# The Right of Publicity: Why the Red-Headed Stepchild of the IP World Deserves a Second Look

by Brian D. Wassom

Seldom do IP lawyers give much thought to the Right of Publicity, which governs the right to commercially exploit a person's likeness. This is understandable. It falls outside the boundaries of the big three areas—Patent, Copyright, and Trademark—where we typically ply our trade. It's not even a federal right, but, rather, a creature of state statutes or common law. And almost half of the states have not even gotten around to recognizing it.

But courts agree that the Right of Publicity is an IP right. And, like the overlooked heroines of fairy tale fame, Right of Publicity litigation, properly understood, can be sexy—figuratively and (sometimes) literally. At the very least, it is an area of law that deserves our attention, for several reasons.

**It fills an important gap in federal IP protections.** The typical Right of Publicity dispute involves a retailer who uses the image, name, or other personally signifying attribute of a famous individual for the purpose of selling goods or services. For example, Johnny Carson used the Right of Publicity to enjoin the advertisement of "Here's Johnny Portable Toilets." Rosa Parks stopped the band Outkast from using her name as the title of a song having nothing to do with her. Models have prevailed against the unauthorized use of their photographs on merchandise and advertising.

Neither copyright nor trademark law offer remedies for these injuries. If there is an expressive work involved—such as a photograph—the copyright therein usually does not belong to the person depicted. Besides, what's really at issue is not a particular expression, but the essence of who the depicted person is—their identity. That falls on the unprotected "idea" side of copyright's idea/expression dichotomy.

Trademark law is not much more helpful. "[A]s a general rule, a person's image or likeness cannot function as a trademark,"[1] because "a photograph of a human being . . . is not inherently 'distinctive' in the trademark sense of tending to indicate origin."[2] Section 43(a) of the Lanham Act offers plaintiffs some alternatives, such as a claim for false endorsement, association, or designation of origin. But in most cases, the elements of such claims, if applicable, "are similar to the elements of a right of publicity claim,"[3] to the point that they have been called "the federal equivalent of the right of publicity."[4]

**It requires different proofs.** A lawyer cannot simply rely on general copyright and trademark principles to litigate a Right of Publicity case. There are two basic components to the claim: that (1) the plaintiff's likeness has commercial value—in other words, that plaintiff is a "celebrity"—and (2) the defendant used the likeness for "commercial purposes." "Celebrity" is not a familiar IP concept, nor is it easy to define. Granted, most IP lawyers will not find themselves representing the likes of Johnny Carson and Rosa Parks. But, as discussed further below, the jury is still out in many ways on what constitutes "commercial value."

"Commercial purposes," also called "use in trade," is trickier. Because it's simpler to show a prima facie case for infringement of the Right of Publicity than it would be for trademark infringement, this element has been defined much more narrowly than it would be in a Lanham Act context—lest Right of Publicity liability impinge on the broad freedoms of expression guaranteed by the First Amendment. Generally, if the work is expressive and has any redeeming social value (such as newsworthiness, entertainment value, or political speech), it is not a "commercial use." Posters, T-shirts, and billboards, on the other hand, are fair game. Where the line between these uses falls, though, is sometimes still blurry.

**Its parameters are still fluid.** Right of Publicity law is a lot like the Wild West of old—many of the boundary lines have yet to be drawn. In addition to defining its elements and finding its place between federal IP laws and the First Amendment, courts are also still deciding which defenses apply. For example, at least two circuit courts have abstracted the various versions of the "first sale" doctrine from federal IP law and applied it to publicity claims. The same defense has also been analyzed in terms of "waiver" and "consent." Other courts have applied the "single publication rule"—an import from the invasion of privacy tort, from which the Right of Publicity originated—to limit damages.

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In short, there is a lot of room left in Right of Publicity law for creative lawyering—and especially here. Commentators have noted that, despite (or perhaps because of) being geographically distant from the nation's entertainment hotbeds, our Sixth Circuit Court of Appeals has balanced

the competing considerations in publicity law "in a more careful and nuanced manner than other jurisdictions."[5] It has even done more to shape Michigan's common law on the subject than the state courts have, which leaves many seemingly resolved issues open to potential reinterpretation by Michigan courts (and/or the Michigan Legislature, which has considered codifying the right in recent years, and may do so again soon).

**It shows up in unexpected places.** Section 230 of the Communications Decency Act exempts internet service providers from most tort liability arising out of user-generated content. That immunity does not apply, however, to "intellectual property" claims.[6] Chances are that most legislators who debated this provision were thinking about patent, copyright, and trademark infringement. But guess what? The Right of Publicity is also IP, and recent court decisions have split over whether such claims are covered by this statute.

Licensors of photographs and videos make the same mistake when they fail to address the publicity claims of those depicted in the works. Experienced media professionals will be sure to have model releases in addition to a license from the copyright owner.

Even more troublesome are the potential tax ramifications. Publicity rights can be licensed, but what are they worth? Complicating things further, several state statutes, and even Sixth Circuit common law, recognize a post-mortem Right of Publicity. Who owns the right, and for how long?

**It can be worth big money.** Granted, many successful Right of Publicity plaintiffs end up settling for a relatively modest royalty. But with great infringement comes great liability. Hockey player Tony Twist secured a $15 million verdict—upheld on appeal—against the publisher of the Spawn comic book, which used his name for one of its villains. And a relatively unknown model in California won an even larger sum from Nestle after learning that his face had appeared for sixteen years, without permission, on packages of Taster's Choice coffee.

**It has found new life online.** As with other areas of IP, the internet allows anyone to be an infringer. People identify themselves online using icons and avatars, which may incorporate the likenesses of famous people. Retro nostalgia and mash-up videos drive the re-use of iconic photographs. In a competitive business environment where customers are increasingly scarce, it is difficult for many companies to resist piggybacking on the drawing power of recognizable celebrity identities.

It can also be hard to ignore the billions of photographs available for instant download. In 2007, a sixteen-year-old Texas girl sued Virgin Mobile after learning that the company had found an unflattering picture of her on Flickr and used it in an Australian ad campaign. In June 2009, a Missouri couple discovered that a Christmas family portrait they had shared with relatives online had become an advertisement for a grocery store in the Czech Republic.

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**It offers a shield against prurient publicity.** Although the case law is mixed, some plaintiffs—including girls who regret having gone wild, a news anchor filmed on vacation participating in a wet t-shirt contest, and celebrities who misplaced their sex tapes—have used the Right of Publicity to keep the embarrassing footage out of the public eye. These decisions suggest the controversial, but interesting, theory that sex appeal has commercial value, and unauthorized distribution of provocative performances infringes the individual's right to profit from that appeal. In many ways, this line of cases takes the Right of Publicity full circle—back to its roots in privacy law, which operates to keep information out of the public eye rather than controlling the right to profit from its exploitation. But however this theory of recovery fares, human nature combined with steady advances in cell phone cameras and online video sharing technology will ensure that it remains a relevant legal issue.

This article is only a thumbnail sketch of the Right of Publicity—an area of law that is young and still evolving. But all IP attorneys should at least be sure they are able to spot these issues for their clients.

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**Endnotes**

1 ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 922 (6th Cir. 2003).

2 ETW, 332 F.3d at 922 (quoting Pirone v. MacMillan, 894 F.2d 579, 583 (2d Cir. 1990)).

3 *Id.* at 924.

4 *Id.*

5 Jon M. Garon, *Publicity Rights in Entertainment*, 11 CHAP. L. REV. 465, 492 (2008).

6 47 U.S.C. § 230(e)(2) (2008).