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PUBLICITY NEVER DIES; IT JUST FADES AWAY: THE RIGHT OF PUBLICITY AND FEDERAL PREEMPTION

David E. Shipley†

It is economic reality that pecuniary value is inherent in publicity.¹ Public figures often undertake endorsements, franchise operations, and other business ventures because their names will transfer goodwill to products and services.² The widespread practice of purchasing rights to use an individual's name, likeness, distinctive personality attributes, style, or characterizations to promote a product or attract an audience is evidence that such publicity interests have pecuniary value.³

Individuals have legitimate proprietary claims to their publicity interests.⁴ In many cases, the elements of a person's public personality become valuable only after the investment of considerable time, effort, skill and perhaps money.⁵ People often want to prevent the reproduction, promotion or other use of their publicity interests without authorization and remuneration.⁶ Since the latter part of the nineteenth century, various courts have indicated that publicity interests constitute a distinct kind of property

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¹ See, e.g., Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROB. 203, 215 (1954). Some courts have taken judicial notice of the widespread commercial exploitation of names, faces, and reputations of celebrities. See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978); *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 881 (S.D.N.Y. 1973).

² One commentator has noted: "[i]n recent years the values of certain famous names have become inestimable. This needs no illustration when consideration is given to the prices paid by companies for the use of a celebrity's name in conjunction with a product." Donenfeld, *Property or Other Rights in the Names, Likenesses or Personalities of Deceased Persons*, 16 BULL. COPYRIGHT SOC'Y 17, 19 (1968).

³ See Nimmer, *supra* note 1, at 215-16.

⁴ See, e.g., *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622, 396 N.Y.S.2d 661, 664 (2d Dep't 1977); *Rosemont Enterprises v. Urban Sys.*, 72 Misc. 2d 788, 790, 340 N.Y.S.2d 144, 146 (Sup. Ct.), *aff'd and modified*, 42 A.D.2d 544, 345 N.Y.S.2d 17 (1st Dep't 1973).

⁵ See, e.g., *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 391-92, 400, 280 N.W.2d 129, 134-35, 138 (1979); Nimmer, *supra* note 1, at 215-16.

⁶ See Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1588-89 (1979); Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEXAS L. REV. 637, 641-48 (1973); Note, *The Right of Publicity: A Doctrinal Innovation*, 62 YALE L.J. 1123, 1124 (1953).

right.⁷ In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁸ the Court of Appeals for the Second Circuit first expressly recognized the right of publicity as an independent, enforceable property right:⁹

We think that, in addition to and independent of the right of privacy . . . , a man has a right in the publicity value of his photograph, *i.e.*, the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross"

This right might be called a "right of publicity." For it is common knowledge that many prominent persons . . . would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money un-

⁷ See, *e.g.*, *Brown Chem. Co. v. Meyer*, 139 U.S. 540 (1891); *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 170-71 (5th Cir. 1941) (dissenting opinion); *Pittsburgh Athletic Co. v. KQV Broadcasting Co.*, 24 F. Supp. 490 (W.D. Pa. 1938); *Uproar Co. v. National Broadcasting Co.*, 8 F. Supp. 358 (D. Mass. 1934); *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (Ct. App. 1928); *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68 (1905); *Munden v. Harris*, 153 Mo. App. 652, 134 S.W. 1076 (1911); *Edison v. Edison Polyform, Mfg. Co.*, 73 N.J. Eq. 136, 67 A. 392 (1907); *Lawrence v. Ylla*, 184 Misc. 807, 55 N.Y.S.2d 343 (Sup. Ct. 1945); *Madison Square Garden Corp. v. Universal Pictures Co.*, 155 A.D. 459, 7 N.Y.S.2d 845 (1st Dep't 1938); *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 A. 631 (1937); *United States Life Ins. Co. v. Hamilton*, 238 S.W.2d 289 (Tex. Civ. App. 1951). *Contra*, *Vassar College v. Loose-Wiles Biscuit Co.*, 197 F. 982 (D. Mo. 1912); *Gautier v. Pro-Football, Inc.*, 278 A.D. 431, 106 N.Y.S.2d 553 (1951), *aff'd*, 304 N.Y. 354, 107 N.E.2d 485 (1952); *Schumann v. Loew's, Inc.*, 199 Misc. 38, 102 N.Y.S.2d 572 (Sup. Ct. 1951), *amended complaint dismissed*, 135 N.Y.S.2d 361 (Sup. Ct. 1954).

⁸ 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

⁹ The plaintiff in *Haelan* contracted with a baseball player for the exclusive right to use the player's name and photograph in promoting sales of the plaintiff's chewing gum. The defendant, a competitor, secured the player's authorization to use his name and photograph to advertise and sell its own gum. The plaintiff alleged tortious invasion of its contract rights with the player. The defendant argued that an individual has no legal right to control the publication of his picture, except in his right of privacy, which is a personal and nonassignable right not to suffer emotional harm from such publication. Thus, the contract between the player and the plaintiff, the defendant argued, was a release from potential liability for invasion of privacy rather than a transfer of exclusive rights.

The court agreed that under existing right to privacy doctrine, the plaintiff's exclusive-use contract released the plaintiff but did not constitute an assignment. *Id.* at 867. The court nevertheless asserted that an individual has, in addition to the right of privacy, an independent right to grant to another in gross the exclusive privilege of publishing his picture. *Id.* at 868. Whether such privilege is called a "property" right was immaterial, in the court's view, because the label "property" simply means that courts enforce claims that have pecuniary value. *Id.* The court held that if the defendant had used the player's photograph with knowledge of the plaintiff's contract, the appropriation would have been actionable. *Id.* at 869. See Note, *State "Copyright" Protection for Performers: The First Amendment Question*, 1978 DUKE L.J. 1198, 1210-11 & n.65.

less it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.¹⁰

Haelan remains the seminal case in the development of the right of publicity.¹¹

During the last fifteen years, the common law publicity right has won increased judicial acceptance.¹² In 1977 it gained the approval of the United States Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*¹³ Despite such judicial recognition, the definition of the right of publicity remains unclear; its theory is still evolving and its limits are uncertain.¹⁴

The state law doctrine of the right of publicity is analogous to the tort of misappropriation in rationale, purpose, and scope.¹⁵ Similarly, the rationale for recognizing and protecting publicity interests parallels the policy considerations that underlie the federal copyright laws¹⁶; the right itself is equivalent to copyright in many respects.¹⁷ Similarities between the right of publicity and

¹⁰ 202 F.2d at 868.

¹¹ See P. GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 134 (1973); Felcher & Rubin, *supra* note 6, at 1589. This Article uses the term "right of publicity" to refer to any theory by which a plaintiff claims infringement of his exclusive property right in his name, likeness, or aspects of his personality. See notes 34-50 and accompanying text *infra*.

¹² Felcher & Rubin, *supra* note 6, at 1589 & n.67. Numerous jurisdictions have recognized the doctrine. See, e.g., *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 827 (9th Cir. 1974) (California); *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969) (Missouri); *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956) (Pennsylvania); *Manger v. Kree Inst. of Electrolysis*, 233 F.2d 5 (2d Cir. 1956) (New York); *Memphis Dev. Foundation v. Factors, Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, No. 80-314 (Nov. 3, 1980); *Uhlaender v. Hendrickson*, 316 F. Supp. 1277 (D. Minn. 1970); *Palmer v. Schonhorn Enterprises, Inc.*, 96 N.J. Super. 72, 232 A.2d 458 (Sup. Ct. Ch. Div. 1967). *Hogan v. Barnes*, 114 U.S.P.Q. 314 (Pa. C.P. 1957); *Loeb v. Turner*, 257 S.W.2d 800 (Tex. 1956); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129 (1979). *But see*, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979); *Carson v. National Bank of Commerce Trust & Sav.*, 356 F. Supp. 811 (D. Neb. 1973).

¹³ 433 U.S. 562 (1977). The Court held that the plaintiff-entertainer's live human cannonball act was professional property under a state law based right of publicity and that a television station consequently did not enjoy a first amendment privilege to report the act in its entirety. *Id.* at 575-79. See Note, *supra* note 9, at 1210-11.

¹⁴ Lack of clarity of definition and scope often attends judicial development of common law rights. See, e.g., *Ettore v. Philco Broadcasting Corp.*, 229 F.2d 481, 490 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956); Felcher & Rubin, *supra* note 6, at 1589-90.

¹⁵ See note 74-86 and accompanying text *infra*.

¹⁶ See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977); notes 63-70 and accompanying text *infra*. Cf. Felcher & Rubin, *supra* note 6, at 1601 (reach of copyright law "limited, especially when asserted against the capabilities of modern media").

¹⁷ See notes 62-73 and accompanying text *infra*.

such doctrines as copyright and misappropriation create uncertainty about the continued vitality of the publicity doctrine in light of the Copyright Act of 1976.¹⁸ Section 301(a) of the Act, which defines the statute's preemptive effects on state law, provides that interests that fall within the scope of federal copyright law may no longer be protected by the common law or state statutes.¹⁹ The sweeping language of section 301, the uncertain status of the misappropriation doctrine under the 1976 Act,²⁰ the conflict between the arguably perpetual duration of the right of publicity and the "limited times" provision of the Constitution's patent and copyright clause,²¹ and the general federal policy on intellectual property suggest that in some situations the common law publicity doctrine is subject to federal preemption.

This Article explores the nature and developing boundaries of the state law doctrine of the right of publicity. It investigates the doctrine's conflict with the 1976 Copyright Act and federal policy concerning intellectual property, and concludes that the 1976 Act precludes publicity actions aimed at protecting certain types of publicity interests. In other situations, the overriding objectives of federal copyright policy preempt the right to the extent that the right is defined as perpetual; moreover, such protection in perpetuity violates the supremacy clause of the Federal Constitution. Many types of publicity actions, however, should escape preemption either because the asserted rights and interests are outside the scope of the 1976 Act or because protection of the particular rights and interests at stake comports with general federal policy. To provide certainty regarding the publicity doctrine's scope and continued vitality, courts must construe state law publicity rights in the context of the current federal copyright law.

¹⁸ See 17 U.S.C. §§ 101-810 (Supp. III 1979).

¹⁹ 17 U.S.C. § 301(a) (Supp. III 1979).

²⁰ See generally A. LATMAN, *THE COPYRIGHT LAW* 69 (5th ed. 1979); Fetter, *Copyright Revision and the Preemption of State "Misappropriation" Law: A Study in Judicial and Congressional Interaction*, 25 BULL. COPYRIGHT SOC'Y 367 (1978); Comment, *The Misappropriation Doctrine After the Copyright Revision Act of 1976*, 81 DICK. L. REV. 469 (1978).

²¹ The Constitution states that "[t]he Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the Exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

Confusion in claim adjudication arises from the fact that although copyright protection is available for only a limited time, some courts have held that the right of publicity survives in perpetuity the death of its owner. See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977), *aff'd*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (holding right of publicity transferable and perpetual if exploited by owner

I

THE RIGHT OF PUBLICITY

A. *Nature and Scope*

Broadly defined, the right of publicity is the right to own, protect, and profit from the commercial value of an individual's name, likeness, activities, and identity.²² The notion that property rights adhere to the pecuniary value of a name and personal features has long received judicial recognition.²³ In 1891, the Supreme Court observed that "[a] man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property."²⁴ If an individual has worked to develop in his name and likeness sufficient value to excite the desire of another to market them, then that person arguably deserves property rights in the interests²⁵ and entitlement to control their resulting profitability. Courts, accordingly, have protected the interests from unauthorized use.²⁶

during his lifetime); *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir.), *cert. denied*, No. 80-314 (Nov. 3, 1980). *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975). *But see* *Lugosi v. Universal Pictures*, 70 Cal. App. 3d 552, *modified*, 139 Cal. Rptr. 35, 38-39 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

²² *See, e.g.*, *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978); *Felcher & Rubin*, *supra* note 6, at 1589; *Rader, The "Right of Publicity"—A New Dimension*, 61 J. PAT. OFF. SOC'Y 228 (1979).

²³ *See* *Gordon, Right of Property in Name, Likeness, Personality and History*, 55 Nw. U. L. REV. 553 (1960). Numerous courts, interpreting interests in pecuniary value of names and personal features as protectible under the right of privacy, have obscured the distinctive nature of such interests. *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 282-83 (S.D.N.Y. 1977) (noting judicial confusion). In general, litigation of claims contesting the appropriation of names, likenesses, and personalities has arisen under various legal theories. Claimants most frequently have alleged invasion of the right of privacy. *See* *Gordon, supra*, at 554; *Note, supra* note 9, at 1210 n.65; notes 27-29 and accompanying text *infra*. For a thorough, well-documented discussion of the general confusion in this area, see *Gordon, supra*. *See also* *Lugosi v. Universal Pictures*, 70 Cal. App. 3d 552, *modified*, 139 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979) (holding right of publicity part of right of privacy).

²⁴ *Brown Chem. Co. v. Meyer*, 139 U.S. 542, 544 (1891). *See also* *Minton v. Smith*, 276 Ill. App. 128 (1934); *Edison v. Edison Polyform Mfg. Co.*, 73 N.J. Eq. 136, 141, 67 A. 392, 394 (1907).

²⁵ *Cf. Munden v. Harris*, 153 Mo. App. 652, 659, 134 S.W. 1076, 1078 (1911) (suggesting physical appearance alone sometimes sufficient to support assertion of property right).

²⁶ In *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129 (1979), the court stated that because "the primary advertising value of a celebrity's personality was created through the work and sacrifice of the celebrity, that value could constitute an interest that the law should protect." *Id.* at 391, 280 N.W.2d at 134 (quoting *Treece, supra* note 6, at 646-47 (footnote omitted)). Recent decisions have held that the interest in the publicity value of one's name or likeness is a valid property right that is transferable and

The right of privacy was often successfully asserted to protect publicity interests.²⁷ The decisions that established the common law right of privacy uniformly recognized that an individual has property rights in his name and likeness,²⁸ and that the appropriation of some element of a public personality constituted an actionable invasion of that right.²⁹ As a result, the appropriation tort became recognized as one of four types of privacy actions.³⁰ With the development of modern advertising and merchandising techniques, publicity interests assumed increased pecuniary value. Although the right of privacy entitled plaintiffs to seek injunctive relief or damages, it provided inadequate protection because recovery was subject to the uncertainty of courts having to measure injury to feelings or emotions.³¹ Thus, it appeared that adequate protection of publicity rights required a publicity right distinct from the right of privacy, the unfair competition doctrine,³² and other theories in contract and defamation.³³

perpetual if exploited by the owner during his lifetime. *See* note 21 and accompanying text *supra*. The term "exploitation," however, has evaded definition. *See* *Hicks v. Casablanca Records & Filmworks*, 464 F. Supp. 426, 429 (S.D.N.Y. 1978); *accord*, *Guglielmi v. Spelling-Goldberg Prods.*, 73 Cal. App. 3d 436, 140 Cal. Rptr. 775 (1975), *aff'd*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979).

²⁷ *Cf.* Gordon, *supra* note 23, at 558, 611-12 (discussing legal protection of interests from commercial exploitation of names and likenesses in context of development of right of privacy). Most early cases concerned the use of a name or likeness in advertisements where the principal injury from the appropriation was humiliation and mental anguish rather than damages or unjust enrichment. *Cf.* *Nimmer*, *supra* note 1, at 216-17 (comparing and distinguishing right of privacy and right of publicity).

²⁸ *See, e.g.*, Gordon, *supra* note 23, at 560.

²⁹ *See, e.g.*, W. PROSSER, *HANDBOOK OF THE LAW OF TORTS* § 117, at 804 (4th ed. 1971). Dean Leon Green argued for classifying right of privacy cases according to the type of harm involved. *See* Green, *The Right of Privacy*, 27 ILL. L. REV. 237, 239 (1932). *See also* *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 213-16, 50 S.E. 68, 78-79 (1905) (citing *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 557, 561-66, 64 N.E. 442, 450 (1902) (Gray, J., dissenting) (describing as a property right the interest in protection against unauthorized commercial use of a person's likeness)); *Munden v. Harris*, 153 Mo. App. 652, 134 S.W. 1076 (1911).

³⁰ *See* W. PROSSER, *supra* note 29, at 804-14. The appropriation tort is distinct from intrusion upon the plaintiff's solitude or seclusion, public disclosure of embarrassing private facts about the plaintiff, or publicity giving the plaintiff a false public image. *Id.* at 807, 809, 812. *See also* Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

³¹ *See* Note, *supra* note 6, at 1124. The threat of lawsuit may have compelled appropriators to pay for the use of names or pictures in some cases.

³² *See, e.g.*, *Chaplin v. Amador*, 269 P. 544, 546 (1928) (held plaintiff entitled to injunctive relief against imitator because of right to protection against unfair competition in business).

³³ *See* *Nimmer*, *supra* note 1, at 204-10.

After the Second Circuit in *Haelan*³⁴ first acknowledged such a distinct right, several jurisdictions followed.³⁵ These courts regarded the right of publicity as an intangible property right that is assignable, transferable,³⁶ and, in some jurisdictions, devisable.³⁷ Unlike the right of privacy, which plaintiffs invoked in this context to compensate injured feelings,³⁸ the right of publicity expressly protects an individual's right to reap financial rewards from his endeavors.³⁹

In general, invasions of the right of publicity involve incidental use by the press of a person's name or picture,⁴⁰ or unautho-

³⁴ *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). See notes 8-11 and accompanying text *supra*.

³⁵ See note 12 *supra*. See also *Carson v. Here's Johnny Portable Toilets, Inc.*, 498 F. Supp. 71, 78 (E.D. Mich. 1980); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978); *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 879 (S.D.N.Y. 1973); *Chaplin v. National Broadcasting Co.*, 15 F.R.D. 134, 139-40 (S.D.N.Y. 1953). In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), the Supreme Court expressly recognized the distinction between the right of publicity and the right of privacy. See note 13 and accompanying text *supra*.

³⁶ See, e.g., *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977).

³⁷ See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (holding right of publicity inheritable). See generally *Felcher & Rubin, supra* note 6, at 1588-90; *Rader, supra* note 24, at 29; Comment, *Transfer of the Right of Publicity: Dracula's Progeny and Privacy's Stepchild*, 22 U.C.L.A. L. REV. 1103, 1103-04 (1975).

Courts had long recognized legal interests similar to the right of publicity, such as an assignable interest in the commercial value of personality. See, e.g., *Uproar Co. v. National Broadcasting Co.*, 8 F. Supp. 358 (D. Mass. 1934); *Wood v. Lucy, Lady Duff-Gordon*, 222 N.Y. 88, 118 N.E. 214 (1917); *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 A.D. 459, 7 N.Y.S.2d 845 (1st Dep't 1938); *United States Life Ins. Co. v. Hamilton*, 238 S.W.2d 289 (Tex. Civ. App. 1951). *But see* *Hanna Mfg. Co. v. Hillerich & Bradsby Co.*, 78 F.2d 763 (5th Cir. 1935).

³⁸ See *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 390-91, 403, 280 N.W.2d 129, 134, 140 (1979). See also *Gordon, supra* note 23, at 558, 611-12; *Nimmer, supra* note 1, at 216; *Treece, supra* note 6, at 648-52.

³⁹ See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977). Allowing free use of some aspect of an individual's persona, which has a recognized value and which normally entitles the owner to compensation, would serve no social purpose. See *id.* at 576 (quoting *Kalven, Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROB. 326, 331 (1965)). Under the right of publicity, damages for violations may match the plaintiff's actual pecuniary losses and lead to injunctive relief as well. Economic damages recoverable under the right may include compensation for damage to reputation if, for example, the value of the plaintiff's name has been diluted by its unauthorized use in advertisements. See, e.g., *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 391, 280 N.W.2d 129, 138 (1979); *Treece, supra* note 6, at 641-43. See generally notes 51-61 and accompanying text *infra*.

⁴⁰ See *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953) (discussed at note 9 *supra*). The court in *Haelan* did not address the question of whether the right of publicity protects only the fame of celebrities.

rized use of a name or likeness for commercial purposes. Thus, an individual may recover damages for breach of the right of publicity when a manufacturer uses the individual's reputation to enhance the attractiveness of a product, or appropriates the activity by which he first acquired his reputation.⁴¹ Courts have protected several interests under the right of publicity,⁴² including the plaintiff's name,⁴³ his nickname,⁴⁴ his likeness,⁴⁵ a character that he has created,⁴⁶ his performance,⁴⁷ his distinctive style,⁴⁸ and materials closely associated with his personality.⁴⁹ Despite this judicial

If the right is so limited, then its protection is incomplete. *See generally* Nimmer, *supra* note 1, at 215-16; Treece, *supra* note 6, at 652; Note, *supra* note 6, at 1128-30.

⁴¹ *See* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977) (discussed at note 13 and accompanying text *supra*, and at notes 190-97 and accompanying text *infra*). *See also* note 39 *supra*.

⁴² *See, e.g.*, Comment, *supra* note 37, at 1105 & n.18.

⁴³ *See, e.g.*, Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953); Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970); Wyatt Earp Enterprises, Inc. v. Sackman, Inc., 157 F. Supp. 621 (S.D.N.Y. 1958).

⁴⁴ *See, e.g.*, Hirsch v. S.C. Johnson & Son, Inc., 90 Wis. 2d 379, 280 N.W.2d 129 (1979) ("Crazylegs").

⁴⁵ *See, e.g.*, Factors Etc., Inc. v. Creative Card Co. 444 F. Supp. 279 (S.D.N.Y. 1977). Protection extends to interests in photographed likenesses, *see* Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973) (noting, in denial of cross motions for summary judgment, possibility of recovery against magazine that published article on fashions which included photograph of plaintiff's head on torso of model), and imitations of likenesses, *see* Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978) (granting injunction against unauthorized printing, publication and distribution of obscene portrait clearly recognizable as that of former heavyweight boxing champion).

⁴⁶ *See, e.g.*, Price v. Worldvision Enterprises, Inc., 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979) (granting injunctive relief against production of television series in which actors portrayed Laurel and Hardy characters).

⁴⁷ *See, e.g.*, Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (holding damages recoverable for unauthorized taped news broadcast of plaintiff's live performance).

⁴⁸ *See, e.g.*, Lahr v. Adell Chem. Co., 300 F.2d 256 (2d Cir. 1962) (sustaining action against imitation of popular actor's voice in advertisements); Chaplin v. Amador, 93 Cal. App. 358, 269 P. 544 (1928) (finding likelihood of public deception sufficient grounds for injunctive relief against unauthorized use of performer's voice, mannerisms, gestures and dress); Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977) (granting relief against advertising agency's automobile commercial depicting plaintiff conducting band at New Year's Eve party); Sim v. H.J. Heinz Co., [1959] 1 All E.R. 547 (C.A.). Entertainers who have a unique and well-known "style" are often unsuccessful in obtaining relief against imitators, in part because of the difficulty of defining what is and is not "style." *See* Note, *Intellectual Property—Performer's Style—A Quest for Ascertainment, Recognition and Protection*, 52 DEN. L.J. 561 (1975).

⁴⁹ *See, e.g.*, Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (vacating summary judgment for defendant where defendant's advertisement depicted plaintiff race-car driver's likeness in manner recognizable on account of distinctive car decorations).

recognition of the right of publicity, however, considerable uncertainty remains concerning the doctrine's definition and scope of protection.⁵⁰

B. *Rationale for Protection*

Protecting the right of publicity provides incentive for performers to make the economic investments required to produce performances appealing to the public.⁵¹ The rationale for patent and copyright protection is analogous.⁵²

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.⁵³

The Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*⁵⁴ emphasized that the economic value of the plaintiff's human cannonball act depended upon his exclusive control of its publicity. If the plaintiff lost his exclusive control and the public could watch the act on television, the Court reasoned, the public might be less willing to pay to see it at a county fair.⁵⁵ The Court added that protecting such individual economic interests would promote the public's interest in access to entertainment.⁵⁶

⁵⁰ See Felcher & Rubin, *supra* note 6, at 1589-90. Arguably, debate about whether the right of publicity protects a property interest is pointless. See, e.g., Prosser, *supra* note 30, at 406. As one commentator has noted, the consequences of recognizing legal publicity interests are practical: "Once protected by the law, [the right of a person to the use of his name and likeness] . . . is a right of value upon which the plaintiff can capitalize by selling licenses." W. PROSSER, *supra* note 29, at 807.

⁵¹ See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977).

⁵² *Id.* at 573. The purpose of the right of publicity overlaps the purpose of the patent and copyright laws in that its protection provides an economic incentive for individuals to create and perform. This promotes the public interest in access to entertainment and other forms of expression. Cf. Katz, *Copyright Preemption Under the Copyright Act of 1976: The Case of Droit de Suite*, 47 GEO. WASH. L. REV. 200, 205-06 (1978) (arguing that encouragement of authors' and inventors' efforts by promise of personal gain best enhances public welfare).

⁵³ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977) (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

⁵⁴ 433 U.S. 562 (1977).

⁵⁵ *Id.* at 575. The Court acknowledged that by increasing the value of the plaintiff's performance, the defendant's broadcast might have precluded his proving damages. Nevertheless, because the plaintiff alleged that the broadcast had caused him injury of \$25,000, the Court upheld the state's power to award compensation for the alleged injuries if proven. *Id.* at 575 n.12.

⁵⁶ *Id.* at 576.

More frequently, litigated publicity actions involve names, likenesses, style, and personality attributes. The rationale for protecting such interests parallels the interest in protecting publicity rights in performances.⁵⁷ Unauthorized use of a recognized publicity interest threatens its continued pecuniary value.⁵⁸ A person's name, likeness, character, style, or reputation becomes valuable because of an investment of skill, effort, energy, and expense. Maintaining the value of such attributes requires the right to exercise exclusive control over their use. Misappropriation of publicity interests to enhance product marketing, for example, could harm the individual by making his authorized endorsements less valuable, diluting the good will and pecuniary value of his name, and perhaps even injuring his credibility.⁵⁹ Protecting these interests from misappropriation prevents unjust enrichment.⁶⁰ In addition, protection provides an economic incentive to make the investment necessary to win audience appeal or gain prominence in a particular field. This in turn promotes public entertainment and other socially beneficial enterprises.⁶¹

C. *Similarity to Copyright*

The right of publicity resembles copyright in many respects. Both doctrines are "intended definitely to grant valuable, enforceable rights"⁶² in order to afford greater encouragement to the

⁵⁷ See, e.g., *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 839, 603 P.2d 425, 441, 160 Cal. Rptr. 323, 339 (1979) (Bird, C.J., dissenting); Felcher & Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125, 1128, 1129-32 (1980); Note, *supra* note 9, at 1214-15.

⁵⁸ See, e.g., Treece, *supra* note 6, at 642-43.

⁵⁹ One commentator has noted that "[a]udience appeal is a principal stock-in-trade of a celebrity. The celebrity creates audience appeal not only through the substantive achievements that bring him fame, but at the expense of the privacy that he must surrender in becoming a public personality." Treece, *supra* note 6, at 646. An advertiser's misappropriation of the celebrity's public image may damage his audience appeal. Resulting harm to the individual, moreover, is greater if the advertised product is a shoddy one.

⁶⁰ See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977). The right to protect publicity values is analogous to a business's right to profit from the goodwill in its name. See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978); *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 879 (S.D.N.Y. 1973). See generally Grimes & Battersby, *The Protection of Merchandising Properties*, 69 TRADEMARK REP. 431 (1979).

⁶¹ See, e.g., *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 829, 603 P.2d 425, 441, 160 Cal. Rptr. 323, 339 (1979) (Bird, C.J., dissenting); Felcher & Rubin, *supra* note 57, at 1128-32; notes 51-56 and accompanying text *supra*.

⁶² *Washington Publishing Co. v. Pearson*, 306 U.S. 30, 36 (1939). One commentator has written that "[t]he purpose of copyright is to attract private investment to the production of original expression. Property is the inducement offered, in the form of rights in the

production of works beneficial to the public.⁶³ Copyright protects valuable achievements of authors, composers, and artists;⁶⁴ similarly, the right of publicity protects a person's rights in the value of his skills, craft, or talents.⁶⁵ As with copyright, protection against the appropriation of publicity interests typically does not require any likelihood of confusion in the marketplace.⁶⁶ Courts in several jurisdictions have held that the right of publicity survives the death of its owner, like copyright.⁶⁷ Further, it extends to the individual's form of expression, but not to the idea underlying that expression.⁶⁸ Originality, a prerequisite for copyright, is also a prerequisite to the creation of a valuable right of

expression created." Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 U.C.L.A. L. REV. 1107, 1107 (1977). Similarly, the right of publicity—a property right in the "persona" or expression that an individual creates—attracts investment and rewards the production of expression. Cf. Note, *supra* note 9, at 1222 (discussing overlapping policies of copyright and right of publicity, and constitutional limits on both rights arising from first amendment).

⁶³ See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 577 (1977). The Court concluded that in view of the similar objectives of copyright and the right of publicity, the Constitution does not prohibit states from choosing to protect an entertainer's incentive in order to encourage the production of creative work. *Id.* (citing *Goldstein v. California*, 412 U.S. 546 (1973), and *Kewanee Oil v. Bicron Corp.*, 416 U.S. 470 (1974)). See notes 102-10 and accompanying text *infra*. See also *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 839, 603 P.2d 425, 441, 160 Cal. Rptr. 323, 339 (1979) (Bird, C.J., dissenting).

⁶⁴ See A. LATMAN, *supra* note 20, at 1. Until recently, the term "copyright" was distinguished from the common law right to control first publication of literary property. The term connotes a congressional statutory grant of a qualified monopoly for a limited time to encourage the production and dissemination of literary, dramatic, musical and artistic works. See note 21 *supra*. Copyrights are not granted by any government agency. Rather, they arise from acts of the authors, who thereafter register their claims. Eligible works need not be novel, nor must they rise to the level of invention; they only have to be original—created without copying. See A. LATMAN, *supra* note 20, at 1.

⁶⁵ In *Lugosi v. Universal Pictures*, 70 Cal. App. 3d 55, *modified*, 139 Cal. Rptr. 35, 37 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979), the Court emphasized the doctrinal overlap in this area:

The tie-up of one's name, face and/or likeness with a business, product or service creates a tangible and saleable product in much the same way as property may be created by one who organizes under his name a business to build and/or sell houses according to a fixed plan or *who writes a book, paints a picture or creates an invention.*

139 Cal. Rptr. at 37 (emphasis added).

⁶⁶ See notes 319-24 and accompanying text *infra*.

⁶⁷ See *Laff & Saret, Further Unraveling of Sears-Compco: Of Patches, Paladin and Laurel and Hardy*, 7 LOY. CHI. L.J. 33, 55 (1975).

⁶⁸ Copyright does not restrain the use of an idea or concept. See *United States v. Bodin*, 374 F. Supp. 1265, 1267 (W.D. Okla. 1974); *Nimmer, Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A. L. REV. 1180 (1970). Similarly, the *Zacchini* decision indicates that the right of publicity does not extend to ideas. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 577 n.13 (1977) (plaintiff's right of publicity would not prevent defendant television station from staging or filming its own human cannonball act).

publicity.⁶⁹ Each right allows its holder to monopolize the copying and use of original expression; such control encourages creative expression.

The doctrines are not, however, identical. Copyright protection is not available unless the author's expression of his idea is fixed in a tangible form,⁷⁰ whereas the availability of protection under the right of publicity does not necessarily require the individual to create anything tangible. The interest created under the right of publicity is the person's individual style—his persona—which need not become tangibly fixed in a medium of expression. More important, although copyright protection is available for a limited time, in some jurisdictions the right of publicity is perpetual, lasting as long as the public recognizes the person's name, likeness, or attributes of his personality.⁷¹ In this sense, the right resembles a trademark; the value of a trademark, and its continuing protectability, derive from public recognition.⁷² Notwithstanding these differences, the right of publicity closely resembles copyright and, at least arguably, falls within copyright doctrine.⁷³

D. *Similarity to Misappropriation*

The right of publicity is likewise analogous to the tort doctrine of misappropriation.⁷⁴ The seminal case in the development of the tort of misappropriation is *International News Service v. Associated Press*.⁷⁵ Because International News Service (INS) did not have access to the cables that wired news of World War I from Europe to America, it copied the news from Associated Press's (AP) bulletin boards and from AP's member newspapers on the east coast and wired the material to clients on the west

⁶⁹ See Brenner, *What's in a Name and Who Owns It?*, 6 BARRISTER 42, 46 (Winter 1979).

⁷⁰ See 17 U.S.C. § 102(a) (Supp. III 1979).

⁷¹ See Laff & Saret, *supra* note 67, at 55; notes 31-37 and accompanying text *supra*.

⁷² See, e.g., Laff & Saret, *supra* note 67, at 55.

⁷³ Cf. Felcher & Rubin, *supra* note 57, at 1129-32 (emphasizing that right of publicity doctrine is closely analogous to copyright doctrine). *Contra*, Brenner, *supra* note 69. When certain kinds of publicity interests become fixed in a tangible medium of expression the analogy to copyright is even stronger. See notes 249-54 and accompanying text *infra*.

⁷⁴ See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). The right of publicity, which the Court in *Zacchini* described as "strong," *id.* at 576, is almost indistinguishable from the tort of misappropriation. In a different jurisdiction, the "human cannonball" plaintiff in *Zacchini* might have alleged misappropriation. Diamond, *Preemption of State Law*, 25 BULL. COPYRIGHT SOC'Y 204, 211 n.44 (1977).

⁷⁵ 248 U.S. 215 (1918).

coast who competed with AP's members. The Supreme Court held this redistribution of plaintiff's news dispatches actionable.⁷⁶

The Court observed that the rule limiting equity courts to protection of property rights "treats any civil right of a pecuniary nature as a property right . . . and the right to acquire property by honest labor or the conduct of a lawful business is as much entitled to protection as the right to guard property already acquired."⁷⁷ *INS*, the Court emphasized, had taken marketable material that AP obtained through its considerable investment and had, "in appropriating it and selling it as its own . . . endeavor[ed] to reap where it ha[d] not sown."⁷⁸ Such misconduct, the Court held, justified the plaintiff's action for damages.⁷⁹

State and federal courts upholding misappropriation claims often stress the *INS* Court's emphasis on unjust enrichment. They cite *INS* as authority for the proposition that the law of unfair competition rests on the broad principle that "property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality, and a court of equity will penetrate and restrain every guise resorted to by the wrong-doer."⁸⁰ The misappropriation doctrine has evolved into an independent prohibition on poaching off of another's investment, without regard to defenses available under passing-off or unfair competition theories.⁸¹ Enabling states to prevent copying where statutory copyright laws would not,⁸² the doctrine recognizes that individuals and commercial enterprises have enforceable proprietary

⁷⁶ *Id.* at 231. See B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 86 (1967). The *INS* Court recognized a viable cause of action for misappropriation—the conversion of the investment, labor or skill of another for use as one's own. 248 U.S. at 236. The case did not concern copyright because the protection sought was not for the copyrightable expression of the news in the dispatches, but for the news itself, which was not copyrightable. *Id.* at 234. The Court assumed "that neither party ha[d] any remaining property interest as against the public in uncopyrighted news matter." *Id.* at 236. Nevertheless, in the Court's view it did not follow that there was no remaining property interest in the news as between the parties. *Id.*

⁷⁷ *Id.* at 236 (citations omitted).

⁷⁸ *Id.* at 239-40. The Court indicated that a court of equity would characterize the misconduct as unfair competition. *Id.* at 240.

⁷⁹ The Court held that equity afforded relief for the claim of unfair competition. *Id.* at 240.

⁸⁰ *Metropolitan Opera Ass'n v. Wagner-Nichols Record Corp.*, 199 Misc. 786, 796, 101 N.Y.S.2d 483, 492 (Sup. Ct. 1950), *aff'd*, 279 A.D. 632 (1st Dep't 1951).

⁸¹ Goldstein, *supra* note 62, at 1116; Comment, *supra* note 20, at 479-80.

⁸² Goldstein, *supra* note 62, at 1116. Courts have made relief against misappropriation "a right, like copyright, valid as against the whole world." Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUM. L. REV. 49, 58 (1969).

interests in trade values they create and that invasion of these values occurs when an unauthorized person converts them for personal use and profit.⁸³

The rationale used in *INS* to protect the news gathering efforts of the Associated Press closely resembles the rationale for protecting the right of publicity.⁸⁴ Indeed, the Court's theory of unjust enrichment and unfair competition formed the foundation from which courts developed the right of publicity.⁸⁵ Under both the misappropriation doctrine and the right of publicity, an individual with publicity interests may seek protection from unauthorized use or appropriation by predatory practices.

Distinctions between conduct actionable under a misappropriation theory and actions giving rise to the prototypical right of publicity action are trivial. Unjust enrichment through the conversion of hard-earned and valuable intangible interests constitutes the remediable wrong in both situations. In either case, the plaintiff seeks damages or injunctive relief against the defendant making free use of his publicity interests. The right of publicity, like misappropriation, can be seen as providing an independent rule, distinct from passing-off or unfair competition, which protects an individual who has invested resources to develop his name, likeness and persona.

II

PREEMPTION AND THE RIGHT OF PUBLICITY BEFORE 1978

The preemption doctrine, derived from the Constitution's supremacy clause,⁸⁶ nullifies a state statute or common law that frustrates objectives underlying an act of Congress.⁸⁷ Federal legislation preempts state law when "either . . . the nature of the regulated subject matter permits no other conclusion, or . . . the Congress has unmistakably so ordained."⁸⁸ Because the Constitution

⁸³ See, e.g., *International News Serv. v. Associated Press*, 248 U.S. 215 (1918); Comment, *supra* note 20, at 469 n.2.

⁸⁴ Because *INS* was decided as a matter of federal common law, the doctrine of *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938), may have diminished its *stare decisis* impact in the federal courts. See Laff & Saret, *supra* note 67, at 35.

⁸⁵ Laff & Saret, *supra* note 67, at 35-36. See notes 60-61 and accompanying text *supra*.

⁸⁶ The supremacy clause states that "The Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding." U.S. CONST. art. VI, cl. 2.

⁸⁷ See, e.g., *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

⁸⁸ *Florida Lime & Avocado Growers, Inc. v. Paul*, 373 U.S. 132, 142 (1963).

granted Congress the power to establish patent and copyright laws,⁸⁹ state regulation of some kinds of intellectual property may unconstitutionally conflict with federal copyright law⁹⁰ and patent legislation.⁹¹

Before examining the preemptive effect of the 1976 Copyright Act,⁹² which took effect in 1978, it is instructive to review cases that arose under the old copyright law, and that involved the right of publicity and analogous causes of action. Few courts have construed the preemption provisions of the 1976 Act, and older decisions may presage the difficulties courts will confront when determining the continued vitality of the right of publicity.

A. Federal Preemption and Intellectual Property Policy

Since 1964, the Supreme Court has decided six cases involving alleged federal preemption of state law affecting intellectual property. In *Sears Roebuck & Co. v. Stiffel Co.*,⁹³ and *Compco Corp. v. Day-Brite Lighting, Inc.*,⁹⁴ the lower courts had held that the copying of unpatentable industrial designs violated state unfair competition laws.⁹⁵ The Supreme Court reversed both decisions. The Court held in *Compco* that the state law remedies conflicted with "the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."⁹⁶ In *Sears*, the Court more broadly stated, "[B]ecause of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying."⁹⁷

Although these decisions suggest that states ought not to enforce their laws against unfair competition in a manner that would conflict even indirectly with the objectives of federal copy-

⁸⁹ U.S. CONST. art. I, § 8, cl. 8. See note 21 *supra*.

⁹⁰ See, e.g., 17 U.S.C. §§ 101-118 (Supp. III 1979).

⁹¹ See 35 U.S.C. §§ 1-14 (1977). See also *Goldstein v. California*, 412 U.S. 546 (1973); B. KAPLAN, *supra* note 76, at 92.

⁹² 17 U.S.C. §§ 101-810 (Supp. III 1979).

⁹³ 376 U.S. 225 (1964).

⁹⁴ *Id.* at 234.

⁹⁵ See 376 U.S. at 225-27, 234-35.

⁹⁶ 376 U.S. at 237.

⁹⁷ 376 U.S. at 232. The Court similarly stated in *Compco* that "when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article." *Id.* at 237. See Comment, *supra* note 20, at 480.

right and patent laws,⁹⁸ the Supreme Court in *Lear, Inc. v. Adkins*⁹⁹ suggested a narrower scope of federal preemption.¹⁰⁰ In *Lear*, Justice Harlan recognized in dicta a state's power to enforce a promise to pay royalties for the use of an unpatentable invention while the patent application was pending.¹⁰¹ The Court thus implied that some state-created rights might be sufficiently compelling to justify their disruptive impact on federal intellectual property policy.¹⁰²

The Court subsequently clarified the *Lear* dictum in *Goldstein v. California*,¹⁰³ holding that the constitutional grant of copyright power to Congress was not exclusive. The defendant had argued that the federal Copyright Act of 1909, which excluded sound recordings from its coverage, preempted state protection of such "writings."¹⁰⁴ The Court, however, upheld the constitutionality of a state law that made pirating sound recordings a criminal offense.¹⁰⁵ The Court determined that the legislative history of the Copyright Act of 1909 reflected no congressional intent to foreclose state regulation of a category of writings unregulated by Congress, so long as that regulation did not interfere with federal copyright policy.¹⁰⁶ The *Goldstein* decision thus permitted states to

⁹⁸ See, e.g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 231, 234 (1964). The actual holdings in *Sears* and *Compco* arguably were narrow. Both cases involved subject matter that was unpatentable only because it lacked "novelty." Novelty, however, is not prerequisite for copyright. This may suggest that the Court's holding on preemption specifically applies only to federal regulation of patents, not copyright. Moreover, in each case the lower court's injunctive relief was based on findings that consumers were likely to be confused as to the manufacturer of the items. The Supreme Court concluded in *Compco* that anticipated consumer confusion was best remedied by labeling rather than an injunction forbidding all sales. 376 U.S. at 238-39. Judicial inquiry into likelihood of confusion is not typical in cases of copyright infringement.

Broader interpretation of *Sears* and *Compco* is, however, possible because the federal interests in controlling patents and copyright are so similar that the rationales of *Sears* and *Compco* apply equally to copyright even though neither case involved copyright questions directly.

⁹⁹ 395 U.S. 653 (1969).

¹⁰⁰ One commentator has argued that *Sears* and *Compco* deprived states of the power to apply the passing-off doctrine. Patterson, *Private Copyright and Public Communication: Free Speech Endangered*, 28 VAND. L. REV. 1161, 1195 (1975). The decisions significantly influenced lower courts. See, e.g., *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315 (1st Cir.), cert. denied, 389 U.S. 1007 (1967); *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348 (9th Cir. 1964), cert. denied sub nom., 379 U.S. 989 (1965); *Herald Publishing Co. v. Florida Antennavision, Inc.*, 173 So.2d 469 (Fla. Dist. Ct. App. 1965).

¹⁰¹ 395 U.S. at 674-75.

¹⁰² See Katz, *supra* note 52, at 209.

¹⁰³ 412 U.S. 546 (1973).

¹⁰⁴ *Id.* at 566.

¹⁰⁵ *Id.* at 570-71. See also 1 M. NIMMER, COPYRIGHT § 1.01[A], at 1-3 to 1-6 (1979).

¹⁰⁶ 412 U.S. at 564-69. *Contra*, THE FEDERALIST NO. 43, at 288 (J. Cook ed. 1964) (J. Madison). Advocating federal authority to regulate patents and copyrights, Madison stated, "The States cannot separately make effectual provision for either of these cases." *Id.*

afford copyright protection to published "writings" that did not fall within the scope of the federal copyright law.¹⁰⁷ Further, the Court held that states retained concurrent power to protect some works of authorship that were within the scope of the Copyright Act if such protection did not conflict with the federal law.¹⁰⁸

In later cases, the Court further delineated this latitude for state regulation. In *Kewanee Oil Co. v. Bicron Corp.*,¹⁰⁹ the Court held that federal patent law did not preempt a cause of action under Ohio's state trade secret law.¹¹⁰ Although the misappropriated secret in the case was an unpatentable process, the Court noted that uncontrolled disclosure of the process would not appreciably benefit the public.¹¹¹ The Court made clear that state law would not be preempted merely because it related to intellectual property.¹¹² Rather, states could regulate the use of intellectual property in any manner not inconsistent with federal law.¹¹³ In *Aronson v. Quick Point Pencil Co.*,¹¹⁴ the Supreme Court considered whether federal patent law preempted a state law that allowed enforcement of an agreement to pay royalties on sales of articles embodying an invention for which a patent, though sought, was unissued.¹¹⁵ The court of appeals had found that the state law contravened "the strong federal policy favoring the full and free use of ideas in the public domain" and was thus preempted.¹¹⁶ The Supreme Court reversed. It noted that commercial transactions traditionally are regulated under state law¹¹⁷ and that enforcement of the royalty agreement would not conflict with the aims of the patent system.¹¹⁸

¹⁰⁷ Comment, *supra* note 20, at 481. The *Goldstein* Court predicted that "a conflict would develop if a state attempted to protect that which Congress intended to be free from restraint or to free that which Congress had protected." 412 U.S. at 559.

¹⁰⁸ See 1 M. NIMMER, *supra* note 105, § 1.01[A], at 1-3. Nimmer notes that there was widespread acceptance of the view that the states retained residual concurrent powers to regulate copyright, subject to the primacy of federal law. *Id.*

¹⁰⁹ 416 U.S. 470 (1974).

¹¹⁰ *Id.* at 479. The Court predicted that protection of the rights under state law would not lead to disregard of the federal patent system. *Id.* at 483-93.

¹¹¹ *Id.* at 482-83.

¹¹² In summarizing the *Goldstein* decision, the Court stated that "at least in the case of writings, the states were not prohibited from encouraging and protecting the efforts of those within their borders by appropriate legislation." *Id.* at 478-79.

¹¹³ *Id.* at 479.

¹¹⁴ 440 U.S. 257 (1979).

¹¹⁵ *Id.* at 258-59. The contract obligations did not depend upon the issuance of a patent. *Id.* at 260-61.

¹¹⁶ *Id.* at 261 (citing *Lear, Inc. v. Adkins*, 395 U.S. 653, 674 (1969)).

¹¹⁷ *Id.* at 262.

¹¹⁸ *Id.* at 262-63. The Court also noted that *Sears and Compco* did not require a contrary result because enforcement of the contract would not prevent others from copying the device. *Id.* at 264.

The *Lear*, *Goldstein*, *Kewanee*, and *Aronson* decisions reflected the Court's view that state and federal regulation of intellectual property is concurrent.¹¹⁹ The cases established that federal controls do not displace state statutory or common law protection merely because it relates to intellectual property potentially eligible for federal patent or copyright. State regulation of intellectual property is preempted only when it conflicts with the objectives of federal law.¹²⁰

In the area of copyright law, for example, no court has ever determined that the Constitution's copyright clause, by its own force, precluded all state laws affecting copyright.¹²¹ From 1834, when the Supreme Court upheld the validity of common law copyright,¹²² until the adoption of the Copyright Act of 1976,¹²³ state common law copyright protected unpublished works and federal statutory copyright protected published works.¹²⁴

B. *Preemption of Analogous Rights*

Following the Supreme Court's strong emphasis in *Sears* and *Compco* on the primacy of federal copyright policies, the state law misappropriation doctrine seemed to be a prime candidate for preemption.¹²⁵ Judge Learned Hand long before had argued, in *Cheny Brothers v. Doris Silk Corp.*,¹²⁶ that the *INS* Court, "for reasons of justice," had recognized a kind of "common law patent or copyright."¹²⁷ Hand contended, however, that in general, providing relief for misappropriation was the responsibility of legislatures, not courts.¹²⁸ He later argued that if a person's work is a "writing," the copyright clause of the Constitution forces its owner to choose between a "limited" use that does not constitute publica-

¹¹⁹ See I M. NIMMER, *supra* note 105, § 1.01[A], at 1-6.

¹²⁰ See, e.g., *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479 (1974).

¹²¹ I M. NIMMER, *supra* note 105, § 1.01[A], at 1-3; Katz, *supra* note 52, at 206.

¹²² *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

¹²³ Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. §§ 101-810 (1976 & Supp. III 1979)). The 1976 Act became effective Jan. 1, 1978. 17 U.S.C. § 302(a) (1977).

¹²⁴ I M. NIMMER, *supra* note 105, § 1.01[A], at 103.

¹²⁵ See *Goldstein*, *supra* note 82, at 50.

¹²⁶ 35 F.2d 279 (2d Cir. 1929).

¹²⁷ *Id.* at 280.

¹²⁸ *Id.* at 281. Judge Hand's disapproval of the *INS* doctrine is evident in several later opinions. See, e.g., *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 664 (2d Cir. 1955) (L. Hand, J., dissenting); *G. Ricordi & Co. v. Haendler*, 194 F.2d 914, 916 (2d Cir. 1952); *National Comics Publications, Inc. v. Fawcett Publication, Inc.*, 191 F.2d 594, 603 (2d Cir. 1951); *Fashion Originators Guild v. Federal Trade Comm'n*, 114 F.2d 80, 83-84 (2d Cir. 1940).

tion, or unrestricted dedication of the work to the public.¹²⁹ A contrary policy, Hand insisted, would permit states to confer perpetual protection upon works and thus "defeat the overriding purpose of the [Copyright] Clause, which was to grant only for 'limited Times' the untrammelled exploitation of an author's 'Writings.'"¹³⁰

The First Circuit adopted Judge Hand's broad preemption theory¹³¹ in its first decision in *Columbia Broadcasting Systems, Inc. v. DeCosta (DeCosta I)*.¹³² In *DeCosta I*, the court held that the plaintiff had no right to the exclusive use of a performance name and denied recovery for the unauthorized use of his character concept.¹³³ The court broadly interpreted *Sears and Compco* to require that any creation, whether or not protectible under federal law, must comply with the requirements of the Copyright Act to avoid falling into the public domain.¹³⁴ The court concluded that the strong emphasis in both cases on the predominance of federal interests effectively overruled *INS*.¹³⁵ The court asserted that the federal policy favoring free dissemination of intellectual creations controlled, and that protection against copying would not extend to a character that, in the court's view, was "so slight a

¹²⁹ *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 667 (2d Cir. 1955) (L. Hand, J., dissenting).

¹³⁰ *Id.* Hand cited the need for uniformity as another justification for preemption. *Id.*

¹³¹ See generally Comment, *supra* note 20, at 478-79 (discussing Hand's constitutional preemption argument).

¹³² 377 F.2d 315 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1968).

¹³³ Plaintiff Victor DeCosta had created in himself a performing character that had a moustache and wore an all-black cowboy outfit with a St. Mary's medal attached to his hat. Adopting the name "Paladin," he participated as a spirited horse-rider and quick-draw artist cowboy in parades, rodeos, and fairs in southeastern New England. His popularity grew and over the years he made many public appearances. He distributed about 250,000 business cards bearing the symbol of a chess knight and the inscriptions "Have Gun Will Travel" and "Wire Paladin, N. Court Street, Cranston, R.I." Selling no product or service and charging no fee, DeCosta made appearances that were later viewed as among "the purest promotions ever staged." 377 F.2d at 316.

DeCosta's publicity interests included his created name, Paladin, his calling cards, and his likeness—the hat, moustache, medallion and the all-black outfit—as well as his distinctive performance. Ten years after creating his character, he viewed the first CBS television production of "Have Gun Will Travel." Similarities between television's "Paladin" and the plaintiff's created character were striking. In his action invoking a misappropriation theory against the television network, the defendant's program writers testified that the series was an independent creation. The trial court, however, held for plaintiff on a theory of misappropriation of plaintiff's idea and character. *Id.* at 317.

¹³⁴ The court stated that "if a 'writing' is within the scope of the constitutional clause, and Congress has not protected it, whether deliberately or by unexplained omission, it can be freely copied." *Id.* at 319. See also Comment, *Copyright Pre-emption and Character Values: The Paladin Case as an Extension of Sears and Compco*, 66 MICH. L. REV. 1018 (1968).

¹³⁵ 377 F.2d at 320.

thing as not to warrant protection by any law.”¹³⁶ The court declared that a character that was “ineffable,” and therefore ineligible for copyright protection, was also ineligible for any other protection, state or federal.¹³⁷ Further, because the plaintiff’s calling cards—writings within the meaning of the Copyright Act—had not been published with the requisite notice, they were in the public domain.¹³⁸

Although the plaintiff in *DeCosta I* had sought recovery on the theory of willful misappropriation of idea and character,¹³⁹ the asserted right in *DeCosta I* resembled the right of publicity.¹⁴⁰ DeCosta created a character in himself named Paladin. DeCosta’s own distinguishing features—a moustache, medallion on his hat, black outfit and calling cards—were the elements of both the created character and the performed act. He claimed that CBS had appropriated all of his character’s attributes without his consent. These facts would support the assertion of a right of publicity claim; the plaintiff alleged that CBS appropriated the very name and character by which this entertainer acquired his reputation.¹⁴¹ However, the court’s rationale for concluding that the misappropriation claim was preempted applies by analogy to imply preemption of a right of publicity claim.

The Supreme Court’s decision in *Goldstein v. California*¹⁴² repudiated the expansive constitutional preemption theory followed in the first *DeCosta* case.¹⁴³ In *DeCosta v. Columbia Broadcasting System (DeCosta II)*,¹⁴⁴ decided six years after *DeCosta I*,¹⁴⁵ the First Circuit considered the two remaining counts of the plaintiff’s

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.* at 321.

¹³⁹ Counts two and three of the complaint asserted willful and intentional infringement of the plaintiff’s common law trademark and/or service marks, and unfair competition (passing-off). *DeCosta v. Columbia Broadcasting Sys., Inc.*, 520 F.2d 499, 502 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976). See note 73-86 and accompanying text *supra*.

¹⁴⁰ See Laff & Saret, *supra* note 67, at 55 n.84.

¹⁴¹ *Cf. Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (holding television station’s broadcast of plaintiff’s entire live “human cannonball” act violative of rights of publicity). The “Paladin” character, including its several accouterments, enhanced the attractiveness of the defendant’s commercial product—a new television series. See also *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 838-31, 603 P.2d 425, 444-45, 160 Cal. Rptr. 323, 332-35 (1979) (Bird, C.J., dissenting).

¹⁴² 412 U.S. 546 (1973).

¹⁴³ The Court stated that “[u]nder the Constitution, the States have not relinquished all power to grant to authors ‘the exclusive Right to their respective Writings.’” *Id.* at 560. See *Diamond*, *supra* note 74, at 211.

¹⁴⁴ 520 F.2d 499 (1st Cir. 1975).

¹⁴⁵ See notes 132-38 and accompanying text *supra*.

original complaint, along with a challenge to the exercise of jurisdiction by a magistrate who had been appointed to decide the first count by a district court.¹⁴⁶ The two counts in issue concerned alleged common law trademark infringement and unfair competition.¹⁴⁷

The court acknowledged that *Goldstein* mandated a retreat from its earlier expansive reading of *Sears* and *Compco*, which had precluded state protection of writings not covered by the Copyright Act.¹⁴⁸ Accepting the trial court's finding that "at least among some people, plaintiff's name and card had come to be associated with him,"¹⁴⁹ the First Circuit viewed the central issue as whether the lower court's finding of likelihood of confusion was clearly erroneous.¹⁵⁰ Noting "that plaintiff has lost something of value to him" and that "the very success of the defendant's series saturated the public consciousness and in time diluted the attractiveness of plaintiff's creation,"¹⁵¹ the court nevertheless found that several factors precluded a finding of likelihood of confusion.¹⁵² The loss, therefore, could not be protected under several related state common law theories.¹⁵³

¹⁴⁶ See *id.* at 502.

¹⁴⁷ The plaintiff alleged that this "Have Gun Will Travel" slogan, along with the figure of a chess knight and the words "Wire Paladin" on his calling cards, constituted common law service marks. The defendant's appropriation allegedly infringed the service marks and thus damaged the plaintiff by detracting from his goodwill. DeCosta also alleged that CBS copied his marks and manner of dress, and then passed off the character as original. CBS thus diluted his goodwill and thereby unjustly profited. *Id.* at 509.

¹⁴⁸ *Id.* at 510. The court's 1967 interpretation had precluded any state sanction, whether based on service mark infringement or unfair competition, that prohibited copying permitted under federal law. *Id.* See Laff & Saret, *supra* note 67, at 44. One commentator has thus argued that the Court acknowledged in *DeCosta II* that it had erred by allowing *Sears* and *Compco* to influence its interpretation in *DeCosta I*. Diamond, *supra* note 74, at 211.

¹⁴⁹ 520 F.2d at 513. The court recognized that *Sears* and *Compco* permitted state protection of marks, labels and trade dress. *Id.* at 509-11. In the case it assumed the existence in the case of valid common law service marks that were distinctive or, alternatively, that had acquired secondary meaning. *Id.* at 511-12.

¹⁵⁰ *Id.* at 514. See Laff & Saret, *supra* note 67, at 45.

¹⁵¹ 520 F.2d at 515.

¹⁵² *Id.* at 514-15. The court used the defense of laches, based on the plaintiff's eleven year delay in filing suit, as justification for increasing the burden on the plaintiff to prove likelihood of confusion. It reasoned that a lack of public deception after a substantial lapse of time supports the defense that the allegedly infringing use created no likelihood of confusion. *Id.* The plaintiff failed to carry this heavier burden of proving likelihood of confusion. The virtually identical nature of the marks was insufficient. Extrinsic differences, such as the gross disparity in the size of the parties' audiences, the difference in type of "customers" or channels of trade, along with the plaintiff's haphazard manner of performance, precluded a finding of likelihood of confusion. *Id.* See Laff & Saret, *supra* note 67, at 45.

¹⁵³ Laff & Saret, *supra* note 67, at 45.

The two *DeCosta* decisions establish that the mere copying of a distinctive character, service mark, or style of appearance or dress is insufficient to establish liability in the absence of copyright protection or a clear showing of likelihood of confusion.¹⁵⁴ Despite the *DeCosta* plaintiff's acknowledged loss, and despite the fact that CBS used his publicity interests to create a successful television series,¹⁵⁵ the court denied recovery in each case. The similarity between DeCosta's unsuccessful assertions and the right of publicity suggests that a publicity theory claim also would have failed either on preemption grounds or because of plaintiff's inability to prove likelihood of confusion.

In *Sinatra v. Goodyear Tire and Rubber Co.*,¹⁵⁶ the Ninth Circuit similarly denied protection to an interest in publicity rights.¹⁵⁷ Nancy Sinatra brought an unfair competition action against an advertiser whose television commercials adopted the music and revised lyrics of a song that she had made popular, "These Boots Are Made For Walkin'." Although the plaintiff did not have a copyright on the melody or lyrics, she alleged that her name was identified with the song, and that she was best known by her connection with it. She claimed that her rendition of the song and its arrangement had acquired secondary meaning, and charged that the women who appeared in the disputed advertisements imitated her dress, mannerisms and style of delivery.¹⁵⁸ The plaintiff complained that this imitation deceived the public by causing them to believe that she had participated in the commercials.¹⁵⁹ Although the defendants admitted that they had imitated the plaintiff's own

¹⁵⁴ *Id.* In an earlier case, *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928), a California court enjoined the unauthorized imitation of the plaintiff's distinctive character creation, "Charlie Chaplin," emphasizing the concreteness given to the character through plaintiff Chaplin's creative expression. The injunction prevented the defendant from imitating Chaplin in a manner that would deceive the public and work a fraud upon both the public and Chaplin. In the court's view, the plaintiff was entitled to protection against passing-off that would constitute unfair competition in business independent of any trademark or tradename rights. *Id.* at 363, 269 P. at 546.

Like Chaplin, DeCosta created a "character," directed it into production and gave it substance through performances. Note, *supra* note 48, at 563. Aside from the finding of passing-off in *Chaplin*, the two causes of action are indistinguishable.

¹⁵⁵ The defendant's television series' gross earnings exceeded \$14 million at the time DeCosta brought his original action in the Rhode Island District Court. Comment, *supra* note 134, at 1018.

¹⁵⁶ 435 F.2d 711 (9th Cir. 1970).

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 712.

¹⁵⁹ *Id.* The plaintiff essentially was attempting to prove passing-off for likelihood of confusion.

style of performance,¹⁶⁰ the court denied relief on the ground that protection of the plaintiff's interests would clash with federal law.¹⁶¹

Nancy Sinatra's cause of action was indistinguishable from a direct right of publicity claim. The defendants in *Sinatra* invaded the plaintiff's exclusive right to exploit and control the use of her likeness, style and performance. These characteristics had acquired pecuniary value through the plaintiff's skills and efforts, and the defendants' imitation enhanced the sales of their product while injuring the value of her interests. Unlike most right of publicity claims, which involve the commercial use of the plaintiff's name or likeness, the defendant in *Sinatra* appropriated only plaintiff's singing style and rendition of a song. The distinction, however, is unimportant; the damage to the plaintiff's economic interests in either case would be the same.¹⁶²

A federal district court reached a similar result in *Booth v. Colgate-Palmolive Co.*¹⁶³ The plaintiff, actress Shirley Booth, sued an advertiser and its agency for damages allegedly resulting from their commercial imitation of the voice she had used as a star of the popular television comedy series, "Hazel." The court rejected plaintiff's unfair competition count on the basis of the emphasis in *Sears* and *Compco* on the federal policy of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.¹⁶⁴ The court cited *Sinatra* and *DeCosta* to support its conclusion that the defendant's imitation of the plaintiff's voice, without more, did not constitute unfair competition.¹⁶⁵

¹⁶⁰ Note, *supra* note 48, at 565.

¹⁶¹ 435 F.2d at 715-18. The court found that the public had not been misled into thinking that the commercials were the product of plaintiff's skills and efforts. Citing the *Sears* and *Compco* cases, the court noted that imitation alone did not justify relief. *Id.* at 717. The court feared that a proposed licensee might become discouraged if he had to "pay each artist who has played or sung the composition and who might therefore claim unfair competition—performer's protection. . . ." *Id.* at 718.

¹⁶² Recognized legal distinctions exist between copying, imitation and appropriation. For example, Nimmer has emphasized the Supreme Court's finding that the defendants liable in *INS* and *Goldstein* had gone beyond copying and had taken more than the plaintiffs' specific products. Appropriation may arise because of improvement and refinement in the means of copying. 1 M. NIMMER, *supra* note 105, § 1.01(b)(1), at 1-17 to 1-19. One court has noted that "[i]n the setting of contemporary business practices, there is a critical, albeit fine, line separating commercial parroting from pirating." *Columbia Broadcasting Sys., Inc. v. Melody Recordings, Inc.*, 134 N.J. Super. 368, 377, 341 A.2d 348, 353 (1975). The distinction, however, is usually economically insignificant to plaintiffs and arguably should not affect their rights to recovery.

¹⁶³ 362 F. Supp. 343 (S.D.N.Y. 1973).

¹⁶⁴ *Id.* at 347.

¹⁶⁵ *Id.* at 345-47.

In support of her unfair competition claim, the plaintiff had alleged that the defendants infringed her right of publicity.¹⁶⁶ Although the commercials did not use her name and likeness or in any way identify her as the source of the voice,¹⁶⁷ the defendants conceded that they intended the voice in the advertisement to sound like the plaintiff.¹⁶⁸ A substantial portion of the television audience, moreover, probably thought that the person speaking in the advertisement was the plaintiff or at least the same person who played and developed the character "Hazel" in that television series.¹⁶⁹

Nevertheless, the court held that the plaintiff's right of publicity theory failed because she was unable to show that the defendants actually used her name or likeness.¹⁷⁰ The court rejected the plaintiff's contention that performers have a protected property right in their performances¹⁷¹ that could be protected from direct and indirect misappropriation.¹⁷² The court's discussion of the right of publicity claim was cursory, but suggests that the plaintiff's cause of action would have been preempted even if the defendants had actually used Booth's likeness.

C. Preemption of the Right of Publicity Before 1978

Many courts have not confronted directly the possible preemption of the right of publicity. For example, no right of publicity claim was asserted in either the *Sinatra* or *DeCosta* cases.¹⁷³ In *Booth*, the defendants' conduct did not infringe the

¹⁶⁶ *Id.* at 347.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 345.

¹⁶⁹ See Note, *supra* note 48, at 563-64.

¹⁷⁰ 362 F. Supp. at 348-49.

¹⁷¹ *Id.* at 345.

¹⁷² *Id.* at 345-47. As additional support for her claim of unfair competition, the plaintiff alleged that the voice she used in playing the part of "Hazel" was so closely connected with the Hazel television series that her voice had acquired a secondary meaning, and that defendants had attempted to deceive the public into thinking that she personally endorsed defendant's product. *Id.* at 348. The court, however, rejected this theory because she did not show that her voice functioned as a trademark or tradename, or that she had ever marketed it to promote any product or service in competition with defendant's product. *Id.* at 349. Furthermore, the court believed that the federal policy (reaffirmed in *Sears* and *Compco*) permitting imitation should prevail over the plaintiff's interest in protecting the secondary meaning in her voice. *Id.* at 347-48. The court's partial reliance on preemption grounds in dismissing this unfair competition theory suggests that federal preemption by the 1976 Copyright Act would similarly have refuted, in the court's view, her right of publicity arguments.

¹⁷³ See notes 132-54, 156-61 and accompanying text *supra*. See also *Davis v. Trans-World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969). In this case, as in *Sinatra*, the court held that

plaintiff's right of publicity because the disputed commercials used the plaintiff's interests anonymously.¹⁷⁴ However, the interests that these courts held unprotectible are almost indistinguishable from those protected in *Price v. Hal Roach Studios*,¹⁷⁵ in which a district court held that the federal copyright law did not preempt the right of publicity.¹⁷⁶

Hal Roach involved a dispute over the ownership of the commercial rights in the names and likenesses of Laurel and Hardy. Plaintiffs were the comedians' widows who were sole beneficiaries of the deceased comedians' estates, and an entrepreneur who had been granted the exclusive right to use and merchandise in perpetuity the names, likenesses, characters, and characterizations of Laurel and Hardy.¹⁷⁷ The defendants purported to hold the exclusive world-wide merchandising rights to the deceased comedians' names and likenesses. The plaintiffs asserted that the defendants were not entitled to merchandising rights because the defendants' asserted control conflicted with plaintiffs' exclusive commercial rights. They alleged, in essence, that the defendants had wrongfully appropriated rights of publicity in the characters of Laurel and Hardy.¹⁷⁸

The defendants contended that they were not precluded from using the disputed names and likenesses. They argued that the interests were in the public domain, "either because plaintiffs never had any exclusive right to their commercial use" or "because they waived whatever rights they had."¹⁷⁹ They also argued that "articles not protected by federal law from [imitation] are not otherwise protectible" under a state right of publicity because this right is preempted by the federal copyright laws.¹⁸⁰

The court concluded that during their lifetimes Laurel and Hardy clearly had property rights in their names and likenesses,¹⁸¹ that these publicity rights survived their deaths,¹⁸² and that there

the defendants had not committed the tort of passing-off where singers in their television commercial anonymously copied part of a song popularized by plaintiff's singing group, the "Fifth Dimension."

¹⁷⁴ See *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252, 258 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979).

¹⁷⁵ 400 F. Supp. 836 (S.D.N.Y. 1975). See *Laff & Saret*, *supra* note 67, at 53-55.

¹⁷⁶ 400 F. Supp. at 846.

¹⁷⁷ *Id.* at 838 & n.2.

¹⁷⁸ *Id.* at 839.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.* at 843-46.

¹⁸¹ *Id.* at 844.

¹⁸² *Id.* at 844-45.

was no evidence of any action constituting a waiver.¹⁸³ Further, the court held that federal copyright laws did not preempt the right of publicity. Quoting *Goldstein v. California*,¹⁸⁴ the court observed:

[W]here Congress determines that neither federal protection nor freedom from restraint is required by the national interest, it is at liberty to stay its hand entirely. Since state regulation would not then conflict with federal action, total relinquishment of the States' power to grant copyright protection cannot be inferred.¹⁸⁵

Without further analysis, the court stated that this conclusion logically foreclosed any argument that federal laws preempt state protection in forms other than copyright laws.¹⁸⁶

Although the *Hal Roach* court held that state protection of the right of publicity did not conflict with federal protection of similar interests, it did not compare rights protected by the publicity doctrine with rights within the scope of the copyright law, nor did it analyze their respective objectives and available remedies.¹⁸⁷ Indeed, the court's holding conflicts with the *DeCosta*, *Sinatra* and *Booth* decisions, which based denials of state law protection of analogous publicity interests in part upon the preemption doctrine.¹⁸⁸

The logic of these cases supports a contrary result in *Hal Roach*.¹⁸⁹ Nevertheless, the summary conclusion in *Hal Roach* subsequently received support in *Zacchini v. Scripps-Howard Broadcasting Co.*,¹⁹⁰ in which the Supreme Court recognized the right of publicity and indicated that a right of publicity claim is not

¹⁸³ *Id.* at 846-47.

¹⁸⁴ 412 U.S. 546 (1972) (discussed at notes 103-08 and accompanying text *supra*).

¹⁸⁵ 400 F. Supp. at 846 (quoting *Goldstein v. California*, 412 U.S. 546, 559 (1972)). The defendants in *Hal Roach* cited the *Goldstein*, *Sears*, and *Compco* decisions for the proposition that "articles not protected by federal law from limitation [*sic*] are not otherwise protectible." *Id.* at 846.

¹⁸⁶ 400 F. Supp. at 846.

¹⁸⁷ The Supreme Court had stated expressly in *Goldstein* that federal power to regulate copyright was nonexclusive. 412 U.S. at 569-70.

¹⁸⁸ See Laff & Saret, *supra* note 67, at 55 & n.84.

¹⁸⁹ In *Hal Roach* the court distinguished the *Booth* case by emphasizing that the former involved anonymous commercials that did not use plaintiff's name or likeness to identify her as the source of the voice. 400 F. Supp. at 845. The court also said that "[t]here are many such cases where a claim is too abstract to be a protectible right or thought to be mere imitation which is not protectible." *Id.* at 845. *Worldvision*, in contrast, enjoined the imitation of the Laurel and Hardy characters.

¹⁹⁰ 433 U.S. 562 (1977).

preempted by federal law.¹⁹¹ The Court emphasized that protecting the right of publicity provides “an economic incentive for [the performer] to make the investment required to produce a performance of interest to the public.”¹⁹² Federal patent and copyright laws, the Court said, share this purpose¹⁹³ because they are “intended definitely to grant valuable, enforceable rights” that will encourage the production of publicly beneficial works.¹⁹⁴ Recognizing this equivalence of objectives, the Court concluded that the Constitution does not prevent states from similarly protecting an entertainer’s interests in the value of his performance in order to encourage beneficial productivity.¹⁹⁵

Allowing states to protect performers and their acts is consistent with permitting states to enact copyright and patent protection for forms of intellectual property unprotected by federal law.¹⁹⁶ However, although the question of federal preemption of state copyright and patent legislation was squarely before the Court in the *Goldstein* and *Kewanee* cases, the Court in *Zacchini* did not directly consider federal statutory preemption of state-created right of publicity protection.¹⁹⁷ Furthermore, the *Zacchini* case concerned only one of the many interests that the

¹⁹¹ *Id.* at 577. Apparently, the defendant did not assert a preemption defense to the state law claim in the case. At least the briefs did not address the issue. Nevertheless, the *Zacchini* decision has been viewed as part of the trend to distinguish the strong emphasis on overriding federal policies evident in *Sears* and *Compco*. See Diamond, *supra* note 74, at 211 n.44.

¹⁹² 433 U.S. at 576.

¹⁹³ *Id.*

¹⁹⁴ *Washington Publishing Co. v. Pearson*, 306 U.S. 30, 36 (1939).

¹⁹⁵ 433 U.S. at 577 (citing *Goldstein v. California*, 412 U.S. 546 (1973) and *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974)).

¹⁹⁶ Note, *supra* note 9, at 1215 n.86. In *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), the court upheld the plaintiff’s assertion of rights of publicity. The court’s holding derived from its observation that the Supreme Court’s *Goldstein* and *Kewanee* decisions, as interpreted in *Zacchini*, do not preclude state protection of this form of intellectual property that is unprotected by federal law. *Id.* at 1100. The defendants, however, argued that federal copyright protection provided in the 1976 Copyright Act preempted not only state protection of copyright, but the common law right of publicity as well. *Id.* at 1096-97. The court reaffirmed its prior rejection of preemption arguments in holding that the right of publicity in issue had survived the death of its owner and creator. *Id.* at 1093. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977), *aff’d*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

¹⁹⁷ See Note, *supra* note 9, at 1215. At issue in *Zacchini* was whether the first amendment rendered the appropriation of an entire performance privileged because it had been presented as news. The Court granted certiorari “to consider an issue unresolved by [the] Court: whether the First and Fourteenth Amendments immunized respondent from damages for its alleged infringement of petitioner’s state-law ‘right of publicity.’” 433 U.S. at 565. The Court expressly declined to decide more than the narrow issue before it. *Id.* at 579 (Powell, J., dissenting). No first amendment claim was made in *Goldstein* or *Kewanee*.

right of publicity comprehends—the right to control exploitation of one's performance—and omitted discussion of the duration of that right. Similarly, the court in *Hal Roach* did not analyze whether state protection of the plaintiffs' exclusive rights to the deceased comedians' names, likenesses, characters, and characterizations obstructed congressional copyright law objectives.

It is uncertain whether copyright protection extends to characters that are clearly developed in copyrighted materials.¹⁹⁸ If, however, federal copyright protection is available for such characters in some circumstances, then concurrent state protection under the right of publicity might be preempted. In addition, the perpetual nature of right of publicity protection is irreconcilable with the limited duration of copyright protection. Because the *Hal Roach* court did not resolve these issues, it is not clear that *Goldstein*, in which the Court held that Congress's copyright powers are not exclusive, would permit state protection of all the interests that the *Hal Roach* decision recognized under the right of publicity.¹⁹⁹

Although the *Hal Roach* and *Zacchini* decisions suggest that states may protect the right of publicity, it is still not clear that all types of publicity actions are secure from preemption challenges. Although decided before *Goldstein*, the *Decosta*, *Sinatra* and *Booth* decisions may undermine the validity of many right of publicity actions. Nevertheless, the restrictive preemption analyses in *Hal Roach* and *Zacchini* appear inappropriate for publicity rights when publicity doctrine and copyright are distinguished with respect to

¹⁹⁸ Compare *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978) (cartoon characters in books and comic strips copyrightable), with *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967) (television producers not liable to originator of early west character in absence of copyright for character's calling cards) and *Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc.*, 216 F.2d 945 (9th Cir. 1954) (use by author of character and character names from copyrighted mystery work in subsequent mystery works did not constitute unfair use and competition against purchaser of rights in copyrighted mystery work) and *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930) (playwright's copyright on property did not extend to ideas). See also notes 285-95 and accompanying text *infra*.

¹⁹⁹ See *Price v. Hal Roach Studios*, 400 F. Supp. 836, 846 (S.D.N.Y. 1975). The injunction granted in *Hal Roach* restrained the defendant's use of the names, likenesses, characters, and characterizations of Laurel and Hardy. It prohibited the use of photographs or other reproductions of their likenesses, and the impersonation of their likenesses through the copying of costumes, mannerisms or voices. *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252, 256 (S.D.N.Y. 1978). *Goldstein* does not expressly preclude preemption of such broad state-law protection.

subject matter, objectives and goals, rights and remedies, and duration of protection.²⁰⁰

III

THE COPYRIGHT ACT OF 1976 AND THE RIGHT OF PUBLICITY

Section 301 of the Copyright Act of 1976²⁰¹ embodies the most fundamental change in the copyright system "since its inception."²⁰² It creates a single system of federal protection for all "original works of authorship," published or unpublished, from the moment they are fixed in a tangible medium of expression.²⁰³ This provision effectively abolishes the dual character of copyright law and expands federal preemption of common law copyright.²⁰⁴

²⁰⁰ The recent decision in *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F.Supp. 1090 (S.D.N.Y. 1980), states that the right publicity is *not* preempted by the 1976 Copyright Act. Because the action in the case arose in 1977, however, before the 1976 Act became effective, the court's analysis of preemption under § 301 was unnecessary. Arguably, the court only had to address preemption through a *Goldstein* analysis, as in the *Hal Roach* and *Zacchini* cases. In any event, several preemption arguments that arose prior to the 1976 Act's effective date remain viable under the revised federal copyright law.

²⁰¹ Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C. §§ 101-810 (Supp. III 1979)). The law became effective Jan. 1, 1978, *see* 17 U.S.C. § 302(a) (Supp. III 1979), except for §§ 118, 304(b), and chapter 8, which became effective upon enactment. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2598 (1976).

²⁰² *See* U.S. COPYRIGHT OFFICE, GENERAL GUIDE TO THE COPYRIGHT ACT OF 1976 2:1 (1977).

²⁰³ 17 U.S.C. § 301 (Supp. III 1979). *See* A. LATMAN, *supra* note 20, at 12.

²⁰⁴ *See, e.g.*, 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-8. Section 301 substantially mitigates the impact of the intellectual property preemption decisions on state copyright law. *See* notes 99-110 and accompanying text *supra*. The Supreme Court in the *Zacchini* case had cited many of the older decisions when it compared the rationale for state protection of publicity interests with the objectives of the federal patent and copyright laws. *See Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977). Congress's attempt to cover the field and preempt state law came at a time when the Supreme Court seemed to be retreating from the emphasis it had previously placed in *Sears* and *Compco* on federal preemption of state law. *See* notes 98-124 and accompanying text *supra*. In *Goldstein* the Court noted that "[u]ntil and unless Congress takes further action with respect to recordings . . . , the California statute may be enforced against acts of piracy such as those which occurred in the present case." 412 U.S. at 571 (emphasis added). Similarly, in *Kewanee* the Court stated:

Just as the States may exercise regulatory power over writings so may the States regulate with respect to discoveries. States may hold diverse viewpoints in protecting intellectual property relating to invention as they do in protecting the intellectual property relating to the subject matter of copyright. The only limitation on the States is that in regulating the area of patents and copyrights they do not conflict with the operation of the laws . . . passed by Congress. . . .

416 U.S. at 479. These decisions, as well as *Quick Point* and *Zacchini*, challenge the effect of the *Sears-Compco* doctrine and diminish its impact on state law. ABA SECTION OF PATENT TRADEMARK AND COPYRIGHT LAW, 1978 COMMITTEE REPORTS 126 (1978).

Section 301(a) provides that any state law,²⁰⁵ whether based on common law or statute, is subject to federal preemption if: (1) it creates "legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106";²⁰⁶ and (2) such rights under state law may be claimed in "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . ." ²⁰⁷ Thus, the two criteria for state law preemption concern the nature of the rights themselves and the nature of the work in which such rights may be claimed.²⁰⁸

Section 301(b) is the obverse of 301(a). It preserves rights and remedies under state statutes or common law with respect to "subject matter that does not come within the subject matter of copyright . . . including works of authorship not fixed in any tangible medium of expression."²⁰⁹ In addition, the 1976 law does not annul or limit state protection of "activities violating legal or equitable rights *that are not equivalent* to any of the exclusive rights within the general scope of copyright . . ." ²¹⁰ Thus, states may protect interests that are not equivalent to those protected by

²⁰⁵ Section 301(a) not only explicitly abolishes state common law copyright for literary property, it also reflects clear congressional intent to preempt and abolish any rights under the common law or statutes of a state that are equivalent to any of the exclusive rights that copyright owners enjoy under the new Act and that extend to works coming within the scope of the federal copyright law. Under this section, all rights in the nature of copyright, including legal or equitable rights, are governed exclusively by the federal copyright statute if the work is of a kind covered by the statute. *See* HOUSE JUDICIARY COMM., REPORT ON S. 22, H.R. REP. No. 1476, 94th Cong., 2d Sess., *reprinted in* [1976] U.S. CODE CONG. & AD. NEWS 5659, 5745-46 [hereinafter cited as H. REP.].

²⁰⁶ 17 U.S.C. § 301(a) (Supp. III 1979). Section 106 of the Copyright Act provides: Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative work based upon the copyrighted works;
- (3) to distribute copies of phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audio-visual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

17 U.S.C. § 106 (Supp. III 1979).

²⁰⁷ 17 U.S.C. § 301(a) (Supp. III 1979). *See* 1 M. NIMMER, *supra* note 119, § 1.01[B], at 1-9 (discussing § 301 preemption).

²⁰⁸ 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-9.

²⁰⁹ 17 U.S.C. § 301(b) (Supp. III 1979).

²¹⁰ *Id.* §§ 301(b)(1), 301(b)(3) (Supp. III 1979) (emphasis added).

copyright as well as noncopyrightable subject matter. All rights equivalent to copyright in works within the subject matter of copyright are now governed exclusively by federal law.²¹¹

The broad preemptive effect of the 1976 Act may undercut the rationales of *Zacchini* and *Hal Roach*. Because the Act significantly restricts state regulatory power over writings,²¹² it diminishes the significance of the Supreme Court's holding in *Goldstein* that the Constitution does not preclude all state regulation of copyright.²¹³ Yet although the thrust of section 301 is clear, its precise preemptive effect on state law is uncertain.²¹⁴ In cases where section 301's prohibitions apply directly, its preemptive effects are evident. There are other areas, however, in which the reach of federal copyright law is dubious and for which the question of state law preemption is critical.²¹⁵ Determining the scope of the preemption under the 1976 Act involves two inquiries: (1) what constitutes noncopyrightable subject matter; and (2) what rights are not equivalent to those granted under the copyright law?²¹⁶

Noncopyrightable subject matter includes works that are not fixed in any tangible medium of expression.²¹⁷ A work is "fixed" if it is "sufficiently permanent or stable to permit it to be per-

²¹¹ Sections 301(a) and (b) together make it clear that the requirements for preemption include a subject matter test and an equivalent rights test. See A. LATMAN *supra* note 20; Comment, *supra* note 20, at 490. Occurrence of preemption appears to turn primarily on the types of works involved (literary, musical etc.). Diamond *supra* note 74, at 206 n.10.

²¹² See 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-7 to 1-8.

²¹³ See Katz, *supra* note 52, at 211.

²¹⁴ 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-8. Professor Nimmer doubts whether § 301 achieves the objective of using clear language to foreclose misinterpretation and avoid vague borderlines between state and federal protection. *Id.* (citing H. REP., *supra* note 205, at 130). The basic question remains: how much of the state statutory and common law does the 1976 Act leave intact to develop further? See A. LATMAN, *supra* note 20, at 64.

²¹⁵ Goldstein, *supra* note 62, at 1112.

²¹⁶ *Id.* See Katz, *supra* note 52, at 211. The conditions for preemption may be viewed as a codification of the *Goldstein* decision, which indicated that categories of writings that Congress has brought within the scope of the federal statute are no longer eligible for state law protection. See 1 M. NIMMER, *supra* note 105, § 1.01[B](2), at 1-19. See also notes 102-09 and accompanying text *supra*. "Works of authorship" are not necessarily limited to the seven broad categories of works listed under § 102(a) because those categories are "illustrative and not limitative" and do not exhaust the scope of the original works the 1976 Act is intended to protect. H. REP., *supra* note 214, at 53. See 17 U.S.C. § 101 (Supp. III 1979). The phrase was deliberately left undefined and neither the 1976 Act nor the several committee reports indicate what kind of works are completely outside the present congressional intent. See H. REP., *supra* note 205, at 51; 1 M. NIMMER, *supra* note 105, § 2.03[A], at 2-25 to 2-26. Consequently, courts are able to find copyright protection for types of works not expressly included in § 102(a)'s enumeration. See 1 M. NIMMER, *supra* note 105, § 2.03[A], at 2-28.

²¹⁷ 17 U.S.C. § 301(a)-(b) (Supp. III 1979).

ceived . . . for a period of more than a transitory duration.”²¹⁸ Thus, unfixed works may include extemporaneous speeches, works communicated only through conversations or live broadcasts, unfiled choreography, and improvised dramatic sketches or musical compositions that are unrecorded and unwritten.²¹⁹ Until fixed in tangible form, states may protect such works²²⁰ even by creating rights that are doctrinally equivalent to copyright.²²¹

Rights “not equivalent” to those granted under the copyright law are rights that are infringed by more than the mere act of reproduction, performance, distribution or display. Professor Nimmer observes that “if other elements are required, in addition to or instead of, the acts of reproduction . . . in order to constitute a state created cause of action, then the right does not lie ‘within the general scope of copyright,’ and there is no preemption.”²²² Section 301’s legislative history does not shed much light on the meaning of this limitation. Early versions of section 301 expressly preserved state remedies for breaches of trust and contract, invasions of privacy, trespass, conversion, and deceptive trade practices such as passing off and false representation.²²³ Accompanying committee reports, however, observed that the legislation would preempt causes of action commonly referred to as “misappropriation” actions.²²⁴ Later drafts expanded the examples of non-

²¹⁸ 17 U.S.C. § 101 (Supp. III 1979). Fixation can be “in any tangible medium of expression now known or later developed, from which [the work] can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. §§ 101, 102(a) (Supp. III 1979).

²¹⁹ 17 U.S.C. § 101 (Supp. III 1979). See S. REP. NO. 473, 94th Cong., 1st Sess. 114 (1975); H. REP., *supra* note 205, at 131. Section 101 provides that “[a] work consisting of sounds, images, or both, that are being transmitted, is fixed for purposes of this title if a fixation of the work is being made simultaneously with its transmission.”

²²⁰ See H. REP. *supra* note 205, at 131. The states cannot, however, protect a work within §§ 102 and 103 that fails to achieve copyright protection because of *de minimis* creativity, lack of originality, or because it is in the public domain. *Id.*

²²¹ 1 M. NIMMER, *supra* note 105, § 101[B](2)(a), at 1-21. Because it is clear that the states retain power to protect unfixed works, it would seem that the *DeCosta*, *Sinatra*, and *Booth* decisions, which cited *Sears* and *Compco* in stating that state protection of characters and voices was preempted, require reexamination. See Comment, *supra* note 20, at 491. However, it is also arguable that because these interests have been fixed by photographs, films, tapes, and records, they remain not subject to state law protection. See note 284-324 and accompanying text *infra*.

²²² 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-11. “If under state law the act of reproduction, performance, distribution of display . . . will *in itself* infringe the state created right, then such right is preempted.” *Id.* In many situations there is, however, a collateral wrong such as an invasion of privacy or a breach of trust or confidentiality.

²²³ See HOUSE JUDICIARY COMM., 88th CONG., 2d Sess., PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW AND DISCUSSIONS AND COMMENTS ON THE DRAFT 18 (Comm. Print 1964); H.R. 4347, 89th Cong., 2d Sess. (1966).

²²⁴ See, e.g., H.R. REP. NO. 83, 90th Cong., 1st Sess. 100 (1967).

preempted rights to include misappropriation actions that are *not* equivalent to any of the rights exclusively within copyright.²²⁵ In 1976, the Justice Department objected to preserving misappropriation actions under state law, arguing that to permit such actions would vitiate the purpose of section 301 by sanctioning the use of a highly anticompetitive theory.²²⁶ The Justice Department argued that the misappropriation doctrine was potentially applicable whenever a person imitated a work developed at another's expense.²²⁷

In an effort to preserve section 301, legislators offered from the floor of Congress an amendment²²⁸ to the pending copyright legislation that deleted all examples of preserved state rights including "rights against misappropriation." The proposal received support from the Justice Department,²²⁹ and Congress accepted the amendment.²³⁰ The surrounding debate, however, obscured the intent of Congress. Consequently, it remains unclear whether any or all of the examples deleted from section 301(b)(3) are available to courts seeking to construe section 301,²³¹ and thus the boundaries of the preemption section are blurred.²³²

Legislative history supports the view that Congress did not intend section 301 to change the existing state of the law, "as it may exist in certain States that have recognized the right of recovery relating to 'misappropriation.'" ²³³ On the other hand, the Justice Department's original purpose in proposing the deletions

²²⁵ See, e.g., S. 22, 94th Cong., 2d Sess. § 301(b)(3) (1976). Trespass and conversion were also added to the illustrations of nonpreempted rights.

²²⁶ The Justice Department wrote two letters in 1976 objecting to the inclusion of misappropriation as an example of a nonpreempted right. It characterized the *INS* decision as "much criticized" and "contrary to the great weight of authority." Letter to Senator Hugh Scott from Thomas E. Kauper, Assistant Attorney General, Antitrust Division (Feb. 13, 1976); Letter to Senator Robert Kastenmeier from Michael M. Uhlmann, Assistant Attorney General, Legislative Affairs (July 27, 1976) [hereinafter cited as Letter of July 27, 1976]. The portions of both letters that protested § 301(b)(3)'s reference to misappropriation are substantially identical.

²²⁷ See Letter of July 27, 1976, *supra* note 226. The Department also argued that copying is often a commercial necessity that is neither unlawful nor immoral but instead promotes competition. *Id.* Although the Department's primary objection concerned misappropriation it also suggested deleting the other causes of action listed in § 301(b)(3) on the ground that they similarly could be construed to negate preemption. *Id.*

²²⁸ See 122 CONG. REC. 32015 (1976).

²²⁹ See *id.*

²³⁰ See generally A. LATMAN, *supra* note 20, at 67; 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-15 to 1-16.

²³¹ See Goldstein, *supra* note 62, at 1114.

²³² A. LATMAN, *supra* note 20, at 66-67.

²³³ 122 CONG. REC. 32015 (1976) (exchange between Representatives Railsback and Seiberling). One commentator concludes that the Senate and House Reports imply non-

was to restrict the scope of misappropriation under state law.²³⁴ Although the examples, other than misappropriation, may still illustrate prototypical nonpreempted rights, section 301's preemptive effect on misappropriation itself is uncertain.²³⁵ Misappropriation actions may escape preemption in cases where the poaching does not involve works of authorship or is "not equivalent" to rights under copyright.²³⁶

Because the right of publicity resembles misappropriation and common law copyright, its status may appear similarly uncertain.²³⁷ Nevertheless, the *Zacchini* and *Hal Roach* cases suggest that this evolving state common law right remains intact.²³⁸ The legislative history of the 1976 Act indicates that section 301 does not affect right of publicity claims involving conduct—such as the invasion of personal rights or a breach of trust or confidence—that differs from copyright infringement.²³⁹ Moreover, characterizing an individual's name or likeness as a work of

preemption of state law misappropriation rights. See A. LATMAN, *supra* note 20, at 67. He notes, however, that the reports were issued prior to the deletions from the statute. *Id.* (citing S. REP. NO. 473, 94th Cong., 1st Sess. 115-16 (1975); H. REP. NO. 1476, 94th Cong., 2d Sess. 131-32 (1976)).

²³⁴ A. LATMAN, *supra* note 20, at 68; 1 M. NIMMER, *supra* note 105, § 1.01[B](1), at 1-15 to 1-16; Comment, *supra* note 20, at 488-89. Diamond argues that the deletion has no substantive effect, but nevertheless may have some unascertainable significance. Diamond, *supra* note 74, at 212.

²³⁵ A. LATMAN, *supra* note 20, at 69. The doctrine's amorphous character compounds the uncertainty of preemption. Goldstein, *supra* note 62, at 1116. See also 1 M. NIMMER, *supra* note 105, § 1.10[B](1), at 1-16, 1-17; *Orth-O-Vision, Inc. v. Home Box Office, Inc.*, 474 F. Supp. 672, 684 & nn.11-12 (S.D.N.Y. 1979) (concurring with Nimmer's analysis).

²³⁶ Comment, *supra* note 20, at 491-93; Fetter, *supra* note 20, at 370; Goldstein, *supra* note 62, at 1117. See, e.g., *Synercom Technology, Inc. v. University Computing Co.*, 462 F. Supp. 1003 (N.D. Tex. 1979) (holding that a computer input format ineligible for patent or copyright protection cannot receive permanent protection under misappropriation doctrine because of preemption); *Mitchell v. Penton/Indus. Publishing Co., Inc.*, 486 F. Supp. 22 (N.D. Ohio 1979). See also Goldstein, *supra* note 62, at 1116-18; 1 M. NIMMER, *supra* note 105, § 1.01[B](1), at 1-13 to 1-19.

²³⁷ Cf. A. LATMAN, *supra* note 20, at 68 (misappropriation doctrine avoided by Supreme Court in *Sears and Compco*). *Contra*, *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980) (publicity right found not equivalent to copyright because prerequisites for infringement different); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 849-50, 603 P.2d 425, 448, 160 Cal. Rptr. 323, 346-47 (1979) (Bird, C.J., dissenting). See notes 62-86 and accompanying text *supra*.

²³⁸ See notes 173-99 and accompanying text *supra*. See also *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 849-50, 603 P.2d 425, 448, 160 Cal. Rptr. 323, 346-47 (1979) (Bird, C.J., dissenting).

²³⁹ H. REP., *supra* note 205, at 132. For example, the essence of the tort of defamation does not lie in acts of reproduction and distribution, but such acts can lead to defamation. 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-12 n.46. See also notes 296-324 and accompanying text *infra*.

authorship fixed in a tangible medium of expression is difficult.²⁴⁰ Arguably, any cause of action concerning names or likenesses should escape preemption.²⁴¹ However, statements in the legislative history opposing preemption of publicity and privacy actions predate the floor debate surrounding the amendment that deleted the examples of nonpreempted rights.²⁴² It is settled that privacy actions should be outside the preemptive reach of section 301 because the asserted right concerns not the individual's economic interest in his identity, but rather his self-esteem²⁴³ and right to be let alone.²⁴⁴ Publicity interest claims, in contrast, concern invaded rights that involve the individual's economic interests in his persona.²⁴⁵ Right of publicity cases generally involve no collateral wrong, such as breach of trust or confidentiality, or invasion of privacy.²⁴⁶ This suggests that although section 301 may have no preemptive effects on state law privacy rights, it may limit the right of publicity.

In *Zacchini*, where the court upheld state law protection of the plaintiff's interest in his live performance as a "human cannonball," the peculiar circumstances were not typical of right of publicity cases generally; *Zacchini* is one of the few reported cases involving rights asserted in an entire performance.²⁴⁷ The subject matter that the court held protectible, the human cannonball act, involved both an idea and its expression, but was not embodied by its creator in a "fixed work." The interests, therefore, were ineligible for statutory copyright protection²⁴⁸ and would escape

²⁴⁰ Under § 102, a person's name or likeness would not qualify as copyrightable subject matter. See 17 U.S.C. § 102 (Supp. III 1979).

²⁴¹ See Katz, *supra* note 52, at 217.

²⁴² The report containing these statements is dated September 3, 1976; the debate took place on September 22, 1976.

²⁴³ See, e.g., *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68 (1890).

²⁴⁴ See, e.g., *Warren & Brandeis, The Right of Privacy*, 4 HARV. L. REV. 193, 205 (1890).

²⁴⁵ See *Zacchini v. Scripps-Howard Broadcasting*, 433 U.S. 562, 576 (1977). *Contra*, Katz, *supra* note 52, at 217.

²⁴⁶ See notes 296-324 and accompanying text *infra*.

²⁴⁷ See Note, *supra* note 9, at 1211. See also *Man v. Warner Bros., Inc.*, 317 F. Supp. 50 (S.D.N.Y. 1970); *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 107 N.E.2d 485 (1952). The more typical right of publicity case involves the unauthorized commercial use of a person's name, likeness or aspects of his persona, against which the states provide remedies to protect the commercial value of these property interests.

²⁴⁸ 17 U.S.C. §§ 101, 102(a) (1978). See also Note, 30 STAN. L. REV. 1185, 1192-94 (1978). In discussing § 102 and the "fixation" requirement, the Senate report indicates that unfixed works of authorship (such as an improvisation or an unrecorded choreographic work, performance or broadcast) would continue to be subject to protection under state common law or statutes, and would not be eligible under § 102 for federal statutory protection. S. REP. NO. 473, 94th Cong., 1st Sess. 115-16 (1975). Similarly, the *Goldstein* deci-

preemption by section 301. In right of publicity cases where the interest claimed is some element of a public image, such as a name or likeness, it is arguably less likely that the interest would be characterizable as a "fixed work." Because states are free to protect unfixed works as noncopyrightable subject matter, courts might hold that the 1976 Act does not preempt state protection under the right of publicity of characters and voices like those in the *DeCosta*, *Sinatra*, and *Booth* cases.²⁴⁹

Section 301, however, may preempt right of publicity interests that involve *more* than an individual's interests in his name and likeness.²⁵⁰ Other aspects of an individual's persona can become products with substantial pecuniary value that can be embodied in tangible media of expression like films, photographs, posters, recordings, graphics, and assorted types of memorabilia.²⁵¹ Resulting interests may constitute "fixed works of authorship." When value attaches to a physical rendering, publicity rights in the product may be subject to regulation under the copyright clause and preemption under section 301 of the 1976 Act.²⁵² Section 301, in short, may preempt state publicity rights if they resemble those protected by copyright.

sion indicated that the states were free to protect subject matter not protected by copyright absent an explicit, valid statutory command to the contrary. Section 301 of the 1976 Act furthers this design by allowing the states to protect subject matter that, although a "writing" and protectible under the Constitution, has not been brought within the copyright law. Unfixed works are one class of subject matter that is constitutionally eligible for federal protection but which § 301 leaves for state regulation.

Thus, both the *Goldstein* analysis and § 301 permit states to protect matters excluded by § 102(b). It is necessary to determine, however, whether state law offers protection as rigorous as that offered under federal copyright law, and whether supplementary state protection of copyrightable subject matter will divert investment away from copyrightable works, in frustration of copyright objectives, toward types of created works regulated under other, conflicting statutory systems. *Goldstein*, *supra* note 62, at 1122. Nevertheless, a court confronting facts identical to *Zacchini* today might hold that § 301 does not preempt a state law claim. ABA SECTION ON PATENT, TRADEMARK, AND COPYRIGHT LAW, 1978 COMMITTEE REPORTS 126-27.

²⁴⁹ See notes 132-73 and accompanying text *supra*.

²⁵⁰ See notes 40-50 and accompanying text *supra*.

²⁵¹ See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 479 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (involving unauthorized manufacture and sale of Elvis Presley posters and memorabilia); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975) (involving rights to the Laurel and Hardy characters fixed on film).

²⁵² *Contra*, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 849-50, 603 P.2d 425, 448, 160 Cal. Rptr. 323, 345-47 (1979) (Bird, C.J., dissenting). In *Lugosi*, the defendant asserted that congressional legislation under the copyright clause preempted the right of publicity. The majority opinion did not address this averment.

Chief Justice Bird, however, argued in dissent that the defendant's position was untenable. *Id.* at 849-50, 603 P.2d at 448, 160 Cal. Rptr. at 346. Justice Bird did not discuss the preemptive effects of § 301 of the 1976 Act, but asserted that the disputed publicity

Section 301's preemptive effect on the right of publicity depends on the extent to which the right is equivalent to copyright. This, in turn, depends on whether the subject matter protected involves a "fixed work of authorship" and, if so, whether the conduct constituting the invasion of rights involves acts other than mere reproduction, distribution, performance or display.²⁵³ Ascertainment of section 301's preemptive effects, further, must take into account the strong federal interest in promoting uniform intellectual property law.²⁵⁴

IV

PUBLICITY RIGHTS OVERLAPPING FEDERAL COPYRIGHT LAW

To determine section 301's preemptive effect on various publicity interests, it is helpful to examine more closely the facts

values in the case did not concern physical renderings and that the right of publicity only protects intangible proprietary interests that are not writings. *Id.* This author's position is that some interests that the right protects are in fact writings.

The decision in a recent case parallels the view of Justice Bird. In *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), the court held that federal copyright law does not preempt the right of publicity. *Id.* at 1100. Judge Tenney's analysis, which includes discussion of preemption both before and after the effective date of the 1976 Copyright Act, more thoroughly addresses preemption and the right of publicity than other courts have. *See id.* at 1095-1100.

Nevertheless, Judge Tenney's analysis seems flawed. First, his review of § 301's legislative history does not adequately address the ambiguity stemming from the deletions of the examples of nonpreempted rights, *see* notes 221-46 and accompanying text *supra*, which suggest that Congress did intend to preempt certain types of publicity actions. Second, despite his thorough analysis of *Goldstein* and other preemption cases, Judge Tenney errs in concluding that Congress in the 1976 Act left the entire scope of publicity rights unaffected by federal copyright law. The 1976 Act does reflect an intent to preempt the state law right in some contexts. Third, Judge Tenney fails to recognize the full range of interests encompassed by the doctrine of publicity rights. *See* notes 40-50 and accompanying text *supra*. Finally, he does not discuss the fact that publicity rights' perpetual duration in some jurisdictions poses problems of consistency and apparent conflicts with federal intellectual property policy. *See* notes 324-44 and accompanying text *infra*.

Judge Tenney's conclusion that the right of publicity is not equivalent to copyright because an action for its infringement requires elements distinct from a copyright violation suit is sometimes, but not always, correct. *See* notes 296-327 and accompanying text *infra*. In addition, the element he views as unique to publicity actions—commercial exploitation of one's name or likeness—is not required in all publicity actions and may not be required in any such actions. *See* notes 327-47 and accompanying text *infra*.

Consequently, Judge Tenney's conclusion that the right of publicity completely escapes preemption by federal copyright law is not completely sound. Some types of publicity actions, like those in several of the *Factors* cases, are contrary to federal copyright law and subject to preemption.

²⁵³ *Cf.* 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-16 (legislative history unclear concerning whether 1976 Copyright Act preempts state actions involving misappropriation).

²⁵⁴ Comment, *supra* note 20, at 490.

of the major pre-1976 cases interpreting rights of publicity and other analogous interests. These decisions suggest that state common law publicity interests in performances, likenesses, characters, and characterizations are subject to preemption by federal copyright law.

A. *Interests in Performances*

If an individual's performance is fixed in a tangible medium of expression, a court could find a basis for preemption under the 1976 Copyright Act.²⁵⁵ For example, suppose Zacchini had transmitted his live act over closed-circuit television and simultaneously filmed it for a later advertising campaign. Several factors would preclude him from bringing a right of publicity action to contest a television station's unauthorized taping and broadcast of his act. First, Zacchini's publicity interest would involve a work of authorship, containing an idea and its expression, that is fixed in a tangible medium.²⁵⁶ Second, the television station's actionable conduct—taping and broadcasting his live act—would entail nothing more than reproduction and distribution. Such conduct infringes rights that are protected under the general scope of copyright law.²⁵⁷ The work itself—the cannonball act—is not a writing, but a film of Zacchini's act, is a “‘fixed’ writing” which would be entitled to copyright protection because of the broadcast and simultaneous filming.²⁵⁸ Consequently, the 1976 federal

²⁵⁵ ABA SECTION ON PATENT, TRADEMARK AND COPYRIGHT LAW, 1978 COMMITTEE REPORTS 126-27. See also Note, 30 STAN. L. REV. 1185, 1192-94 (1978).

²⁵⁶ See 17 U.S.C. §§ 101, 102(6) (1978). See also note 219 and accompanying text *supra*. Copyright protection requires two fundamental criteria: originality, and fixation in tangible form. The term “original works of authorship” in § 102 of the 1976 Act was purposely left undefined. See 17 U.S.C. § 102(a) (Supp. III 1979). Continued use of the term “is intended to incorporate without change the standard of originality established by the courts” under the old law. H. REP., *supra* note 205, at 51.

The “original works” standard “does not include any requirements of novelty, ingenuity or esthetic merit.” *Id.* Original, in reference to a copyrighted work, simply means that the author originated the particular work. The author is entitled to copyright protection if he independently creates a work, even if the work is completely identical to some previous work. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). Although the 1976 Act does not define “authorship” or “author,” the United States Supreme Court defined “author” as “[h]e to whom anything owes its origin; originator; maker; one who completes a work of science or literature.” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (quoting *Worcester*).

²⁵⁷ 17 U.S.C. § 106(1), (3), (4) (1978). In *Zacchini* the Court suggested that Ohio's right of publicity law promoted public welfare by protecting incentives for economic investment. 433 U.S. at 576. This rationale also underlies federal copyright laws.

²⁵⁸ The copyrightable expression would be the recording or filming of the act, not the live act itself. 1 M. NIMMER, *supra* note 105, § 1.08[C], at 1-51.

Copyright Act would preempt an equivalent state law right of publicity if the case arose today.

The decision in *Lombardo v. Doyle, Dane & Bernbach, Inc.*,²⁵⁹ in which the court extended the right of publicity to protect a professional entertainer against imitation of his public performance, also illustrates section 301's possible preemptive effects. The defendants in *Lombardo* aired an advertisement that simulated the gestures, musical beat, and choice of music that the public associated with Guy Lombardo.²⁶⁰ Because the advertisement clearly imitated the plaintiff's distinctive style of performance, the court upheld his common law claim alleging misappropriation of his public personality.²⁶¹

Lombardo sought protection of rights equivalent to those encompassed by copyright.²⁶² The actionable conduct was nothing more than the unauthorized copying, by reproduction and distribution, of his performance—a form of expression. It is questionable whether this form of expression constituted a work of authorship fixed in a tangible medium.²⁶³ Lombardo was more concerned with the simulation of his distinctive, identifiable style than with the copying of a particular live performance. He claimed that the defendants' use of his style to promote automobile sales diluted its value for his own endorsements. These attributes of plaintiff's publicity interests are forms of expression less well defined than a live performance and they usually are not fixed in a tangible medium. Thus, a right of publicity action similar to *Lombardo* might escape preemption.

On the other hand, the fact that Lombardo's performances often have been filmed, recorded, and taped suggests that his form of expression—gestures, choice of music, and manner of conducting—arguably has been “fixed” in several different “tangible mediums.” With fixation, style may become a “writing” qualifying for copyright protection.²⁶⁴ In view of the plaintiff's

²⁵⁹ 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977) (mem.).

²⁶⁰ *Id.* at 622, 396 N.Y.S.2d at 664.

²⁶¹ *Id.*, 396 N.Y.S.2d at 664. Undisputed evidence in the record indicated that the defendants had negotiated with the plaintiff to appear in the commercial. The negotiations failed, but the defendants nevertheless produced the imitative commercial. *See also* ABA SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW, 1978 COMMITTEE REPORTS 127.

²⁶² *See* 17 U.S.C. § 106(1), (4) (1978). The plaintiff sought recovery for unauthorized copying and reproduction, but his claim also involved elements of passing-off. *See* notes 295-324 and accompanying text *infra*.

²⁶³ *See* 1 U.S.C. § 102(a) (1978). *But see* Note, *supra* note 48, at 572-73.

²⁶⁴ 17 U.S.C. § 102(a) (1978). A performer's style may become sufficiently developed to constitute tangible writing for which protection is available. It would not be impractical to

basic goal of recovering for the unauthorized copying of this form of expression—a right equivalent to copyright—it is possible to conclude that his right of publicity action is subject to preemption.

B. *Interests in Likenesses*

At issue in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*,²⁶⁵ was the plaintiff's right to control the use of baseball players' photographs in connection with the sale and advertising of bubble gum cards. The plaintiff-licensee sought to prevent interference with its contractual relations with baseball players, to maintain its acquired publicity rights, and to enjoin a third party's unauthorized reproduction and distribution of the players' photographs.²⁶⁶

This appears to be a case for preemption. A photograph is appropriate subject matter for copyright protection²⁶⁷ and there was a fixation. The legislative history of section 301, however, clouds the issue. The examples deleted from subsection 301(b)(3) illustrated "rights and remedies that are different in nature from the rights comprised in a copyright and that may continue to be

incorporate into the copyright system a procedure for registering "style" by filing a pictorial and narrative description in an identifiable, durable and material form. *Cf.* *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315, 320 (1st Cir. 1967).

In *DeCosta*, the court suggested that the *constitutional* scope of copyright protection extends to any concrete describable manifestation of intellectual creation. *Id.* at 320. *See also* Note, *supra* note 48, at 566-67. Section 301 of the 1976 Copyright Act is similarly broad, arguably providing *statutory* protection for created style. Under this theory, if a defendant deliberately appropriated publicly-identifiable style or personal traits associated with another individual's professional endeavors, a cause of action would be available to the individual under federal copyright law. Style that is ineffable, however, would be ineligible for such protection. *But see* notes 283-95 and accompanying text *infra*.

²⁶⁵ 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). *See* notes 8-10 and accompanying text *supra*.

²⁶⁶ *See* 17 U.S.C. § 106(1), (3) (1978). Recovery in such cases traditionally depended upon the plaintiff-licensee showing active inducement to breach. *See, e.g., Sweeney v. Smith*, 167 F. 385 (C.C.E.D. Ap.), *aff'd*, 171 F.2d 645 (3d Cir.), *cert. denied*, 215 U.S. 600 (1909); Note, *supra* note 6, at 1126 & n.14.

The defendant third party in *Haelan* had contracted through its agent with baseball players under contract with the plaintiff. The court held that the defendant would be liable for any resulting breach of the plaintiff's contracts. 202 F.2d at 863. The defendant also had purchased contract rights from another party to use other players' names and pictures, and had used additional players' names and photographs without their consent during the term of their contracts with the plaintiff. *Id.* at 868. Although the inducement-to-breach rationale did not apply to these acts, the court held that the right of publicity was assertable. *Id.* at 869. *See* Note, *supra* note 6, at 1126 & n.14. The plaintiff's contracts were more than releases of liability and any subsequent, conflicting grants to the defendant, who had knowledge of the plaintiff's contracts, were invalid. 202 F.2d at 868-69.

²⁶⁷ *See* 17 U.S.C. § 102(5) (1978).

protected under State common law or statute.”²⁶⁸ The House Report further stated:

Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract; however, to the extent that the unfair competition concept known as “*interference with contract relations*” is merely the equivalent of copyright protection, it would be preempted.²⁶⁹

If the preemptive language of section 301 is read expansively, then the 1976 Act preempts *Haelen*-type causes of action, based in part on interference with contractual relations. However, ambiguities in the 1976 Act’s legislative history,²⁷⁰ recent Supreme Court decisions dealing with preemption, contract actions and trade secrets,²⁷¹ and limitations imposed on *Sears* and *Compro* by the Supreme Court²⁷² and other courts make this conclusion uncertain.²⁷³ Moreover, it is difficult to characterize a likeness as a work of authorship within the subject matter of copyright.²⁷⁴ Thus, the subject matter test could not be satisfied in the *Haelen* case even if the photographer, as creator of the fixed works of authorship, assigned all of his rights to the photographs of the players to the plaintiff-advertiser. The plaintiff sought to control the use of the players’ likenesses, which were neither “writings”

²⁶⁸ H. REP., *supra* note 205, at 132.

²⁶⁹ *Id.* (emphasis added).

²⁷⁰ *See, e.g., id.*

²⁷¹ *See, e.g.,* Aronson v. Quick Point Pencil Co., 440 U.S. 257 (1978); Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1976); A. LATMAN, *supra* note 20, at 68-69.

²⁷² *See, e.g.,* Goldstein v. California, 412 U.S. 470 (1974); Lear, Inc. v. Adkins, 395 U.S. 653 (1969).

²⁷³ *See, e.g.,* A & M Records, Inc. v. M.V.C. Distrib. Corp., 574 F.2d 312 (6th Cir. 1978); National Football League v. Governor of Delaware, 435 F. Supp. 1372, 1377 (D. Del. 1977); Compumarketing Serv. Corp. v. Business Envelope Mfrs., Inc., 342 F. Supp. 776 (N.D. Ill. 1972); Tape Indus. Ass’n v. Younger, 316 F. Supp. 340 (C.D. Cal. 1970), *appeal dismissed*, 401 U.S. 902 (1972); Mercury Record Prods., Inc. v. Economic Consultants, Inc., 64 Wis. 2d 163, 218 N.W.2d 705 (1974), *cert. denied*, 420 U.S. 914 (1975). *See also* Zim v. Western Publishing Co., 573 F.2d 1318 (5th Cir. 1978).

In *Zim*, the defendant published a book and used the plaintiff’s name on the book’s spine without his approval. *Id.* at 1326. This conduct constituted breach of an agreement as well as a tortious use of the author’s name under state law. The plaintiff’s causes of action, which were analogous to a right of publicity action against the unauthorized use of the plaintiff’s name, accrued before the effective date of the 1976 Copyright Act. The court, accordingly, never considered the preemptive effects of § 301. The actions, however, do not appear to be preempted by the 1976 Act because a person’s name is not a “writing” within the meaning of the statute.

²⁷⁴ Equating an individual’s relationship to his likeness with that of an author to his work arguably over-broadens the definition of “original works of authorship.” Nevertheless, the character likenesses of some actors and comedians might reasonably be classified as “works of authorship.”

nor "works of authorship," not to protect the copyrighted photographs themselves. His right to control the use of these likenesses was susceptible to infringement either by reproduction of the photographs themselves, a copyright infringement, or by the distribution of completely different photographs. Fixation of the likenesses would not be a prerequisite for relief.²⁷⁵

Two recent decisions involving the manufacture and sale of iron-on transfers and imprinted T-shirts, however, illustrate the possible overlap of publicity rights with copyright when the protected interest is a likeness. In *Spelling-Goldberg Productions v. Schneider*,²⁷⁶ the defendants, without authorization, manufactured iron-on transfers depicting the marks of the television shows "Starsky & Hutch" and "Charlie's Angels." The court held them liable for trademark infringement and unfair competition.²⁷⁷ The court also held that the use of the television stars' likenesses on the transfers infringed their publicity rights, which had been assigned to the plaintiff Spelling-Goldberg. Under the 1976 Act this type of right of publicity claim might be preempted because the protected likenesses are embodied in copyrightable iron-on transfers and because the actionable conduct involves no more than the reproduction and distribution of these "artistic" works. The right to control reproduction and distribution of such works is equivalent to rights encompassed by section 106.²⁷⁸

²⁷⁵ For example, in *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978), the plaintiff, a former heavyweight boxing champion, received preliminary injunctive relief against the unauthorized publication and distribution of an objectionable portrait of him in the defendant's magazine. *Id.* at 732. Prior photographs of Ali had fixed his likeness in a tangible medium of expression. Therefore, the unauthorized reproduction and distribution of his photographed likeness arguably involved "equivalent rights" and "copyrightable subject matter." Nevertheless, a celebrity like Ali who seeks relief against the unauthorized use of his likeness is not asserting interests in a "writing," which is prerequisite for federal copyright protection.

A celebrity's publicity interest in his likeness can be infringed through its use in such media as photographs, film and paintings. Whether the offending use of his likeness copies an existing tangible representation of his visage is irrelevant. A cause of action arguably should exist for him regardless of whether he has permitted others to photograph his likeness and reduce it to a tangible medium of expression. The pecuniary values associated with the use of his likeness may derive chiefly from his personal efforts. These values are not confined to any particular fixation of his likeness (a "writing"). Rather, the pecuniary value is inseparable from his likeness itself. Protection of his interests, therefore, should not require technical adherence to the copyright act's "fixation" requirement. Despite its overlap with federal copyright law, the publicity doctrine should be applicable in such cases to provide appropriate protection.

²⁷⁶ 450 BNA PATENT, TRADEMARK AND COPYRIGHT J., A-18 (D.N.J. 1979).

²⁷⁷ *Id.*

²⁷⁸ The imprints or transfers constituted graphic artwork copyrightable under § 102. *See* 17 U.S.C. § 102(5) (1978). Similarly, a copyright owner's bundle of rights under § 106 encompasses the rights indicated in this action. *See* 17 U.S.C. § 106 (1978).

Supporting this view is the decision in *Aucoin Management, Inc. v. Neil's Fads, Inc.*²⁷⁹ The plaintiff, who owned copyrights associated with the rock-and-roll group "KISS," charged the defendants, wholesalers and retailers of iron-on transfers and imprinted T-shirts, with infringement. The court granted a preliminary injunction enjoining defendants from selling "unauthorized merchandise using plaintiff's copyrighted graphic artwork, including the 'KISS' characters."²⁸⁰ The distinction between this result, achieved under the copyright law, and the result in *Spelling-Goldberg*, based in part on infringement of the right of publicity, is insignificant.²⁸¹ Even a narrow reading of section 301 appears to mandate preemption of right of publicity claims like that in *Spelling-Goldberg*.²⁸²

C. *Interests in Characters and Characterizations*

The assertion of right of publicity interests in characters and characterizations creates another potential overlap between right

²⁷⁹ 450 BNA PATENT, TRADEMARK AND COPYRIGHT J., A-18 (D. Mich. 1979) (awarding plaintiff attorney's fees arising from defendant's defiance of preliminary injunction).

²⁸⁰ *Id.*

²⁸¹ With respect to qualifying as a work of authorship, the marketable likeness of an individual as himself is different from the individual's likeness as a character created by him or another person.

For example, the likeness of a player on a baseball card is nothing more than the player himself, who has become famous for his ability as a baseball player. The individual's efforts were directed at developing his sporting talents, not a persona. There is no work of authorship. However, the likeness of a singer from a rock group is considerably different because members of the group have created fanciful, distinctive characters that *are* works of authorship. The character types are capable of description and are reducible to tangible media of expression.

The circumstances in *Spelling-Goldberg* fell between these two examples. In some settings, the likeness of Farah Fawcett is one of "Charlie's Angels," yet in another setting that likeness is Farah Fawcett separate and apart from the "Angels." The former, but not the latter, is arguably a work of authorship.

²⁸² A publicity claim like that in *Spelling-Goldberg* might escape preemption because it is analogous to a trademark infringement action and unfair-competition or passing-off claim. The performers' likenesses in the case were analogous to trademarks used by the plaintiff in connection with the sale of goods and services. The defendants' use of the likenesses enabled them to pass-off their goods as those of the plaintiff, which was likely to cause confusion in the marketplace.

Section 301(d) of the 1976 Act expressly insulates rights and remedies provided under other federal statutes from preemption. See 17 U.S.C. § 301(d) (1976). This exclusion applies, *inter alia*, to the Lanham Act's provisions for trademark protection and false representation. See 15 U.S.C. §§ 1125(a), 1051-1127 (1976); A. LATMAN, *supra* note 20, at 65. In addition, the 1976 Act's legislative history suggests that Congress may not have intended § 301 to preempt state common law protection against activities like passing-off, even where the subject matter involved comes within the scope of copyrightable subject matter. See H. REP., *supra* note 205, at 132. See also notes 294-327 and accompanying text *infra*.

of publicity doctrine and federal copyright law.²⁸³ Section 102 of the 1976 Act does not clarify whether copyright protection is available for characters *per se*.²⁸⁴ State courts, repeating the familiar maxim of *INS* that no person should be permitted to pass off as his own the thoughts and works of another, have protected characters where the public identifies the character with the work of a particular author.²⁸⁵

Many actors have created on the stage and screen distinctive characters, expressed by identifiable and concrete styles of dress,

²⁸³ Application of the accepted distinction between "ideas" and "expressions" (*see* note 370-94 and accompanying text *infra*) is difficult for determining whether an author's character creation is a "stock" character that is available for free public use, or an intellectual creation entitled to protection as property. Through dramatic expression by voice, mannerisms and dress, a performer can change a created character from an unprotectible idea to a protectible expression of that idea. He can create a style expressing the character idea in definable terms. With sufficient development, the performer's unique personal style in playing the character could exist independent of the character/idea and become a protectible expression. Thus, although the performer normally would have no monopolistic control over the general character concept and performance role, he would have a personal proprietary interest in his own particular expression of that character concept.

In some circumstances, the performer may become so identified with the character/idea that he is the character/idea itself in the public's mind. For example, the public inextricably associated Bela Lugosi's performance expressions with the Dracula idea, and the performance expressions of Laurel and Hardy with the Laurel and Hardy character/idea. When such identification occurs, it is difficult to conclude that the style of expression exists independent of the character/idea. *See generally* *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 754-55 (9th Cir. 1978); Note, *supra* note 48, at 569-72.

²⁸⁴ *See* E. KITCH & H. PERLMAN, *LEGAL REGULATION OF THE COMPETITIVE PROCESS* 595 (2d ed. 1979). The issue of providing copyright protection of characters *per se* has arisen in the context of sequels. A character made popular in a copyrighted play or novel is sometimes used by another author in an independent work. *See, e.g.,* *Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc.*, 216 F.2d 945 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955). Literary characters have received copyright protection from use in sequels when they are found to be "well developed" and "individualized." *See, e.g.,* *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931); *Burns v. Twentieth Century-Fox Film Corp.*, 75 F. Supp. 986 (D. Mass. 1948). Cartoon characters received similar protection. *See, e.g.,* *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 754-55 (9th Cir. 1978).

One commentator has suggested that "[a] sensible dividing line on the sliding scale between a well-defined character and the stock figure is the ability of the reader to discover more about the character than, for example, his name." Parish, *Statutory Copyright Protection for Fictional Characters*, 8 *IDEA* 455, 457 (1964) (footnote omitted). *See also* Comment, *supra* note 134, at 1021-24. *But see* *Warner Bros. Pictures, Inc. v. Central Broadcasting Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954) ("It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright.").

²⁸⁵ E. KITCH & H. PERLMAN, *supra* note 284, at 595. *See* *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133, *cert. denied*, 257 U.S. 654 (1921) (enjoining use of term "Mutt and Jeff" and publication of cartoon imitating Mutt and Jeff cartoon series). *See also* *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 844-47, 603 P.2d 425, 444-46, 160 Cal. Rptr. 323, 342-44 (1979) (Bird, C.J., dissenting).

posture, and mannerisms that the public associates with them. In *Price v. Worldvision Enterprises, Inc.*,²⁸⁶ the widows of comedians Oliver Hardy and Stanley Laurel, and a third party, who possessed the exclusive rights to use and merchandise the names, likenesses, characters, and characterizations of Laurel and Hardy, sought to enjoin the production and distribution of a television series entitled "Stan 'n Ollie," in which two actors portrayed the Laurel and Hardy characters.²⁸⁷ The court granted the injunction, reasoning that Laurel and Hardy possessed a property right of publicity which survived their deaths and which, by descent and assignment, belonged to the plaintiffs.²⁸⁸ Here, as in the *Hal Roach* decision,²⁸⁹ the defendants were restrained from using the Laurel and Hardy names, likenesses, characters, and characterizations,

(including, without limitation, use of their photographs or other reproductions of their physical likenesses, *the impersonation of their physical likenesses or appearances, costumes and mannerisms, and/or the simulation of their voices*) for advertising or commercial purposes, including their use in or in connection with publications, recordings, clothing, toys, games, foods, or other product or service, merchandising, or other product or service endorsements, or in the production of animated cartoons or motion pictures. . . .²⁹⁰

The conduct enjoined was the reproduction or copying of distinctive characters and styles. The invasion of the right of publicity arose solely from the acts of reproduction and distribution, which constitute rights "within the general scope of copyright."²⁹¹ The preemption inquiry in this context hinges on whether distinctive styles and characterizations are copyrightable subject matter.

State law protection of characters and characterizations, however, is not always available, and reconciliation of federal decisions on the matter is difficult. See notes 125-91 and accompanying text *supra*. Compare *DeCosta v. Columbia Broadcasting Sys., Inc.*, 377 F.2d 315 (1st Cir. 1967), *cert. denied*, 359 U.S. 1007 (1968) and *Booth v. Colgate Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973), with *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (upholding well-known actor's claim against unauthorized voice imitation) and *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928) (enjoining imitator of Charlie Chaplin character from distributing film or creating public perception that Chaplin acted in his productions). See generally Note, *supra* note 48.

²⁸⁶ 455 F. Supp. 252 (S.D.N.Y. 1978).

²⁸⁷ *Id.* at 253-54.

²⁸⁸ *Id.* at 256-58.

²⁸⁹ *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975). See notes 175-89 and accompanying text *supra*.

²⁹⁰ 455 F. Supp. at 256 (emphasis in original) (quoting injunction issued in *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975)).

²⁹¹ 17 U.S.C. §§ 100, 106, 301(a) (1978).

If a performer's style and character creation are viewed as the oral and visual expressions of ideas, then style and character, when developed to the point of being definable in terms of distinctive dress, mannerisms, and vocal characteristics, arguably constitute "writings."²⁹² The performer's expressions of character and style are works of authorship because they result from the performer's own intellectual labors. Individuals who have created characters with their own gestures, styles, mannerisms, timing, and type of vocal delivery, like Laurel and Hardy, have developed unique artistic expressions.²⁹³ Although a performer's character of style is not tangible, his performances can become "works of authorship" fixed by means of films and tapes.²⁹⁴ Consequently, the 1976 Act appears to preempt right of publicity actions like those in the *Hal Roach* and *Worldvision* cases.²⁹⁵

V

PUBLICITY RIGHTS GENERALLY SUBJECT TO FEDERAL COPYRIGHT PREEMPTION

Section 301(a) of the Copyright Act of 1976 specifies that only state laws that create "legal or equitable rights . . . equivalent to any of the exclusive rights within the general scope of copyright" are subject to federal preemption.²⁹⁶ A leading authority on copyright law has stated:

If under state law the act of reproduction, performance, distribution or display . . . will *in itself* infringe the state created right, then such right is preempted. But if other elements are required, in addition to or instead of, the acts of reproduction, performance, distribution or display, in order to constitute a state created cause of action, then the right does not lie "within the general scope of copyright," and there is no preemption.²⁹⁷

Thus, to determine the scope of preemption under the 1976 Act, it is necessary to determine whether infringement of particular

²⁹² See note 264 *supra*; cf. Note, *supra* note 48, at 569.

²⁹³ See *id.* at 572.

²⁹⁴ Thus, it would not "be impracticable to incorporate into the copyright system a procedure for registering 'characters' by filing pictorial and narrative description in an identifiable, durable, and material form." *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315, 320 (1st Cir. 1967).

²⁹⁵ *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975).

²⁹⁶ 17 U.S.C. § 301(a) (Supp. III 1979).

²⁹⁷ 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-11.

rights requires more than "reproduction, performance, distribution or display."

The right of publicity protects the commercial display and exploitation of names, likenesses, activities, and personal characteristics.²⁹⁸ Because infringement of this right may occur under particular circumstances upon the mere reproduction or display of one of an individual's publicity attributes, the publicity right in some situations lies within the general scope of copyright and is preempted. However, an analysis of several varieties of publicity claims indicates that interests in publicity do not always create rights equivalent to copyright.²⁹⁹

Publicity actions resemble invasion of privacy actions against the appropriation of names or likenesses for commercial purposes.³⁰⁰ This type of privacy right gave rise to the right of publicity because the basic privacy cause of action did not provide adequate protection for the person who had exploited his attributes commercially.³⁰¹ Unauthorized appropriation in such circumstances not only injures the person's right to be let alone, but it also damages property interests having recognized economic value.³⁰² A right of publicity action seeks to vindicate both interests. Accordingly, a publicity action against the unauthorized use of the name or likeness of a person who has not energetically exploited his persona commercially is closely akin to a privacy action.³⁰³ The plaintiff's privacy interests, as opposed to his economic interests, predominate. Where it closely resembles a classic

²⁹⁸ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 569 (1977) (quoting *Zacchini v. Scripps-Howard Broadcasting Co.*, 47 Ohio St. 2d 224, 231, 351 N.E.2d 454, 459 (1976)). See also *Felcher & Rubin*, *supra* note 6, at 1589.

²⁹⁹ See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980) (holding right of publicity not equivalent to copyright because plaintiff in former must demonstrate that he commercially exploited his name or likeness during his lifetime).

³⁰⁰ *Felcher & Rubin*, *supra* note 6, at 1591 & n.78.

³⁰¹ See notes 27-37 and accompanying text *supra*.

³⁰² See note 39 and accompanying text *supra*.

³⁰³ Some commentators and courts have asserted that the right of publicity does not extend to the appropriation of a person's name or likeness when that person has not previously exploited those interests commercially. See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980); *Felcher & Rubin*, *supra* note 6, at 1591 & n.78. *Contra*, *Nimmer*, *supra* note 1, at 217. *Nimmer* states:

Probably it would be wiser not to inject any arbitrary limitation on the scope of the right of publicity relying instead [*sic*] on the limitation imposed by the rule of damages. . . . It is impractical to attempt to draw a line as to which persons have achieved the status of celebrity and which have not; . . . the right of publicity accorded to each individual "may have much or little, or only a nominal value," but the right should be available to everyone.

Id. (footnote omitted).

right of privacy action,³⁰⁴ a right of publicity action does not fall within the scope of copyright because the essence of the tort lies not in the acts of reproduction and distribution,³⁰⁵ but in the injury to the primary interest the plaintiff seeks to vindicate—the right to be let alone. This particular kind of publicity action should not be preempted by section 301 even though the harm—both economic and personal—results from the reproduction of personality attributes.³⁰⁶

Similarly, in many circumstances a viable cause of action based on the right of publicity requires something more than just the unauthorized reproducing, distributing, or displaying of the plaintiff's publicity interests. A strong rationale for protecting these interests is the prevention of fraudulent business practices.³⁰⁷ For example, when an individual's right of publicity is infringed by the unauthorized use of one of his distinctive attributes in an advertised endorsement, he suffers economic damage by not receiving payment for the endorsement. The resulting dilution of his interests or his association with shoddy products may render his future endorsements less valuable.³⁰⁸ The advertisement, further, may create the false impression that a business relationship exists between him and the advertiser.³⁰⁹ This unauthorized sponsorship or endorsement misleads the public because it involves a false claim about the product.³¹⁰ Thus, the advertis-

³⁰⁴ Cf. *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68 (1905) (holding unauthorized use of plaintiff's picture in insurance advertisement invasion of right of privacy).

³⁰⁵ 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-13.

³⁰⁶ Analogous is a cause of action for the state right of defamation, which is not preempted. The essence of both defamation and the right of privacy, as well as rights of publicity closely akin to the right of privacy, is not reproduction and distribution. Such acts, however, may lead to violations of any of these rights. Cf. 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1013 n.49 (noting that acts of reproduction, distribution, performance or display are not the essence of invasion of privacy and defamation).

³⁰⁷ Cf. *Felcher & Rubin*, *supra* note 6, at 1600 (“[one] policy motivating courts to grant recovery for media portrayals is the desire to prevent fraudulent business practices.”).

³⁰⁸ *Treece*, *supra* note 6, at 641-48.

³⁰⁹ Cf. *id.* at 638-41 (unauthorized advertisements using publicity interests amount to involuntary association with product or enterprise).

³¹⁰ *Felcher & Rubin*, *supra* note 6, at 1600. See, e.g., *Motschetenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (finding false association between race-car driver and advertiser's promotion of cigarette sales); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129 (1979) (finding public deceived by false impression that famous athlete endorsed lady's shaving gel); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977) (finding public deceived under false and misleading impression that famous entertainer was connected with defendants' automobile sales promotions). But see *Carson v. Here's Johnny Portable Toilets, Inc.*, 498 F. Supp. 71, 77-78 (E.D. Mich. 1980).

er's conduct damages not only the individual's economic and personal interests, but the public's interests as well.

Such a cause of action is analogous to an unfair trade practices action. Both require proof of deception, passing-off or misrepresentation—that the defendant advertiser caused the public to believe that the plaintiff sponsored, endorsed, or was in some way connected with the product.³¹¹ The elements of deception, misrepresentation or passing-off, essential for liability, are unrelated to a cause of action for copyright infringement.³¹² Although the defendant invades plaintiff's publicity interests by reproducing and displaying attributes of his persona, relief depends upon additional proof that this conduct was deceptive or amounted to a misrepresentation.³¹³ A publicity action against the advertiser who uses one of the plaintiff's publicity attributes to endorse or promote a product without consent should, therefore, withstand preemption under section 301.

Publicity actions are also analogous to common law unfair competition actions and causes of action under section 43(a) of the Lanham Act.³¹⁴ For example, a female entertainer's fictional character can amount to a protectible trade symbol if over time that character comes to symbolize the plaintiff and her act in the

³¹¹ See, e.g., *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971); *Chaplin v. Amador*, 93 Cal. App. 358, 269 P.2d 544 (1928).

³¹² 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-12 to 1-13. See also *Orth-O-Vision, Inc. v. Home Box Office, Inc.*, 474 F. Supp. 672, 682-84 (S.D.N.Y. 1979) (concurring with Nimmer's analysis).

³¹³ Deceptive trade practices like passing-off and false representation were among the illustrative examples of nonpreempted rights listed in but later deleted from § 301(b)(3). See H. REP., *supra* note 205, at 132; notes 222-32 and accompanying text *supra*. Section 301 was not originally intended to preempt common law protection of such rights even where the involved subject matter came within the statute's scope. See H. REP., *supra* note 205, at 132.

The essence of the passing-off and false representation torts, unlike the publicity rights doctrine, is not merely reproduction or distribution, but rather the resulting public confusion or deception. For example, if a performer's name or likeness is used without his authorization to promote the sale of a product, the public may be deceived into believing that the person does in fact endorse that product, just as he may endorse other products. In many jurisdictions this conduct constitutes an actionable invasion of the performer's right of publicity. See, e.g., *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973).

Arguments that the 1976 Copyright Act preempts this type of right of publicity action are weak. First, it is difficult to conceptualize the performer's name or likeness as a "fixed work of authorship." Second, this type of state-created right of publicity is arguably not a right "equivalent to copyright"; successful assertion of the right in this context, unlike in copyright, implicitly requires a showing of public deception or passing-off, not just proof of the copying of a name or the reproduction of a likeness.

³¹⁴ See 15 U.S.C. § 1125(a) (1978).

public mind.³¹⁵ A defendant's unauthorized reproduction and display or performance of this character—arguably copyrightable subject matter³¹⁶—interferes with a plaintiff's right of publicity. However, nothing in section 301(a) restricts any rights or remedies under other federal statutes,³¹⁷ including those under section 43(a) of the Lanham Act.³¹⁸ Further, this type of publicity action is akin to an unfair competition action, which depends upon a showing of likelihood of confusion that is not a necessary element in a copyright infringement case.³¹⁹ Such an action, accordingly, does not lie within the general scope of copyright. A publicity action in these circumstances should not be preempted.

Other publicity actions, on the other hand, do not seem to require any showing of passing-off, deception, misrepresentation or other collateral harm, other than showing that a publicity attribute was reproduced, distributed, performed or displayed.³²⁰ In *Zacchini*, for example, the plaintiff only had to show, to state a valid claim, that the defendant had filmed his act and subsequently showed it on the evening news.³²¹ In the several Elvis Presley and Laurel and Hardy actions the actionable conduct

³¹⁵ For example, one court recently stated:

[W]here the product sold by plaintiff is "entertainment" in one form or another, then not only the advertising of the product but also an ingredient of the product itself can amount to a trademark protectable under § 43(a) because the ingredient can come to symbolize the plaintiff or its product in the public mind.

Protectable "ingredients" . . . include the names and nicknames of entertainment characters, as well as their physical appearances and costumes, but not their physical abilities or personality traits.

D.C. Comics, Inc. v. Filmation Assocs., 477 BNA PATENT, TRADEMARK AND COPYRIGHT J., A-9 (S.D.N.Y. May 1, 1980). See, e.g., *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (Ct. App. 1928).

³¹⁶ See notes 283-95 and accompanying text *supra*.

³¹⁷ See 17 U.S.C. § 301(d) (1978).

³¹⁸ Cf. 1 M. NIMMER, *supra* note 105, § 1.01[B], at 1-25 to 1-26 ("the current Copyright Act does not in any manner repeal or otherwise affect other federal statutes which may in some degree overlap [it]"). See also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979).

³¹⁹ Cf. *D.C. Comics, Inc. v. Filmation Assocs.*, 477 BNA PATENT, TRADEMARK AND COPYRIGHT J., A-9, A-10 (S.D.N.Y. May 1, 1980) (finding no preemption of unfair competition claims where state law "protects a right that is 'not equivalent' to any right granted by the [Copyright] Act"). See also *Carson v. Here's Johnny Portable Toilets, Inc.*, 498 F. Supp. 71, 78 (E.D. Mich. 1980) (summarily rejecting right of publicity argument where claim alleging unfair competition found untenable). *Contra*, *Orth-O-Vision v. Home Box Office, Inc.*, 474 F. Supp. 672, 684 (S.D.N.Y. 1979).

³²⁰ See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979); *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1977).

³²¹ See notes 255-58, 283 and accompanying text *supra*.

involved nothing more than the unauthorized reproduction and distribution of the deceased celebrities' likenesses and characterizations. Defendants used these publicity interests to promote products, but the celebrities themselves had become the product.³²² As a result, the public was not misled or deceived, and the plaintiffs could not demonstrate a likelihood of confusion. Because these celebrities were deceased, the injuries were economic rather than personal.³²³

The fact that the defendants in these cases were attempting to reap what they had not sown by exploiting the late entertainers' reputations or publicity interests, does not preclude preemption under the Act. The actionable conduct involved nothing more than unauthorized reproduction and distribution, which violated rights within the general scope of copyright.³²⁴ The argument that such publicity actions lie within the general scope of copyright and hence are subject to federal preemption is strong.³²⁵

³²² A right of publicity action does not require a showing of deception or passing-off where the individual himself has become a marketed product, like the late performer Elvis Presley. Courts enjoining under the right of publicity the production and sale of Presley memorabilia have not conditioned relief upon showing or findings of passing-off or deception. Appropriation of the good will associated with the late entertainer—the public's demand for Presley mementos—alone justified relief. *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1977); *Memphis Dev. Foundation v. Factors Etc., Inc.* 441 F. Supp. 1133 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir.), *cert. denied*, 101 S.Ct. 358 (1980).

Similarly, a court has enjoined, under the right of publicity, the imitation of the Laurel and Hardy characters in a television comedy series. *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979). The plaintiffs in *Worldvision* did not show passing-off or deception, only the unauthorized appropriation of the good will and creative efforts of the late comedians. *Id.* at 259.

In these cases, publicity interests provided adequate grounds for relief, without the showing or finding of any collateral harm or other element different in kind from copyright infringement. *But see Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980).

³²³ See notes 30-33 and accompanying text *supra*.

³²⁴ *Cf.* 1 M. NIMMER, *supra* note 105, § 1.01[B](1), at 1-17 (citing case where defendant copied news from bulletin boards and early editions of complainant's newspapers and sold them to his own customers).

³²⁵ The court in *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), held that a plaintiff asserting the right of publicity must demonstrate that the "celebrity" or performer who created the alleged interests commercially exploited his name and likeness during his lifetime. Because recovery for copyright infringement does not require this showing, the court reasoned that the right of publicity is not equivalent to copyright and therefore escapes preemption. *Id.* at 1099-1100.

The court's analysis in *Pro Arts*, however, is unconvincing. See note 252 *supra*. Recovery in a right of publicity action does not always require a showing of commercial exploitation. See notes 320-23 and accompanying text *supra*. Further, a requirement that the right

VI

RATIONALE FOR OTHER PREEMPTIVE EFFECTS

A. *The Right of Publicity: Time Duration*

Although the duration of copyright is limited,³²⁶ courts have held the right of publicity to be an assignable property right that survives in perpetuity. Consequently, if section 301 of the 1976 Copyright Act does not preempt rights of publicity such as those asserted in the characters of Laurel and Hardy in the *Hal Roach* and *Worldvision* cases, the right will conflict with copyright law when the copyrights on the Laurel and Hardy films expire.³²⁷

When copyright on a movie film expires, for example, the film falls into the public domain, and a retailing company may freely use scenes from the film to advertise its products or for any other purpose.³²⁸ However, this commercial use of the names, likenesses, and other distinguishing attributes of the movie actors is precisely the type of conduct enjoined in the *Hal Roach* and *Worldvision* cases.³²⁹ The arguably perpetual nature of the right of publicity would allow the plaintiffs in *Hal Roach* and *Worldvision*

of publicity plaintiff always show status of the interest-creator as a "celebrity," or prove "commercial exploitation," arguably imposes limitations on the publicity doctrine that are arbitrary and not clearly definable. Assertion of publicity rights should not depend upon "celebrity" status, but should be possible for anyone who has his persona wrongfully-appropriated. Cf. Nimmer, *supra* note 1, at 217 (arguing that arbitrariness in applying test of what constitutes "celebrity" status makes reliance on rule of damages preferable). Adherence to contract principles for damages and equitable relief provides fair and more easily applicable restrictions on recovery in right of publicity actions.

³²⁶ See 17 U.S.C. § 302(a) (Supp. III 1979) (copyright protection available for life of author plus 50 years).

³²⁷ The right of publicity's purely commercial nature has led some courts to construe it as a property right that is validly transferable and perpetual. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 479 F.2d 215, 221 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). See also *Hicks v. Casablanca Records & Filmworks*, 464 F. Supp. 426, 429-30 (S.D.N.Y. 1978); *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323, 1330 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, No. 80-314 (Nov. 3, 1980); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975); *Felcher & Rubin, supra* note 6, at 1618-19; Comment, *supra* note 37, at 1124-28; Note, *The Right of Publicity—Protection for Public Figures and Celebrities*, 43 BROOKLYN L. REV. 537, 541-49 (1976). Other courts, however, have reached a conflicting result that the right of publicity survives the death of its creator only if he commercially exploited his publicity interests during his lifetime. See, e.g., *Memphis Dev. Foundation v. Factors Etc., Inc.*, 616 F.2d 956, 958 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980); *Lugosi v. Universal Pictures*, 70 Cal. App. 3d 552, *modified*, 139 Cal. Rptr. 35, 37-38 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979). See generally 503 BNA PATENT, TRADEMARK AND COPYRIGHT J., at A-5 (Nov. 6, 1980) (discussing split between circuits that have addressed issue of perpetuity).

³²⁸ See, e.g., *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

³²⁹ See notes 283-94 and accompanying text *supra*.

to enjoin the *imitation* of characters like Laurel and Hardy in a film that is in the public domain after a copyright has expired. The appropriation would be an invasion of the plaintiffs' rights of publicity even though copyright on the particular film was no longer effective. Similarly, commercial exploitation of an actual Laurel and Hardy film would be as much an invasion of their publicity interests as the live imitation of the original actors' performances, and plaintiffs would argue that the commercial use of the film should be enjoined even though the film is in the public domain.

This argument should fail. Permitting a publicity action would contravene the federal policy of allowing the free use of intellectual property that is in general circulation and not protected by a valid patent or copyright.³³⁰ These strong federal interests also argue against allowing control over the imitation of the characters and characterizations captured in that film.³³¹ In this instance, the right of publicity contravenes federal policy favoring the free use of intellectual property in the public domain to the same extent, for example, as would control of the use of a Laurel and Hardy film with an expired copyright.³³²

The limited duration of copyright protection balances the interest of allowing an artist or author to use and derive long term benefits from intellectual creations against the competing interests of the copyright clause and the first amendment guarantees of free speech and press.³³³ The rationale for restricting the duration of copyright protection should apply to the right of publicity

³³⁰ Cf. *Lear, Inc. v. Adkins*, 395 U.S. 665, 668 (1969) (emphasizing permissibility of state protection of property not protected by federal copyright).

³³¹ The issue of whether publicity rights are assertable in characters and characterizations captured on film and in the public domain is analogous to the question of whether authors retain copyright interests in their created literary characters when works involving the characters fall into the public domain. When an author has used the same well-developed character in a series of works, and copyright protection on some but not all of the works has expired, anyone may copy the works that are within the public domain. However, whether the well-developed character found in both the protected and unprotected works may be used by someone writing a new story is debatable. One view is that once any work containing the character enters the public domain, anyone may use the same character in a work that is otherwise original. See 1 M. NIMMER, *supra* note 105, § 2.12, at 2-170.

³³² See, e.g., *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

³³³ See, e.g., Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A. L. REV. 1180, 1193 (1970); Comment, *supra* note 37, at 1125. The first amendment states that "Congress shall make no law . . . abridging the freedom of speech, or of the press. . . ." U.S. CONST. amend. I. The limited period of copyright protection balances the interest in allowing personal monopoly as an incentive for creation, against the public's interest in maximizing the dissemination of creative works.

as well. Permitting recovery for unauthorized appropriations of names, likenesses and other aspects of persona restricts freedom of speech as much as an injunction or an award of damages would in a copyright infringement action involving works in the public domain.³³⁴ Offsetting this restriction on free speech, of course, are the rationales supporting the right of publicity: rewarding an individual for his labors, allowing him to profit from the publicity value of his persona, and encouraging creativity.³³⁵ Recognition of a post-mortem right of publicity encourages creativity and vindicates expectations of profitability.³³⁶ Nevertheless, because a perpetual right of publicity conflicts with federal policies favoring the free use and expression of ideas, it should be preempted.³³⁷

If the duration of publicity rights requires limitation to escape constitutional preemption, courts must determine the appropriate limits on continuity and inheritability. Courts might do so in three ways. First, they might hold that publicity right protection, like copyright, lasts for the life of the proprietor plus fifty years.³³⁸ Second, courts might recognize the right after death of the creator only if he had assigned to an agent his right

³³⁴ See Comment, *supra* note 37, at 1126.

³³⁵ *Id.*; Felcher & Rubin, *supra* note 57, at 1129-32; Brenner, *supra* note 69, at 46.

³³⁶ See, e.g., *Memphis Dev. Foundation v. Factors, Etc., Inc.*, 616 F.2d 956, 958-59 (6th Cir. 1980), *cert. denied*, No. 80-314 (Nov. 3, 1980). The court in *Memphis* added, however, that making the right of publicity inheritable would not significantly inspire the creative efforts of individuals. *Id.* See generally Felcher & Rubin, *supra* note 57.

³³⁷ See, e.g., *Sears & Roebuck Co. v. Stiffel*, 376 U.S. 225, 231-32 (1965). Protection of a performer's persona is arguably permissible for a period of 50 years following his death. After that "reasonable period," however, it perhaps would no longer be constitutionally permissible to restrict the use of his likeness or name. Comment, *supra* note 37, at 1128. *Accord*, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 847, 603 P.2d 425, 447, 160 Cal. Rptr. 323, 345 (1979) (Bird, C.J., dissenting); Note, 29 HASTINGS L.J. 751 (1978).

³³⁸ See Comment, *supra* note 37, at 1126-28; Felcher & Rubin, *supra* note 57, at 1131; note 337 *supra*. See generally Note, 29 HASTINGS L.J. 751 (1978). In her dissenting opinion in *Lugosi*, Justice Bird argued that

[s]ince the right of publicity recognizes an interest in intangible property similar in many respects to creations protected by copyright law, . . . that body of law is instructive.

The Copyright Act of 1976 . . . provides that a copyright in new works shall be recognized during the author's life and for 50 years thereafter. That period represents a reasonable evaluation of the period necessary to effect the policies underlying the right of publicity. Therefore, I would hold that the right of publicity should be recognized during the subject's life and for 50 years thereafter.

25 Cal. 3d 813, 847, 603 P.2d 425, 446-47, 160 Cal. Rptr. 323, 344-45 (1979) (citations omitted).

to control it or otherwise had contracted for its use.³³⁹ Finally, courts could hold that the right is either personal, like the right of privacy,³⁴⁰ or not inheritable.³⁴¹ If courts characterize the right of publicity as inheritable, they must decide how long this property interest should last, considering the possible conflicts between the publicity doctrine and copyright policy, as well as rights of free expression.³⁴² The problems inherent in this sort of judicial line-drawing, along with the current uncertainty about the scope and nature of this right,³⁴³ suggest that to avoid conflicts with copyright law and the first amendment rights of free expression, courts should hold that the right of publicity is *not* inheritable.³⁴⁴

³³⁹ See Felcher & Rubin, *supra* note 6, at 1618-19. The rationale for allowing protection in perpetuity is that the possibility of legally providing for a person's heirs may have a motivational effect on the person during his life. Requiring that the interest-creator execute an assignment or contract lessens the difficulty of identifying harm from post-mortem misuse of publicity. *Id.* See also *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221-22 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); *Hicks v. Casablanca Records & Filmworks*, 464 F. Supp. 426, 429-30 (S.D.N.Y. 1978).

³⁴⁰ In *Lugosi*, the court stated:

If rights to the exploitation of artistic or intellectual property never exercised during the lifetime of their creators were to survive their death, neither society's interest in the free dissemination of ideas nor the artist's rights to the fruits of his own labor would be served. Authority, as noted, supports the strong policy considerations which underlie the conclusion that the right is personal.

Lugosi v. Universal Pictures, 70 Cal. App. 3d 552, *modified*, 139 Cal. Rptr. 35, 40 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

³⁴¹ See, e.g., *Memphis Dev. Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

³⁴² See, e.g., *id.* at 959.

³⁴³ For example, the court in *Memphis* stated:

Is the right of publicity taxable? . . . Does the right apply to elected officials and military heroes whose fame was gained on the public payroll, as well as to movie stars, singers and athletes?

. . . .

Fame often is fortuitous and fleeting. It always depends on the participation of the public in the creation of an image. It usually depends on the communication of information about the famous person by the media. The intangible and shifting nature of fame and celebrity status, the presence of widespread public and press participation in its creation, the unusual psychic rewards and income that often flow from it during life and the fact that it may be created by bad as well as good conduct combine to create serious reservations about making fame the permanent right of a few individuals to the exclusion of the general public.

Id. at 959. See also *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

³⁴⁴ In holding the publicity right uninheritable, the court in *Memphis* concluded: "We do not think that whatever minimal benefit to society may result from the added motivation and extra creativity supposedly encouraged by allowing a person to pass on his fame for the commercial use of his heirs or assigns outweighs the [countervailing]

B. Incentive to Create and the Public Benefit

Several right of publicity decisions that involved the name and likeness of Elvis Presley conflict with copyright law and suggest another rationale for preemption. Presley had granted the exclusive right to market his persona to his manager early in his career and, later, to a corporation. When he died in 1977, this company granted to Factors Etc., Inc., the exclusive right to market the commercial Presley attributes throughout the world.³⁴⁵ Following Presley's death a substantial market for memorabilia developed as the public demanded posters, statuettes, and other merchandise bearing his name or likeness.³⁴⁶ In several suits that challenged the marketing of Presley memorabilia by entities not licensed by Factors, courts held that the exclusive right to exploit the Presley name and likeness existed during his life, survived his death, and was validly transferred.³⁴⁷ Thus, courts enjoined the sale of eight-inch pewter replicas of a Presley statue³⁴⁸ and a poster made from a copyrighted photograph of Elvis on stage during one of his last live performances.³⁴⁹ One rationale for the injunctions was that permitting a non-licensee to use Presley's persona would vitiate the contract transferring control of these interests to Factors.³⁵⁰

Right of publicity actions like those involving the Presley persona possibly are subject to preemption under section 301. Factors

considerations. . . ." *Memphis Dev. Foundation v. Factors Etc., Inc.*, 616 F.2d 956, 960 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

³⁴⁵ *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 281 (S.D.N.Y. 1977), *aff'd*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

³⁴⁶ *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323, 1325 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980). *See also* *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 285 n.6 (S.D.N.Y. 1977), in which the court noted that an issue of *People* magazine had depicted on its cover a variety of Elvis Presley merchandise under the headline "Remembering Elvis/Imitators, fans & rip-offs launch a billion dollar industry."

³⁴⁷ *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288, 290 (S.D.N.Y. 1977), *aff'd*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). The Second Circuit left undecided the issue of whether the right of publicity would survive the death of a celebrity if not exploited during his life. 579 F.2d at 222 n.11. *See also* *Memphis Dev. Foundation v. Factors Etc., Inc.*, 442 F. Supp. 1323, 1327-28 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980). Other courts have noted that exploitation during lifetime might be necessary for the right's perpetuity. *See, e.g.*, *Hicks v. Casablanca Records*, 464 F. Supp. 426, 429 (S.D.N.Y. 1978).

³⁴⁸ *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323, 1330-31 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

³⁴⁹ *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 279, 288 (S.D.N.Y. 1977).

³⁵⁰ *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323, 1330 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

licensed the manufacture and sale of Presley memorabilia, which was copyrightable subject matter. The posters, photographs, and statuettes were "works of authorship" fixed in tangible media of expression.³⁵¹ The conduct constituting the invasion of publicity rights involved nothing more than the reproduction and distribution of Presley's likeness, which had been previously fixed.³⁵² Thus, because the two elements required for preemption existed,³⁵³ Factors should have been unable to obtain relief under a right of publicity theory.³⁵⁴

The *Factors* decisions also conflict with the balance of interests struck by Congress in the copyright law—to reward the artist or author and secure "the general benefits derived by the public from the labor of authors [and artists]."³⁵⁵ Copyright protection undoubtedly encourages and rewards individuals for their creative work. But the underlying aim of promoting this incentive is to stimulate artistic creativity for the benefit of the general public.³⁵⁶ The right of publicity has the same ultimate goal.³⁵⁷

In one Elvis Presley case, the court held that the reproduction and sale of a poster made from a copyrighted photograph of Elvis in concert invaded publicity interests of the plaintiff, who held "the exclusive license to exploit commercially the name and likeness of Elvis Presley."³⁵⁸ In another, *Memphis Development*

³⁵¹ See 17 U.S.C. § 102 (Supp. III 1979). Factors was marketing its own pewter statuettes through a licensee. See *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323, 1325 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 156 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980). A copyright infringement action against the defendant nonlicensee appears to have been possible. Similarly, assuming that other licensees had fixed Presley's likeness in various media of expression, it appears to have been possible for Factors to bring copyright infringement actions against other nonlicensees.

Success in copyright infringement actions would have been dubious, however, because proof of copying and "substantial similarity" would have been difficult. The defendants would have insisted that their Presley poster and statuette were independent creations based not on Factors' marketed products embodying the Presley character, but rather on the "original" Presley character itself. Cf. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903) ("Others are free to copy the original. They are not free to copy the copy.").

³⁵² See 17 U.S.C. §§ 106(1), (3) (Supp. III 1979). *But see Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1097 (S.D.N.Y. 1980) (holding right of publicity not equivalent to copyright because its assertion requires more than proof of reproduction and distribution).

³⁵³ See notes 205-08 and accompanying text *supra*.

³⁵⁴ *But see Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1100 (S.D.N.Y. 1980).

³⁵⁵ See, e.g., *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932).

³⁵⁶ See, e.g., *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

³⁵⁷ See notes 51-73 and accompanying text *supra*.

³⁵⁸ *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 217 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). The defendant in the case had purchased rights to a copyrighted photograph of Presley from an Atlanta Journal staff photographer. *Id.* at 217.

Foundation v. Factors Etc., Inc.,³⁵⁹ the plaintiff, a nonprofit corporation, commissioned a sculptor to create a bronze Elvis Presley statue.³⁶⁰ To finance the project, the plaintiff arranged to give eight-inch pewter replicas of the statue to persons donating twenty-five dollars or more to the commemoration effort.³⁶¹ Both the statue and replicas were copyrightable subject matter.³⁶²

The injunction issued on the basis that the right of publicity claim in the *Memphis Development* case prohibited the sculptor from exercising rights that section 106 of the 1976 Copyright Act gives to copyright owners—the exclusive right to exploit works by reproduction, distribution, and display.³⁶³ When the artist or author cannot publicly sell or distribute his work because his product incorporates a name or likeness in a manner that is actionable as an invasion of some individual's right of publicity, the incentive to create diminishes, with detrimental effects on the general public. Similarly, companies would have little incentive to buy from an artist the assignment of copyright in subject matter involving publicity interests if some individual, or his estate, could prevent commercial exploitation of the interests by asserting ex-

³⁵⁹ 441 F. Supp. 1323, 1324 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

³⁶⁰ *Id.* at 1324.

³⁶¹ *Id.*

³⁶² See 17 U.S.C. § 102(a)(5) (Supp. III 1979); *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959) (holding sculptured reproduction of Rodin's "Hand of God" copyrightable); 1 M. NIMMER, *supra* note 105, § 2.08[C], at 2-94 to 2-99. If the sculptor and plaintiff had copyrighted the items, they would have had the right, in accordance with the goals of copyright, to reap and control the benefits of their creative endeavors. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576-77 (1977); *Mazer v. Stein*, 347 U.S. 201, 219 (1954). Infringement of this right would have frustrated the copyright law's purpose of enhancing their creative motivation. In theory, this would have proved detrimental to the public good. Cf. *Washington Publishing Co. v. Pearson*, 306 U.S. 30, 36 (1939) (noting that purpose of Copyright Act of 1909 was to afford greater protection to literary works of lasting public benefit).

³⁶³ See 17 U.S.C. § 106 (Supp. III 1979). The injunction in *Memphis Development* allowed the defendant to build the disputed memorial, but prohibited it from manufacturing, selling or distributing any statuette bearing Presley's image or likeness. See *Memphis Dev. Foundation v. Factors Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956, 957 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

Similarly, the permanent injunction that the court granted in the *Pro Arts* case eliminated the defendant copyright purchaser's rights to reproduce and distribute its Elvis Presley poster. *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1104 (S.D.N.Y. 1980). The court's analysis of right of publicity preemption, however, did not address the conflict between copyright goals and the right of publicity. Rather, the court simply stated that "[t]he right of publicity, firmly supported by the Supreme Court and the Second Circuit, would be severely undermined if it could be so easily circumvented by using a photograph or representation allegedly copyrighted or within the public domain." *Id.* at 1100. *But see* note 252 *supra*.

clusive control over the commercial use of the person's name, likeness or character. In this context the right of publicity and copyright are incompatible. Overriding federal policy and the supremacy clause mandate that the copyright law prevail, even though the artist's creation—his tangible work—is the likeness or characterization of a celebrity.³⁶⁴

Another conflict between the right of publicity and copyright arises from the decisions in the *Memphis Development* and other *Factors* cases. The copyright monopoly comports with the public interest and the first amendment because it is of limited duration and protects only a particular expression of an idea rather than the idea itself.³⁶⁵ These limitations preserve the availability of the idea to the public.³⁶⁶ The unauthorized poster of Elvis Presley in *Factors Etc., Inc. v. Pro Arts, Inc.*³⁶⁷ was based upon a photograph on which the defendant held a copyright. If the plaintiff had owned the copyright then its monopoly would have been limited in duration and scope. Upon expiration of the copyright, the photograph would have entered the public domain. The court's grant of injunction under the right of publicity, however, bestowed a much broader monopoly than possible under the copyright law. The injunction not only restrained the defendant's exploitation of its copyrighted photograph but also gave the plaintiff, *Factors*, perpetual rights to control the reproduction and public distribution of all representations of Elvis Presley's likeness, including copyrighted paintings, photographs, drawings and sculptures created and owned by others.³⁶⁸ This perpetual monopoly on any and all pictures or representations of Presley, grounded on the right of publicity, is incompatible with the policy underlying the federal copyright law.³⁶⁹

³⁶⁴ State law is preempted under the supremacy clause when it obstructs the accomplishment or execution of the objectives of an act of Congress. *See, e.g., Hines v. Davidowitz*, 312 U.S. 52, 57 n.20 (1941). Excessive state protection in this context inhibits the artist's incentive, which is detrimental to both the objectives of federal copyright law and the public's interest in having access to creative works.

³⁶⁵ *See* note 333 and accompanying text *supra*.

³⁶⁶ *See, e.g., Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 393-95 (1968).

³⁶⁷ 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

³⁶⁸ *Id.* at 217-18. The preliminary injunction in the *Memphis Development* case not only stopped sale of the statuettes, but in addition it prevented the Foundation from using commercially in any manner or form, the name, image, photograph or likeness of Presley. 441 F. Supp. 1323, 1330-31 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 101 S.Ct. 358 (1980).

³⁶⁹ On appeal to the Supreme Court in *Factors Etc., Inc. v. Pro Arts, Inc.*, the defendant asserted this argument against the right of publicity as one of several reasons for setting

C. Protection of Ideas and the Right of Publicity

The right of publicity may conflict with the established principle that ideas are not protectible.³⁷⁰ The distinction between ideas and expression, expressly recognized by the 1976 Act,³⁷¹ should also apply to the right of publicity.³⁷² For example, the protectible live performance in *Zacchini* consisted of an idea and its expression. As with a fixed copyrightable work, the idea of the performance—a man being shot from a cannon—was freely available for use by others. The Supreme Court indicated that the defendant television station might freely stage and film its own “human cannonball” act,³⁷³ based on *Zacchini*’s idea. Federal policy and the first amendment interests support this result.³⁷⁴

In copyright law, the idea/expression dichotomy is not so much a limitation on the copyrightability of works as it is a factor that must be considered in determining whether an unauthorized copy infringes an original copyrighted work.³⁷⁵ Actionable copying results when the defendant substantially copies the plaintiff’s expression.³⁷⁶ If the only similarity between two works is an abstract idea, there is not substantial similarity, and there-

aside the injunction restraining distribution of the defendant’s poster. Petitioner’s Brief for Certiorari at 16, *Pro Arts, Inc. v. Factors Etc., Inc.*, No. 78-682 (1978). The Supreme Court, however, refused to consider the issue and denied certiorari. 440 U.S. 908 (1979). Subsequently, when the district court approved the plaintiff’s request for a permanent injunction, it did not convincingly analyze the incompatibility of federal and state policies. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980) (discussed at note 252 *supra*).

³⁷⁰ See 3 M. NIMMER, *supra* note 105, § 13.03[A][1], at 13-17. Affording property status to an idea would contradict the policy of having ideas freely accessible to the public. Copyright, therefore, allows protection for only the expression of a “work of authorship,” not the underlying idea.

The idea/expression distinction is viewed as a requirement of the first amendment because extending copyright protection to abstract ideas as property might constitute an abridgement of free speech. See, e.g., *Eichel v. Martin*, 241 F. 404, 410 (S.D.N.Y. 1913). Moreover, protection of an idea as property would make it unavailable to authors, which would reduce the arena of thought open for creative development and commercial exploitation. Such a result would obstruct the constitutional purpose of copyright law, which is to promote “the progress of science and the useful arts.” 3 M. NIMMER, *supra* note 105, § 13.03[A][1], at 13-17 (citing *Becker v. Loew’s, Inc.*, 133 F.2d 889 (7th Cir. 1943)).

³⁷¹ See 17 U.S.C. § 102(b) (Supp. III 1979).

³⁷² See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 577 n.13 (1977).

³⁷³ *Id.*

³⁷⁴ See note 370 *supra*.

³⁷⁵ 1 M. NIMMER, *supra* note 105, § 2.03[D], at 2-32. See, e.g., *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

³⁷⁶ See, e.g., *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

fore, no infringement.³⁷⁷ The distinction is nonetheless difficult to draw. One court has commented, "Obviously, no principle can be stated as to when an imitator has gone beyond the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be *ad hoc*."³⁷⁸ Existing formulations as to when a work of authorship transcends a mere idea and becomes a protectible expression are vague. Consequently, the "guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the . . . copyright laws."³⁷⁹

Distinguishing a protectible expression of a publicity interest from the idea upon which the persona expression is based becomes even more difficult. For example, a name or likeness, without more, is not copyrightable subject matter. The name or likeness alone entails no underlying idea and does not constitute a work of authorship.³⁸⁰ Protection of these simple publicity interests does not contravene the policy of having ideas freely accessible to the public. A performer's right of publicity in his performance, however, is more problematic. Although the defendant in *Zacchini* could have staged its own human cannonball act without infringing the plaintiff's right of publicity,³⁸¹ it is unclear whether the defendant could have freely copied and filmed a number of the other aspects of *Zacchini*'s act. The qualities that made the expression of the "human cannonball" idea unique were the various accouterments of *Zacchini*'s act.³⁸² How many of those elements warrant protection? Is the conduct actionable only if there has been slavish copying of every aspect of the act—an outright misappropriation?

In copyright, the "essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization."³⁸³ The

³⁷⁷ See, e.g., *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943).

³⁷⁸ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, J.).

³⁷⁹ *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

³⁸⁰ See 17 U.S.C. § 102 (Supp. III 1979); *Katz*, *supra* note 52, at 217; notes 274-82 and accompanying text *supra*.

³⁸¹ See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 577-78 n.13 (1966) (noting that copyright law does not restrain communication of ideas or concepts).

³⁸² Presumably *Zacchini*'s actual fifteen second cannon shot was preceded by some fanfare lasting several minutes that served to heighten audience anticipation. The dramatic prelude to his act may have included an introduction, a description of his equipment and of the uniqueness and danger of his stunt, a final check of the cannon, and the performer's entry into its barrel. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 579 n.1 (1977) (Powell, J., dissenting).

³⁸³ *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir.), *cert. denied*, 429 U.S. 980 (1976).

requirements for copyright infringement may apply by analogy to right of publicity claims. For example, suppose an appropriator like the defendant in *Zacchini* staged its own human cannonball act by copying the plaintiff's costume, his cannon-shot rituals, the dress of his cannon, and the costumes and number of attendants. He would probably infringe the plaintiff's publicity interests because these aspects of the original creator's act—his expression of the idea—are distinctive. Reproduction of these traits invades the creator's right of publicity in his performance. In order to be actionable, the defendant's conduct need not amount to an outright misappropriation of the plaintiff's live performance.

The *Lombardo* case clearly illustrates an actionable copying of protected expression.³⁸⁴ In their efforts to promote retail sales of automobiles, the defendants were unable to obtain the participation of Guy Lombardo and his orchestra in their television advertisement of a special edition of car model. The promotional idea was to have a band playing at a party celebrating both a New Year and the new edition of the car. The defendant infringed the plaintiff's publicity interests not by using the advertising format itself, but rather by adopting a format that made it appear to the viewing public that Lombardo himself and his band played at the celebration.³⁸⁵ The court's holding that this conduct created a valid cause of action and that the appropriation of his form of expression possibly warranted relief does not contravene the principle that ideas alone are freely copyable.³⁸⁶ The defendants could have used the identical advertising format so long as the actor conducting the band did not use the same gestures, musical beat, and choice of music that the public associated with Guy Lombardo. The plaintiff had no exclusive rights in the format itself, but did possess rights in the particular mode of expression used in that format, which he had developed over a period of forty years.

Difficulty in reconciling the idea/expression dichotomy with the scope of the right of publicity arises from the tenuous distinction between the actionable appropriation of expression and the nonactionable appropriation of an idea. The distinction is sometimes clear, as in *Lombardo*. In other circumstances, however, the distinction is difficult. Where the publicity interest is in a charac-

³⁸⁴ *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977).

³⁸⁵ *Id.* at 622, 396 N.Y.S.2d at 664.

³⁸⁶ *See, e.g., Fendler v. Morosco*, 253 N.Y. 281, 171 N.E. 56 (1930).

ter, characterization, or even style, the amount of "expression" entitled to protection may be minimal.³⁸⁷ Right of publicity protection, consequently, may conflict with the basic principle that ideas are not protected. For example, the "idea" of Laurel and Hardy in the *Hal Roach* and *Worldvision* cases³⁸⁸ involved a comedy team consisting of two male characters. One was fat, "explosive," and jolly, and the other was skinny, "lovable and bumbling."³⁸⁹ One played the straight man for the other's gags and jokes. Other comedy teams have used a similar format, but the two deceased actors had become personally identified with these characters. They had come to personify both an idea and its expression. Thus, the plaintiffs in the *Hal Roach* and *Worldvision* cases were able to prevent any use, imitation or reproduction of the Laurel and Hardy characters.³⁹⁰

Another comedy team's use of the comic routines and gags that the public associates with Laurel and Hardy could have violated the publicity interests in the deceased comedians' characters even though the specific routines and gags may not have been sufficiently developed and individualized to justify copyright protection.³⁹¹ Typically, the dialogues, settings, and sequences in comedy routines are stock scenarios, freely usable by other comedians.³⁹² Thus, the proposed comedy series enjoined in *Worldvision* probably would not have infringed copyrights effective on the Laurel and Hardy movies absent verbatim copying or substantial similarity of scripts. Moreover, the test of substantial similarity is one of degree and is necessarily vague.³⁹³ The right of

³⁸⁷ The idea/expression distinction, as applied to characters, implies that the more unoriginal the character, the more likely that it is public property as a stock character, available for use in a wide variety of stories and entertainment contexts. However, the clarity of the character's delineation and his importance to the original work is always a question of degree. Comment, *supra* note 134, at 1022 & n.21.

³⁸⁸ *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979); *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975).

³⁸⁹ *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252, 257 (S.D.N.Y. 1978).

³⁹⁰ *Price v. Worldvision Enterprises, Inc.*, 455 F. Supp. 252, 266 (S.D.N.Y. 1978) (prohibiting development of television series in which actors imitated Laurel and Hardy in typical comic situations), *aff'd*, 603 F.2d 214 (2d Cir. 1979); *Price v. Hal Roach Studios*, 400 F. Supp. 836, 847 (S.D.N.Y. 1975).

³⁹¹ See notes 283-95 and accompanying text *supra*.

³⁹² Basic comedy team character-types are classifiable as "stock" characters and the principal elements of a familiar comedy routine have been termed "hallowed shelf items." Use of either typically involves no invasion of publicity rights. Cf. Comment, *supra* note 134, at 1033 (discussing problem of articles that are "mechanical, . . . lacking in invention" and "lacking in originality").

³⁹³ See, e.g., *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

publicity, in contrast, is invaded by the imitation of characters, not by the use of the unprotected comedy routines and formats. Thus, the plaintiffs in *Hal Roach* and *Worldvision* were arguably eligible for protection under the right of publicity even though a copyright infringement action would be unavailable.

The unique contribution of Laurel and Hardy, in addition to public domain material such as the formats of their skits and routines, was their familiar character style and form of expression. By imitating these character styles, the defendants in *Hal Roach* and *Worldvision* appropriated a form of expression that deserved protection. The simulation did not need to be a mirror image of the characterizations to infringe the right of publicity.

The prospect that slavish imitation itself may be actionable poses the risk that courts will extend protection to interests that would otherwise fall within the prohibition against monopolized control of pure ideas. The courts should not overbroadly construe the right of publicity as inhering to interests which, under copyright law, would not be protectible because they are not fixed or, because the interests consist of an unprotectible idea, format or other material in the public domain. The right of publicity must not contravene the principle that ideas are freely usable by all.

CONCLUSION

The effects of federal intellectual property policy and section 301 of the Copyright Act of 1976 on the right of publicity is problematic. The conduct that gives rise to a claim based on an invasion of this right is often nothing more than the unauthorized copying, reproduction, distribution, or display of one or more of the several publicity interests it protects. Thus, a right of publicity action often vindicates rights that are "equivalent" to the exclusive rights within the general scope of copyright. However, these "equivalent" rights do not necessarily inhere in "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright."³⁹⁴ Such intangible interests as names, likenesses, distinctive styles, attributes of personality, acts or performances, and other elements of one's "persona" have been the bases of viable right of publicity claims. Because these interests are not all writings or fixed works of authorship, section 301 may not require preemption of some right of publicity actions.

³⁹⁴ 17 U.S.C. § 301 (Supp. III 1979).

When one of these interests amounts to a work of authorship and is fixed in a tangible medium of expression, however, it falls within the subject matter of copyright. If the fixed expression is subsequently copied, reproduced, and distributed, forceful arguments support federal preemption of a state-created right of publicity aimed at redressing the appropriation of interests in the form of fixed expressions. The perpetual nature of the doctrine strengthens the argument for preemption. Otherwise, the right of publicity would conflict with the federal scheme of copyright and perhaps stifle the creative efforts of some individuals.

No blanket generalizations can resolve the questions concerning the continued vitality of the right of publicity. Like misappropriation, some right of publicity actions may be preempted. Others may survive either because of the subject matter of the plaintiff's claim, or because the particular right being vindicated is not equivalent to copyright. Future defendants should assert the federal statutory preemption defense against state right of publicity claims under the 1976 Copyright Act.³⁹⁵ In view of the variety of interests protected by this right, some of which can be classified as copyrightable subject matter, and the several rights that have been vindicated by publicity actions, the preemptive effects of federal law on right of publicity claims must be determined on a case by case basis.

³⁹⁵ See, e.g., *Mitchell v. Penton/Indus. Publishing Co.*, 486 F. Supp. 22 (N.D. Ohio 1979). The plaintiff in *Mitchell* argued that the defendant had infringed copyright on the plaintiff's book, and that the defendant had committed the tort of unfair competition by appropriating many factual recitations contained in the plaintiff's book. *Id.* at 22-23. The court rejected the plaintiff's unfair competition argument on the ground that, because the plaintiff was asserting it to vindicate state law rights equivalent to rights protected by copyright, it was preempted by the federal copyright laws. *Id.* at 25-26. See also *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1979) (affirming district court's grant of summary judgment against plaintiff's unfair competition claim joined with copyright infringement claim); *Orth-O-Vision, Inc. v. Home Box Office, Inc.*, 474 F. Supp. 672, 684 (S.D.N.Y. 1979) (holding state unfair competition claim preempted in multiple count action).