

**Integrating the Right of Publicity with First Amendment
and Copyright Preemption Analysis**

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Abstract. The right of publicity has been a feature of U.S. law for several decades, and yet the answers to many fundamental questions concerning the relationship of publicity rights to federal law—including the First Amendment and federal copyright law—can differ radically from one state or circuit to another. In this Article, we argue that conformity to the Supreme Court’s First Amendment jurisprudence (including, but not limited to, *Zacchini v. Scripps-Howard Broadcasting Co.*) and to its standards for assessing federal preemption of state intellectual property rights requires greater scrutiny of the asserted state interests that would support a particular exercise of state publicity rights. In cases involving purely commercial speech, states legitimately may assert a broad range of interests—including all of the various interests that traditionally have been proposed as justifications for publicity rights—as reasons for tolerating the interference with defendants’ (or others’) exercise of free speech and copyright rights. By contrast, only a relatively small number of state interests can overcome a First Amendment or copyright preemption challenge with respect to noncommercial speech. These include the interests in preventing deceptive marketing, and in vindicating personal privacy and autonomy; apropos of this last (autonomy) interest, we contend that only the state’s interest in remedying the nonconsensual appropriation of another’s services as performer, model, or spokesperson can suffice as a legitimate interest in the face of a First Amendment or copyright challenge. We conclude by proposing an integrated three-step framework for evaluating when state publicity rights overstep their proper boundaries, focusing on (1) whether the plaintiff should be deemed to have withheld consent from the type of use at issue; (2) whether the use involves the plaintiff’s “indicia of identity” and is “for purposes of trade,” as those terms are used in the Restatement (Third) of Unfair Competition; and (3) whether the asserted state interest outweighs the defendant’s interest in free speech, taking into account (as indicated above) the status of the use as either commercial or noncommercial speech. Only if the answer to all three questions is affirmative does the plaintiff’s claim survive.

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I. Introduction

Laws granting individuals what is commonly referred to as a “right of publicity”—the right to prevent the unauthorized use of their names, likenesses, and sometimes other indicia of identity for commercial or other purposes—originated in this country over a century ago, and are now in place (either by statute or common law) in well over half of the states. It is, therefore, surprising that the answers to fundamental questions concerning the relationship of publicity rights to federal law—including the First Amendment and federal copyright law—can vary so much from one state or circuit to another. Consider, for example, the following fact patterns based on real-world disputes, in which judicial and scholarly opinion over the viability of publicity claims is all over the map:

- The author of a motion picture, sound recording, or photograph captures a person’s performance or image, with her consent, in a copyrightable work. The performer thereafter claims that a particular exploitation of the video, recording, or photo, to which the performer has not expressly consented, infringes the performer’s right of publicity. Does copyright law preempt the performer’s assertion of publicity rights because those rights would interfere with the exercise of copyright rights in the work? Although many decisions appear to answer this question affirmatively, others—including recent cases involving claims by Jackson Browne against the Republican National Committee, based upon the latter’s use of Browne’s recording of the song *Running on Empty* in a John McCain campaign commercial,¹ and another involving a claim by the late Godfather of Soul James Brown against a firm that owned the copyright to certain photographs of Brown, arising from the firm’s display of copies of those photographs on its website for the purpose of advertising its willingness to license its copyrights to third parties²—have permitted such claims to go forward.
- An artist depicts a real person’s image, without that person’s consent, on a shirt, doll, or poster, or in a video game or comic book or other merchandise. Does the First Amendment—or copyright law, insofar as it protects pictorial, graphic, and sculptural works—prevent the unwilling subject from successfully asserting a publicity claim against the artist’s marketing of the merchandise? Courts addressing claims of this type (involving performers as varied as the Three Stooges,³ Tiger Woods,⁴ and “Lady Kier” Kirby⁵) have

¹ *Browne v. McCain*, No. CV 08-05334-RGK (Ex), 2009 WL 483212, at *5-8 (C.D. Cal. Feb. 20, 2009) (denying defendant’s motion to strike Browne’s right of publicity claim, on the ground that Browne had demonstrated a possibility of success).

² *See Brown v. ACMI Pop Div.*, 873 N.E. 2d 954, 959-64 (Ill. App.), *appeal denied*, 879 N.E.2d 929 (Ill. 2007).

³ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

reached differing outcomes. In a recent variation on this theme, several commentators argued that Ty Inc.’s marketing of “Sweet Sasha” and “Marvelous Malia” dolls that evoked the image of President Obama’s daughters⁶ likely violated the children’s right of publicity.⁷

- A company stages a show that includes an actor’s imitation of a famous performer’s actual performance, as it once might have occurred, complete with the performance of copyrighted songs (with consent of the relevant copyright owners). Once again, the question arises whether the First Amendment, or copyright law, permits the owner of the original performer’s publicity rights to enjoin the staging of what might appear to be a copyrightable (dramatic) work. To date, courts have shut down unauthorized Elvis impersonators and Beatles tribute bands⁸; another court, however, permitted a play based on the life of Janis Joplin, including one act that replicated a Joplin concert, to proceed.⁹
- An actor known for his depiction of a fictional character (copyright to which character is owned by another entity) claims that the continued use of the character or its adaptation into another medium requires the consent of the actor. The court in *Wendt v. Host International, Inc.*¹⁰ permitted such a

⁴ ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915 (6th Cir. 2003).

⁵ See Kirby v. Sega of Am., Inc., 50 Cal. Rptr. 3d 607 (Ct. App. 2006).

⁶ See *Ty Denies Obama Girls Inspired Sweet Sasha, Marvelous Malia*, CNN (Jan. 23, 2009), available at <http://www.cnn.com/2009/LIVING/01/22/obama.dolls/>. Ty later renamed the dolls “Mariah” and “Sydney.” See Stephen M. Silverman, *Toy Company Renames Malia, Sasha Dolls*, PEOPLE (Feb. 9, 2009), available at <http://www.people.com/people/article/0,,20256763,00.html?xid=rss-fullcontentcnn>.

⁷ See, e.g., Mark Goldstein, *Sasha and Malia Dolls: Legal Remedies for the Obamas*, available at <http://www.patentlyo.com/patent/2009/01/sasha-and-malia-dolls-legal-remedies-for-the-obamas.html> (Jan. 24, 2009) (arguing that the Obamas would prevail under California law); Ryan Pasquale, *Obama Dolls Pose Presidential IP Pickle*, available at <http://www.managingip.com/Article/2091074/Obama-dolls-pose-presidential-IP-pickle.html> (Jan. 29, 2009) (quoting Fross Zelnick partner David Donahue as stating that the “First Amendment concerns are limited at best”).

⁸ See *Apple Corps Ltd. v. A.D.P.R., Inc.* 843 F. Supp. 342, 347 (M.D. Tenn. 1992); *Apple Corps Ltd. v. Leber*, 229 U.S.P.Q. 1015, 1016-17 (Cal. Super. Ct. 1986); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1356 (D.N.J. 1981).

⁹ See *Joplin Enters. v. Allen*, 795 F. Supp. 349, 350-51 (W.D. Wash. 1992).

¹⁰ 125 F.3d 806, 810-12 (9th Cir. 1997) (holding that the actors who portrayed Norm and Cliff on “Cheers” tv show stated a claim for violation of their rights of publicity against a defendant that had obtained permission from the owner of copyright in “Cheers” to establish “Cheers” bars that included animatronic robots resembling the Norm and Cliff characters); see also *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1285-89 (9th Cir. 1999) (Kozinski, J., dissenting from denial of rehearing en banc) (arguing that copyright and First Amendment law preempted the claims).

claim to go forward; the court in *Stanford v. Caesar's Entertainment, Inc.*,¹¹ by contrast, did not.

- Professional athletes object to the use of their names and (uncopyrightable) performance statistics in a fantasy sports game marketed by the defendant. In one recent case, the Eighth Circuit (without reaching the copyright preemption issue) concluded that the defendant's interest in freedom of speech outweighed the state interest in according publicity rights to the objecting athletes.¹² At least two other cases, however, have permitted similar claims to proceed.¹³
- In one of the more sensational right of publicity cases in recent memory, *Hustler Magazine* published nude photographs of Nancy Toffoloni Benoit, a former model and professional wrestler, who was murdered by her husband, wrestler Christopher Benoit, in 2007.¹⁴ Ms. Benoit had posed for the photos (which she allegedly believed had been destroyed) approximately twenty years earlier.¹⁵ The district court concluded that the publication was lawful under a "newsworthiness" exception to Georgia's common law right of publicity, but the Court of Appeals, citing among other things the decedent's interest in privacy, reversed.¹⁶ *Toffoloni* is one of many cases that involve the question of whether models and actors can assert right of publicity claims that interfere with the publication of sexually explicit, but nevertheless copyrightable and possibly nonobscene, works in which they appear.¹⁷

¹¹ 430 F. Supp. 2d 749, 754-59 (W.D. Tenn. 2006) (holding that copyright law preempted a performer's claim against a defendant for continuing to use a fictional character that the performer had agreed to portray for defendant's advertising campaign); *see also* *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000) (holding that copyright did not preempt a performer's claim arising from the marketing of an action figure toy, that was licensed by the copyright owner of the film in which the performer acted and based upon the performer's role in the picture; but that the claim failed due to a lack of resemblance between the performer and the toy).

¹² *See C.B.C. Distr. & Mktg., Inc. v. Major League Baseball Adv. Media, L.P.*, 505 F.3d 818, 823-24 (8th Cir. 2007), *cert. denied*, 128 S. Ct. 2872 (2008); *see also* *CBS Interactive Inc. v. Nat'l Football Players Ass'n*, Civil No. 08-5097 ADM/SRN, 2009 WL 1151982, at *21 (D. Minn. Apr. 28, 2009) (in a case involving a fantasy football game, following *C.B.C.*); Jenna Ross, *Yahoo! Sues for Fantasy Football Info*, MINNEAPOLIS STAR-TRIBUNE (June 3, 2009) (discussing similar lawsuit filed by Yahoo).

¹³ *See Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1278-83 (D. Minn. 1970); *Palmer v. Schonhorn Enters.*, 232 A.2d 458, 459-62 (N.J. Super. 1967); *see also* *Gridiron.com, Inc. v. National Football League Player's Ass'n, Inc.*, 106 F. Supp. 2d 1309 (S.D. Fla. 2000) (enjoining unauthorized use of players' images in connection with fantasy football game).

¹⁴ *See Toffoloni v. LFP Publ. Group, LLC*, ___ F.3d ___, 2009 WL 1793180 (11th Cir. 2009). Christopher also killed the couple's child and, then, himself. *See id.* at *1.

¹⁵ *See id.*

¹⁶ *See id.* at *4-6.

¹⁷ *See* cases cited *infra* notes ____.

In this Article, we argue that the correct—and predictable--resolution of cases such as these should not be as difficult as it currently appears to be. Although we are skeptical of some of the rationales put forward from time to time in support of an expansive right of publicity,¹⁸ we recognize that the right is probably here to stay, in one form or another; indeed, in one case (*Zacchini v. Scripps-Howard Broadcasting Co.*¹⁹) the right has received the blessing of the U.S. Supreme Court. Where courts have sometimes faltered, however, is in recognizing the limits imposed both by the Supreme Court's First Amendment jurisprudence (into which *Zacchini* can be fitted without too much difficulty) and by its standards for assessing federal preemption of state intellectual property rights. Both bodies of law, we argue, recognize that only *some* state interests will suffice to overcome a First Amendment or preemption challenge to the exercise of publicity rights. We argue below that, in cases involving purely commercial speech, as that term is used in First Amendment case law, states legitimately may assert a broad range of interests--including all of the various interests that traditionally have been proposed as justifications for publicity rights—as reasons for tolerating the interference with defendants' (or others') exercise of free speech and copyright rights. In our view, however, only a relatively small number of state interests can overcome a First Amendment or copyright preemption challenge with respect to noncommercial speech. These include the interests in preventing deceptive marketing (coextensive with protections afforded under the Lanham Act); in vindicating personal privacy; and in protecting the plaintiff's interest in autonomous self-definition from being compromised by the defendant's nonconsensual appropriation of his or her actual services as a performer, model, or spokesperson/attention-grabber.²⁰ Importantly, this focus on the relevant state interests can serve to reconcile the outcomes (though not necessarily the reasoning) of many (though not all) of the leading cases, including *Zacchini*; it also demonstrates, in our view, that the relevant First Amendment and copyright preemption analyses are largely congruent. As a result, we are able to propose a practical three-step framework, that integrates both our First Amendment and copyright preemption analysis, for evaluating when state publicity rights overstep their proper boundaries.²¹ Although

¹⁸ See *infra* notes __ and accompanying text.

¹⁹ 433 U.S. 562, 573 (1977).

²⁰ We use the terms “spokesperson” and “attention-grabber” synonymously herein. Note that it shouldn't be sufficient for the plaintiff merely to *allege* the existence of such an interest; the interest must be both substantial and substantiated. The state interest in vindicating personal privacy and autonomy interests, for example, usually would cease upon the performer's death; and in any event it might not be sufficiently weighty to prevent a mere *imitation*, as opposed to (as in *Zacchini*) a reproduction of the plaintiff's *actual*, performance. See *infra* notes __ and accompanying text..

²¹ As discussed herein, many of our critiques of the right of publicity, from both the First Amendment and copyright perspectives, are shared by other scholars. To our knowledge, however, no one previously has integrated these two bodies of law into a cohesive framework in the manner that we propose. Our proposal would enable courts note only to reach the correct outcomes but to do so, with relative ease, at an early stage of litigation.

the application of our framework may involve close questions in some instances, we think that the vast majority of improper cases can be readily resolved on preliminary motions. This will have the added benefit of minimizing potential chilling effects due to defendants' inability to finance a costly war of attrition against plaintiffs who (often) hail from the entertainment and sports elite.

Part II provides an overview of publicity rights and their potential conflicts with the First Amendment and with copyright law. Part III presents our proposed First Amendment analysis; Part IV, our copyright preemption analysis; and Part V an integrated, three-step approach to resolving the tensions among these bodies of law. Part VI presents our analysis of the illustrative examples presented in the introductory paragraphs above. Part VII concludes.