associate Appellant’s request with routinely denied requests for numerical or symbolized surnames rather than with those accepted requests for non-western or gender-transitional names. Finally, we must note that if courts were to permit initialized official names as a matter of course, we would invite surname replication at an exponential rate, greatly in excess of what is currently experienced with common surnames, so as to make informal identification burdensome at best.

We find, therefore, that the trial court properly exercised its discretion when it ruled that the public interest overrides Appellant’s personal interest in choosing the letter “R” as her official surname. Where, as here, the desired name is devoid of any significance to the petitioner and would likely spawn insurmountable difficulties affecting both the petitioner and the general population, its denial is proper. Though we are to interpret the Judicial Change of Name Statute liberally, we will not extend the statute to permit one to officially identify oneself by use of a mere alphabetical symbol instead of by a meaningful word or name.



**In re Serpentfoot**  
285 Ga. App. 325 (2007)

Pro se appellant Serpentfoot appeals the superior court’s order denying her third amended petition to change her name to Ann Serpentfoot-Mooney and awarding \$2,500 in attorney fees to Burgett Mooney III, who objected to the petition.

The record shows that Mooney is the publisher of the Rome News Tribune. Appellant’s current name, as well as her former name, Anne Otwell, appear in the newspaper on occasion in an unflattering light.<sup>3</sup> In her first petition, appellant sought to change her name to “Blowd-jett Mooney, IV.” Mooney objected on the ground that appellant intended to defraud him and that this name change would cause him

<sup>3</sup>This is due to various criminal and other newsworthy acts committed by appellant. See *Serpentfoot v. State*, 524 S.E.2d 516 (Ga. App. 1999) (appellant’s suspended sentence for public indecency revoked because she shot and killed her neighbors’ ten-year-old, crippled dog because it was annoying her).

embarrassment and ridicule. Appellant amended her petition three times, on each occasion seeking an order to utilize the Mooney surname.<sup>4</sup>

At the hearing held on the petition, appellant testified that the newspaper refuses to stop using her former name, even though she changed it to Serpentfoot after her arrest for protesting in the nude during Christian prayers at government meetings; that the newspaper is blackmailing her and prints the name Otwell in order to hurt her family and alienate her from her children; and that she chose the surname Mooney, although she is “not particularly fond of the name,” because she believes that Burgett Mooney will not likely print the name Otwell if it is associated with Mooney’s name. In her third amended petition, appellant set forth the reason for seeking the name change as follows:

I would like for our newspaper owner, Burgett Mooney, III to treat my name and the name of my previous husband’s family, the same way he would like his name treated. Since they, and I, pleaded with him and it did no good, I see no solution to get him to practice “The Golden Rule” as to my name unless my surname is the same as his surname.

Given the probable harm to Burgett Mooney and appellant’s improper motives, the trial court exercised sound legal discretion in denying the petition. Also, a person is not authorized to change his name “with a view to deprive another fraudulently of any right under the law.” Every individual has a common law right to the protection of his own good name. Based on her testimony and the pleadings appellant has included in the record, the court could have found that she intended to deprive Mooney of his good name.

**Weingand v. Lorre**

41 Cal. Rptr. 778 (1964)

Appellant Eugene Weingand appeals from the judgment (“Order”) entered herein (1) denying appellant’s petition for change of name, and (2) permanently restraining petitioner from using the name Peter Lorie in either his personal or business activities unless petitioner first obtains in writing the express written consent of Peter Lorre.

[The court discussed *In re Ross*.] There one Ross, an actor, had used the name of Ian Keith as a stage name for some fifteen years; it had become valuable to him and he desired it to be legally made his name. There was no opposition but the trial court denied his petition upon determining that he had once been adjudicated a bankrupt and

<sup>4</sup>Appellant chose “Bridgett S. Mooney, IV,” then “S.S. Serpentfoot-Mooney,” and finally, “Ann Serpentfoot-Mooney.

CCGA § 19-12-4.

Ross: 67 P.2d 94 (1937)

had not subsequently paid such debts. In reversing the judgment the court held that a lawful bankruptcy proceeding without subsequent payment of the discharged debts was not a substantial reason to justify the denial. The court then said:

The common law recognizes the right to change one's personal name without the necessity of legal proceedings, and the purpose of the statutory procedure is simply to have, wherever possible, a record of the change. Hence Mr. Ross may, regardless of the present petition, use the name of Keith if he desires. And in keeping with the object of the statute, a court to which he applies should normally make its decree recording such change of name.

In light of the evidence herein and the substantial showing made in opposition to the petition no abuse of discretion was exercised by the trial court in denying the petitioner a legal record for change of name. The evidence fully supports the findings of the court to the effect that it is not true petitioner's last name is hard to pronounce; it is true that petitioner has been engaged in show business and his associates have called him by his proposed name for about one year; petitioner has no family connection with the name Lorre or with any other name sounding like Lorre or Lorie; that petitioner bears a physical resemblance of sorts to, and affects a manner of speech similar to that for which Peter Lorre is known; that for more than one year petitioner, in the course of his business transactions, has held himself out to the public to be Peter Lorre, Peter Lorie, Peter Lorie, Jr., and also as the son of Peter Lorre, the well-known actor. Petitioner, before moving to California, was active in theater groups in Germany and New York City. For about one year he has been attending an acting school in Hollywood, California. That Peter Lorre is a world-famous actor in motion pictures and television. His name is unique in the entertainment industry and has acquired a secondary meaning in that it connotes the unique characterization, style, manner of speaking and appearance of Mr. Lorre. That the appearance in the entertainment industry of an actor bearing the name Peter Lorie would confuse the public in that advertising and publicity for a performance of Peter Lorie would draw members of the public expecting to see a performance of Peter Lorre. This would directly affect the commercial and professional value of the services and performances of Peter Lorre both present and future. That petitioner has not acted in good faith in filing his petition to change his name to Peter Lorie and his purpose in seeking an order of the court authorizing such name change is to 'cash in' on the reputation of Peter Lorre. These findings, based upon credible evidence, constitute substantial reasons for the denial by the court of the petition herein for a change of name.

The final matter before us concerns the voluntary inclusion in the conclusions of law and the judgment of a permanent injunction. As pointed out in *Ross*, the common law recognizes the right of a person to change his name without the necessity of legal proceedings. The trial court therefore exceeded its jurisdiction in permanently enjoining petitioner from using the name Peter Lorie.

#### **Application of Clark**

85 N.Y.S.2d 667 (N.Y. Sup. 1948)

Identical applications are presented by Maxine Sheppard and Nancy Clark for leave, by each, to assume the name of Nancy Clark-Sheppard. Petitioners are actresses, radio and television artists and desire to engage in television work as a partnership. Each avers that "The theatre and its allied arts is justly famous throughout the ages for its generosity. Unfortunately, this generosity does not always extend within its own ranks. Especially is this true in regard to publicity and personal fame. We are about to launch this theatrical partnership. Realizing the human frailties of woman, in particular her petty jealousies over career, we feel that by thus bearing the same name much of this will be eliminated. Therefore, we wish to circumvent the possibility of having the spotlight of publicity trained more upon one of us than the other. We wish to share and share alike in publicity, the life blood of a performer." To approve these requests would, it seems to me, create a situation which may veritably lead to a "Comedy of Errors" and may tend to prejudice persons having business and commercial relations with petitioners. The applications are denied.

#### **In re Name Change of Handley**

736 N.E.2d 125 (Ohio Probate Ct. 2000)

The petitioner filed an application with the court on December 29, 1999 to change his name to Santa Robert Claus. In his application, he stated that children have called him "Santa Bob" year round and that he lives his life for the children. The petitioner is a rotund gentleman with a full white beard and wears wire glasses, which he says attributes to people commenting on his resemblance of Santa Claus. The petitioner has been acting the role of Santa Claus for over forty years, initially playing the role in a school play at age fourteen. The petitioner receives gratuity for his portrayal of Santa Claus at various events, but it does not cover his expenses incurred. The petitioner stated in his application, "I don't want people to say you look like Santa, I want to be Santa."

The court finds that there is an economic value to the name of Santa Claus. The court finds no fraudulent intent of the petitioner to take advantage of the economic value for the use of the name. How-

ever, the court finds public policy reasons to deny the petitioner's request, particularly the interference with the rights of others. The petitioner is seeking more than a name change, he is seeking the identity of an individual that this culture has recognized throughout the world, for well over one hundred years. Thus, the public has a proprietary interest, a proprietary right in the identity of Santa Claus, both in the name and the persona. Santa Claus is really an icon of our culture; he exists in the minds of millions of children as well as adults.

The history of Santa Claus – the North Pole, the elves, Mrs. Claus, reindeer – is a treasure that society passes on from generation to generation, and the petitioner seeks to take not only the name of Santa Claus, but also to take on the identity of Santa Claus. Although thousands of people every year do take on the identity of Santa Claus around Christmas, the court believes it would be very misleading to the children in the community, particularly the children in the area that the petitioner lives, to approve the applicant's name change petition.

Therefore, for the foregoing reasons, the court finds that it would be against public policy to grant the application of the petitioner.

**In re Porter**  
**2001 UT 70**

The issue before us is whether the trial court erred in denying David Lynn Porter's petition to change his name to "Santa Claus." We conclude it did and reverse.

The reasons offered by the district court for denying Porter's petition included that the name "Santa Claus" would likely "create confusion, misunderstanding and intended or unintended, could allow for substantial mischief." The district court also feared that the name could cause a substantial chilling effect for persons otherwise entitled to exercise access to the courts but who would be hesitant to sue Santa Claus.

On the record before us, we simply disagree with the district court. Porter's proposed name may be thought by some to be unwise, and it may very well be more difficult for him to conduct his business and his normal everyday affairs as a result. However, Porter has the right to select the name by which he is known, within very broad limits. Significantly, Porter already tells others that he is Santa Claus. Allowing him to legally change his name to reflect his practice of doing so is more likely to avoid greater confusion than to create it by making Porter legally responsible for his actions in the name Santa Claus.

## E Defamation and False Light

While the tort law of defamation and false light is not strictly speaking a body of intellectual property law, our survey would be incomplete without it. Unlike the right of publicity (but like commercial disparagement and false advertising), these torts are deeply concerned with truth and falsity.

**Milkovich v. Lorain Journal Co.**  
497 U.S. 1 (1990)

Respondent J. Theodore Diadiun authored an article in an Ohio newspaper implying that petitioner Michael Milkovich, a local high school wrestling coach, lied under oath in a judicial proceeding about an incident involving petitioner and his team which occurred at a wrestling match. [The article stated, for example, "Anyone who attended the meet, whether he be from Maple Heights, Mentor, or impartial observer, knows in his heart that Milkovich and Scott lied at the hearing after each having given his solemn oath to tell the truth." Milkovich sued for defamation. The Ohio courts concluded that the article constituted constitutionally protected "opinion."]

Since the latter half of the 16th century, the common law has afforded a cause of action for damage to a person's reputation by the publication of false and defamatory statements. In Shakespeare's *Othello*, Iago says to Othello:

Good name in man and woman, dear my lord,  
Is the immediate jewel of their souls. Who  
steals my purse steals trash; 'Tis something,  
nothing; 'Twas mine, 'tis his, and has  
been slave to thousands; But he that  
filches from me my good name Robs me  
of that which not enriches him, And  
makes me poor indeed."

Defamation law developed not only as a means of allowing an individual to vindicate his good name, but also for the purpose of obtaining redress for harm caused by such statements. As the common law developed in this country, apart from the issue of damages, one usually needed only allege an unprivileged publication of false and defamatory matter to state a cause of action for defamation. The common law generally did not place any additional restrictions on the type of statement that could be actionable. Indeed, defamatory communications were deemed actionable regardless of whether they were deemed to be statements of fact or opinion. As noted in the 1977 Restatement (Second) of Torts § 566, Comment a:

Under the law of defamation, an expression of opinion could be defamatory if the expression was sufficiently

derogatory of another as to cause harm to his reputation, so as to lower him in the estimation of the community or to deter third persons from associating or dealing with him. The expression of opinion was also actionable in a suit for defamation, despite the normal requirement that the communication be false as well as defamatory.... This position was maintained even though the truth or falsity of an opinion—as distinguished from a statement of fact—is not a matter that can be objectively determined and truth is a complete defense to a suit for defamation.

However, due to concerns that unduly burdensome defamation laws could stifle valuable public debate, the privilege of “fair comment” was incorporated into the common law as an affirmative defense to an action for defamation. The principle of fair comment afforded legal immunity for the honest expression of opinion on matters of legitimate public interest when based upon a true or privileged statement of fact. As this statement implies, comment was generally privileged when it concerned a matter of public concern, was upon true or privileged facts, represented the actual opinion of the speaker, and was not made solely for the purpose of causing harm. According to the majority rule, the privilege of fair comment applied only to an expression of opinion and not to a false statement of fact, whether it was expressly stated or implied from an expression of opinion. Thus under the common law, the privilege of “fair comment” was the device employed to strike the appropriate balance between the need for vigorous public discourse and the need to redress injury to citizens wrought by invidious or irresponsible speech.

In 1964, we decided in *New York Times Co. v. Sullivan* that the First Amendment to the United States Constitution placed limits on the application of the state law of defamation. There the Court recognized the need for “a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with ‘actual malice’ – that is, with knowledge that it was false or with reckless disregard of whether it was false or not.” This rule was prompted by a concern that, with respect to the criticism of public officials in their conduct of governmental affairs, a state-law rule compelling the critic of official conduct to guarantee the truth of all his factual assertions’ would deter protected speech.

*New York Times*: 376 U.S. 254 (1964)

Three years later, in *Curtis Publishing Co. v. Butts*, a majority of the Court determined that the New York Times test should apply to criticism of “public figures” as well as “public officials.” The Court has also determined that both for public officials and public figures, a showing of New York Times malice is subject to a clear and convinc-

*Butts*: 388 U.S. 130 (1967)

ing standard of proof.

The next step in this constitutional evolution was the Court's consideration of a private individual's defamation actions involving statements of public concern. Although the issue was initially in doubt, the Court ultimately concluded that the *New York Times* malice standard was inappropriate for a private person attempting to prove he was defamed on matters of public interest. *Gertz v. Robert Welch, Inc.* As we explained:

*Gertz*: 418 U.S. 323 (1974)

Public officials and public figures usually enjoy significantly greater access to the channels of effective communication and hence have a more realistic opportunity to counteract false statements than private individuals normally enjoy.

More important, public officials and public figures have voluntarily exposed themselves to increased risk of injury from defamatory falsehood concerning them. No such assumption is justified with respect to a private individual.

Nonetheless, the Court believed that certain significant constitutional protections were warranted in this area. First, we held that the States could not impose liability without requiring some showing of fault. Second, we held that the States could not permit recovery of presumed or punitive damages on less than a showing of *New York Times* malice.

*Hepps*: 475 U.S. 767 (1986)

Still later, in *Philadelphia Newspapers, Inc. v. Hepps*, we held that "the common-law presumption that defamatory speech is false cannot stand when a plaintiff seeks damages against a media defendant for speech of public concern." In other words, the Court fashioned a constitutional requirement that the plaintiff bear the burden of showing falsity, as well as fault, before recovering damages.

Respondents would have us recognize, in addition to the established safeguards discussed above, still another First-Amendment-based protection for defamatory statements which are categorized as "opinion" as opposed to "fact." For this proposition they rely principally on the following dictum from our opinion in *Gertz*:

Under the First Amendment there is no such thing as a false idea. However pernicious an opinion may seem, we depend for its correction not on the conscience of judges and juries but on the competition of other ideas. But there is no constitutional value in false statements of fact.

Judge Friendly appropriately observed that this passage "has become the opening salvo in all arguments for protection from defamation actions on the ground of opinion, even though the case did not remotely



concern the question.” *Cianci v. New Times Publishing Co.* Read in context, though, the fair meaning of the passage is to equate the word “opinion” in the second sentence with the word “idea” in the first sentence. Under this view, the language was merely a reiteration of Justice Holmes’ classic “marketplace of ideas” concept.

Thus, we do not think this passage from Gertz was intended to create a wholesale defamation exemption for anything that might be labeled “opinion.” Not only would such an interpretation be contrary to the tenor and context of the passage, but it would also ignore the fact that expressions of “opinion” may often imply an assertion of objective fact.

If a speaker says, “In my opinion John Jones is a liar,” he implies a knowledge of facts which lead to the conclusion that Jones told an untruth. Even if the speaker states the facts upon which he bases his opinion, if those facts are either incorrect or incomplete, or if his assessment of them is erroneous, the statement may still imply a false assertion of fact. Simply couching such statements in terms of opinion does not dispel these implications; and the statement, “In my opinion Jones is a liar,” can cause as much damage to reputation as the statement, “Jones is a liar.” As Judge Friendly aptly stated: “It would be destructive of the law of libel if a writer could escape liability for accusations of defamatory conduct simply by using, explicitly or implicitly, the words ‘I think.’” *Cianci*

Foremost, we think *Hepps* stands for the proposition that a statement on matters of public concern must be provable as false before there can be liability under state defamation law, at least in situations, like the present, where a media defendant is involved. Thus, unlike the statement, “In my opinion Mayor Jones is a liar,” the statement, “In my opinion Mayor Jones shows his abysmal ignorance by accepting the teachings of Marx and Lenin,” would not be actionable. *Hepps* ensures that a statement of opinion relating to matters of public concern which does not contain a provably false factual connotation will receive full constitutional protection.<sup>7</sup>

Next, [another] line of cases provides protection for statements that cannot “reasonably [be] interpreted as stating actual facts” about an individual. *Hustler Magazine, Inc. v. Falwell*. This provides assurance that public debate will not suffer for lack of “imaginative expression” or the “rhetorical hyperbole” which has traditionally added

*Cianci*: 639 F.2d 54 (2d Cir. 1980)

*Falwell*: 485 U.S. 46 (1988)

<sup>7</sup>We note that the issue of falsity relates to the defamatory facts implied by a statement. For instance, the statement, “I think Jones lied,” may be provable as false on two levels. First, that the speaker really did not think Jones had lied but said it anyway, and second that Jones really had not lied. It is, of course, the second level of falsity which would ordinarily serve as the basis for a defamation action, though falsity at the first level may serve to establish malice where that is required for recovery.

much to the discourse of our Nation.

We are not persuaded that, in addition to these protections, an additional separate constitutional privilege for "opinion" is required to ensure the freedom of expression guaranteed by the First Amendment. The dispositive question in the present case then becomes whether a reasonable factfinder could conclude that the statements in the Diadiun column imply an assertion that petitioner Milkovich perjured himself in a judicial proceeding. We think this question must be answered in the affirmative. As the Ohio Supreme Court itself observed: "The clear impact in some nine sentences and a caption is that Milkovich 'lied at the hearing after . . . having given his solemn oath to tell the truth.'" This is not the sort of loose, figurative, or hyperbolic language which would negate the impression that the writer was seriously maintaining that petitioner committed the crime of perjury. Nor does the general tenor of the article negate this impression.

We also think the connotation that petitioner committed perjury is sufficiently factual to be susceptible of being proved true or false. A determination whether petitioner lied in this instance can be made on a core of objective evidence by comparing, *inter alia*, petitioner's testimony before the OHSAA board with his subsequent testimony before the trial court.

The numerous decisions discussed above establishing First Amendment protection for defendants in defamation actions surely demonstrate the Court's recognition of the Amendment's vital guarantee of free and uninhibited discussion of public issues. But there is also another side to the equation; we have regularly acknowledged the "important social values which underlie the law of defamation," and recognized that "[s]ociety has a pervasive and strong interest in preventing and redressing attacks upon reputation." *Rosenblatt v. Baer*. Justice Stewart in that case put it with his customary clarity:

The right of a man to the protection of his own reputation from unjustified invasion and wrongful hurt reflects no more than our basic concept of the essential dignity and worth of every human being — a concept at the root of any decent system of ordered liberty. ...

The destruction that defamatory falsehood can bring is, to be sure, often beyond the capacity of the law to redress. Yet, imperfect though it is, an action for damages is the only hope for vindication or redress the law gives to a man whose reputation has been falsely dishonored."

We believe our decision in the present case holds the balance true.

*Rosenblatt*: 383 U.S. 75 (1966)  
In his concurring opinion

### Restatement (Second) of Torts

§ 652E  
*Publicity Placing Person in False Light*

One who gives publicity to a matter concerning another that places the other before the public in a false light is subject to liability to the other for invasion of his privacy, if

- (a) the false light in which the other was placed would be highly offensive to a reasonable person, and
- (b) the actor had knowledge of or acted in reckless disregard as to the falsity of the publicized matter and the false light in which the other would be placed.

cmt. b. *Relation to Defamation.* – The interest protected by this Section is the interest of the individual in not being made to appear before the public in an objectionable false light or false position, or in other words, otherwise than as he is. In many cases to which the rule stated here applies, the publicity given to the plaintiff is defamatory, so that he would have an action for libel or slander under the rules stated in Chapter 24. In such a case the action for invasion of privacy will afford an alternative or additional remedy, and the plaintiff can proceed upon either theory, or both, although he can have but one recovery for a single instance of publicity.

It is not, however, necessary to the action for invasion of privacy that the plaintiff be defamed. It is enough that he is given unreasonable and highly objectionable publicity that attributes to him characteristics, conduct or beliefs that are false, and so is placed before the public in a false position. When this is the case and the matter attributed to the plaintiff is not defamatory, the rule here stated affords a different remedy, not available in an action for defamation.

Illustrations:

5. A is a war hero, distinguished for bravery in a famous battle. B makes and exhibits a motion picture concerning A's life, in which he inserts a detailed narrative of a fictitious private life attributed to A, including a non-existent romance with a girl. B knows this matter to be false. Although A is not defamed by the motion picture, B is subject to liability to him for invasion of privacy.

cmt. c. *Highly offensive to a reasonable person.* – The rule stated in this Section applies only when the defendant knows that the plaintiff, as a reasonable man, would be justified in the eyes of the community in feeling seriously offended and aggrieved by the publicity. Complete and perfect accuracy in published reports concerning any individual is seldom attainable by any reasonable effort, and most minor errors, such as a wrong address for his home, or a mistake in the date when he entered his employment or similar unimportant details of his career, would not in the absence of special circumstances give any serious offense to a reasonable person.

Illustrations:

6. A is a noted musician. B writes and publishes a biography of A, which is in general a correct and favorable portrayal. Included in the book are a number of minor mistakes concerning details of A's career, together with accounts of a few fictitious but quite unimportant incidents in which A is reported to have been involved and conversations he is reported to have had with others. These are not defamatory and nothing in the book casts any adverse reflection upon A's character or reputation. B's attention is called to these errors, but he nevertheless publishes the book. B has not invaded A's privacy.

**Tyne ex rel. Tyne v. Time Warner Entertainment Co., L.P.**  
204 F. Supp. 2d 1338 (M.D. Fla. 2002)

In October 1991, the fishing vessel the *Andrea Gail* was caught in a severe storm, and lost at sea. All of the crewmembers aboard the vessel were presumed dead. Due to interest in the unusual meteorological forces that caused the storm, the loss of the *Andrea Gail* became the subject of news stories and a best-selling book, *The Perfect Storm*, by Sebastian Junger. In June 2000, Warner Bros. released *The Perfect Storm* a motion picture based on the book and the events that occurred during the "storm of the century."

[Plaintiffs were the surviving children and spouses of some of the crew members. They sued the filmmakers of *The Perfect Storm* for] (1) unauthorized commercial appropriation of decedents' likenesses, in violation of Florida Statute § 540.08; (2) unauthorized commercial appropriation of Plaintiffs' likenesses, also in violation of § 540.08; (3) common law invasion of privacy—false light; and (4) common law invasion of privacy based on disclosure of private facts.

*A. Section 540.08 Claims*

Defendants concede that they did not obtain authorization to include characters based on Plaintiffs and the decedents prior to the production of *The Perfect Storm*. However, they argue that they did not violate § 540.08 by failing to obtain such authorization, because *The Perfect Storm* is an expressive work that has no commercial advertising purpose, and is, therefore, outside the scope of the rights protected by § 540.08.

Despite Plaintiffs' protestations to the contrary, the Court believes that this case is squarely on point with the case of *Loft v. Fuller*. In that case, decedent Robert Loft was a commercial pilot who died in the crash of Eastern Airlines Flight 401. In the weeks and months following the crash, there were reported sightings of apparitions of Flight 401 crew members, including Loft. These reports were exten-

sively covered by the news media. In 1976, John Fuller wrote a non-fiction book about the crash, “The Ghost of Flight 401,” which was later made into a motion picture. Loft’s family filed an action for invasion of privacy and unauthorized publication of Loft’s name and likeness, based on the movie’s depiction of Loft as a “reappearing ghost.”

The Fourth District Court of Appeal held:

In our view, Section 540.08, by prohibiting the use of one’s name or likeness for trade, commercial or advertising purposes, is designed to prevent the unauthorized use of a name to directly promote the product or service of the publisher. Thus, the publication is harmful not simply because it is included in a publication that is sold for a profit, but rather because of the way it associates the individual’s name or his personality with something else. Such is not the case here. While we agree that at least one of the purposes of the author and publisher in releasing the publication in question was to make money through sales of copies of the book and that such a publication is commercial in that sense, this in no way distinguished this book from almost all other books, magazines or newspapers and simply does not amount to the kind of commercial exploitation prohibited by the statute.

The court’s statement makes it clear that merely using an individual’s name or likeness in a publication is not actionable under § 540.08. A motion picture is not, therefore, in and of itself, a “commercial purpose.” Furthermore, the promotion and advertising of the picture also do not constitute a commercial purpose.

In the instant case, Plaintiffs have failed to raise a genuine issue of material fact as to whether the use of decedents’ likenesses and their own likenesses were used for the purposes of trade or a commercial purpose. Plaintiffs have presented no evidence showing that their names and likenesses were used to directly promote *The Perfect Storm*. In the absence of such evidence, Plaintiffs have no cause of action under § 540.08.

Finally, the Court addresses Plaintiffs’ argument that Defendants are liable under § 540.08 because the Picture contains fictionalized elements even though it purports to be “a true story.” This argument has no merit. No Florida court has interpreted § 540.08 to include an element of falsity. It is therefore immaterial whether *The Perfect Storm* claims to be a work of fiction or nonfiction. Plaintiffs’ arguments regarding the alleged fictionalization of the Picture suggest that they have confused the statutory action of unauthorized publication with the common law action of false light invasion of privacy.

“We think it does not matter whether the book is properly described as a biography, a fictional biography, or any other kind of literary work. It is not for a court to pass on literary categories, or literary judgment. It is enough that the book is a literary work and not simply a disguised commercial advertisement for the sale of goods or services. The protection of the right of free expression is so important that we should not extend any right of publicity, if such exists, to give rise to a cause of action against the publication of a literary work about a deceased person.” *Frosch v. Grosset & Dunlap, Inc.* 427 N.Y.S.2d 828 (N.Y. App. Div. 1980) (dismissing suit by Marilyn Monroe’s estate against the publisher of Norman Mailer’s *Marilyn*)

The Court, however, has no such problem distinguishing those two causes of action. Consequently, the Court determines that the truth or falsity of the events depicted in the Picture is of no import to the issue of whether there was unauthorized publication of the Plaintiffs' and decedents' likenesses.

*B. False Light Invasion of Privacy*

Plaintiffs Erica and Billie-Jo Tyne do not have standing to bring an action for false light invasion of privacy on their father's behalf. It is well-settled that:

a cause of action for invasion of the common law right of privacy is strictly personal and may be asserted only by the person who is the subject of the challenged publication. Relatives of a deceased person have no right of action for invasion of privacy of the deceased person regardless of how close such personal relationship was with the deceased.

*Loft.* The only recognized exception to this rule occurs when plaintiffs experience an independent violation of their own personal privacy rights other than the violation alleged to have occurred indirectly by virtue of the publicity given to the deceased.

Plaintiffs argue that they have experienced an independent violation of their own personal privacy rights by having been individually depicted in the Picture. It is true that both Erica and Billie-Jo Tyne are portrayed in the Picture. However, neither actress portraying Erica or Billie-Jo speaks any lines at any point during the film. In the film, the actresses are shown in a photograph in the wheelhouse of the *Andrea Gail*; both Erica and Billie-Jo admitted in requests for admissions that their father kept such a photograph in the wheelhouse of the vessel. The Picture also includes a scene depicting Erica and Billie-Jo attending their father's memorial service. Both Erica and Billie-Jo admit that they attended the memorial service. Thus, the Picture cannot be said to have portrayed Erica and Billie-Jo in a false light, because they have admitted to the factual accuracy of the scenes depicting them. The Picture's portrayal of the Tyne daughters is not sufficiently egregious in nature to establish a claim of invasion of privacy against Defendants.

*C. Invasion of Privacy—Public Disclosure of Private Facts*

Plaintiffs Debra Tigie and Dale R. Murphy, Jr. assert claims for invasion of privacy based on public disclosure of private facts. The complaint alleges that *The Perfect Storm* falsely portrays Tigie and Murphy, Jr. as living in Massachusetts. In their memorandum in opposition to the motion for summary judgment, Plaintiffs further contend

that “the depiction in the Picture of Debra Tigue as being intimately involved with another man who is about to supplant the role of decedent Murphy in the lives of both Debra Tige and Dale R. Murphy, Jr. is likewise entirely fabricated and has been advanced by Warner, as alleged in the Complaint, in knowing or reckless disregard of the truth.”

In response to the motion for summary judgment, Plaintiffs primarily argue that the details of Tigue and Murphy, Jr.’s lives, as depicted in the Picture, are of no concern to the public. The Court need not address this issue, however, because it is clear that the Picture did not disclose private facts about Tigue and Murphy, Jr.

The Restatement (Second) of Torts has recognized that an essential element of the tort of public disclosure of private facts is that the facts at issue be true. However, Plaintiffs argue that the Picture’s entire depiction of Tigue and Murphy, Jr. is fabricated and false. Because none of the facts disclosed by the picture are alleged to be true, Plaintiffs have no cause of action for invasion of privacy based on public disclosure of private facts. In a situation where the “facts” disclosed in a publication are, in actuality, false, the interest invaded is that protected by the defamation and false-light torts: the interest in being represented truthfully to the world. However, because Tigue and Murphy, Jr. did not assert claims for defamation or false light invasion of privacy, they do not have a valid cause of action, and Defendants are entitled to summary judgment on their claims.

### Restatement (Second) of Torts

cmt d. *Fictitious character.* – A libel may be published of an actual person by a story or essay, novel, play or moving picture that is intended to deal only with fictitious characters if the characters or plot bear such a resemblance to actual persons or events as to make it reasonable for its readers or audience to understand that a particular character is intended to portray that person. The fact that the author or producer states that his work is exclusively one of fiction and in no sense applicable to living persons is not decisive if readers actually and reasonably understand otherwise. Such a statement, however, is a factor to be considered by the jury in determining whether readers did so understand it, or, if so, whether the understanding was reasonable.

Illustration:

1. The A motion picture producing company produces a film based upon historical events but offered as a fictitious play. In the film, B, a young woman who was a participant in some of these events, is represented as having yielded to the hypnotic

#### § 564

*Applicability of Defamatory Communication to Plaintiff*

power of the villain. In spite of the deviations of the film from the exact historical facts, B's friends reasonably understand that she is portrayed in the picture. The film is defamatory of B.

**Jessica Litman, *Information Privacy/Information Property***

52 Stan. L. Rev. 1283 (2000)

The entire house of cards represented by Hollywood's recognition of property rights in subjects' life stories is an illusory creation impelled by the realities of financing. If one seeks either loans or investors, it helps to have a piece of property to offer as collateral. Producers of works based loosely on truth rather than fiction have no property rights in their subjects. If the central actors in the story can be persuaded to "sell" the exclusive rights to film what happened to them, then those rights become property that a producer can take to the bank, even though no court would enjoin such a production on the ground that its principals lacked such a property right or had created their production despite the fact that the relevant life story rights had been sewn up by someone else.

## F Identity Theft

**Flores-Figueroa v. United States**

556 U.S. 646 (2009)

A federal criminal statute forbidding "[a]ggravated identity theft" imposes a mandatory consecutive 2-year prison term upon individuals convicted of certain other crimes if, during (or in relation to) the commission of those other crimes, the offender "*knowingly transfers, possesses, or uses, without lawful authority, a means of identification of another person.*" The question is whether the statute requires the Government to show that the defendant knew that the "means of identification" he or she unlawfully transferred, possessed, or used, in fact, belonged to "another person." We conclude that it does.

The facts of this case illustrate the legal problem. Ignacio Flores-Figueroa is a citizen of Mexico. In 2000, to secure employment, Flores gave his employer a false name, birth date, and Social Security number, along with a counterfeit alien registration card. The Social Security number and the number on the alien registration card were not those of a real person. In 2006, Flores presented his employer with new counterfeit Social Security and alien registration cards; these cards (unlike Flores' old alien registration card) used his real name. But this time the numbers on both cards were in fact numbers assigned to other people.

The statute, the Government says, does not require a prosecutor to show that the defendant *knows* that the means of identification the

18 U.S.C. § 1028A(a)(1) (emphasis added)



defendant has unlawfully used in fact belongs to another person. But how are we to square this reading with the statute's language?

In ordinary English, where a transitive verb has an object, listeners in most contexts assume that an adverb (such as knowingly) that modifies the transitive verb tells the listener how the subject performed the entire action, including the object as set forth in the sentence. Thus, if a bank official says, "Smith knowingly transferred the funds to his brother's account," we would normally understand the bank official's statement as telling us that Smith knew the account was his brother's.

If a child knowingly takes a toy that belongs to his sibling, we assume that the child not only knows that he is taking something, but that he also knows that what he is taking is a toy *and* that the toy belongs to his sibling. If we say that someone knowingly ate a sandwich with cheese, we normally assume that the person knew both that he was eating a sandwich and that it contained cheese.

Finally, and perhaps of greatest practical importance, there is the difficulty in many circumstances of proving beyond a reasonable doubt that a defendant has the necessary knowledge. Take an instance in which an alien who unlawfully entered the United States gives an employer identification documents that in fact belong to others. How is the Government to prove that the defendant knew that this was so? The Government may be able to show that such a defendant knew the papers were not his. But perhaps the defendant did not care whether the papers (1) were real papers belonging to another person or (2) were simply counterfeit papers. The difficulties of proof along make it reasonable, in the Government's view, to read the statute's language as dispensing with the knowledge requirement.

We do not find this argument sufficient, however, to turn the tide in the Government's favor. For one thing, in the classic case of identity theft, intent is generally not difficult to prove. For example, where a defendant has used another person's identification information to get access to that person's bank account, the Government can prove knowledge with little difficulty. The same is true when the defendant has gone through someone else's trash to find discarded credit card and bank statements, or pretends to be from the victim's bank and requests personal identifying information. Indeed, the examples of identity theft in the legislative history (dumpster diving, computer hacking, and the like) are all examples of the types of classic identity theft where intent should be relatively easy to prove, and there will be no practical enforcement problem. For another thing, to the extent that Congress may have been concerned about criminalizing the conduct of a broader class of individuals, the concerns about practical enforceability are insufficient to outweigh the clarity of the

text.

### White v. Ortiz

No. 13-cv-251-SM, 2015 WL 5331279 (D.N.H. Sept. 14, 2015)

Pro se plaintiff, June White, is a resident of New Hampshire and the author of an “unauthorized biography” of her son, Dana, who is the president of the mixed martial arts (“MMA”) organization known as the Ultimate Fighting Championship (“UFC”). The defendant, Cynthia Ortiz, is a resident of Holt, Michigan. Ortiz is, it would seem, a fan of neither White nor her book.

Following the book’s release, Ortiz began publishing numerous statements on various Internet websites that were highly critical of the author. Ortiz published many (if not all) of those statements using pseudonyms, in an effort to conceal her identity. She also appears to have used social media to further her attack on White, by publishing numerous statements on Twitter while posing as “The Real June White” (“@RealJuneWhite”) – statements White says were false and demeaning comments on her character, conduct, and her book.

A representative (though by no means exhaustive) list of some examples of Ortiz’s work includes the following. While posing as “Tony Foster” (“TonyF575”), Ortiz published numerous statements on Twitter accusing White of being a bad parent, saying her children hate her and “disowned” her, asserting that she is mentally ill, and claiming she was a “barhoppin drop out 4 a mom” who “couldn’t stay out of the bars long enough” to raise her son. Under the moniker “JoeBlow,” Ortiz implied White had incestuous relations with family members (comments Ortiz elaborated upon elsewhere), was estranged from her children, and suffered from mental illness: “[White] should have stuck to doing her father and brothers instead of trying her hand at writing ... Her only daughter Kelly cut her off, too. She won’t let her kids see Grandma because she’s freakin off her rocker!”

Under the pseudonym “The Real June White,” Ortiz published a number of statements on Twitter including, for example, “I am publicly apologizing 4 ever writing that horrendous book about my son. Most wasn’t true. I am reaping what I sowed and now my only 2 children hate me.”

White asserts that Ortiz is liable for appropriating her identity – a form of invasion of privacy – by appearing on Twitter as “The Real June White” and posting false, demeaning comments about White’s character and the truthfulness of the book.

Ortiz claims she cannot be liable under a theory of identity appropriation because she did not use White’s name in an effort to obtain monetary gain or commercial success from White’s reputation, prestige or other value associated with her name. The court disagrees. The New Hampshire Supreme Court did not limit the tort exclusively

Discussion of defamation causes of action omitted.

to situations in which a defendant has employed another's name or likeness for personal financial gain; it merely listed that purpose as a fairly common example.

Here, Ortiz employed the Twitter handle "The Real June White" in an effort to leverage White's name and reputation, thus giving the false "confessions" Ortiz published presumptive credibility. Absent the use of White's name in association with those statements, Ortiz would likely have been seen as simply another crank publishing incendiary, derogatory, and demeaning comments on Twitter. But, by appropriating White's name (and the credibility and notoriety associated with that name), Ortiz added weight and validity to her posts. That act of appropriation lent value to those "confessions," and furthered Ortiz's apparent goal of perpetrating a fraud on the public, undermining sales of White's book, and ruining White's reputation. It is, therefore, actionable conduct under New Hampshire's common law, and Ortiz's motion to dismiss White's invasion of privacy claim is denied.

Does this theory usefully fill a gap between defamation and the right of publicity? Or is that gap there for a reason?

## G Plagiarism

### *Stuart P. Green, Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*

54 Hastings L.J. 167 (2002)

Again and again, plagiarists are referred to as "thieves" or "criminals," and plagiarism as a "crime," "stealing," "robbery," "piracy," or "larceny." Even some dictionaries define plagiarism as "literary theft" – a definition that is consistent with the term's etymological origin, the Latin word *plagium* (which, at Roman law, referred to the stealing of a slave or child). Yet, despite such talk, the fact is that no plagiarist has ever been prosecuted for theft.

Plagiarism has been variously defined as the act of "stealing and passing off (the ideas or words of another) as one's own," "using (another's created production) without crediting the source," or "presenting as new and original an idea or product derived from an existing source. Plagiarism thus seems to involve, in the language of the criminal law, two, or possibly three, basic "elements": two actus reus elements and a possible mens rea element. The actus reus elements are copying a work (an act) and failing to attribute such work to its author (an omission) where one has a duty to do so. The mens rea element is less clear. As we shall see below, there is a good deal of confusion over whether copying or failure to attribute must be "intentional" or "knowing," or whether plagiarism is committed even when such acts are inadvertent.

Tom Lehrer, *Lobachevsky*:

I am never forget the day I first meet  
the great Lobachevsky. In one word he  
told me secret of success in mathematics:  
Plagiarize!

Plagiarize, Let no one else's work evade  
your eyes, Remember why the good  
Lord made your eyes, So don't shade  
your eyes, But plagiarize, plagiarize,  
plagiarize... Only be sure always to call  
it please, "research."

The concept of plagiarism is embedded within the context of a complex set of social norms. To see how this set of norms functions, we begin with the proposition that people generally value the esteem of others, particularly their peers. Among the ways one can earn the esteem of one's peers is by being recognized for one's originality, creativity, insight, knowledge, and technical skill. This is particularly so among writers, artists, and scholars, who, in addition to achieving satisfaction through the creative act itself, usually wish to see those acts recognized by others.

This desire for esteem produces a norm that I shall refer to as the "norm of attribution." According to this norm, words and ideas may be copied if and only if the copier attributes them to their originator or author.

It seems obvious that there is a legitimate distinction to be made between mere influence, unconscious imitation, and inadvertent failure to attribute (on the one hand), and extensive copying that is intended to convey the impression that the copier is the original author (on the other). However forgiving we may be of the student who, as a result of sloppy note taking, neglects to put quotation marks around a sentence copied from one of his sources, most of us would not hesitate to condemn David Sumner, the plagiarist who submitted Neal Bowers's poems under his own name.

Perhaps some of the confusion about the moral status of plagiarism can be attributed to a deeper confusion about the mental element, if any, necessary for its commission. Some ethical codes prohibit only "intentional" or "knowing" plagiarism. Others prohibit plagiarism that is either "intentional" or "unintentional" – that is, they treat plagiarism as a kind of "strict liability" offense.

Should plagiarism require an intent to deceive or some other mental element, or should it be viewed as a strict liability offense? I would argue that, just as morality informs law, so too should law inform morality. If theft requires intent, and plagiarism derives much of its meaning from theft law, it seems to follow that plagiarism should also require intent. At the same time, I would modify this requirement to say that the element of intent can be satisfied by "deliberate indifference" to the obligation to attribute. That is, if the reason a person was unaware that he was copying or failing to attribute is that he was deliberately indifferent to the requirements of attribution, he should be viewed as having committed plagiarism.

Consider the recent cases involving the noted historians, Doris Kearns Goodwin and the late Stephen Ambrose. Beginning in January 2002, Ambrose was accused of failing to properly attribute works quoted in his books *The Wild Blue*, *Crazy Horse and Custer*, *Nothing Like it in the World*, and *Citizen Soldiers*. Shortly thereafter, Goodwin was accused of copying up to fifty improperly attributed pas-

The Council of Writing Program Administrators' Statement on Best Practices says:

Most current discussions of plagiarism fail to distinguish between:

1. submitting someone else's text as one's own or attempting to blur the line between one's own ideas or words and those borrowed from another source, and
2. carelessly or inadequately citing ideas and words borrowed from another source.

Such discussions conflate plagiarism with the misuse of sources.

Ethical writers make every effort to acknowledge sources fully and appropriately in accordance with the contexts and genres of their writing. A student who attempts (even if clumsily) to identify and credit his or her source, but who misuses a specific citation format or incorrectly uses quotation marks or other forms of identifying material taken from other sources, has not plagiarized. Instead, such a student should be considered to have failed to cite and document sources appropriately.

sages from the work of Lynne McTaggart, in her book *The Fitzgeralds and the Kennedys*. Both Ambrose and Goodwin acknowledged their unattributed copying (or at least some of it), which they blamed on sloppy note taking rather than any intentional or knowing deception, and promised to include proper attribution in future editions of their books.

According to newspaper accounts, Ambrose, in order to maintain his prolific, and lucrative, output of recent years, used his son, Hugh, as a collaborator, with additional research help from his four other children. The result seems to have been a loss of control over his own books. It may well be – and one can only speculate about such things – that Ambrose essentially stuck his head in the sand, purposely avoiding the possibility that he might become aware of plagiarism in his work. As for Goodwin, it seems hard to imagine how a writer could have included as many as fifty improperly attributed passages in a single book without being deliberately indifferent to the rules of attribution. Accordingly, we might say (following the Model Penal Code’s formulation of the willful blindness instruction), that both Ambrose and Goodwin possessed the “knowledge” necessary to commit plagiarism because they were “aware of a high probability” that their sources had been inadequately acknowledged.

Exactly what harms does plagiarism cause, and who are its victims? The first kind of victim that plagiarism affects is the person whose words or ideas are copied and who fails to receive credit. In the academic context, citation to one’s work can contribute, directly or indirectly, not only to psychic rewards (the satisfaction that comes from being esteemed by one’s peers) but also to monetary rewards, including grants and scholarships, tenure and promotion, and other forms of career advancement and compensation. A second kind of harm is that done to the reader who is deceived into believing that the plagiarist was the original source of such words or ideas. A third, closely related, kind of harm is that done to the institution within which the plagiarism is committed. As the Sixth Circuit stated in *United States v. Frost* (a case in which the University of Tennessee rescinded its grant of a Ph.D. degree after discovering that the degree candidate had committed plagiarism): “Awarding degrees to inept students, or to students who have not earned them, will decrease the value of degrees in general. More specifically, it will hurt the reputation of the school and thereby impair its ability to attract other students willing to pay tuition, as well as its ability to raise money.”

*Frost*: 125 F.3d 346, 367 (6th Cir. 1997)

What should we make of politicians and corporate executives who use unnamed speech writers to write their speeches, movie stars and other celebrities who use unacknowledged ghostwriters to write their memoirs, and federal and state judges who rely on anonymous law clerks to write their judicial opinions? Does the fact that such people

present work written by others as their own mean that they are guilty of plagiarism?

The first thing to note is that, in each of these cases, the actual author consents to the second comer's non-attribution. I would argue, however, that the author's consent should not be a defense to plagiarism (although consent is of course a defense to charges of theft). If a student copies a term paper from an Internet cheat site or fraternity file, the actual author has consented, but the student has nevertheless committed plagiarism, because the student has intentionally passed off another's work as his own.

The real question is whether anyone is, or could be, harmed by such conduct. When a student submits an Internet-purchased term paper as her own, she causes no harm to the original author, but she is likely to cause harm to her institution, instructor, and fellow students. By contrast, when a politician, celebrity, or judge uses language written by an unacknowledged ghostwriter, no one is harmed because—unlike students and professors—there is no cultural expectation that such people write their own copy. To put it another way, we can say that the norm of attribution does not apply to the use of ghostwriters. And because the norm of attribution does not apply, the rule against plagiarism does not apply either.

Focusing on harm rather than consent is also helpful in evaluating those cases in which a writer quotes his own work without acknowledging that such words have previously been published. I would argue that such unacknowledged self-quotation is a genuine form of plagiarism. Once again, the fact that the actual author (i.e., the plagiarist herself) "consents" to her own copying is not relevant to determining whether there is plagiarism. What does matter is that third parties, such as the self-plagiarist's readers, are deceived into believing that her work is original.

One of the most striking characteristics of plagiarism is that its investigation, adjudication, and punishment are typically committed to educational and professional institutions that resolve the charges, essentially, in private. Plagiarism is prohibited by various codes of academic and professional ethics (though, curiously, most news organizations have no such written rules). Violation of such codes can lead to a student's being failed, suspended, or expelled; professors and other employees being dismissed; and lawyers and other professionals being censured or having licenses revoked. What little litigation there is concerning plagiarism of this sort almost always involves due process-type claims brought by alleged plagiarists who challenge the procedures under which they have been institutionally sanctioned, or, in a few cases, defamation suits brought by alleged plagiarists against their accusers.

How is this "private justice" paradigm maintained? One of its dis-

tinguishing features is that students (at least at the college level and beyond), employees, and members of professional associations have subjected themselves, voluntarily, to the “jurisdiction” of the adjudicating institution; they agree, explicitly or implicitly, to abide by the rules of the guild. Such institutions tend to have special expertise in detecting and dealing with plagiarism. The teacher who is familiar with the literature from which her student has copied is probably in the best position to uncover the plagiarist’s acts and to be most sensitive to the particularities of the plagiarist’s circumstances. The institution is also likely to have the most direct interest in preserving the values that plagiarism most directly threatens.

**Jonathan Band & Matt Schruers, *Dastar, Attribution, and Plagiarism*  
33 AIPLA Q.J. 1 (2005)**

Between the oral argument and the issuance of the decision in ??, the saga of Jayson Blair, the *New York Times* reporter who had fabricated and plagiarized numerous articles, unfolded in the national media. At the heart of both cases was a knowing failure to attribute the source of information conveyed by the speaker. *Dastar* failed to reveal that much of the footage of its World War II videotape came from a Twentieth Century Fox television series; and Blair failed to reveal that he copied quotations and descriptions from other newspaper articles. And yet, *Dastar* emerged the victor in the Supreme Court, while Blair resigned and was disgraced.

This asymmetry of outcomes results from the fact that while society views plagiarism as normatively wrong, it is not, at least after the ?? decision, a violation of law. A plagiarist presents as new and original an idea or product derived from an existing source. A plagiarist also is a copyright infringer if he copies another person’s protected expression. His legal offense, however, lies in copying the expression, not in failing to attribute its source.

In ??, Fox attempted to impose legal liability on *Dastar* for non-attribution. It attempted to convert plagiarism, which violates the moral standards of many professions and communities, into a legal violation. The Supreme Court rejected this effort emphatically. The Court had a strong legal basis for concluding that plagiarism did not violate section 43(a) of the Lanham Act. But the Court also reached the right result from a public policy perspective. The “wrongness” of non-attribution depends significantly on the context in which it occurs. The law is poorly suited to make the nuanced distinctions better left to the self-regulatory mechanisms of specific communities.

Copyright protects the author’s expression. The copyright owner can file suit in federal court against any person who copies the expression without authorization. As a general matter, however, U.S. copyright law has nothing to do with attribution. Thus, a student

who uploads the latest *Harry Potter* novel to the Internet infringes the copyright regardless of whether he claims he wrote the novel himself or properly attributes it to J.K. Rowling. By the same token, if he copies something that is not covered by copyright – for example, ideas, facts, or a work whose copyright term expired – he has not infringed copyright, even if he fails to attribute the source. While copyright does not concern itself with non-attribution, non-attribution is the essence of plagiarism.

Many acts of plagiarism do not constitute copyright infringement. If a history graduate student without attribution publishes in his doctoral dissertation facts or ideas copied from articles in the field, he is a plagiarist, but not a copyright infringer. This is because copyright does not protect facts or ideas. As a plagiarist, he likely would face academic sanctions from his university. However, he would not incur copyright liability to the authors of the articles, because copyright does not extend to the facts or ideas that he copied.

Of course, copyright infringement and plagiarism may overlap. If the graduate student copies unreasonably lengthy passages of other articles in his dissertation without attribution, he is both a plagiarist and a copyright infringer. In that case, he must answer to both his university and the authors of the articles he copied. On the other hand, if he provides proper attribution for the passages, he might be a copyright infringer but not a plagiarist.

The codes of professional responsibility that set the ethical standards for practicing lawyers are silent on the subject of plagiarism. Presumably, few lawyers think twice when duplicating formatting suggested by *Bender's Federal Forms*, or downloading templates from a court website. One court found "no impropriety" in the fact that "legal instruments are widely plagiarized." Not only would contravening this convention require the continual reinvention of the wheel at a client's expense, but it would also undermine the benefits of lawyers practicing as a group.

Similarly, trial courts frequently order parties to prepare proposed findings of fact and law, and then incorporate these proposed findings in the final opinion, without attribution. Sometimes a court will adopt one party's proposed findings almost verbatim. The other party might argue to the appellate court that this wholesale plagiarism demonstrates the trial court's bias or a failure to consider all the evidence, but rarely does that appellant argue that the plagiarism itself was improper. Judge Richard Posner notes that judges freely plagiarize their colleagues because "no value is attached to originality." On the contrary, members of the judiciary hope to "conceal originality and pretend that their decisions are foreordained."

*Fed. Intermediate Credit Bank v. Ky. Bar Ass'n*, 540 S.W.2d 14, 16 n.2 (Ky. 1976)

**Gregory N. Mandel, Anne A. Fast & Kristina R. Olson, *Intellectual***



*Property Law's Plagiarism Fallacy*

2015 BYU L. Rev. 915

Intellectual property law suffers from somewhat of an identity crisis. A robust debate has raged for decades concerning how intellectual property law can best incentivize creation and whether it should have more of a natural rights or commons bent than current doctrine. This debate has been ignorant of a critical fact. To the public, intellectual property law is not about these traditionally identified objectives. Rather, in the public mind, the primary objective of intellectual property law is to prevent plagiarism. Across a wide variety of subject matters and contexts, people tend to believe that simply providing proper attribution to the originator of a creative work or invention should enable the free copying of that work by others. These results hold in a diverse range of circumstances that would constitute intellectual property infringement under the law.