

From PLI's Course Handbook

Understanding the Intellectual Property License 2005

#6042

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RIGHTS OF PUBLICITY AND
ENTERTAINMENT LICENSING

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INTRODUCTION

The right of publicity is one of a group of torts that generally are referred to as comprising the right of privacy. These torts include: 1) intrusion, *e.g.* trespass, 2) false light, 3) truthful publication of embarrassing private fact and 4) commercial appropriation of an individual's identity or identifiable aspects. It is the fourth type (the only one recognized in New York State) that generally is referred to as the right of publicity. Professor McCarthy has defined the right of publicity as "the inherent right of every human being to control the commercial use of his or her identity."

Under state law protections for the right of publicity, a release is necessary in order to exploit a person's right of publicity in advertising or in connection with the sale of commercial products. In other words, permission is needed whenever a person's name, picture, likeness or voice (and sometimes other elements of persona) is used in advertising or promotion (paid media insertion for the promotion of the sale of goods or services) or for any purposes of trade (products and merchandise). *E.g.*, N.Y. Civ. Rights Law §§50, 51 (written release required).

The First Amendment restricts application of the right of publicity in situations involving the dissemination of information and other protected activities. For example, permission is not needed to use a photograph of a person on the cover of a book or magazine (of course, permission of the copyright owner of the work may be required) or to illustrate an article in a newspaper or a television news item.

It is not always clear whether a particular use of a person's name, picture, likeness or voice fits within the categories requiring permission. *See Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989) (function and marketing determine whether use is for purpose of trade). *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 21 P.3d 797 (2001) (Three Stooges images on a T-Shirt is no more than an item of commerce). *See ETW Corp., Plaintiff, vs. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003) (affirming summary judgment dismissing claims based upon use of likeness of Tiger Woods in limited edition painting commemorating Woods' victory in 1997 Masters).

NON-COMMERCIAL USE:

Editorial use, at least where the photograph bears a real relationship to an article on matters of public interest, does not require a release. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (L.A. magazine

fashion article using famous actors as models); *Finger v. Omni Publ. Int'l Ltd.*, 77 N.Y. 2d 138, 564 N.Y.S.2d 1014 (1990) (photo of family with six children used to illustrate an article about caffeine-enhanced fertility); *Creel v. Crown Publishers, Inc.*, 115 A.D.2d 414, 496 N.Y.S. 2d 219 (1st Dept. 1985) (pictures illustrating a book entitled “Nude Beaches of the World” concern newsworthy matters of public interest and cannot be the basis for a claim for invasion of privacy).

Information regarding availability of products and services, provided it is not a paid insertion or controlled by the marketer, does not generally require permission. In *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174, 485 N.Y.S.2d 220 (1984) (*New York Magazine* “Best Bets” Column, which featured price and store location, was not an “advertisement,” where there was not payment for the insertion and content was totally under magazine's control). One Court has held that a 900 phone number poll to name the most popular member of a pop group (yielding a profit) which was conducted by a newspaper, with the results published as a feature story, did not constitute a use for purposes of trade of the names of the celebrities. *New Kids on the Block v. News America Pub., Inc.*, 745 F. Supp. 1540 (C.D. Cal. 1990), *aff'd*, 971 F.2d 302 (9th Cir. 1992). However, alleged editorial content in a commercial catalog may be deemed to be part of the advertising. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001). (Photo of surfers in Hawaii illustrating article about California Surfing).

In a highly publicized decision, a California district court ruled that the use of a photo of Dustin Hoffman as he appeared in the movie “Tootsie” as part of a fashion spread in Los Angeles Magazine violated Hoffman’s right of publicity. But the case was reversed on the ground that the spread was not commercial speech and defendants did not act with actual malice in publishing it. *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (C.D. Cal. 1999) *reversed*, 255 F.3d 1180 (9th Cir. 2001); *see Messenger v. Gruner & Jahr*, 994 F. Supp. 525 (S.D.N.Y. 1998) (picture used with an unsigned letter to editor); *Weber v. Multimedia Entm’t, Inc.*, 1998 U.S. Dist. LEXIS 2, (S.D.N.Y. Jan. 5, 1998) (passing minor off as a 15-year-old prostitute on TV show).

Satire and parody have also been held to constitute protected speech and therefore use of a person’s name or likeness is not a violation of the right of publicity. *See Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (caricature of celebrity in a parody of an advertisement protected by First Amendment); *Geary v. Goldstein*, 1996 U.S. Dist. LEXIS 11288

(S.D.N.Y. Aug. 7, 1996) (actor's performance in a commercial which was used in a sexually explicit parody of the commercial could not be the basis for a claim); *Cardtoons L.C. v. Major League Baseball Players Assn*, 95 F 3d 959 (10th Cir. 1996) (parody baseball cards). But in most instances, the Courts will require the parody to make some comment on the original work, not simply use the original work to make some comment or humorous point about contemporary issues.

Entertainment and biography are also protected by the First Amendment. See *Hampton v. Guare*, 195 A.D. 2d 366, 600 N.Y.S.2d 57 (1st Dep't 1993) (play "Six Degrees of Separation" based on actual story); *Joplin Enterpr. v. Allen*, 795 F. Supp. 349 (W.D. Wash.) (play based on life of Janis Joplin). Note that falsity within an otherwise protected use may deprive it of this protection.

Content on web sites, including bulletin boards and chat, similarly do not require permission if not advertising in disguise. *Stern v. Delphi Internet Services Corp.*, 165 Misc. 2d 21, 626 N.Y.S.2d 694 (Sup. Ct. New York Co. 1995) (chat-line). The chat-line concerned Howard Stern, a talk-show personality who at the time was running for governor of New York. The Court held that the chat-line, which permitted subscribers to use Stern's name in discussing Stern and his candidacy, was editorial content fully protected by the First Amendment. The Court, citing the leading case that deals with online services, *Cubby Inc. v. CompuServe, Inc.*, 776 F. Supp. 135 (S.D.N.Y. 1991), agreed that an online service, even one where only paid subscribers may access the information services, is like a book store or a letter to the editor column in a newspaper. No permission is necessary to use the name of an individual in connection with such material. In *Cubby* the Court held: "A computerized database is the functional equivalent of a more traditional news vendor, and the inconsistent application of a lower standard of liability to an electronic news distributor. . . than that which is applied to a public library, book store or news stand would impose an undue burden on the free flow of information." 776 F. Supp at 140. This of course goes to the chat service aspect of the Delphi service as opposed to a web site's editorial material, but a publisher's own editorial material is certainly entitled to the same protection as the letters to the editor. *Daniel v. Dow Jones & Co.*, 137 Misc. 2d 94, 520 N.Y.S.2d 334, 340 (N.Y. Civ. Ct. 1987) (news and information aspect of online services are entitled to the same protection as a newspaper).

ART

Art and drama are also protected by the First Amendment. *Comedy III Prods. Inc. v. New Line Cinema*, 200 F. 3d 593 (9th Cir. 2000) (Three Stooges film clip in a film); *ETW Corp. v. Jireh Publ. Inc.*, 332 F.3d 915 (6th Cir. 2003)(5,000 copies of “limited edition” Tiger Wood Lithograph was art); *Hampton v. Guare*, 600 N.Y.S.2d 57 (1993) (play “Six Degrees of Separation” based on actual story); *Joplin Enterpr. v. Allen*, 795 F. Supp. 349 (W.D. Wash.) (play based on life of Janis Joplin); *Costanza v. Seinfeld*, 719 N.Y. 2d 29 (1st Dep’t 2001) (TV show inspired by actual persons). Comic books have also been recognized as an artistic use not mere “advertising or trade.” See *Winter v. D.C. Comics*, 30 Cal. 4th 881, 69 F.3d 473, 134 Cal. Repr. 2d 634 (2003). *But see Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (Former NHL Player Tony Twist has right of publicity claim arising out of villainous character with same name in comic books).

Use of celebrity name in titles has been held to be subject to a “reasonable relationship” test to avoid a right of publicity claim. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (reversing district court dismissal and holding that jury must decide whether there was a reasonable relationship between use of Rosa Parks’ name in title of song and content of song).

Use of a celebrity in art must be “more than mere celebrity likeness.” See *Winter v. D.C. Comics*, 30 Cal. 4th 881, 69 P.3d 473, 134 Cal. Repr. 2d 634 (2003) (half-worm comic book characters “Johnny and Edgar Autumn”). The California Supreme Court found that the use was sufficiently “transformative.” – the value to the consumer is more than or different from just a likeness of the celebrity. *But see Comedy III Prods, Inc. v Gary Saderup, Inc.*, 25 Cal 4th 387 (2001) (lithographs and T-Shirts with lithograph of The Three Stooges faces were not sufficiently transformative).

AVOIDING THE NEED FOR A LICENSE

ARTIST'S EXCEPTION

Use of an artist's name and likeness in connection with truthful advertising of the sale or the showing of the artist's works is generally not actionable and probably protected by the First Amendment. Thus you can promote the sale of a book, or motion picture or musical recording by

using the name and likeness of a performance in the work. *See Shaw v. Time/Life Records*, 38 N.Y.2d 201, 379 N.Y.S. 2d 390 (1975); Restatement (Third) of Unfair Competition §47 Comment (a).

You may be able to advertise that you are selling or giving away the celebrity's product *See Astaire v Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997), *cert. denied*, 525 U.S. 868 (1998) (advertising instructional dance video tapes), but you must avoid any implication that the celebrity himself is involved in the advertising campaign. *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (use of Woody Allen's name and photo on videocassette of his films appearing in an advertisement for video rental stores is permissible, but together with the use of look-alike raised likelihood of confusion as to his endorsement of the advertiser); *See Rostropovich v. Koch Int'l Corp.*, 1995 U.S. Dist LEXIS 2785, U.S.P.Q. 2d 1609 (S.D.N.Y. 1995) (literally true, but could confuse as to artist's approval of the new release of old recordings).

MEDIA EXCEPTION

Truthful advertising of the content of a media publication is protected by the First Amendment, provided that the advertising is a truthful description of the content of the medium. *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 40 Cal. Rptr. 2d 639 (Cal Ct. App. 1995) (newspaper's use of a poster of football star permissible as advertising of its content): The person used must be a subject presented or discussed in the publication. *Cohn v. National Broadcasting Co.*, 50 N.Y. 2d 885, 430 N.Y.S.2d 265 (1980) (Use of Roy Cohn's name in advertising TV movie about Sen. Joseph McCarthy that included Cohn was permissible). In addition, the advertising must be limited to an explanation or illustration of the content of the publication. *Namath v. Sports Illus.*, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1st Dep't 1975), *aff'd*, 39 N.Y. 2d 897, 386 N.Y.S.2d 397 (1976) (*Sports Illustrated* subscription advertising could use Joe Namath's picture and name in describing coverage of Namath); *see Booth v. Curtis Pub. Co.*, 11 N.Y.2d 907, 228 N.Y.S.2d 468 (1962); *Stein v. Delphi, supra* (advertising of chat line subject is permissible). A medium cannot use any photography merely because it has appeared in the medium, and it cannot use the people who appear in publication as models or endorsers. *See Velez v. VV Pub. Corp.*, 135 A.D. 2d 47, 524 N.Y.S. 2d 186 (1st Dep't 1988). The exception is limited to actually illustrating or describing the subject matter covered by the medium

and the advertising is promoting a constitutionally protected use of the person's identity. See *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994).

False advertising loses First Amendment protection. *Cher v. Forum International, Ltd.*, 692 F.2d 634 (9th Cir. 1982) (False claims in ad promoting an interview of Cher in a magazine resulted in violation of her publicity rights.) See *Eastwood v. Nat'l Enquirer*, 123 F.3d 1249 (9th Cir. 1997) (falsely representing an interview was an exclusive).

FOREIGN CITIZENS

Canada and France have recognized certain rights in the nature of commercial appropriation. Great Britain and many other countries do not, though the trend is toward recognizing this or analogous rights. Indeed, Great Britain recognizes claims for breach of commercial "confidence," which may lead to same result. Harmonization of European law mandated by the European Community also has expanded the reach of right of publicity and analogous protection. In addition, many countries have unfair competition, passing off, or false endorsement principles which may be applied. Choice of law principles should require use of the law of the individual's domicile. See *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013 (C.D. Cal. 1998), *aff'd*, 216 F.3d 1082 (9th Cir.1999) (no right of publicity for estate of Princess Diana, but Lanham Act and state unfair competition claims are not precluded). However, some courts have held that where a license has been granted for use in the U.S., there is a claim. *Bi-Rite Enterprises, Inc. v. Bruce Miner Co.*, 757 F.2d 440 (1st Cir. 1985) (company with exclusive license to exploit certain English rock stars could despite the absence of any rights under English law enjoin sale of product with their likeness under law of states where licensee resides); see *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983); *Apple Corps v. Button Master*, 998 U.S. Dist. LEXIS 3366, 47 U.S.P.Q. 2d 1236 (E.D. Pa. 1998).

DECEASED

There is a growing trend toward the recognition of a post-mortem (after death) right of publicity. Until fairly recently only a handful of states offered this protection, but many now recognize a descendible right of publicity, by explicit statute or under common law. New York does not recognize such a right, but will look to the law in the state of the claimant's domicile at the time of death. Among these states are the following but it is important to check recent case law and legislation:

California - 70 years after death. California also provides for registration by the heirs. Cal. Civ. Code § 3344.1 (d), formerly codified at §990(d). (Also a common law right, according to the Federal Courts).

Connecticut - common law (Federal Court).

Florida - 40 years. But only if spouse, issue or bequest. S.A. § 540.08.

Georgia - common law.

Illinois - 50 years. 765 Ill. Comp. Stat. § 1075/1.

Indiana - 100 years. (Without regard to where estate is located, statute includes distinctive appearance, gestures and mannerisms). Code § 32-12-1 and 32-13-1-1.

Kentucky - 50 years. R.S. § 391.170.

Nebraska - no stated limit. R.S.A. §§ 20-208, 202.

Nevada - 50 years (without regard to where estate is located). R.S.A. § 598.984(i).

New Jersey - common law (Federal Court).

Ohio - 60 years. Rev. Code § 2741.

Oklahoma - 100 years. Stat. Tit. 12 § 1448(G).

Tennessee - (Elvis Presley) statute extends for 10 years, and, if used during that 10-year period, extends indefinitely until 2 years of non-use. Code § 47-25-1104.

Texas - 50 years. Prop. Code § 26.012(d).

Utah - common law (Federal Court).

Virginia - 20 years. Code § 8.01-40.

Washington - 10 for all; 75 for persons whose identity has “commercial value”

The following states have rejected claims for a descendible right of publicity: Mass., N.Y., R.I. and Wis. by statute; Pa. by Federal Court decision; and Ariz., La. and Wash. by defeating legislation proposing to enact it. See Rest. (3d) of Unfair Competition Tentative Draft No. 4 § 46 Comment (h). Be sure to check recent case law and statutory developments.

What law applies? Most properly the law of the state of the person's estate applies, but Courts may not always follow this rule. Nevada and Indiana statutes provide that this rule is not applicable. Under prevailing conflicts of law provisions applied in most, but not all states the existence of a post mortem right of publicity should be determined by the law of the domicile of estate. *See Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013 (C.D. Cal. 1998), *aff'd*, 216 F.3d 1082 (9th Cir.1999). In New York, the law of the state of domicile of the subject governs the issue as to whether a post-mortem right of publicity applies. *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 498 N.Y.S. 2d 775 (1985). *See Schwartzenegger v. Fred Martin Motor Co.*, 2004 U.S. App. LEXIS 13473 (9th Cir. 2004).

PUBLIC FIGURE

Unauthorized use of name or likeness of public figures and public officials in advertising technically violates right of privacy. Politicians are frequently used and have not sued, but letters demanding that use be stopped (*e.g.*, U.S. President) are likely. A bona fide commentary on an issue of public importance may be given First Amendment protection. *Paulsen v. Personality Posters, Inc.*, 59 Misc. 2d 444 299 N.Y.S.2d 501 (Sup. Ct. New York Co. 1968) (Poster of candidate for President not prohibited use for purposes of trade); *See N.Y. Magazine v. MTA*, 136 F.3d 123 (2d Cir. 1998), *cert. denied*, 525 U.S.824 (1998) (Bus posters: "Possibly the only good thing in New York Rudy hasn't taken credit for. . . N.Y. Magazine logo).

COMPARATIVE ADVERTISING

Showing a competitor's product necessarily includes any model on the package, so there is a limited exception for some comparative advertising. Referencing the competitor's endorser may depend on whether the reference addresses the endorser's qualifications or endorsement.

"NAME"

Any use of a first and last name should be covered by a release from someone with that actual name who is consistent with the portrayal. No matter how fanciful and ridiculous, names often result in claims. Use names of people in the Agency or find someone with that name (phone

books) and get a written release. A release from anyone with the name suffices so long as no one else is more closely identified.

First names generally do not require a release, but where a name identifies a person (Cher, Madonna) you need a release. *See Cher v. Forum International, Ltd.* 692 F.2d 634 (9th Cir.1982), *cert. denied*, 462 U.S. 1120 (1983).

Nicknames, if sufficient to identify a particular person, may be sufficient to support a claim. *See McFarland v. Miller*, 14 F.3d 921 (3d Cir. 1994); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W. 2d 129 (1979).

Former name may also be protected. *Abdul-Jabbar v. GMC*, 85 F. 3d 407 (9th Cir. 1996) (formerly Lew Alcindor).

Context may make a nickname recognizable. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (“Here's Johnny”).

“PICTURE”

Any picture of a person should be covered by a written license.

Recognizable. Not just Face - There may be a claim if anyone recognizes a person. *Cohen v. Herbal Concepts*, 63 N.Y.2d 379, 482 N.Y.S.2d 457 (1984) (Face not shown, but Husband's affidavit that he recognized “Two dimples above her buttocks,” “Long slender neck, slim waist, bony elbows, indented back, short freely flowing hair” was held to be sufficient evidence of recognizability). It is also probably sufficient if a person recognizes himself (statute protects an individual's own sentiments, thoughts and feelings).

Distinguishing feature/context. Distinctive clothing, jewelry or context in which a photo was taken may be sufficient to identify person. *See Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (race car retouched but identifiable makes silhouette of driver in photo recognizable as the race car's owner). *Newcombe v. Adolph Coors Co.*, 157 F.3d 686 (9th Cir. 1998) (baseball pitcher's distinctive windup).

Age. Age difference is irrelevant if it is the person's photograph. *Negri v. Schering Corp.*, 333 F. Supp. 101 (S.D.N.Y. 1971) (photo of movie star taken in 1922 used in 1970).

Portrait. A drawing, even a caricature or cartoon, may be a sufficient basis for a claim. *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); see *Cardtoons, L.C. v. Major League Baseball players Ass'n*, 838 F. Supp. 1501 (N.D. Oklahoma 1993).

Crowd. Some states limit claims to exclude crowd shots. (Cal., Fla., Neb.) However, if a person recognizes himself, there may be a claim.

Exceeding scope of License. On February 1, 2005, a California jury awarded Kindergarten teacher Russell Christoff, who had done a two hour photo shoot for Nestles, \$15.6 million in damages resulting from the use of his image for years on Taster's Choice instant coffee.

STOCK PHOTOS/FILM

Stock photo licenses usually cover only the copyright in the photograph. Do not rely on a claim that the photographer has a release covering any people in the photo. Obtain a copy of the release. Photographers often incorrectly presume that they have an unconditional release. Even where there is a release, the signature may not be genuine. Stock photo house indemnifications are usually limited to the amount of the license fee, and are therefore totally inadequate.

"LIKENESS"

Advertising may include a likeness without using a person's photograph. Any likeness, even illustrations or cartoons, communicating a person's appearance or their participation or endorsement may violate publicity rights. Claims are most likely where a celebrity knows you contemplated using him. In addition, a showing of likelihood of confusion as to authorization by the celebrity is sufficient to state a claim under federal false advertising law (§43(a)(1) of the Lanham Act).

Look-alike. Use of a model made up to look like a celebrity, where the public believes it is the actual celebrity, constitutes a "portrait" or "likeness" of the celebrity. *Onassis v. Christian Dior-New York, Inc.*, 122 Misc.2d 603, 472 N.Y.S.2d 254, (Sup. Ct. New York Co., 1984), *affirmed*, 110 A.D.2d 1095 (1st Dep't 1985)(Dior Campaign included a photograph with actual celebrities and a Jacqueline Onassis Look Alike (circa 1960)).

Disclosed look-alike may be permissible where it is clear that is not the celebrity and it is clear that the celebrity has not authorized the advertisement. *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (no

violation of right of privacy/publicity where “People who would recognize a photograph of Woody Allen would believe this was not his photograph”). (But Woody Allen won summary judgment on his claim that readers were likely to believe that he authorized the use of the look-alike.) A disclaimer of identity may not be sufficient to avoid the likelihood of confusion as to authorization. *Allen v. Men's World Outlet, Inc.*, 679, F. Supp. 360 (S.D.N.Y. 1988) (user bears the burden of proving that a disclaimer is effective in dispelling any confusion as to authorization).

Similarity in appearance may also result in a claim. This usually happens where the celebrity has previously been approached. *E.g., Washington v. Brown & Williamson Tobacco Corp.*, 1984 U.S. Dist. LEXIS 17178, 223 U.S.P.Q. (BNA) 1116 (E.D. Pa. 1984) (Grover Washington sued claiming he would be recognized as appearing in a Kool cigarettes ad featuring another black jazz saxophonist based in part on his having been invited to play at the Kool Jazz Festival.) It may also happen where a particular individual claims to be the most famous example of a particular type. *Prudhomme v. Procter & Gamble Co.*, 800 F. Supp. 390, 394 (E.D. La. 1992) (commercial which identified the chef portrayed could still be the basis for a claim for false advertising and trademark infringement: “The mere existence of a disclaimer will not preclude a finding of consumer confusion.”).

Similarity in costume may provide the basis for a claim. After “the Fat Boys” rap group was contacted for a Miller Light Commercial, they were referenced for purposes of costuming the intended generic group of fat, black rap singers. They sued claiming that their costume, style of performance, music, and persona were imitated, relying on square rhinestone covered eyeglass frames worn by lead signer. *Tin Pan Apple v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990).

Context alone may result in a claim. Volkswagen for an end of year sale commercial (when they play “Auld Lang Syne” the sale ends) negotiated with Guy Lombardo to conduct the band at a New Year’s Eve party. When they failed to reach agreement, they hired an actor who looked nothing like Lombardo. While holding that it was not Lombardo's likeness (3:2), and personality or style of performance is not a likeness, a middle level appeals court in New York was so upset with the agency for going ahead without Lombardo that it twisted the law to give him a claim for wrongful “appropriation of public personality for commercial purposes. . . The imitation is completely unfair, amounts to a deception of the public, and thus exploits [Lombardo's] property right and violates his interest in his public

personality.” *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661. But, New York's highest court has subsequently made clear that there is no such common law right of publicity in New York.

California, however, permits judicial expansion of publicity rights, and the Ninth Circuit has taken context to its outer limits, holding that a robot dressed in an evening gown, wearing large jewelry next to a “Wheel of Fortune” type game board was sufficient for a claim by Vanna White of appropriation of her persona, as well as confusion as to whether she authorized the ad. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *rehearing en banc denied*, 989 F.2d 1512 (1993) (Kozinski, J. dissenting), *cert. denied*, 508 U.S. 951 (1993). See The “Cheers” case which involved two robots in Cheers-like bars licensed by the copyright owner specifically designed to not look like George Wendt and John Ratzenberger). After the District Court compared the actual robots to the two actors and held that the “facial features are totally different,” the Ninth Circuit reversed summary judgment holding that a jury must determine whether they were “sufficiently similar to plaintiffs to constitute their likenesses.” *Wendt v. Host Int'l*, 125 F.3d 806 (9th Cir. 1997), *cert. denied*, 531 U.S. 811(2000)

VOICE

The unauthorized use of a person’s voice in advertising is prohibited under various State laws. E.g. California Civ. Code § 3344.1; New York Civ. Rts. Law §§ 50,51 (amended 1995); Indiana; Nevada; Oklahoma; and Texas.

SOUND-ALIKE

New York does not recognize a claim for use of a sound alike under its statute. See *Tin Pan Apple*, *supra*. Importantly, New York limits rights of publicity to those encompassed in the statute and does not allow parallel common law expansion of those rights. See *Freihofer v. Hearst Corp.*, 65 N.Y.2d 135, 490 N.Y.S. 2d 735 (1985); *Howell v. New York Post Co.*, 81 N.Y.2d 115, 596 N.Y.S.2d 350 (1993). California, on the contrary, specifically permits the courts to expand the right of publicity beyond the statutory protections. California Civ. Code § 3344.1 Thus, the Ninth Circuit, recognizing that the applicable California law prohibited use of voice, but not use of a sound alike, took the liberty of creating a claim under California common law. *Midler v. Ford Motor Co.*, 849 F.2d 460 (1988), *cert. denied*, 503 U.S. 951 (1992). Consequently, use of a sound

alike will be actionable (unless the California state courts reject the Federal court's expansion of California law), at least in California.

Anonymous voice-over. A voice imitation may result in a claim if listeners believe it is a famous person's voice. *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962). Lestoil commercial using an animated duck with voice that sounded like Bert Lahr, supported a possible defamation claim that the commercial suggested he “stoops so low as to do anonymous voice-over, and a claim for passing off/unfair competition by obtaining the “enhanced value” of appearance of Lahr's participation.” Similarly, a radio commercial using an imitation of a famous singer's voice resulted in a jury verdict for appropriation of publicity rights under California law and false, implied endorsement under Federal law, and punitive damages totalling \$2.6 million. *Waits v. Frito Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

Animated character. Mere similarity does not violate publicity rights of the actor. *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973) (actress who played Hazel, a character on TV derived from a comic strip, who sued based on voice used in animated commercial, failed to state a claim). However, recent developments suggest a claim where it can be shown the public may believe that the voice is the actor and therefore he or she has licensed use of the actor's voice or performance. *E.g., Waits, supra*.

Popular song. Although imitation of voice alone does not violate right of publicity, a lawsuit is likely where you have sought permission to use a famous singer's recording. Goodyear Wide Boot tires paid the composer for the right to use a popular song “*These Boots Are Made For Walkin'*”, which was made popular by Nancy Sinatra. They contacted Nancy Sinatra's agent, but could not agree on a price. They produced four commercials for TV and two for radio. Sinatra claimed: 1) deliberate imitations of voice, style of singing, physical appearance, dress, and mannerisms and 2) deceived public to believe she was a participant. The court held: “Imitation alone does not give rise to a cause of action,” and Nancy Sinatra's voice was not distinctive enough to be mistakenly recognized. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970)

Deliberate Imitation may be actionable where the public is misled. In 1985, Ford used songs that were famous in the 1970's in its commercials. One song was “*Do You Wanna Dance*”, a 1972 hit sung by Bette Midler (1972 & 1976 albums). They asked Midler's agent and they were told she

was not interested. In reliance on the *Sinatra* case, they hired one of Midler's back-up singers to imitate Midler's rendition. The Court rejected Midler's claim under the California publicity rights statute. (Statute provides "Photograph" and "Likeness" where it intends to include imitation; "voice" does not include likeness of voice). Instead, it created a common law claim of theft of a property interest, "appropriation of the attributes of one's identity. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 503 US 951 (1992) ("We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated. . ."). The court distinguished the *Sinatra* case on the ground that Sinatra's voice was not as distinctive as Midler's. The *Midler* holding is thus explained by the court's conclusion that the voice in the commercial would be mistaken for Midler's, and the public would be deceived. In this sense it does not go any further than a false advertising (implication of endorsement or participation) claim, *see Allen, supra*, which would have been the basis for the same result if it had been properly pleaded. (Jury award of \$400,000). *Midler* has been rejected as not supportable under New York law. *Tin Pan Apple v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990).

Impersonations on radio may be actionable on a showing of confusion as to the celebrity's participation or authorization. A showing of confusion about whether the celebrity gave permission may be sufficient to convince a jury that people think that the celebrity endorses the product advertised. *Waits v. Frito Lay, supra*.

PERSONA

The Ninth Circuit has extended California common law beyond the scope of California's right of privacy statute to include any claim of commercial appropriation of identity of a celebrity, despite the absence of any use of name, picture, likeness, voice or signature. Although heavily criticized and subject to reversal by the California state courts, there is a significant risk that mere association of a celebrity, without confusion as to endorsement or participation, may be actionable in California federal courts. *Wendt v. Host Int'l*, 125 F.3d 806 (9th Cir. 1997), *cert. denied*, 531 U.S. 811 (2000) (licensed use of "Cheers" characters as animatronic robots designed to not look like actors who played the roles on television is still actionable by the actors associated with characters); *see Newcombe v. Adolph Coors Co.*, 157 F.3d 686 (9th Cir. 1998) (pitcher's distinct wind up depicted in a drawing which otherwise did not depict him); *White, supra*; *Waits, supra*; *Midler, supra*.

IMPLIED AUTHORIZATION OR ASSOCIATION

After resolving issues related to the use of another person's copyrighted material, trademark, name, picture, likeness or voice, you must consider the possibility that your advertising or promotional materials may imply the authorization by, or other voluntary association with, another person or entity. This claim arises under § 43(a)(1) of the Federal trademark statute, otherwise known as the Lanham Act. It provides a cause of action where anyone can establish that a communication "is likely to cause confusion. . . as to the affiliation, connection, or association of [the advertiser] with another [person, firm or organization], or as to the origin, sponsorship, or approval of [the advertiser's] goods, services, or commercial activities by [the other person, firm or organization]." 15 U.S.C.A. § 1125(a)(1)(A).

Thus, although your advertising or promotional materials may avoid a typical trademark infringement action on the basis of likelihood of confusion as to the identity of the manufacturer or marketer of a product, you still may be subjected to liability if consumers think that another entity has a voluntary connection with the advertisement. It is not necessary that the other entity prove that consumers believe it has endorsed the advertised product or service. The entity only has to prove that consumers think it has authorized or agreed to be referenced or implicated in the advertising.

LICENSES: KEY CONSIDERATIONS

1. Nature of Grant of Rights: Right of Publicity, trademarks, etc. limitations?
2. Term
3. Territory (include consideration of internet)
4. Exclusive v. Non-Exclusive
5. Advance
6. Royalty Rate
7. Guaranteed and/or minimum royalties
8. Conditions for renewal
9. Goods/services and channel of trade

10. Quality control and approvals, including foreign manufacture issues
11. Media/promotions support
12. Ownership of materials created under license
13. Insurance
14. Warranties and representations
15. Indemnification
16. Enforcement of Rights
 - who had to do it
 - who pays
17. Termination
 - with and without cause
 - notice and cure
18. Sell-offs after expiration or termination
19. Miscellaneous provisions
 - jurisdiction
 - venue
 - arbitration