Preventing the Misappropriation of Identity: Beyond the Right of Publicity

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Preventing the Misappropriation of Identity: Beyond the "Right of Publicity"

by

SETH E. BLOOM*

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Introduction

Good name in man or woman, dear my lord,
Is the immediate jewel of their souls;
Who steals my purse steals trash; tis something, nothing;
'Twas mine, 'tis his, and has been slave to thousands;
But he that filches from me my good name
Robes me of that which not enriches him,
And makes me poor indeed.¹

Consistent with the individualistic social ethos pervading American life is the belief that all persons have a right to be left alone, a “right to privacy.”² Although such a right was relatively late in developing,³ most jurisdictions now recognize a common-law right of privacy and tort actions for violations of that right.⁴ Courts and commentators generally divide the right to privacy into four categories: unreasonable intrusion upon another’s seclusion and private affairs, public disclosure of embarrassing private facts about another person, publicity which places another in a false light, and appropriation of another’s name or likeness for one’s own advantage.⁵

The last of these four rubrics has developed into a separate doctrine, which many courts call the “right of publicity.” The right of publicity makes actionable the use of a person’s name or likeness (i.e., picture) without his or her consent.⁶ The doctrine is typically applied when a person’s name or likeness, usually a celebrity’s or public figure’s, is appropriated in a commercial context to advertise a product or service.

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¹. William Shakespeare, Othello, Act III, Scene 3.
². “[T]he right to privacy has been defined as the right to be let alone.” RESTATEMENT (SECOND) OF TORTS § 652A comment a (1977) [hereinafter RESTATEMENT]; see also W. PROSSER, & P. KEETON, PROSSER AND KEETON ON TORTS § 117 at 849 (5th ed. 1984).
³. A common-law right of privacy was unknown in the United States or England before 1890. The right of privacy was first asserted academically by Samuel Warren and Louis Brandeis in the noted article, The Right to Privacy, 4 HARV. L. REV. 193 (1890). For the history of the courts’ recognition of a legal right of privacy, see generally W. PROSSER & P. KEETON, supra note 2 § 117; Prosser, Privacy, 48 CALIF. L. REV. 383 (1960).
⁴. “One who invades the right of privacy of another is subject to liability for the resulting harm to the interests of the other.” RESTATEMENT, supra note 1, § 652A(l). In some jurisdictions, the right of privacy is statutory. See infra note 82.
⁵. Prosser, supra note 3, at 398. The Restatement makes virtually the same fourfold categorization. It states,

The right of privacy is invaded by
(a) unreasonable intrusion upon the seclusion of another, . . . or
(b) appropriation of the other’s name or likeness, . . . or
(c) unreasonable publicity given to the other’s private life, . . . or
(d) publicity that unreasonably places the other in a false light before the public

RESTATEMENT, supra note 2, § 652A(2).
⁶. The Restatement has defined what many courts call (as will this Article) the “right of publicity” in the following terms: “One who appropriates to his own use or benefit the name
The emergence of the right of publicity as a distinct doctrine is not surprising, as it plainly serves different interests from the three other types of right of privacy actions. The first three categories of the right to privacy tort generally protect a person's right "to be let alone" and guard against injuries to an individual's feelings or reputation as a result of unwanted, excessive, or false publicity. The right of publicity, on the other hand, protects a public figure's pecuniary interest in the commercial exploitation of his identity.\footnote{See Note, The Right of Publicity—Protection for Public Figures and Celebrities, 42 BROOKLYN L. REV. 527 (1976). The U.S. Supreme Court accepted this distinction between the general right of privacy and the right of publicity in Zacchini v. Scripps-Howard Brdct. Co., 433 U.S. 562, 573 (1980).} Indeed, many commentators view the right of publicity not as a privacy concern at all, but rather as a form of property right.\footnote{See infra note 182 and accompanying text.}

The traditional application of the doctrine extended protection only to an individual's name or likeness. That is, only appropriations of one's name or likeness could be actionable, not uses of other aspects of identity. However, the law has now begun to recognize that characteristics other than name or likeness may identify a person sufficiently for him or her to claim the exclusive right to control their use. For example, a famous actor's or singer's distinctive voice may be such that its imitation immediately brings to mind the person imitated. Likewise, a prominent celebrity's unique appearance, dress, hairstyle, or clothing may be imitated so that the audience believes the actual celebrity is present. What is common to all these situations is an attempt to appropriate or exploit another's identity, usually for commercial ends.

In recent years the right of publicity doctrine has been extended to protect from appropriation many characteristics of identity beyond merely name or likeness. While liberalizing the doctrine beyond its original formulation in this manner may appear to be more responsive to the fundamental goal of protecting the integrity of identity, discarding the relative certainty of the name or likeness standard creates new difficulties. The range of permissible expression is necessarily limited once the right of publicity is expanded. A vague, diffuse protection for identity or likeness of another is subject to liability to the other for invasion of his privacy." RESTATEMENT, supra note 2, § 652C.

Although it was not the first case applying the doctrine, the term "right of publicity" was apparently coined by Judge Jerome Frank in Haelen Laboratories v. Topps Chewing Gum, 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953). The case involved a contract dispute between a chewing gum company and a baseball player and the use of his photograph on baseball cards sold with the gum. The court stated that "a man has a right in the publicity value of his photograph," a "right of publicity." 202 F.2d at 868; see Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 842 n.6 (6th Cir. 1983) (dissenting opinion) (the right of publicity did not "emerge" until 1953).
inevitably chills the portrayal of public figures and grants public figures an unregulated monopoly over the use of various "attributes" of identity, a monopoly that may not be deserved. Moving beyond the traditional strictures of name or likeness in order to protect the misappropriation of identity has thus proven to be problematic.

This Article discusses the scope of the right of publicity and the desirability of expanding the protection afforded by the doctrine beyond its original boundaries of name or likeness. Recent developments in the case law are first explored and then an analysis of the proper scope of the doctrine is undertaken.

I
The Developing Case Law: The Emerging Protection for "Attributes of Identity"

In the last decade, considerable litigation has occurred concerning the scope and boundaries of the right of publicity. Courts have come to recognize that there are many ways to appropriate an individual's identity, beyond merely using one's name or a picture of one's face. Advertisers have known this truth for many years and have applied this knowledge in many creative ways to advertise products. This advertising led to increased litigation by aggrieved public figures, which in turn forced the courts to confront the issue of appropriation. While, in general terms, the courts have expanded the right of a publicity action to extend beyond name or likeness appropriation, this expansion of the tort has occurred inconsistently among different jurisdictions, both in its doctrinal formulation and its logical basis. A review of several leading right of publicity decisions illustrates both the abandonment of the traditional name or likeness limitation and the difficulties in formulating a new definition of precisely what the "right of publicity" should protect.

A. Slogan As an Attribute of Identity: Carson v. Here's Johnny Portable Toilets, Inc.

A recent leading decision that addresses the scope of the right of publicity doctrine, albeit in rather unique circumstances, is Carson v. Here's Johnny Portable Toilets, Inc. In Carson, the U.S. Court of Appeals for the Sixth Circuit confronted the issue of whether a company


10. 698 F.2d 831 (6th Cir. 1983).
that sold portable toilets violated a prominent entertainer's right of publicity by using a phrase associated with him in the name of its product.

The plaintiffs in this case were the prominent entertainer and television talk show host, Johnny Carson, and also Johnny Carson Apparel, Inc. Carson was a major stockholder of Carson Apparel and had licensed it to use his name and picture on its product and advertising materials. Johnny Carson has achieved national prominence as the host of the popular television program *The Tonight Show*, which broadcasts nationwide five nights a week on NBC. From the time he began hosting *The Tonight Show* in 1962, Carson has been introduced every night by the words "Here's Johnny." Carson never registered the phrase "Here's Johnny" as a trademark or service mark, although in 1977, Carson Apparel, Inc. granted a license to Marcy Laboratories to use the phrase as the name of a line of men's toiletries.11

The defendant, a Michigan corporation formed in 1976, sold and rented portable toilets. As well as using the phrase "Here's Johnny" in its corporate name, the defendant named its product the "Here's Johnny Portable Toilet." The defendant's founder admitted he adopted this name for his product fully aware that "Here's Johnny" was the introduction for Carson on *The Tonight Show*. He stated that he coupled the phrase "Here's Johnny" with another, "the world's foremost comedian," to make "a good play on a phrase."12

Carson apparently was not amused.13 He sued the defendant in federal court in Michigan, claiming unfair competition, trademark infringement, and invasion of privacy and publicity rights because of the defendant's use of the phrase "Here's Johnny" without his consent. Carson sought damages from the defendant's resulting profits and an injunction prohibiting the defendant's further use of the phrase.

The U.S. District Court for the Eastern District of Michigan entered judgment in favor of the defendant corporation and ordered the suit dismissed.14 On the unfair competition and trademark infringement claims, the court held that Carson failed to satisfy the "likelihood of confusion" test.15 With respect to the invasion of privacy and right of publicity theo-

11. *Id.* at 833.
12. *Id.*
13. The court of appeals commented, "Clearly, the association does not appeal to Carson's sense of humor." *Id.* at 834.
15. This test states that unfair competition and trademark infringement are present if, as a result of the defendant's conduct, the public is likely to believe that the product was originated by, or sponsored by, the plaintiff, thereby creating a "likelihood of confusion." *Id.* at 74 (citing Societe Comptoir De L'Industrie v. Alexander's Dep't Stores, Inc., 299 F.2d 33, 36 (2d Cir. 1962); *Restatement of Torts* § 729 (1938)).
ries, the trial judge followed the traditional rule that the right of publicity only protects appropriation of a "name or likeness" and that "Here's Johnny" did not so qualify. The judge stated that it "would not be prudent to allow recovery for a right to publicity claim [that] does not more specifically identify Johnny Carson."\textsuperscript{16} Carson appealed the judgment against him to the U.S. Court of Appeals for the Sixth Circuit.

In a two-to-one decision, the Sixth Circuit reversed the district court. The court of appeals upheld the lower court's disposition of the unfair competition and trademark issues, but held that Carson's right of publicity had been violated by the defendant's use of the phrase "Here's Johnny."

The majority's analysis of the right to privacy claim began with a discussion of the established fourfold classification of the tort, as discussed above. The court noted that "the right of privacy and the right of publicity protect fundamentally different interests and must be analyzed separately."\textsuperscript{17} It then stated, with little further explanation, that "the facts here presented do not . . . amount to an invasion of any of the interests protected by the [first three types of] right of privacy."\textsuperscript{18}

Purporting to apply Michigan law, which had not yet addressed the right of publicity,\textsuperscript{19} the majority set forth a new formulation of the right of publicity doctrine. It rejected the trial court's approach, which followed the rule enunciated in the \textit{Restatement (Second) of Torts}\textsuperscript{20} that limited the right of publicity to protecting only against appropriation of one's \textit{name} or \textit{likeness}.\textsuperscript{21} The majority found such a doctrine to be "too narrow"\textsuperscript{22} because "a celebrity's legal right of publicity is invaded whenever his \textit{identity} is intentionally appropriated for commercial purposes."\textsuperscript{23} The court concluded that "[i]f the celebrity's identity is commercially exploited [without that celebrity's consent], there has been an invasion of the right [of publicity], whether or not his name or likeness is used."\textsuperscript{24}

\textsuperscript{16} \textit{Id.} at 78.
\textsuperscript{17} \textit{Carson}, 698 F.2d at 834.
\textsuperscript{18} \textit{Id.}
\textsuperscript{19} \textit{Id.}
\textsuperscript{20} \textit{Restatement, supra} note 2, § 652C; see also \textit{W. PROSSER \\& P. KEETON, supra} note 2, § 117, at 851 n.20 (Prosser, however, implies that the "name or likeness" limitation on what is protected by the right of publicity need not always be followed).
\textsuperscript{21} The court of appeals assumed, as does this discussion, that using the phrase "Here's Johnny" was not to be considered an appropriation of Carson's name, as the name "Johnny" alone did not identify Johnny Carson.
\textsuperscript{22} \textit{Carson}, 698 F.2d at 835.
\textsuperscript{23} \textit{Id.} at 837 (emphasis added).
\textsuperscript{24} \textit{Id.} at 835.
Applying this new "identity" test, the majority first found that "the phrase 'Here's Johnny' is generally associated with Carson by a substantial segment of the television viewing public," making the phrase "Here's Johnny" part of Carson's public identity. Second, the court found that the defendant intentionally used the phrase because of its association with Carson. The president of the defendant corporation admitted that he knew that for years the phrase introduced Carson on television. The defendant's counsel, in fact, agreed to stipulate before trial that the words "Here's Johnny" were publicly associated with Johnny Carson. The court thus reached the conclusion that "the 'Here's Johnny' name was selected by [the defendant's president] because of its identification with Carson." Since the phrase was appropriated for the defendant's commercial purposes, all the elements of the majority's new test for determining violations of the right of publicity were satisfied. The majority held, therefore, that "Carson's right of publicity was invaded because appellee intentionally appropriated his identity for commercial exploitation."

The court of appeals majority was quite explicit in stating the policy basis for its expansion of the protection offered by the right of publicity. The court stressed that the right of publicity existed to protect a public figure's exclusive right to exploit the pecuniary value of his public identity. It reasoned,

The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. . . . "The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality."

Under this analysis, giving celebrities the sole right to financially exploit their identities is desirable, because it encourages the type of achievement that makes one famous in the first place. This right adds financial reward for persons to expend the time and resources necessary to produce intellectual and creative works that have the potential to bring one fame. The court argued that "[c]ertainly appellant Carson's

25. Id. at 832-33.
26. Id. at 836.
27. Id.
28. Id.
29. Id. at 835 (quoting Memphis Dev. Found. v. Factors Etc., 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953 (1980)).
achievement has made him a celebrity which means that his identity has a pecuniary value which the right of publicity should vindicate."

Conversely, the majority believed it was unjust that people who have done nothing to help make the celebrity famous should be able to profit from the celebrity's fame. The majority claimed that "[v]indication of the right [of publicity] will also tend to prevent unjust enrichment by persons such as appellee who seek commercially to exploit the identity of celebrities without their consent." A celebrity's public identity, the majority contended, may be appropriated in various ways. The majority held, therefore, that there was no reason to limit actionable appropriation only to circumstances in which a celebrity's name or likeness was used, if other characteristics would identify him or her in the public eye.

Supporting this view, the majority cited several cases where the use of various characteristics other than the plaintiff's name or likeness were held to violate the plaintiff's right of publicity. In one case, Motschenbacher v. Reynolds Tobacco Company, the Ninth Circuit Court of Appeals held that the plaintiff, a famous race car driver, had his right of publicity violated when an advertisement used a slightly altered picture of his distinctive race car without his consent. In another, Hirsch v. S.C. Johnson & Sons, Inc., the defendant was held to have violated a famous retired athlete's right to publicity by using his nickname, "crazylegs," to advertise a shaving gel for women.

Judge Cornelia Kennedy wrote a lengthy and well reasoned dissent to the Sixth Circuit's opinion in Carson. She disagreed with the majority's doctrinal innovation, its policy arguments, and its application of its own test to the facts of the case.

The dissent first argued that, even using the majority's new formulation of the right of publicity, the defendant's use of the phrase "Here's Johnny" did not appropriate Carson's identity. The phrase had no connection to Johnny Carson other than being his introduction on The Tonight Show. Judge Kennedy pointed out that "[t]he phrase is not said by Johnny Carson, but said of him." She simply did not believe that the

30. Id. at 837; see also Hoffman, Limitations on the Right of Publicity, 28 BULL. COPYRIGHT SOC'Y 111, 116-22 (1980).
31. Carson, 698 F.2d at 837.
32. Id.
33. 498 F.2d 821 (9th Cir. 1974).
34. 90 Wis. 2d 379, 280 N.W.2d 129 (1979).
words “Here’s Johnny” were part of Carson’s identity or could be construed in any way as “belonging to” him. She explained that
Johnny Carson’s fame as a comedian and talk show host is severable from the phrase with which he is associated, “Here’s Johnny.” This phrase is not Johnny Carson’s “thumbprint”; it is not his work product; it is not original; it 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. It can hardly be said to be a symbol or synthesis, i.e., a tangible “expression” of the “idea,” of Johnny Carson the comedian and talk show host . . . . 37

Rather than protecting the economic interests of Carson, Judge Kennedy contended “the majority is awarding Johnny Carson a windfall.” 38

Moreover, the goal of encouraging the production of creative and intellectual works was not served by giving Carson the exclusive right to use the words “Here’s Johnny,” a phrase neither created nor performed by him. Judge Kennedy pointed out that “the phrase contains nothing personal to Carson in the sense of being caused by him or a product of his time, effort and energies.” 39 By gaining the exclusive right to use the phrase, “Johnny Carson is simply reaping the rewards of the time, effort and work product of others.” 40 In sum, the dissent argued, the phrase was neither part of Carson’s identity nor a product of his own efforts. Thus defendant’s use of the phrase violated neither the majority’s new test nor the principal purpose of the right of publicity doctrine. 41

In addition, and most significantly of all, Judge Kennedy disagreed with the majority’s new formulation of the right to publicity doctrine. She argued that two countervailing policies opposed an excessively broad definition of the right of publicity. First, a court should be restrained in recognizing publicity rights, since “[p]rotection under the right of publicity confers a monopoly on the protected individual that is potentially broader, offers fewer protections and potentially competes with federal statutory monopolies [such as trademark or copyright].” 42 The monopoly on the use of items to which the right of publicity attaches is for the public figure’s entire life without being subject to governmental regulation or limitation. Thus, expanding the protection afforded by the right of publicity would run squarely counter to the federal policy of discour-

37. Id. at 844. Judge Kennedy pointed out that, “It cannot be claimed that Johnny Carson’s appearances on ‘The Tonight Show’ are the only times at which a performer is introduced with the phrase ‘Here’s ——.’ Numerous other performers are introduced with the phrase ‘Here’s ——,’ using their first name, last name or full name.” Id. at 838 n.1.
38. Id. at 838.
39. Id. at 845.
40. Id. at 839.
41. Id.
42. Id. at 840.
aging monopolies. Moreover, a broadly defined "publicity right" monopoly provides virtually no notice to the public of what is claimed to be protected. Thus the public is left to act at its peril, with the threat of a potential lawsuit if an arguably "protected" item is used. "The result is a chilling effect on commercial innovation and opportunity."  

The dissent also contended that important free expression and first amendment interests were harmed by an excessively broad definition of what was protected by the right of publicity. Judge Kennedy pointed out that "[s]trong federal policy permits the free use of intellectual property, words and ideas that are in general circulation and not protected by a valid copyright, patent or trademark." Removing items from the public domain as a result of the operation of the right of publicity doctrine contradicts this fundamental policy.

In addition, the dissent criticized the majority's approach as a form of strict liability, imposing liability without fault on unsuspecting users of anything protected. Judge Kennedy stated that "the majority's extension of the right of publicity to phrases and other things merely associated with an individual is not conditioned upon wrongdoing and would apply with equal force in the case of an unknowing user."  

Because of these considerations, Judge Kennedy’s dissenting opinion proposed a balancing test to determine what characteristics, in addition to name or likeness, should be protected by the right to publicity. She wrote,

The right of publicity, whether tied to name, likeness, achievements, identifying characteristics or actual performances, etc. conflicts with the economic and expressive interests of others. Society's interests in free enterprise and free expression must be balanced against the interests of an individual seeking protection in the right of publicity where the right is being expanded beyond established limits.

Under this approach, the phrase “Here’s Johnny” was not entitled to protection since “the public’s interest in free enterprise and free expres-

43. Monopolies are discouraged under federal law because of the basic public policy of fostering free enterprise and the belief that monopolies are economically inefficient and disadvantageous to the consumer. See generally Northern Pac. Ry. v. United States, 356 U.S. 1, 4 (1958); Apex Hosiery Co. v. Leader, 310 U.S. 469, 493 (1940).


46. Carson, 698 F.2d at 839. The validity of using this argument to attack the majority's approach seems doubtful, because the majority would only impose liability for intentional appropriation of a celebrity's identity. See id. at 837.

47. Id. at 839.
sion takes precedence over any interest Johnny Carson may have in a phrase associated with his person." 48

*Carson* is noteworthy because it so starkly presents the alternatives available in determining the proper scope of right of publicity protection. Once the certainty and clarity of the name or likeness test is abandoned, defining the boundaries of the doctrine presents a clash of competing basic social policies. The dilemma of the rights of individuals to control the use of their identities versus society’s interests in free expression, as well as the economic interests of creative industriousness, is presented in each of the other decisions reviewed below.

### B. Use of Vocal Impression: *Midler v. Ford Motor Company*

In *Midler v. Ford Motor Company*, 49 the U.S. Court of Appeals for the Ninth Circuit conferred *Carson*-type protection in favor of another celebrity, this time the prominent singer and actress, Bette Midler. While the *Midler* court never used the phrase “right of publicity,” it plainly applied a publicity analysis in reaching its decision. The court began its opinion by stating that “[t]his case centers on the protectability of the voice of a celebrated chanteuse from commercial exploitation without her consent.” 50

The *Midler* case focused on an advertising campaign created by the advertising agency Young & Rubicam, Inc. for the Ford Motor Company. In 1985, Young & Rubicam created a television advertising campaign to sell Ford cars that aimed to make “an emotional connection with Yuppies.” 51 The campaign centered around various popular songs of the 1970s, with a different song in each commercial. The advertising agency attempted to have the performer who initially popularized each song to sing that song for the television commercial. When the original performer was unwilling to do so, the agency had the songs performed by

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48. *Id.* at 841. After the Sixth Circuit's *Carson* decision in 1983, the case was remanded to the district court for a determination of appropriate relief. The district court awarded Carson over $30,000 in damages and enjoined the defendant from using the phrase “Here's Johnny” anywhere in the Nation. The defendant appealed, arguing that the injunction should be limited to Michigan, because it was unclear whether other states would recognize the broad right of publicity enunciated by the Sixth Circuit to be Michigan law. *Carson v. Here's Johnny Portable Toilets*, 810 F.2d 104 (6th Cir. 1987). The court of appeals rejected defendant's arguments and held that a national injunction was proper “[B]ecause there are indications that other states would hold as we have predicted Michigan would . . . .” *Id.* at 105. The court explained that if the defendant sought to use the phrase in states where it believed such use would not be prohibited, it could seek a modification of the injunction at that time. *Id.*

49. 849 F.2d 460 (9th Cir. 1988).

50. *Id.* at 461.

51. *Id.*
so-called "sound alikes."\textsuperscript{52} In the course of this campaign, the advertising agency wished to use a song originally performed by Bette Midler in 1973, entitled "Do You Want to Dance." Bette Midler did not own the copyright, but the advertising agency contacted Midler's agent to inquire if Midler would consent to the use of this song. Midler's agent informed Young & Rubicam that she would not so consent.\textsuperscript{53}

Young & Rubicam nevertheless proceeded with the commercial. It decided to use another singer, Ula Hedwig, who had performed as a backup singer, one of The Harlettes, for Midler in the past. In performing "Do You Want to Dance," Hedwig was instructed by Young & Rubicam to "sound as much as possible like the Bette Midler record."\textsuperscript{54}

Hedwig intentionally imitated Midler "to the best of her ability."\textsuperscript{55} Hedwig was successful: after the commercial was aired, a number of people told Midler that the song in the commercial "sounded exactly" like Midler's recording of "Do You Want to Dance." Hedwig likewise was told by many friends that they thought it was Midler performing in the commercial.\textsuperscript{56}

Neither Bette Midler's name nor her picture was used in the commercial, and Young & Rubicam had a license from the copyright holder to use the song.\textsuperscript{57} Therefore, the Ninth Circuit noted, "At issue in this case is only the protection of Midler's voice."\textsuperscript{58}

Midler filed suit against both the advertising agency, Young & Rubicam, and its client, Ford, in the U.S. District Court for the Central District of California, claiming that the defendants had "irreparably damaged" her reputation by producing and televising the commercial.\textsuperscript{59} The trial court, however, granted the defendants' motion for summary judgment and dismissed the suit. The court dismissed Midler's suit despite its characterization of the defendants' conduct as that "of the average thief," and as an "[i]f we can't buy it, we'll take it" approach.\textsuperscript{60} Similar to the \textit{Carson} trial court, the district court simply "believed that

\textsuperscript{52} \textit{Id.}

\textsuperscript{53} \textit{Id.} At trial, Ms. Midler explained her refusal to consent to the use of "Do You Want to Dance" in a television commercial. "I don't do commercials," she stated. "I don't believe in it. I resent people looking at the commercial and thinking that's me. They think I've sold out." Anderson, \textit{Soundalike Suit}, A.B.A. J., Jan. 1990, at 24.

\textsuperscript{54} \textit{Midler}, 849 F.2d at 461. Only a few "aahs" deemed "unsuitable for the commercial" were omitted. \textit{Id.}

\textsuperscript{55} \textit{Id.}

\textsuperscript{56} \textit{Id.} at 461-62.

\textsuperscript{57} \textit{Id.} at 462.

\textsuperscript{58} \textit{Id.}

\textsuperscript{59} Anderson, supra note 53, at 24.

\textsuperscript{60} \textit{Midler}, 849 F.2d at 462.
there was no legal principle preventing imitation of Midler's voice."

It apparently took the traditional view of limiting protection to appropriation of name or likeness, neither of which were implicated here. Midler appealed this decision to the U.S. Court of Appeals for the Ninth Circuit.

In an unanimous decision, a three-judge panel of the Ninth Circuit reversed the trial court's order dismissing the suit and remanded the case for trial. The court held that Midler stated a cause of action based on her common law right to the protection of her identity—plainly a "right to publicity" analysis. In reaching this decision, the court overcame several hurdles—the first amendment, federal copyright law preemption, and several California Civil Code provisions.

The Midler court first rejected the argument that the first amendment protected the defendant's action. The court explained that "[t]he purpose of the media's use of a person's identity is central. If the purpose is 'informative or cultural' the use is immune; 'if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.'" Since Young & Rubicam used Midler's song for purely

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61. Id.
62. Id. (quoting Felcher & Rubin, Privacy, Publicity and the Portrayals of Real People by the Media, 88 YALE L.J. 1577, 1596 (1979)) (emphasis added). Felcher and Rubin claimed that, in the context of media portrayals, this distinction "account[s] for court decisions regarding media portrayals more consistently than any rules that can be stated solely in terms of the right of privacy and publicity." Id. Such an analysis, however, is overly simplistic at least with respect to application of the "right to publicity" doctrine. If the court's main concern is the purpose of appropriation, then all commercial appropriation would be actionable. Such an approach begs the question. As the Felcher and Rubin article discusses, one must determine whether "identity" has been appropriated in the first place. Id. Moreover, in certain contexts, purely commercial exploitation of certain features of a celebrity's identity may in fact be worthy of protection. See infra text accompanying notes 181-82.

Generally, however, courts refuse to find the right of publicity violated when the plaintiff's name or likeness is used in a dramatic performance or nonfictional work for commercial or advertising purposes. See, e.g., Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) (the court, applying Oregon law, found that film actress Ginger Rogers did not have a valid right of publicity claim against producers of Ginger and Fred, a film about two fictional Italian cabaret performers); Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978) (fictional work based on life of writer could not be basis of right of publicity action); Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979) (Bird, C.J., concurring) (right of publicity did not bar the use of a celebrity's name not used to endorse a collateral commercial product; television broadcast about Rudolph Valentino's life entitled Legend of Valentino: A Romantic Fiction did not violate Valentino's right of publicity); Frosch v. Grosset & Dunlap, Inc., 75 A.D.2d 768, 769, 427 N.Y.S.2d 828, 829 (N.Y. App. Div. 1980) (Right of publicity did not bar the use of a celebrity's name in a title so long as the item was a literary work and not "simply a disguised commercial advertisement for the sale of goods or services."). But cf. Binns v. Vitagraph Co., 210 N.Y. 51, 103 N.E. 1108 (1913) (dramatic portrayal in motion picture picture of action of wireless operator involved in steamship collision violated New York right of privacy statute).

Courts generally argue that fundamental free expression interests mandate this limitation. Former Chief Justice Bird of the California Supreme Court, concurring in Guglielmi, aptly summed up the basis for this limitation on the doctrine as follows: "[P]rominence invites
commercial motives, the court refused to confer first amendment immunity on its actions.

creative comment. Surely the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction." 25 Cal. 3d at 869, 603 P.2d at 460, 160 Cal. Rptr. at 358 (Bird, C.J., concurring).

This distinction—that dramatic, informative, or cultural portrayals of an individual cannot violate the right of publicity, while uses of identity only for commercial or advertising purposes can violate the right of publicity—is logically flawed. Courts often justify this distinction by pointing out that only the exploitation of another's identity for financial gain as with commercial advertising should be made actionable (e.g., using Johnny Carson to sell portable toilets). See, e.g., Frosch, 75 A.D.2d at 769, 427 N.Y.S.2d at 829. However, commercial gain is also a motive for dramatic or nonfictional portrayals. The television network, film studio, theater, or book publisher that shows or publishes the dramatic portrayal is motivated by the desire to earn money as much as the toilet manufacturer in Carson or the automobile manufacturer in Midler. Even the author of the nonfiction work or newspaper article which uses a celebrity's identity hopes that the portrayal will generate income so that the author can make a living.

This point was made in a special concurrence to the decision reached in Martin Luther King, Jr., Center for Social Change, by Justice Welton of the Georgia Supreme Court, which criticized the Georgia Supreme Court's recognition of the right of publicity doctrine. He disagreed with the court's definition of the doctrine as use of another's name or likeness without consent and for the "financial gain" of the appropriator. He commented as follows:

If "financial gain" is to be the watershed of violation vel non of this new-found right, it cannot withstand scrutiny. It is rare, indeed, that any expression of sentiment beyond casual conversation is not somehow connected, directly or indirectly, to "financial gain." For example, a school child wins a $25 prize for the best essay on Dr. [Martin Luther] King's life. Is this "financial gain?" Must the child then account for the winnings?

The essay, because of its worth, is reprinted in a commercial publication. Must the publisher account?

The publication is sold on the newsstand. Must the vendor account?

Obviously, the answers to the above questions will vary, and properly so, because the circumstances posited are vastly different. The dividing line, however, cannot be fixed upon the presence or absence of "financial gain." Rather, it must be grounded in the community's judgment of what, ex aeguo et bono, is unconscionable.

Were it otherwise, this "right of publicity," fully extended, would eliminate scholarly research, historical analysis, and public comment, because food and shelter, and the financial gain it takes to provide them, are still essentials of human existence.

Were it otherwise, no newspaper might identify any person or any incident of his life without accounting to him for violation of his "right to publicity."

Were it otherwise, no author might refer to any event in history wherein his reference is identifiable to any individual (or his heirs!) without accounting for his royalties.


Justice Weltner's comments are well founded. It is not the presence of financial gain that is decisive for the recognition of the right of publicity, but rather the court's judgment that certain types of exploitation of identity are to be tolerated, and are indeed desirable—namely, appropriation of a public figure's identity in a dramatic portrayal or a nonfictional work—while exploitation of identity to sell a product or service unrelated to the public figure is not to be permitted. See Estate of Presley v. Russen, 513 F. Supp. 1339, 1356-58 (D.N.J. 1981).
Neither did provisions of federal copyright law preempt Midler's suit. As noted above, Young & Rubicam had obtained a license to use the song from the copyright holder. Moreover, Midler was not claiming that the song had obtained a secondary meaning, i.e., that it was uniquely associated with her, nor was she attempting to prevent the defendants from using the song. She was attempting only to protect her rendition of the song, that is, the imitation of her voice. This court found this latter point crucial. This plainly is a "right to publicity" analysis, even if not identified as such. The court further ruled that such a claim could not be preempted by federal copyright law, because a voice is not copyrightable. As the court pointed out, copyright law only protects "original works of authorship fixed in any tangible medium of expression." The court held the sound of one's voice is not so fixed; thus a voice is not copyrightable.

The core of the Ninth Circuit decision was its attempt to move beyond the traditional strictures of the "right of publicity" tort to prevent this use of Bette Midler's identity. The court held that Midler's claim for relief could lie under a common law misappropriation theory. California Civil Code § 3344, which afforded damages to a person injured by use of his "name, voice, signature, photograph or likeness," was of no aid to Midler simply because none of the attributes named in the statute were used by the defendants. The voice used was Ms. Hedwig's, not Midler's, and the term "likeness" referred only to visual image, not a vocal imitation. However, the court ruled, this statute did "not preclude Midler from pursuing any cause of action she may have at common law" as its remedies are merely "cumulative."
Midler's only remaining cause of action was for appropriation of common law property rights, recognized as a tort in California. The court held that Midler made out such a cause of action based on the fact that defendants "for their own profit in selling their product did appropriate part of her identity" and reversed the trial court's grant of summary judgment for the defendants.

The court compared this case with the decision of the Ninth Circuit fourteen years earlier in *Motschenbacher v. R.J. Reynolds Tobacco Company*. In *Motschenbacher*, the Ninth Circuit ruled that the use of signs and symbols on a racing car associated with a race car driver in an advertisement without use of the driver's actual picture, was an actionable appropriation of the attributes of the driver's identity, an appropriation that "suggested" that the driver was appearing in the advertisement. "In the same way," the court stated, "the defendants have used an imitation to convey the impression that Midler was singing for them."

Plainly, Midler's voice was of value to the defendants—why else would they have asked her to perform the song for them and, failing that, why would they have "studiously acquired the services of a sound-alike and instruct[ed] her to imitate Midler." Indeed, the court explained that this attempted appropriation of Midler's voice was an effort to take as intimate a part of Midler's identity as could be imagined:

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

Therefore, the court concluded, what defendants "sought was an attribute of Midler's identity." This appropriation of an attribute of identity was actionable. The Ninth Circuit stated its holding as follows: "when a distinctive voice of a professional singer is widely known and

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71. Midler, 849 F.2d at 463 (citing Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 823 (9th Cir. 1974)). In *Motschenbacher*, the Ninth Circuit held that California common law recognizes an injury for the appropriation of one's identity. 498 F.2d at 825-26.

72. Id. at 463-64.

73. 498 F.2d 821 (9th Cir. 1974).

74. Midler, 849 F.2d at 463.

75. Id.

76. Id.

77. Id. (quoting D. IHDE, LISTENING AND VOICE 77 (1976)).
deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and committed a tort in California. 78

In *Midler*, therefore, another court expanded protection for identity beyond merely name or likeness protection. Although fully consistent with the *Carson* majority's holding that the "right of publicity" is violated whenever the celebrity's identity is intentionally appropriated for commercial purposes, 79 the Ninth Circuit panel in *Midler* gave no consideration to the competing interests noted by the dissent in *Carson*. Completely absent from the decision is any consideration of the effects of the *Midler* precedent on free expression and first amendment interests.

It is plain, however, that the singer's voice in *Midler* was more worthy of protection than the slogan said by another about an entertainer in *Carson*. Unlike "Here's Johnny," Midler created her distinctive voice and performed it. Moreover, the defendants in *Midler* intentionally attempted to appropriate this voice for their commercial ends, despite Midler's unwillingness to cooperate. Even had *Midler* applied the balancing test of Judge Kennedy in *Carson*, it seems likely that the defendants' conduct would have been actionable.

The essential significance of *Midler* demonstrates how far courts have moved in their abandonment of the traditional name or likeness test. In the face of a plain statute that did not include vocal imitation as a form of actionable appropriation, the court ruled that the statute was inapplicable and held imitation of a celebrity's voice in advertising to be an actionable taking of an "attribute of identity." 80

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78. *Id.* The case was remanded for trial to the U.S. District Court for the Central District of California. Ms. Midler prevailed, and was awarded a $400,000 jury verdict against Young & Rubicam. Anderson, *supra* note 53, at 24. At trial, the judge dismissed Ford Motor Company as a defendant due to insufficient evidence of an agency relationship linking Ford to Young & Rubicam's tortious conduct. *Id.*


The *Waits* case appears to move beyond even *Midler*. While Waits' voice was imitated in the advertising, the lyrics of one of his songs were not. Additionally, the defense's argument that Waits was not sufficiently well-known to be unlawfully imitated failed. *Id.*
C. Visual Impersonations as Misappropriation of Identity

Until this point, the case law discussed has interpreted the common-law right of publicity.\(^8\) However, several states have enacted privacy statutes that attempt to specifically define the dimensions of what judges call the “right of publicity” (i.e., the misappropriation of another’s identity).\(^2\) These statutes (unlike California’s) typically limit the cause of action to the traditional confines of name or likeness appropriation. Such legislative definition of the boundaries of misappropriation has not, however, halted the development of the case law. Indeed, in recent years courts have continued to expand misappropriation protection beyond the traditional limits of name or likeness appropriation under (or despite) these statutes.

An important jurisdiction with such a statute is New York, which in 1903 enacted what is now codified as sections 50 and 51 of the New York Civil Rights Law.\(^3\) These sections provide both civil and criminal sanctions for using “the name, portrait or picture of any living person” for purposes of trade or advertising without having first received written consent.\(^4\) As a result of this statute, the New York courts do not recognize any common-law “right of publicity,” but hold instead that an action of this type is exclusively governed by the Civil Rights Law.\(^5\)


Whether New York’s apparently narrow statutory protection could be extended beyond mere use of name or likeness was considered in Onassis v. Christian Dior-New York, Inc.\(^6\) The plaintiff was Jacqueline Kennedy Onassis, widow of both President John F. Kennedy and of Aristotle Onassis, and “a well-known personality in her own right.”\(^7\) She sued the defendants, a clothing and cosmetic company (Christian Dior),

\(^8\) The Midler case ruled that the California statute did not apply to the vocal impersonation at issue and instead applied a common-law analysis to determine if the impersonation was actionable. The cases discussed in this section, by contrast, are governed by statute.

\(^2\) See, e.g., N.Y. CIV. RIGHTS LAW § 50 (McKinney 1976), § 51 (McKinney Supp. 1991); CAL. CIV. CODE § 3344 (Deering 1984 and Supp. 1991); FLA. STAT. ANN. § 540.08 (West 1988); VA. CODE ANN. § 8.01-40 (1984). Sections 50-51 of the New York Civil Rights Law are provided in full in Addendum II to this Article infra p. 532. Section 3344 of the California Civil Code is provided in full in Addendum I to this Article, infra p. ____.

\(^3\) See Addendum II to this Article, infra p. 532, for the complete text of these sections and a brief discussion of their history.

\(^4\) N.Y. CIV. RIGHTS LAW §§ 50-51.


\(^7\) Id. at 603, 472 N.Y.S.2d at 256.
an advertising agency, a celebrity "look-alike" agency, a photographer, and a model, in a New York state court over a magazine advertisement for Dior merchandise that utilized, without Onassis's consent, a model who closely resembled Onassis.

The advertisement at issue mixed fictional characters and real people. It was a photograph of a group of people, entitled "Christian Dior: Sportswear and Clothing for Men." Included in the photograph were television personality Gene Shalit, model Shari Belafonte, and actress Ruth Gordon. Also present was Barbara Reynolds, a woman who bore "a remarkable resemblance to plaintiff Jacqueline Onassis."

The photograph depicted an elegant, extravagant, and stylish wedding, characterized as "a legendary private affair." The trial judge commented that "[o]f course, what stamps it as 'legendary', is the presence of this eclectic group, a frothy mix, the most legendary of which would clearly be Jacqueline Kennedy Onassis, shown discretely behind Gordon and Shalit, obviously delighted to be in attendance at this 'event.'"

The visual impersonation of Onassis "was no mere happenstance." Instead, it was deliberate: the defendant advertising agency contacted codefendant Ron Smith Celebrity Look-Alikes to provide someone who could "pass for" Onassis. Dior reportedly spent $2.5 million on this ad campaign. After the advertisement appeared, sales of Dior's merchandise "went through the roof."

Onassis's lawsuit alleged that the advertisement violated her rights under the New York Civil Rights Law sections 50 and 51 and her right to privacy, and she requested an injunction against future use of the advertisement.

The court recognized that Onassis's claim was governed by sections 50 and 51 of the Civil Rights Law, which grants a civil action to those injured because of use of their "name, portrait or picture" without their consent. As the court explained,

Plaintiff's name appears nowhere in the advertisement. Nevertheless, the picture of a well-known personality, used in an ad and instantly recognized, will still serve as a badge of approval for that commercial product. It is designed to "catch the eye and focus it on the advertisement." That is why the use of a person's "portrait or picture" without consent is also proscribed.

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88. Id. at 605, 472 N.Y.S.2d at 257.
89. Id., 472 N.Y.S.2d at 257.
90. Id., 472 N.Y.S.2d at 257.
91. Id. at 606, 472 N.Y.S.2d at 258.
92. N.Y. Civ. RIGHTS LAW § 51. For the complete text of this section, see Addendum II to this article, infra p. 532.
The court stated that the case therefore turned on whether, as a result of its intentional visual impersonation, the advertisement could be considered to have used Onassis's "portrait or picture." A literal reading of the statute implies that her portrait or picture was not so used, as Onassis herself was not photographed in the advertisement.

However, after reviewing prior decisions construing the statute, the court attempted to resolve this issue quite expansively. It held that "the phrase 'portrait or picture' as used in [section] 51 of the Civil Rights Law is not restricted to actual photographs, but comprises any representations which are recognizable as likenesses of the complaining individual."\(^94\)

Turning to the specific facts of the case, the court held that the advertisement at issue violated the Civil Rights Law and granted Onassis's motion for a preliminary injunction enjoining any further use of the advertisement. The court held that use of the model who resembled Onassis in the advertisement created the illusion that Onassis actually appeared in the advertisement and endorsed Dior's product.\(^95\) Crucial to this illusion was "[t]he juxtaposition of the counterfeit figure [of Onassis] just behind the real-life figures of a veteran actress, a [TV] personality, and a well-known model."\(^96\) The advertisement was thus "deceptive [and] promote[d] confusion"\(^97\) and was properly enjoined.

The court was not persuaded by the arguments of the Onassis model, Barbara Reynolds, that her free expression rights and artistic career would be harmed. All that Reynolds did was capitalize on her phys-
ical resemblance to Onassis; she did not create anything to achieve this effect. "To paint a portrait of Jacqueline Kennedy Onassis is to create a work of art; to look like Jacqueline Kennedy Onassis is not." Reynolds merely attempted to capitalize on her resemblance to Onassis for commercial purposes. While she was free to appear as Onassis in dramatic performances, the court held that doing so in the context of commercial advertising violated the Civil Rights Law.

Finally, the court was not persuaded by the defendants' first amendment arguments. It tersely stated that "[l]ittle more heed need be given to the contention that somehow this advertisement is privileged as a protected form of free speech. It deals with the sale of goods, and not with the promulgation of ideas." The court summarized its holding by stating that "[i]n essence, this court finds . . . that plaintiff's identity was impermissibly misappropriated for the purposes of trade and advertising, and that it makes no difference if the picture used to establish that identity was genuine or counterfeit."

The fundamental significance of Onassis is that, faced with statutory language that on its terms narrowly limited the misappropriation action to a name or portrait, the Onassis court, as would courts in Carson and Midler not so governed by statute, refused to so circumscribe the action. The court held that the principle to be distilled from a study of the statute and of the cases construing it is that all persons, of whatever station in life, from the relatively unknown to the world famous, are to be secured against rapacious commercial exploitation. While the statute may not, by its terms, cover voice or movement, character or style, it is intended to protect the essence of the person, his or her identity or persona from being unwillingly or unknowingly misappropriated for the profit of another. . . . The essence of what is prohibited, as the statute, the cases, and the dictionary definitions make clear, is the exploitation of one's identity as that is conveyed verbally or graphically. Thus, the seemingly exact terms of a statute were reduced to protection from exploitation of the "essence" of one's "identity." This, as we have seen, was eventually the same result reached by the Sixth Circuit major-

98. Id. at 613, 472 N.Y.S.2d at 262.
99. Id. at 614, 472 N.Y.S.2d at 262. The dismissal of defendant's first amendment arguments, while consistent with the terms of New York's Civil Rights Law, completely ignored the now well-established principle that commercial speech—speech aimed at the sale of goods or services—is entitled to constitutional protection. See Central Hudson Gas & Elec. Corp. v. New York Pub. Serv. Comm'n, 447 U.S. 557 (1980); L. Tribe, AMERICAN CONSTITUTIONAL LAW §§ 12-15, at 890-904 (2d Ed. 1988). The Onassis decision thus either demonstrates a surprising degree of ignorance by the trial judge, or illustrates the dangers, for free expression interests, of a broad reading of a "right to publicity."
100. Onassis, 122 Misc. 2d at 615, 472 N.Y.S.2d at 263.
101. Id. at 610-11, 472 N.Y.S.2d at 260-61 (emphasis added).
ity in Carson a year earlier (a decision not cited in Onassis) and the Ninth Circuit in Midler five years later (a decision that does not cite Onassis).

The court’s paramount concern was preventing the exploitation of the public figure’s identity. It explained,

> We are dealing here with actuality and appearance, where illusion often heightens reality and all is not quite what it seems . . . . If we truly value the right of privacy in a world of exploitation, where every mark of distinctiveness becomes grist for the mills of publicity, then we must give it more than lip service and grudging recognition. Let the word go forth—there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.\(^{102}\)

The court, however, attempted to reconcile this protection for identity with the limits of the statute. “There are many aspects of identity,” the court pointed out. “A person may be known not only by objective indicia—name, face, and social security number—but by other characteristics as well—voice, movement, style, coiffure, typical phrases, as well as by his or her history and accomplishments.”\(^ {103}\) However, the court held that, in its Civil Rights Law, the New York legislature “accorded protection only to those aspects and identity embodied in name and face.”\(^ {104}\)

Nonetheless, the holding in Onassis is plainly an expansive reading of the statutory protection afforded by a narrowly tailored statute. Once again, the court expanded the misappropriation action beyond traditional limits to protect the taking of “identity.” In attempting to prevent exploitation of identity for commercial ends, the court felt justified to reach out and broadly construe the statute to prevent “the commercial hitchhiker” from “travel[ling] on the fame of another.”\(^ {105}\)


*Allen v. National Video, Inc.*\(^ {106}\) presented a similar issue of visual impersonation. Instead of the impersonation at issue being of the plaintiff however, it was of a fictional character that the plaintiff portrayed on film.

Woody Allen, a noted comic actor and film director, sued National Video, a video club, for using a Woody Allen impersonator to advertise

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102. *Id.* at 612, 472 N.Y.S.2d at 261.
103. *Id.*, 472 N.Y.S.2d at 261. The court’s implication that voice, movement, and style are not “accomplishments” is not always tenable. Especially for entertainers, one’s personal style and similar characteristics may be the product of many years of effort to develop a public persona recognizable and popular with the public. In this sense the public’s recognition of these characteristics are, for the entertainer, “accomplishments.”
104. *Id.*, 472 N.Y.S.2d at 261.
105. *Id.*, 472 N.Y.S.2d at 261.
PREVENTING THE MISAPPROPRIATION OF IDENTITY

membership in the club. The "celebrity impersonator," Phil Boroff, whom plaintiff claimed was masquerading as Allen, portrayed a satisfied holder of National Video's movie rental "V.I.P. card." Allen asserted that the advertisement "appropriate[d] his face" and implied his endorsement. Therefore, he argued, it violated his statutory right to privacy, his right to publicity, and the Federal Lanham Act's prohibition against misleading advertising. He filed suit in the U.S. District Court for the Southern District of New York, seeking both damages and injunctive relief.

The advertisement in question plainly impersonated Allen. The advertisement contained a photograph that, in the words of the trial judge, portrays a customer in a National Video store, an individual in his forties, with a high forehead, tousled hair, and heavy black glasses. The customer's elbow is on the counter, and his face, bearing an expression at once quizzical and somewhat smug, is leaning on his hand. It is not disputed that, in general, the physical features and pose are characteristic of plaintiff [Allen].

Moreover, the advertisement pictured the impersonator with videotape cassettes of Woody Allen films, Annie Hall and Bananas, as well as Humphrey Bogart films that were associated with Allen as a result of a character Allen portrayed in Play It Again Sam. In addition to the photograph, the advertisement contained the following words: "Become a V.I.P. at National Video. We'll Make You Feel Like A Star." It added that "you don't need a famous face to be treated to some pretty famous service."

The defendants admitted that Boroff "was selected and posed as he was to capitalize on his resemblance to [Woody Allen]," and that Boroff had in the past offered his services as a look-alike for Allen. Nor was there any dispute that the photograph in question was used in the advertisement for commercial purposes and that Allen did not give his consent to the use of the photograph.

The advertisement was placed in Video Review, a trade magazine, as well as on "countercards" distributed to National Video's franchisees. The advertisement placed in Video Review contained a disclaimer that stated: "celebrity double provided by Ron Smith's Celebrity Look-

107. The impersonator and the owner of the impersonator's talent agency were named as defendants as well.
108. The trial judge commented that "[t]his case arises because plaintiff, to paraphrase Groucho Marx, wouldn't belong to any video club that would have him as a member." Allen, 610 F. Supp. at 617.
109. Id. at 617-18.
110. Id. at 618.
111. Id.
112. Id.
Alike's, Los Angeles, California.

Both plaintiff and defendants moved for summary judgment. The defendants principally argued that since "Boroff merely appeared as someone who looks like Woody Allen, but not as Woody Allen himself, then plaintiff's rights were not violated." As we have already seen, a similar argument was to be found unavailing by the court in *Midler*.

Ruling on the cross-motions for summary judgment, the court first addressed Allen's privacy and publicity claims. The court explained that to make out a violation of section 51 of the New York Civil Rights law (the section authorizing a civil action), a plaintiff must satisfy three elements: 1) use of the plaintiff's name, portrait, or picture 2) for commercial or trade purpose, 3) without plaintiff's written permission. The court stated that the traditional "name or likeness" rule applied under the Civil Rights Law: "Merely suggesting certain characteristics of the plaintiff, without literally using his or her name, portrait or picture is not actionable under the statute." To make out a claim under the statute, therefore, Allen had to show the advertisement appropriated his "name or picture."

Woody Allen originally pleaded a common-law right of publicity claim, but in light of the New York Court of Appeals' intervening ruling in *Stephans v. New Group Publications* that no common-law right of publicity existed in New York, Allen moved to amend his complaint to delete references to the common law as a source for the right of publicity. The court granted the motion, stating that it would "treat plaintiff's causes of action for privacy and publicity together under the general rubric of privacy."

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113. *Id.*
114. *Id.*
115. *Id.* at 621.
116. *Id.; see, e.g., Lahr v. Adell Chem. Co.*, 300 F.2d 256, 258 (1st Cir. 1962) (the court, applying New York Law, found no statutory violation resulting from defendant's impersonation of plaintiff Bert Lahr's distinctive voice in a television commercial); Wojtowicz v. Delacourte Press, 43 N.Y.2d 858, 374 N.E.2d 129, 403 N.Y.S.2d 218 (1978) (no statutory violation based on identifiable description of plaintiff in dramatization of a true story that did not show her face or use her true name); Lombardo v. Doyle Dane & Birnbach, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977) (no statutory violation resulting from recognizable depiction in a television commercial of plaintiff Guy Lombardo's style of conducting "Auld Lang Syne" in a New Year's Eve setting when plaintiff's name was not used and impersonator did not resemble plaintiff).
was that "plaintiff have cultivated a valuable property interest in his public image"—a requirement "without question" satisfied here.119

The court ruled that Allen sufficiently satisfied the last two of the three elements necessary to make out a violation of the Civil Rights Law. The only element in serious dispute was whether the photograph in the advertisement was a "portrait or picture" of Allen.120 Allen argued, as did the plaintiffs in Carson and Midler, that his "portrait or picture" was used as matter of law, because of the photograph's resemblance of him or, at least, of a character he created in many films. He also claimed that the props used identified him. In essence, he argued that his identity was appropriated: "Plaintiff notes that it is not necessary that all persons seeing the photograph actually identify him, only that he be identifiable from the photograph."121

The court, however, was not persuaded. First, it pointed out, this case differed from those cases in which actual photographs of the plaintiff were used, and the issue in dispute was whether the pictures were too old or too obscure to be recognizable as the plaintiff.122 This case held a closer resemblance, the court believed, to those cases holding that any "recognizable likeness," not only an actual photograph, might be considered a "portrait or picture."123 Under these cases, the court stated, if defendants had used a clearly recognizable painting or cartoon of plaintiff, this would constitute a "portrait or picture" under the Civil Rights Law.124

However, a "look-alike's" impersonation of a celebrity was different and "more problematic," the court concluded. Unlike a printing or drawing, the impersonator has his own identity and his own appearance. "Plaintiff's privacy claim therefore requires the court to answer the almost metaphysical question of when one person's face, presented in a certain context, becomes, as a matter of law, the face of another."125 The court was concerned, moreover, with the interests of the impersonator: it pointed out that any actor "has the right to exploit his or her own face

119. Id. at 621-22.
120. Id. at 622.
121. Id. (emphasis in original).
123. See, e.g., Ali v. Playgirl, 447 F. Supp. 723, 726 (S.D.N.Y. 1978) ("clearly recognizable" drawing of Muhammad Ali portrayed as boxer, captioned "The Greatest", constitutes a "portrait or picture" under statute); Young v. Grenecker Studios, Inc., 175 Misc. 1027, 1027, 26 N.Y.S.2d 357, 358 (Sup. Ct. 1941) (Mannequin made in plaintiff's likeness was his "portrait or picture").
125. Id.
for personal gain”—a right itself protected by the Civil Rights Law.\textsuperscript{126} In other words, the right of Allen to control the exploitation of his identity and the right of Boroff to make a living came into conflict, a conflict the court would have to mediate in order to decide Allen’s misappropriation claim.

The court pointed out that under New York’s statute Allen’s interest in exploiting his image might not weigh heavily. Instead, Allen’s interests were more properly considered under a “right of publicity” theory, a right not recognized in New York. The court commented that

\textit{[u]}nlike the Civil Rights Law provision, which is primarily designed to compensate for the hurt feelings of private people who find their identities usurped for another’s commercial gain, the right of publicity protects this property interest of the celebrity in his or her public identity. . . . It is primarily this [latter] interest which Woody Allen seeks to vindicate in the case at bar.\textsuperscript{127}

The court, therefore, was unwilling to grant Allen summary judgment on his claim under the New York privacy statute. The court noted that whether a photograph creates a recognizable likeness of a person is ordinarily an issue of fact for the jury. For the court to grant summary judgment in favor of Allen’s claim, it must conclude that the photograph in question “creates, as a matter of law, the illusion of Woody Allen’s actual presence in the advertisement.” It concluded it could not find, as a matter of law, that the photograph of Boroff in the advertisement was a “portrait or picture” of Allen.\textsuperscript{128}

Several factors militated against summary adjudication of Allen’s misappropriation claim. First, the resemblance between Allen and Boroff was not exact: “there are several physical differences between plaintiff’s face and that of defendant Boroff.”\textsuperscript{129} Second, the image of Allen presented by the photograph was that of his earlier works than those of the time of the lawsuit, filed in 1984 and decided a year later. The court noted that “the hair style and expression [of the look-alike in the advertisement], while characteristics of the endearing ‘schlemiel’ embodied by plaintiff in his earlier comic works, are out of step with plaintiff’s post-‘Annie Hall’ appearance and the serious image and sober mien that he has projected in recent years.”\textsuperscript{130} Finally, the court stated that it could not conclude that no reasonable jury might find that the photograph was not of Allen. Although the advertisement plainly made “ref-
ence” to Allen, it could not conclude that it contained Allen’s portrait or picture as required by the Civil Rights Law.\textsuperscript{131}

The court contrasted this case with the decision in \textit{Onassis v. Christian Dior-N.Y., Inc.}\textsuperscript{132} of a year earlier. As discussed above,\textsuperscript{133} \textit{Onassis} held that, under the Civil Rights Law, it was sufficient to claim that the overall impression created an image of the plaintiff appearing herself in the advertisement, even if her own photograph had not been duplicated. What was decisive in \textit{Onassis}, the \textit{Allen} court stated, was the “illusion” that Onassis was present in the advertisement,\textsuperscript{134} an illusion created by juxtaposing the Onassis look-alike in one large photograph with several actual celebrities.\textsuperscript{135}

The \textit{Allen} court asserted that the \textit{Onassis} decision was fully consistent with the “portrait or picture” requirement of section 51 of the Civil Rights Law. Because of the “illusion” created by the advertisement, the advertisement implied that the look-alike was Onassis. The \textit{Allen} court stated that in that unique situation a look-alike could constitute a “portrait or picture” of the plaintiff. It concluded that “when, as in \textit{Onassis}, the look-alike seems indistinguishable from the real person and the context of the advertisement clearly implies that he or she is the real celebrity, a court may hold as a matter of law that the look-alike’s face is a ‘portrait or picture’ of plaintiff.”\textsuperscript{136} In \textit{Allen}, though, such was not the case: the court held that it could not conclude, as a matter of law, that the advertisement created the “illusion” that Allen was present.

Ultimately, however, the court evaded the necessity of holding that Allen’s Civil Rights Law claim failed by finding that Allen could obtain the identical injunctive relief—an order precluding defendants from representing that Boroff was actually Allen in advertising—under a novel interpretation of section 1125(a) of the federal Lanham Act.\textsuperscript{137} By grant-

\begin{itemize}
\item \textsuperscript{131} \textit{Id.}
\item \textsuperscript{132} 122 Misc. 2d 603, 472 N.Y.S.2d 254 (Sup. Ct. 1984), aff’d mem., 100 A.D.2d 1095, 488 N.Y.S.2d 943 (1985).
\item \textsuperscript{133} See supra text accompanying notes 101-03.
\item \textsuperscript{134} \textit{Allen}, 610 F. Supp. at 613.
\item \textsuperscript{135} \textit{Id.}
\item \textsuperscript{136} \textit{Id.} at 623.
\item \textsuperscript{137} At the time of the \textit{Allen} decision, this portion of the Lanham Act read as follows:
\begin{quote}
Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or
\end{quote}
\end{itemize}
ing Allen summary judgment on his Lanham Act claim, the court ruled that a resolution of Allen’s privacy claim was unnecessary.138

The court noted that the Lanham Act was not limited only to situations that constituted formal trademark infringement; it also applied to “unfair competitive practices resulting in actual or potential deception.”139 The court pointed out that just as a trademark holder had an important interest in maintaining the value and integrity of the trademark, a celebrity had similar interests in his name or face. The court explained,

A celebrity has a similar commercial investment in the “drawing power” of his or her name and face in endorsing products and in marketing a career. The celebrity’s investment depends upon the good will of the public, and infringement of the celebrity’s rights also implicates the public’s interest in being free from deception when it relies on a public figure’s endorsement in an advertisement. The underlying purposes of the Lanham Act therefore appear to be implicated in cases of misrepresentations regarding the endorsement of goods and services.140

The court therefore held that “the unauthorized use of a person’s name or photograph in a manner that creates the false impression that the

by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125(a) (1982). In 1988, this provision was amended. The amended statute provides as follows:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a) (1988). The new language in Section 1125(a)(1), which makes representations likely to cause confusion regarding the “sponsorship” or “approval” of goods, services, or commercial activities by another person actionable, has interesting implications for the right of publicity. A strong argument can be made that advertising that appropriates a person’s identity so as to imply that the person endorsed the product or service is unlawful under this statute, despite the fact that the legislative history of the 1988 amendment does not discuss this issue or mention that it had such a purpose. See S. REP. NO. 515, 100th Cong., 2d Sess. 40-41, reprinted in 1988 U.S. CODE CONG. & ADMIN. NEWS 5577, 5603-04. No reported decision was found that construed this new language with respect to the right of publicity doctrine. The 1988 amendment can be expected to become a source of right of publicity-type litigation in the future.

139. Id. at 625.
140. Id. at 625-26.
party has endorsed a product or service in interstate commerce violates the Lanham Act."³¹⁴¹

Unlike the Civil Rights Law claim, Allen’s claim under the federal Lanham Act did not require that the court find that Allen’s “portrait or picture” had been used, only that the advertisement created the “likelihood of consumer confusion” over whether Allen endorsed the product.³¹⁴² This standard, the court pointed out, is “broader than the strict ‘portrait or picture’ standard under the Civil Rights Law. Evocation of plaintiff’s general persona is not enough to make out a violation of section 51, but it may create a likelihood of confusion under the Lanham Act.”³¹⁴³ The broader standard was justified, the court explained, because the purpose of the Lanham Act is the protection of the public’s interest in avoiding deception, not merely the protection of the plaintiff’s property interest in his face.³¹⁴⁴

The court concluded that the plaintiff showed on the undisputed facts, as a matter of law, that a likelihood of consumer confusion existed as a result of the advertisement.³¹⁴⁵ It, therefore, granted Allen’s summary judgment motion on his Lanham Act claim and enjoined Boroff from appearing in advertising that created the likelihood that a reasonable person might believe that he was really Allen or that Allen had approved of Boroff’s appearance. This injunction was national in scope.³¹⁴⁶ The court, however, was sensitive to Boroff’s own free expression rights and his right to earn a living. The court held that Boroff could continue to act as an Allen impersonator “in any setting [, including advertising,] where the overall context makes it completely clear that he is a look-alike and that plaintiff has nothing to do with the project.”³¹⁴⁷

The trial judge was plainly uncomfortable, however, with her holding that the Civil Rights Law did not protect Allen and her consequent necessity to engage in a novel reading of the Lanham Act. In significant dicta, she echoed the concern that the Sixth Circuit majority in Carson expressed about the traditional limits on “right of publicity,” limits also circumscribed by the Civil Rights Law. Chief Judge Motley noted,

Since the New York Court of Appeals has subsumed the common-law right of publicity within the relatively narrow statutory requirements of [section 51], it may fall to the state legislature to fashion a workable remedy to protect the pecuniary interests of celebrities in the market value of their identities and to protect the public from the false impli-

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¹⁴¹ Id. at 626.
¹⁴² Id. at 626-27.
¹⁴³ Id. at 628.
¹⁴⁴ Id. at 629.
¹⁴⁵ Id. at 630.
¹⁴⁶ Id.
¹⁴⁷ Id. (emphasis in original).
cation of endorsement. Controlling the use of a person's "portrait or picture" may be sufficient to protect the feelings of private citizens, but a broader statute modeled on the Lanham Act might provide fuller protection for the interests threatened when a celebrity's endorsement is implied without the use of an actual "portrait or picture."\(^{148}\)

Woody Allen's effort to halt the appropriation of his identity in advertising did not end with Chief Judge Motley's 1985 decision in *Allen v. National Video, Inc.* As one might have expected, Boroff continued to impersonate Allen in advertising, albeit with a disclaimer as mandated by Judge Motley. In April 1986, an advertisement appeared in the New York newspaper *Newsday* for a clothing store, Men's World Outlet, Inc., in which Boroff appeared holding a clarinet.\(^{149}\) Once again Boroff resembled Allen and, in addition, "[t]he copy evoked the 'schlemiel' persona Allen cultivated up through his appearance in Annie Hall."\(^{150}\) Below the photograph of Boroff, in small type, the following statement appeared: "This is a Ron Smith Celebrity Look-Alike."\(^{151}\)

Allen attempted to re-open the prior lawsuit, and hold Boroff and Ron Smith in contempt of Judge Motley's 1985 Order.\(^{152}\) The court refused to hold Boroff or Smith in contempt.\(^{153}\) While Judge Motley stated that the Men's World advertisement was in "clear contempt" of the spirit of her 1985 decision, she also "reluctantly" found that the advertisement failed to violate the specific terms of the order.\(^{154}\) The advertisement, she reasoned, *did* contain the disclaimer mandated by the order, albeit a weak one, and the order did not specify any other manner by which Boroff or Smith were to avoid the possibility of consumer confusion.\(^{155}\)

However, the court amended its 1985 order to make it stronger and more specific. Boroff was not to appear as a look-alike of Allen in advertising unless the text of the advertisement, in bold face type equal in size to the body of the advertising text, identified Boroff as a look-alike and disclaimed any connection between Allen and the advertised product or service.\(^{156}\)

\(^{148}\) *Id.* at 624 n.5.


\(^{150}\) *Id.*

\(^{151}\) *Id.*

\(^{152}\) *Id.* at 624 n.3. Boroff also was to give a copy of the court's new order to all potential clients wishing to use him as an Allen look-alike. The order also imposed the same restrictions on Smith.

\(^{153}\) *Allen*, 679 F. Supp. at 362.

\(^{154}\) *Id.*

\(^{155}\) *Id.* 626 n.3. Boroff also was to give a copy of the court's new order to all potential clients wishing to use him as an Allen look-alike. The order also imposed the same restrictions on Smith.

\(^{156}\) *Id.* at 362.
This June 1986 order did not end the Woody Allen look-alike litigation. Allen next filed suit against Men's World and its advertising agency, R&S.\textsuperscript{157} As in the earlier litigation, Allen claimed, \textit{inter alia}, that the advertisement violated his rights under the Civil Rights Law sections 50-51 and the federal Lanham Act.\textsuperscript{158}

After ruling that Allen's common-law unjust enrichment claim and his claim under New York's General Business Law section 368-d\textsuperscript{159} were "equivalent to a claim of violation of his right of publicity" and, therefore, must be dismissed as cognizable only under the Civil Rights Law,\textsuperscript{160} Judge Motley addressed Allen's Civil Rights Law claim. In so doing, the court reached the virtually identical result that it had reached in the first \textit{Allen} litigation.

Once again, the court ruled that it was not necessary to address whether the Civil Rights Law had been violated—that is, whether the photo of Boroff constituted a "portrait or picture" of Allen for the purposes of the statute—because Allen would be entitled under the Lanham Act to the relief that he sought.\textsuperscript{161} Citing the first \textit{Allen} litigation, the court held that the "use of Boroff's photograph in their advertisement creat[ed] a likelihood of consumer confusion over plaintiff's endorsement or involvement,"\textsuperscript{162} and it therefore granted Allen summary judgment on his claim under 15 U.S.C. § 1125(a). While denying Allen's claim for damages, the court granted Allen the same injunctive relief as it had in the earlier \textit{Allen} litigation.\textsuperscript{163}

The \textit{Allen} and \textit{Onassis} decisions are excellent examples of the deficiencies of a strict "name or likeness" approach to right of publicity. Even when confronted with statutes that limit protection to only these two attributes, courts have begun to find ways to extend protection to prevent takings of other attributes of identity.\textsuperscript{164} The state trial court in \textit{Onassis} even found a violation under section 51 the Civil Rights Law, despite the fact that the public figure's name or actual picture had not been used, on the grounds that the "illusion" had been created that she appeared in the advertisement. Decisive to this holding was the \textit{Onassis} court's finding of appropriation of Ms. Onassis's identity.

\textsuperscript{158} Id.
\textsuperscript{159} N.Y. GEN'L BUS. LAW § 368-d (McKinney 1988).
\textsuperscript{160} Allen, 679 F. Supp. at 367.
\textsuperscript{161} Id.
\textsuperscript{162} Id. at 370 (quoting Allen v. National Video, Inc., 610 F. Supp. 612, 628 (S.D.N.Y. 1985)).
\textsuperscript{163} Id. at 372.
\textsuperscript{164} See supra text accompanying note 93.
The court in *Allen* was not willing to go so far or to put such a strained construction on section 51.\(^{165}\) It did however, "hesitate" to deny Allen relief under the Civil Rights Law\(^{166}\) and, as noted, sharply criticized the statute for limiting protection to "portrait or picture." The *Allen* court's solution, although itself not fully satisfactory either, is an original construction of the Federal Lanham Act to sanction impersonation that creates the likelihood of consumer confusion concerning a public figure's endorsement. The problem left by such a "solution" is that the Lanham Act is solely concerned with protecting the consumer from confusion as to the source of a product, while the "right of publicity" is concerned with public figures' rights to control attributes of their identity and their need to protect those attributes from exploitation by others. Making "likelihood of confusion" the standard may leave instances when celebrities will not be able to control the commercial use of their identities. The limited relief granted in *Allen* is a good example. Boroff was not enjoined from appearing as a Woody Allen look-alike in all contexts, even in all advertising contexts, only from appearing without some form of disclaimer or other means so that a reasonable person would not believe that he was actually Allen. Allen found, and may well continue to find, that Boroff continues to exploit attributes of his identity to advertise products. This prospect, in light of the example of "Here's Johnny Portable Toilets," cannot be expected to leave Allen without apprehension.

However, *Allen* and *Onassis* also show that even in the face of strict statutes such as New York's, courts have begun to protect the uncon- sented to use of attributes of a public figure's identity beyond name or likeness, whether under the rubric of "right of publicity" or something else. In general terms, then, these decisions are consistent with the *Carson* and *Midler* cases in their abandonment of the traditional boundaries of name or likeness.

3. *Nurmi v. Peterson*

California has also enacted a statute which creates a civil action for appropriation, specifically appropriation of name, voice, signature, photograph, or likeness.\(^{167}\) Unlike New York's statute, the statutory cause of action does not eliminate the common-law right of publicity action; instead, the statute's remedies are expressly stated to be cumulative.\(^{168}\) *Nurmi v. Peterson*,\(^{169}\) an impersonation case, was partially decided under

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166. *Id.*
167. *CAL. CIV. CODE* § 3344(a) (Deering 1984 and Supp. 1991). For the complete text of this statute, see Addendum I to this Article, *infra* p. 530.
168. See *CAL. CIV. CODE* § 3344(g) (Deering 1984 and Supp. 1991).
this statute, and it reached a different result from *Onassis* and *Allen*. This lawsuit concerned an alleged imitation of a television character created by the plaintiff.

The plaintiff was a 1950s television movie hostess who created and performed a character called “Vampira.” This character wore a distinctive dark dress, horror movie props, and maintained a special vampire-like personality. The plaintiff claimed that the defendants, actress Cassandra Peterson and affiliated marketing, management, and broadcasting firms, contacted her in 1981 to seek to recreate her character for contemporary audiences. Negotiations between the parties to reach an agreement regarding use of the character failed.

The plaintiff further alleged that the defendants then created a character, “Elvira,” based on plaintiff’s “Vampira.” Elvira became a successful character on television and in films, leading to a number of merchandising spin-offs. The plaintiff brought suit in the U.S. District Court for the Central District of California alleging that the defendants violated the California right of publicity statute, the common-law rights of publicity and privacy, and section 43(a) of the Federal Lanham Act.

The court granted the defendants’ motion to dismiss all of the plaintiff’s right to privacy and publicity claims, both statutory and common law. First, the court dismissed the claims under California Civil Code section 3344, which grants a cause of action against anyone who knowingly uses another’s name, voice, signature, photograph, or likeness. The court ruled that the defendants had not appropriated the plaintiff’s “likeness,” the plaintiff did not allege that the Elvira character was created to look exactly like plaintiff’s Vampira. Indeed the plaintiff only argued that Elvira was similar to the props, clothes, and mannerisms of Vampira. The court held that “likeness” was to be construed to mean an “exact replication of [another] person’s features.”

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170. *Id.* at 1776.
171. *Id.*
173. 10 U.S.P.Q.2d at 1776. The court also dismissed the plaintiff’s claims for punitive damages under the Lanham Act, ruling that the Lanham Act does not permit punitive damage. *Id.* at 1778-79.
174. *Id.* at 1777.
175. *Id.* The court stated that this definition of “likeness” was consistent with the *Midler* court’s interpretation of the same statute. *Midler* had ruled that use of a voice imitating the plaintiff’s singing style was not actionable under section 3344 since the plaintiff’s actual voice was not used. *Id.* (citing *Midler* v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988)). As the *Nurmi* court recognized, however, *Midler* did not directly construe the meaning of “likeness” in section 3344, holding that the term did not apply, because “likeness” was limited to visual images and not to voices. *Id.* at n.2.
The court rejected the plaintiff's view that "likeness" is appropriated if the defendants created a character that bore an "approximate resemblance" to the plaintiff's character. This interpretation of likeness would simply foreclose too much expression, as the court explained,

Under the plaintiff's definition, if a person merely were to wear another's clothes or emulate another's mannerisms, an action would lie under section 3344 because a "likeness" was being appropriated. However, such a definition would expand section 3344 to freeze all rights to certain props, clothing, or other qualities surrounding a character with the first person to portray a given part. In effect, all subsequent actors would be subject to legal challenge on the grounds that they had copied elements of characters portrayed by earlier generations of actors. This result would greatly inhibit the development of the entertainment arts and the freedom of expression, a result the court finds cannot have been intended by the California legislature in drafting section 3344.176

The court's dismissal of the plaintiff's common-law right of publicity claim177 was based on a similarly narrow construction of the tort. In sharp contrast to the other recent decisions reviewed, the court decided the right of publicity claim in completely traditional terms: "To maintain a right of publicity claim, a plaintiff must show that his or her name or likeness was appropriated without consent."178 Once again, "likeness" was not appropriated because the defendants did not "copy exactly" the Vampira character. Instead, the court explained,

The defendants are alleged to have created a new character that resembled the Vampira character but which used a different name and employed a different actress in the lead role. The court finds that because these allegations do not amount to the claim that the plaintiff's actual features were used by the defendants for commercial purposes, no common[-]law right of publicity or privacy action can be maintained.179

The court contrasted this case to Midler. In Midler, the court pointed out, the advertiser attempted to defraud the public into thinking that Bette Midler actually performed the song and then endorsed the product. In Nurmi, there was no "fraudulent attempt to deceive the public into believing that the plaintiff[] was actually present."180

The Nurmi decision is notable because it is a rare example of a recent decision applying a strict name or likeness standard. However, the plaintiff in Nurmi was attempting to protect a fictional character from appropriation, rather than her own identity. Although the issue of the

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176. Id. at 1777-78.
177. The court stated that the right of publicity is part of the right of privacy claim. Id. at 1778.
178. Id.
179. Id.
180. Id.
appropriation of a fictional character was never discussed as such by the court, and the court did not expressly base its decision on this distinction, the court's reluctance to find the defendant's "appropriation" actionable seems in large part to be due to this fact. To the extent that "Elvira" is merely a updated "Vampira," this decision warrants criticism because it allowed the defendants to appropriate the work of the plaintiff without compensating her. Nurmi, then, demonstrates that the name or likeness approach, while generally discredited and rarely applied today, has not been completely discarded.

II

Alternative Approaches to Protecting Identity from Misappropriation

A. The Deficiencies of Broad Protection for Identity

This review of developments in the case law shows that the protection offered by the right of publicity generally continues to expand beyond name or likeness. No consensus has yet emerged on the proper boundaries of the doctrine. It is, however, possible to distill the case law into several alternative approaches.

An examination of the developing case law reveals essentially three possible alternative doctrinal approaches for determining what the right of publicity protects. First, the traditional Restatement rule, relied on by the trial courts in Carson and Nurmi and essentially adopted in New York in the Civil Rights Law (though now falling into disfavor), only protects the public figure's "name or likeness" from appropriation. Second is the approach of the Carson court of appeals majority and the Ninth Circuit in Midler, which considerably broadens the protection to cover any appropriation of a person's "identity" without that person's consent. The third alternative is what could be called the middle ground proposed by the dissenting judge in Carson: the protection may extend beyond merely a public figure's name or likeness, but only if a balancing test is satisfied so that the interests of the person seeking protection outweigh society's interests in free expression and free enterprise. This third approach was also essentially adopted by the Allen trial court, in light of the limited nature of the relief granted, albeit in the guise of an application of the Federal Lanham Act.

Determining which, if any, of these three approaches is the proper one to follow in right of privacy cases ultimately depends on which policies one wishes to advance. Clearly the Carson majority correctly identified the basic policy rationale for the existence of a right of publicity in the first place: the desire to give public figures the sole right to commer-
cially exploit their identities. This right, as previously discussed, operates as an incentive and reward for creative achievement and as a way of preventing those who have nothing to do with celebrities' achievements from profiting from them.\textsuperscript{181} Thus, the right of publicity, in essence, is a property right, the property being a celebrity's public image and identity.\textsuperscript{182}

Since it is the celebrity's \textit{identity} that is protected, the developing case law correctly holds that the right of publicity should protect more than a person's name or likeness. Undoubtedly, a celebrity's public identity can be appropriated without using the celebrity's name or picture, and there is no principled basis for ending protection at that point.\textsuperscript{183} Therefore, even though it has the advantages of relative certainty and ease of application,\textsuperscript{184} the \textit{Restatement} rule is unsatisfactory because it remains too narrow. In fact, even the \textit{Restatement} itself recognizes that "[t]he interest protected by the rule . . . is the interest of the individual in the exclusive use of his identity."\textsuperscript{185} Likewise, Professor Prosser commented that "[i]t is the plaintiff's name as a symbol of his identity that is involved [in the right of publicity doctrine], and not as a mere name."\textsuperscript{186} While citing it as the established approach, he also expressed some doubts about the "name and likeness" rule. In a footnote to his famous treatise, he stated that "it is not impossible that, in the absence of a limiting statute, there might be invasion of privacy by appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness."\textsuperscript{187} The experience of New York courts in applying a statute virtually identical to the \textit{Restatement} rule conclusively demon-

\textsuperscript{181} The United States Supreme Court has commented that right of publicity protection "provides an economic incentive for [the person protected] to make the investment required to produce a performance of interest to the public." \textit{Zacchini v. Scripps-Howard Brdcst. Co.}, 433 U.S. 562, 576 (1977). In the words of the Wisconsin Supreme Court, "It is a form of commercial immorality to 'reap where another has sown.'" \textit{Hirsch v. S.L. Johnson & Son, Inc.}, 90 Wis. 2d 379, 392, 280 N.W.2d 129, 135 (1979) (quoting Mercury Record Prods., Inc. v. Economic Consultants, Inc., 64 Wis. 2d 163, 176, 218 N.W.2d 705, 711 (1974)).

\textsuperscript{182} The right of publicity confers "something analogous to a property right upon the individual." \textit{Restatement}, \textit{supra} note 2, § 652A comment b. Courts have also held the right of publicity to be a property right. \textit{See Note, supra} note 7, at 527 (citing \textit{Price v. Hal Roach Studios, Inc.}, 400 F. Supp. 836 (S.D.N.Y. 1975)); \textit{Cepeda v. Swift & Co.}, 415 F.2d 1205, 1206 (8th Cir. 1969).

\textsuperscript{183} For example, a radio commercial narrated by a person with a voice that sounds like a celebrity with a distinctive voice would seem to appropriate the celebrity's identity without using his name or likeness. \textit{See supra} text accompanying note 79.

\textsuperscript{184} However, as the \textit{Nurmi} case demonstrated, there could be problems in determining what constitutes a "likeness" even under the \textit{Restatement} rule.

\textsuperscript{185} \textit{Restatement}, \textit{supra} note 2, § 652C comment a (emphasis added).

\textsuperscript{186} \textit{W. Prosser & P. Keeton, supra} note 2, § 117.

\textsuperscript{187} \textit{Id.} § 117 at 851 n.20; \textit{see also W. Prosser, supra} note 2.
strates that courts, as Prosser expected, have come to recognize the deficiencies of the "name or likeness" approach.

The right of publicity also operates to protect more than just the celebrity's interest in protecting the use of the celebrity's identity. It also helps prevent public confusion resulting from advertising. This second objective, in fact, formed the basis of the court's holding in Allen. Under a broad Carson-type protection, only with the celebrity's consent may an advertiser use a celebrity to promote a product. Therefore, whenever a potential consumer sees a celebrity used to advertise a product, the consumer knows that the celebrity consented, presumably implying that the celebrity endorses the product's quality. Thus, the right of publicity actually serves two important objectives: protecting the celebrity's identity from misappropriation and protecting the public from deceptive advertising that falsely implies a celebrity's endorsement.

Important reasons exist, however, for one to be cautious about advocating an overly expansive protection for "identity" under the right of publicity rubric. First, the argument that the recognition of the right of publicity offers an "incentive for achievement" may not always be well founded. A public figure may not have achieved anything to become famous or may have become well known through bad deeds. A good example of the latter is an infamous criminal, such as John Dillinger in the 1930s or John Hinckley in 1981. These people should not be able to file suit against the use of their identity in an advertising campaign (for example, to advertise burglar alarms) and to claim that control of their public identities is their reward for "achieving" criminal fame, unless one wishes to encourage criminal behavior. Furthermore, some particular attribute of a public figure's identity may not have been created or in any sense achieved by that person. The dissenting judge in Carson found this a persuasive reason for criticizing the majority's protection of the phrase "Here's Johnny"; she believed that Carson neither created nor performed the phrase. For these reasons, protecting all aspects of a public figure's identity cannot always be justified.

There are other considerations that militate against too broad of a definition of what is protected by the right of publicity. The Carson majority claimed using a celebrity's identity to promote a product without his or her consent allows the advertiser to profit by exploiting another's achievements with which the advertiser had nothing to do, and is thus a form of "unjust enrichment." Similar reasoning followed to protect other attributes of identity from appropriation in each of the

189. See supra text accompanying notes 21-35.
190. Carson, 698 F.2d at 833.
other decisions reviewed, with the exception of *Nurmi*. However, when not merely using a celebrity's name or picture but instead something associated with his identity, the advertiser may have worked very hard, and with much creativity, to use that characteristic to promote the product. One person's unjust enrichment is another's clever advertising campaign. The law, through the right of publicity doctrine, should not necessarily in every case penalize one who creates the advertisement by using a characteristic associated with a celebrity. The advertiser in fact may be more creative than the celebrity.

Another problem with a broad *Carson* majority-type approach is that, while it appears simple on its face, it may not be easy to apply. Determining whether a particular characteristic is part of a public figure's identity often may be difficult. Indeed in *Carson*, the four federal judges considering this issue split two to two.191

One final consideration implicated by the *Carson* decision, a consideration that some might argue made the right to publicity protection inapt in the particular circumstances of the *Carson* case, but which the dissent did not address, was that Carson did not seek relief merely because the defendant made a profit from using his identity. Rather, the real reason that he filed suit was undoubtedly because he was embarrassed by the use of "Here's Johnny" to advertise a portable toilet. Needless to say, one does not maintain an esteemed public image by advertising a toilet. If this is correct, if Carson really sued due to embarrassment, the basic justification for the right of publicity—to protect celebrities' financial interests in the exploitation of their identities—was not served by the doctrine's application in this case. Other invasion of privacy interests may have been implicated, however.192

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191. A good example of this difficulty is the once popular television commercial of the mid-1980s for a chain of hamburger restaurants that featured the phrase "Where's the beef?" The actress who uttered those words in the commercial might claim, in a manner similar to Johnny Carson, that the phrase became part of her public identity through the wide exposure of the commercial; and thus, she had the exclusive right to further commercially exploit that phrase. Whether "Where's the beef?" was really part of her "identity" (rather than a creation of the advertising copywriters) would plainly be quite difficult for a court to determine.

192. If this interpretation of Carson's motives for filing suit is correct, invasion of privacy rather than right of publicity was the more appropriate rubric in which the court should have considered Carson's claim. In claims not founded on an invasion of the right of publicity, "essentially the injury is a mental one in terms of embarrassment, humiliation, and hurt feelings." Note, *supra* note 7, at 533. However, with respect to the right of publicity,

When a celebrity's name or picture is appropriated for use in advertising or for purposes of trade, an entirely different injury is inflicted . . . [I]t is ludicrous to suggest that the vast majority of entertainers, for example, experience embarrassment or humiliation when their names or images are publicized. Rather, in most cases publicity is desired inasmuch as a celebrity's income may be directly proportionate to his or her degree of fame.
Right of publicity cases often present a choice between protecting the rights of advertisers or the rights of celebrities. Underlying the right of publicity doctrine, as the recent case law demonstrates, is essentially the protection of one particular status group—celebrities. Only those persons with a publicly known identity can have their identity used in a way that is commercially beneficial to others. The Carson majority implicitly admits this basic function of the doctrine when they state, "the right to publicity has developed to protect the commercial interest of celebrities in their identities." Although the Carson majority would probably disagree, courts should not always choose to protect the celebrity by applying the right of publicity doctrine when an advertiser uses something associated with the celebrity’s identity.

These considerations lead to the conclusion that the Carson majority’s rule, that the right of publicity protects against any commercial appropriation of any aspect of a celebrity’s identity, is too broad. In some circumstances, an aspect of the celebrity’s identity may not warrant protection. The fundamental problem with an overly broad right of publicity doctrine, as Judge Kennedy in dissent in Carson correctly pointed out, is that the "extension of the right of publicity to include phrases or other things [that] are merely associated with the individual permits a popular entertainer or public figure, by associating himself or herself with a common phrase, to remove those words from the public domain." Right of publicity protection, unlike the statutory monopolies of copyright and trademark, creates a monopoly unlimited in duration and unregulated by statute. Our society encourages free expression, both for its own sake and also to assist free competition in the marketplace. By removing the protected items from the public domain, the extension of the right of publicity protection beyond a celebrity’s name or picture contradicts these basic societal values. Determining the proper scope of the right of publicity doctrine, then, presents the familiar situation in tort law of the interest of the individual conflicting with the interests of society at large.

Id. However, unless it alters the measure of damages, there is little practical difference between the categories of the actions.

193. Carson, 698 F.2d at 835 (emphasis added).
194. See supra text accompanying notes 21-35.
195. Carson, 698 F.2d at 837.
197. The interests of the public figure and of society do not conflict in all respects under the right of publicity doctrine, however. Since creative and artistic achievements enrich society, to
B. The Proper Scope of the Protection of Identity

A review of the recent development and growth of the right of publicity doctrine leads to a somewhat contradictory conclusion. While the doctrine now quite properly extends beyond its original formulation of protecting merely name or likeness, its continued growth also has the dangerous potential to swallow large amounts of commercial expression and grant windfall protection to public figures of attributes that are not clearly parts of the celebrity’s identity. Plainly, “name or likeness” is an insufficient definition of what should be protected by right of publicity. On the other hand, an overly simplistic Carson-type protection for any “attribute” of “identity” sweeps too broadly. A new and more carefully crafted formulation of the doctrine is needed, if for no other reason than that this doctrine will otherwise likely continue to spawn extensive litigation with often inconsistent results.

The basic approach to determining what should properly be protected by the right of publicity is best accomplished in the context of a case-by-case balancing of factors, similar to the approach advocated by the dissenting judge in Carson. That is, public figures’ interests in control over the commercial exploitation of their identities should be balanced against the public interest in free expression and avoidance of monopolies. While such a balancing test always brings into question the criticism of uncertainty in application, in this context it is more responsive to the conflicting fundamental interests implicated by the right of publicity.

The following criteria ought to be examined in such an analysis. First, one should examine whether the attribute at issue truly identifies the celebrity. That is, the first inquiry should be as follows: Would an average citizen exposed to the attributes or characteristics at issue believe that the public figure was present? Second, whether the public figure was responsible for the creation of the attribute at issue should be considered. The less the public figure had to do with the creation of the identifying characteristic, or the less it actually protects the public figure, the less worthy it is of protection. Third, whether the attribute itself is deserving of protection should be determined by considering whether the attribute is a product of creative effort and achievement or is merely a result of a fortuity or of a “negative” achievement.

Fourth, on the other side of the scale, the creative content of the use of identity and the likelihood of causing public confusion regarding a celebrity’s endorsement should be scrutinized. Thus, a highly creative and artistic visual impersonation of a celebrity should be viewed much the extent that the right of publicity actually has the effect of encouraging such achievements, the doctrine serves societal as well as individual interests.
more favorably than a simple appropriation of name or likeness. Disclaimers similar to those ordered by the court in *Allen* should also be used to reduce the risk of consumer confusion. Likewise, whether the advertiser’s intent was to confuse the public into believing in the presence of the celebrity is relevant.

III

Conclusion

Recent developments in the case law demonstrate, if nothing else, the difficulty of formulating a proper doctrinal approach to define exactly what is protected by the right of publicity. This difficulty occurs because the right of publicity implicates two important and often conflicting policies: the interest of public figures in the commercial exploitation of their identities and society's interest in free expression and the avoidance of monopolies. The traditional *Restatement* rule is too narrow because the identifying characteristics of a public figure may encompass more than name or likeness. On the other hand, the “identity” rule of *Carson* and *Midler*, that any unauthorized use of anything associated with a public figure’s identity is actionable, appears excessively broad. It may protect characteristics not really deserving of protection, while ignoring free expression interests. Because it is responsive to both basic policies, an approach that balances the interest in the exclusive use of their identities against the public interest in free creative expression is the best method of determining whether right of publicity protection is warranted.
Addendum I to Bloom Article


(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in the amount equal to the greater of seven hundred fifty dollars ($750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use and the person who violated this section is required to provide his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney's fees and costs.

(b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person such that the person is readily identifiable.

(1) A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.

(2) If the photograph includes more than one person so identifiable, then the person or persons complaining of the use shall be represented as individuals rather than solely as members of a definable group represented in the photograph. A definable group includes, but is not limited to, the following examples: a crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.

(3) A person or persons shall be considered to be represented as members of a definable group if they are represented in the photograph solely as a result of being present at the time the photograph was taken and have not been singled out as individuals in any manner.

(c) Where a photograph or likeness of an employee of the person using the photograph or likeness appearing in the advertisement or other publication prepared by or in behalf of the user is only incidental, and not essential, to the purpose of the publication in which it appears, there shall arise a rebuttable presumption affecting the burden of producing evidence that the failure to obtain the consent of the employee was not a knowing use of the employee's photograph or likeness.

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or
sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(e) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a use for which consent is required under subdivision (a) solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

(f) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that such owners or employees had knowledge of the unauthorized use of the person's name, voice, signature, photograph, or likeness as prohibited by this section.

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.
Addendum II to Bloom Article


[§ 50] 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, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

[§ 51] Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person's name, portrait or picture in such manner as is forbidden or declared to be unlawful by section fifty of this article, the jury, in its discretion, may award exemplary damages. But nothing contained in this article shall be so construed as to prevent any person, firm or corporation from selling or otherwise transferring any material containing such name, portrait or picture in whatever medium to any user of such name, portrait or picture, or to any third party for sale or transfer directly or indirectly to such a user, for use in a manner lawful under this article, nothing contained in this article shall be so construed as to prevent any person, firm or corporation from using the name, portrait or picture of any manufacturer or dealer in connection with the goods, wares and merchandise manufactured, produced or dealt in by him which he has sold or disposed of with such name, portrait or picture of any author, composer or artist in connection with his literary, musical or artistic productions which he has sold or disposed of with such name, portrait or picture used in connection therewith.

These statutory provisions were enacted in 1903 after the New York Court of Appeals ruled that New York did not recognize an action for the misappropriation of name or likeness. Robertson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442 (1902). The Robertson court held that recognizing such an action would lead to "a vast amount of litigation" and that only the legislature could create such a doctrine. Id. at 545, 64 N.E. at 443.