



THE JOURNAL OF THE
INDIANA STATE BAR
ASSOCIATION

RES GESTÆ

November 2001

Vol. 45, No. 4

**LEGAL COMMUNITY
COMES TO THE AID
OF ITS OWN, ONLINE**

**LEGAL ETHICS COMMITTEE
OPINION NO. 2 OF 2001**

**WITH INDIANA'S LAW AS A MODEL,
STATE-BASED RIGHT OF PUBLICITY
READY TO MOVE TO THE FEDERAL LEVEL**

**THE NEXT 50 YEARS: WHAT IS THE
FUTURE OF THE PRACTICE OF LAW?**

Spreading Its Wings and Coming of Age: With Indiana's Law As A Model, The State-Based Right of Publicity Is Ready to Move to the Federal Level

Editor's Note: Jonathan L. Faber and Wesley A. Zirkle, both of Indianapolis, are the first-place recipients of the Harrison Legal Writing Award. Established in 1996 by ISBA Written Publications Committee, the Harrison Legal Writing Award commemorates the first president of the Indiana State Bar Association, former U.S. President Benjamin Harrison, and recognizes articles of significant subject matter, practicality and timeliness, with high quality research and legal analysis. Plaques and cash prizes (funded by the ISBA Insurance Agency) were recently awarded to first-, second- and third-place winners at the State Bar's 105th Annual Meeting in South Bend. The second- and third-place articles will be published in upcoming issues of Res Gestae.

"Our destiny exercises its influence over us even when, as yet, we have not learned its nature: it is our future that lays down the law of our today."¹

Within the Intellectual Property law family, the maverick Right of Publicity appears to have outgrown its status as a state-based doctrine. The Right of Publicity consistently attracts attention from legal scholars and commentators in comparison to its more familiar cousins, trademark and copyright. Much of the controversy centers on the proper parameters of this emerging, state-based legal doctrine, as high-profile litigation and various legislative efforts to enact or amend publicity rights statutes fuel the debate. By virtue of having the most progressive Right of Publicity statute in the nation, Indiana represents ground zero in one of the most fervently contested areas of the law. Eventually, the Right of Publicity will move to the federal level; when it does, Indiana is posed to serve as the model for the future of the emerging Right of Publicity.

A Crash Course On The Right of Publicity

The Right of Publicity as a legal doctrine is still in its infancy, but Indiana's 1994 statutory entry in the annals of Right of Publicity development, as embodied in Indiana Code §§32-13-1-1 through 32-13-1-20, gave the doctrine a dose of puberty-inducing testosterone through "one of the most sweeping right of publicity statutes in the nation."² The Right of Publicity describes every individual's right to control the commercial use of his or her persona, which is the property interest embodied in an individual's "name, voice, signature, photograph, image, likeness, distinctive appearance, gestures or mannerisms."³

The Right of Publicity captures the attention of the legal community due to the fact that Right of Publicity disputes almost always involve celebrities. Every person possesses a Right of Publicity, not just famous individuals, a point noted by the foremost Right of Publicity scholar, J. Thomas McCarthy.⁴ However, it is a celebrity's name and image that advertising agencies and companies seek out as a promotional tool to hype advertisements and sell products. To be sure, being famous constitutes a pragmatic prerequisite to having a Right of Publicity of value on the open market.

Because every person has an enforceable Right of Publicity, the origin of one's fame, or that for which a person is known, is not especially important—though it may impact the revenues that can be generated through licensing a particular person's Right of Publicity. Recent advertising campaigns which implicate the Right of Publicity have featured such diverse personalities as President Bill Clinton in a print advertisement for Fizzy Lab,⁵ footage of Jackie Robinson in a television commercial for AIG Insurance, a re-animated John Wayne in Coors Light commercials,⁶ Amelia Earhart

in Apple Computer's "Think Different" campaign, and the \$50,000 Shaq SST Ford Expedition, which Shaquille O'Neal helped design, marking "the first time an athlete's name has appeared on an automaker's vehicle."⁷

Meet the Family: the Right of Publicity as a Distinct Doctrine

In order to properly comprehend the Right of Publicity as a distinct legal theory with its own policy rationales and vibrant history of precedent, one must not confuse the doctrine with its more recognized cousins in the intellectual property family, copyright and trademark. "[Right of publicity] is a distinct legal category, not just a 'kind of' trademark, copyright, false advertising or right of privacy."⁸

The Right of Publicity could hardly be more distinct from copyright, though that distinction does not prevent the frequent juxtaposition between the two doctrines. Copyright applies to the rights one acquires in "original works of authorship fixed in a tangible medium of expression."⁹ Simply stated, copyright applies to the static rights embodied in a creative work itself. In contrast, the Right of Publicity is the dynamic right of an individual that is not tied to any particular work, but rather applies to commercial applications incorporating that individuals' name, image or likeness. A person's name, image, or likeness can never constitute a "work of authorship" for copyright purposes, and nothing about the fundamental Right of Publicity can be copyrighted. Because these are wholly distinct doctrines, federal copyright does not preempt the state-based Rights of Publicity. For instance, an advertisement featuring Bobby Knight's picture requires authorization from the photographer who took the picture for the copyright use, and from Bobby Knight for the use of his Right of Publicity.



Jonathan L. Faber
CMG Worldwide, Inc.
Indianapolis, Ind.



Wesley A. Zirkle
CMG Worldwide, Inc.
Indianapolis, Ind.

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Unlike the clear distinction between copyright and the Right of Publicity, trademark law exhibits some of the same policy rationales supporting the Right of Publicity. Both trademark and the Right of Publicity share the analytical filters of unfair competition and misappropriation.¹⁰ Like a trademark, the Right of Publicity can function as a quality assurance to a consumer, especially if a celebrity monitors quality standards in licensing the use of the Right of Publicity. Trademark owners and publicity rights owners also both seek to prevent others from reaping unjust gains by appropriation of the mark or celebrity's fame.

Perhaps the most fundamental distinction between copyright and trademark on the one hand, and the Right of Publicity on the other, is the fact that copyright and trademark emanate from federal laws while the Right of Publicity remains a state-based doctrine. Certain aspects of state copyright and trademark statutes remain in force yet today to the extent that the Federal laws do not address a particular issue proscribed on the state level. If the evolution of copyright and trademark law serves as a reliable predictor, the Right of Publicity is on course for moving to the Federal level, which will present a multitude of advantages in the application and consistency of the doctrine in practice.

Policy Rationales for the Right of Publicity: Compensation and Control

Examples of the Right of Publicity permeate our society, yet few realize its pervasive presence. Whenever you see a Marilyn Monroe Franklin Mint doll, a Kobe Bryant Adidas commercial, or Katherine Hepburn in a Longines print advertisement, you are witnessing manifestations of the celebrity-licensing industry which is predicated upon the Right of Publicity. The synergy between celebrities and

advertising campaigns or merchandise is being capitalized upon at an ever-increasing rate.¹¹ While financial considerations often are the motivating factor behind such arrangements, there is more to the Right of Publicity than merely providing a source of revenue for famous individuals or their heirs.

It is no surprise that if Britney Spears endorses a product, sales will improve as the "hipness" of the product is confirmed. If the popularity of a celebrity and the loyalty of his or her fans provides a potential source of profit to any person or entity that can exploit a celebrity for commercial purposes, the company or advertiser which uses that celebrity without paying the licensing fees for clearance of the Right of Publicity can ensure an even larger profit margin by exploiting a celebrity without their knowledge or consent. Typically, such an infringer underprices competitors who have properly licensed and paid for the use of the celebrity.¹² The stakes are high, however, as the sizable damages awards in Right of Publicity cases consistently confirm when an infringer is caught and held liable.

The ability to control commercialization in the first place is as much a policy objective of the Right of Publicity as is providing revenue streams for the rightful recipient. If compensation were the sole objective, a standardized statutory fee might be advisable (which it is not), similar to the statutory rates for mechanical licenses for the use of copyrighted music. Control over one's image allows an individual to prohibit the use of their right of publicity for any reason, whether the use is morally objectionable to the individual or whether they give no reason whatsoever for withholding the right.

As a rubber to road example, the Estate of Humphrey Bogart rejects licensing opportunities that exist with tobacco companies, despite the

fact that such opportunities would be extremely lucrative because of the perpetual appeal of Humphrey Bogart, and because there are numerous famous images of Bogart smoking. The reason for their rejection of such opportunities? Humphrey Bogart died of cancer. It would be unconscionable if the children of Humphrey Bogart and Lauren Bacall had to endure exposure to advertising campaigns for tobacco products playing off of famous images of their father smoking, thereby promoting the very thing which caused their father's death. The Right of Publicity exists in part to ensure that a celebrity or her heirs can prevent undesirable or unsavory commercialization of their loved one. As Vince Lombardi Jr. has said: "Nothing anyone can do is going to enhance my father's reputation, but they certainly can detract from it."¹³

What do *Los Angeles Magazine*, *Cheers Restaurants*, the *Three Stooges*, and *Princess Diana* Have in Common? Recent Right of Publicity Case Law

The case history of the Right of Publicity exhibits much of the growth of the doctrine, but also reflects the way in which a federal Right of Publicity statute would be of enormous benefit. The phrase "Right of Publicity" was first coined in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*¹⁴ In *Haelan*, the court focused on the right of a person to license his likeness for a profit. "We think that, in addition to and independent of that right of privacy... 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."¹⁵ Judge Jerome Frank reasoned that this right is

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necessary to ensure that moral justice prevails in the market. “[I]t is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements, [and] popularizing their countenances.”¹⁶

The Supreme Court of the United States has reviewed the Right of Publicity only once, but it has thereby provided critical guidance that the Right of Publicity does not inherently conflict with the First Amendment. *Zacchini v. Scripps-Howard Broadcasting Co.* involved a “human cannonball” who did not want his entire fifteen-second performance televised on the local news because he felt that televising the event would reduce the number of people willing to pay to see his act.¹⁷ The Court rejected the Broadcasting Company’s First Amendment defenses, noting that the decision was not merely to ensure compensation for the performer; rather, it was to provide “an economic incentive for him to make the investment required to produce a performance of interest to the public.”¹⁸ The law serving as an incentive to create is not unique to Right of Publicity, as the incentive concept also buttresses the existence of copyright and patent laws.

Following *Zacchini* and throughout the second half of the Twentieth Century, numerous noteworthy and fascinating cases have issued from jurisdictions all over the country which define and expand the doctrine.¹⁹ Several of the most recent examples involved Dustin Hoffman, the Norm and Cliff characters from the television show *Cheers*, and the Three Stooges.

In January of 1999, Dustin Hoffman sued a magazine publisher for infringing upon his Right of Publicity.²⁰ *Los Angeles Magazine* digitally manipulated movie still

shots of celebrities to make it appear that the celebrities were wearing modern designer clothing. For example, Dustin Hoffman’s character in *Tootsie* was dressed in a Richard Tyler gown and Ralph Lauren heels. Though it was clear from the photo editorial that Hoffman personally did not endorse these designers, he nevertheless was awarded \$3,270,000 for the violation of his publicity rights.²¹

George Wendt and John Ratzenberger, who played Norm and Cliff respectively on the television show *Cheers*, also were recently forced to assert their Right of Publicity against an infringer.²² A multi-location theme restaurant based around the barroom set of *Cheers* decided to place two robots at the end of the bar where Norm and Cliff always appeared in the show. The robots “perform” soundbites of Norm and Cliff lines from the show. The case received considerable media attention but ultimately, Host International, owner of the Cheers establishment, settled with the actors while the appeal of the lower court’s decision was pending.

Another recent Right of Publicity case, *Comedy III Productions Inc. v. Gary Saderup, Inc.* reads as a *tour de force* analysis of the Right of Publicity, in which the judge defends the existence of the Right of Publicity against overreaching First Amendment arguments presented by the defendant.²³ At issue was an artist’s depiction of the Three Stooges on t-shirts and lithographs. The defendant argued that his merchandise was protected because it was “newsworthy” by virtue of the fact that the Three Stooges once made headlines. The judge rejected this argument and ruled that newsworthy defense has a timeliness component to its successful employment. Regarding the broader First Amendment defenses that were raised, the court held for the plaintiff and developed a new balancing test to de-

termine when the Right of Publicity trumps an artist’s First Amendment rights. When a celebrity is the subject of a work of art which is not an original single work of art, the celebrity’s publicity rights are outweighed by the artist’s right to commercially produce his art only when the work is “sufficiently transformative.”²⁴ In determining whether a work is sufficiently transformative, the relevant inquiry is whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.”²⁵ To put it another way, “when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the right of publicity.”²⁶

Of all the recent Right of Publicity cases, none exemplifies the critical need for a federal Right of Publicity more than *Cairns v. Franklin Mint*.²⁷ *Cairns* involved the use of Princess Diana’s Right of Publicity by one of the world’s largest gift and collectible companies, Franklin Mint. Simply stated, the Estate of Diana, Princess of Wales lost its case against Franklin Mint in the lower court for Franklin Mint’s issuance of collectible Princess Diana dolls and plates. Under California’s choice of law rule in a property-related dispute, the court held that it must look to the domicile of the decedent to determine if the Estate of Diana, Princess of Wales possessed an enforceable Right of Publicity in the first place. Currently, the United Kingdom does not recognize a post-mortem Right of Publicity. Hence, the *Cairns* court concluded that the Estate did not have an enforceable Right of Publicity, even though California has a very plaintiff-friendly publicity statute on the books. The application of California’s choice of law rule by the

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Cairns court appears inconsistent with California's precedent on this issue, and the case remains under appeal. A decision is not expected until late 2002.

The controversy of the *Cairns* decision, and the unpalatable result that Princess Diana may not have an enforceable Right of Publicity in California under this decision, could have been avoided if California's statute dispensed of the issue of domicile as the Indiana statute does. That Indiana dispenses of domicile is one of the contentious aspects of the Indiana publicity statute, but as detailed in the following section, it is also one of the most useful and important. The domicile provision in the Indiana statute distinguishes it from other state statutes, and it will be one of the most critical provisions in a federal Right of Publicity statute when one is eventually implemented.

A Patchwork of Laws: Championing the Indiana Statute

Sixteen states presently recognize the Right of Publicity via statute,²⁸ and the majority view is that the right exists by common law in every state that has not defined its position through legislation.²⁹ An ever-increasing number of states are implementing Right of Publicity statutes, with Washington and Ohio as the most recent. The legislature of Michigan is presently considering adopting its own publicity statute.

The Right of Publicity began its journey late in the Nineteenth Century, with an article written by Louis D. Brandeis and Samuel D. Warren in 1890³⁰ in which the authors expressed concern that photographic technology could be used to take a man's portrait which could then be used without his knowledge and consent. Shortly thereafter in 1903, New York passed the first Right of Publicity statute through New York Civil Right Law, sections 50 and 51, in 1903. Section 50 of New York's

statute prohibits "a person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person." By virtue of being first, and because it viewed the Right of Publicity through a Right of Privacy vantage point, New York became entrenched in a statutory construction which does not recognize a deceased individual's Right of Publicity.

If the Right of Publicity is a personal right, the right dies with the individual. While this analytical approach served its purpose when New York was forging new terrain, the Right of Publicity is more properly viewed as a property right, which is now an accepted and proven proposition. Nevertheless, New York to this day does not recognize a post-mortem Right of Publicity, which is unfortunate given the prominence of the jurisdiction.³¹ If the Right of Publicity does not make it to the federal level first, it is possible that New York will eventually amend its law on this point as efforts to do so have been attempted on numerous occasions.

On the other side of the nation, California stands as perhaps the most important jurisdiction to have codified the Right of Publicity due to the concentration of the entertainment industry in Los Angeles, and the fact that many celebrities call California home. As such, the California judiciary sets the pace for Right of Publicity development because it confronts the majority of Right of Publicity cases that become headlines. In 1999, California amended its post-mortem right of publicity statute, formerly embodied in California Civil Code Section 990, by enacting section 3344.1, which increased the post-mortem right from fifty to seventy years duration. Nicknamed the "Robyn Astaire Bill" because Fred Astaire's widow, Robyn

Astaire, was the catalyst for Senate Bill 209, the controversial bill was backed by the Screen Actors Guild and countless celebrities and celebrity estates, including Tom Cruise, Michael Douglas, and the Estates of Babe Ruth and Mickey Mantle among many others. Senate Bill 209 was opposed by all the major movie studios and the Motion Picture Association of America.

In the effort to amend the California statute, supporters of the bill referenced the Indiana statute as a model for the California legislature to follow.³² Other jurisdictions have either followed Indiana's statute explicitly, or at least implicitly by passing publicity statutes with similar provisions.³³ The Indiana statute is truly an exemplary statute in both its clarity of drafting and ease of application, both of which represent ideals often aspired to but rarely achieved in the drafting of legislation.³⁴

The proprietary nature of publicity rights in Indiana is reflected in Section 16 of the Indiana statute. The provision states: "The rights recognized under this chapter are property rights, freely transferable and descendible, in whole or in part." These proprietary rights may be transferred "by contract, license, gift, trust, testamentary document and [by] operation of the laws of intestate succession applicable to the state administering the estate and property of an intestate deceased person, regardless of whether the state recognizes the property rights set forth under this chapter." This provision ensures that the Right of Publicity will transfer upon the death of an individual, whether the individual consciously chose to make the transfer, or if the individual failed to recognize the importance of his or her publicity rights and did not make a specific bequeathment or assignment of the right. Fortunately, most wills contain residual clauses by which all non-specific bequests

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pass to the residual beneficiary. Thus, the Right of Publicity often transfers by will, even when it is not specifically articulated in the document.

Indiana provides for the longest post-mortem publicity rights duration in the United States. Recognition of post-mortem rights varies dramatically from state to state. For example, Tennessee recognizes the right for ten years after death, Virginia for twenty, Florida for forty, Kentucky, Nevada, and Texas for fifty years, California for seventy years, and Washington for seventy-five years. Section 8 of the Indiana statute states: “A person may not use an aspect of a personality’s Right of Publicity for a commercial purpose during the personality’s lifetime or for 100 years after the date of the personality’s death....” With such substantial variations between states in the term of post-mortem protection, it is understandable that Indiana’s publicity statute attracted much attention upon passage. It is conceivable that the duration of a Federal statute should be even longer, or perhaps not expire unless and until the individual’s publicity rights are not promoted or protected for a continuous five year period.³⁵

Indiana’s statute, like most publicity statutes, contains various exceptions that address First Amendment concerns and carve out certain works that are considered of such inherent social utility that the Right of Publicity must not impede their creation. Specifically, Section 32-13-1-1(c)(1-3) states that the provisions do not apply to books, films single and original works of art, or for news reporting purposes. These exemptions also ensure that a newspaper publisher, for instance, will not be liable for publishing a third-party’s advertisement that contains an infringement of an individual’s publicity rights. Additionally, artists are ensured the right to create single and original works

of art, but the right does not extend to allow mechanically reproduced copies of the work. Mechanically reproduced copies of artwork are no longer single and original works, and are obviously commercially rather than artistically motivated. If the merchandise and advertising that implicate the Right of Publicity are deserving of Constitutional protection as a form of speech, it is generally of the commercial speech variety which historically receives the lowest level of judicial scrutiny.³⁶ A federal Right of Publicity statute should include the same exceptions for First Amendment purposes as those contained in the Indiana statute for at least two reasons: 1) to ensure that the draft statute could get passed in the first place, and 2) to protect the integrity of the doctrine and to prevent it from unnecessary criticism and resistance that would ensue if it were viewed as an affront to such sacred, inalienable rights as free speech.

Indiana’s Right of Publicity statute provides for a variety of remedies and damages, including statutory damages, punitive damages, attorney’s fees, and injunctive relief. Damages in publicity cases are measured by the commercial injury to the business value of personal identity, which in turn can be determined by the compensation involved in prior licensing arrangements in which the personality was utilized. Infringement damages can be calculated not only by the fair-market value of the plaintiff’s identity, but also by the infringer’s actual profits, or by the loss of other licensing opportunities, as stipulated in sections 10 through 13. If an infringement is willful or intentional, the plaintiff may elect treble or punitive damages. In certain circumstances, disgorgement can provide an appropriate measure of damages for a Right of Publicity infringement. Additionally, plaintiff can seek an injunction for the impound-

ment of the infringing merchandise. These provisions should likewise be a material component in a federal Right of Publicity statute.

Indiana’s publicity statute also provides for statutory damages, which is a useful and critical provision. Indiana Code 31-13-1-10 allows for minimum damages of \$1,000 in the event of an infringement. This provision ensures that would be infringers are not able to “test the market” by issuing an infringement that would otherwise be actionable but which may not cause measurable damages to the personality. The statutory damages therefore serve as a deterrent, providing that an infringement of any kind subjects the infringer to liability of no less than \$1000. If and when the Right of Publicity moves to the federal level, the statutory damages should be increased by possibly as much as three hundred percent. On this point, the Texas Right of Publicity statute (also known as the “Buddy Holly bill” because the widow of Buddy Holly, Maria Elena Holly, organized the effort to pass the Texas Right of Publicity statute³⁷) provides greater protection than Indiana by providing statutory damages in the amount of \$2,500.

Perhaps the single most important feature of the Indiana Right of Publicity statute is the fact that it dispenses of the issue of domicile—in the first clause of the statute, no less, which underscores the significance of the provision. By dispensing of domicile, the Indiana statute applies to any act or event that occurs in Indiana, regardless of a personality’s domicile, residence or citizenship. This provision thus makes an infringement that enters Indiana actionable upon very simple and easily understood criteria. Similarly, a federal Right of Publicity statute must include a provision that dispenses of domicile, which would eliminate complicated and potentially convoluted choice of law issues

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such as those which led to the unfortunate result in the aforementioned case of *Cairns v. Franklin Mint*.

The Mechanics of Federalization

The Patent, Trademark and Copyright Section of the American Bar Association in 1995 began efforts to draft a federal Right of Publicity with the intent that it could then promote through the appropriate channels, but the effort never made it out of sub-committee. More recently, at an ABA meeting in Atlanta in August of 1999, a referendum to form a committee to review the possibility of drafting a federal publicity statute was passed. While these efforts over the years have lost momentum under the strain of unresolved debate by powerful lobbying forces, similar to the forces at conflict in the California Senate Bill 209 initiative, the idea of federalizing the Right of Publicity is consistently renewed by scholars, organizations, and special interest groups.³⁸

The Commerce Clause gives Congress the power to regulate interstate commerce, which would allow for a federal Right of Publicity to be implemented in the first place. Under the established principles of choice of law analysis, the federal Right of Publicity would preempt the state-based laws, at least to the extent that there are inconsistencies between the two laws. However, the state-based statutes would remain in place, in that there would likely be provisions in some states on which the federal statute is silent. In this event, the state statute would still have validity and remain in full force and effect.

If and when a federal Right of Publicity statute is enacted it will standardize the parameters of a potentially unruly doctrine. Results of litigated disputes would necessar-

ily become more uniform and the existence of the law will become more widely understood, thereby reducing the frequency of unwitting infringers who would otherwise not intend to violate a personality's Right of Publicity, but for their erroneous assumptions that, for example, a deceased personality is in the public domain. In today's borderless economy, the diversity of state right of publicity laws places a tremendous burden on merchants and advertisers to comply with the most stringent state laws for any national advertising campaigns or nationally distributed merchandise. Even by a conservative estimate, many merchants and advertisers are unaware that there is a legal doctrine out in the ether called the Right of Publicity which protects not only living but also deceased celebrities.

Another advantage of a federal Right of Publicity would be the reduction of forum shopping. Currently, the variances from state to state could conceivably create an environment in which a plaintiff will selectively find the jurisdiction in which a claim can be brought and which provides the greatest advantage to plaintiff. However, it is noteworthy that while the potential for forum shopping is often cited as a problem with the current state-based regime, there is no evidence that Indiana is methodically sought out as an especially favorable forum for plaintiffs. In fact, there are no reported Right of Publicity cases on the books in Indiana. Nevertheless, a federal Right of Publicity would eliminate the potential for forum shopping, which is generally regarded as an undesirable technique in the practice of law.

A provision not included in the Indiana statute, but which would nonetheless simplify the application of the federal statute in practice, involves an express Statute of Limitations time period in which an infringement must be prosecuted.

Ohio's Right of Publicity statute, through section 2741.07(C), sets the limit at four years.³⁹

Many state statutes require that an owner of a Right of Publicity assert their rights and provide a form of notice to the public through a registry mechanism, while other states merely make the registry optional and not a prerequisite to asserting the Right of Publicity against an infringer. Indiana does not have such a provision, which is the proper approach because it eliminates potential bureaucratic complications.

As far as the proper placement for a federal Right of Publicity goes, some have proposed that the proper location for a federal Right of Publicity statute is in the Lanham Act.⁴⁰ While this could be the best location for the federal statute—certainly in comparison to placement in proximity with copyright—problems could arise through interpreting the Right of Publicity as a species of trademark. The best alternative would be for the federal Right of Publicity to stand on its own in order to preserve its own distinct characteristics and engaging and rich history of development.

Conclusion

“The law must be stable, but it must not stand still.”⁴¹

The beauty of the American legal system is reflected in the fact that ours is a dynamic, responsive system designed to ensure justice is served in accordance with the needs of the American people in every age and era. One only needs to look to the U.S. Constitution to witness the profound brilliance in the document that allows for constant change and adaptability as needed for the growth of our democracy.⁴²

The significance of the Right of Publicity as a distinct legal doctrine has stood the test of time over the course of a century-worth of development. The policies and purposes

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underlying the existence of the law in the first place are critically important, even if they only impact famous individuals in most instances, and it is worth noting that famous individuals often help float entire industries, like advertising, sports memorabilia, franchise and team sports, celebrity-licensing, and publishing. A world without a Right of Publicity would be extremely problematic and the situations that would arise in the absence of the doctrine would be more severe and complicated than one initially might expect.⁴³

In a real sense, the Right of Publicity is analogous to the fish in Helen Palmer's classic children's book *A Fish Out of Water* in which the fish, constantly being fed by the overzealous boy who owns him, grows out of his fish bowl, then progresses from a vase, to a cooking pot, and eventually to a swimming pool. There comes a time when new accommodations must be provided, and within the Intellectual Property family, the Right of Publicity has reached its time to move out of its state-based housing and up to the federal level along with copyright and trademark law. Because of its efficiency and the profound importance of its progressive provisions, the Indiana Right of Publicity statute should serve as the model for any attempt to federalize the Right of Publicity.

ENDNOTES

1 Friedrich Wilhelm Nietzsche, *Human, All Too Human*. 1878 at 7.

2 J. T. McCarthy, *The Rights of Publicity and Privacy*, Second Edition, Section 6.57.

3 Indiana Code §32-13-1-7 (1-9).

4 McCarthy, *supra* note 2, at 4:3.

5 Incidentally, this advertisement constitutes an infringement as the

company did not have authority from former President Bill Clinton to use his Right of Publicity. Yes, even politicians have an enforceable Right of Publicity, subject to certain heightened First Amendment issues.

6 On September 5th of 2000, author Jonathan Faber was an invited expert guest on a Detroit-area live talk show dedicated to the topic of George Orwell's estate suing the Big Brother Production Company responsible for the CBS television show *Big Brother* based on a copyright infringement claim that the show constituted a derivative work of Orwell's *1984*. In the context of the discussion, and much to the chagrin of the host, Mr. Faber referenced the increasing capacity of technology to allow for deceased celebrities to appear in new works through re-animation techniques, such as the Coors Light commercial with John Wayne threatening would-be bar-room bullies and the Dirt Devil commercial with Fred Astaire dancing with a vacuum cleaner. Without debating the myriad moral, ethical and legal issues involved, it will not be long before a "new" Elvis Presley movie, for example, could be created in a seamless and convincing manner based on existing video and audio footage of Elvis.

7 *Sports Illustrated*, June 18, 2001, at 30.

8 McCarthy, *supra* note 2, at 1:3

9 17 U.S.C. Section 102 (a)

10 As an example of the proximity between trademark and the Right of Publicity, see *Motown Record Corp. v. Hormel & Co.*, in which trademark laws were used to protect the "persona" of the legendary music group, the Supremes. 657 F. Supp. 1236 (C.D. Cal. 1987).

11 Consider the relatively recent merger of advertising giant McCann-Erickson (clients include GM and Coca-Cola) and the publicity firm PMK (clients include Tom Hanks and Tom Cruise). Chris Taylor, "Marriage of Convenience: It's Gen-

eral Motors on Line One, Mr. Redford," *Time Magazine*, Feb. 22, 1999 at 22. The union demonstrates how celebrity icons can help establish the branding of a trademark. "Branding," an industry buzz-word, is the elusive goal of every corporation's marketing department because of the empirical evidence which confirms that consumers often buy a particular product merely because of familiarity with the name and logo of the product. From Pepsi's perspective, it does not hurt if the most popular teen pop singer of the moment ostensibly drinks and is loyal to Pepsi instead of its competitor, Coca-Cola. Of course, Coca-Cola is free to go out and get an equally popular teen pop singer who conveniently is a Coke devotee, who can therefore appear in Coke's advertisements.

12 Licensing fees can be very sizable, depending upon the value of the celebrity to the licensee's campaign. Any entity that can exploit the celebrity without paying licensing fees incurs less overhead in the process of bringing the product to the marketplace and can therefore undersell its competitors.

13 Mark Hyman, "Dead Men Don't Screw Up Ad Campaigns," *Business Week*, March 10, 1997.

14 202 F.2d 866 (2nd Cir. 1953).

15 *Id.*, at 868

16 *Id.*

17 433 U.S. 564 (1977)

18 433 U.S. 564, 576 (1977).

19 For example, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) involved similar fact patterns in that both Bette Midler and Tom Waits declined to lend their distinctive voices to advertising jingles for two prominent manufacturers. The advertisers proceeded to find performers who could duplicate the vocal styling of Bette Midler and Tom Waits. Both Midler and Waits prevailed on Right of Publicity claims

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which yielded \$400,000 for Midler and \$2,500,000 for Waits several years later. In another famous impersonator case, *White v. Samsung Electronics America, Inc.*, Samsung utilized a robot that looked and acted like Vanna White of “Wheel of Fortune” fame. 971 F.2d 1395 (9th Cir. 1992). Samsung deliberately dressed the robot like Vanna White and made the robot turn letters like Vanna White’s role on the longest-running game show in history, *Wheel of Fortune*. Through the \$403,000 she was awarded, Ms. White received a small fortune of her own.

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

21 Numerous other noteworthy Right of Publicity cases have come down over the years. *Carson v. Here’s Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983) and *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) are significant in that neither case involved the name or image of the famous individual implicated in the case. The former of these cases involved the well-known “Here’s Johnny” introduction of Johnny Carson on the *Tonight Show* in an advertisement. The latter involved an advertising use of a certain race car that was identifiable as belonging to a specific driver. In each case, the companies were infringing because of the unequivocal association that the public could make between the phrase and the car, and the famous individuals associated therewith.

22 *Wendt v. Host International Inc.*, 197 F.3d 1284 (1999).

23 Supreme Court of California (April 30th 2001), 2001 Cal. LEXIS 2609.

24 *Id.* at 41.

25 *Id.*

26 *Id.* at 46.

27 *Cairns v. Franklin Mint Co.*, 24 F.Supp.2d 1013 (C.D. Cal. 1998)

28 Cal.Civ. Code 3344 (Deering

1995); Fla. Stat. Ann. 540.08 (West 1997); Ind. Code Ann. 32-13-1 et seq. (Michie 1995); Ky. Rev. Stat. Ann. 391.170 (Baldwin 1984); Mass. Gen. Laws Ann. Ch. 214 3A (West 1994); Neb. Rev. Stat. 20-201-20-211 (1979); Nev. Rev. Stat. 597.810(1)(b)(1993); Okla. Stat. Ann. Tit. 12 1449 (1986); R.I. Gen. Laws 9-1-28 (1956); Tenn. Code Ann. 47-25-1104 (1984); Utah Code Ann. 45-3-1 (1981); Va. Code Ann. 8.01-40 (1977); Wash. Rev. Code Ann. 63.50-040-070 (West 1998); Wis. Stat. Ann. 895.50 (West 1977).

29 The American Law Institute’s Third Restatement of Unfair Competition (1995) §46 also recognizes the Right of Publicity as a distinct legal theory.

30 Louis D. Brandeis and Samuel D. Warren, *The Right to Privacy*, 4 Harv. L. Rev. 193 (1890). The basis of the right to prevent such a use lies in the common conception of property rights, not privacy rights. “The right of property, in its widest sense, including all possession, including all rights and privileges, and hence embracing the right to an inviolate personality, affords alone that broad basis upon which the protection which the individual demands can be rested.” *Id.* at 211. Thus, Brandeis and Warren were the first to recognize an individual’s own likeness constitutes his unique property.

31 New York’s limiting viewpoint was addressed by Judge Jerome Frank in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* In his decision, Judge Frank distinguished the “right of publicity” from the “right of privacy” by focusing on the economic interests involved, rather than the personal interests characteristic of the right of privacy. *Haelan* is also cited as the first articulation of these interests as the Right of Publicity. See also Alison Sachs, “It’s Up To You, New York – It’s Time for a Statutory Right of Publicity,” 20 Colum.-VLA J.L. &

Arts 59 (1995) in which the author argues that the time has come for New York to recognize a post-mortem Right of Publicity.

32 See “Senate Bill 209: The Facts.” This document was prepared by the Screen Actor’s Guild in response to lobbying efforts by the movie studios to sway the California legislature against the bill.

33 For example, the most recent Right of Publicity statutes to be passed, Washington and Ohio, passed laws with a post-mortem duration of 75 and 60 years respectively, placing them near the top of the list of states with the longest post-mortem duration.

34 It has been said that watching legislation being made is like watching sausage being made – you don’t want to see it.

35 It is the author’s personal knowledge that attorneys from Elvis Presley Enterprises recently argued at a roundtable subcommittee meeting on the topic of a draft Federal statute that publicity rights should never expire, which is perhaps an attractive and meritorious position.

36 McCarthy, *supra* note 2, at 8:18

37 *Texas Monthly*, February 2001, at 108. In addition, author Jonathan Faber works closely with Maria Elena Holly and she has reminded him of this point on numerous occasions.

38 See generally Marci A. Hamilton et al, Symposium: *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*. 16 Cardozo Arts & Ent. L.J. 209 (1998). Also see: Eric J. Goodman, “A National Identity Crisis: The Need for a Federal Right of Publicity Statute,” 9 *DePaul-LCA J. Art & Ent. L.* 227 (1999); Richard S. Robinson, “Preemption, The Right of Publicity, And A New Federal Statute,” 16 *Cardozo Arts & Ent L.J.* 183 (1998); Bruce P. Keller & David H. Berstein, “The Right of Publicity: Towards A Federal Statute,” 1076 *PLI/Corp* 61 (1998); J.

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Steven Bingman, Comment, "A Descendible Right of Publicity: Has The Time Finally Come For A National Standard?," 17 *Pepp. L. Rev* 933 (1990); J. Eugene Solomon, Jr., Note, "The Right Of Publicity Run Riot: The Case For A Federal Statute," 60 *S. Cal. L. Rev.* 1179 (1987).

39 The authors propose a five year Statute of Limitations period in their draft federal Right of Publicity Statute. See *infra* note 42.

40 Hamilton et al, *supra* note 38, at 211.

41 Roscoe Pound, *Introduction to the Philosophy of Law*. 1922.

42 As such, the authors submit the following as a draft Federal statute, based on the Indiana statute, with a number of additional useful provisions which would help in the application and comprehension of publicity rights by the judiciary, practitioners and the general public.

The Federal Right of Publicity Statute

Section 1

(a) This chapter applies to any act or event that occurs within the United States, regardless of a personality's domicile, residence or citizenship.

(b) This chapter does not apply to the following:

(1) The use of a personality's name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms in any of the following:

(A) Literary works, theatrical works, musical compositions, film, radio, or television programs.

(B) Material that has political or newsworthy value.

(C) Single and original works of fine art that are not merely faithful replications of a personality's likeness.

(D) Promotional material or an advertisement for a news reporting or an entertainment medium that:

(i) uses all or part of a past edition

of that medium's own broadcast or publication; and

(ii) does not convey or reasonably suggest that a personality endorses the news reporting or entertainment medium.

(E) An advertisement or commercial announcement for a use described in this subdivision.

(2) The use of a personality's name to truthfully identify the personality as:

(A) the author of a written work; or

(B) a performer or a recorded performance; under circumstances in which the written work or recorded performance is otherwise rightfully reproduced, exhibited, or broadcast.

(3) The use of a personality's"

(A) name;

(B) voice;

(C) signature;

(D) photograph;

(E) image;

(F) likeness;

(G) distinctive appearance;

(H) gestures; or

(I) mannerisms

in connection with the broadcast or reporting or an event or a topic of general or public interest.

(c) This chapter applies to acts or events that occur before or after the effective date of this chapter.

Section 2

As used in this chapter, "commercial purpose" means the use of an aspect of a personality's right of publicity as follows:

(1) On or in connection with a product, merchandise, goods, services, or other commercial activities.

(2) For advertising or soliciting purchases or products, merchandise, goods, services, or for promotional activities.

(3) For the purposes of fundraising.

Section 3

As used in this chapter, "name" means the actual or assumed name of a living or deceased natural person that is intended to identify the

person.

Section 4

As used in this chapter, "likeness" means an image, painting, sketching, model, diagram, or other representation of an individual's face, body, or parts thereof, or the distinctive appearance, gestures, or mannerisms of the individual.

Section 5

As used in this chapter, "single and original works of fine art" means a painting, drawing, print, or sculpture, existing in a single copy or, in the case of a sculpture, a single cast. Mechanically reproduced copies, even if limited edition, are not exempted works under this statute.

Section 6

As used in this chapter, "news reporting or an entertainment medium" means a medium that publishes, broadcasts, or disseminates advertising in the normal course of its business, including the following:

(1) Newspapers.

(2) Magazines.

(3) Radio and television networks and stations.

(4) Cable television systems.

Section 7

As used in this chapter, "person" means a natural person, a partnership, a firm, a corporation, or an unincorporated association.

Section 8

As used in this chapter, "personality" means a living or deceased natural person.

Section 9

As used in this chapter, "right of publicity" means a personality's property interest in the personality's:

(1) name;

(2) voice;

(3) signature;

(4) photograph;

(5) image;

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- (6) likeness;
- (7) distinctive appearance;
- (8) gestures; or
- (9) mannerisms.
- (10) other unequivocal identifying indicia.

Section 10

As used in this chapter, “fundraising” means an organized activity to solicit donations of money or other goods or services from persons or entities by a nonprofit organization, company, or other entity.

Section 11

A person may not use an aspect of a personality’s right of publicity for commercial purposes during the personality’s lifetime or for as long as the personality’s beneficiaries exploit or protect the personality’s right of publicity without any more than a 5-year period of nonuse or regulation, via licensing or policing efforts. A personality’s right of publicity can be used only after having obtained prior written consent from a person specified in section 21 of this chapter.

Section 12

A person who:

- (1) engages in conduct within the United States that is prohibited under section 11 of this chapter;
- (2) creates or causes to be created within the United States goods, merchandise, or other materials prohibited under section 11 of this chapter;
- (3) transports or causes to be transported into the United States goods, merchandise, or other materials created or used in violation of section 11 of this chapter;
- (4) knowingly causes advertising or promotional material created or used in violation of section 11 of this chapter to be published, distributed, exhibited, or disseminated within the United States; or
- (5) uses the right of publicity of a United States citizen;

submits to the jurisdiction of the United States federal courts.

Section 13

A person who violates section 11 of this chapter may be liable for any of the following:

- (1) Damages in the amount of:
 - (A) three thousand dollars (\$3,000); or
 - (B) actual damages, including profits derived from the unauthorized use; whichever is greater.
- (2) Treble or punitive damages, as the injured party may elect, if the violation under section 11 of this chapter is knowing, willful, or intentional.
- (3) attorney’s fees

Section 14

In establishing the profits under section 13(1)(B) of this chapter:

- (1) the plaintiff is required to prove the gross revenue lost due to the unauthorized use; and
- (2) the defendant is required to prove properly deductible expenses.

Section 15

In addition to any damages awarded under section 13 of this chapter, the court;

- (1) shall award to the prevailing party reasonable attorney’s fees, costs and expenses relating to an action under this chapter; and
- (2) may order temporary or permanent injunctive relief.

Section 16

Injunctive relief is not enforceable against a news reporting or an entertainment medium that has:

- (1) contracted with a person for the publication or broadcast of an advertisement; and
- (2) incorporated the advertisement in tangible form into material that has been prepared for broadcast or publication.

Section 17

An action under this section shall

be brought within five (5) years after a violation of this chapter should have been discovered.

Section 18

(a) This section does not apply to a news reporting or an entertainment medium.

(b) During any period that an action under this chapter is pending, a court may order the impoundment of:

- (1) goods, merchandise, or other materials claimed to have been made or used in violation of section 11 of this chapter; and
- (2) plates, molds, matrices, masters, tapes, negatives, or other items from which goods, merchandise, or other materials described under subdivision (1) may be manufactured or reproduced.

(c) The court may order impoundment under subsection (b) upon terms that the court considers reasonable.

Section 19

(a) This section does not apply to a news reporting or an entertainment medium.

(b) As part of a final judgment or decree, a court may order the destruction or other reasonable disposition of items described in section 18(b) of this chapter.

Section 20

The rights recognized under this chapter are property rights, freely transferable and descendible, in whole or in part, by the following:

- (1) contract.
- (2) license.
- (3) gift.
- (4) trust.
- (5) testamentary document.
- (6) operation of the laws of intestate succession applicable to the state administering the estate and property of an intestate deceased personality.

Section 21

(a) the written consent required by

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section 11 of this chapter and the rights and remedies set forth in this chapter may be exercised and enforced by:

- (1) a personality; or
 - (2) a person to whom the recognized rights have been transferred under section 20 of this chapter.
- (b) If the transfer described under subsection (a) has not occurred, a person or personality to whom the rights recognized are transferred under section 18 of this chapter may exercise and enforce the rights and remedies under this chapter.

Section 22

- (a) Subject to sections 16 and 17 of this chapter, after the death of an intestate personality, the rights and remedies of this chapter may be exercised and enforced by a person who possesses a total of not less than one-half (1/2) interest in the rights.
- (b) A person described in subsection (a) shall account to any other person in whom the rights have vested to the extent that the other person's interest may appear.

Section 23

If:

- (1) a deceased personality has not transferred the deceased person's rights under this chapter by:
 - (A) contract;
 - (B) license;
 - (C) gift;
 - (D) trust; or
 - (E) testamentary document; and
- (2) there are no surviving persons as described in section 21 of this chapter for intestacy transfer to take effect, the rights set forth in this chapter terminate.

Section 24

The rights and remedies provided for in this chapter are supplemental to any other rights and remedies provided by law.

43 The recent controversy over Napster and the fact that the sharing of files through Napster constitutes copyright infringement seems analogous. Everyone likes to get

something for nothing, and the convenience of Napster as a method of distribution is useful and undeniable; however, a decision in favor of Napster would have eroded copyright law in ways that could have eventually proven disastrous not only for record companies, but also for everyone who works in the entertainment industry, including artists and performers. For one thing, it is commonly known within the industry that record companies can and do pass on increased expenses to the artists with whom they work. If Napster had been allowed to continue, individual artists unequivocally would have suffered harm. Thus, the decision in Napster was not simply one of the individual consumer against the big-business record companies. The issue is far from resolved however, because of numerous other programs that distribute music in a similar fashion but which do not involve a singular body which can be sued, such as Gnutella and AudioGalaxy.com.