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CATCHING SMOKE, NAILING JELL-O TO A WALL: THE *VANNA WHITE* CASE AND THE LIMITS OF CELEBRITY RIGHTS

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The suit brought by Vanna White against Samsung[1] already has achieved considerable notoriety, both in legal circles[2] and in the media.[3] (And, incidentally, it resulted in a not inconsiderable award of money to Vanna White.[4]) With so much having been said already, one hesitates to add to the pile. Yet, the case is a very troubling one and should be commented upon for that reason. In this essay, I propose to explore a few aspects of the case I find most troubling and difficult. By the end, I hope to convince readers not only that this case was decided incorrectly, but also that the court overlooked important differences between this case and other so-called "right of publicity" cases in which recovery was allowed.

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[1] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 23 U.S.P.Q.2d (BNA) 1583 (9th Cir. 1992), *en banc reh'g denied*, 989 F.2d 1512, 26 U.S.P.Q.2d (BNA) 1362 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

[2] *E.g.*, J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 4.15[D] (1994 rev.); William M. Borchard, *The Common Law Right of Publicity is Going Wrong in the United States:* Waits v. Frito-Lay *and* White v. Samsung Electronics, 6 ENT. L. REV. 208 (1992); Patricia B. Frank, White v. Samsung Electronics America, Inc.: *The Right of Publicity Spins its Wheels*, 55 OHIO ST. L.J. 1115 (1994); Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97 (1993); Alexander C. Giftos, Comment, *The Common Law Right of Publicity and Commercial Appropriation of Celebrity Identity: "A Whole New Wardrobe for Vanna"*, 38 ST. LOUIS U. L.J. 983 (1994); John F. Hyland and Ted C. Lindquist III, Note, White v. Samsung Electronics America, Inc.: *The Wheels of Justice Take an Unfortunate Turn*, 23 GOLDEN GATE U. L. REV. 299 (1993).

[3] *E.g.*, Greg Braxton, *Vanna White Ruling Has Impressionists Spinning*, L.A. TIMES, June 4, 1993, at F2; Aaron Epstein, *Cashing in on Celebrities Courts Trouble*, DETROIT FREE PRESS, September 19, 1993, at 1F; Lois Romano, *The Reliable Source*, WASH. POST, June 2, 1993, at B3; Neal Rubin, *Neal Rubin's Names and Faces*, DETROIT FREE PRESS, January 21, 1994, at 10F. *See also White*, 989 F.2d at 1517 n.23 (Kozinski, J., dissenting from denial of rehearing *en banc*) (citing several articles).

[4] Shauna Snow, Morning Report, L.A. TIMES, January 21, 1994, at F2 (reporting jury verdict for $403,000 in favor of Vanna White).

The dispute arose from an advertising campaign for videocassette recorders on behalf of Samsung, a manufacturer of consumer electronic products. The point of the advertising in question was to emphasize that Samsung intended to be a leader in the consumer electronics market for many years to come. Its advertisements featured whimsical (and often farcical) looks at future events, indicating that Samsung still would be around when those events took place. For example, one advertisement showed commentator Morton Downey, Jr. with the caption "Presidential candidate. 2008 A.D."[5] The advertisement that induced the lawsuit featured a robot with a blond wig and gown standing next to a set of capital letters like those on the Wheel of Fortune game show. The caption read "Longest-running game show. 2012 A.D."[6] Vanna White, hostess of Wheel of Fortune, sued Samsung, claiming that the advertisement infringed her commercial right of publicity. Although the advertisement used a *robot* and did not claim that she was a Samsung product endorser, the Ninth Circuit Court of Appeals upheld White's right to sue[7] and, ultimately, a jury awarded her $403,000.[8]

This essay will focus on the kind of use made by Samsung of the "identity" of Vanna White and how it differs from other cases. By permitting Vanna White to recover, the court overlooked necessary limits on the right of publicity. Part I of the essay will focus on a specific problem with *White*—what I call the "metaphoric use" of celebrity. It will be argued that *White* gives protection to a celebrity far beyond what ought to be the core concerns of any right of publicity. The primary problem with such protection is the chameleon-like quality of the right at issue. At various times, it looks and is treated like different types of intellectual property. But, as the right has expanded, it has taken on new shapes that transcend limits on traditional intellectual property rights. When deciding whether to grant a right to the celebrity in a particular case, one appropriately may ask whether this transcendence is

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[5] *White*, 971 F.2d at 1396.

[6] *Id.* The robot clearly was not intended to be a recognizable human being. The only human features were the blond wig, dress and jewelry. *See id.* at 1396-97 (holding it was not "likeness" of Vanna White).

[7] *Id.* at 1402.

[8] Snow, *supra* note 4, at F2.

justified or whether more traditional limits on intellectual property rights should cabin this right as well.

Part II will expand the discussion to the larger issue of the boundaries of the right of publicity, again focusing on the boundaries (or lack thereof) implicit in the *White* case. The *White* decision, and many others, give broad protection to celebrities against any use of their celebrity "status" or "identity," if the use is labeled "commercial." But "commerciality" is a poor proxy for a wrongful appropriation.

We will begin with some background, followed by a focused look at *White* and the specific use of Vanna White's "identity" in that case.

PART I: CELEBRITY AND METAPHOR

A. THE EXPANDING RIGHT OF PUBLICITY

1. In the Beginning. An offshoot of the right of privacy—or, more colloquially, the "right to be left alone"—the right of publicity as a separate doctrine generally is considered to have emerged in a 1953 Second Circuit decision, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*[9] In that case, Judge Frank found an exclusive, assignable right of commercial exploitation of one's name or likeness.[10] He used the term "right of publicity" to distinguish this commercial right from the privacy concept of protection from

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[9] 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). *See* MCCARTHY, *supra* note 2, § 1.7.

[10] *Haelan Labs.*, 202 F.2d at 868. Years earlier, in Pavesich v. New England Life Ins. Co., 50 S.E. 68 (Ga. 1905), the Georgia Supreme Court granted a right of action to a person whose picture had been used without his permission in an advertisement for an insurance company. *Id.* at 79. The advertisement also contained a false endorsement by the plaintiff, Paolo Pavesich. *Id.* at 81. But Mr. Pavesich was not a celebrity and his suit was grounded in the violation of his dignity interest, rather than a misappropriation of his commercial rights. Thus, the case rested on privacy grounds, rather than a right of publicity. (Moreover, the court expressly declined to decide whether a celebrity, a public character, would have any less right to an injunction in similar circumstances. *Id.* at 79-80.) However, one can see that the right of privacy and right of publicity are not entirely distinct. *See also* Edison v. Edison Polyform Mfg. Co., 67 A. 392, 394 (N.J. Eq. 1907) (injunction granted to Thomas Edison against company using his name without permission and false endorsement). By contrast, New York's courts resisted giving plaintiffs this same claim. Roberson v. Rochester Folding Box Co., 64 N.E. 442 (1902).

an invasion of one's personal enclave of solitude.[11] Two influential law review articles followed the *Haelan* decision, one by Melville Nimmer[12] and one by William Prosser.[13] Prosser's article recognized that the appropriation tort at the root of the right of publicity fundamentally differed from the conventional privacy torts.[14] However, he still categorized it as a form of "privacy" tort, rather than as a separate and distinct claim.[15] Shortly after the *Haelan* decision, Nimmer argued that limitations on the privacy tort and other available torts made them unsuitable vehicles for protecting rights of publicity.[16] He asserted that the right of publicity should be treated "as a property (not a personal) right."[17] His rationale for such protection was that publicity values normally are the result of expenditures of time and effort by the celebrity and the celebrity should be "entitled to the fruit of his labors, unless there are important countervailing policy considerations."[18]

From these roots a rather large tree has grown. No consistent doctrine has evolved that is followed in substantially all states.[19] However, many states have recognized some form of a right to control the commercial exploitation of one's name or likeness.[20] Most of the states have acceded to this through common law

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[11] *Haelan Labs.*, 202 F.2d at 868.

[12] Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

[13] William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

[14] Prosser divided privacy into four categories: intrusion into one's "solitude," disclosure of embarrassing facts, false light, and appropriation. *Id.* at 389. *See also* MCCARTHY, *supra* note 2, § 1.5.

[15] A California state court case from 1983, Eastwood v. Superior Court, 149 Cal. App. 3d 409, (1983), used the Prosser categories to describe a right of publicity claim. *Id.* at 416. However, the court also referred to the claim as one for infringement of a "right of publicity." *Id.* at 413. *See also* Lugosi v. Universal Pictures, 603 P.2d 425, 428 (Cal. 1979) (also using Prosser's four categories).

[16] Nimmer, *supra* note 12, *passim*.

[17] *Id.* at 216.

[18] *Id.* For a critical view of this argument, see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 182-96 (1993) [hereinafter Madow, *Publicity Rights*].

[19] There is no *federal* right of publicity as such. However, under § 43(a) of the Lanham Act (the federal trademark statute), 15 U.S.C. § 1125(a) (1994), a celebrity can bring a claim if he or she believes that an advertiser falsely implied that the celebrity has endorsed a particular product. *See* White v. Samsung Elecs. Am., Inc., 971 F.2d, 1395, 1399-1401 (9th Cir. 1992) (discussing § 43(a) claim), *cert. denied*, 113 S. Ct. 2443 (1993).

[20] MCCARTHY, *supra* note 2, § 6.1[B] (24 states).

development;[21] ironically, New York, whose law the *Haelan* court ostensibly interpreted, recognizes only a statutory right.[22] The U.S. Supreme Court recognized the existence of right of publicity claims in *Zacchini v. Scripps-Howard Broadcasting Co.*[23] *Zacchini* examined the extent to which the First Amendment limited the right of publicity granted under state law; it did not create an independent federal law of publicity rights. The *Zacchini* decision has been credited, however, with spurring interest in using the right of publicity by attorneys and judges.[24] The recent expansion of this right to the point reached in the *White* decision prompts this discussion.

2. Recent Expansion.[25] *White* is one of a series of recent Ninth Circuit decisions expanding the rights of celebrities to control their images.[26] In *Motschenbacher v. R. J. Reynolds Tobacco Co.*,[27] the plaintiff, a famous race car driver, claimed that a cigarette ad using a *car* identifiable as one usually driven by plaintiff infringed his right of publicity. With little discussion, the Ninth Circuit agreed that California law "afford[ed] legal protection to an individual's

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[21] *Id.*

[22] Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 (N.Y. 1984). At least twelve other states have statutes protecting rights of publicity. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, statutory note at 536 (1995) [hereinafter RESTATEMENT]. Not all are as restrictive as New York's statute. MCCARTHY, *supra* note 2, § 6.2.

[23] 433 U.S. 562 (1977).

[24] MCCARTHY, *supra* note 2, § 1.10[B], at 1-44.

[25] The discussion below of recent cases does not purport to be comprehensive. Its focus is on Ninth Circuit cases and a few cases from other courts demonstrating the potential breadth of the right of publicity. For a lengthier discussion of recent cases, see MCCARTHY, *supra* note 2, *passim*; Giftos, *supra* note 2, at 983, 993-1001.

[26] *E.g.*, Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992) (upholding singer's right to sue), *cert. denied*, 113 S. Ct. 1047 (1993) 168 U.S.P.Q. (BNA) 12; Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (same); Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (upholding car driver's right to sue); *cf.* Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) (denying right of publicity claim by Nancy Sinatra); Nurmi v. Petersen, 10 U.S.P.Q.2d (BNA) 1775 (C.D. Cal. 1989) (denying right of publicity claim under California law). This expansion is not confined to the Ninth Circuit. *E.g.*, McFarland v. Miller, 14 F.3d 912, 29 U.S.P.Q.2d (BNA) 1586 (3d Cir. 1994) (finding right of publicity in character applying New Jersey law); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 218 U.S.P.Q. (BNA) 1 (6th Cir. 1983) (holding no use of name or likeness needed applying Michigan law); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970) (using names and statistics of ball players in board game).

[27] 498 F.2d 821 (9th Cir. 1974).

proprietary interest in his own identity."[28] Finding that the advertisement uniquely identified plaintiff, the court held that plaintiff could proceed with his claim.[29] The court at least hinted broadly that the heart of the claim was false endorsement; the court noted that "part of [plaintiff's] income" derived from endorsements[30] and that plaintiff submitted affidavits averring an assumption that plaintiff endorsed defendant's products.[31]

Motschenbacher provided the springboard for the decision in *Midler v. Ford Motor Co.*,[32] where the court upheld singer/actress Bette Midler's right to sue Ford. Ford had hired a singer to imitate Midler's voice, and to sing in a Ford radio commercial a song known to be sung by Midler.[33] The court relied heavily on its *Motschenbacher* opinion in concluding that Ford unlawfully appropriated "part of [Midler's] identity."[34] Not surprisingly, *Midler* was the primary authority for a case that immediately followed *White, Waits v. Frito-Lay, Inc.*[35] In *Waits*, Frito-Lay hired a singer to imitate the voice and "style" of Tom Waits, but not to sing a song connected with Waits.[36] Despite this difference—and its expansion of the celebrity's right to control his or her

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[28] *Id.* at 825. The court cited a string of California cases in footnotes, *id.* at 823 n.6, 824 nn.7 & 8, but did not discuss any of them in the body of the opinion. Footnotes 7 and 8 very briefly discussed two opinions; footnote 6 was simply a string cite without meaningful discussion.

[29] *Id.* at 826.

[30] *Id.* at 822.

[31] *Id.*

[32] 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 503 U.S. 951 (1992).

[33] *See id.* at 461 (discussing hiring of "sound alike" to sing "Do You Want to Dance"). Ford originally tried to hire Midler herself but she turned down Ford's offer. *Id.*

[34] *Id.* at 464. Beyond saying that one who appropriates a well known singer's voice to sell a product is liable in tort, the court did not identify the true "wrong" committed. *Id.* at 463. Not all jurisdictions recognize a claim for voice imitation. *See* Maxwell v. N.W. Ayer, Inc., 605 N.Y.S.2d 174, 176-77 (N.Y. Sup. Ct. 1993) (no such claim under New York law). In an earlier case, Booth v. Colgate-Palmolive Co., 362 F. Supp. 343, 179 U.S.P.Q. (BNA) 819 (S.D.N.Y. 1973), a federal court in New York held that a commercial's imitation of an actress's voice as she portrayed a television character was not actionable. *Id.* at 347 (Shirley Booth complaining of commercial imitating her voice as "Hazel").

[35] 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

[36] *Id.* at 1097.

voice—the court found *Midler* to be controlling.[37]

Thus, the broadly defined right given to Vanna White can be seen as a link in a chain of continually more expansive decisions by the Ninth Circuit in this area. As in *White*, these cases did not involve the use of an *actual* picture, likeness, accessory (car) or voice of the celebrity. Nevertheless, because advertisers led the public to believe that the celebrity actually was the source, the court held that a claim could be brought. Moreover, the Ninth Circuit panels continually wrote of protecting a celebrity's "identity," which is a more amorphous (and potentially more expansive) concept than name or likeness.

The expansion of rights of publicity under state law is not limited to the Ninth Circuit.[38] In *Uhlaender v. Henricksen*,[39] the court granted a judgment against the manufacturer of a baseball simulation game. The game used the names, team affiliations and statistics of actual players (which are matters of public record[40]). The court described the protection offered celebrities in broad terms: "Defendants have violated plaintiffs' rights by the unauthorized appropriation of their names and statistics for commercial use."[41] It apparently assumed that a "commercial use" constituted a per se wrongful appropriation.

In *McFarland v. Miller*,[42] the actor who once played the role of

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[37] *Id.* at 1102. *Midler* focused on the imitator singing a "trademark" song of Bette Midler. In *Waits*, the imitation was of the singer's voice and "style," with all of the lack of definition inherent in that term, as aspects of a claim. Copying style alone, however, apparently would not have been sufficient. *See id.* at 1100-01 & n.2. *See also* Lombardo v. Doyle, Dane & Bernbach, Inc., 396 N.Y.S.2d 661 (N.Y. App. Div. 1977) (musical "style" of Guy Lombardo appropriated). *Cf.* Romm Art Creations Ltd. v. Simcha Int'l, Inc., 786 F. Supp. 1126, 22 U.S.P.Q.2d (BNA) 1801 (E.D.N.Y. 1992) (granting protection under § 43(a) of Lanham Act to artistic style). On the other hand, *Waits* contained the undercurrents of a false endorsement through the use of a good imitation of his *voice* alone. *Waits*, 978 F.2d at 1103 (friends of Waits thought he was endorsing Frito-Lay products).

[38] Or, as Judge Kozinski of the Ninth Circuit so colorfully described it, the "Court of Appeals for the Hollywood Circuit." White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1521 (9th Cir.) (Kozinski, J., dissenting from denial of rehearing *en banc*), *cert. denied*, 113 S. Ct. 2443 (1993).

[39] 316 F. Supp. 1277 (D. Minn. 1970).

[40] *See id.* at 1279 (defendant asserted statistics are published regularly in newspaper).

[41] *Id.* at 1283. *See* Palmer v. Schonhorn Enters., Inc., 232 A.2d 458, 462 (N.J. Super. Ct. Ch. Div. 1967) (use of names and biographical data of famous golfers in golf game violated rights of publicity).

[42] 14 F.3d 912 (3d Cir. 1994).

"Spanky" in the "Our Gang" movie series and in the "Little Rascals" television series sued the owner of a restaurant named "Spanky McFarland's."[43] The court ruled that an "actor [may] obtain[] an interest [in his stage or screen persona] which gives him standing to prevent mere interlopers from using it without authority."[44] Thus, the court allowed one's stage "identity" to become the basis of a publicity right.[45]

Carson v. Here's Johnny Portable Toilets, Inc.[46] also extended the right of publicity beyond simple name or likeness appropriation. A portable toilet manufacturer marketed a product called "Here's Johnny," an obvious play on the "Tonight Show" host introduction.[47] The court of appeals reversed the district court's dismissal of the complaint, finding a claim under Michigan law for violation of Carson's right of publicity. Notably, the appellate court *upheld* the lower court's determination that there was no likelihood of consumer confusion.[48] Moreover, the court rejected a claim based on a right of privacy for embarrassment.[49] Nevertheless, it found a right to recover under the right of publicity. The court stated its rationale as follows: "It is our view that, under the existing authorities, a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes."[50] The ambiguous phrase "appropriated for commercial purposes" is subject to many interpretations, as is evident by the result in *White*.

The focal point of the court's discussion of the right of publicity in *White* was whether a celebrity could recover without showing

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[43] *Id.* at 916.

[44] *Id.* at 920 (footnote omitted). *Cf.* Lugosi v. Universal Pictures, 603 P.2d 425, 432 (Cal. 1979) (Mosk, J., concurring) (expressing doubt about publicity right in character not of actor's own creation).

[45] The court also held that New Jersey law would permit that right to survive the death of the plaintiff. *McFarland*, 14 F.3d at 917-18.

[46] 698 F.2d 831 (6th Cir. 1983).

[47] "Here's Johnny!" was the standard introduction of Johnny Carson by Ed McMahon on the Tonight Show. *Id.* at 832. To make the connection more obvious, the product also was denoted the "World's Foremost Commodian." *Id.* at 833.

[48] *Id.* at 833-34. This is a necessary predicate for claims of false endorsement under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

[49] *Carson*, 698 F.2d at 834.

[50] *Id.* at 837.

that her "name or likeness" had been appropriated.[51] The court cited to its earlier decisions in *Midler* and *Motschenbacher* as examples of cases where right of publicity claims were upheld, though the plaintiff's name or likeness had not been appropriated directly.[52] The court concluded that the linchpin of the claim was the appropriation of the "celebrity['s] identity value,"[53] no matter how that identity is evoked. Where *White* first departs from the earlier Ninth Circuit decisions is in the definition of identity. Although the advertisement used a robot in a blond wig and evening gown, not a recognizable human being, the court still found an appropriation of identity. All that was necessary was that the advertisement taken as a whole, in this case including the fact that the robot was in a Wheel of Fortune set, evoked the image of Vanna White.[54] Apparently, the court found the following a sufficient justification for its result:

> Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's *sole right* to exploit this value [i.e., the value of being a celebrity] whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.[55]

Once the court determined that a right of publicity claim could be founded on something other than appropriation of one's name or likeness, it engaged in little discussion of any other limits inherent in such a claim. The court brushed aside a First Amendment

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[51] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1397-99 (9th Cir. 1992).

[52] *Id.* at 1397-98. The court also cited Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983), as an example of a right of publicity claim without a name or likeness appropriation. *White*, 971 F.2d at 1398.

[53] *White*, 971 F.2d at 1399.

[54] The court gave an example that it thought was analogous—an advertisement using a recognizably male robot with "an African-American complexion, . . . a bald head . . . wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23." *Id.* at 1399. The court asserted that the obvious association with Michael Jordan was the same sort of association evoked by the Samsung ad. *Id.* This analogy is discussed further, *infra* text, at notes 63-68.

[55] *White*, 971 F.2d at 1399.

defense based on the advertisement as a parody. The court's one paragraph discussion of this issue was summed up this way: "Defendant's parody arguments are better addressed to non-commercial parodies. The difference between a 'parody' and a 'knock-off' is the difference between fun and profit."[56]

B. VANNA WHITE AS A METAPHOR

In *White*, the court regarded *Midler* and *Motschenbacher* as important precedents for its decision. However, the court overlooked two critical distinctions between Vanna White's claim and those made in *Midler* and *Motschenbacher*. First, in the two earlier cases there was an element of deception. In *Motschenbacher*, the defendant apparently tried to imitate a race car known to be driven by the plaintiff. In *Midler*, the defendant set out to convince the public that Bette Midler herself was singing in the background.[57] No such deception existed in *White*. Samsung was not trying to fool anyone into believing that the robot actually was Vanna White (and it is difficult to imagine even the most gullible person being so deceived, given the nature of the robot).[58] The court should have been aware that "calling to mind" a celebrity is different than making one believe that it *is* the celebrity, or that there is a connection between the ad and the celebrity.[59]

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[56] *Id.* at 1401 (footnote omitted).

[57] Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988). *Waits*, a subsequent case, contained the same element of deception. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098 (9th Cir. 1992) (describing wrong as "a deliberate imitation of Waits' voice"), *cert. denied*, 113 S. Ct. 1047 (1993).

[58] The robot is pictured in an Appendix to Judge Kozinski's opinion, dissenting from the denial of rehearing en banc. *White*, 989 F.2d at 1523. It is true that the Ninth Circuit found that White stated a claim for false endorsement under § 43(a) of the Lanham Act. 971 F.2d at 1399-1401. However, that ruling most charitably can be described as strained. The court cited no evidence in the record indicating either an intent to confuse on the part of Samsung or a likelihood of confusion on the part of consumers (such as a survey). *Id.* at 1400-1401. Rather, the court stressed that other celebrities whose likenesses were used in the advertisement series were paid for this use—a fact of which consumers would likely have been aware. *Id.* at 1401. To allow an inference of confusion on such meager evidence implies that the court simply thought it was unfair that some celebrities were paid while Vanna White was not.

[59] The Ninth Circuit upheld, however, White's right to a trial on her claim for false endorsement. *Id.* at 1399-1401. *See supra* note 58 (discussing court's analysis of false endorsement).

The second, and crucial point, however, is that the use made by Samsung of White's identity differed markedly from the use of celebrity identities in other cases. Typically, when an advertiser uses a celebrity (or a deceptively similar imitation) in an advertisement, it has one overriding reason in mind—the celebrity projects an image, or "star quality," that embodies certain qualities with which the advertiser wishes to associate its products.[60] These qualities need not be explicit. In *Midler*, the imagery of Bette Midler may have combined dynamism and nostalgia.[61] In *Motschenbacher*, no doubt the imagery of a race car driver fit the outdoor, exciting image desired by a cigarette company. In *McFarland*, though the association was with a character, not the actual person, evidently the defendant restaurant wanted to use the positive nostalgia of the "Our Gang" characters as part of a movie star motif for the establishment.[62]

This associational underpinning is why the hypothetical contained in the Ninth Circuit's opinion in *White* fails as an analogy to the actual facts. The court asked us to "[c]onsider a hypothetical advertisement . . . run on television during professional basketball games" using a robot recognizable as representing Michael Jordan.[63] If a Converse or Reebok sneaker advertisement used such a robot simply to compare their shoes with Nike's Air Jordans, or perhaps to deceive consumers into believing that Jordan now endorsed another brand of sneakers, then the concern for infringement of Jordan's right of publicity would be understandable.[64] Moreover, we may logically assume the hypothesized advertisement was not simply a somewhat disparaging parody of Michael Jordan.

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[60] *See* McFarland v. Miller, 14 F.3d 912, 919 (3d Cir. 1994) (suggesting people link celebrities with products they endorse).

[61] *See Midler*, 849 F.2d at 461 (noting Midler had been termed "dynamic" personality and point of advertising was to "make an emotional connection with Yuppies, bringing back memories of when they were in college").

[62] According to the court, the restaurant contained "over 1,000 photos of movie characters, including some of the 'Little Rascals' [and t]he restaurant also displays two [very large] murals of 'Our Gang.' " *McFarland*, 14 F.3d at 916.

[63] *White*, 971 F.2d at 1399.

[64] That the court assumed the hypothetical was like an endorsement is indicated in the paragraph just preceding the example. There the court wrote of advertisers "us[ing] celebrities to promote their products." *Id.* Moreover, Michael Jordan's known commercial ties to various companies would reinforce the endorsement model of the robot advertisement.

Rather, it seems that the hypothetical advertiser wanted to obtain some of the star quality associated with Jordan for its products. Furthermore, Michael Jordan's commercial association with a major manufacturer of basketball sneakers, Nike, is widely known. This fact reinforces the notion that the hypothesized advertiser is seeking to use Jordan's star quality in association with its products (if not a false representation of an endorsement).[65]

In analogizing this hypothetical to White's case, the court omitted critical information—for what purpose is the robot being used? The hypothetical seemed to rely on the associative star quality of Michael Jordan. But that is precisely the distinction from *White*; there, the advertiser, Samsung, was *not* seeking to use the positive star quality values of Vanna White to sell its products. First of all, Samsung was not using Vanna White, the person, at all. It was using the *role* she plays on television—hostess and letter turner.[66] This use does not even rise to the level of a recognizable "character" as was the case in *McFarland*.[67] Second, Samsung was using the role as a *metaphor* for television in the future.[68] It was, in effect, saying "This robot is the future Vanna White." Thus, the purpose was not to associate the qualities of Vanna White with the qualities of Samsung VCRs. Far from it—the purpose was to make a statement, and the role Vanna White plays was a convenient

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[65] Professor Madow also uses a hypothetical Michael Jordan advertisement in his article. Madow, *Publicity Rights*, *supra* note 18, at 234-35. His example—a truthful advertisement by a sneaker company whose sneakers Jordan wore in college—raises a difficult issue. It appears that Jordan's star quality is being used by the hypothetical advertiser. Yet, as Professor Madow notes, permitting a right of publicity claim in this instance suppresses truthful information. *Id.* Although star quality may be a useful starting point for a court, it is not necessarily the only limit to be considered.

[66] *See White*, 989 F.2d at 1515 (Kozinski, J., dissenting from denial of rehearing *en banc*) ("The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.").

[67] It is unclear that California law would permit her to recover even if this were a "character," since she did not create the character herself. *See* Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (Mosk, J., concurring) (actor did not create character of Dracula). On the other hand, given the Wheel of Fortune setting, the Samsung advertisement inevitably brings to mind Vanna White. *White*, 989 F.2d at 1515 (Kozinski, J., dissenting from denial of rehearing *en banc*).

[68] It is important to understand that it was not Ms. White per se that was being portrayed but the character that she plays on the television show. *White*, 971 F.2d at 1404 (Alarcon, J., dissenting in part); *White*, 989 F.2d at 1515 (Kozinski, J., dissenting from denial of rehearing *en banc*).

shorthand for that statement.

Rather than the hypothetical put forth by the Ninth Circuit, another hypothetical seems a more apt comparison to the case. Consider the following radio commercial for Samsung products. "In the future, when the Pentium computer becomes the Twentium, when bacon and eggs are health food, when Vanna White has been replaced by a robot, this same Samsung VCR will still be in use!" Would that commercial give rise to a right of publicity claim?[69] I submit that it should not be the basis for imposing any liability.[70] And the thrust of the hypothetical radio commercial is the same as the actual Samsung advertisement; Samsung will be a leader in the future consumer electronics industry. Though the example does not use a series of famous people, it uses the same symbolism, namely, humorous looks at the future. Most important, Vanna White's place in the advertisement is the same as before—a symbol of a job that could be replaced by a machine. No doubt Vanna White was not flattered by the symbolism. However, there is no obvious reason to allow celebrities to exercise complete "spin" control over the way they are perceived by the public.

Thus, the critical difference between *White* and other cases permitting a right of publicity claim is that Vanna White was no more than a literary reference in Samsung's advertisement. Samsung did not exploit her image to gain some positive associational value. Not all *uses* of a celebrity constitute wrongful appropriation. Only those uses that exploit the core commercial value of the celebrity, the star quality, should be questioned. A commercial *use* must be distinguished from a use of the commercial *value* of the celebrity. An advertisement—a commercial use—does not automatically constitute a use of the commercial *value* of the celebrity identity. When the advertisement seeks to associate the positive values of the celebrity with the product, a use of the

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[69] It is hard to imagine even the panel that decided *White* being willing to assume an implied endorsement in such a situation. True enough, that panel permitted a claim of implied endorsement by Vanna White to go forward. *White*, 971 F.2d at 1400-01. However, the hypothetical posed here seems somewhat removed from the facts of *White* regarding possible consumer confusion. Thus, a claim under § 43(a) of the Lanham Act, the federal trademark statute, should fail.

[70] It seems equally ridiculous to posit a successful suit by Intel for trademark infringement for using its "Pentium" mark.

commercial value may be occurring. But where the celebrity is merely a point of reference, the celebrity's commercial value is not being used.

Put another way, it may be that Bette Midler "owns" the right to use her voice as a sales mechanism. Parts of a celebrity's image, however, must be shared with the public. In Vanna White's case, the part of her image that connoted a robotic job is a public image that does not belong to her. Thus, Samsung had a right to use that public domain portion of her image, even in a commercial setting.

The Ninth Circuit did not have to look far afield to find cases making a very similar point. A line of cases in trademark law recognizes the need to give even non-competitors a right to use a trademark to make a linguistic point.[71] A good example is a case decided by the Ninth Circuit at almost the same time it decided the *White* case. In *New Kids on the Block v. News America Publishing, Inc.*,[72] two tabloid newspapers promoted telephone polls about the singing group New Kids on the Block.[73] Both newspaper polls referred to the "New Kids on the Block," and both polls employed 900 numbers, which impose a charge on the caller.[74] The "New Kids" group sued the newspapers and claimed an infringement of its name. The Ninth Circuit upheld a grant of summary judgment for the newspapers and refused to recognize liability for such a use. The court found a "nominative fair use defense" to be applicable where one uses a trademark to describe a product or service "not readily identifiable without use of the trademark."[75] The court

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[71] Use of trademarks in truthful comparative advertising is widely recognized as legitimate. Smith v. Chanel, Inc., 402 F.2d 562, 159 U.S.P.Q. (BNA) 388 (9th Cir. 1968) (maker of fragrance imitating "Chanel No. 5" may use Chanel mark in comparative advertising); *see* Champion Spark Plug Co. v. Sanders, 331 U.S. 125, 73 U.S.P.Q. (BNA) 133 (1947) (permitting second hand dealer in spark plugs to sell reconditioned "Champion" spark plugs without removing original trademark as long as they are clearly marked as reconditioned).

[72] 971 F.2d 302, 23 U.S.P.Q.2d (BNA) 1534 (9th Cir. 1992).

[73] A USA Today poll "asked 'Who's the best on the block?' " and a Star poll queried "Now which kid is the sexiest?" and "Which of the New Kids on the Block would you most like to move next door?" *Id.* at 304.

[74] *Id.* USA Today promised its profits from the poll to charity; the Star made no similar promise. *Id.*

[75] *Id.* at 308. Judge Kozinski, author of the *New Kids* opinion, noted its omission from the *White* panel's analysis. White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1516 & n.20 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993) (Kozinski, J., dissenting from denial of

noted that "it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark."[76]

Another such case is *WCVB-TV v. Boston Athletic Ass'n*,[77] which was cited in *New Kids*. The Boston Athletic Association ("BAA"), which runs the Boston Marathon, sued a television station that intended to broadcast the event (but not under license by the BAA) and promoted its broadcast using the term "Boston Marathon." However, the First Circuit found no evidence that the public would be confused in any way[78] by the station's use of the Boston Marathon mark. In a revealing passage, the court stated:

> As a general matter, the law *sometimes* protects investors from the "free riding" of others; and *sometimes* it does not. . . . Just how, when and where the law should protect investments in "intangible" benefits or goods is a matter that legislators typically debate, embodying the results in specific statutes, or that common law courts, *carefully weighing relevant competing interests*, gradually work out over time.[79]

How would one distinguish these cases from *White*? Apart from the fact that they involved trademarks, not rights of publicity, any distinctions would have to turn narrowly on the facts of *White*. In particular, the *White* court cited these facts as important: (i) the use in a concerted campaign, both print and television; and (ii) Samsung had paid *other* celebrities appearing in these advertisements for the use of their names or likenesses.[80] Neither distinction is convincing. The first does not alter the nature of the use in both cases as a metaphor or shorthand reference. The second is not one about which the *audience* would be knowledgeable.[81] Moreover, using payment of others as decisive begs the essential

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rehearing *en banc*).

[76] *New Kids*, at 306.

[77] 926 F.2d 42, 17 U.S.P.Q.2d (BNA) 1688 (1st Cir. 1991).

[78] Such as by thinking that this television station was the "official" station. *Id.* at 45.

[79] *Id.* (third emphasis added).

[80] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992).

[81] Nor is it likely that the audience would care, given the parody-like nature of the ads.

question—is there anything here to be appropriated?

The Ninth Circuit majority in *White* did not refer to either *New Kids* or *Boston Athletic*. Their absence suggests that the court viewed these cases through a very different lens, one where the crux of the case is the context of the use made of the celebrity identity—i.e., whether the use is deemed commercial or non-commercial. But if the nature of the claim is for *wrongful* appropriation or misappropriation then it should make a difference how the celebrity identity is used. Unfortunately, the Ninth Circuit focused on the fact of use, as if that were conclusive. In doing so, it confused the *means* of appropriation—i.e., whether an actual likeness was used—with the *purpose* of the appropriation.

The *New Kids* and *Boston Athletic* cases recognize principles that ought to apply to publicity rights as well. First, they recognize that trademarks convey information beyond simply the source of goods or services. Second, corresponding to this observation, they recognize that one who does not use the mark as an indication of source, but as a *description* of the services offered by the person, should not be liable for infringement.[82] Similarly, at least regarding advertisements, celebrity rights should not extend to circumstances where the advertiser is not using the associative value of the celebrity's image (the star quality) but instead is using the image to make a linguistic point.[83]

A second line of trademark cases may also be relevant to this discussion. This set of cases determines whether a trademark has become the generic term or symbol for a product or service and thus has lost its protection as a trademark. In other words, generic marks are those that have become the primary means of referring to an object, rather than a unique *source* of the object.[84] In Vanna White's case, she was a means of referring to a concept; she stood

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[82] Along these same lines, the Restatement (Third) of Unfair Competition states that the doctrine of trademark dilution should not apply where the alleged diluting use is not a *trademark* use of the original mark (that is, where it is not being used to indicate the source of the products or services of the allegedly diluting user). RESTATEMENT, *supra* note 22, § 25(2) and cmt. c. at 268.

[83] My limitation to advertisements is meant to limit the focus to trademark-like uses of celebrity images. As discussed below, other uses, resembling copyright uses, would not necessarily fit this framework.

[84] *See* MCCARTHY, *supra* note 2, § 12.01[1].

for the concept. In a way, she was the generic description of a particular idea.

Professor Rochelle Dreyfuss propounds a more elaborate and pertinent discussion of marks as generic expressions of ideas.[85] Briefly stated, she argues that trademarks have an expressive linguistic component transcending their value as source identifiers. This value, she states, should not be monopolized by the trademark owner, but should be available to the public.[86] She points out that our language is peppered with phrases derived from trademarks, for example "Barbie doll" and "Pepsi Generation."[87] Our language is richer for these expressions and the public is the loser if we give total control over such expressions to the trademark owner.

A similar argument could be made for using celebrity images as a form of expression.[88] Celebrities often become metaphors for concepts. "Acting like Clint Eastwood" no doubt conveys an idea to many people.[89] Similarly, Vanna White, in her role on "Wheel of Fortune," conjures up a variety of images. These images are useful shorthands for longer expressions. Thus, when Samsung used a robot in a role recognizable as a substitute for Vanna White, it used that imagery, that shorthand expression, represented by Vanna White. Just as Vanna White cannot control the connotations—good and bad—that surround her image, she should not be able to control the *use* of those connotations, except perhaps to the extent that they are used deceptively or fall within the realm of defamation.[90] To do otherwise grants her a right not grounded in any public interest. To the extent that Samsung's advertisement placed

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[85] Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990) [hereinafter Dreyfuss, *Expressive Genericity*].

[86] *Id.* at 408-09. I should note that this very brief synopsis does not do justice to Professor Dreyfuss' very interesting discussion.

[87] *Id.* at 397.

[88] *See id.* at 400 n.16.

[89] *See* White v. Samsung Elecs. Am., Inc., 989 F.2d 1512 n.6 (9th Cir.) (Kosinski, J., dissenting from denial of rehearing *en banc*) (citing examples of trademarked items used in popular culture), *cert. denied*, 113 S. Ct. 2443 (1993). Among the examples cited in the footnote is a song by Mel Tillis entitled "Coca-Cola Cowboy," with lyrics that include "You've got an Eastwood smile and Robert Redford hair." *Id.*

[90] *Cf.* RESTATEMENT, *supra* note 22, § 25(2) (limiting liability for trademark dilution in many cases to circumstances amounting to defamation, invasion of privacy, or injurious falsehood); *see also* David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531, 557-58 (1991) (discussing trademark tarnishment).

her image in a bad light (by implying that a robot could do her job), the imagery was effective because of an *existing* connotation connected with her image. Though celebrities work hard to maintain an image that they desire, in truth their images represent public perceptions. There is no discernable public interest in permitting those perceptions to be shaped solely by the celebrity. Absent a malicious motivation, a public figure is partly subject to the imagery created by others.

If we allow unlimited control of metaphorical uses of celebrity identities by those celebrities, we surely are limiting our variety of permissible expression with little, if any, noticeable gain to the public. Even the conventionally cited rationales for celebrity control—promotion of celebrity activity, granting the celebrity the fruits of her labor, or unjust enrichment ("reaping where one has not sown")—do not ineluctably support such control. A metaphoric use is not a pure appropriation of the celebrity's identity; the second user has added value to the celebrity symbol by using it in a new way.[91] Thus, any enrichment to the second user is hardly unjust and is not the result of the *celebrity's* labor.[92] And it is hard to imagine that failing to allow such complete control over this use of a celebrity identity would measurably affect the willingness of people to engage in celebrity activity.[93]

Thus, the Ninth Circuit's failure to examine carefully the purpose for which the celebrity was invoked inevitably led to an overbroad concept of the property right of celebrity. Samsung's use of White's identity was not unfair or exploitative. Instead, it was a rational linguistic use that accurately conveyed meaning to Samsung's audience. That meaning transcended any star quality of Vanna White, which should be the heart of the court's protective instincts.

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[91] *See, e.g.*, Madow, *Publicity Rights*, *supra* note 18 at 204-05 (discussing humorous and creative appropriations of celebrity names and likenesses).

[92] The "added value" notion, which is discussed extensively by Professor Madow in his article, shows that absolute control in one person may prevent the adding of value by others. *Id.* at 199-205. This does not seem to serve a public purpose.

[93] *Id.* at 208-15.

PART II: THE SEARCH FOR LIMITS

A. RIGHTS AND BOUNDARIES

The preceding discussion focused on a single problem with *White*—that there was no misuse of Ms. White's "identity" at all. Samsung simply evoked her image as a metaphor, not to gain whatever star quality associations that her image might carry. However, *White* is symptomatic of a larger problem with the right of publicity: it has become a right virtually without limits. To this problem we now turn.

The majority in *White* concluded that California law permitted a suit where the "defendant has in fact appropriated plaintiff's identity."[94] The court went on to say that "[i]t is not important *how* the defendant has appropriated the plaintiff's identity, but *whether* the defendant has done so."[95] And it said that the "sole right" to use commercially the celebrity's "identity" belongs to the celebrity.[96] Having labeled Samsung's use commercial, the court dispensed with the most obvious limit available, the First Amendment.[97] Thus, *White* gives the celebrity a preemptive right not limited either by the means the defendant used or by ordinary needs of expression (except for some uses in media traditionally protected by the First Amendment).[98]

1. Why Not a Broad Property Right? Proponents of broad rights of publicity put forth an appealing argument in favor of such rights that may explain the lack of a limiting principle. They argue the celebrity possesses something—a name, voice, face, or star quality—for which a commercial user is prepared to pay.[99] Therefore,

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[94] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1992).

[95] *Id.* (emphasis in original).

[96] *Id.* at 1399.

[97] *Id.* at 1401.

[98] *E.g.*, Joplin Enters. v. Allen, 795 F. Supp. 349 (W.D. Wash. 1992) (play about life of Janis Joplin); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458 (N.J. Super. Ch. Div. 1967) (game using actual biographical data of famous golfers not protected); Marcinkus v. NAL Publishing, Inc., 522 N.Y.S.2d 1009 (N.Y. Sup. Ct. 1987) (print advertising for book separated from book itself for right of publicity purposes).

[99] *E.g.*, Jerre B. Swann & Theodore H. Davis, Jr., *Dilution, An Idea Whose Time Has Gone; Brand Equity as Protectable Property, the New/Old Paradigm*, 1 J. INTELL. PROP. L. 219, 236 (1994) (quoting Winterland Concessions Co. v. Sileo, 528 F. Supp. 1201, 1213, 213

it is only right that the celebrity be permitted to reap the benefits of possessing this asset. In other words, the law should not interfere with an economically sound, bargained-for exchange that otherwise would occur only by forcing the celebrity to give that asset away for free.[100]

That argument, however, is flawed because it depends on the assumptions that a fair or proper system must recognize the desirability of bargained-for exchanges and that it must *favor* such exchanges. It is almost a natural law conception that the natural order of things must of course favor encouragement of these bargaining exchanges. Indeed, it also resembles a "takings" argument—to interfere with the celebrity's right to sell his or her fame is to destroy a recognizable property right.[101] But one certainly can imagine a rational system of law in which such rights are not recognized.[102] The Framers of the Constitution were not shy about protecting property and expectations. One of the few explicit limits on state authority in the original document is the Contracts Clause, which prevents states from interfering with contractual expectations.[103] The Fifth Amendment prohibits

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U.S.P.Q. (BNA) 813 (N.D. Ill. 1981) (quoting Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977))). *See* MCCARTHY, *supra* note 2, § 2.3. Professor Dreyfuss calls this the "if value, then right" theory. Dreyfuss, *Expressive Genericity*, *supra* note 85, at 405.

[100] Intuitively, this appears strikingly similar to two other arguments in favor of publicity rights: the "reap/sow" argument (one should not reap where she has not sown), International News Serv. v. Associated Press, 248 U.S. 215, 239 (1918), and the "fruits of one's labor" argument. *See* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992) (discussing need for restrictive control); *cf.* Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 352-54, 358, 18 U.S.P.Q.2d (BNA) 1275 (1991) (rejecting "sweat of the brow" theory of recovery under copyright law for compilations of otherwise uncopyrightable facts). However, the latter argument depends on the celebrity having done something to earn the property. The former does not depend on this, but it seems implicit that the legitimate "reaper" (i.e., the celebrity) should have "sown" something herself. In the bargaining model, the celebrity status could have come by accident without affecting the appeal of the argument.

[101] Of course, here the taking is by a private party, not the government, so the analogy is not completely accurate.

[102] *See* White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1517 (9th Cir.) (Kozinski, J., dissenting from denial of rehearing *en banc*) (suggesting panel majority begged question whether White should have right to identity), *cert. denied*, 113 S. Ct. 2443 (1993).

[103] U.S. CONST. art. I, § 10, cl. 1.

taking private property for public use without compensation.[104] Yet, as Professor Madow has shown, eighteenth century common law did not protect a celebrity's image from appropriation.[105]

Moreover, a public interest is at the root of even a strong model of protecting assets by encouraging bargaining. Where the asset is tangible, the model prevents physical battles over possession. After all, one can assert exclusive dominion over tangible property.[106] With intangibles, such a rationale does not work. Many intangibles[107] have attributes of so-called "public goods"; that is, they may be used simultaneously by several people and it is inefficient to prevent people from doing so.[108] Thus, with both tangible and intangible property rights, the principle of exclusivity is not a product of the natural order. Rather it is the result of decisions that society will benefit as a whole from the creation of property rights.[109] Therefore, proponents of broad property rights in publicity value should shoulder the burden of demonstrating that the *public* is best served by the existence of such rights.[110] In

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[104] U.S. CONST. amend. V. This restriction originally applied only to the federal government. Barron v. Mayor and City Council of Baltimore, 32 U.S. (7 Pet.) 243, 250-51 (1833) (holding Fifth Amendment prohibition on taking private property without compensation applies only to federal government). However, it has since been applied to the states. *See* Chicago, B. & Q. R.R. v. City of Chicago, 166 U.S. 226, 234-35 (1897) (prohibiting state taking of private property without compensation using Due Process Clause of Fourteenth Amendment).

[105] Madow, *Publicity Rights*, *supra* note 18, at 148-51.

[106] This does not mean that only one person can have an *interest* in any item of tangible property at one time. *See, e.g.*, JOHN E. CRIBBET & CORWIN W. JOHNSON, PRINCIPLES OF THE LAW OF PROPERTY 1-2 (3d ed. 1989) (discussing various potential interests in "Blackacre").

[107] Some intangibles, like stock certificates, can be viewed as tangibles from the point of view of protection rationales. A stock certificate can be used to represent only one ownership interest at any one time.

[108] *See, e.g.*, G. S. Rasmussen & Assocs., Inc. v. Kalitta Flying Serv., Inc., 958 F.2d 896, 900 (9th Cir. 1992) (discussing public good externality of free-riders), *cert. denied*, 113 S. Ct. 2927 (1993); Apple Computer, Inc. v. Microsoft Corp., 799 F. Supp. 1006, 1025, 24 U.S.P.Q.2d (BNA) 1081 (N.D. Cal. 1992) (same), *modified*, 35 F.3d 1435, 32 U.S.P.Q.2d (BNA) 1086 (9th Cir. 1994), *cert. denied*, 115 S. Ct. 1176 (1995). However, the desire to encourage creation of such intangibles may lead society to grant a degree of exclusive control over such intangibles to one person.

[109] This may overstate the rationale for property rights, especially in land. One might argue, for instance, that property rights result from a property controlling elite with the political or physical power to impose its desires to hold onto land on the legal system.

[110] *Cf.* MCCARTHY, *supra* note 2, § 2.3 (indicating that proponents of broad rights place burden on opponents to show why it should be limited).

both copyright and patent law, Congress granted limited monopolies over intangibles to encourage innovation. Without some monopoly control by the creator, creativity could be stifled. On the other hand, patents and copyrights are limited both in time and in scope.[111] In contrast, publicity rights seem almost unlimited in scope, particularly where the use is labeled "commercial,"[112] and, in many states, they are unlimited in time as well.[113]

Furthermore, the argument in favor of broad publicity rights ignores a salient fact—other intellectual property rights do have reasonably definable limits. Trademark law, by and large,[114] is limited by the requirement that the mark owner show a likelihood

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[111] *E.g.*, 17 U.S.C. §§ 102-07 (1988) (copyright scope); *id.* §§ 302-04 (1988) (copyright duration); 35 U.S.C. §§ 101-03 (1988 & Supp. V 1993) (patentable subject matter); *id.* §§ 154-56 (amended 1995) (patent duration).

[112] *But see* Cardtoons, L.C. v. Major League Baseball Players Ass'n., 868 F. Supp. 1266 (N.D. Okla. 1994) (finding parody defense to right of publicity claim even when use is deemed "commercial").

[113] During the lifetime of the celebrity there is no time limit. States differ about the extent to which the rights are descendible. MCCARTHY, *supra* note 2, § 9.5. *See also* Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1215-37 (1986) (discussing descendability of right of publicity). California has a statute permitting inheritance of publicity rights, but limits the time to 50 years after the celebrity's death. Cal. Civ. Code § 990(g) (West Supp. 1995).

[114] I say it is "by and large" so limited because one aspect of trademark law is not so limited—trademark "dilution." Trademark dilution is an action under state law, available in about half of the states. RESTATEMENT, *supra* note 22, § 25, statutory note at 275. Prohibiting a mark's use on other (usually non-competing) goods and services is a protection against the diminution of the selling power of the mark. *Id.* cmt. c at 278. Statutes protecting trademarks against dilution do not require a showing of likelihood of confusion. *E.g.*, N.Y. Gen. Bus. L. § 368-d (McKinney 1984); Cal. Bus. & Prof. Code § 14330 (West 1987). Although dilution is potentially a very broad form of protection, its use has been limited by two general requirements. First, one must have a famous mark. *E.g.*, Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1049, 24 U.S.P.Q.2d (BNA) 1161 (2d Cir. 1992) (refusing to protect "PM" following analgesic trade name). This would not be a problem for a celebrity. Second, many courts require a showing of "likelihood of dilution." *E.g.*, W.W.W. Pharmaceutical Co. v. Gillette Co. 984 F.2d 567, 577, 25 U.S.P.Q.2d (BNA) 1593 (2d Cir. 1993) (comparing lip balm sold under same name as deodorant); Mead Data Cent. v. Toyota Motor Sales, 875 F.2d 1026, 1030, 10 U.S.P.Q.2d (BNA) 1961 (2d Cir. 1989) (comparing LEXIS computer network to Lexus automobile); Schieffelin & Co. v. Jack Co. of Boca, 850 F. Supp. 232, 251, 31 U.S.P.Q.2d (BNA) 1865 (S.D.N.Y. 1994) (comparing Dom Perignon champagne to Dom Popingnon popcorn sold in champagne bottle). What constitutes "likelihood of dilution" is not well defined, however. Moreover, the lack of a useful analytical structure in general for dilution cases, as well as a correlative lack of a limiting principle, makes it subject to some of the same criticisms presented here. *See generally* Welkowitz, *supra* note 90 (criticizing antidilution statutes).

of consumer confusion between the owner's use and the use claimed to be an infringement.[115] Copyright law is limited by protecting only an *expression* of an idea, not the idea itself[116] and by the fair use doctrine, which permits others to make use of the copyrighted expression under certain circumstances.[117] Patent law is limited by, among other things, a requirement that the invention be a novel one[118] and by the fact that patents last only twenty years.[119] These limits exist for good reasons. The rights granted through the legal system serve the public interest. Congress limited those rights to insure that the public interest is not overtaken by the private interests of intellectual property owners. Thus, trademarks help consumers distinguish the goods and services of various merchants.[120] Confusingly similar marks used by others may distort the marketplace to the detriment of consumers. Patents and copyrights promote invention and expression. On the other hand, the limits imposed on these rights uphold the public's interest in free competition, free expression of ideas, and abhorrence of monopoly control. To give publicity rights greater force than other intellectual property rights, one should put forth a stronger justification than the "I have something that you want" argument.

2. Content and Limits. A recent case, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*,[121] is instructive in the search for appropriate limits. *Cardtoons* denied a right of publicity claim

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[115] 15 U.S.C. §§ 1114(1), 1125(a); *see also*, Eclipse Assocs. v. Data Gen. Corp., 894 F.2d 1114, 1117-18, 13 U.S.P.Q.2d (BNA) 1885 (9th Cir. 1990) (explaining tests for likelihood of confusion).

[116] 17 U.S.C. § 102(b); *see also* CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 68, 33 U.S.P.Q.2d (BNA) 1183 (2d Cir. 1994) (republishing portions of book compiling automobile valuations), *cert. denied*, 116 S. Ct. 72 (1995); Shaw v. Lindheim, 919 F.2d 1353, 1356 (9th Cir. 1990) (television show idea based on other script); Pamela Samuelson, *Reviving* Zacchini: *Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 881 (1983) [hereinafter Samuelson, *Reviving Zacchini*].

[117] *E.g.*, Campbell v. Acuff-Rose Music, Inc., 114 S. Ct. 1164, 1169-70, 29 U.S.P.Q.2d (BNA) 1961 (1994) (musical group using song as parody); 17 U.S.C. § 107. *See also* Samuelson, *Reviving Zacchini*, *supra* note 116, at 883-84.

[118] *See* 35 U.S.C. §§ 101-103 (describing requirements for patentability).

[119] 35 U.S.C. § 154.

[120] Trademark dilution law also recognizes the reciprocal use of trademarks—as selling devices benefitting businesses. *See supra* note 114 (discussing trademark dilution).

[121] 868 F. Supp. 1266 (N.D. Okla. 1994).

based on the sale of parody baseball cards that used caricatures of actual players with names like "Don Battingly" and "Treasury Bonds."[122] Although the court found the cards to be clearly commercial, it held that the players were not entitled to recover for violation of their rights of publicity.[123] The court employed a fair use test drawn from copyright law to determine whether Cardtoons and its cards deserved protection from liability.[124]

Cardtoons informs us that the right of publicity has limits, even when the use of the celebrity image is labeled commercial. *Cardtoons* also demonstrates the importance of context in determining those limits. In *Cardtoons*, the product itself was the source of the problem—the celebrity image *was* the commercial product and not merely a means to enhance the marketability of another product. Thus, Cardtoons' parody cards represent the sale of an expression of the celebrity identity. This use strongly resembles a copyright situation, where the question is whether the allegedly infringing use has copied the expression of the copyrighted work. That a fair use defense seemed appropriate to the court is not surprising.

Cardtoons is not unique in this regard. Many other right of publicity cases present copyright-like situations.[125] One example is *Zacchini*.[126] The local television station was not using Zacchini as an advertising vehicle. Rather, it broadcast Zacchini's act (the expression of his identity), thus depriving him of the value of the expression he had created. By rejecting a First Amendment defense, the Court, in effect, found no fair use of the expression. Other right of publicity cases also emulate copyright, including "poster" cases (defendant sells a poster containing the celebrity's picture),[127] "t-shirt" cases (basically the same as poster cases),

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[122] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 838 F. Supp. 1501, 1512 nn.17 & 18 (N.D. Okla. 1993), *vacated*, 868 F. Supp. 1266 (N.D. Okla. 1994). For the uninitiated, those names referred to Don Mattingly of the New York Yankees and Barry Bonds of the San Francisco Giants. *Id.*

[123] *Cardtoons*, 868 F. Supp. at 1268.

[124] *Id.* at 1271-74.

[125] *See* Samuelson, *Reviving Zacchini*, *supra* note 116, at 850.

[126] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977).

[127] *E.g.*, Factors Etc., Inc. v. Pro Arts, Inc., 652 F.2d 278, 211 U.S.P.Q. (BNA) 1 (2d Cir. 1981) (enjoining sale of Elvis Presley posters), *cert. denied*, 456 U.S. 927 (1982).

"game" cases,[128] celebrity impersonation cases[129] and "unauthorized biography" cases.[130]

The copyright/publicity cases also help explain some of the axioms of rights of publicity that can lead to misuse. One such axiom is that right of publicity claims do not require showing confusion or deception, just appropriation.[131] The copyright-like cases do not require deception or confusion. This is logical because the crux of the problem is the sale of the celebrity image, not its use as an independent marketing device. Nevertheless, by using limits appropriate to the kind of case, as in *Cardtoons*, reasonable boundaries may be imposed.

Cases like *White*, on the other hand, do not fit the copyright pattern. These cases involve using a celebrity image as part of an advertising campaign. Particularly when such uses rely on the star quality association with the celebrity image, such cases strongly resemble trademark cases. These cases use the celebrity as a marketing device, to enhance consumer recognition of an independent product. This use is similar to the function of trademarks. Thus, the tools and limits of trademark law can be helpful models for these cases.

Indeed, the more expansive cases of celebrity rights in the advertising context strongly resemble cases brought under trademark dilution statutes.[132] An action under state law, trademark

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[128] *E.g.*, Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970) (enjoining use of baseball players' names on baseball table game); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967) (enjoining use of professional golfers' names).

[129] *E.g.*, Groucho Marx Prods., Inc. v. Day and Night Co., 689 F.2d 317, 216 U.S.P.Q. (BNA) 553 (2d Cir. 1982) (holding right of publicity not descendible under California law).

[130] *E.g.*, Joplin Enters. v. Allen, 795 F. Supp. 349 (W.D. Wash. 1992) (involving play about life of Janis Joplin). Sports games using celebrity names and statistics, such as *Uhlaender* and *Palmer*, also fit the copyright model. The name of the celebrity is an integral part of the product, rather than just a promotional vehicle.

[131] As to intent, see MCCARTHY, *supra* note 2, § 3.6. As to confusion, see *id.*, § 3.3[A][1], [2].

[132] *See* RESTATEMENT, *supra* note 22, § 46 cmt. c ("excessive commercial use . . . may dilute the value of the identity"). One such case is Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983), a maker of portable toilets named its product "Here's Johnny." Johnny Carson, then host of the Tonight Show, sued, claiming that the use of a phrase associated with him and the Tonight Show (it was part of the introduction used by Ed McMahon virtually every night—"Here's Johnny!") violated his right of publicity. *See id.* at 832. A divided Sixth Circuit panel upheld this claim. It is unlikely that consumers were confused either as to an endorsement of the product by Carson, or even by any implicit "star

dilution protection is available by statute in about half the states.[133] These laws exist to protect the mark against the diminution of its selling power when it is used on other (usually non-competing) goods.[134] Unlike traditional trademark laws, statutes protecting trademarks from dilution do not require a showing of likelihood of confusion.[135] Nonconfusing uses of famous trademarks that clearly are parodies have been enjoined under this doctrine.[136] Even a form of commercial/non-commercial distinction appears in such cases.[137] The analogous concern in right of publicity cases would be overexposure, diluting the possibilities for endorsements.[138]

Recent dilution cases have suffered some of the same defects as right of publicity cases. In both situations, the courts often focus on the fact that the second user has conjured up the image of the original in the mind of the viewer, as if that alone is sufficient to create liability. Often these cases omit a careful analysis of the harm, if any, that accompanies such associations.[139] This simplistic analysis gives both owners of well-known marks and celebrities

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quality association" as used in *Midler* or *Waits*. The court upheld a finding of no likelihood of confusion in this case. *Id.* at 833-34. However, the court still found a violation of Carson's right of publicity because the manufacturer had "appropriated [Carson's] identity for commercial exploitation." *Id.* at 836.

[133] RESTATEMENT, *supra* note 22, § 25, statutory note at 275-76.

[134] *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.13[1][b], at 24-107 (3d ed. 1994). For a discussion of dilution via competing goods, see *id.* § 24.13[2].

[135] *E.g.*, Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 624 & n.5, 217 U.S.P.Q. (BNA) 658 (2d Cir. 1983) (dicta) (suggesting damage is injury to trade name, not consumer confusion); *see supra* note 114 (discussing trademark dilution).

[136] *E.g.*, Deere & Co. v. MTD Prods., Inc., 41 F.3d 39 (2d Cir. 1994) (holding competitor's use of mark in ad was likely to violate antidilution statute); *see* Anheuser-Busch, Inc. v. Balducci Publications, 28 F.3d 369 (8th Cir. 1994) (parody of Michelob trademark held to be both trademark infringement and violation of state dilution statute), *cert. denied*, 115 S. Ct. 903 (1995).

[137] *Deere*, 41 F.3d at 44-45 (distinguishing uses denoted "not for worthy purposes of expression" and "simply to sell products" from those deserving protection).

[138] *Cf.* Madow, *Publicity Rights*, *supra* note 18, at 221-22 (increased use of celebrity in merchandising may increase sales of celebrity related *goods*; over-advertising, however, may lead to lessened advertising value of celebrity).

[139] In trademark dilution, the supposed harm is the whittling away of the marketing power of the trademark. One could make a similar argument in favor of rights of publicity. RESTATEMENT, *supra* note 22, § 46, cmt. c. For a critical evaluation of dilution, *see generally* Welkowitz, *supra* note 90 (discussing trademark tarnishment).

a great deal of control over the use of those marks or identities by other people.[140] On the other hand, important countervailing concerns are surfacing in the dilution area.[141] Although courts have yet to adopt this limitation, the recently promulgated Restatement of Unfair Competition would limit dilution to situations in which the second (diluting) use is a *trademark* use.[142] That is, in order for dilution to apply, the second user must be using the mark as a trademark for its own goods, not merely as a referent to the famous mark's owner or goods. An analogous limit for publicity rights would be that the appropriator must be using the celebrity's image not just to conjure up the celebrity to the viewer, but to project a star quality association between the celebrity and the advertised product.[143] Another limit imposed in some dilution cases is a requirement that the owner of the famous mark introduce some *evidence* that dilution has occurred or is likely to occur.[144] Similarly, a celebrity could reasonably be required to introduce evidence of dilution by overexposure in order to succeed.[145]

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[140] For a recent example, see *Deere*, 41 F.3d at 45 (upholding preliminary injunction against use of altered version of Deere mark used as parody in advertisement by competitor).

[141] *E.g.*, Welkowitz, *supra* note 90.

[142] RESTATEMENT, *supra* note 22, § 25(2). Unfortunately, the courts have not heeded this limitation, thereby creating some of the same problems associated with the right of publicity. *E.g.*, *Deere*, 41 F.3d at 39 (competitor using parody of Deere symbol in advertisement). Notably, while the Restatement says that the reasons for protecting celebrity rights "are generally less compelling than those that justify rights in trademarks," RESTATEMENT, *supra* note 22, § 46, cmt. c, its authors make no attempt to limit the publicity right as they would dilution.

[143] One might also use a copyright analogy here to describe the use made by Samsung of Vanna White's identity. One could view the role that she plays on television—the hostess who turns the letters—as simply a fact. Samsung made use of that fact (and any concomitant public perceptions about such a job) to create its parody. Thus, in copyright terms, it made use of uncopyrightable features—a fact and, possibly, an idea—to create its own work. Just as facts cannot be copyrighted, Vanna White should not be able to control use of facts about her (or the fact that she is the Wheel of Fortune hostess) so easily. *Cf.* Hoeling v. Universal City Studios, Inc., 618 F.2d 972, 979, 205 U.S.P.Q. (BNA) 681 (2d Cir.) (holding one cannot claim copyright in historical facts), *cert. denied*, 449 U.S. 841 (1980).

[144] W.W.W. Pharmaceutical Co. v. Gillette Co., 984 F.2d 567, 577 (2d Cir. 1993); Schieffelin & Co. v. Jack Co. of Boca, 850 F. Supp. 232, 251 (S.D.N.Y. 1994); Black Dog Tavern Co. v. Hall, 823 F. Supp. 48, 59, 28 U.S.P.Q.2d (BNA) 1173 (D. Mass. 1993).

[145] This assumes that there is no deceptive use of the celebrity, for which independent recovery ought to be granted. Apparently, Vanna White did introduce some such evidence at her trial regarding loss of potential electronic goods endorsements. *See* Rubin, *supra* note

The point is that the appropriate analysis and source of limits in right of publicity cases varies depending on context. The general aphorisms about rights of publicity are inappropriate substitutes for a sensitivity to the different situations in which right of publicity claims arise. Whether one uses a copyright model or a trademark model, finding *some* limits that account for the public interest in using the celebrity image is essential. The limitations imposed on rights of publicity need not be exact replicas of those from trademark or copyright law. Trademark law concepts can be adapted, however, to cases involving brand-like associations without damaging the interests of the various parties, and copyright concepts may be used as models for appropriate limits in cases involving copyright-like uses of celebrity images.[146]

3. The Commercial Use Issue. As noted earlier, another problem with *White* that is typical of many right of publicity cases is that courts tend to view most commercial uses of rights of publicity as unworthy of protection. We have already seen that commercial use and use of commercial value may not be the same thing. In addition, the preceding discussion illustrates that attaching near fatal status to the sobriquet commercial use is inappropriate. In *Campbell v. Acuff-Rose Music, Inc.*[147] (on which the *Cardtoons* decision relied), the Supreme Court unanimously held that commercial use did not presumptively mean that a parody was not entitled to the fair use defense under copyright law.[148] Commercial use is simply one factor in the analysis.[149] Although the Court distinguished its "parody as product" situation from a parody contained in an advertisement,[150] it did not state that advertising *should* be a presumptively wrongful use. The Court simply said it

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3, at 10F. Any such losses, however, would appear to be more a result of the critical nature of the parody than a result of overexposure.

[146] Naturally, there will be some line drawing issues. Some cases may not fall easily into one category or the other. Consider, for example, a restaurant that serves food named after celebrities (the Vanna White omelet?). On the one hand, the celebrity is not the product in any direct sense. However, the celebrity's star quality is not really a marketing tool, either. Because the celebrity name is used as the name of the product, rather than to associate it with a unique source, this example most likely fits the copyright model.

[147] 114 S. Ct. 1164 (1994).

[148] *Id.* at 1173-74.

[149] *Id.* at 1174.

[150] *Id.*

would be "less indulgent" of such uses.[151] This observation suggests that the mere invocation of commerciality, or even advertising, should not substitute for a careful examination of other factors that might validate the commercial use of a celebrity's identity. As the dissent in *White* noted, the Supreme Court may give *lesser* protection to commercial speech, but it does not leave such speech unprotected.[152] In particular, where the use is not an associational or star quality use, courts should consider whether the celebrity should be rewarded for a suit motivated more by pique than by lost commercial opportunity.

B. AN END RUN AROUND DEFAMATION?

Finally, in its haste to grant Ms. White a claim for misuse of her identity, the Ninth Circuit overlooked a subtle but troubling undercurrent in the case. This undercurrent is its *departure* from the distinction between a commercial right of publicity and a right of privacy grounded in a dignity interest. Though the right of publicity traces its origins from the right of privacy, the theory of publicity rights evolved rather distinctly from the motivations of rights of privacy. The seminal *Haelan* decision distinguished the dignity interest of rights of privacy from the commercial interest of the right of publicity.[153] As the court noted, "it is common knowledge that many prominent persons . . . far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances [etc.]"[154] Thus, the classic publicity right is, in essence, the right to recover the fee lost when the defendant used the celebrity's name, likeness, etc. without permission to promote defendant's products. Although implicit in this claim may be an understanding that the celebrity has a right to pick and choose among available offers (or to refuse them all), it is the appropriation, not any perceived insult, that

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[151] *Id.*

[152] White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1519-20 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993) (Kozinski, J., dissenting from denial of rehearing *en banc*).

[153] Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

[154] *Id.*

underlies the right.[155]

However, in *White*, one gets the distinct feeling that what motivated the suit was not the commercial aspect of the advertisement, but the comment it made about Vanna White—that a robot could do her job equally well. Thus viewed, the suit is less about commercial misappropriation, as in *International News Service v. Associated Press*,[156] than about a kind of defamation. If so, then, as with defamation, appropriate accommodation should be made for competing values.

White is not unique in this regard. Other cases involving celebrity rights also have appeared to be more like defamation cases than intellectual property cases. Another example is the Ninth Circuit's decision in *Waits v. Frito-Lay, Inc.*[157] Tom Waits evidently was upset at the imitation of his voice primarily because he adamantly refused to endorse products. Thus, the commercial made him look like a hypocrite.[158] Discussing the compensatory damage award to Waits of $375,000,[159] the court expressly held that right of publicity claimants can recover for "humiliation, embarrassment, and mental distress."[160] These are not measures of commercial detriment, but are measures of loss of dignity, such as that associated with defamation.

Still another example is *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, Inc.*,[161] where the defendant marketed busts of the late Dr. Martin Luther King, Jr. without permission. The Georgia Supreme Court,[162] responding to certified questions from the Eleventh Circuit Court of Appeals, acknowledged the distinction between rights of publicity and rights of privacy and the differing measures of damages for

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[155] *See, e.g.*, MCCARTHY, *supra* note 2, § 1.1, at 1-6, 1-7 (calling rights of publicity property rights, possibly grounded in misappropriation and distinct from privacy).

[156] 248 U.S. 215, 239 (1918).

[157] 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

[158] *Id.* at 1103.

[159] *Id.* at 1102-03. Waits also was awarded $2 million in punitive damages. *Id.* at 1104.

[160] *Id.* at 1103 (quoting Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 & n.11 (9th Cir. 1974)).

[161] 694 F.2d 674 (11th Cir. 1983).

[162] The Georgia Supreme Court's answers to the questions can be found in Martin Luther King Jr., Ctr. for Social Change, Inc. v. American Heritage Prods., Inc., 296 S.E.2d 697, 216 U.S.P.Q. (BNA) 711 (Ga. 1982).

each claim.[163] The court also indicated that commercial exploitation of one's name or likeness "for advertising purposes [invokes] not the slightest semblance of an expression of an idea, a thought, or an opinion [protected by the First Amendment]."[164] Thus, the court did not see a conflict with the law of defamation. Nevertheless, overtones of defamation are in the motivations described for the suit: "Here [the plaintiffs] seek to prevent the exploitation of [Dr. King's] likeness in a manner they consider unflattering and unfitting."[165]

In essence, many right of publicity suits resemble claims for intentional (or perhaps negligent) infliction of emotional distress. When such damages are recoverable in a right of publicity case, however, the courts effectively are bypassing the limitations on defamation of public figures created by *New York Times Co. v. Sullivan*[166] and its progeny.

The Supreme Court indirectly addressed this issue in *Zacchini v. Scripps-Howard Broadcasting Co.*[167] There, the Court distinguished a right of publicity claim (such as Zacchini's) from the claims in defamation and "false light" tort cases,[168] thus indicating it believed the defamation analysis to be inapplicable. However, the context of *Zacchini* was vastly different from *White*. In *Zacchini*, the Court specifically distinguished Zacchini's situation from that of an unauthorized use of a celebrity in an advertisement, calling Zacchini's case the "strongest case for a 'right of

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[163] Martin Luther King, Jr., Ctr. for Social Change, Inc. v. American Heritage Prods., Inc., 694 F.2d 674, 680 (11th Cir. 1983) ("the measure of damages to a public figure for violation of his or her right of publicity is the value of the appropriation to the user").

[164] *Id.* at 677 (quoting Pavesich v. New England Life Ins. Co., 50 S.E. 68, 80 (Ga. 1905)). This quotation also shows that the court did not distinguish an "advertising" use from one in which the celebrity was the product. The sale of Martin Luther King, Jr. busts appears to be a copyright-like issue more than an advertising issue (although the advertising for the busts may have been offensive as well).

[165] *Id.* at 683. In a concurring opinion, Justice Weltner cautioned that the right of publicity enunciated by the majority carried the potential for infringing free speech. *Id.* at 685-86 (Weltner, J., concurring). He pointed out that a "commercial" use of one's name or likeness did not remove the portrayal from the protection of free expression. *Id.* at 686. He concurred with the majority's result on the grounds that in *this* case the defendant's actions were unconscionable and called for a remedy—which he pointedly refused to call a right of publicity. *Id.* at 684-85.

[166] 376 U.S. 254 (1964).

[167] 433 U.S. 562 (1977).

[168] *Id.* at 573-74.

publicity.' "[169] The reason for the distinction was that Zacchini's very livelihood was at stake after a news program showed his "entire act."[170] Moreover, in *Zacchini*, the plaintiff sought to recover essentially the fair market value of the appropriated performance. His concern was purely economic—that the broadcast had taken the value of his performance. In *White*, Vanna White seems to have been concerned with protecting her reputation, as much as complaining of a misappropriation.

Rather than looking to *Zacchini* as a paradigm, one might look to *Hustler Magazine v. Falwell*[171] for a more analogous situation to *White*. In *Falwell*, the Supreme Court held that the *New York Times* standard applied to the tort of intentional infliction of emotional distress when the plaintiff is a public figure.[172] Though there are differences between *White* and *Falwell*,[173] there are notable similarities as well. Both cases used parody to make fun of a famous personality. Both used the parody to communicate to the audience—one to suggest that Rev. Jerry Falwell was not as moral as his public image, the other to say that Vanna White's job could be done by a robot in the future. No doubt both were offended by the parodies and both sought damages for that offense. The most significant difference is that the Vanna White parody was in an actual advertisement. Yet, the ad still communicated an idea over and above that ascribed to it by the court—selling Samsung VCRs. The communication of ideas is at the heart of the First Amendment's limitation on state tort law.[174]

The danger presented by cases like *White*, *Waits* and *Martin Luther King* is that celebrities are able to use the right of publicity claim as a substitute for a defamation claim without being subject to the public interest limits imposed on defamation actions.

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[169] *Id.* at 576.

[170] *Id.* at 575.

[171] 485 U.S. 46 (1988).

[172] *Id.* at 56.

[173] For one, *Falwell* did not involve an actual advertisement, just a parody of an advertisement.

[174] *See* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 577 n.13 (1977) (noting copyright laws have been upheld in face of First Amendment challenges because copyright laws do not restrain dissemination of ideas).

Damages for humiliation[175] are not the same as lost wages or opportunities that ostensibly motivate the celebrity activity and provide a public interest component to a right of publicity claim.[176] Before awarding damages for injury to reputation, courts should demand that a public interest component be considered,[177] just as is done with defamation and other reputational injury tort claims.

The most likely counter argument would employ the commercial/non-commercial speech distinction to escape the necessity of closely examining the public interest. In *White*, for example, the court dismissed a First Amendment defense in this manner.[178] The commercial speech argument in a defamation context can be summarized as follows. *New York Times* intended to insure a robust debate on public issues and about public figures by insulating merely negligent conduct of certain defendants from liability. Commercial speech, as the Court has instructed us, needs less protection because it is less likely to be deterred by the threat of liability for false or misleading publication.[179] One might conclude, therefore, that commercial speech—such as the advertisement at issue in *White*—does not require the extra protection granted by *New York Times*.

This argument, however, would miss the point. Samsung might not be deterred from advertising by the threat of liability for misappropriating someone's identity. But it *would* be deterred from presenting a parody of a famous person as part of that advertising. And therein lies the critical issue: do we, as a society, wish to deter the parodies and social commentaries contained within commercial advertising? I think not. Moreover, whatever humiliation celebrities feel from such commentaries (in the absence of a false implicit endorsement) is no greater than—and often less

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[175] *See, e.g.*, Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1102-06 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993) (upholding both punitive and compensatory damages for humiliation).

[176] *See Zacchini*, 433 U.S. at 573 (false light claims focus on injury to reputation while right of publicity claims promote celebrity activity).

[177] Published articles indicated that many comedians were concerned about the effect of *White* on their ability to imitate or parody celebrities as part of their acts. *E.g.*, Braxton, *supra* note 3, at F2.

[178] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992).

[179] Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557, 564 n.6 (1980).

than—the humiliation permitted by *New York Times* in the defamation context. Thus, the invocation of commerciality should not substitute for a careful analysis of the real issues. Otherwise, celebrities may be receiving undeserved protection from otherwise protected commentary relating to them and to other social issues. The "Vanna White" advertisement used by Samsung, for example, could be seen as a commentary on the incongruity of one who acquires fame and fortune by acting as a letter turner. The commentary may not be on the level of a political cartoon, but for us, or for judges, to attempt to measure the "worthiness" of such commentary may be unwise.[180]

CONCLUSION

In sum, courts have treated rights of publicity as property rights of a higher order than other forms of intellectual property. By doing so, they lose sight of the central wrong at issue. Both trademark-like and copyright-like right of publicity cases share an important trait: the wrong at issue is a *mis*appropriation. Too often, courts focus on the appropriation and overlook the requirement that it be wrongful. At a minimum, to be wrongful, the appropriation must take something that the supposed owner has a *need* to control. A comparison of *Zacchini*, *Cardtoons*, and *White* is instructive here. In *Zacchini*, the most compelling reason to grant relief was that the broadcast of his act deprived Zacchini of his livelihood.[181] By contrast, in *Cardtoons*, the parody baseball cards did not deprive the ballplayers of their ability to pursue their livelihood, either as baseball players *or* as celebrities. In addition, the cards did not truly borrow the star quality of the players—they

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[180] *See* Campbell v. Acuff-Rose Music, Inc., 114 S. Ct. 1164, 1173 (1994) (stating judges should not assess quality of commentary).

[181] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 575-76 (1977). It is instructive to compare *Zacchini* to the classic misappropriation case, International News Serv. v. Associated Press, 248 U.S. 215 (1918). One of the problems presented in the latter was that International News Service's appropriation of Associated Press's (uncopyrighted) stories threatened the viability of Associated Press's news gathering ability. *See id.* at 239-40. Thus, as with *Zacchini*, there was a demonstrable need to allow one side to control information otherwise within the public domain. *See* Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149, 267 (1992).

merely poked fun at the players' public image. In *White*, however, the court focused on the *appropriation*, without any meaningful analysis of what made it wrongful. In essence, Samsung's free ride for commercial gain on some aspect of Vanna White's fame made its actions wrongful. But, as the Supreme Court noted in *Acuff-Rose*, free-riding is not per se a bad thing.[182]

In advertising cases such as *White*, the core interest should be protection against the use of the star quality as a sales vehicle. The farther one gets from the core protection, the more indulgent the court should be of the use. To the extent that the parody does not simply borrow the star quality of the celebrity as a sales vehicle, there should be a presumption of legitimacy to that use.[183] Where the use is a parody, that factor should weigh against finding a misappropriation. A parody is an expression independent of the celebrity image. In short, a much more searching inquiry of the nature of the use is required than most courts have been willing to give. Trying to make sense of the current state of the law must often feel like catching smoke or nailing JELL-O[184] to a wall.

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[182] Campbell v. Acuff-Rose Music, Inc., 114 S. Ct. 1164, 1171 (1994) (discussing "transformative" works).

[183] The *White* court's example of the Michael Jordan robot might be an example of using a parody as a sales vehicle.

[184] JELL-O is a registered trademark of Kraft General Foods, Inc.