SUMMARY OF RIGHT OF PUBLICITY ISSUES

Kelli L. Sager
Davis Wright Tremaine LLP

I. INTRODUCTION

Right of publicity/misappropriation claims arise from the use of another’s likeness (or voice, or persona) for commercial purposes. More than 40 states, including California and New York, now recognize right of publicity tort claims based on common law, state statute or both. The elements of a right of publicity claim vary from state to state; however, the most common elements are: (1) use of someone’s name, identity, likeness or persona; (2) through which use the defendant received a commercial advantage (i.e., through advertising or trade); (3) the use was made without the person’s consent; and (4) there is injury to the plaintiff.

California and New York are the most common venues for celebrities to bring claims, and are the states where the law has been the most developed, although in recent years there have been more cases decided in other jurisdictions. All of the states’ laws are subject to federal constitutional limitations under the First Amendment.

In general, just as use of a celebrity’s name or likeness in expressive works is protected under the First Amendment, advertisements for those works that use the name or likeness of a

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1 Ms. Sager is a partner in Davis Wright Tremaine’s Los Angeles office. Connie Pendleton, who contributed to this summary, is a partner in DWT’s Washington, D.C. office. This outline is a summary of issues, and is not intended to be exhaustive or to substitute for research or legal advice in connection with a specific matter. This outline was prepared in Spring/Summer 2012 for the MLRC Conference in Virginia in September 2012.

2 These terms tend to be used interchangeably in the case law.

3 While courts in some states, such as New York, have narrowly interpreted right of publicity claims, other states have defined the rights more broadly. Decisions vary on which state’s law will apply to a publicity claim, which in turn is decided based on the particular state’s conflict of law analysis. Any analysis of a particular claim or publication should consider the specific state law that will be applied.

4 Some states, like California recognize both a common law and a statutory right of publicity. The common law elements typically are: (1) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (2) lack of consent; and (3) resulting injury. See Eastwood v. Superior Court for Los Angeles Co., 149 Cal. App. 3d 409, 198 Cal. Rptr. 342, 346 (1983). California’s right of publicity statute adds two further elements: (4) a knowing use; and (5) a direct connection between the use and the commercial purpose. Cal. Civ. Code § 3344(a). California’s statute was intended to complement, rather than replace, California’s common law claim for misappropriation. Montana v. San Jose Mercury News, Inc., 34 Cal. App. 4th 790, 793, 40 Cal. Rptr. 2d 639 (1995).

celebrity featured in the program also are protected.5 Even advertising related to expressive works may not be protected if the advertisement misleads the public by expressly stating that there is an association with a celebrity that does not exist, or if the advertisement falsely states that the celebrity endorses the advertiser or its products.6

Although most of the case law in this area addresses appropriation of a celebrity’s name, image or likeness, anyone — including a private individual — may have a right of publicity claim if his or her name, image or likeness is used for a commercial purpose without his or her consent. In many states, liability is strict; i.e., the unauthorized use itself creates liability regardless of the user’s intent. (But see Cal. Civ. Code § 3344(a) (“knowing use” required).) The plaintiff also typically does not need to show that viewers of an advertisement were confused or likely to be confused, or that there was an implied endorsement, as in a Lanham Act or state unfair competition claim.7 A plaintiff need only prove that he or she has a pecuniary interest in his identity and that his or her identity has been commercially exploited. Parks v. LaFace Records, 328 F.3d 437, 460 (6th Cir. 2003).

II. WHO AND WHAT IS COVERED

A. A Celebrity’s Persona

A right of publicity claim can arise from the use of many aspects of a celebrity’s persona. Courts and state legislatures have found liability from use of a celebrity’s name, nickname, former name, pseudonyms that are widely known to the public and closely identified with the celebrity, voice, image, and other attributes of a celebrity’s persona, including distinctive props or settings that evoke the celebrity’s image.8

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5 Cases involving expressive works can be distinguished from cases involving products, where there is no arguable First Amendment protection. Not surprisingly, right of publicity or misappropriation cases arising from advertisements for products that are not expressive works tend to favor the plaintiffs. See, e.g., Vanna White v. Samsung Electronics America, et al., 971 F.2d 1395 (9th Cir. 1992) (advertisement for Samsung electronics); Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (advertisement for portable toilets).

6 A comprehensive discussion of the law applicable to claims under the federal Lanham Act, which are most typically brought where plaintiffs make these kinds of allegations, is beyond the scope of this memorandum. See note 7, infra.

7 Plaintiffs frequently allege claims for both right of publicity and false endorsement under section 43(a) of the Lanham Act. This outline does not include a detailed discussion of the Lanham Act or other claims that may arise from use of an individual’s name, likeness, or persona, but some of the key cases are cited in the outline.

8 Under the Restatement of Law, Unfair Competition, § 46, the right of publicity extends to use of “name, likeness, or other indicia of identity ....” (Emphasis added.) California’s statute covers “name, voice, signature, photograph or likeness.” Cal. Civ. Code § 3344(a). The Indiana right of publicity statute — one of the broadest state statutes — even goes so far as to expressly protect the “gestures” and “mannerisms” of a celebrity, in addition to the individual’s name, voice, signature, photograph, image, likeness, and distinctive appearance. Ind. Code § 32-36-1-1 to 20.
Examples of some of aspects of persona that have been found to create a claim include:

Vanna White v. Samsung Electronics America, et al., 971 F.2d 1395 (9th Cir. 1992) (holding that Samsung advertisement that included a robot dressed in a blond wig, gown and jewelry and posing next to a Wheel of Fortune-like game show board violated Vanna White’s common law right of publicity; court found that right of publicity protects the celebrity’s “identity” or “anything that evokes [the celebrity’s] personality”). Now-chief Judge Alex Kozinski penned a vigorous dissent. 989 F.2d 1512 (9th Cir. 1993). 9

Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F. 2d 821 (9th Cir. 1974) (Ninth Circuit upheld a claim based on an advertiser’s unauthorized use in an advertisement of a plaintiff’s distinctive race car, holding that it could give rise to liability because the advertisement called to mind a well-known professional race car driver).

Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (Sixth Circuit upheld a publicity claim based on use in advertisement for portable toilets of the distinctive phrase, “Here’s Johnny,” associated with Johnny Carson’s entrance on stage for his television program).

But compare Uri Geller v. Fallon McElligott Advertising and Timex Corp., 1991 WL640574, *1-2 (S.D.N.Y 1991) (New York federal district court held that neither the name nor the likeness of a magician, well-known for bending kitchen utensils and stopping watches with the power of his mind, was exploited by TV commercials for Timex watches depicting a “psychic” who bore no physical resemblance to the plaintiff bending a fork and a key, but who could not stop a Timex watch; court held that the New York statute, Civ. Rts. Law §§ 50-51, only protected a celebrity’s right in his name or likeness and not an individual’s style or characteristics).

B. Look-alikes and Sound-alikes

The use of “look-alike” actors or “sound-alike” performers in advertisement can give rise to a right of publicity claim, even without identifying the particular celebrity by name.

The Ninth Circuit has upheld sound-alike claims based on singers in advertisements imitating a famous performer’s well-known rendition of a song. See, e.g., Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098-1101 (9th Cir. 1992), cert. denied, 506 U.S. 1080 (1993) (granting damages, including punitive damages, in excess of two million dollars to singer in connection with use of radio commercial for Doritos which used deliberate imitation of his voice; although noting that imitation of musical style without imitation of a particular voice would not violate the performer’s publicity rights); Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988) (concerning use of off-camera voice very similar to that of

9 The Ninth Circuit construes section 3344’s “protection of ‘name, voice, signature, photograph, or likeness’ more narrowly than the common law’s protection of identity.” Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 414 (9th Cir. 1996).
Bette Midler’s in a television commercial for Ford Lincoln Mercury; court held that tort claim could arise where a distinctive voice of a professional singer is widely known and deliberately imitated in order to sell a product.

Courts in the Second Circuit also have upheld “look-alike” claims based on the use of actors who were deliberately made up to resemble famous celebrities, even if the celebrity’s name was not used. Tin Pan Apple, Inc. v. Miller Brewing Co., 737 F. Supp. 826, 837 (S.D.N.Y. 1990) (use of actors in beer commercial who bore “striking resemblance” to members of rap group stated a claim under New York’s commercial misappropriation statute); Allen v. Men’s World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988) (use of actor resembling Woody Allen in ad for clothing store violated Lanham Act; declining to reach right of publicity claim under New York’s commercial misappropriation statute); Allen v. National Video Inc., 610 F. Supp. 612 (S.D.N.Y. 1985) (same; use of photograph of actor closely resembling Woody Allen to promote video rental chain). Compare Onassis v. Christian Dior, 472 N.Y.S.2d 254, 261 (Sup. Ct. 1984), aff’d, 488 N.Y.S.2d 943 (1st Cir. 1985) (holding that imitators were free to simulate voice or hairdo, or characteristic clothing or accessories, and actors could reenact events unless and until it was done to be deceptive or prompt confusion).


C. Characters

Unauthorized use of a fictional character in an ad for a non-expressive service or product could give rise to a claim if the character is closely associated with a real-life individual. See, e.g., Wendt v. Host Int’l, Inc., 125 F.3d 806, 810 (9th Cir. 1997) (suit by actors who played the roles of Norm and Cliff on the TV show asserted publicity rights to prevent Paramount licensee from using robots in bars that the actors they alleged resembled them; court found genuine issues of fact relating to plaintiff’s misappropriation claims that precluded summary judgment). But see Donchez v. Coors Brewing Co., 392 F.3d 1211 (10th Cir. 2004) (local baseball stadium beer vendor who created the character “Bob the Beerman” did not have a publicity claim against Coors when the beer company created a series of beer ads using actors playing beer men; court found actors bore no resemblance to the plaintiff and plaintiff failed to show that the character was closely associated with him); Naked Cowboy v. CBS, No. 11 Civ. 0942 (BSJ), - F. Supp. 2d -, 2012 WL 592539 (S.D.N.Y. Feb. 23, 2012) (dismissing 50-51 claim based on character similar to plaintiff’s fictional persona, the “Naked Cowboy,” holding that “the right to privacy does not extend to fictitious characters adopted or created by celebrities”).
D. Dead Celebrities: Descendability of the Right of Publicity

A right of publicity claim is not necessarily limited to plaintiffs who are living; depending on state law, family members or other heirs of a deceased celebrity may have a tort claim arising from the use of a dead celebrity’s likeness or image in a nationally broadcast advertisement. Statutes in some states provide for descendability, although the duration of the right varies. For example, California grants protection for 70 years after death (Cal. Civ. Code. § 3344.1(g)), but the heirs must register their rights for damages to be recoverable. Cal. Civ. Code. § 3344.1(f)(1). Indiana, home of CMG (Curtis Management Group), which represents the estates of many celebrities, protects a celebrity’s publicity rights for one hundred years after death. See Indiana Code § 32-36-1-1, et seq.

Even where there is no statute, courts may recognize a common law post-mortem right of publicity. See, e.g., Presley’s Estate v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (applying New Jersey law, court recognized post-mortem right of publicity for Elvis Presley). In some states, recognizing of a common law post-mortem right is conditioned on proof that the decedent exploited the rights during his or her lifetime. See, e.g., Nature’s Way Prods., Inc. v. Nature-Pharma, Inc., 736 F. Supp. 245 (D. Utah 1990); Sinkler v. Goldsmith, 623 F. Supp. 727 (D. Ariz. 1985). But see Martin Luther King, Jr., Center for Social Changes, Inc. v. American Heritage Products, Inc., 694 F.2d 674, 678 (11th Cir. 1983) (rejecting requirement of exploitation during lifetime); 2 J. Thomas McCarthy, Rights of Publicity and Privacy § 9:17 (“the overwhelming majority rule under either statute or common law is that the right of publicity is descendible property and has a postmortem duration which is not conditioned on lifetime exploitation”).

Determining what state law applies requires a conflicts-of-law analysis, but often it has been held that the law of the individual’s domicile when he or she died should be applied. See, e.g., Cairns v. Franklin Mint Co., 292 F.3d 1139, 1145 (9th Cir. 2002) (interpreting California statute).

III. FIRST AMENDMENT PROTECTION

The First Amendment protects against misappropriation claims based on the use of a celebrity’s name, likeness, or persona in an expressive work. Most courts that have addressed the issue also have found that the First Amendment protects against claims arising from advertisements promoting those works that uses the celebrities’ personas, recognizing that the content provider must be allowed to tell the prospective viewer what the expressive work is about.

A. Use In Expressive Work

It is well established as a matter of First Amendment doctrine that the use of a celebrity’s name, likeness, or persona in motion pictures, books, magazines and other expressive works is constitutionally protected against right of publicity claims. Courts have held
that individuals cannot restrict the exercise of free speech by preventing others from speaking about them – even if the speech is “commercial” in the sense that the speaker is a profit-making enterprise.

Examples of some of the works that courts have found protected under the First Amendment include:

**Books:**

Matthews v. Wolstoncraft, 15 F.3d 432 (5th Cir. 1994) (affirming grant of summary judgment for publisher, movie studio, and plaintiff’s ex-wife in former undercover narcotics officer’s misappropriation claim based upon book authored by ex-wife about their story; “[c]ourts long ago recognized that a celebrity’s right of publicity does not preclude others from incorporating a person’s name, features or biography in a literary work, motion pictures, news or entertainment story”)

**Motion pictures:**

Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 871-72 (1979) (Bird, C.J., concurring, with majority of court joining her concurrence) (finding feature film about Rudolph Valentino protected by First Amendment; “[w]hile few courts have addressed the question of the parameters of the right of publicity in the context of expressive activities, their response has been consistent. Whether the publication involved was factual and biographical or fictional, the right of publicity has not been held to outweigh the value of free expression”); Tyne v. Time Warner Entertainment Co., 901 So.2d 802 (Fla. 2005) (dismissing a lawsuit arising out of the feature film, “The Perfect Storm”; court held that the term “commercial purpose” under Florida’s commercial misappropriation statute “does not apply to publications, including motion pictures, which do not directly promote a product or service”); Polydoros v. Twentieth Century Fox Film Corp., 67 Cal. App. 4th 318, 325 (1997) (rejecting publicity rights claim in the motion picture “The Sandlot” on First Amendment grounds).

**Magazines:**


**Newspaper - use of 900 number:**

New Kids on the Block v. News America Pub., Inc., 971 F.2d 302, 309-10 (9th Cir. 1992) (recognizing that newspapers had complete defense to misappropriation claim relating to use by papers of New Kids’ name in 900-number telephone survey to determine most popular band member if they used New Kids’ name “in connection with any news, public affairs, or sports broadcast or account which was true in all material respects”; court affirmed holding that publishers’ use of New Kids’ name was “in
connection with” news accounts about the singing group and its popularity and therefore barred New Kids’ misappropriation claim).

Newspaper – poster created from published photograph:

Videogames:

Whether the expressive work is technically described as “news” or “entertainment” has not been a distinguishing factor, since the First Amendment protection applies to both. As Chief Justice Bird noted in Guglielmi, 25 Cal. 3d at 867, “our courts have often observed that entertainment is entitled to the same constitutional protection as the exposition of ideas.”

Limitation on First Amendment Protection:

Some courts have found that the First Amendment does not protect a media defendant if it uses a celebrity’s name and likeness in a knowingly false manner to increase sales of the publication. See, e.g., Solano v. Playgirl, 92 F.3d 1078, 1080-81, 1089 (9th Cir. 2002) (genuine issue of material fact precluded summary judgment for magazine on issue whether newsworthiness exception would protect unauthorized use by Playgirl magazine of Baywatch star’s photo on cover under headline “TV Guys: PRIMETIME’S SEXY YOUNG STARS EXPOSED” which star claimed gave false impression he posed nude in pages of magazine and was willing to degrade himself and endorse magazine).

B. Advertisement of Content of First Amendment Protected Work

The publication of otherwise newsworthy information concerning a celebrity may not be protected when it is used in the context of an advertisement for a product that is unrelated to the coverage of the celebrity in a news or sports account. For example, in Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 409 (9th Cir. 1996), a TV commercial for GM cars compared Lew Alcindor’s record as three-time MVP with GM’s three-time

10 California’s misappropriation statute, like the common law, specifically exempts from liability the use of a name or likeness “in connection with any news, public affairs, or sports broadcast or account of any political campaign ....” Cal. Civ. Code § 3344 (d). The extent of this protection varies by state. See, e.g., Toffoloni v. LFP Publishing Group, LLC , 2010 WL 187274 (N.D. Ga., Jan. 13, 2010) (rejecting “newsworthiness” defense under Georgia law for publication of nude photographs of former professional wrestler who was murdered by her husband; mother’s suit was permitted to proceed).
listing on Consumer Reports' "Best Buy" through the use of trivia questions. Alcindor's name was used directly in the ad to sell cars and his winning record was equated with GM's. Id. The court held that while Alcindor's basketball record might be "newsworthy," its use in the context of an automobile advertisement, rather than in a news or a sports account, was not protected as newsworthy under California's right of publicity statute. Id. at 416. See also Yeager v. Cingular Wireless LLC, 673 F. Supp. 2d 1089 (E.D. Cal. 2009) (First Amendment did not protect use of Chuck Yeager's name in advertisement for Cingular, despite inclusion of facts about Yeager's achievement in breaking the sound barrier).

But it is well established that content providers may truthfully use the name or likeness of a celebrity who is the subject of an expressive work to advertise the content of the First Amendment protected publication or program. See Restatement (Third) of Unfair Competition § 47 cmt. A (1995); Boller v. Youngs Drug Prods. Corp., 463 U.S. 60, 67 n.14 (1983) ("[a]lthough commercial speech has not traditionally enjoyed constitutional protection, commercial solicitation or promotion of constitutionally protected ... works is protected as an incident to the First Amendment value of the underlying speech or activity"); Daly v. Viacom, Inc., 238 F. Supp. 2d 1118 (N.D. Cal. 2002) (plaintiff did not state a right of publicity claim based on defendants' use of her image in the program "Bands on the Run" or in billboards and other promotional material because the entertainment program -- and the advertisements for the program -- were protected by the First Amendment); Lane v. Random House, Inc., 98 F. Supp. 141, 147 (D.D.C. 1995) ("[i]t would be illogical to allow respondents to exhibit [speech products] but effectively preclude advance discussion or promotion of their lawful enterprise" (quoting Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 462 (Cal. 1979) (advertisement for constitutionally protected film is constitutionally protected as an adjunct to the film)).

The fact that a media defendant is engaged in the business of publication, and profits from the publication, the use of a celebrity's name or likeness in connection with that publication is insufficient to make such use "commercial." Lane, 985 F. Supp. at 147 (citing Restatement (Second) of Torts § 652C, cmt. d (1977)) ("[t]he very nature of the incidental use privilege is to exclude certain material from the rubric of commercial speech").

California courts also have held that a newspaper has a constitutional right to promote itself by reproducing -- in whole or in part -- its constitutionally protected news stories and photographs, and by selling or distributing those reproductions separately. See, e.g., Montana v. San Jose Mercury News, Inc., 34 Cal. App. 4th 790 (1995) (rejecting misappropriation claim by quarterback Joe Montana arising from the newspaper's creation of posters that were exact reproductions of pages from the newspaper depicting a photograph of Montana, which were used to promote its sports coverage. Court held that "where a newspaper page conveying newsworthy events is reproduced for the purpose of showing the quality and content of the newspaper, the subsequent production is exempt from the statute and common law prohibitions"; noted that posters did not contain additional information not included in the newspaper's pages and did not state or imply that Montana endorsed the newspaper); Booth v. Curtis Publishing Co., 15 A.D.2d 343, 223 N.Y.S.2d 737, 738-39 (1962) (publication without consent of actress Shirley Booth's
photo from edition of Holiday magazine in advertising for Holiday in editions of the New Yorker and Advertising Age magazines did not violate Booth’s right of publicity where nothing in the reproduction suggested her endorsement of Holiday magazine; court held that “a person’s photograph originally published in one issue of a periodical as a newsworthy subject … may be republished subsequently in another medium as an advertisement for the periodical itself, illustrating the quality and content of the periodical, without the person’s written consent.” (emphasis added).

Even where copy has been added to the reproduction for an advertisement, courts in at least some states have held that the additional material is not enough to give rise to a misappropriation claim if it merely indicates the nature of the contents of the publication, and does not imply any endorsement by the individual depicted. See, e.g., Namath v. Sports Illustrated, 371 N.Y.S.2d 10, 11-12 (N.Y. App. Div. 1st Dep’t 1975) (unauthorized use of sports figure’s photograph from Super Bowl game, which appeared in previously published news story in Sports Illustrated, in ads in Cosmopolitan and Life, with captions reading “The Man You Love Loves Joe Namath” and “How to Get Close to Joe Namath,” used to solicit magazine subscriptions for Sports Illustrated was a protected use, where photograph gave the reader an indication of the contents of Sports Illustrated magazine; the language in captions merely indicated the general nature of the contents of what was likely to appear in future issues), aff’d, 386 N.Y.S.2d 387 (1976); Int-Elect Engineering, Inc. v. Clinton Harley Corp., 1993 WL 557639, *4-5, 21 Med. L. Rep. 1762 (N.D. Cal. 1993) (court held that a magazine subscription card that reproduced photograph of plaintiff’s motorcycle that was depicted in an earlier issue was permissible because it described the nature, quality and contents of the magazine and the general nature of what was likely to be featured in future editions of the magazine; the court held that the mere reproduction of the photograph did not falsely imply plaintiff’s endorsement of the magazine).

There also is some support for the proposition that a media company may promote its content in general by using images of celebrities that are related to the content of its programs, even if the specific item used in the ad did not appear in the company’s content. For example, the Central District of California held that a celebrity’s likeness could be used to promote not only expressive works – videotapes of movies – in which she starred, but also could be used in an advertisement which the plaintiff claimed was more intended to promote the defendants generally. Page v. Something Weird Video, 960 F. Supp. 1438 (C.D. Cal. 1996). Actress Betty Page brought a right of publicity claim against a video distributor of older motion pictures who use an artistic rendering of her likeness (virtually indistinguishable from stills of the actress derived from the movies advertised) in a mail order catalogue to announce the release of two videos of movies in which the actress starred. Id. at 1444. The actress further alleged that her likeness had been appropriated to promote defendants’ entire lines of videotape products.

The court, granting summary judgment for defendants, held that the use of Page’s likeness to advertise the two videos in which she starred was incidental to the protected publication of those videos. Id. The court further held that the First Amendment protection set forth in Montana and Cher extended to protect the distributor’s use of
Page's image to advertise their "entire line of video products so long as they did not falsely claim that Page endorsed [the distributor]." Id. at 1445. (The utility of this decision is limited, because Page had not asserted a false endorsement claim.)

In Groden v. Random House, Inc., a case arising from the use of plaintiff's name and photograph in advertisements in a book concerning JFK's assassination, the Second Circuit specifically refused to limit the "incidental use" defense to content that was actually used in the underlying work. The Court extended the defense to include the use of a photograph of plaintiff Robert Groden, another JFK conspiracy theorist, even though the photograph did not appear anywhere in the book being advertised. 61 F.3d at 1049 (2d Cir. 1995). Similarly, in Rand v. Hearst Corp., 31 A.D.2d 406, 298 N.Y.S.2d 405 (1969), aff'd, 26 N.Y.2d 806, 309 N.Y.S.2d 348 (1970), cited approvingly by the Second Circuit in Groden, writer Ayn Rand complained that a book jacket that compared her writing style to that of the book's author was a commercial misappropriation because it used Rand's name. In rejecting the claim, the court observed, "[t]o hold otherwise would constitute an impermissible restriction on what we deem to be the right of a publisher in informing the public of the nature of his book and comparing it with the works of other authors." Id. at 411, 298 N.Y.S.2d at 412.

Similarly, in New York Magazine v. Metropolitan Transportation Auth., 987 F. Supp. 254, 268 (S.D.N.Y. 1997), aff'd on other grounds, 136 F.3d 123 (2d Cir. 1998), an advertisement for New York Magazine on the side of New York City buses that read, "The Only Thing Rudy doesn't claim credit for," was found to be an incidental use of Mayor Giuliani's name and did not state a claim for commercial misappropriation, even though the ad did not refer to any particular article in the magazine but related in a more thematic way to the magazine's coverage of local politics. In Seale v. Gramercy Pictures, 964 F. Supp. 918 (E.D. Pa. 1997), aff'd, 156 F.3d 1225 (3d Cir. 1998), involving a docudrama about the Black Panthers, the use of photos of the actor playing Bobby Seale on the video cover, cover of book and a brochure for the CD soundtrack of the docudrama did not violate Seale's right of publicity, despite his claims that there was "no relationship to the content of those songs to the history of my organization, the Black Panther Party," because Seale failed to show that the use was for an unrelated commercial purpose.

Compare Tellado v. Time-Life Books, Inc., 643 F. Supp. 904, 910 (D.N.J. 1986) (applying New Jersey law predating Groden, et al., court found that plaintiff could state a claim for commercial misappropriation because plaintiff's photo was included in a promotional brochure about a book series on Vietnam but the photo had not been included in the books, plaintiff was not referenced in the books, and his individual story had no connection to the series).

Limitation:
California courts have noted that any use of a celebrity persona under the media advertising exception must be carefully limited to ensure that the use of the celebrity's image does not falsely suggest any endorsement of the program or the media entity.
For example, in *Cher v. Forum International, Ltd.*, 692 F.2d 634 (9th Cir 1982), cert. denied, 462 U.S. 1120 (1983), actress/singer Cher was interviewed on a talk show in connection with a cover story originally to be published in *Us* magazine. 692 F.2d at 637. The interviewer later sold the Cher interview to *Forum* magazine and *Star*. *Id.*. *Forum* magazine used a picture of Cher with various captions on its subscription “tear out” ads, including the false statements that “There are certain things that Cher won’t tell People and would never tell Us. She tells Forum” and “So join Cher and Forum’s hundreds of thousands of other adventurous readers today.” *Id.* at 638. An ad for *Forum* also appeared in *Penthouse* that read, “So take a tip from Cher and hundreds of thousands of other adventurous people and subscribe to *Forum.*” *Id.* at 639. Cher sued, claiming her reputation had been damaged by the suggestion that she would give an exclusive interview to those publications. *Id.* The Ninth Circuit determined that *Forum* magazine would be entitled under the First Amendment to use the picture of Cher to refer to her truthfully in subscription advertising to indicate the content of its specific publication. *Id.* The Court recognized that “[c]onstitutional protection extends to the truthful use of a public figure’s name and likeness in advertising which is merely an adjunct of the protected publication .... Advertising to promote a news medium, accordingly, is not actionable under an appropriation of publicity theory so long as the advertising does not falsely claim that the public figure endorses the news medium.” *Id.* But the Court held that the magazine’s advertisement was not protected in that particular case, because the copy added to the ads went beyond the exception by falsely implying Cher’s endorsement of the magazine. *Id.*

**B. Tests for Evaluating Whether Use Is Protected**

Depending on the jurisdiction, different tests have evolved for evaluating whether the use of a celebrity’s persona is protected under the First Amendment. Cases pending in the Ninth and Third Circuits as of the date this outline was prepared may help determine what tests will be applied in future cases, and how those tests are to be interpreted.

1. **Transformative Use**

The transformative use test derives from the California Supreme Court’s decision in *Comedy III Prods. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001), in which the Court considered whether the use of likenesses of the Three Stooges on t-shirts and lithographs could give rise to right of publicity claims, or was protected by the First Amendment. In evaluating the works – which the Court found to be “expressive” works that had First Amendment protection – it looked at whether the work containing the likeness “is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.” *Id.* The Court found that expressive works that merely use the celebrity’s likeness as “one of the ‘raw materials’ from which an original work is synthesized” are protected. *Id.* at 406 (emphases added). Applying the test to the works at issue, the *Comedy III* Court found that the works were not protected. Two years later, in *Winter v. DC Comics*, 30 Cal. 4th 881, 890 (2003) the Court clarified its earlier ruling, in finding that a comic book that parodically depicted musician brothers as “half-man, half-worm” creatures was clearly transformative.

Cases now pending in the Ninth Circuit may help clarify the proper application of this test. See Keller v. Electronic Arts, Inc., No. 10-15387 (9th Cir.); Brown v. Electronic Arts, Inc., 09-56675 (9th Cir.).

Other cases applying the transformative use test include:

Hilton v. Hallmark, 599 F.3d 894 (9th Cir. 2010) (finding that use of Paris Hilton’s picture on greeting card could not be deemed “transformative” as a matter of law; denying SLAPP motion); ETW Corp. v. Jirah Publishing, Inc., 332 F.3d 915 (6th Cir. 2003) (painting and mass produced prints depicting Tiger Woods in famous pose after winning the Masters Golf Tournament were infused with the artist’s original expression and protected from a right of publicity claim); Arenas v. Shed Media, Case No. CV 11-05279 DMG (C.D. Cal. Aug. 22, 2011) (rejecting preliminary injunction in right-of-publicity and trademark case arising from the use of NBA star Gilbert Arenas’ name in a reality-television show called Basketball Wives: Los Angeles); aff’d, 2011 U.S. App. Lexis 25261 (9th Cir. December 20, 2011) (judge did not abuse her discretion in denying preliminary injunction).

2. Rogers Test

This test is derived from the Second Circuit’s decision in Rogers v. Grimaldi, 875 F.2d 994, 1003-04 (2d Cir. 1989), which involved a lawsuit filed by Ginger Rogers based on her claim that the motion picture “Ginger and Fred” violated her rights. The court adopted a test that looks first at whether the use is “wholly unrelated” to the content of the work, or “explicitly misleads” consumers into believing that the plaintiff endorsed the work. Id. (court found title was “clearly related” to the content of the movie and was not a disguised advertisement for the sale of products or services; affirmed summary judgment for defendants on Ginger Rogers’ misappropriation and Lanham Act claims).

The Ninth Circuit has adopted the Rogers test in Lanham Act cases involving expressive works. Mattel v. MCA Records, 296 F.3d 894, 902 (9th Cir. 2002); P.S.S. Entertainment 2000 v. Rock Star Videos, 547 F.3d 1095, 1099-1101 (9th Cir. 2008).

The Sixth Circuit, although citing the Rogers test, denied summary judgment for defendants in Parks v. LaFace Records, 328 F.3d 437, 460-61 (6th Cir. 2003), finding a genuine issue of material fact as to whether the title of the hip-hop group Outkast’s song “Rosa Parks was or was not “wholly unrelated” to the content of the song. (Defendants admitted that the content of the song was not about Rosa Parks, and that the “back of the bus” lyric referred to the message that the group’s competitors were of lesser quality and therefore must “move to the back of the bus” or “take a back seat.”) Id. at 452.
Media groups have advocated use of the Rogers test for both Lanham Act and misappropriation/right of publicity lawsuits; that issue may be decided in the videogame cases currently pending in the Ninth and Third Circuits.

3. Likelihood-of-Confusion Test

The likelihood-of-confusion test is applied in typical Lanham Act cases, involving non-expressive products. In the Ninth Circuit, for example, this test involves the application of eight (or more) factors, known as the “Sleekcraft” factors, which include such things as the strength of the mark, the relatedness of the goods, and the similarity between the plaintiff’s and defendant’s marks. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979).

The Ninth Circuit has rejected the use of this test in Lanham Act cases involving the use of a celebrity’s name/likeness/persona in an expressive work, finding that the test “fails to account for the full weight of the public’s interest in free expression.” Mattel v. MCA Records, 296 F.3d 894, 900 (9th Cir. 2002).

4. Alternative Means Test

The “alternative means” test has been proposed by plaintiffs in some cases involving expressive works, arguing that the use of their likenesses or personas was not necessary to the expression. The Second Circuit rejected use of this test in right of publicity cases involving expressive works, finding that it does “not sufficiently accommodate the public’s interest in free expression.” Rogers v. Grimaldi, 875 F.2d at 999. Other courts have agreed; the Sixth Circuit, for example, declined to use this test where an expressive work is involved. ETW Corp. v. Jireh Publ’g, 332 F.3d 915 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003). Cf. Dallas Cowboy Cheerleaders v. PussyCat Cinemas, 604 F.2d 200 (2d Cir. 1979) (applying alternative means test; distinguished in Rogers).

5. Predominant Use Test

The predominant use test was articulated by the Missouri Supreme Court in Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003), in which former professional hockey player Anthony “Tony” Twist sued the publisher and creator of a comic book that used “Tony Twist” as the nickname for a fictional mafia boss inspired by Twist’s real-life persona as an “enforcer” in the National Hockey League. 110 S.W.3d at 366. Doe’s “predominant use” test posits that “[i]f a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some ‘expressive’ content in it that might qualify as ‘speech’ in other circumstances.” Id. at 374.
The test has been widely criticized, and to date, no other court has adopted this test, and even the Eighth Circuit ignored the test in a subsequent right-of-publicity decision applying Missouri law. C.B.C. Distribution and Marketing v. Major League Baseball Advanced Media, 508 F.3d 818 (2007). See also C.B.C. Distributing and Marketing v. Major League Baseball Advanced Media, 443 F. Supp. 2d 1077, 1096 n.26 (E.D. Mo. 2006) (declining to adopt Doe in fashioning a First Amendment balancing test for right-of-publicity claims).

C. Mixed Commercial and Commentary

Several cases demonstrate that the boundary between editorial content and commercial use is not well-defined. For example, in Beverley v. Choices Women’s Medical Center, Inc., 532 N.Y.S. 2d 400 (2d Dep’t 1988), the defendant, a Women’s Health Center, that provided abortion services, published a calendar celebrating famous women throughout history within the theme of the women’s movement in the United States. The plaintiff, whose picture appeared incidentally, won on summary judgment. The court stated that her right of publicity could not be removed by “wrapping [the] advertising message on the cloak of public interest ....” Similarly, in Downing v. Abercrombie & Fitch, 265 F.3d 994, 1002 (9th Cir. 2001), the Ninth Circuit held that the First Amendment did not bar the commercial misappropriation claim of surfers whose photos were used by the company without the surfer’s permission to illustrate a surf-themed catalogue. In addition to advertising clothing, one quarter of the catalogue was devoted to stories, news and other editorial pieces. Id. at 999. The photos of appellants – taken in 1965 at a surf competition – appeared after a story about the history of surfing and before two pages of t-shirts advertised for sale and designed to replicate those worn by the appellants. Id. at 1000. Although conceding that the themes of the catalogue – surfing and surf culture – were a matter of public interest, the court rejected defendant’s public interest defense, finding that Abercrombie used the individuals’ photos as “window dressing to advance the catalogue’s surf-theme.” Id. But see Stewart v. Rolling Stone, LLC, 181 Cal. App. 4th 664, 692 (2010) (finding First Amendment protected references to independent bands in magazine feature; court rejected plaintiffs’ claim that proximity to advertisements converted the feature into “commercial” speech).

See also Grant v. Esquire, Inc., 367 F.Supp. 876 (S.D.N.Y. 1973) (actor Cary Grant successfully sued Esquire magazine for use of a photograph of Grant’s head on the torso of a model in connection with an article on clothing styles. Compare Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001) (Ninth Circuit held LA Magazine article about fashion entitled “Grand Illusions,” in which famous stills from sixteen movies were updated to show how the characters would dress in more modern fashions, was protected by First Amendment against actor Dustin Hoffman’s misappropriation claim, based on the use in the article of Hoffman’s head (as “Tootsie”) with the body of a male model in a

modern cream colored dress). Court held that despite the presence of a Ralph Lauren ad and a “shoppers guide” elsewhere in Los Angeles Magazine, containing price and store details for the clothes in the article, the use of Hoffman’s photograph was not transformed into pure commercial speech; “[a]ny commercial aspects are ‘inextricably entwined’ with expressive elements, and so they cannot be separated out ‘from the fully protected whole.’”

The fact that expressive, editorial content is “brought to you by” an advertiser or “sponsored by” an advertiser does not turn otherwise editorial programming into advertising or trade. In Benavidez v. Anheuser Busch, Inc., 873 F.2d 102 (5th Cir. 1989), the Fifth Circuit held that a documentary titled “Heroes” that recounted the exploits of Hispanic Congressional Medal of Honor recipients, including an eighty-second segment on the military exploits of plaintiff, Roy Benavidez was protected. The documentary had been produced by the corporate relations department of the beer company, and included in the credits, “‘Heroes was [made] possible by Anheuser Busch, Inc. and its family of wholesalers.” Id. at 104. The documentary was shown at hospitality centers at company conventions where company produced refreshments were distributed. Id. at 103. The court nonetheless found that even if the company’s goal was “an attempt to capitalize on Benavidez’s good name and reputation and thereby commercially benefit from it,” the Fifth Circuit held these facts “would not transform the otherwise unobjectionable into a commercial advertisement for [Anheuser Busch].” Id. at 103.

F. Joking References and Parody

Even joking references to a celebrity in an ad for a non-expressive work may give rise to a right of publicity claim. Thus, for example, a department store’s advertisement for a shirt showing a man named Don donning a Henley shirt with the captions “This is Don” and “This is Don’s Henley,” was held to violate The Eagles lead singer Don Henley’s right of publicity. See Henley v. Dillard Dep’t Stores, 46 F. Supp. 2d 587 (N.D. Tex. 1999). In that case, the shirt was clearly a product, not a First Amendment work, and one with which the singer had no connection. But the court was not persuaded by the idea that the advertisement was intended to be humorous. But cf. Vanna White v. Samsung Electronics America, et al., 971 F.2d 1395 (9th Cir. 1992) (Kozinski, J., dissenting: “It’s impossible to parody a movie or TV show without at the same time “evok[ing] the “identity[ies]” of the actors”).

IV. OTHER DEFENSES

Several other defenses may be available to defendants in responding to right of publicity claims.

A. Consent

Consent is a defense to a right of publicity claim. In preparing expressive works where a celebrity will be involved (e.g., feature films), it is helpful to include in contracts a
provision that allows the use of their images, biographical information, and other references, or that require on-screen endorsements in advertisements, promotions and marketing materials for the network. Some states require that such consent be in writing; for evidentiary purposes, even if the state law does not require a written agreement, it is a good practice to have the consent in writing so that the celebrity cannot disavow it later. Where consent is to be used as a defense, publishers should take care to ensure that the use does not exceed the scope of the consent. See, e.g., Miller v. Anheuser Busch, Inc., 348 Fed. Appx. 547 (11th Cir. 2009) (releases barred part of plaintiff’s misappropriation claim, but claim based on uses of her likeness beyond the time period provided for in the releases survived summary judgment).

B. Incidental Use: Fleeting Reference

An insignificant or fleeting use of a celebrity’s name, image or likeness that is not central to the advertisement may not be actionable under the incidental use defense. For example, under California’s misappropriation statute, group shots – such as a crowd at a sporting event or an audience at a performance – are not actionable. See Cal. Civ. Code. §§ 3344(b)(2),(3).

In applying the incidental use exception, courts look at several factors: (1) whether the use has a unique quality or value that would result in commercial profit to the defendant; (2) whether the use contributes something of significance; (3) the relationship between the reference to the plaintiff and the purpose and subject of the work; and (4) the duration, prominence or repetition of the name or likeness relative to the rest of the publication. Aligo v. Time-Life Books, 1994 WL 715605, *3, 4 (N.D. Cal. 1994) (holding that four-second use of plaintiff’s photograph in 29-minute infomercial promoting Rolling Stones’ rock music anthology was “too fleeting and inconsequential” to give rise to right of publicity claim).

In order to be actionable, there must be a “direct and substantial connection between the appearance of the plaintiff’s likeness and the main purpose and subject of the work.” D’Andrea v. Rafla-Demetrjous, 972 F. Supp. 154, 155-56, 157-58 (E.D.N.Y 1997) (citation omitted) (use of former hospital resident’s picture in one-half page of 16-page recruiting brochure, which included photographs of 41 other people and did not identify or refer to plaintiff in the text, was incidental to main purpose of the brochure and did not state a claim under New York’s commercial misappropriation statute). That the subject of an advertisement might be recognizable does not preclude application of the incidental use doctrine. Id. at 157. But compare Pooley v. National Hole-In-One Ass’n, 89 F. Supp. 2d 1108, 1112-14 (D. Ariz. 2000) (holding that use of six-seconds of videotape footage of professional golfer’s hole-in-one in eight minute videotape to promote golf association’s fundraising activities was not incidental where use was central to promotional video’s promise that contest was winnable).
C. Copyright Preemption

If a celebrity's likeness is depicted in a copyright protected work, the state law right of publicity claim may be preempted by federal copyright law. See, e.g., Armstrong v. Eagle Rock Entertainment, Inc., 655 F. Supp. 2d 779 (E.D. Mich. 2009) (to extent plaintiff's misappropriation claim was based on re-creation of his performance on DVD, it was preempted by Copyright Act); Fleet v. CBS, 50 Cal. App. 4th 1911 (1996). But because right of publicity claims usually involve elements which are not themselves copyrightable, such as likeness, persona or voice, courts typically reject the preemption defense. See, e.g., Downing, 265 F.3d at 1003-05 (misappropriation claim based on use of historical surfing photos of plaintiffs in clothing catalogue not preempted by copyright law).

V. REMEDIES

Available relief varies, depending on the particular state law involved. Remedies against advertisers for violation of a celebrity's right of publicity theoretically can include injunctive relief, as well as compensatory and punitive damages.

With respect to money damages, the law typically protects celebrities from having the publicity value of their names and reputations unlawfully appropriated by others. See Grant, 367 F. Supp. at 880. Because movie stars, famous musicians and sports figures can command fees in the many millions of dollars for agreeing to act as a spokesperson or to be otherwise identified with a product, the fair market value of the "use" can be substantial. See, e.g., Waits, 978 F.2d at 1103 ($100,000 awarded for fair market value of singer's services and $75,000 for injury to good will, professional standing and future publicity value for use of imitation of singer's voice in advertisement).

The law is not well developed on the methods by which damages can be awarded. One element of damage can include whether the celebrity has previously sanctioned his or her commercial use as a model. Id. at 881. There may be a first time value, which diminishes with use, which a jury may find was wrongfully appropriated by the defendant. Id. But celebrities who have successfully negotiated endorsement deals worth millions of dollars have an easier time establishing the "value" of the use.

Profits attributable to the violation also may be recoverable. Parties typically will retain marketing experts to opine on the value of the exploitation of a person's likeness. In some cases, experts have testified that the easiest way to link profits to advertising is to look at the value of the use of the likeness to the product's branding. In a misappropriation case involving Nestlé, for example, the plaintiff's expert testified that the use of faces is the most effective way to advertise, even where the person is unrecognizable. Based on this testimony, a Los Angeles County Superior Court jury in Glendale awarded former model Russell Christoff $15.6 million for Nestlé's use of his image on the Taster's Choice coffee containers over a period of approximately six years, in the U.S and abroad. The jury determined that Christoff should have been paid $330,000 for the use of his likeness, and based on the expert's testimony about the percentage of "profits" attributable to the "branding" of Nestlé's image through use of the
photograph, also awarded damages equal to 5% of the profit from Taster's Choice sales during the six-year period, or $15.3 million. After further proceedings on appeal, the case settled for a confidential amount.

In some instances, the celebrity plaintiff also has recovered damages for non-economic harms, such as humiliation, mental anguish, distress or outrage for being associated with a commercial advertisement. See, e.g., Waits, 978 F.2d at 1103 ($200,000 awarded in mental distress damages for use of imitation of singer’s voice in advertisement).

Some states, including California, award attorney’s fees to the prevailing party in a right of publicity action. See Cal. Civ. Code §§ 3344(a), 3344.1(a); Page, 960 F. Supp. at 1445-47 (awarding fees and costs to prevailing defendant).

Finally, punitive damages awards have been upheld in right of publicity cases in some states, where there was clear and convincing evidence of oppression, fraud or malice. See, e.g., Cher, 692 F.2d at 640 (affirming $100,000 punitive damages award); Waits, 978 F.2d at 1104-06 (upholding jury’s $2 million punitive damages award in sound-alike claim). Indiana’s statute permits treble damages for right of publicity violations.

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