

**Texas Intellectual Property Law Journal**  
Spring 2004

Articles

**FEET OF CLAY: HOW THE RIGHT OF PUBLICITY EXCEPTION UNDERMINES COPYRIGHT ACT PREEMPTION**

P. Stephen Fardy<sup>al</sup>

Copyright (c) 2004 State Bar of Texas, Intellectual Property Law Section; P. Stephen Fardy

**Table of Contents**

Introduction	444
I. The Copyright Act of 1976: Unifying a Dual System Through Preemption	445
A. Statutory Preemption under Section 301(a) of the Act	445
B. Conflict Preemption under the Supremacy Clause	448
C. Preemption in Action: Preempting the Right of Publicity	449
II. The Right of Publicity: Conceptual and Geographic Expansion	454
A. The Development of the Right of Publicity	454
B. The Unholy Trinity: the Midler, Waits, and White Decisions	455
1. <i>Midler v. Ford Motor Co.</i>	456
2. <i>Waits v. Frito-Lay, Inc.</i>	457
3. <i>White v. Samsung Electronics America, Inc.</i>	459
C. The Wendt Decision: Unholy Trinity Plus One	463
D. Beyond the Ninth Circuit	466
III. Today's Right of Publicity: The Losers and Where to Go	468
A. Results of the Right of Publicity and Preemption Conflict: The Losers	469
B. Where Do We Go From Here?	470
IV. Conclusion	471

## **\*444 Introduction**

Prior to 1978, a dual state and federal system dating back to 1790 governed copyright law in the United States.<sup>1</sup> In an effort to unify copyright law and to create a system compatible with the rest of the world, Congress passed the Copyright Act of 1976<sup>2</sup> (the “Act”). One of the bedrock principles<sup>3</sup> of the Act is a provision<sup>4</sup> that specifically preempted state-law copyright actions.

On the West Coast, far from the halls of Congress, an unwanted exception to this preemption provision, the right of publicity, gradually developed. Initially a common law cause of action, it subsequently drew the attention of various state legislatures who took heed of the trend and enacted their own right of publicity statutes. The right of publicity has particularly flowered in California, with constant care and affection from the Ninth Circuit (that is, the so-called “Court of the Stars”).<sup>5</sup> Over time, this right has expanded, both in geographic and conceptual scope, with effects felt far beyond California and the Ninth Circuit.

The right of publicity has a role to play in the legal system independent of that of copyright, and in most circumstances, it operates in a way that does not conflict with the Act. However, the rights, protected by both doctrines, in certain areas, overlap one another. In these areas, some courts have held that the right of publicity avoids or trumps the Act’s preemption provision. In doing so, these courts have created an exception to preemption. This exception limits the copyright holders from fully exploiting their copyrights.

The exception has become problematic, as a small number of celebrities have invoked the right of publicity to prevent owners of copyrights from effectively licensing their copyrights. If left unchecked, this trend will lead to a multiplicity of rules in an area of the law intended to be uniform, discourage investment in intellectual property due to uncertain legal risks, and chip away at the public domain. The victims of the trend include copyright owners, the public, and the legislative goals of the Act.

Section I of this article outlines the legislative purpose behind preemption and sets forth cases where the Act has preempted the right of publicity. Section II analyzes **\*445** the development and expansion of the right of publicity and its emerging effect and ensuing tension with copyright law. Finally, Section III examines the injuries resulting from the expansion of the right of publicity and considers possible remedies.

### **I. The Copyright Act of 1976: Unifying a Dual System Through Preemption**

In 1976, Congress passed the Copyright Act, thereby creating a unified federal copyright system. The Copyright<sup>6</sup> and Supremacy<sup>7</sup> Clauses of the United States Constitution provide the authority for exclusive federal regulation of copyrights. Pursuant to the constitutional grant of power and its own language, the Act regulates all copyright law in the United States.

According to the Act, copyright protects an author’s original expression when it is fixed in a tangible medium.<sup>8</sup> Upon fixation, the author owns certain exclusive rights in the expression. After the expiration of a finite copyright term, the work enters the public domain. Thus, the Act seeks to provide a balance between the interests of society and the interests of authors.<sup>9</sup> Full achievement of this intended balance requires uniformity in the application of copyright law. Congress sought to achieve this uniformity through the Act’s preemption of state copyright law. Sections 102, 103, 106, and 301 of the Act provide the framework for statutory preemption.

#### **A. Statutory Preemption under Section 301(a) of the Act**

The enactment of § 301(a)<sup>10</sup> constitutes the most fundamental change to copyright law since its inception in the United States.<sup>11</sup> This provision largely preempts state common law copyright claims, as the Act protects original works of authorship from the moment of creation.<sup>12</sup> Congress created this section for the principal **\*446** purpose of eliminating the dual system of state and federal law and replacing it with a unified federal system.<sup>13</sup> Under § 301(a), there are two necessary conditions for preemption of a state statute or common law cause of action: (1) the work of authorship in question is fixed in a tangible medium of expression and falls within the subject matter of copyright, and (2) the state law in question embodies rights that are equivalent to any of the exclusive rights within the general scope of copyright.<sup>14</sup> In other words, § 301(a) preempts the operation of any state law that addresses the subject matter of copyright and presents rights equivalent to those provided by the Act.<sup>15</sup>

Sections 102<sup>16</sup> and 103<sup>17</sup> of the Act outline the subject matter requirements of copyright. The work in question must be

original, one of the types of works of authorship \*447 enumerated in these sections, and fixed in a tangible medium of expression. If this first prong is satisfied, the work falls within the subject matter of copyright, and § 301(a) will potentially apply. The next step is to examine whether the state law provides equivalent rights.

Deciding whether state rights are equivalent to those provided by the Act requires a review of § 106.<sup>18</sup> Section 301(a) provides that preemption will occur if the state cause of action addresses legal or equitable rights equivalent to those listed in § 106. For example, if a state statute were to allow an author to license the production of derivative works based on his original literary work, but for a longer period than the copyright term authorized in the Act, § 301(a) will preempt the statute. The hypothetical statute would protect works of authorship included in §§ 102 and 103, and the right to prepare derivative works would clearly be equivalent to the same right enumerated in § 106. By contrast, suppose a state statute were to provide trade secret protection against the unauthorized reproduction of works such as databases or recipes. Section 301(a) would not apply because protection of such works is not within the subject matter of copyright as specified by §§ 102 and 103 even though the protection offered by the statute is equivalent to the § 106 right of reproduction.

The Act does not subject state rights that are different from the rights enumerated in § 106 to preemption.<sup>19</sup> A question of statutory interpretation arises when \*448 some of the rights provided by a state law are equivalent to those in the Act, but that state law also contains additional protections. Some commentators refer to these additional rights as “extra elements.”<sup>20</sup> This Article discusses extra elements after first outlining the operation of § 301(a) on state rights of publicity.

## B. Conflict Preemption under the Supremacy Clause

In addition to the express statutory preemption of § 301(a), the Supremacy Clause implicitly contains two mechanisms for preemption of state rights of publicity that are in conflict with the Act.<sup>21</sup> First, under the “exclusion” or “occupation of the field” preemption, a provision of the Constitution or a piece of federal legislation is read to leave no room for state legislation regarding that subject matter.<sup>22</sup> While one might read an intent to occupy the entire field within the sweeping language of the Act or the Copyright Clause, this interpretation is very broad and probably does not fairly apply to the regulation of authors and writings given the history of copyright law in the United States.<sup>23</sup> The express statutory preemption test seems to rule out complete exclusion preemption of a right of publicity.

\*449 Second, under the “conflict preemption” doctrine, a given Congressional act in a particular area implicitly may not coexist with state regulation of that area.<sup>24</sup> Where regulations are in conflict and cannot be reconciled, even in the absence of specific statutory language on the matter, the state regulation yields to federal copyright law pursuant to the Supremacy Clause.<sup>25</sup> It is this theory that applies to the apparent overlap between the right of publicity and the Act. Even where the Act may leave the matter unclear on its face, the Supremacy Clause voids conflicts resulting from state rights of publicity.

As the discussion in the next section suggests, courts should desire to read the Act as expressly preempting the problematic applications of the right of publicity rather than rely on implied conflict preemption. Courts generally accord greater weight to the principle of stare decisis when courts construe statutes as opposed to constitutional provisions.<sup>26</sup> A uniform rule of construction of the Act could emerge through common law interpretation without the risk of courts later reversing an unpopular constitutional decision. This rule would also more fully accord with the apparent intent of the drafters of § 301(a). It is doubtful that the drafters would have included the section if they intended it to have only a half-hearted scope, thereby leaving the courts to apply only conflict preemption in borderline cases. Nevertheless, a discussion of conflict analysis is appropriate because it remains an alternate theoretical basis for preemption.

## C. Preemption in Action: Preempting the Right of Publicity

Several courts have preempted right of publicity claims by applying a § 301(a) analysis. An early landmark case<sup>27</sup> applying § 301(a) preemption to the right of publicity, *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*,<sup>28</sup> involved a dispute over ownership rights of the broadcasts of baseball players’ performances during games.<sup>29</sup> For decades, both the players and team \*450 owners had negotiated over the allocation of revenue stemming from these performances.<sup>30</sup> The players contended that they were entitled to a share of the revenue, that the telecasts of their performances were made without their consent, and that the owners had misappropriated the players’ property rights by broadcasting the games.<sup>31</sup> The owners, disagreeing with this position, filed a declaratory judgment action seeking an order stating that they possessed both the exclusive right to broadcast the games and the exclusive rights to the telecasts.<sup>32</sup> The players filed a separate suit that included

a right of publicity count.<sup>33</sup> The court consolidated the two suits.<sup>34</sup>

The district court found that the disputed telecasts were copyrightable works, and the Seventh Circuit agreed upon appeal.<sup>35</sup> According to the court, the telecasts were works fixed in a tangible medium of expression and constituted original works of authorship coming within the subject matter of copyright pursuant to § 102(a).<sup>36</sup> The players contended that even if the telecasts were copyrightable, the owners still misappropriated their rights of publicity because their game performances were not fixed in a tangible form and, consequently, were outside the subject matter of copyright.<sup>37</sup> However, the Seventh Circuit affirmed the district court's finding that the Act preempted the players' right of publicity, finding that the players' performances were fixed in a tangible form through the recording of the televised broadcast.<sup>38</sup>

The court reasoned that through the medium of a video recording, live performances can be "perceived, reproduced or otherwise communicated for a period \*451 of more than transitory duration."<sup>39</sup> Even though unrecorded performances, such as extemporaneous speech or unfilmed choreography, are not fixed and therefore not copyrightable,<sup>40</sup> recording a broadcast of a performance fixes it for purposes of the Act.<sup>41</sup> The court held that once the players' performances were reduced to a tangible form through recordation on videotapes, there was no distinction between the performances and the recording of the performances for purposes of § 301(a) preemption.<sup>42</sup>

Next, the court applied the equivalency prong of the § 301(a) test.<sup>43</sup> The court reasoned that a right under state law is equivalent to a right within the general scope of copyright if the state right is violated by the exercise of any of the rights enumerated in § 106.<sup>44</sup> The court found the players' right of publicity in their performances, which they claimed allowed them to control the broadcasts, to be equivalent to a copyright holder's right to perform an audiovisual work under the Act.<sup>45</sup> Exercise of the latter right would infringe the players' publicity rights.<sup>46</sup> Consequently, the two-part test in § 301 was satisfied and the court denied the players' right of publicity claim.

The court noted that the Act's purpose is "to induce individuals to undertake the personal sacrifices necessary to create works" and to grant them a limited monopoly to "reap the rewards of their endeavors" in return.<sup>47</sup> The relevant creators here were the producers of the game telecasts, and the players were their employees. The owners hired the players to play baseball, and the court refused to make an artificial distinction between the player's performances and the performances as part of the recorded game.<sup>48</sup> For the court to allow the players to control the copyrighted broadcasts would have turned the policy of the Act upside down; the court essentially asked why the owners would have broadcast the games if the players \*452 controlled the broadcasts.<sup>49</sup> Allowing the players to take control of these performances at the expense of the copyright owner would have limited the scope of the rights granted by the Act and contravened the strong preemptive intent of Congress. The Seventh Circuit thus acknowledged that the state right of publicity granted the players a property interest in their performances, but held that the interest could not trump the control of the telecasts granted to the copyright owners by federal law.<sup>50</sup>

Eleven years later, this question arose again within the Seventh Circuit, this time in connection with performances displayed in video games. In *Ahn v. Midway Manufacturing Co.*,<sup>51</sup> the defendant's videotaped images of the plaintiffs' martial arts performances were incorporated into the successful arcade video games *Mortal Kombat* and *Mortal Kombat II*.<sup>52</sup> The defendant later incorporated the same performances into the home and hand-held versions of the games.<sup>53</sup> The plaintiffs had signed an agreement making the producer of the games the sole owner of "all of plaintiffs' copyrightable expression."<sup>54</sup> Subsequently, plaintiffs filed suit based on an alleged unauthorized use of their names, personae, and likenesses.<sup>55</sup> The district court, relying on *Baltimore Orioles*, held that the two-part § 301(a) test was satisfied and that the Act preempted this right of publicity claim.<sup>56</sup> The court found the plaintiffs' performances fell within the subject matter of copyright because they were original works of choreographic authorship and fixed (by consent) on a videotape.<sup>57</sup> The plaintiffs' rights of publicity were equivalent to the rights specified in the Act because they were infringed by the distribution, performance, or preparation of derivative works, all of which the defendant game producers had done.<sup>58</sup> As with *Baltimore Orioles*, the court found that the right of publicity could not coexist with the federal rights held by the copyright owner.

\*453 Other district court cases within the Seventh Circuit have further developed the *Baltimore Orioles* preemption theory. *Villa v. Brady Publishing*<sup>59</sup> involved an outdoor muralist with a distinctive style. The defendant publisher reproduced one of his murals, which incorporated his pseudonym, in a book without obtaining permission.<sup>60</sup> The muralist sued, alleging that the appropriation of his pseudonym violated his right to publicity.<sup>61</sup> The court assumed that the mural was copyrightable and fixed, and it applied the equivalence prong of § 301(a).<sup>62</sup> In evaluating equivalence under § 106, the court noted:

A proper assessment of equivalence looks beyond the bare elements of the state-law cause of action to the particulars of each case. A claim escapes the preemption bar only if the rights alleged to have been

violated are qualitatively different from those protected by copyright. The labels a plaintiff affixes to a defendant's activities are insignificant if the complaint does not assert rights that fall outside the scope of those listed in § 106.<sup>63</sup> The court asserted a vigorous and fact-sensitive view of § 301(a) preemption that focused on the substance of state law claims rather than on their form, and in doing so it implicitly rejected the notion of extra elements that are not actually separable from copyrightable expression. It held that the inclusion of the artwork in the book implicated § 106 rights and that the incorporation of the pseudonym was incidental.<sup>64</sup> Therefore, the court held that the Act preempted the publicity claim, and thus the muralist's proper remedy lay in copyright law.

In *Toney v. Loreal USA, Inc.*,<sup>65</sup> the district court examined a model's claim that the defendant's use of her likeness beyond the period and extent that she had authorized violated her right of publicity. The defendants and their successors had an agreement with the model to use photographs of her on the packaging of a hair relaxer product in order to promote it.<sup>66</sup> The agreement was limited to a five-year period, and the plaintiff claimed defendants continued to use her likeness after the \*454 five years had expired.<sup>67</sup> Using the same rationale as the Baltimore Orioles, Ahn, and Villa courts, the Toney court held that plaintiff's likeness was fixed in a photograph that came within the subject matter of copyright and that her publicity rights were equivalent to Section 106 rights; thus, the claim could not survive preemption and was dismissed.<sup>68</sup> The state right in Toney's control of the reproduction of her persona may have constituted an "extra element," but any such extra element was inseparable and was not qualitatively different from any of the rights attached to a copyrightable work in which such persona was embedded.

## II. The Right of Publicity: Conceptual and Geographic Expansion

The scope of the right of publicity has expanded both conceptually and geographically, with ensuing harmful effects on the policy of the Act in the areas where the two overlap. The conceptual expansion of the right of publicity involves an increase in the variety of qualities the right protects. Where these areas intersect with copyright law there has been a repeated tendency by courts, especially the Ninth Circuit when applying California law, to allow celebrities to assert right of publicity claims at the expense of copyright owners or licensees. The product rulings have limited the utility of the owners' copyrights and, in effect, have diminished their value. Geographic expansion of the right of publicity has come in tandem as a number of other jurisdictions have cited Ninth Circuit rulings as precedent for allowing right of publicity claims to survive § 301(a) preemption.

### A. The Development of the Right of Publicity

A court first specifically recognized the "right of publicity" in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>69</sup> A number of professional baseball players had granted Haelan the exclusive right to print their images on baseball cards.<sup>70</sup> Subsequently, Topps induced a number of these players to appear on its baseball cards despite the players' agreement with Haelan.<sup>71</sup> Haelan asserted the \*455 rights of publicity the players had assigned to it.<sup>72</sup> The court held that Haelan could stop Topps because the players had contracted with Haelan, and, therefore, Haelan had received the exclusive right to publish the images of the players and not Topps.<sup>73</sup>

The modern right of publicity protects images, likenesses, names, nicknames, voices, slogans, and personae<sup>74</sup> from misappropriation and unauthorized commercial exploitation.<sup>75</sup> It is alienable, and, in some states, inheritable. As discussed in the next section, the right of publicity has expanded from prohibiting the use of someone's name or likeness for advertising purposes to protection against voice imitations, character imitations, and virtually anything else that appears to evoke an individual's personality. As a result, advertisers are reluctant to use anyone in an advertisement who may potentially remind the public of a celebrity.<sup>76</sup>

In California, the right of publicity found fertile soil in which to flourish. Although the doctrine originally applied only to celebrities, California has extended it to include non-celebrities so long as they allege the statutory minimum damage amount of \$750.<sup>77</sup> Furthermore, and problematically, California residents may file suit in California regardless of where the alleged misappropriation of the right of publicity occurs.<sup>78</sup> This provision allows the California state courts, and thus federal courts sitting in diversity and applying California law, to adjudicate matters that have national ramifications.<sup>79</sup>

## B. The Unholy Trinity: the Midler, Waits, and White Decisions

In a trilogy of cases addressing voice and appearance imitations, the Ninth Circuit, applying California law, issued a series of rulings that have had an enormous impact on the Act.

### \*456 1. Midler v. Ford Motor Co.<sup>80</sup>

The first major expansion of the right of publicity occurred in *Midler v. Ford Motor Co.* Bette Midler, a famous singer and actor, sued Ford alleging that Ford misappropriated her voice for use in a television commercial.<sup>81</sup> In 1973, Midler recorded an album containing the song “Do You Want to Dance.”<sup>82</sup> She did not own the copyright to the musical work. In 1985, Ford launched “The Yuppie Campaign,” which featured popular songs of the seventies played during Ford commercials in an attempt to translate reminiscences of halcyon college days into purchases of Ford vehicles.<sup>83</sup> When Ford contacted Midler to get her to do the song for the campaign, she declined.<sup>84</sup> Not to be deterred, Ford’s advertising agency hired an imitator to sing the song.<sup>85</sup> The commercial featured an imitator who sounded “exactly” like Midler in the original recording.<sup>86</sup> In an effort to avoid any problems, the advertising agency secured a license from the copyright owner for the song.<sup>87</sup>

Midler contended that her voice, in and of itself, was not copyrightable because it could not be fixed in a tangible medium of expression and consequently was outside the subject matter of copyright.<sup>88</sup> The court dismissed the statutory right of publicity count because Ford did not use Midler’s actual voice, but the court determined that Ford did violate Midler’s common law right of publicity due to the imitation.<sup>89</sup> The court accepted Midler’s argument that her voice was not copyrightable because it was not fixed, despite the fact that the song had been fixed in a sound recording. To arrive at this conclusion, the court separated the voice from the song. It found that preemption did not apply because the voice itself was not within the subject matter of copyright preemption. “What [the defendants] sought was an attribute of Midler’s identity.”<sup>90</sup> By affiliating voice with persona, the Midler court expanded the right of publicity to include protection for celebrities against voice imitators.

\*457 Numerous problems arise from this ruling. First, the copyright holder owned the song. One right in the bundle of rights held by a copyright owner is the right to license the work.<sup>91</sup> Here, the owner did just that: it granted a presumably non-exclusive license to the advertising agency for Ford. The Midler decision prohibited the licensee, the advertising agency, from fully exploiting the license it had obtained for the song that Midler sang by creating liability for hiring a Midler voice imitator.

Midler argued that a voice itself is not copyrightable because it cannot be fixed. However, what Midler really objected to and sought prohibition of was her voice being used in a fixed medium: the commercial. Both the vocal performance of the imitator and the commercial containing it were copyrightable works within the subject matter prong of § 301(a). Moreover, the action involved in this case was the reproduction of a copyrighted work: the licensed song. For Midler’s suit to succeed, the act of reproducing the song, allowed by § 106, had to violate her right of publicity. Arguably, both prongs of § 301(a) were fulfilled.

Additionally, the fact situation in *Midler* called for conflict preemption. The Act addresses imitation sound recordings and specifically allows them under § 114(b).<sup>92</sup> Pursuant to this section, the Act does not prohibit the duplication of a sound recording composed entirely of an independent fixation of sounds, which was exactly what the advertising agency did. By restricting the rights of copyright holders in sound recordings, Congress signaled its intent that the creation of independently fixed imitations or simulations was permissible and therefore should not be regulated by the states. However, the *Midler* court upheld California’s regulation and prohibited an imitation of a sound recording by finding that a misappropriation had occurred pursuant to the common law right of publicity.<sup>93</sup>

### 2. Waits v. Frito-Lay, Inc.<sup>94</sup>

Frito-Lay retained an advertising agency to promote a new snack product.<sup>95</sup> The agency recommended using Tom Waits, a well-known singer, for the commercial. \*458<sup>96</sup> Waits has a distinctive singing voice, described as “like how you’d sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades . . . . Late at night. After not sleeping for three days.”<sup>97</sup> Waits, however, did not do commercials.<sup>98</sup> Undeterred, Frito-Lay decided to have a voice imitator do a song for their commercial that was stylistically similar to Waits’s song “Step Right Up.”<sup>99</sup> The imitator’s voice was extraordinarily similar to Waits’s.<sup>100</sup> Waits, apparently not amused and in a refutation of the old adage that imitation is the sincerest form of flattery, filed a voice misappropriation claim based upon the right of publicity.<sup>101</sup>

The court held that copyright law did not preempt Waits's voice misappropriation claim because the elements of voice misappropriation were different from those of copyright infringement.<sup>102</sup> Following the rationale of Midler, the court found that a voice *per se* was not copyrightable, allowing it to escape the subject matter of copyright:

The . . . focus was on the elements of voice misappropriation . . . whether the defendants had deliberately imitated Waits' voice rather than simply his style and whether Waits' voice was sufficiently distinctive and widely known to give him a protectable right in its use. These elements are "different in kind" from those in a copyright infringement case challenging the unauthorized use of a song or recording. Waits' voice misappropriation claim, therefore, is not preempted by federal copyright law.<sup>103</sup> Finding that the Waits imitation failed the subject matter prong of § 301(a), the court did not address the question of equivalent rights.

In Waits the court did not address the conflict preemption issue raised by § 114(b) of the Act. When the court purported to address § 114, it apparently confused that section with § 301,<sup>104</sup> and in doing so it then proceeded to discuss the \*459 wrong portion of legislative history.<sup>105</sup> Because of this confusion, the court never addressed the allowance for sound recording imitations and simulations in § 114(b). Congress's intention, as expressed in that section, was to allow independently fixed imitations and simulations to remain in the public domain. Though the song in the radio commercial did not exactly imitate a real song, as the imitation in Midler had, it did "simulate" the original Waits song. Thus, conflict preemption also should have served as a basis for preemption in this instance.

To allow states to regulate an area designated for the public domain by Congress, as the Ninth Circuit did with the imitation recordings in Midler and Waits, specifically contradicts the intent of Congress and challenges the Supremacy Clause of the Constitution.

### 3. White v. Samsung Electronics America, Inc.<sup>106</sup>

The court further expanded the right of publicity in White v. Samsung Electronics America, Inc. to protect images and likenesses of identifiable characters. Samsung ran a series of futuristic advertisements for their products containing parodies of various elements of pop culture found in the 1980s.<sup>107</sup> One commercial portrayed a robot in a gown, with jewelry and a blonde wig turning a game wheel.<sup>108</sup> Underneath the robot ran a slogan that read "Longest-running game show 2012 A.D."<sup>109</sup> The image and the wheel resembled Vanna White and the Wheel of \*460 Fortune game show set.<sup>110</sup> White did not consent to the production of the commercial, nor was she compensated.<sup>111</sup>

White sued Samsung under the California common law right of publicity.<sup>112</sup> The District Court granted summary judgment against her.<sup>113</sup> The Ninth Circuit reversed.<sup>114</sup> The Ninth Circuit conceded that defendants did not use White's name or likeness,<sup>115</sup> but, in finding for White, the court stretched the right of publicity by arguing that White's very identity had been misappropriated.<sup>116</sup> The court cited a series of older right of publicity cases that allegedly supported this ruling.<sup>117</sup> However, the court did not address the issue of preemption and, in fact, did not mention the Act.

This case's holding created a troubling result for copyright owners like the owners of the Wheel of Fortune game show. The ruling implies that a character, sufficiently delineated in personality or physical traits, may be copyrightable. The copyright owner of the Wheel of Fortune game show created the physically identifiable character of "Vanna White" as embodied by her outfit, jewelry, and makeup. Thus, White represents an integral part of the copyrightable subject matter of not only Wheel of Fortune but also a copyrightable character in her own right - one owned by the copyright holder for the show. Consequently, the Vanna White robot, properly viewed, is a derivative work, the production of which is a privilege enjoyed solely by the copyright holder.<sup>118</sup> If anyone were entitled to an infringement suit, it would be the copyright holder rather than White.<sup>119</sup>

Assuming Samsung did not obtain a license, the copyright owner may have decided not to file suit because the White robot appeared to be a parody. After all, other parties had raised the parody defense in other copyright infringement cases,<sup>120</sup> and arguably could have applied in this instance. In any event, the issue of whether \*461 the robot did or did not constitute a parody may be an academic question, but it does indicate that the copyright holder may have opted not to file suit out of the belief that the Act allows for parodies and that those provisions would be a competent defense to the infringing commercial.

Judge Kozinski, in a later proceeding in this matter, strongly criticized the majority position.<sup>121</sup> After pointing out that the panel had misinterpreted the California law of publicity in allowing White to claim that the robot, which did not contain her

name or likeness, had misappropriated her identity, Kozinski stated that “[b]y refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act.”<sup>122</sup> He noted that the Act allowed for parodies because they are in the public interest.<sup>123</sup> If the White robot had borrowed too much from the original, the copyright owner could have licensed out this creation as a derivative work.<sup>124</sup>

The White ruling inhibits the ability of advertisers to present parodies of celebrities to the public and limits a copyright owner’s right to license derivative works if they portray a celebrity.<sup>125</sup> The only winner in this discrepancy is the celebrity. The majority in White created a remarkable and dangerous property right for celebrities - a right that devastates the balancing scheme underlying the Act.<sup>126</sup> Judge Kozinski stated that “[i]n a case where the copyright owner isn’t even a party - where no one has the interests of copyright owners at heart - the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit.”<sup>127</sup>

Interestingly, a division of the Court of Appeal of California, in contrast to the Ninth Circuit opinions, upheld the rights of copyright holders and their licensees by holding a state right of publicity claim preempted. In Fleet, Performance Guarantees, a production company, did not pay a group of actors who appeared in a film was not paid for their work.<sup>128</sup> In response, the actors filed suit alleging that CBS, the licensee granted exclusive distribution rights in the film, could not use the actors’ \*462 names, voices, photographs, likenesses, or performances in the film.<sup>129</sup> No one disputed that the film was copyrightable, that CBS had received an exclusive distribution license, or that the actors did not own the copyright.

In its ruling, the court analyzed the issue of “whether the rights appellants claim . . . can coexist with the federal copyright statute.”<sup>130</sup> The court found that once the actors’ individual performances were put on film, they became “dramatic work[s] fixed in [a] tangible medium” and consequently came within the subject matter of copyright law.<sup>131</sup> The court also held that the rights sought by the actors were equivalent to those exclusive rights contained in the Act: “a claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted.”<sup>132</sup> The court’s message was clear: a party who does not own the copyright in a film cannot prevent the copyright holder from exploiting that right through a state law right of publicity allegation.<sup>133</sup> Actors who wish to protect the use of their images and likenesses contained in fixed dramatic performances should obtain ownership in the copyrights.<sup>134</sup> Given the preceding series of opinions where the Ninth Circuit, applying California law, allowed the right of publicity to coexist with copyright, the Fleet case is a surprising and positive statement of the proper function of the preemption doctrine. Unfortunately, subsequent courts have made flimsy attempts to distinguish Fleet from similar cases.<sup>135</sup>

#### **\*463 C. The Wendt Decision: Unholy Trinity Plus One**

In Wendt v. Host International, Inc.,<sup>136</sup> well-known Cheers actors George Wendt and John Ratzenberger sued Host International alleging a violation of their rights of publicity.<sup>137</sup> Paramount, which held the copyright for Cheers, intervened in the case.<sup>138</sup> Wendt and Ratzenberger played two of the most famous characters on Cheers: Norm and Cliff, respectively. The show was extremely popular in the 1980s and early 1990s. Given this popularity, defendant, Host decided to create a line of Cheers airport bars.<sup>139</sup> Host properly secured a license from Paramount for the Cheers concept. The defendants placed two robots at the bars that did not physically resemble Wendt and Ratzenberger; however, one was dressed in a postal uniform while the other was overweight.<sup>140</sup> The animatronic robots were named “Bob” and “Hank.”<sup>141</sup>

The district court granted summary judgment for the defendant. The Ninth Circuit reversed.<sup>142</sup> The Ninth Circuit’s opinion states that “at the outset, we wish to make it clear that this is not a preemption case” .<sup>143</sup> In a short and woefully inadequate opinion, the court held plaintiffs’ cause of action was not preempted.<sup>144</sup> Specifically, the court ruled, as it did in Waits, that the claims contained extra elements (the commercial use of the plaintiffs’ identities) that differed from a copyright infringement cause of action.<sup>145</sup> After the district court again granted summary judgment for Host, the Ninth Circuit, in their second opinion, reiterated that the Act did not preempt plaintiffs’ claims.<sup>146</sup>

In denying preemption, the court rejected Host’s use of Fleet v. CBS as controlling California authority, reasoning that Fleet only applies to the distribution of copyrighted films.<sup>147</sup> This attempt to distinguish Fleet is unconvincing. Here, Host \*464 sought to display licensed copyrighted characters; there, the film licensee sought to display copyrighted performances. A federal court’s disregard of an essential California precedent may conflict with the Erie doctrine.<sup>148</sup> It also presents the curious phenomenon of a federal appeals court giving more weight to state law than the state’s own courts. Additionally, it may permit celebrities in California wishing to prevent licensed advertisers or parodists from placing reminders of the celebrities in the public eye to forum shop by alleging both a federal statutory claim to obtain federal question jurisdiction (if they

cannot allege diversity) and a pendent state claim under California law.<sup>149</sup> These celebrities would then expect the federal courts to afford the right of publicity claim more favorable treatment than California state courts would.

In White, Judge Kozinski specifically stated that the broad application of the right of publicity puts state law on a collision course with the federal rights of the copyright holder.<sup>150</sup> In Wendt II, this apocalyptic vision happened. Kozinski began his scathing dissent with the phrase “Robots Again.”<sup>151</sup> He stated that “[t]he panel holds that licensed animatronic figures based on the copyrighted Cheers characters Norm and Cliff infringe on the rights of the actors who portrayed them. As I predicted, White’s voracious logic swallows up rights conferred by Congress under the Copyright Act.”<sup>152</sup> The Wendt series of cases served to confirm that the right of publicity was spreading rapidly out of control like kudzu at the expense of the Act.<sup>153</sup> Judge Kozinski proceeded to provide a colorful portrayal of a “bizarro” world, where a copyrighted television show did not have any rights in its characters resulting in Seinfeld spin-off where “a skinny Newman sits down to coffee with a svelte George, a stocky Kramer, a fat Jerry, and a lanky blonde Elaine.”<sup>154</sup>

The Wendt decisions go a step beyond even White because in the Wendt cases the defendant had secured a license from the copyright holder in order to utilize the Cheers concept. Without question, the parties were fighting over the same bundle \*465 of intellectual property rights.<sup>155</sup> The owner of the copyright license was pitted against the actors who were in the copyrighted Cheers show:

So who wins? The Copyright Act makes it simple, at least insofar as the plaintiffs interfere with Paramount’s right to exploit the Cheers characters. Section 301 of the Copyright Act preempts any state law “legal or equitable rights that are equivalent to any of the exclusive rights that are in the general scope of copyright.” The copyright to Cheers carries with it the right to make derivative works based on its characters. The presentation of the robots in the Cheers bars is a derivative work, just like a TV clip, promotion, photograph, poster, sequel or dramatic rendering of an episode. Thus, under federal law, Host has the unconditional rights to present robots that resemble Norm and Cliff.<sup>156</sup>

Instead, the ruling in Wendt II requires anyone who wants to use a figure, statue, robot, drawing, or poster that reminds the public of a famous character to obtain consent and pay for consent.<sup>157</sup> This directly contradicts the rights of the copyright owner. Studios should be able to freely reproduce the characteristics of the characters that they created and for which they obtained a copyright.<sup>158</sup> Furthermore, this ruling contradicts the Baltimore Orioles decision, which specifically held that the owners of the telecasts have the copyrights to the employees’ performances and that any right to publicity claims are preempted.<sup>159</sup>

Interestingly, although Judge Kozinski couched his dissent in terms of a § 301(a) preemption analysis, he spent very little time analyzing the two conditions necessary for preemption. Instead, the dissent focused on the inherent tension between copyright law and the right of publicity. Host properly obtained a license to the Cheers concept. Did Host really have to pay for the individual actors’ consent? The Ninth Circuit seemed to think so. This trumping of federal law by the right of publicity creates an implicit conflict. Thus, while mentioning § 301(a), Judge Kozinski was in reality discussing conflict preemption. Here the state law undoubtedly was in conflict with the rights granted by the Act; thus, the stronger argument for preemption in Wendt II may have actually been preemption pursuant to the Supremacy Clause.

Additionally, Wendt II has national ramifications because it conflicts with the “dormant copyright clause.”<sup>160</sup> Arguably, California’s right of publicity law is invalid as it substantially interferes with federal copyright law because it will “prejudice \*466 the interests of other states.”<sup>161</sup> The California law stops Host from using its license anywhere in the United States, even in states that have an interest in not recognizing the right of publicity.

#### **D. Beyond the Ninth Circuit**

In a disturbing trend, the right of publicity, as interpreted by the Ninth Circuit, is increasingly being applied on a national basis in areas where it overlaps with copyright. Specifically, Midler, Waits, White, and Wendt II are being cited as precedent throughout the country. In *Landham v. Lewis Galoob Toys, Inc.*,<sup>162</sup> the Sixth Circuit found no preemption by the Act. Landham involved marketing and licensing toys based on characters in the movie Predator.<sup>163</sup> Sonny Landham, an actor from the movie, filed a right of publicity suit under Kentucky law because he never consented to having his character merchandised by defendant.<sup>164</sup> Defendant moved for preemption of the right of publicity claim.<sup>165</sup> The Sixth Circuit reversed the district court’s summary judgment and found that the Act did not preempt plaintiff’s claim.<sup>166</sup> The court based its ruling, in part, on both Wendt II and Midler, stating that plaintiff’s right of publicity claim asserted elements separate from those

protected by the Act.<sup>167</sup>

In *Brown v. Ames*,<sup>168</sup> the Fifth Circuit refused preemption.<sup>169</sup> The defendants had allegedly misappropriated the names and likenesses of the plaintiffs to market the plaintiffs' musical performances.<sup>170</sup> Plaintiffs alleged a violation of their rights of publicity. The facts indicated that one of the defendants had fraudulently conveyed a license to use the names and likenesses of the plaintiffs (as contained in packaging and promotional materials for musical recordings) to the other defendant.<sup>171</sup> Having found the Ninth Circuit's opinions in *Midler* and *Waits* (both holding that a vocal style was not fixed and therefore not copyrightable) to be persuasive, \*467 the Fifth Circuit held that names and likenesses are like vocal styles, and thus, a claim for misappropriation of them is not within the subject matter of copyright.<sup>172</sup> Additionally, the court found that conflict preemption was not applicable because the plaintiffs' state law claims did not conflict with the Act.<sup>173</sup>

Both of these propositions are debatable. The names and likenesses of the plaintiffs became fixed once they were placed on the compact disc cover. Further, they were also works of authorship since they constituted a pictorial work whether the likenesses were drawn or photographed. Additionally, even assuming that the license obtained from the copyright holder to use the names and likenesses was invalid, the issue of the propriety of use of a copyright license arises under federal law. Thus, the court should have held that the state misappropriation claim was preempted. Again, as in *Wendt II*, conflict preemption may be the stronger basis for preemption.

In *Prima v. Darden Restaurants, Inc.*,<sup>174</sup> the defendant hired a vocalist who did a voice imitation of the singer Louis Prima for an Olive Garden restaurant commercial.<sup>175</sup> Prima's widow filed the lawsuit alleging amongst other things violations of his right of publicity.<sup>176</sup> While New Jersey courts have not expressly decided whether the right of publicity protects a singer's voice from unauthorized commercial exploitation, they acknowledged that the trend among other courts that the imitation of another's voice can give rise to a cause of action for infringing the right of publicity.<sup>177</sup> The court was persuaded that the *Waits* and *Midler* decisions would cause the New Jersey courts to adopt the rules followed in those cases.<sup>178</sup> Relying heavily on the aforementioned cases the court stated "while the issue has not been addressed by the Third Circuit, this Court is persuaded by the reasoning that the Copyright Act does not preempt a common law right of publicity for unauthorized use of another's voice."<sup>179</sup>

In *KNB Enterprises v. Matthews*,<sup>180</sup> the California appellate court created a new twist by allowing a copyright owner to file a right of publicity claim rather \*468 than a copyright infringement claim.<sup>181</sup> The defendant used pictures owned by the plaintiff on its website.<sup>182</sup> The plaintiff clearly could have filed a copyright action based upon his copyrightable photographs. Instead, plaintiff opted to file a right of publicity suit, possibly because of greater potential for damages, the lesser likelihood of defenses such as fair use being raised, or even possibly because the state court jurisdiction may have been more favorable than federal court. Whatever the reason, plaintiff preferred the right of publicity claim to the copyright claim, and the court denied preemption.<sup>183</sup> The court ruled that the copyrighted photographs contained likenesses of models that were not copyrightable.<sup>184</sup> These likenesses, though depicted in photographs, were outside the subject matter of copyright and could not be preempted.<sup>185</sup> Since the models did not consent to defendant displaying their photographs, the plaintiff, through an assignment from the models, could assert their right of publicity claims on their behalf.<sup>186</sup>

The facts clearly indicate copyright infringement. Despite the plaintiff's attempt to hide the infringement case in a right of publicity cloak, it was, nevertheless, a copyright infringement case. The plaintiff was the copyright holder in the photos, which indisputably fall within the subject matter of copyright. The plaintiff sought to prevent their reproduction and distribution by the defendant, which were exclusive rights under § 106. Characterizing the issue as a right of publicity issue should not have allowed the plaintiff to avoid § 301 or conflict preemption, given the conflict between the text and the goals of the Act and state law.

### **III. Today's Right of Publicity: The Losers and Where to Go**

Expansion of the right of publicity fails to balance societal rights with celebrities' rights. Instead, it seeks to protect the selected rights of a single individual, usually a celebrity, at the expense of the public domain. This expansion, led by the Ninth Circuit, has had deleterious effects on copyright owners, on the public, and on the Act's policy of uniformity.

#### **\*469 A. Results of the Right of Publicity and Preemption Conflict: The Losers**

Copyright owners have watched the value of their copyrights lessen because of recent right of publicity rulings. Specifically, the effect of the rulings has reduced the value of copyright licenses in areas where celebrities are involved. Courts may soon apply the logic limiting the rights of licensees to the copyright owners themselves, thereby restricting the exploitation of their copyrights. The Act provides a balance between the interests of the public and those of the copyright owner: it seeks to allow the public eventual access to copyrighted works in exchange for protecting the work for a limited time from unauthorized exploitation as well as providing an incentive to the copyright owners. However, the right of publicity does not provide this balance between the public and the creator. Instead, the right of publicity simply protects and enhances the interests of celebrities when they come into conflict with the Act.

One of the rights the Act creates is the ability to license copyrighted materials. This can serve as a source of considerable revenue for the copyright owner. If licensees, such as Host International in the Wendt cases, seek to use copyrighted materials, they now need additional consent from any celebrity involved. Otherwise, celebrities could threaten the licensees with a right of publicity suit. Licensees will be much less likely to obtain a license if they are aware of the possibility that a right of publicity suit can occur despite the license. As a result, copyright owners will have more difficulty licensing their copyrights and will receive less revenue in doing so.

Furthermore, with the expansion of publicity rights, the copyright owners' ability to enforce their copyrights is diminished. Copyright owners will increasingly find themselves in a position where a right of publicity case is taking place involving their copyright. If a celebrity files a right of publicity suit and a potential copyright action exists, as in White, it raises questions about what the copyright holder should do. Potentially, the copyright owner may feel compelled to file suit prematurely if concerns about the financial viability of the defendant exist and if the copyright owner anticipates the filing of a right of publicity suit. In addition, similar lawsuits with similar discovery could be pending in both state and in federal courts, thereby creating logistical nightmares.

Additionally, the conflicting state and federal statutes burden interstate commerce. In California, the jurisdiction for a right of publicity suit is predicated upon the domicile of the plaintiff. This creates strain on interstate commerce because a California state court can render judgment on behalf of its citizens for activity occurring anywhere in the United States.

Finally, the right of publicity can restrict the ability to parody, which in certain circumstances is allowable pursuant to the Act. Society's ability to parody, especially its ability to parody celebrities, could be limited in areas where a right of \*470 publicity suit is not preempted, harming the public as a whole. First Amendment problems will also arise with increasing frequency.

## **B. Where Do We Go From Here?**

California's right of publicity doctrine does have a time and a place. In *Eastwood v. Superior Court*,<sup>187</sup> for instance, the National Enquirer allegedly used Clint Eastwood's name and photograph on its newspaper cover without his consent.<sup>188</sup> Looking beyond the issue of the photograph, the usage of his name, without his consent, creates a proper right of publicity claim. This case is also similar to *Abdul-Jabbar v. General Motors, Corp.*,<sup>189</sup> where the defendants allegedly used the name Lew Alcindor in a television commercial without the plaintiff's consent. These cases show the proper place for a right of publicity cause of action.

The right of publicity should allow both the celebrity and the non-celebrity the ability to protect their image and likeness. However, once that person has expressed that image or likeness in copyrightable terms, the copyright owner (who may or may not be the same person) owns it. It is up to copyright owners to enforce their copyrights and to determine whether their copyrighted materials have been infringed. Celebrities and the copyright owners should negotiate in contract if there are concerns about licenses or about being associated with various companies. Courts should apply the right of publicity in the areas that do not fall within the Act, but to allow it to conflict with the rights of copyright owners undermines their rights and the policy of the Act. The recent growth of the right of publicity has developed somewhat like a "haystack in a hurricane."<sup>190</sup> Unquestionably, the Ninth Circuit has judicially carved out a right of publicity exception to preemption. The situation as it stands and the current trends discussed previously undermine the Act in the areas where tension exists between copyright law and the right of publicity.

Regaining a more balanced approach will require either judicial or legislative intervention. From a judicial standpoint, either conflict preemption or a more vigorous application of § 301 preemption could properly curtail the right of publicity's growth.

On the legislative side, Congress could amend the Act to address some of the issues that have arisen with the recent Ninth Circuit rulings to make its intent on the matter clear. Another legislative possibility--perhaps the best option for restoring uniformity and clarity to this area of the law--is a new federal statute defining \*471 the permissible scope of the right of publicity (and preempting similar state rights) and, thereby, harmonizing the two doctrines.

#### IV. Conclusion

The Ninth Circuit has expanded the right of publicity. Through this expansion, the right has come into direct conflict with and has repeatedly trumped the Act. As a result, in the areas where tension between the Act and copyright exist, the Act has been undermined, copyright owners have seen their copyrights diminish in strength and value, and the public domain has been harmed. The Supreme Court or Congress must examine the consequences of continuing to travel this route.

#### Footnotes

<sup>a1</sup> Partner, Swanson, Martin & Bell of Chicago, Illinois. The author obtained his B.A., with honors, and his J.D. from Indiana University in 1991 and 1994, respectively. The author obtained his LL.M., with honors, in Intellectual Property from John Marshall Law School--Center for Intellectual Property in 2001. The author gratefully acknowledges the assistance of summer associate David Lundein with research and drafting.

<sup>1</sup> H.R. Rep. No. 94-1476, at 129-33 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5745-49.

<sup>2</sup> 17 U.S.C. §§ 101-702 (2000 & Supp. 2004). The Act originally took effect on January 1, 1978.

<sup>3</sup> H.R. Rep. No. 94-1476, at 129-33.

<sup>4</sup> 17 U.S.C. § 301(a) (2000).

<sup>5</sup> Felix H. Kent, Reviewing 1997: Tobacco Settlement, N.Y.L.J., Dec.19, 1997, at 3.

<sup>6</sup> "The Congress shall have power to . . . promote the progress of science and the useful arts, by securing for limited times to authors . . . the exclusive right to their . . . writings . . ." U.S. Const. art. I, § 8, cl. 1, 8.

<sup>7</sup> "This Constitution, and the laws of the United States which shall be made in Pursuance thereof . . . shall be the Supreme Law of the land . . ." U.S. Const. art. VI, cl. 2.

<sup>8</sup> 17 U.S.C. § 102(a) (2000).

<sup>9</sup> See Aaron A. Bartz, . . . And Where it Stops, Nobody Knows: California's Expansive Publicity Rights Threaten the Federal Copyright System, 27 Sw. U. L. Rev. 299, 305 (1997).

<sup>10</sup> 17 U.S.C. § 301(a).

<sup>11</sup> David E. Shipley, Publicity Never Dies; It just Fades Away: the Right of Publicity and Federal Preemption, 66 Cornell L. Rev. 673, 701 (1981).

<sup>12</sup> That is, creation by fixation in a tangible medium of expression. "[S]tate common law copyright might play a role when a work is

not fixed in a tangible medium of expression. Examples would include an oral interview or jazz improvisation.” Marshall A. Leaffer, *Understanding Copyright Law* 39 (3d. ed. 1999).

<sup>13</sup> See Scott L. Whiteleather, *Rebels With a Cause: Artists’ Struggles to Escape a Place Where Everyone Owns Your Name*, 21 Loy. L.A. Ent. L. Rev. 253, 268 (2001).

<sup>14</sup> 17 U.S.C. § 301(a) provides:

Preemption with respect to other laws: (a) On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by Sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

<sup>15</sup> The two level test of § 301(a) might be viewed as presenting ‘two doors’: (1) nonequivalency to copyright and (2) subject matter different from that of copyright. If a given state right can pass through either of these doors, it will survive federal preemption. If it can pass through neither of the doors, it will be federally preempted by copyright law.

J. Thomas McCarthy, *The Rights of Publicity and Privacy* § 11:46 (2d ed., updated 2003).

<sup>16</sup> 17 U.S.C. § 102 provides:

Subject matter of copyright: In general: (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic and sculptural works; (6) motion picture and other audiovisual works; (7) sound recordings; and (8) architectural works.

(2000).

<sup>17</sup> 17 U.S.C. § 103 provides:

Subject matter of copyright: Compilations and derivative works: (a) The subject matter of copyright as specified by Section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(2000).

<sup>18</sup> 17 U.S.C. § 106 provides:

Exclusive rights and copyrighted works: Subject to Section 107 through 120 [sic], the owner of a 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 works based upon the copyrighted work; (3) to distribute copies or 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 audiovisual works, to perform the copyrighted work publicly; (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; and (6) in the case of sound recordings to perform the copyrighted work publicly by means of a digital audio transmission.

(2000 & Supp. 2004).

<sup>19</sup> 17 U.S.C. § 301(b) provides, in pertinent part:

Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to--(1) subject matter that does not come within the subject matter of copyright as specified by Sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or . . . (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106 . . . .

(2000).

<sup>20</sup> See 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 1.01 [B][1] (rev. ed. 1986, updated 2003).

[I]f under state law the act of reproduction, performance, distribution, or display, no matter whether the law includes all such acts or only some, will in itself infringe the state-created right, then such right is pre-empted. But if qualitatively other elements are

required, instead of, or in addition to, 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 pre-emption. Thus, the “extra element” test generally furnishes the touchstone here.

*Id.* (internal citations omitted) (emphasis in original).

<sup>21</sup> See, e.g., *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 540-545 (2001) (discussing express preemption and the two types of implied preemption).

<sup>22</sup> See, e.g., *Fidelity Fed. Sav. & Loan Ass’n v. De la Cuesta*, 458 U.S. 141, 153 (1982).

<sup>23</sup> See, e.g., *Goldstein v. California*, 412 U.S. 546 (1973) (construing a state anti-recording piracy statute and holding that Congress has not extinguished all State power to regulate authors and their writings). Though *Goldstein* was decided before the Act took effect, there is no reason to doubt that Congress saw some room for concurrent state regulation, even while it greatly narrowed state power with § 301(a) of the Act.

<sup>24</sup> See, e.g., *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 869-74 (2000).

<sup>25</sup> *Edgar v. MITE Corp.*, 457 U.S. 624, 631 (1982) (“[A] state statute is void to the extent that it actually conflicts with a valid federal statute . . .”).

<sup>26</sup> *Guo XI v. INS*, 298 F.3d 832, 839 (9th Cir. 2002) (citing *Patterson v. McLean Credit Union*, 491 U.S. 164, 173-74 (1989)) (“Considerations of stare decisis have special force in the area of statutory interpretation, for [] unlike in the context of interpretation . . . Congress remains free to alter what we have done.”); see also Edward H. Levi, *An Introduction to Legal Reasoning*, 15 U. Chi. L. Rev. 501, 540 (1948) (“More than any other doctrine in the field of precedent, [stare decisis] has served to limit the freedom of the court. It marks an essential difference between statutory interpretation on the one hand and case law and constitutional interpretation on the other.”).

<sup>27</sup> See *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911 (Cal. Ct. App. 1996).

<sup>28</sup> 805 F.2d 663 (7th Cir. 1986).

<sup>29</sup> *Id.* at 665.

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

<sup>31</sup> *Id.* at 665-66. The only “property rights” the players specifically asserted were their rights of publicity. *Id.* at 667 n.2. The players’ claim that the telecasts were made without consent was later held not to be a genuine issue of material fact, with the court finding that the telecasts were made within the scope of the players’ employment by the team owners, and that the players were well aware that the television revenues were factors accounted for in the players’ salaries. *Id.* at 670.

<sup>32</sup> *Id.* at 665. The owners alleged that they, as the employers, owned the performances as copyrightable works made for hire by the employee players. *Id.* at 667.

<sup>33</sup> *Id.* at 665.

<sup>34</sup> *Baltimore Orioles*, 805 F.2d at 665.

- 35        Id. at 668.
- 36        Id. Professor Nimmer, in critiquing Baltimore Orioles, argues that game performances are not protectable works of authorship. 1 Nimmer & Nimmer, *supra* note 20, at § 2.09[F]. *Contra* Baltimore Orioles, 805 F.2d at 669 n.7 (the telecasts of the games, including the creative contributions of producers, directors, and camerapersons, as well as the players' performances, were the works of authorship for copyright purposes).
- 37        Baltimore Orioles, 805 F.2d at 674-75.
- 38        Id. at 675.
- 39        Id. (discussing 17 U.S.C. § 101 (2000), the Act's fixation provision).
- 40        Id. at 675.
- 41        Id. at 674-76.
- 42        Id. at 675.
- 43        Baltimore Orioles, 805 F.2d at 676.
- 44        Id.
- 45        Id. at 677.
- 46        Id.
- 47        Id. at 678.
- 48        Id.
- 49        As the court noted, "the Players have attempted to obtain *ex post* what they did not negotiate *ex ante* . . . they seek a judicial declaration that they possess a right--the right to control the telecasts of major league baseball games--that they could not procure in bargaining with the Clubs." Baltimore Orioles, 805 F.2d at 679.
- 50        Id. at 674.
- 51        965 F. Supp. 1134 (N.D. Ill. 1997).
- 52        Id. at 1136.
- 53        Id.

54        Id.

55        Id.

56        Id. at 1137-38.

57        Ahn, 965 F. Supp. at 1138.

58        Id.

59        63 U.S.P.Q.2d (BNA) 1603 (N.D. Ill. 2002).

60        Id. at 1604.

61        Id. The artist had also previously claimed federal copyright infringement, but the court dismissed this claim, as he had not registered with the Copyright Office; the court then dismissed all of the artist's pendent state claims for want of jurisdiction. The procedural posture in the stage of the case discussed here was a motion for leave to amend the plaintiff's complaint to allege diversity jurisdiction over his state law publicity claim.

62        Id. at 1605.

63        Id. (citations omitted).

64        Id. at 1606.

65        64 U.S.P.Q.2d (BNA) 1857 (N.D. Ill. 2002).

66        Id. at 1858-59.

67        Id.

68        Id. at 1859-60; see also, e.g., *Glovaroma v. Maljack Prods., Inc.*, No. 96 C 3985, 1998 U.S. Dist. LEXIS 2399, at \*15-18 (N.D. Ill. Feb. 25, 1998) (preempting Frank Zappa's right of publicity claims in his name, voice, photograph, and likeness, as asserted by his wife and successor-in-interest Gail Zappa, where the works at issue were videotaped performances recorded with Zappa's consent). For criticism of Toney see Ryan S. Hilbert & Maki Kanayama, Case Note: *Toney v. Loreal USA Inc.: The Answer to the Question "What Do Hair Relaxer Products Have to Do With the Seventh Circuit's View on Copyright Preemption and the Right of Publicity?"*, 19 Santa Clara Computer & High Tech. L.J. 531 (2003) (arguing for a distinction between the photograph of Toney, which the author concedes is a copyrightable writing, and Toney's persona as captured in the photograph).

69        202 F.2d 866 (2d Cir. 1953).

70        Id. at 867.

71       Id.

72       Id.

73       Id.

74       A concept that sometimes embraces the other items in the list.

75       See McCarthy, *supra* note 15, at §§ 1:3, 4:1-86.

76       See generally Kent, *supra* note 5.

77       Cal. Civ. Code § 3344 (West 1997).

78       Id.

79       Bartz, *supra* note 9, at 321-22.

80       Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir.1988), cert. denied, 503 U.S. 941 (1992).

81       Id. at 461.

82       Id.

83       Id.

84       Id.

85       Id.

86       Midler, 849 F.2d at 461.

87       Id. at 462.

88       Id.

89       Id. at 464.

90       Id. at 463.

91       See 17 U.S.C. § 201(d) (2000).

92       17 U.S.C. § 114(b) provides in pertinent part:

The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of Section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. (2000).

93       Bartz, *supra* note 9, at 318-319.

94       Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).

95       Id. at 1097.

96       Id.

97       Id. (quoting description by an unknown fan).

98       Id.

99       Id.

100       Waits, 978 F.2d at 1097.

101       Id. at 1098.

102       Id. at 1100.

103       Id.

104       The court stated the following:

The defendants ask that we rethink Midler . . . arguing as the defendants did there that voice misappropriation is preempted by Section 114 of the Copyright Act. Under this provision, a state cause of action escapes Copyright Act preemption if its subject matter “does not come within the subject matter of copyright . . . including works or authorship not fixed in any tangible medium of expression.” 17 U.S.C. § 301(b)(1).

Id.

105       The court stated the following:

Moreover, the legislative history of Section 114 indicates the express intent of Congress that “the evolving common law rights of ‘privacy,’ ‘publicity,’ and trade secrets . . . remain unaffected [by the preemption provision] . . . as long as the causes of action contain elements, such as an invasion of personal rights, that are different in kind from copyright infringement.”

Id. (citing H.R. Rep. No. 94-1476, at 132 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5748) (internal quotation marks and brackets by the court). In fact, this section of the House Report discusses section 301, not section 114, of the Act.

<sup>106</sup> White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992).

<sup>107</sup> Id. at 1396.

<sup>108</sup> Id.

<sup>109</sup> Id.

<sup>110</sup> Id.

<sup>111</sup> Id.

<sup>112</sup> White, 971 F.2d at 1396.

<sup>113</sup> Id.

<sup>114</sup> Id.

<sup>115</sup> Id. at 1397.

<sup>116</sup> Id.

<sup>117</sup> Id. at 1398.

<sup>118</sup> 17 U.S.C. 106(b).

<sup>119</sup> Bartz, *supra* note 9, at 312.

<sup>120</sup> See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

<sup>121</sup> See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting) (dissenting from the order rejecting the suggestion for rehearing en banc).

<sup>122</sup> Id. at 1517.

<sup>123</sup> Id.

<sup>124</sup> Id. at 1517-18.

<sup>125</sup> Id. at 1518.

<sup>126</sup> Id.

<sup>127</sup> White, 989 F.2d at 1518.

<sup>128</sup> Fleet, 50 Cal. App. 4th at 1914.

<sup>129</sup> Id. at 1915. Plaintiffs' right of publicity allegation was brought forth under California's right of publicity statute. See Cal. Civ. Code § 3344 (West 1997).

<sup>130</sup> Fleet, 50 Cal. App. 4th at 1917.

<sup>131</sup> Id. at 1919 (citation omitted, alterations by the court).

<sup>132</sup> Id. at 1924.

<sup>133</sup> Id. at 1923.

<sup>134</sup> Id. at 1921.

<sup>135</sup> Fleet was distinguished in a recent Ninth Circuit case involving photographs (with accompanying names) of surfers, purchased from the photographer and used to promote clothing in a catalog; the surfers sued for unauthorized appropriation of their names and likenesses in violation of their publicity rights. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001). The court argued in a footnote that Fleet involved copyrightable performances in a film, whereas Downing involved the non-copyrightable names and likenesses embodied in the photographs. Id. at 1005 n.4. The unwritten distinction from performances in films upon which the court operated on seems to be simply that photographs are still and thus cannot contain copyrightable works of authorship such as dramatic performances, even while the court acknowledged that photographs themselves are pictorial works of authorship. See *id.* at 1003-04.

<sup>136</sup> 35 U.S.P.Q.2d (BNA) 1315 (9th Cir. 1995) [hereinafter *Wendt I*].

<sup>137</sup> Id. at 1315.

<sup>138</sup> Id.

<sup>139</sup> *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting) (dissenting from an order rejecting an en banc hearing) [hereinafter *Wendt II*].

<sup>140</sup> Id. at 1285.

<sup>141</sup> Id. n.6.

<sup>142</sup> Wendt I, 35 U.S.P.Q.2d at 1315.

<sup>143</sup> Id. at 1316.

<sup>144</sup> Id.

<sup>145</sup> Id.

<sup>146</sup> Wendt v. Host Int'l, Inc., 125 F.3d 806, 810 (9th Cir. 1997).

<sup>147</sup> See *id.* at 810.

<sup>148</sup> See *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938) (stating that there is no general federal common law).

<sup>149</sup> See 28 U.S.C. § 1367 (2000).

<sup>150</sup> White, 989 F.2d at 1517-18 (Kozinski, J., dissenting).

<sup>151</sup> Wendt II, 197 F.3d at 1285 (Kozinski, J., dissenting).

<sup>152</sup> *Id.* (emphasis in original).

<sup>153</sup> *Id.* at 1289. Kudzu is a vine regarded as an uncontrollable weed throughout the southeastern United States.

<sup>154</sup> *Id.* at 1287 n.6.

<sup>155</sup> *Id.* at 1286.

<sup>156</sup> *Id.* (citations omitted).

<sup>157</sup> Wendt II, 197 F.3d at 1286.

<sup>158</sup> *Id.*

<sup>159</sup> Baltimore Orioles, 805 F.2d at 676-78.

<sup>160</sup> Wendt II, 197 F.3d at 1288.

<sup>161</sup> *Id.* (quoting *Goldstein v. California*, 412 U.S. 546 (1973)).

<sup>162</sup> 227 F.3d 619 (6th Cir. 2000).

<sup>163</sup> *Id.* at 621-22.

<sup>164</sup> *Id.*

<sup>165</sup> *Id.* at 623.

<sup>166</sup> *Id.* at 621.

<sup>167</sup> *Id.* at 623-24.

<sup>168</sup> 201 F.3d 654 (5th Cir. 2000).

<sup>169</sup> *Id.* at 661.

<sup>170</sup> *Id.* at 656-57.

<sup>171</sup> *Id.*

<sup>172</sup> *Id.* at 658-59.

<sup>173</sup> *Id.* at 659-61.

<sup>174</sup> 78 F. Supp. 2d 337 (D.N.J. 2000).

<sup>175</sup> *Id.* at 340-341.

<sup>176</sup> *Id.* at 342.

<sup>177</sup> *Id.* at 349.

<sup>178</sup> *Id.* See *Midler*, 849 F.2d 460; *Waits*, 978 F.2d 1093.

<sup>179</sup> *Prima*, 78 F. Supp. 2d at 352.

<sup>180</sup> 78 Cal. App. 4th 362 (Cal. Ct. App. 2000).

<sup>181</sup> *Id.* at 365.

<sup>182</sup> Id. at 366.

<sup>183</sup> Id. at 365.

<sup>184</sup> Id.

<sup>185</sup> Id. at 374.

<sup>186</sup> KNB, 78 Cal. App. 4th at 372-73.

<sup>187</sup> Eastwood v. Superior Court, 149 Cal. App. 3d 409 (Cal. Ct. App. 1983).

<sup>188</sup> Id. at 414.

<sup>189</sup> Abdul-Jabbar v. General Motors, Corp., 85 F.3d 407 (9th Cir. 1996).

<sup>190</sup> Adair v. Falk Television Broadcasting Corp., 229 F.2d. 481, 485 (3d Cir. 1956).