

The Expanding Right Of Publicity

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On January 12, 2006 the European Union's highest court dismissed a legal bid by the heirs of Pablo Picasso to prevent DaimlerChrysler from using the trademark "Picaro" which, the Estate argued, was too similar to the name "Picasso." Although the decision itself is not remarkable, what is remarkable is the universal acceptance of the Picasso Estate's position that a celebrity's name and persona can be protected by trademark laws. More and more, a celebrity's rights in his or her name, likeness and/or persona are being protected under both trademark law and the so-called "right of publicity."

Two years ago, the Sixth Circuit Court of Appeals denied Tiger Woods' attempt to secure blanket protection to his image and likeness as a trademark. Nonetheless, at almost the same time, the same Court did recognize that civil rights leader Rosa Parks did have trademark rights in her name. As demonstrated below, the history of these rights has progressed from no real existence 50 years ago to a recognizable set of intangible property rights today, and the protection in a celebrity's name and persona continues to narrow.

A. Early History – Rejection Of The Right Of Publicity

Famous individuals have not long had or even long laid claim to a property right in their identities. In 1899, the widow of Colonel John Atkinson, described as a "well-known lawyer and politician," sued to prevent the marketing of a "John Atkinson Cigar," bearing her late husband's likeness on its label. The Michigan Supreme Court, which disapproved of the defendant's conduct, declined to recognize an enforceable right. In another well known case, the Fifth Circuit Court of Appeals dismissed the case of a well-known plaintiff, David O'Brien, a professional football player, whose photograph was being utilized to endorse the sale of beer. Even though O'Brien was morally opposed to alcohol, the Court determined that he had valid cause of action.

B. The Haelan Case – Creating A Recognizable Right

Although the history of the right of publicity starts predominantly in the second half of the twentieth century, there is one anomaly. Specifically, the New Jersey Chancery Court issued perhaps the earliest decision on this issue. The Court enjoined the unauthorized use of Thomas Edison's name and picture on a medicine and explained "If a man's name be his own property, as no less an authority than the United States Supreme Court says it is[,] it is difficult to understand why the peculiar cast of one's features is not also one's property, and why its pecuniary value, if it has one, does not belong to its owner, rather than to the person seeking to make an unauthorized use of it."

The New Jersey Court clearly viewed Edison's persona as having tangible value, thereby making it a commodity which Edi-



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son owned and could exploit (or refrain from exploiting) as he deemed fit. As such, the unauthorized use of Edison's persona injured him by depriving him of the opportunity to market the commodity himself.

Yet, it was not until almost 50 years after the *Edison* decision that the Second Circuit rendered its decision in *Haelan Laboratories Inc. v. Topps Chewing Gum Inc.*, when the term "publicity rights" actually was coined.

In *Haelan*, a famous baseball player signed an exclusive baseball card contract with one company (*Haelan*) and then a rival company (*Topps*) printed cards with pictures of the same player. Thus, the true issue before the Court was whether *Haelan*, as the assignee, could bring a claim against *Topps*. The Court decided the issue in the affirmative, and in the process coined the term "right of publicity." However, beyond recognizing a right of publicity for an individual, what *Haelan* really did was create an alienable property right – a right that could be transferred by, at the least, an assignment.

C. Evolution From A Right To A Property

Throughout the 1950's and 1960's the courts were reluctant to allow the right of publicity to develop into a full fledged property right. For example, in *Miller v. Comm'r* the Second Circuit, which decided *Haelan*, was forced to consider the tax implications of a license by Glenn Miller's widow authorizing a movie production of Glenn Miller's life. The Second Circuit determined that the license was not a transfer of property, and moreover, that it was questionable whether publicity rights were inheritable.

However, as this issue became more pervasive, courts and state legislatures began steering in the opposite direction. One of the first cases to address this issue directly (the *Miller* Court was examining tax treatment for the license) is *Price v. Hal Roach Studios*. In reaching its decision that the right did not terminate at death, the Court reasoned that the right of privacy and the right of publicity are to be treated differently – the right of privacy is neither assignable nor does it survive death. However, the *Price* Court reasoned, because the right of publicity is of a purely commercial nature and was therefore assignable, there was no reason for the right to terminate at death. The *Price* Court concluded its analysis by determining that the right of publicity should, therefore, be treated as a property right. Thereafter, many other Courts wound up reaching the same result,

applying the same reasoning. For example, in *Factors Etc., Inc. v. Pro Arts, Inc.*, the Second Circuit discussed Elvis Presley's right of publicity: "There can be no doubt that Elvis Presley assigned [to the licensee] a valid property right, the exclusive right to print, publish, and distribute [Elvis Presley's] name and likeness ... The identification of this exclusive right belonging to [the licensee] as a transferable property right compels the conclusion that the right survives Presley's death."

With the progression of time, many courts continued to develop these rights and begin to treat the right of publicity as a "property" right as a matter of course.

D. Expansion To Cover Persona

Whereas the right and property had previously been limited to a celebrity's name and/or likeness, the scope of protection began to broaden as public exposure to celebrity continued to expand. Thus, the Supreme Court weighed in on the right of publicity when it recognized another type of publicity right, that of performance value. In *Zacchini v. Scripps-Howard Broadcasting Co.*, the court distinguished a performer's right to the economic value of his performance as a separate right from his identification value. Specifically, the Court held that "The broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purpose of trade or the incidental use of a name or picture by the press, goes to the heart of petitioner's ability to earn a living as an entertainer."

Because most states now protect name, voice, signature, photograph, and likeness, almost all facets of a celebrity, including persona, now come within the ambit of protection. Thus, for instance, in two separate instances, well known singers – Tom Waits and Bette Midler – have been able to protect against so-called "sound-alikes." Likewise, in a relatively famous decision, the Ninth Circuit Court of Appeals held that a robot in a commercial violated the right of publicity of Vanna White. In the *Vanna White* case, the Court found that the robot was "identifiable" as Vanna White – although it clearly was not her likeness – because of its dress, poses and the identifiable "Wheel of Fortune" game-show background. Likewise, in *Wendt v. Host International, Inc.*, the Ninth Circuit determined that the animatronic figures of the characters Norm and Cliff from the television show *Cheers*, could be substantially similar enough to constitute likenesses of the actors that played these roles.

In the *Vanna White* case, the Court created a much more expansive paradigm, suggesting that celebrities would be protected from any use in which the celebrity was identifiable, because "[a] rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth." Thus, "it is not important how the defendant has appropriated the plaintiff's identity, but whether the defendant has done so."

The reasoning of the *Vanna White* case can be found in earlier expansion of the doctrine. For instance, one court protected Johnny Carson's catch phrase "Here's Johnny." Another court protected Guy Lombardo's nickname as "Mr. New Year's Eve," and football star Elroy Hirsch's nickname "Crazylegs." Finally, in one case, a beer company could be held accountable

for appropriating a famous baseball pitcher's identity by stealing his distinctive stance.

Currently, 18 states have statutory rights of publicity and at least thirteen allow for a post mortem right of publicity. The duration of the protection differs substantially among the states that have adopted statutory postmortem protection. For example, Tennessee's statute permits executors, heirs, assigns, or devisees to maintain the exclusive right for a period of ten years after the person's death; after this period, the right extends indefinitely provided the use continues. Oklahoma's statute, however, extends the right for one hundred years after death, whereas California's postmortem protection is for seventy years.

E. Looking Forward – Treating Persona As A Trademark

Clearly, a name of a celebrity can be used as a trademark. Elvis Presley, Marilyn Monroe and John Lennon are all names protected by U.S. trademarks. The real question that now arises is to what extent a "persona" and/or a "likeness" can be treated as a trademark. As stated above, in the *Tiger Woods* case the Court did not allow a claim to protect Tiger Woods' image as a trademark. However, the reasoning of that case and others seem to indicate that while not every likeness of a celebrity can function as a trademark – if in fact a likeness and persona are in use for certain classes of goods or services – trademark protection will follow. Indeed, in one decision, the Trademark Trial and Appeal Board denied registration to the likeness and image of Elvis Presley, when it was not limited to his dress, age, or pose. At the same time, however, one Court did allow a famous basketball player to maintain rights to his former name (i.e. a name no longer in use). And, in the *Picasso* case, the Court evaluated the "meaning" of "connotation" of "Picasso." Commercialization of celebrity personas only recently has invaded our daily lives, and the effect of this invasion has been pervasive, both culturally and legally. As such the protection surrounding such personas has continued to grow amorphously. The exact contours of protection continue to be redefined, and the nature of the property itself continues to expand in certain directions while contracting in others. However, as this commercialization continues to grow, the clear trend is that the property rights associated with these personas will continue expanding as well.

RELEVANT CASES:

ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 922 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003); Atkinson v. John E. Doherty & Co., 80 N.W. 285 (Mich. 1899); O'Brien v. Pabst Sales Co., 124 F.2d 167, 169-170 (5th Cir. 1941); Edison v. Edison Polyform Mfg., 67 A. 392 (N.J. Ch. 1907); Haelan Laboratories Inc. v. Topps Chewing Gum Inc., 202 F.2d 866 (2d Cir. 1953); Miller v. Comm'r, 299 F.2d 706 (2d Cir. 1962); Price v. Hal Roach Studios, 400 F. Supp. 836 (S.D.N.Y. 1975); Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977); Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098-99 (9th Cir. 1992); Midler v. Ford Motor Co., 849 F.2d 460, 463-64 (9th Cir. 1988); White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992); Carson v. Here's Johnny Portable Toilets, 698 F.2d 831, 835-37 (6th Cir. 1983); Lombardo v. Doyle, Dane, & Bernbach, Inc., 396 N.Y.S.2d 661, 664 (App. Div. 1977); Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129, 137-38 (Wis. 1979); Newcombe v. Adolf Coors Co., 157 F.3d 686, 691-94 (9th Cir. 1998); In re Elvis Presley Enters. Inc., 50 U.S.P.Q.2d 1632 (T.T.A.B. 1999); Abdul-Jabbar v. General Motors Corp., 75 F.3d 1391 (9th Cir. 1996).

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