

## **Fictional Characters and the Right of publicity: Policies, History, and Conflict**

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### **I. Introduction to the Right of publicity**

Much discussion has centered on the parameters of the right of publicity as it relates to actors and the fictional character which they portray. The Ninth Circuit has provided the most expansive definition of the right of publicity; however, many critics believe the court's decisions were ill-conceived and only added to the confusion surrounding the right of publicity. This paper addresses the right of publicity and its origin. It then discusses the Federal Copyright Act and the confusion it causes regarding the right of publicity. The next portion goes on to discuss different ways in which the right of publicity could be preempted by the Federal Copyright Act. Part IV addresses possible First Amendment issues which the publicity right could face, and the likelihood of a publicity right claim surviving a First Amendment defense. Finally, Part V suggests theories which could lessen the confusion around the right of publicity and create uniformity across the nation.

### **II. The Right of publicity: History, Policy, and Analysis**

The right of publicity originates in the right of privacy and is broadly described as the "right of individuals, most often celebrities, to protect, control, and profit from his or her name or likeness."<sup>1</sup> The Right of publicity was created in response to the growing inadequacy of privacy law as applied to the quickly increasing commercial and economic value of celebrity status.<sup>2</sup>

William Prosser divided the right of privacy into four separate torts: 1) Intrusion upon the

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<sup>1</sup> Estate of Presley v. Russen, 513 F. Supp. 1339, 1353 (D.N.J. 1981).

<sup>2</sup> F. Colin Kingston, TV Dads, Past and Present (last modified June 9, 1998) <http://www.suite101.com/article.cfm/television/8088>.

plaintiffs seclusion or solitude, or into private affairs; 2) Public disclosure of embarrassing private facts about the plaintiff; 3) Publicity which places the plaintiff in a false light in the public eye; and 4) Appropriations for the defendant's advantage of the plaintiff's name or likeness."<sup>3</sup> In the discussion, Prosser focused on the name and appropriations category, and noted that "extension beyond this realm was entirely possible."<sup>4</sup> To elaborate on the realm to which he was referring, Prosser stated that "[I]t is not impossible that there might be appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy."<sup>5</sup> He went on to say that it was not inconceivable that there might be appropriations of the plaintiffs' identity, as by impersonation, without the use of either his name or likeness, and that this, too, would be an invasion of his right of privacy.<sup>6</sup> Clearly, the right of publicity is the evolution of Prosser's fourth tort of the Right of Privacy.<sup>7</sup> However, similar to the Federal Copyright Law, the right of publicity and its antecedent, Prosser's fourth sub-category, are concerned with the economic interests of the harmed person, as opposed to the interest protected against by privacy law which is the emotional well-being of the harmed party.<sup>8</sup>

Melville Nimmer formally proposed the idea that the foundation for a right of publicity claim does not truly exist within the right of privacy, and it was greatly expounded upon in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>9</sup> Nimmer posited that celebrities' recognizable names and likeness carried a great deal of economic value when used for

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<sup>3</sup> See Restatement (Second) of Torts §§ 652I, 652A-652I cmt. a (1977); William Prosser, Privacy, 48 Cal. L. Rev. 383, 398-401 (1960)

<sup>4</sup> Prosser, supra note 44, at 401 n.155.

<sup>5</sup> Prosser, supra note 44, at 401 n.155.

<sup>6</sup> Id.

<sup>7</sup> H. Lee Hetherington, Direct Commercial Exploitation of Identity: A New Age for the Right of publicity, 17 Colum.-VLA J.L. & Arts 1,4 (1992)

<sup>8</sup> Mark Rosler, The Right of publicity, <http://www.markroesler.com/legal/rights.html> (2009).

<sup>9</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

commercial endeavors because of the celebrity's contribution of time, money and effort to achieve public status.<sup>10</sup> Therefore, granting a right of publicity to these celebrities follows with the labor principle that something of value is entitled to the fruits of its economic gain.<sup>11</sup> Nimmer's theory was articulated in the *Haelan* case when the court concluded a right of publicity was necessary because "many prominent persons, far from having their feelings bruised through public exposure of their likenesses [as in a right of privacy claim], would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."<sup>12</sup>

The Right of publicity is based on the theory that the public's reaction to such indicia of identity creates commercially exploitable opportunities.<sup>13</sup> The right of publicity applies to natural persons, including music groups, but excluding corporations, partnerships, and other forms of business organizations.<sup>14</sup> While the right of publicity applies to all individual, it has most often been utilized by celebrities.<sup>15</sup> Celebrities have relied upon this right in arguing to courts the unfairness of allowing third parties to exploit a celebrity's name, reputation, or accomplishments, despite the fact that she has assumed celebrity status.<sup>16</sup> Although originally employed only to protect a celebrity's name or likeness, the statutory and common law rights of publicity have gradually been expanded to protect anything associated with a celebrity, from slogans to styles of singing.<sup>17</sup>

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<sup>10</sup> Melville B. Nimmer, The Right of publicity, 19 Law & Contemp. Probs. 203, 218-23 (1954)

<sup>11</sup> *Id.*

<sup>12</sup> *Haelan Labs.*, 202 F.2d at 868.

<sup>13</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425, 431 (Cal. 1979)

<sup>14</sup> *Apple Corps. Ltd. v. A.D.P.R. Inc.*, 843 F. Supp. 342, 348 (M.D. Tenn. 1993)

<sup>15</sup> *Luther King, Jr., Center for Social Change v. American Heritage Products, Inc.*, 694 F.2d 674, 683 (11th Cir. 1983).

<sup>16</sup> *McFarland v. Miller*, 14 F.3d 912, 922 (3d Cir. 1994)

<sup>17</sup> See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (concerning protection of style of singing); *White v. Samsung Elecs. Am., Inc. (White I)*, 971 F.2d 1395 (9th Cir. 1992) (concerning protection of image which may have been evoked through advertisement of robot in place of Vanna White); *Carson v. Here's Johnny Portable*

Those in favor of the Right of publicity offer several convincing argument in support of its existence. First, some make the argument that the publicity right prevents those who have not contributed to the publicity value of the celebrity's image from being unjustly enriched.<sup>18</sup> Second, proponents argue that the right creates a powerful incentive for actors to expend time and resources to develop the skills or achievements necessary for public recognition. In addition, artists who achieve celebrity status "deserves" a property right in his identity because of the labor he expended in making himself famous.<sup>19</sup> Finally, the argument is made that the publicity right should be used to fill the void that copyright law fails to distinguish between the personal features and characteristics of the actor in his portrayal of a character and the character itself.<sup>20</sup>

The right of publicity is governed by state law; and therefore, the degree of recognition of the right varies significantly from one state to another.<sup>21</sup> To date, twenty-eight states have recognized the right, either in their case law, by statute or both.<sup>22</sup> Being that there is no Federal statute or definitive perspective with respect to the Right of publicity, state courts lack guidance on the issue are often produce contradictory and confusing results.<sup>23</sup> Because of the lack of uniformity of state courts, the ability to forum-shop, along with the efficient ways to spread information, national advertisers must abide by the laws of the state or circuit with the most expansive view of the right of publicity to avoid lawsuit.<sup>24</sup> By far, the Ninth circuit has the most

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Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (concerning protection of identifiable slogan from Tonight Show); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (concerning protection of celebrity through his association with identifiable car); Lugosi, 603 P.2d at 425 (concerning protection of role associated with celebrity).

<sup>18</sup> Lombardo v. Doyle, Dane & Bernbach, Inc., 396 N.Y.S.2d 661 (App. Div. 1977)

<sup>19</sup> The Right of publicity; A Matter of Privacy, Property, or Public Domain?, 19 Nova L. Rev. 1013 (1995)

<sup>20</sup> Lugosi v. Universal Pictures, 603 P.2d at 425, 441 (Cal. 1979)

<sup>21</sup> Haelan Laboratories, Inc., 202 F.2d at 870.

<sup>22</sup> Roberta Rosenthal Kwall, Fame, 73 Ind. L.J. 1, 42 (1997)

<sup>23</sup> J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 28:01[3], 28-7 to -8 (4th ed. 1999)

<sup>24</sup> See Robinson, supra note 43, at 201-02

liberal interpretation of the right of publicity in the nation.<sup>25</sup> A number of decisions by the Ninth Circuit have expanded the right of publicity to lengths not previously seen.

In the first of the Ninth Circuit's important decisions regarding the publicity right, in *Midler v. Ford Motor Co*<sup>26</sup>, the court ruled that a celebrity's right of publicity included protection against using a voice imitator.<sup>27</sup> Next, in *White v. Samsung Electronics*, the court greatly expanded the scope of the publicity right by implying that any appropriation of a celebrity's identity, regardless of how it occurs, is sufficient for establishing a successful right of publicity claim.<sup>28</sup> In the *White* case, Samsung used a robot version of Vanna White in a series of advertisements. The robot did not have any physical features that indicated that it was supposed to be White, but the robot was wearing a blond wig, white gown, jewels, and was turning letters on a game board similar to that used on the wheel of fortune show.<sup>29</sup> White argued that this advertisement infringed on her statutory and common-law publicity rights.<sup>30</sup> In response, the court held that viewed together, the robot and its accessories leave little doubt about the celebrity the ad is meant to depict.<sup>31</sup> The Ninth Circuit, by focusing on the robot's setting and environment, as well as the robot, expanded and broadened the right of publicity yet again.<sup>32</sup>

Finally, in the Ninth Circuit's most recent and controversial decision regarding the publicity right, in *Wendt v. Host International, Inc.*, the court formally acknowledged an actor's right of publicity, and further held that this right was not preempted by the federal copyright statute.<sup>33</sup> In this case, Paramount, the owner of copyrights to the television show *Cheers*, licensed the series

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<sup>25</sup> *Wendt v. Host International, Inc.* 125 F.3d 806, 806 (9th Cir. 1997),

<sup>26</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988)

<sup>27</sup> 849 F.2d 460 (9th Cir. 1988).

<sup>28</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, (9th Cir. 1992)

<sup>29</sup> *White*, 971 F.2d at 1396

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993)

<sup>33</sup> *Wendt v. Host Int'l, Inc.*, No. 93-56318, 93-56510, 1995 WL 115571, at \*1 (9th Cir. Mar. 16, 1995).

and its characters to Host International Inc. Host wanted to construct a chain of Cheers-themed bars. As part of the bars, Host placed two robotic figures of that were meant to resemble “Norm” (portrayed by George Wendt) and “Cliff” (portrayed by John Ratzenberger).<sup>34</sup> Wendt and Ratzenberger brought suit to enjoin the use of their robots, stating that Host was encroaching on their publicity rights.<sup>35</sup> The Ninth Circuit reversed a lower court’s grant of summary judgment and supported the position that actors may claim a violation of the right of publicity if the misappropriation identifies the actor or is “sufficiently like” the actor.<sup>36</sup> Further, the court held that the federal copyright statute did not preempt the actor from bringing the state claim of right of publicity.<sup>37</sup> By holding this, the court implied that Paramount did not have a copyright in the show’s character independent of their on screen depiction.

Other jurisdictions have expanded the publicity rights of actors in ways similar to the Ninth Circuit. In *Cheatham v. Paisano Publications, Inc.* the judge allowed an assertion of an individual’s right of privacy action based on an appropriation of the likeness of the Plaintiff’s derriere photographed and subsequently published in a magazine and on shirts.<sup>38</sup> In so ruling, the court cited *Waits v. Frito-Lay, Inc.*, which awarded damages to recognized recording artist, Tom Waits, for a violation of California’s voice misappropriation statute because Frito-Lay utilized a vocalist in an advertisement that sounded like Waits without his consent.<sup>39</sup> The jury award of \$200,000 compensated for injury to Waits’ peace, happiness and feelings to stand in a case primarily involving unauthorized commercial exploitation of a celebrity’s vocal identity.<sup>40</sup> In citing the Ninth Circuit, however, the Kentucky court’s decision marks the confusion arising

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<sup>34</sup> *Wendt v. Host Int’l, Inc. (Wendt II)*, 125 F.3d 806 (9th Cir. 1997)

<sup>35</sup> *Id.*

<sup>36</sup> *Wendt*, 1995 WL 115571, at \*1-\*2.

<sup>37</sup> *Paramount Pictures Corp. v. Wendt*, 531 U.S. 811 (2000) (mem.).

<sup>38</sup> 891 F. Supp. 381, 387 (W.D. Ky. 1995)

<sup>39</sup> *Cheatham*, 891 F. Supp. at 387 (citing *Waits*, 978 F.2d at 1098, 1101-06).

<sup>40</sup> *Waits*, 978 F.2d at 1111-12.

from a lack of a definitive perspective dating back to *Haelan* by holding that the plaintiff would have a cause of action only if the distinctive fishnet design of her jeans was recognized by friends and customers.<sup>41</sup>

### **III. Copyright Protection for Fictional Characters**

While the actors playing fictional characters rely on their publicity rights to control the future use of the characters they play, the studio often relies on the federal copyright statute to control the same fictional character. Often studios claim a copyright interest in both the film in which the character is featured, and, although less commonly recognized, in the character itself.<sup>42</sup> Often the author(s) originally own the movie or television show for copyright purposes.<sup>43</sup> The copyright may be easily transferred to any third party, including the studio, producers, or other parties to which the author chooses to transfer the rights.<sup>44</sup> On the other hand, the right of publicity is generally considered to consist of two types of rights: the right to publicity, or to keep one's image and likeness from being commercially exploited without permission or contractual compensation.<sup>45</sup> Therefore, the right of publicity is considered a personal right, and may only be claimed by the actor whose image is being used and not a third party.<sup>46</sup>

The Copyright Act was created in order to “promote the Progress of Science and useful Arts.”<sup>47</sup> While this clause is stated in the United States Constitution, it is also argued that Congress has the power to regulate copyright and trademark based on the Commerce Clause of the Constitution.<sup>48</sup> The Commerce Clause gives Congress the authority “to regulate commerce with foreign nations, and among

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<sup>41</sup> Cheatham, 891 F. Supp. at 387.

<sup>42</sup> Lawrence L. Davidow, Copyright Protection for Fictional Characters: A Trademark-Based Approach to Replace Nichols, 8 Colum. J.L. & Arts 513, 514 n.3 (1984).

<sup>43</sup> *Copyright in General*: [www.copyrights.gov](http://www.copyrights.gov), U.S Copyright Office (2009).

<sup>44</sup> *Id.*

<sup>45</sup> Johnathan Farber, Right of publicity, <http://rightofpublicity.com/brief-history-of-rop>, (2000).

<sup>46</sup> *Id.*

<sup>47</sup> *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 141 (2d Cir. 1998)

<sup>48</sup> Lee A. Hollaar, An Overview of Copyright, <http://digital-law-online.info/lpdi1.0/treatise4.html> ( 2007)

the several states.”<sup>49</sup> Starting at the time of the New Deal, the courts have read that clause expansively, saying that it gives Congress the authority to regulate virtually anything that affects interstate or foreign commerce.<sup>50</sup> Given today’s broad reading of the Commerce Clause, and the national and international scope of copyright and patents, there is little need for a separate Patent and Copyright Clause.<sup>51</sup> Many commentators now treat the Patent and Copyright Clause as a limitation on Congress, not a grant of authority.<sup>52</sup> Patents and copyrights must have limited durations, even though there would be no such restriction if Congress legislated them under the Commerce Clause.<sup>53</sup> Others argue that any copyright or patent law passed by Congress must be shown to “promote the Progress of Science and the useful Arts” when they feel that copyright or patent is limiting something that they feel is worthwhile.<sup>54</sup>

The Copyright Act grants exclusive control right to the creators of “original works of authorship” that include literary, musical, artistic, dramatic, and certain other works.<sup>55</sup> Not included in these works of art covered by the Copyright Act are fictional characters.<sup>56</sup> Fictional characters were intentionally omitted from the list of “works of authorships” in section 102 of the Copyright Act.<sup>57</sup> The legislative history of the Copyright Act reveals that the legislators felt that while

Proposals have been advanced for identifying fictional characters as copyrightable works in themselves under the bill. There are undoubtedly some characters that are developed in detail and with such breadth that they emerge as separately identifiable parts of the copyrighted works in which they appear. Others, perhaps the large majority, cannot be said to represent independent creations from the literary or pictorial works depicting them. As is equally true in the case of detailed presentations of plot, setting, or dramatic action, we believe it would be unnecessary and misleading to specify fictional characters as a separate

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<sup>49</sup> U.S. Const. art. I, sec. 8 cl. 3.

<sup>50</sup> Lee A. Hollaar, *An Overview of Copyright*, <http://digital-law-online.info/lpdi1.0/treatise4.html> (2007)

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> U.S. Const. art. I, § 8, cl. 8

<sup>55</sup> 17 U.S.C. § 102(a) (West, 2001).

<sup>56</sup> Richard S. Robinson, *Preemption, the Right of publicity, and a New Federal Statute*, 16 *Cardozo Arts & Ent. L.J.* 183, 185 (1990)

<sup>57</sup> William Prosser, *Privacy*, 48 *Cal. L. Rev.* 383, 389 (1960).



class of copyrightable works.<sup>58</sup>

Although fictional characters are not included, most courts have found a way to give these fictional characters copyright protection as a component of the larger copyrighted work in which they appear.<sup>59</sup> Some courts have even gone as far as to allow these fictional characters to be copyrightable in their own right.<sup>60</sup> A fictional character has three identifiable and legally significant components: its name, its physical or visual appearance, and its physical attributes and personality traits or “characterization.” The combination of these three elements determines a character’s copyrightability. Copyright protection extends to original works of authorship fixed in a tangible medium of expression.<sup>61</sup> Fictional characters are expressive, original, and may be fixed in literary, musical, or audiovisual works, thus many fictional characters qualify for copyright protection.

By having copyright protection on either the fictional character, or at least the film in which the fictional character appears, the studio gains a number of rights and protections.<sup>62</sup> First, the copyright owner can utilize the character in any future work.<sup>63</sup> The right to exclusive use of the character thus places the copyright owner in an excellent bargaining position with production studios, manufacturing enterprises, or any potential licensee seeking to capitalize on the character's fame.<sup>64</sup>

No publication or registration or other action in the Copyright Office is required to secure

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<sup>58</sup> Supp. Rep. of the Reg. of Copyrights on the General Revision of U.S. Copyright Law: 1965 Revision Bill, 89th Cong., 1st Sess., at 6 (1965).

<sup>59</sup> Id. at 401.

<sup>60</sup> Prosser, *supra* note 44, at 401 n.155

<sup>61</sup> Erin Green, *Superheroes: An Overview of Protecting Characters Under the Law*, <http://tlc.usm.maine.edu/documents/Superheroes.pdf> (2007).

<sup>62</sup> Copyright in General: [www.copyrights.gov](http://www.copyrights.gov), U.S Copyright Office (2009).

<sup>63</sup> Melville B. Nimmer, *The Right of publicity*, 19 *Law & Contemp. Probs.* 203, 203 (1954)

<sup>64</sup> Id.

copyright.<sup>65</sup> Copyright is secured automatically when the work is created, and a work is “created” when it is fixed in a copy or phonorecord for the first time.<sup>66</sup> “Copies” are material objects from which a work can be read or visually perceived either directly or with the aid of a machine or device, such as books, manuscripts, sheet music, film, videotape, or microfilm.

<sup>67</sup>“Phonorecords” are material objects embodying fixations of sounds (excluding, by statutory definition, motion picture soundtracks), such as cassette tapes, CDs, or vinyl disks. Thus, for example, a song (the “work”) can be fixed in sheet music (“copies”) or in phonograph disks (“phonorecords”), or both.<sup>68</sup> If a work is prepared over a period of time, the part of the work that is fixed on a particular date constitutes the created work as of that date.<sup>69</sup>

Copyright is a form of property which, like physical property, can be bought or sold, inherited, licensed or otherwise transferred, wholly or in part.<sup>70</sup> Accordingly, some or all of the rights may subsequently belong to someone other than the first owner and may be shared. Under the U.S. Copyright Act, a transfer of ownership in copyright must be memorialized in a writing signed by the transferor.<sup>71</sup> For that purpose, ownership in copyright includes exclusive licenses of rights. Thus exclusive licenses, to be effective, must be granted in a written instrument signed by the grantor.<sup>72</sup>

Second, as the holder of exclusive rights to use of the character, the copyright owner may sue any unauthorized user for infringement.<sup>73</sup> If the actor is found not to be an owner of a copyright in her character, she could be sued by the studio for appearing as the character in a

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<sup>65</sup> Copyrights: The Basics, [www.copyrights.gov](http://www.copyrights.gov), U.S. Copyright office (2009)

<sup>66</sup> Id.

<sup>67</sup> Id.

<sup>68</sup> Id.

<sup>69</sup> Id.

<sup>70</sup> Copyright in General: [www.uscopyrights.gov](http://www.uscopyrights.gov), U.S Copyright Office

<sup>71</sup> *Copyright in General*: [www.uscopyrights.gov](http://www.uscopyrights.gov), U.S Copyright Office

<sup>72</sup> Id.

<sup>73</sup> Melville B. Nimmer, *The Right of publicity*, 19 *Law & Contemp. Probs.* 203, 216 (1954).

future performance.<sup>74</sup> Finally, only the copyright owner is able to license out the name and likeness of the character for merchandising purposes.<sup>75</sup>

In order for a studio to prove copyright protection on one of its works, the studio must satisfy certain criteria. Courts have asked two threshold questions when determining if motion picture characters can ever be considered independently copyrightable subject matter under section 102. First, whether the character is considered a "work of authorship."<sup>76</sup>, and second, whether the character can be fixed in a tangible medium of expression<sup>77</sup>

With regard to the authorship requirement, some courts have found that those characters constitute an expressive component protected by copyright "from the story in which they are contained."<sup>78</sup> According to some courts copyright is available not only for characters (often as an expressive component part of another work), but also for the expressive component parts that significantly aid in identifying the character.<sup>79</sup> The court in *Anderson v. Stallone* found that plaintiffs' use of characters originally from the popular boxing movie "Rocky" infringed the copyright of those characters.<sup>80</sup> The *Stallone* decision supports the notion that the complete identity of a motion picture character--the totality of work done by screenwriters, actors, directors, and others, constitutes an original work of authorship.<sup>81</sup> Therefore, fictional characters may be a class that meets the authorship requirement.

Next, the requirement of "fixation" requires that the work be reduced to a tangible form.<sup>82</sup> It is questionable whether a character portrayed by a live actor who is constantly moving can ever

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<sup>74</sup> Id. at 215-16.

<sup>75</sup> Id. at 216.

<sup>76</sup> 17 U.S.C. § 102(a) (West, 2001).

<sup>77</sup> *Anderson v. Stallone*, 11 U.S.P.Q.2d (BNA) 1161, 1166 (C.D. Cal. 1989).

<sup>78</sup> *New Line Cinema Corp. v. Russ Berrie & Co., Inc.*, 161 F. Supp. 2d 293; and *New Line Cinema Corp. v. Easter Unlimited, Inc.*, Not Reported in F.Supp., 1989 WL 248212, E.D.N.Y.,1989.

<sup>79</sup> Id. at 293.

<sup>80</sup> Id.

<sup>81</sup> See 1 Nimmer, supra note 6, § 1.01(B)(1)(c), at 1-21 to 1-23

<sup>82</sup> *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 736 (1989).

be deemed "fixed."<sup>83</sup> unless their portrayal is captured on video or described in stage direction. The court in *Baltimore Orioles, Inc. v. Major League Baseball Players Association*, however, held that the performances of baseball players are sufficiently "fixed" in the taped telecasts of the games for the purposes of copyright protection.<sup>84</sup> Under this analysis, a motion picture character could similarly be deemed "fixed" in the tape of the motion picture in which it is featured.<sup>85</sup>

Although motion picture characters may be considered independent works of authorship, courts must still decide which standard to employ when determining if a particular character is a work of authorship meriting copyright protection. In the landmark case of *Feist Publications v. Rural Telephone Service*, Feist had copied information from Rural's telephone listings to include in its own, after Rural had refused to license the information.<sup>86</sup> Rural sued for copyright infringement.<sup>87</sup> The Supreme Court ruled that information contained in Rural's phone directory was not copyrightable, and that therefore no infringement existed.<sup>88</sup> The court reasoned that the Copyright Act was created to "encourage creative expression," and that while the standard of creativity is extremely low, that this compilation of data was not sufficient to meet that standard, and was therefore not copyrightable.<sup>89</sup> It was established that mere labor, if not original, was not copyrightable.<sup>90</sup> This inevitably means that the copyright in a factual compilation is thin.

<sup>91</sup>Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the

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<sup>83</sup> *Factors v. Pro Arts, Inc.*, 652 F.2d 278, 289 (2d Cir. 1981)

<sup>84</sup> 805 F.2d 663, 675 (7th Cir. 1986).

<sup>85</sup> *Wendt I*, 35 U.S.P.Q.2d (BNA) 1315 (9th Cir. 1995)

<sup>86</sup> 499 U.S. 340, 340 (1991).

<sup>87</sup> *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340, 340 (1991).

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 345

<sup>90</sup> *Id.*

<sup>91</sup> *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340, 349 (1991).

competing work does not feature the same selection and arrangement.<sup>92</sup> This notion has been referred to as “thin protection.” This legal interpretation was derived from the Copyright Clause of the United States Constitution, which grants Congress the power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>93</sup>

One option is to employ the well-established “sufficient delineation” test, first articulated by the Second Circuit in *Nichols v. Universal Pictures Corporation*, a case involving the alleged use in defendant's motion picture of characters from plaintiff's play.<sup>94</sup> In this case, Judge Learned Hand held that the characters at issue were merely “stock figures,” not sufficiently developed to merit copyright protection.<sup>95</sup> However, he offered no guidance to a court applying the “sufficient delineation” test in the future.<sup>96</sup> As a result, in practice the test was unworkable and confusing, a fact Judge Hand recognized when he admitted that the “sufficient delineation” standard seemed arbitrary.<sup>97</sup> This confusion, however, did not prevent future courts from applying the test, which often resulted in findings that characters were copyrightable.<sup>98</sup> Where, however, there is minimal character development, such as in the case of “stock” characters, courts have universally held that the characters are not “sufficiently delineated” as to merit copyright protection.<sup>99</sup>

Clearly there are shortcomings to the sufficient delineation test when it comes to the copyrightability of fictional characters. A new test must be formulated to address fictional characters, specifically those portrayed by human actors. The copyrightability of literary characters is often measured by whether the character's personality is sufficiently developed on

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<sup>92</sup> Id.

<sup>93</sup> U.S. Const. art. I, § 8, cl. 8

<sup>94</sup> *Nichols*, 45 F.2d at 121-22.

<sup>95</sup> Id.

<sup>96</sup> *Anderson*, 11 U.S.P.Q.2d at 1165

<sup>97</sup> *Nichols*, 45 F.2d at 122.

<sup>98</sup> *Silverman v. CBS, Inc.*, 870 F.2d 40 (2d Cir. 1989)

<sup>99</sup> *Jones v. CBS, Inc.*, 733 F. Supp. 748, 753 (S.D.N.Y. 1990)

paper to be considered "delineated."<sup>100</sup> Cartoon characters, however, have been granted protection based on their appearance alone, without any attention to issues of character development.<sup>101</sup> It is argued that courts should consider that motion picture characters, often highly developed and visual, may contain elements of both literary and cartoon characters, thus raising unique issues of copyrightability which have not been settled.<sup>102</sup>

#### **IV. Preemption**

Although many courts have assumed that the studios own the rights to fictional characters, actors have, in many cases, attempted to fight this assumption by asserting their publicity rights, and in some cases, have been successful. In cases in which actors attempt to assert control over their fictional character using state statute or common law publicity rights, studios often argue that these rights are preempted by the copyright act; and therefore, the actor should not be able to engage in conduct reserved to the studio. Studios often claim that the actors' right of publicity is invalid because of conflict preemption, as well as equivalency preemption. Both of these arguments are derived from the Federal Copyright Act.

The first way in which a studio may combat an actor's claim of publicity rights is by use of the equivalency preemption. Under section 301 of the Copyright Act, Congress established that a state law yields to a federal copyright under the doctrine of equivalency preemption if two requirements are met.<sup>103</sup> The work under which the right of publicity is asserted must be fixed in

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<sup>100</sup> Nichols, 45 F.2d at 121.

<sup>101</sup> King Features Syndicate v. Fleischer, 299 F. 533 (2d Cir. 1924)

<sup>102</sup> Anderson, 11 U.S.P.Q.2d at 1166

<sup>103</sup> Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n, 805 F.2d 663, 674 (7th Cir. 1986).

a tangible form and come within the subject matter of copyright.<sup>104</sup> Also, the state –created right must be equivalent to one of the exclusive rights granted to copyright holders under the Act.<sup>105</sup>

When analyzing whether equivalency preemption applies to a situation, a court must first determine whether the right of publicity claim applies to the personal or proprietary rights of publicity of the actor.<sup>106</sup> In the case that the right of publicity claim is based on personal rights, the subject matter of copyright is not involved, therefore, it should not be preempted.<sup>107</sup> If the subject matter is a proprietary right of publicity this means the actor is attempting to gain legal or equitable right in a copyrighted motion picture character. Thus, if the claim is based on a propriety right of publicity, it will likely meet the first element for equivalency preemption,<sup>108</sup> if the character is also fixed in a media.

Whether a character is fixed in a motion picture or television show is often not in question. Other forms of mediums, such as theater or stand-up performances, are more questionable, but would likely be considered fixed for the purposes of copyright laws.<sup>109</sup> So, in the cases where the actor’s rights of publicity claim is based on the celebrity’s image or likeness as a copyrighted character, it is clearly proprietary in nature, and the first element of the equivalency preemption is satisfied.<sup>110</sup>

Second, and more difficult to satisfy, the court must consider whether the state-created right is equivalent to an exclusive right under the Copyright Act. Courts are split over what the word

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<sup>104</sup> Id.

<sup>105</sup> Id.

<sup>106</sup> Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988)

<sup>107</sup> Id.

<sup>108</sup> Wendt I, 35 U.S.P.Q.2d (BNA) 1315 (9th Cir. 1995)

<sup>109</sup> Edgar v. MITE Corp., 457 U.S. 624 (1982).

<sup>110</sup> Factors v. Pro Arts, Inc., 652 F.2d 278 (2d Cir. 1981); Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188 (S.D.N.Y. 1983).

“equivalent” means.<sup>111</sup> A number of circuit have all addressed the definition of equivalent, and have clarified or expanded upon the definition. In *Harper & Row, Publishers, Inc. v. Nation Enterprises*, the Second Circuit determined that that equivalency test’s second should be assessed as follows:

When a right defined by state law may be abridged by an act which, in and of itself, would infringe one of the exclusive rights [outlined in section 106 of the Copyright Act], the state law in question must be deemed preempted... Conversely, when a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur.<sup>112</sup>

The court in *Harper* seems to simply restate the “Copyright Defense” in the first portion of the above quote, by saying that a state law which conflicts with the Federal Copyright Act should be preempted.<sup>113</sup> In the second portion of the quote, the court seems to create an “additional element” test to determine whether the state law is equivalent to the rights granted in the Federal Copyright Act. The court states that when the state act incorporates an additional element beyond mere reproduction, that there is no preemption.<sup>114</sup> It follows then that since an actor’s right of publicity requires reproduction and then additionally commercial reproduction, that the actor’s right of publicity claim would survive preemption. This “additional element” test is what the Ninth Circuit used to justify not granting summary judgment to the Defendant in the *Wendt* case based on preemption.<sup>115</sup>

In contrast to the Ninth Circuit’s analysis of the “additional ” test of the second element of equivalency preemption, in *Baltimore Orioles, Inc v. Major League Baseball Players*

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<sup>111</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573, 576 (1977); *Lugosi v. Universal Pictures*, 603 P.2d 425, 441-42 (Cal. 1979)

<sup>112</sup> 723 F.2d 195, 204 (2d Cir. 1983)

<sup>113</sup> *Wendt II*, 125 F.3d 806, 810 (9th Cir. 1997)

<sup>114</sup> *Id.*

<sup>115</sup> 17 U.S.C. § § 106, 501; 35 U.S.P.Q.2d at 1316 (citing *Waits*, 978 F.2d at 1100); *Brown Bag Software v. Systematic Corp.*, 960 F.2d 1465 (9th Cir. 1992).



*Association*, the Seventh Circuit held that the baseball players' publicity rights were equivalent to at least one of the rights encompassed by copyright—the right to perform an audio visual work.<sup>116</sup> Under the *Baltimore Orioles* court's analysis, an actor's claim of publicity rights to prevent the creation of a licensed derivative work should be preempted.<sup>117</sup> This holding is, of course, in contrast to the *Wendt* court, which ruled that the right of publicity's requirement of commercial appropriation constitutes an element beyond those required in a copyright infringement claim.

The basis for these courts referring to the “additional element” test is the legislative history of section 301 of the Copyright Act. The legislative history suggests that both the rights of privacy and publicity would be unaffected by preemption as long as the causes of action contained elements that are “different in kind from copyright infringement.”<sup>118</sup> The Seventh and Ninth Circuits stand in contrast to one another on whether the commercial appropriation aspect of the right of publicity constitutes an additional element.

Second, a studio can argue that the actor's publicity rights are preempted under Section 106 of the Federal Copyright Act.<sup>119</sup> This is referred to as conflict preemption, or the “copyright defense.” Section 106 provides that the copyright holder has the exclusive right to make derivative works, and the Supremacy Clause of the U.S. Constitution prohibits any state law form restricting or conflicting with a federally-granted right.<sup>120</sup> If a character in a motion picture production is copyrightable. The principle of conflict preemption should prevent a state law right

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<sup>116</sup> 805 F.2d 667 (7th Cir. 1986).

<sup>117</sup> See *Baltimore Orioles*, 805 F.2d at 678 n.26

<sup>118</sup> H.R. Rep. No. 1476, 94th Cong., 2d Sess. 51, 132, reprinted in 1976 U.S.C.C.A.N. 5659, 5748.

<sup>119</sup> 17 U.S.C. § 106.

<sup>120</sup> U.S. Const. art. VI, cl. 2.

of publicity from interfering with the copyright holder's unfettered use of the character's image in a derivative work.<sup>121</sup>

It is established that those studios that possess ownership of a copyrightable production, also possess have copyright rights over that productions components.<sup>122</sup> It follows that a studio that possesses copyright rights of a television show, it would also have copyright ownership of any fictional characters within that production in derivative works.<sup>123</sup> Thus, a studio should be able to rely on the copyright defense to prevent an actor from attempting to restrict the studio from using his image in derivative works

## V. First Amendment Concerns

Another hurdle to an actor's successful claim of publicity rights with regard to a fictional character may be the First Amendment. Despite the fact that the First Amendment has not been the main focus of right of publicity analyses in courts, it is directly implicated because the right of publicity is a communicative right.<sup>124</sup> The law attempts to strike a balance between an individual's right of publicity and free speech rights to permit specific uses of an individual's identity.<sup>125</sup>

To delve into this issue fully, it is necessary to understand the interrelationship between fair use and the first amendment. The first amendment assures that we have a right to voice our ideas, assert conflicting views from which new thought is derived, and criticize thought and action of

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<sup>121</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425, 449 (Cal. 1979)

<sup>122</sup> *Warner Bros., Inc. v. American Broad. Co., Inc.*, 720 F.2d 231, 235 (2d Cir. 1983)

<sup>123</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425, 449 (Cal. 1979)

<sup>124</sup> Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 *Yale L.J.* 1577, 1577 n.2 (1979)

<sup>125</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

powerful forces in society.<sup>126</sup> But fair use provides a means to access the information upon which our opinions are based. Without the fair use exception to copyright, free speech would be at best, inhibited and in some cases, eliminated altogether.<sup>127</sup> The driving policy behind the first amendment *requires* the maintenance of a balance between the rights of speech in the individual and the need to establish a secure and orderly environment in which that speech might flourish.<sup>128</sup>

Similarly, the constitutional grant of a limited copyright monopoly in individual creators was developed to advance these same goals of society. The constitutional provision states that “The Congress shall have power . . . to Promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>129</sup> The ordering of the clauses indicates the policy intent behind the provision to ensure the advancement of societal knowledge.<sup>130</sup> The means is to grant to authors a limited monopoly in their work in order to provide incentive for the development of new work. The limitation ensures the existence of a public domain.<sup>131</sup>

The fair use doctrine, a judicial creation later encoded in the statutory language of section 107 of the Copyright Act of 1976, provides specific support for the stated constitutional goals of the copyright clause.<sup>132</sup> This doctrine has, since common law, supported the principal that access to information forms the basis for free speech and participatory government and that without

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<sup>126</sup> Bielefield, Arlene, & Cheeseman, Lawrence, Technology and Copyright, <http://endora.wide.msu.edu/3.1/coverweb/ty/ff.html> (1997).

<sup>127</sup> Id.

<sup>128</sup> Id.

<sup>129</sup> U. S. Const. art. I Section 8, cl. 8.

<sup>130</sup> Shiffrin, Steven H. & Cooper, Jesse H., The First Amendment. <http://endora.wide.msu.edu/3.1/coverweb/ty/ff.html> (1991).

<sup>131</sup> Id.

<sup>132</sup> Patterson, L. Ray, & Birch, Jr., Stanley F. (1996). Copyright and free speech rights. *Journal of Intellectual Property Law*, 4, 1-23.

access to information, society's ability to progress would be hindered.<sup>133</sup> This principal specifies that fair use is an exception to the limited monopoly granted to authors in their work.<sup>134</sup> The statute states that “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching, scholarship, or research is not an infringement of copyright.”<sup>135</sup> It is the common origin of the First Amendment and the copyright clause that makes clear the purpose of the constitutional policies: to protect free speech rights by preventing copyright from being used as a device of censorship, consistent with the purpose that copyright promote learning.<sup>136</sup>

One serious difficulty with relying upon First Amendment protection is the legal unpredictability of First Amendment rules. The First Amendment provides a hierarchy of protection under the newsworthiness exception depending upon how the individual's identity is being used.<sup>137</sup> The newsworthiness exception to the First Amendment is based on the belief that free speech rights clearly transcend privacy rights when the speech concerns “newsworthy events or matters of public interest.”<sup>138</sup> The greatest protection is provided for news, lesser protection is provided for entertainment and fiction and the least protection is available for advertising uses where a portrayal of a real person's identity is used to sell a product or service.<sup>139</sup>

First Amendment protection exists to ensure that the public is constitutionally entitled to know about things, people and events that affect it.<sup>140</sup> The newsworthiness exception includes information about the real world and is generally defined to include: (1) current news items,

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<sup>133</sup> Patterson, L. Ray, & Lindberg, Stanley. The nature of copyright, <http://endora.wide.msu.edu/3.1/coverweb/ty/ff.html> (1991).

<sup>134</sup> Id.

<sup>135</sup> 17 U.S.C. 107 (1982)

<sup>136</sup> Patterson, L. Ray, & Birch, Jr., Stanley F., Copyright and free speech rights. *Journal of Intellectual Property Law*, 4, 1-23. (1996).

<sup>137</sup> Lloyd Rich, *Right of publicity*, The Publishing Law Center, 1, 1 (2000).

<sup>138</sup> .Stephano v. News Group Publications, Inc., 64 N.Y.2d 174, 485 N.Y.S.2d 220, 224-25, 474 N.E.2d 580 (1984)

<sup>139</sup> Id.

<sup>140</sup> Id.

news that has occurred in the past and information that is not strictly news, but is still informative; (2) media presentation on "public issues"; (3) factual, educational and historical material; and (4) entertainment and amusement concerning interesting aspects of an individual's identity.<sup>141</sup> Two elements must be satisfied before a person's identity may be used under the newsworthiness exception. First, the unauthorized use of an individual's identity must be news that is subject to First Amendment protection. Second, there must be a reasonable connection between the use of the individual's identity and the news that is being conveyed.<sup>142</sup>

Regarding the first element, when there is an unauthorized use of an individual's identity, there must be a connection, or reasonable relationship, with the news or public interest story subject and the individual.<sup>143</sup> When there is a connection, the individual's property rights in the right of publicity must yield to the First Amendment.<sup>144</sup> To succeed on a right of publicity claim, the person must show that the property right in his/her identity was merely used as a vehicle to attract attention to the news or entertainment message.<sup>145</sup> Furthermore, an individual cannot use the right of publicity to claim a property right in his/her likeness as reflected in photographs that were taken in a public place to illustrate a newsworthy story.<sup>146</sup>

In *Whitney v. California*. Justice Brandeis in 1927 outlined the underlying goals of the First Amendment for safeguarding free speech: the enlightenment function, the self- fulfillment function; and the safety valve function.<sup>147</sup> The majority of courts that have addressed First Amendment concerns with the publicity rights have made a distinction between the use of one's

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<sup>141</sup> Id.

<sup>142</sup> Marr, Jeremy T., Constitutional Restraints on State Right of publicity Laws, Boston College Law Review, Vol. 44, May 2003. Available at SSRN: <http://ssrn.com/abstract=410025> or doi:10.2139/ssrn.410025

<sup>143</sup> Lloyd Rich, *Right of publicity*, The Publishing Law Center, 1, 1 (2000).

<sup>144</sup> Id.

<sup>145</sup> Id.

<sup>146</sup> Id.

<sup>147</sup> 274 U.S. 357, 375 (1927)

identity for purely commercial uses as opposed to uses of free speech that are protected.<sup>148</sup> The issue for the courts becomes balancing the interests of both parties to create a workable and fair policy.

The Supreme Court addressed the balance between the First Amendment and the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>149</sup> In this case, the Court agreed with the Plaintiff that the filming of his human cannonball performance at a fair, by a television reporter, was considered “unlawful appropriation” of his professional property.<sup>150</sup> The defendants argued that the First Amendment protected their right to broadcast the performance without compensation, but the court recognized the right of publicity as an established cause of action with significant rational and economic underpinning.<sup>151</sup> The court did ensure that it was understood that the holding in this case should be narrowly interpreted to the facts of the case; however, this case left the possibility of preemption of state publicity right law, based on First Amendment grounds, an open issue.

Since the holding in *Zacchini*, courts have often held that First Amendment concerns preempt right of publicity interests.<sup>152</sup> Courts tend to subordinate interests protected by the right of publicity under competing free speech interests when faced with a conflict between the two.

## **VI. The Possible Solutions: Federal Statues or Sliding Scale?**

With the new-media technologies, choice of law issues may become crucial as the exploitation of identity can occur easily and quickly at national levels in ambiguous jurisdictions (e.g., the Internet); a consensus on the law would promote certainty and reduce forum

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<sup>148</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988)

<sup>149</sup> 433 U.S. 562 (1977)

<sup>150</sup> *Id.* at 564.

<sup>151</sup> *Robinson*, *supra* note 43, at 187-88

<sup>152</sup> *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996)

shopping.<sup>153</sup> An obvious solution to the courts' splitting regarding fictional characters and the right of publicity would be a federal statute which provided a definitive perspective. More than half of states recognize the right of publicity.<sup>154</sup> Some states have enacted statutes that recognize the right, while others rely on common law for protection of their right of publicity.<sup>155</sup> Those states that do not explicitly recognize a right of publicity find justification for protection under privacy laws.

Court of Appeals remain split over right of publicity issues and use various schemes to justify and carry out the right. There are a number of cases which illustrate the unresolved conflicts and the lack of definitive perspective on the issue.

Under a dual common law and statutory schema, the Ninth Circuit's decision in *Wendt* discussed in the previous section broadened the scope of California's right of publicity law in the context of animatronics' reproductions of celebrity likeness.<sup>156</sup> In contrast, under a New York privacy statute, which does not recognize a common law right of publicity, the Southern District of New York rejected plaintiff Astrud Gilberto's request for a right of privacy action based on defendant's unauthorized use of her voice in an advertisement.<sup>157</sup> Specifically, the Frito-Lay advertisement portrayed "Miss Piggy" lip-synching Gilberto's recording of "The Girl From Ipanema," while gorging her face with potato chips.<sup>158</sup> Due to the absence of a common law right of publicity recognition in New York, the plaintiff was forced to bring what amounted to a right of publicity claim under privacy statutes. Ultimately, the plaintiff's claim was dismissed because

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<sup>153</sup> Russell J. Frackman, Tammy C. Bloomfield, *The Right of publicity: Going to the Dogs?*, <http://www.gseis.ucla.edu/iclp/rftb.html> (1996).

<sup>154</sup> Roberta Rosenthal Kwall, *Fame*, 73 *Ind. L.J.* 1, 42 (1997)

<sup>155</sup> *Mass. Gen. Laws Ann. ch. 214, § 3A* (West 1989);

<sup>156</sup> *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997).

<sup>157</sup> *Oliveira v. Frito-Lay, Inc.*, 43 U.S.P.Q.2d (BNA) 1455, 1460 (S.D.N.Y. 1997)

<sup>158</sup> *id.* at 1457.

New York law specifically excludes voice misappropriation under their current statutory scheme.<sup>159</sup>

These conflicting court of appeals decisions highlight the potentially endless cycle of inconsistency in right of publicity cases that seek the guidance of a federal statute. Not only will the inculcation of a federal statute solve copyright-based preemption questions and assist in the resolution of First Amendment preemption concerns, it will also promote consistency and predictability of protection, reform efforts must create the most efficient law, while at the same time fortifying the law's weaknesses with supplemental means. The most effective reform would take the responsibility for defining publicity rights away from the hands of the inconsistent state courts and place it in the hands of Congress so that a uniform federal law can be passed.<sup>160</sup>

Congress is best able to delineate clearly what the right of publicity in audiovisual characters should encompass, making negotiations for the parties easier and more predictable.

In the interest of creating uniformity among court decisions, Congress should enact a federal statute dealing explicitly with the right of publicity. Celebrities' livelihood is dependent upon the protection of their public persona.<sup>161</sup> Moreover, the morass of laws upon which one may seek protection may encourage practices such as forum shopping and waste of public and judicial resources.<sup>162</sup> Without a workable federal statute that accounts for the ephemeral, chameleon, and continually evolving nature of the technological universe, ongoing confusion among the courts is rendered inevitable.<sup>163</sup>

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<sup>159</sup> *id.* at 1462

<sup>160</sup> Michael Albano, Should The Right of publicity Be Extended to the Fictional Characters Which they Portray, 90 *GEOLJ* 253, 290 (2001).

<sup>161</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977)

<sup>162</sup> Robinson, *supra* note 43, at 201-02.

<sup>163</sup> Jennifer Y. Choi, No Room for Cheers: Schizophrenic Application in the Realm of Right of publicity Protection, 9 *VLSSELJ* 121 (2002).



The bedrock of a federal right-of-publicity statute should be that, in general, an actor has no right of publicity in a character she portrays.<sup>164</sup> Current right-of-publicity law and proposals for reform provide actors with overexpansive rights.<sup>165</sup> These rights not only allow actors to collect more than their fair share of a character's worth, but they also hinder the rights of federal copyright owners.<sup>166</sup> Establishing a presumption that an actor retains no right of publicity in characters she portrays will eliminate the unfairness of the current system. Such a principle also eradicates concerns about federal preemption that plague the present scheme.<sup>167</sup> To prevent such a statute from being overly burdensome on actors, however, Congress should draft an exception.<sup>168</sup>

The exception would grant an actor a federal right of publicity in a character she portrays when she is the substantial creative force behind the character or when the character has become so associated with the actor that they are inseparable to the public eye.<sup>169</sup> Cases in which an actor is the creator of her character have always been deemed worthy of right-of-publicity protection.<sup>170</sup> To satisfy this portion of the exception, an actor must satisfy a threshold significantly higher than merely imparting some level of creativity or originality in the character.<sup>171</sup> Instead, an actor must have created or co-created the character--meaning she has taken a substantial role in the character's origins as well as made material contributions to the character's development, personality, dialogue, and mannerisms.<sup>172</sup> This standard may not provide the brightest of lines, but the threshold would be high, and congressional guidelines for determining when an actor has

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<sup>164</sup> Michael Albano, Should The Right of publicity Be Extended to the Fictional Characters Which they Portray, 90 GEOLJ 253, 290 (2001).

<sup>165</sup> Id.

<sup>166</sup> Id.

<sup>167</sup> Id.

<sup>168</sup> Id.

<sup>169</sup> Id.

<sup>170</sup> Id. at 291.

<sup>171</sup> Id.

<sup>172</sup> Id.

"created" a character would substantially limit the subjective application of the test by the judiciary.<sup>173</sup> Criteria would not be developed by judicial whim, but would instead be the result of the thorough investigation and detailed findings of various congressional committees.<sup>174</sup> Nor would the criteria be formed based on the particular needs of an actor or copyright owner in a specific case.<sup>175</sup> Instead, all of the entertainment industry, actors and studios alike, would have the ability to participate in the drafting of congressional guidelines through testimonial avenues or lobbying efforts. This would achieve the goal of taking the inquiry from the hands of the judiciary in order to create uniform standards.

Another suggested remedy to the haphazard application of publicity rights is the use of a sliding scale associated with the input the actor has on creating and personalizing the character. Right of publicity protection should be extended to any character that is "so associated with [the actor] that [the character] becomes inseparable from the actor's own public image."<sup>176</sup> This "associative value" test, as set forth in *McFarland*, should be applied as a sliding scale which, pursuant a spectrum which begins with situations where the actor is incorporated into the creation of the character, and continues to instances in which the character is independently created by the studio.<sup>177</sup> The spectrum or "tiers" of protection are as follows: (1) the actor portrays himself or herself as a character; (2) the actor creates the character; (3) the character is based on the actor; (4) the actor plays a character with the same name, but with fictional elements; (5) the actor plays a character with the same first name, but with fictional elements; and (6) the actor plays a character who is dissimilar to himself or herself, but has become

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<sup>173</sup> Id.

<sup>174</sup> Id.

<sup>175</sup> Id.

<sup>176</sup> Id.

<sup>177</sup> Angela Cook, Should Right of publicity Protection Be Extended to Actors In The Characters Which They Portray, 9 DePaul-LCA J. Art & Ent. L. 309 (1999).

associated with the character.<sup>178</sup> The theory is that the courts should provide protection to a character at the top tier of the spectrum without requiring a showing of association and requires a high association level for characters in the bottom tier.<sup>179</sup> The purpose for the progressive level of proof of association rests in the acknowledgement that celebrities in the first tier of the spectrum (i.e., talk show hosts), are implicitly associated with their characters as they convey their personality into their screen personification.<sup>180</sup> Conversely, an actor who portrays a character in a bottom tier of the spectrum (i.e., an actor who portrays a character unique from the actor personally) must establish that he or she has imparted some level of creativity or originality in the character in order to elicit public recognition of the actor upon exploitation of the character.<sup>181</sup>

The above mentioned “sliding scale” is analogous to the “thin protection” mentioned in the *Feist* case. Overall, with regard to “thin protection” the *Feist* Court made clear that copyright rewards originality, not effort.<sup>182</sup> The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.<sup>183</sup> Similarly, the “sliding scale” solution mentioned above rewards the amount of originality and creativity that the actor contributes to the character in order to determine the amount of protection the actor deserves.

Celebrities can prove their associative value with their character by utilizing the fact finding techniques which demonstrate consumer confusion in both right of publicity and trademark infringement analyses.<sup>184</sup> Such evidence includes surveys, statistical data, individual accounts

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<sup>178</sup> Id. at 314.

<sup>179</sup> Id. at 347.

<sup>180</sup> Id.

<sup>181</sup> Id.

<sup>182</sup> *Feist Publications, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340, 391(1991).

<sup>183</sup> Id.

<sup>184</sup> Id.

and expert testimony.<sup>185</sup> The ‘universe’ of such data should only encompass the relevant audience, rather than drawing samples from the public at large.<sup>186</sup> The evidence should demonstrate that the actor has acquired a general identification with his or her character throughout the public.<sup>187</sup> Additionally, evidence of character merchandising that exploits the image of the actor supports a finding that the actor is associated with the character.<sup>188</sup> Finally, the court must determine on a case by case basis whether, in the situation where the actor becomes highly associated with another character after already establishing a proprietary interest in a previously portrayed character, the public at large continues to associate the actor with the original character.<sup>189</sup>

In light of the expanding protection provided individuals for exploitation of their personas, the right of publicity as applied to characters should also embody this expansive view, thus concentrating not on how the celebrity's identity was appropriated, “but whether the defendant has done so.”<sup>190</sup> Unlike when the right of publicity was first established, “...a character is comprised of a “name, physical appearance, attributes, mannerisms, speech and expression, habits, attire, setting, and locale.”<sup>191</sup> Therefore, the court must determine which of the character's attributes are the most distinctive, consequently identifying the celebrity when used by the defendant.<sup>192</sup>

In the *White* holding, it was held that the background and location could elicit recognition of an actor. Although many scholars dispute the *White* holding, critics of the decision did not claim

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<sup>185</sup> *Computer Assocs. Int., Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992)

<sup>186</sup> 9 DePaul-LCA J. Art & Ent. L. 309, 348 (1999).

<sup>187</sup> *Id.*

<sup>188</sup> *Lugosi*, 25 Cal. 3d at 817.

<sup>189</sup> 9 DePaul-LCA J. Art & Ent. L. 309, 348 (1999).

<sup>190</sup> John R. Braatz, *White v. Samsung Electronics America: The Ninth Circuit Turns a New Letter in California Right of publicity Law*, 15 Pace L. Rev. 161, 195-222 (1994).

<sup>191</sup> Dean D. Niro, *Protecting Characters through Copyright Law: Paving a New Road Upon Which Literary, Graphic, and Motion Picture Characters Can All Travel*, 41 DePaul L. Rev. 359 (1992).

<sup>192</sup> *White*, 971 F.2d at 1399.

that the advertisement failed to elicit public recognition of Vanna White. Some critics of the holding argue that a defendant should not be prohibited from simply “reminding” the public of a celebrity.<sup>193</sup> The right of publicity's expansion beyond appropriations of an individual's name and likeness is premised on the acknowledgment that traits other than a name or likeness may identify, or remind, the public of a celebrity.<sup>194</sup> Consequently, a defendant's display of a location that is associated with a character, while not “belonging” to the actor, may in fact appropriate his or her image.<sup>195</sup>

## **VII. Conclusion**

It is clear that the courts are far from in agreement when it comes to the breadth of the right of publicity and fictional characters. The Ninth Circuit, in the *Wendt* decision, made a decision that may, critics argue, cross constitutional boundaries. Without a uniform and workable model of the right of publicity, courts will continue to make their own erratic standards, and Plaintiffs will continue to forum-shop for the most favorable courts. While ideally, the right of publicity would be incorporated into the Federal Copyright Act, a sliding scale similar to the one mentioned above would provide the court with direction, as well. It is clear that until the problems are addressed regarding the right of publicity, each court's decision will change and shape to rights which an actor has regarding the use of their fictional character.

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<sup>193</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988)

<sup>194</sup> *Id.*

<sup>195</sup> 9 DePaul-LCA J. Art & Ent. L. 309, 348 (1999).