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# Carson v. Here's Johnny Portable Toilets, Inc.: Plumbing the Depths of the Right of Publicity

Carrie Goldstein

# *Carson v. Here's Johnny Portable Toilets, Inc.*: Plumbing the Depths of the Right of Publicity

*by* CARRIE GOLDSTEIN*

## I
## Introduction

A relatively new legal right, the right of publicity is a victim of its age.[1] Despite the fact that it has been defined with surprising consistency as comprising a person's right in the use of his name,[2] likeness,[3] activities,[4] or personal characteristics,[5] courts are still struggling with its scope and definition.[6] As one legal commentary noted, there is currently no consistent test for determining how far the right of publicity extends:

> The language of some courts would suggest that virtually any recognizable attribute would be protected. But a number of other decisions have refused to extend the right of publicity nearly as far. As a result, the extent to which a person's attributes are protected by the right of publicity remains unclear.[7]

This confusion and lack of predictability has serious first amendment implications. If interpreted too broadly, the right of

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* Member, Third Year Class.

1. *See infra* notes 11-14 and accompanying text.

2. *See, e.g.*, Cepeda v. Swift & Co., 415 F.2d 1205 (8th Cir. 1969) (real name); Gardella v. Log Cabin Prods. Co., 89 F.2d 891 (2d Cir. 1937) (stagename).

3. *See, e.g.*, Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973) (likeness); McQueen v. Wilson, 117 Ga. App. 488, 161 S.E.2d 63, *rev'd on other grounds*, 224 Ga. 420, 162 S.E.2d 313 (1968) (likeness).

4. *See, e.g.*, Palmer v. Schonhorn Enter., 96 N.J. Super. 72, 212 A.2d 458 (1967) (individual achievements); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (actual performance).

5. *See, e.g.*, Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977) (band leader's gestures as identifying characteristics).

6. *E.g.*, Hirsch v. S.C. Johnson & Son, Inc., 90 Wis. 2d 379, 280 N.W.2d 129 (1979) (is the right of publicity a property right or a personal right?); James v. Screen Gems, Inc., 174 Cal. App. 2d 650, 344 P.2d 799 (1959) (is the right of publicity devisable?); *see generally* Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577 (1979) (discussing the confusion between right of privacy and right of publicity and suggesting the abandonment of the terms "privacy" and "publicity").

7. Felcher & Rubin, *supra* note 6, at 1590.

publicity may impair the free exercise of rights guaranteed by the first amendment.[8] The boundaries of the right of publicity must be clearly drawn and a consistent method of analyzing right of publicity cases must be adopted by the courts if we are to foster the goals of the right of publicity without running afoul of first amendment freedoms.

A recent court of appeals decision, *Carson v. Here's Johnny Portable Toilets, Inc.*,[9] exemplifies the need for reform. In this case, the court gave protection to "Here's Johnny," a phrase popularly associated with entertainer Johnny Carson, under the right of publicity.[10] Such an extension of the right of publicity is unprecedented and undesirable.

After a brief overview of the right of publicity, this note examines and critiques the court's analysis in *Carson*. Then, drawing from established principles of copyright law, it suggests a new method of analysis that is more protective of first amendment freedoms. Finally, such analysis is applied to the facts of *Carson*.

## II
## The Right of Publicity: An Overview

Direct recognition of the right of publicity first came in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*,[11] a case in which the question of whether an exclusive contract right to photograph a person was legally cognizable was at issue. In holding that such right was legally cognizable, the court stated, "[W]e think that, in addition to and independent of [the] right of privacy . . . a man has a right in the publicity value of his photograph . . . the right

8. *See* Hoffman, *Limitations on Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111 (1980).

> [W]hen enforced, . . . the right of publicity may conflict with both the defendant's and the public's right of free expression in a number of ways. First the right of publicity can inhibit free expression . . . . Second, reports and commentaries on the thoughts and conduct of public and prominent persons [could] be subject to censorship under the guise of preventing the dissipation of the publicity value of a person's identity . . . .

*Id.* at 125. *See also* Felcher & Rubin, *supra* note 6, at 1594 ("[i]t is generally held that First Amendment rights require 'breathing space,' and uncertainty about the legal standards that control these rights is regarded as having a 'chilling effect' on freedom of expression"). *But see* Note, *The Right of Publicity—Protection for Public Figures and Celebrities*, 42 BROOKLYN L. REV. 527, 549 (1976) ("right of publicity is not a restriction on free speech because material that is the object of the right's protection is thoroughly commercial, beyond the reach of the first amendment").

9. 698 F.2d 831 (6th Cir. 1983).

10. *Id.* at 832.

11. 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

to grant the exclusive privilege of publishing his picture."[12] This language laid the foundation for the development of a right of publicity. In 1954, Melville Nimmer wrote the seminal article advocating judicial recognition of this new right,[13] and by the 1970's, judicial recognition of the right of publicity had been granted in a substantial number of jurisdictions.[14]

The theory underlying the right of publicity is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has a protectible interest in that identity.[15] There are three primary policy justifications for protecting that interest.[16] First, the right of publicity vindicates the economic interests of celebrities, enabling those whose achievements have "imbued their identities with pecuniary value"[17] to profit from their fame.[18] Second, the right of publicity fosters the production of intellectual and creative works by providing the financial incentive for individuals to expend the time and resources necessary to produce them.[19] Finally, the right of publicity serves societal interests by preventing what is regarded by our legal tradition as wrongful conduct: unjust enrichment and deceptive trade practices.[20]

The boundaries of the right of publicity are unclear. Though the right of publicity is routinely defined as comprising an individual's exclusive right to use his name, likeness, or personal characteristics, there is little consensus as to what this definition

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12. *Id.* at 868. Prior to *Haelen*, public personalities often attempted to use a right of privacy theory to protect their name, photograph, likeness, etc., but were generally unsuccessful. *See generally* Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

13. Nimmer, *supra* note 12.

14. *See, e.g.*, Ettore v. Philco Television Broadcasting Corp., 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956) (Pennsylvania, New Jersey, Delaware, New York); Lugosi v. Universal Pictures Co., 70 Cal. App. 552 (1977); Zacchini v. Scripps-Howard Broadcasting Co., 47 Ohio St. 2d 224, 231-34, 351 N.E.2d 454, 458-60 (1976), *rev'd on other grounds*, 433 U.S. 502 (1977) (Ohio).

15. 698 F.2d 831 (6th Cir. 1983). *See* Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

16. 698 F.2d at 838. *See generally* Hoffman, *supra* note 8, at 116-22.

17. Hoffman, *supra* note 8, at 116.

18. See Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977), wherein the television broadcast of a 15-second "human cannonball" act without the consent of the performer was held to be a violation of the performer's right of publicity:

> The broadcast . . . poses a substantial threat to the economic value of that performance. . . . Much of its economic value lies in the "right of exclusive control over the publicity given to [the] performance." If the public can see the act free on television, it will be less willing to pay to see it at the fair.

*Id.* at 573, 575-76.

19. *Id.* at 575-76.

20. Hoffman, *supra* note 8, at 118.

means.[21] For instance, what qualifies as a "name"? What qualifies as a "likeness"? The words are simple and few, but, as the remainder of this note makes apparent, the interpretations given them are varied and numerous.[22]

## III
## Expanding the Scope of the Right of Publicity

In *Carson v. Here's Johnny Portable Toilets, Inc.*,[23] appellants Johnny Carson and the apparel company with which he is associated brought suit against Here's Johnny Portable Toilets, Inc., for use of the phrase "Here's Johnny" in their corporate name. Appellants alleged, *inter alia*, infringement of the right of publicity.[24]

Appellant John W. Carson is the well-known host of "The Tonight Show," a talk-show program aired five nights a week by the National Broadcasting Company. The phrase "Here's Johnny" has been used to introduce Carson since he began hosting the show in 1962. The phrase is spoken in a distinctive drawn-out manner and has become associated with Carson by a large proportion of television viewers.[25]

The appellee, Here's Johnny Portable Toilets, Inc., is a Michigan corporation which rents and sells portable toilets.[26] Appellee's founder admittedly used the phrase "Here's Johnny" in its corporate name because of its association with "The Tonight Show." He stated that he coupled the phrase "Here's Johnny Portable Toilets" with the phrase "The World's Foremost Commodian" to make "a good play on a phrase."[27]

Although the district court dismissed the complaint,[28] the United States Court of Appeals for the Sixth Circuit reversed and

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21. *See supra* note 7 and accompanying text.

22. *Compare* Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962) (distinctive speaking style protected) *with* Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) (no relief for imitation of singing style).

23. 698 F.2d 831 (6th Cir. 1983).

24. Appellants also alleged unfair competition, trademark infringement under federal and state law, and infringement of the right of privacy.

25. 698 F.2d at 832-33.

26. *Id.* at 833.

27. *Id.*

28. Carson v. Here's Johnny Portable Toilets, Inc., 498 F. Supp. 71 (1980). Regarding the right of publicity and right of privacy theories, the trial court held that these rights extend only to a name or likeness. Additionally, "Here's Johnny" did not qualify on the unfair competition claim, and the court concluded that appellants had failed to satisfy the "likelihood of confusion" test.

found for Carson on a right of publicity theory.[29] The Sixth Circuit concluded that the district court's conception of the right of publicity was too narrow, and held that the scope of the right is not limited to the misappropriation of a "name" or "likeness," but rather extends to any situation in which a celebrity's identity is commercially exploited.[30] The appeals court relied on three cases to support this conclusion: *Hirsch v. S.C. Johnson & Son, Inc.*;[31] *Ali v. Playgirl, Inc.*;[32] and *Motschenbacher v. R.J. Reynolds Tobacco Co.*[33]

In *Hirsch*,[34] plaintiff-appellant Elroy Hirsch brought an action for damages for the unauthorized use of his nickname, "Crazylegs," on a shaving gel manufactured by defendant S.C. Johnson & Son, Inc. Hirsch is a nationally known sports figure who acquired the nickname "Crazylegs" while playing football at the University of Wisconsin in 1942.[35] The court took judicial notice that as recently as June 24, 1979, Hirsch had been referred to as "Crazylegs" in a Madison, Wisconsin newspaper.[36] Evidence was submitted to show that Hirsch had a proprietary interest in the nickname "Crazylegs"; he had made numerous commercials and advertisements that used the nickname to identify him.[37] The court held that the fact the name "Crazylegs" was plaintiff's nickname and not plaintiff's actual name did not preclude a cause of action under the right of publicity, but, rather, all that was required was a showing that the name clearly identified plaintiff.[38]

In *Ali*,[39] former heavyweight boxing champion Muhammad Ali brought an action for injunctive relief against Playgirl, Inc., for allegedly printing, publishing, and distributing an objectionable portrait of Ali in a magazine without authorization. The portrait in question depicted a nude black man seated on a stool in the corner of a boxing ring with both hands outstretched, resting on

29. Although other theories on which to award relief were advanced, this note is limited in scope to a discussion of the right of publicity. The court did not accept or reject the claim of invasion of privacy. The court found that there was no trademark infringement. 698 F.2d at 834.

30. 698 F.2d at 835.

31. 90 Wis. 2d 379, 280 N.W.2d 129 (1979).

32. 447 F. Supp. 723 (S.D.N.Y.1978).

33. 498 F.2d 821 (9th Cir. 1974).

34. 90 Wis. 2d 379, 280 N.W.2d 129 (1979).

35. For a brief overview of Hirsch's athletic career, see *id.* at 384-85, 280 N.W.2d at 131.

36. *Id.* at 384, 280 N.W.2d at 131.

37. *Id.* at 384-85, 280 N.W.2d at 131.

38. *Id.* at 397, 280 N.W.2d at 137.

39. 447 F. Supp. 723 (S.D.N.Y. 1978).

the ropes on either side.[40] The district court noted that "[e]ven a cursory inspection of the picture . . . suggests that the facial characteristics of the black male portrayed are those of Muhammad Ali. The cheekbones, broad nose and wideset brown eyes, together with the distinctive smile and close cropped black hair, are recognizable as the features of the plaintiff . . . ."[41] The picture, captioned "Mystery Man," was accompanied by a verse which referred to the figure as "The Greatest." The court took judicial notice that the plaintiff is regularly identified by the media and the public as "The Greatest."[42] In granting a preliminary injunction, the *Ali* court found that Ali had a proprietary interest in his "likeness" and that the unauthorized publication of a portrait unmistakably recognizable as the plaintiff amounted to a misappropriation of that likeness.[43]

In *Motschenbacher,*[44] Lother Motschenbacher, a professional driver of racing cars, sought injunctive relief and damages for the alleged misappropriation of his name, likeness, personality, and endorsement in a nationally televised cigarette commercial, under a right of publicity theory.[45] As an internationally known race car driver, Motschenbacher derived some of his income from manufacturers of commercial products who paid him for endorsing their products. Motschenbacher consistently individualized his cars to set them apart from the cars of other drivers. For instance, his car bodies were uniformly red, and his car number "11" was always placed against an oval background, as opposed to the circular background used on all other cars.[46] Defendant R.J. Reynolds Tobacco Co. produced a television commercial that utilized a stock photograph of race cars on a racetrack. Motschenbacher's car appeared in the foreground. Defendant altered the photograph as follows: Motschenbacher's car number "11" was changed to "71," a "spoiler" with the word "Winston" on it was attached to the car; and all other advertisements were removed from the car. The oval medallions bearing the racing car numbers and the red color of the car were retained.[47] In defendant's television commercial, a message reading "Did you know Winston tastes good like a ciga-

40. *Id.* at 726.
41. *Id.*
42. *Id.* at 726-27.
43. *Id.* at 728-29.
44. 498 F.2d 821 (9th Cir. 1974).
45. The advertisement was for "Winston" brand cigarettes.
46. 498 F.2d at 822.
47. *Id.*

rette should?" was made to appear to emanate from the altered version of plaintiff's car.[48] Plaintiff offered the affidavits of several persons who had seen the commercial, recognized Motschenbacher's car, and inferred that he was endorsing Winston Cigarettes (cigarettes manufactured by defendant R.J. Reynolds Company).[49]

On these facts, the Ninth Circuit Court of Appeals vacated the district court's grant of summary judgment for defendant and afforded Motschenbacher protection under the right of publicity.[50] The court concluded that, although neither Motschenbacher's name nor likeness was used in the commercial, he was nevertheless entitled to protection under the right of publicity since the driver of the car was identifiable as plaintiff due to the distinctive decorations on the vehicle.[51]

Although the above cases may initially appear to support the Sixth Circuit's holding in *Carson,* upon reflection it becomes evident that the *Carson* court's reliance on these cases was misplaced. *Hirsch* simply stands for the proposition that a nickname can in some instances qualify as a "name" and therefore receive protection under the right of publicity.[52] The court in *Hirsch* did not mention or discuss the treatment of descriptive phrases, such as "Here's Johnny," which are merely associated with an individual. In *Ali,* defendants virtually conceded that the artistic drawing in Playgirl Magazine was a depiction of Muhammad Ali,[53] and the court therefore concluded that the drawing was a "likeness" of Ali within the meaning of the right of publicity.[54] As in *Hirsch,* the *Ali* court did not express any opinion as to whether phrases merely associated with a person fall within the scope of the right of publicity. Therefore, neither *Ali* nor *Hirsch* can be seen as extending the right of publicity to phrases associated with a person, as was the situation in *Carson.*

At first glance, *Motschenbacher* and *Carson* appear to be similar cases. In *Motschenbacher,* plaintiff sought protection under the

48. *Id.*

49. *Id.*

50. *Id.* at 821. The district court had characterized the action as one for invasion of privacy. *Id.* at 822.

51. *Id.* at 827.

52. 698 F.2d at 842-43 (Kennedy, J., dissenting). The right of publicity has consistently been interpreted as providing protection for celebrities' names. *See supra* note 2 and accompanying text.

53. 447 F. Supp. at 726 & n.7.

54. *Id.* at 729.

right of publicity for the unauthorized use of one of his identifying characteristics—his car. Likewise, in *Carson*, plaintiff sought protection for the unauthorized use of one of his identifying characteristics—the phrase "Here's Johnny." A closer look, however, uncovers some significant distinctions.

In *Motschenbacher*, defendant's use of a "Winston" spoiler on a car identifiable as plaintiff's in a television commercial was injurious not only to plaintiff but also to the general television viewing public.[55] The plaintiff was economically injured, for, as he asserted, although part of his income as a race car driver was derived from commercial endorsements, he was not remunerated at all by defendant tobacco company for the television commercial. It is conceivable that the commercial might deter other tobacco companies from legitimately seeking Motschenbacher's endorsement, thereby depriving him of additional income. The television viewing public was also harmed because of the misleading nature of the commercial; plaintiff had several affiants who had seen the commercial and had inferred from it that plaintiff was endorsing Winston cigarettes.[56]

In contrast, both the district court and the appeals court in *Carson* found no evidence that appellant had been damaged by appellee's usage of the phrase.[57] The *Carson* courts further found that although the appellee had intentionally capitalized on the phrase "Here's Johnny," he did not intend to deceive the public into believing Carson was connected with the product. And, in fact, the courts found that there was little evidence of actual confusion.[58] Thus, while both *Motschenbacher* and *Carson* are concerned with an identifying characteristic, they are factually distinguishable from one another and, hence, the *Carson* court's reliance on *Motschenbacher* was misplaced.

The foregoing discussion indicates that there is a need for a new method of analyzing right of publicity cases. There are currently no consistent guidelines for our courts to follow when determining the scope of the right of publicity.[59] This lack of consistency is unacceptable for two reasons. First, with such an unstructured and unsystematic approach to determining the right of publicity, an overbroad definition of the right of publicity may be adopted by

55. 498 F.2d at 822.
56. *Id.*
57. 698 F.2d at 834.
58. *Id.*
59. *See supra* note 7 and accompanying text.

our courts, as the *Carson* case illustrates. Such an occurrence is clearly undesirable. If extended too far, the right of publicity may result in the impairment of precious first amendment freedoms.[60] As one commentator so aptly stated, "One man's right is another man's restraint . . . ."[61] That is, the additional rights that are granted to one individual under an expansive right of publicity simultaneously represent additional limitations that must be placed on the free speech rights of all other individuals in society. Such limitations on guaranteed first amendment freedoms must not be accepted casually. The ideal of free speech, if not the reality, is a cornerstone of our national ethos.[62] The public as a whole has important interests that are served by free and uninhibited expression,[63] and that require vigorous safeguarding. At the very least, set standards and criteria should be developed that will mandate cautious enforcement and expansion of the right of publicity.

A second problem with the current, haphazard approach to analyzing right of publicity cases is that it has the effect of making a court's decision very unpredictable. Unpredictability is less than ideal in any area of law, but it has always been regarded as particularly undesirable when issues of free speech are concerned.[64] "It is generally held that First Amendment rights require 'breathing space,' and uncertainty about the legal standards that control these rights is regarded as having a 'chilling effect' on freedom of expression."[65] The mere threat of sanctions may deter the exercise of first amendment freedom as potently as the actual appropriation of sanctions.[66]

Reform is necessary. Well-defined standards for analyzing right of publicity cases must be developed. Much can be borrowed from the law of copyright.[67]

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60. *See supra* note 8 and accompanying text.

61. Hoffman, *supra* note 8, at 112.

62. *See* A. MEIKLEJOHN, FREE SPEECH AND ITS RELATION TO SELF-GOVERNMENT (1948).

63. *Id.*

64. Felcher & Rubin, *supra* note 6, at 1592-96.

65. *Id.* at 1594; *see supra* note 8 and accompanying text.

66. Felcher & Rubin, *supra* note 6, at 1595.

67. Copyright is defined as "[t]he exclusive privilege, by force of statute, of an author or proprietor to print or otherwise multiply, publish, and vend copies of his literary, artistic, or intellectual productions, and to license their production and sale by others during the term of its existence." BALLANTINE'S LAW DICTIONARY 272 (3d ed. 1969). Simply stated, copyright means the right to copy.

## IV
## Analogy to Copyright as a New Methodology

At the heart of both copyright law and the right of publicity is an ongoing tension between two vital interests.[68] On one side is the interest in fostering our first amendment freedoms by opposing attempts of censorship.[69] On the other side is the interest in providing protection for the works of individuals so as to stimulate creative endeavors.[70]

The law of copyright has effectively dealt with this conflict by limiting the scope of copyright protection.[71] First, copyright protection does not extend to an author's ideas per se; there is no restraint on the use of an idea or concept.[72] Protection extends only to the manner in which the ideas are expressed.[73] This idea-expression dichotomy represents a workable balance between copyright and free speech interests.[74] As one legal commentator noted:

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68. *See generally* M. NIMMER, NIMMER ON COPYRIGHT § 1.10[A], at 62 (1983); Felcher & Rubin, *supra* note 6; Hoffman, *supra* note 8. But see M. NIMMER, *supra*, § 1.10[A], at 63-64, for a discussion of the view that copyright law falls within a built-in exception to the first amendment.

69. See M. NIMMER, *supra* note 68, § 1.10[B], at 1.70.1-1.72, for a review of policy justifications that underlie the freedom of speech.

70. *See* Mazer v. Stein, 347 U.S. 201 (1954):

> The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

*Id.* at 219. In Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977), the Court stated that these same considerations underlie the right of publicity. *See also* Hoffman, *supra* note 8, at 116 (stating that allowing talented persons to reap the full reward of their talents encourages creative efforts that benefit society).

71. *See* Nimmer, *Does Copyright Abridge The First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A. L. REV. 1180 (1970).

72. 17 U.S.C. § 102(b) (1981) ("In no case does copyright protection . . . extend to any idea."). *See, e.g.*, Baker v. Selden, 101 U.S. 99 (1880) (blank forms that merely record information are ideas that are not copyrightable).

73. *See* M. NIMMER, *supra* note 68, § 1.10[B], at 72 ("The market place of ideas would be utterly bereft, and the democratic dialogue largely stifled, if the only ideas which might be discussed were those original with the speakers.").

74. Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980):

> The idea/expression distinction, although an imprecise tool, has not been abandoned because we have as yet discovered no better way to reconcile the two competing societal interests that provide the rationale for the granting of and the restrictions on copyright protection: "rewarding an individual's ingenuity and effort while at the same time permitting the nation to benefit from further improvements or progress resulting from others' use of the same subject matter."

*Id.* at 912. For a good discussion of the use of the idea-expression dichotomy in copyright, see M. NIMMER, *supra* note 68, § 1.10[B], at 76-77.

> In some degree it encroaches upon freedom of speech in that it abridges the right to reproduce the "expression" of others, but this is justified by the greater public good in the copyright encouragement of creative works. In some degree it encroaches upon the author's right to control his works in that it renders his "ideas" per se unprotectible, but this is justified by the greater public need for free access to ideas as part of the democratic dialogue.[75]

A second limitation on the scope of copyright is triggered when there is a unity of idea and expression. When an idea is such that it is capable of expression in only a limited number of ways, copyright law will limit the amount of protection given to any one expression.[76] This offer of limited protection is an attempt to prevent an individual from receiving what in practice would amount to the monopolization of an idea. *Herbert Rosen Jewelry Corp. v. Kalpakian*[77] is illustrative of the point. In that case, plaintiff sought copyright protection for a jeweled bee pin. In denying protection, the court held that the similarity between plaintiff's and defendant's pins was inevitable because the "expression" of a jeweled bee pin contains nothing new over the "idea" of a jeweled bee pin.[78]

A third limitation imposed on copyright is the requirement of originality. To be "original," a work must be independently created and not copied from other works.[79] An author must put something of himself or herself into the work. There appears to be a "reciprocal relationship between creativity and independent effort."[80] This is not to say that a work must be creative to command copyright protection, but, rather, that the smaller the independent effort, the greater must be the degree of creativity in order to claim copyright protection. In this regard, Judge Jerome Frank, in *Heim v. Universal Pictures Co.*,[81] suggested that copyright protection would be granted to phrases such as "Euclid alone has looked on Beauty bare"[82] and "Twas brillig and the Slithy

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75. M. NIMMER, *supra* note 68, § 1.10[B], at 76-77.

76. Sid & Marty Krofft Television Prod., Inc. v. McDonald's Corp., 562 F.2d 1157, 1168 (9th Cir. 1977) (the "scope of copyright protection increases with the extent expression differs from the idea"). *See, e.g.*, Morrissey v. Procter & Gamble Co., 379 F.2d 675, 678 (1st Cir. 1967) (contest rules were held uncopyrightable because its subject matter permitted "if not only one form of expression, at best only a limited number"). *See infra* note 92 and accompanying text.

77. 446 F.2d 738 (9th Cir. 1971).

78. *Id.* at 739.

79. Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99 (2d Cir. 1951).

80. M. NIMMER, *supra* note 68, § 2.01[B]. at 15.

81. 154 F.2d 480 (2d Cir. 1946).

82. 154 F.2d at 487 n.8.

Toves."[83]

Finally, all copyrighted works are subject to the fair use doctrine.[84] This doctrine provides a defense to a copyright infringement action. A court will excuse the unauthorized use of a copyrighted work if the use is deemed "fair." In determining whether the use of a work is fair, a court will consider such factors as: (1) the purpose and character of the use; (2) the nature of the protected work; (3) the amount and substantiality of the portion used; and (4) the effect of the use upon the potential market for the protected work. This list is not exhaustive,[85] and a finding on any particular factor is not determinative; fair use is an equitable doctrine which is necessarily defined on a case by case basis.[86]

The limitations above are built into the laws of copyright. By narrowing the scope of protection, these limitations effectively preserve the interests of copyright without encroaching upon the fundamental principles of the first amendment.[87]

The right of publicity is similar to the law of copyright in that it is faced with the same competing interests: a desire to encourage creative efforts of individuals by providing economic incentives, and a desire to safeguard first amendment freedoms.[88] Unlike the law of copyright, however, the right of publicity has yet to strike a compatible balance among the competing interests. Such a balance can be achieved if the copyright limitations discussed above are applied to the right of publicity. When determining how far the right of publicity should extend—what attributes and characteristics will receive protection—a court should consider the idea/expression dichotomy; whether there is a unity in idea and expression; how original the work is; and whether in the particular case it is equitable to grant protection.[89] By utilizing this framework, a court can foster the goals underlying the right of publicity without running afoul of the first amendment.

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83. *Id.*

84. 17 U.S.C. § 107 (1981). For a more complete discussion of the fair use doctrine, see N. BOORSTYN, COPYRIGHT LAW 117-30 (1981).

85. 17 U.S.C. § 107 (1981).

86. H.R. REP. No. 94-1476, 94th Cong., 2d Sess. 65 (1976).

87. *See supra* note 74 and accompanying text.

88. *See supra* notes 69-70 and accompanying text.

89. *See supra* notes 71-86 and accompanying text.

## V
## A New Method in Action

The decision in *Carson* to extend the scope of the right of publicity to protect the phrase "Here's Johnny" is questionable when viewed in light of the suggested approach.

The phrase "Here's Johnny" is an example of an idea and an expression which are only marginally distinguishable. It is analogous to the jeweled bee pin example previously discussed.[90] There is almost complete unity of idea and expression; the expression of "Here's Johnny" contains little, if anything, new over the idea of introducing a person. When one considers the limited number of ways that an introduction can be expressed, the danger of granting a monopoly on such an expression becomes apparent. If the expression is simple and ordinary, granting a monopoly on its use would be akin to granting a monopoly on the very idea of using introductory phrases. In *Morrissey v. The Proctor and Gamble Co.*[91] the court recognized this danger when it held that simple contest rules are uncopyrightable:

> [When] the topic necessarily requires [it be limited to] if not only one form of expression, at best [to] only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances . . . it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated.[92]

In addition to the problem of the merging of idea and expression, there is a problem with the quantum of originality in the phrase "Here's Johnny." As the dissent in *Carson* noted, the phrase "Here's Johnny" is a "common, simple combination of a direct object, a contracted verb and a common first name; divorced from context, it is two dimensional and ambiguous."[93] A greater amount of creativity, i.e., originality, seems necessary to justify granting a monopoly on the expression. The phrase is distinguishable from identifying characteristics such as the race car in *Motschenbacher*, as the number and the various decorations on Motschenbacher's car were "unique enough to resist duplication

90. *See supra* notes 76-78 and accompanying text.
91. 379 F.2d 675 (1st Cir. 1967).
92. *Id.* at 678-79.
93. 698 F.2d at 844.

other than by intentional copying."[94]

Finally, even if the hurdles of unity of idea and expression and quantum of originality can be overcome, the issue of fair use remains. Taking into account factors such as the purpose and character of defendant's use, the nature of the work itself, the amount and substantiality of the portion used, and the effect of the use upon the potential market for the protected work, the court must determine the overall reasonableness of defendant's conduct.

The district court in *Carson* found that the defendant did not intend to deceive the public in any way and that there was little evidence of any confusion. The court also found no evidence that appellee's use of the phrase damaged appellants.[95] It is true that appellants in *Carson* might receive additional income by selling the rights to the phrase "Here's Johnny," but, as one legal commentator explained:

> [C]elebrities are compensated for the activities that generate their publicity values in the first place. To the extent this compensation provides them an adequate rate of return on the time and effort they have invested in their human capital, less weight need be accorded their individual interests in reaping additional remuneration for collateral uses of their names and likenesses . . . . Rewards accruing from collateral uses of their names and likenesses may be more like proverbial icing on the cake. . . . For the most part it is the Elvis Presleys, the Bela Lugosis, the Agatha Christies of the world who benefit from the right of publicity—and these are precisely the persons whose income would be more than adequate even if publicity rights were nonexistent.[96]

Consideration of the above factors reveals that appellee's use of the phrase "Here's Johnny" was a fair use and thus beyond the reach of appellant Carson's right of publicity.

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94. *Id.*

95. *See supra* notes 48-49, 57-58, and accompanying text. It is worth noting that, in contrast to *Carson*, defendant's acts in *Ali* and *Motschenbacher* at best confused the viewing public and at worst deceived them. An individual viewing the portrait in *Playgirl* is certain to recognize the likeness to Ali, just as a television viewer watching the Winston commercial is likely to notice the peculiar features on the racing car pictured, mistake the number "71" for an "11," and assume that Motschenbacher is endorsing Winston cigarettes. Also, plaintiffs in *Hirsch* and *Motschenbacher* were directly affected by defendant's actions. Both plaintiffs normally receive income from the very activity that was the subject of their complaint.

96. Hoffman, *supra* note 8, at 119-20.

## VI
## Conclusion

The courts currently have no consistent method of analysis for determining how far the right of publicity extends. As a result, there is much confusion and inconsistency in their decisions. This confusion jeopardizes our first amendment freedoms by increasing the likelihood that an overbroad definition of the right of publicity will be adopted by the courts.

Reform is necessary. A cohesive method of analysis must be developed and adhered to by the courts. Set criteria must be established that adequately balance the interests in both the right of publicity and the first amendment. As suggested, much can be borrowed from the law of copyright. The idea/expression dichotomy, originality requirement, and fair use doctrine are three principles of copyright law which can be applied effectively to the right of publicity. But what is of central importance is not that any one method in particular be adopted, but rather that some method be adopted. The stakes are high.