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Rights of Publicity: A Practitioner's Enigma

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PRACTICE POINTS

RIGHT OF PUBLICITY: A PRACTITIONER'S ENIGMA

Gil N. Peles, Esq.*

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I. INTRODUCTION

Monday morning. You walk into the office and encounter three voice messages from a single client. The client, based in Los Angeles, took a trip to Australia where he filmed his five-year-old daughter, Emma, hopping around with a baby kangaroo. Your client posted the hopping-heavy video clip on YouTube, it went viral overnight, and Emma became an instant celebrity. One month later, Acme Toys (Acme), a Georgia-based toy company, sells thousands of wind-up hopping “Kangaroo Kid” dolls nationwide that bear a remarkable resemblance to Emma. Your client calls you, fuming about this unpermitted exploitation.

What do you do? The short answer: File a lawsuit against the toy company for the misappropriation of Emma’s likeness, or her right of publicity. However, where you should file the lawsuit constitutes the difficult part of the question.

This Article will explore challenges facing practitioners in filing a right of publicity action. Issues relating to forum, damages, and defenses will be addressed. As Emma’s dilemma will illustrate, the current condition of right of publicity jurisprudence necessitates a practitioner to carefully navigate through a nationwide patchwork of conflicting state laws.

II. BACKGROUND

The right of publicity is a state-law based intellectual property right of a person to control the commercial use of his or her identity. It is not limited to celebrities, but is a right for every person to recover for the unpermitted taking of his or her persona. The right of publicity is currently recognized, to greatly varying degrees, in nearly every state.

Due to the varying degrees in which each state recognizes the right of publicity, it remains largely misunderstood and inconsistently applied across jurisdictions. Depending on the state, remedies in a right of publicity case may include an injunction, restitution, pecuniary damages, non-pecuniary damages, punitive damages, and attorney’s costs and fees and may or may not include protection of a post-mortem right. These wide variations make it necessary for practitioners to carefully navigate through a nationwide patchwork of conflicting state laws.

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1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:3 (2d ed. 2009).
2 Id.
5 Id.
litigants, such as Emma, to carefully evaluate a variety of laws and jurisdictions prior to filing a right of publicity action.

III. WHERE CAN EMMA SUE?

A right of publicity dispute usually involves a number of jurisdictions including the location of the plaintiff, the location of the defendant, and the location(s) of the misappropriation. In our scenario, Emma, a California resident, will bring suit against a Georgia corporation that is selling its “Kangaroo Kid” product nationwide. Based on Acme’s nationwide sales, Emma can theoretically choose among many jurisdictions. For purposes of this Article, we will focus on the two most relevant jurisdictions, California and Georgia.

California and Georgia offer different types of right of publicity laws. California has a long recognized common-law right of publicity as well as extensive statutes that also allow for a post-mortem right. California Civil Code section 3344 authorizes recovery of damages by any person whose “name, voice, signature, photograph, or likeness” has been knowingly used without the person’s consent for commercial purposes. For example, California’s right of publicity statute has been successfully invoked against a company that produced statue likenesses of George Wendt and placed them in airport restaurants, an Oldsmobile television commercial that compared its automobiles to Kareem

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6 States apply varying rules to determine choice of law. Under the “Vested Rights Theory,” utilized in roughly a third of states, tort cases are governed by the place of injury. MCCARTHY, supra note 1, § 11:8. Under this theory, Emma could theoretically bring an action in any state in which Acme’s product was sold. Other states, such as California, apply a three-step “governmental interest” analysis that attempts to “apply the law of the state whose interest would be more impaired if its law were not applied.” Downing v. Abercrombie & Fitch, 265 F.3d 994, 1005 (9th Cir. 2001) (citations and quotation marks omitted) (allowing non-California residents to bring a California right of publicity action).

7 See Comedy III Prods., Inc. v. Gary Saderup, Inc., 1 P.3d 797, 799 (Cal. 2001) (noting that in California “the right of publicity is both a statutory and a common law right”); see also CAL. CIV. CODE §§ 3344-3344.1 (Deering 2010).

8 CAL. CIV. CODE § 3344(a) (Deering 2010). To prevail on a claim for violation of the right of publicity under California common law, a plaintiff must prove “(1) the defendant’s use of plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.” Montana v. San Jose Mercury News, Inc., 40 Cal. Rptr. 2d 639, 640 (Cal. Ct. App. 1995). The California statutory right of publicity additionally requires proof that the alleged violation was committed “knowingly” and that there is a “direct connection” between the use of the plaintiff’s identity and the defendant’s commercial purpose. CAL. CIV. CODE § 3344(a); see also Eastwood v. Superior Court for L.A. County, 198 Cal. Rptr. 342, 346–47 (Cal. Ct. App. 1983).

9 Wendt v. Host Int’l, Inc., 197 F.3d 1284 (9th Cir. 1999).
Abdul-Jabbar, and a clothing catalogue that displayed pictures of surfers next to Abercrombie clothes.

Unlike California, Georgia does not have a right of publicity statute. Instead, Georgia recognizes a common law right of publicity to protect against "the appropriation of another's name and likeness . . . without consent and for the financial gain of the appropriator . . . whether the person whose name and likeness is used is a private citizen, entertainer, or . . . a public figure who is not a public official." The common law right of publicity in Georgia grew out of a long-standing recognition of the right to privacy—the Georgia Supreme Court became the first such court to recognize the right of privacy in 1905. In the most well-known Georgia right of publicity case, the estate of Martin Luther King Jr. successfully brought an action against a company selling souvenir plastic busts depicting Dr. King. In that case, the Supreme Court of Georgia held that

the appropriation of another's name and likeness, whether such likeness be a photograph or sculpture, without consent and for the financial gain of the appropriator is a tort in Georgia, whether the person whose name and likeness is used is a private citizen, entertainer, or as here a public figure who is not a public official.

In our scenario, both California and Georgia allow Emma an opportunity to bring an action against Acme for the misappropriation of her likeness. Even though California offers a statutory-based cause of action versus Georgia's common-law tort, the basic elements surrounding a right of publicity claim are virtually identical in either state.

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11 Downing, 265 F.3d 994.
12 Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 703 (Ga. 1982). "The right of publicity may be defined as [an individual's] right to the exclusive use of his or her name and likeness." Id. at 700 (citation omitted); see also Alonso v. Parfet, 325 S.E.2d 152, 153 (Ga. 1985) ("The courts in this state have long recognized that one who makes an unsanctioned appropriation of another's name or likeness for his own benefit may be liable to that person in tort." (citation omitted)).
14 Martin Luther King, 296 S.E.2d at 703.
15 Id.
16 See supra notes 8–15 and accompanying text.
17 Although not relevant to our current hypothetical, it should be noted that California's statute provides recovery for misappropriation of one's "voice" and it is unclear whether Georgia would allow a similar claim.
IV. WHERE CAN EMMA GET THE MOST MONEY?

Which states' law could provide Emma with the largest damage award? California's right of publicity statute allows for extensive damage claims; a party can claim actual damages, disgorgement of profits, punitive damages, and attorney's fees and costs. One can also seek injunctive relief to prevent future misappropriation. However, in a note of caution, California's right of publicity statute mandates an award of attorney's fees and costs to either prevailing party, heightening the risks involved.

Damage awards in California have varied widely. In one of the largest right of publicity awards on record, singer Tom Waits was awarded $375,000 compensatory damages and $2 million in punitive damages when the defendant, Frito-Lay, Inc., hired a sound-alike performer to imitate Waits' voice in its commercial after Waits refused to personally participate in the advertisement. Waits' award included compensation for injury to Waits' "peace, happiness and feelings," his "goodwill, professional standing and future publicity value" and the fair market value of Waits' services.

In another California case, the owner of The Three Stooges' right of publicity was awarded $75,000 in damages and $150,000 in attorneys' fees, but no punitive damages, against an artist that sold t-shirts depicting lithograph drawings of the Stooges. The damage award in that case was based on the artists' profits from the sale of the unlicensed products.

In Georgia, the measure of damages for violation of a right of publicity is more limited than California, compensating a plaintiff for the "value of the..."
appropriation to the user” of the likeness.\(^{25}\) A plaintiff can also seek punitive damages under the general punitive damage statute, although any such award is limited to $250,000.\(^{26}\) In addition, a plaintiff can seek attorney’s fees under the general attorney’s fees statute, but those fees are not mandatory and require a showing of bad faith.\(^{27}\) In a recent example from 2006, a model was awarded $25,000 in damages and $10,000 in attorney’s fees after the defendant corporation used the model’s picture, without permission, in a marketing campaign.\(^{28}\)

As applied here, California offers Emma the prospect of a significantly larger monetary award than Georgia. In California, Emma can claim various forms of actual damages, including damages to “peace, happiness and feelings,” in addition to a disgorgement of Acme’s profits, attorneys’ fees, and punitive damages. In Georgia, Emma would be restricted to a disgorgement of Acme’s profits and a limited amount of punitive damages and a discretionary award of attorneys fees. Thus, from a damages award perspective, California’s laws appear to be more favorable to Emma.

V. CAN ACME ASSERT A FIRST AMENDMENT DEFENSE?

Can Acme claim a constitutional right to use Emma’s likeness? The interaction between the right of publicity and the constitutional freedom of speech is perhaps one of the murkiest areas of right of publicity law. Courts across the country have employed widely varying rules and tests in an attempt to balance competing interests between the right of publicity and the First Amendment.

The right of publicity is necessarily in tension with the First Amendment’s protection of freedom of speech. The First Amendment provides that “Congress shall make no law ... abridging the freedom of speech, or of the press . . . .”\(^{29}\) The Georgia and California state constitutions provide similar protections.\(^{30}\)


\(^{29}\) U.S. CONST. amend. I.

\(^{30}\) The Georgia state constitution provides that “[e]very person may speak, write, and publish sentiments on all subjects but shall be responsible for the abuse of that liberty.” GA. CONST. art. I, § I, ¶ V. The California constitution states: “Every person may freely speak, write and publish his or her sentiments on all subjects, being responsible for the abuse of this right.” CAL. CONST. art. I, § 2(a).
Georgia and California employ very different tests in balancing the right of publicity with First Amendment concerns. Georgia courts have adopted a "newsworthiness" exception to the right of publicity. The Supreme Court of Georgia affords First Amendment protection to the use of a plaintiff's likeness where such use "is a matter of public interest." At the same time, Georgia courts also distinguish purely commercial use from newsworthy use, stating that a defendant may not obtain First Amendment protection if it uses a plaintiff's likeness "for purely financial gain."

Georgia courts have used the "newsworthy" right of publicity test to find that the publication of a plaintiff's nude pictures would not qualify for First Amendment protection because the publication was purely commercial and not related to any news event. In another example, the sale of a plastic bust depicting Dr. Martin Luther King Jr. also did not qualify for First Amendment protection because the use of Dr. King's likeness was purely commercial.

Unlike Georgia, California has employed a recently created and copyright-derived "fair use" test to balance the right of publicity with the First Amendment. Specifically, the California publicity fair use test asks whether the product in question merely replicates the likeness of the plaintiff or "adds something new" that makes the work sufficiently "transformative." If the "product containing the celebrity's likeness is so transformed that it has become primarily the defendant's own expression of what he or she is trying to create or portray, rather than the celebrity's likeness, it is protected."

The California test has been utilized to hold that an artist who produced t-shirts depicting paintings of the plaintiffs did not gain First Amendment protection because his work constituted nothing more than drawings of the literal likenesses of the plaintiffs. However, in another application, the court held that half-worm comic book characters depicting musicians Johnny and Edgar Winter did merit First Amendment protection. In that case, the court found that the

31 Toffoloni v. LFP Publ'g Group, LLC, 572 F.3d 1201, 1208 (11th Cir. 2009).
32 Id. (citing Waters v. Fleetwood, 91 S.E.2d 344, 348 (Ga. 1956)).
33 Id. (citing Pavesich v. New England Life Ins. Co., 50 S.E. 68, 80 (Ga. 1905)).
34 Id. at 1210.
35 Id. at 1210 (citing Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 699 (Ga. 1982)). Although the Georgia Supreme Court did not explicitly discuss the First Amendment in the Martin Luther King decision, the Eleventh Circuit in Toffoloni interpreted the Martin Luther King decision to hold by inference that the plastic bust depicting Dr. King would not have qualified for First Amendment protection. Id.
38 Comedy III, 21 P.3d at 810–11.
A comic book’s addition of worm-like characteristics to the celebrities caused the product to be sufficiently transformative.40

Most recently, a video game manufacturer was entitled to First Amendment protection (and $608,000 in attorneys’ fees) for a game character that appeared to depict the plaintiff, singer Keirin Kirby.41 In that case, both the video game character and Kirby had similar body types, shaped eyes, and pink hair.42 In addition, Kirby’s famous catch phrase (“ooh la la”) was remarkably similar to the video game character’s name (Ulala).43 However, the game character also had some non-resembling characteristics, including a shorter hairstyle, different dance moves, and clothing accessories not associated with Kirby.44 The court held these non-resembling characteristics to be sufficiently transformative to merit First Amendment protection.45

Based on the holdings in Martin Luther King, Winter, and Kirby,46 Acme’s “Kangaroo Kid” toy may very well gain First Amendment protection in California, but not in Georgia. In California, a court could find any non-Emma resembling characteristic in Acme’s toy to be sufficiently transformative and merit First Amendment protection.47 Thus, for example, if Acme’s depiction of Emma was nearly identical but included kangaroo feet, a court would be hard-pressed to not rule in favor of Acme.48 And, pursuant to California’s right of publicity statute, Emma would also be forced to pay Acme’s attorney’s fees and costs.49

40 Id. at 476. The court noted that, unlike in Comedy III, the half-worm comic book characters were “fanciful, creative characters, not pictures of the [plaintiff celebrities].” Id. at 480. For comparison, in an extremely similar case, the Supreme Court of Missouri held that a comic book character that was based on a hockey player, but included different features, did not qualify for First Amendment protection because the use “had very little literary value compared to its commercial value.” Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003).
41 Kirby, 50 Cal. Rptr. 3d at 613.
42 Id.
43 Id.
44 Id.
45 Id. at 616.
46 See supra notes 35, 37, 40–45 and accompanying text.
47 See supra notes 37, 40–45 and accompanying text.
48 Due to the continued prospect for commercial exploitation, as illustrated by the Emma hypothetical, this author has criticized the California right of publicity fair use test and advocated a modified test that includes an economic or commercial consideration. See Gil Peles, The Right of Publicity Gone Wild, 11 UCLA ENT. L. REV. 301, 323 (2004) (“[I]nstituting an ‘economic’ inquiry within a distinct fair use factor, and balancing it with the ‘transformative’ factor, may add clarity to a right of publicity fair use standard.”); Gil N. Peles, Comedy III Productions v. Saderup, 17 BERKELEY TECH. L.J. 549, 564 (2002) (noting that “a publicity fair use test should separate economic and transformative elements”).
49 CAL. CIV. CODE § 3344(a) (Deering 2010) (“The prevailing party in any action under this section shall also be entitled to attorney’s fees and costs.”).
However, in Georgia, Emma would not encounter a similar risk. The Georgia First Amendment test, revolving around newsworthiness and commercial purpose, would likely favor Emma. Similar to the plastic souvenirs depicting Dr. King, a court would likely hold the toys to be a non-newsworthy commercial exploitation of Emma’s likeness. Thus, due to the nature and application of California’s right of publicity fair use test, Georgia’s laws might present Emma with a greater prospect of a successful case.

VI. CONCLUSION

As demonstrated by Emma’s hypothetical, a right of publicity action requires a careful evaluation of various, often inconstant, jurisdictional laws. Emma, for example, could assert a broad theory of damages in California, but Georgia might provide her with a better chance of overall success. Unfortunately, so long as the right of publicity is exclusively governed by states, rather than federal law, practitioners will continue to be confronted by similar enigmas.

50 See supra notes 31–35 and accompanying text.