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# A Descendible Right of Publicity: Has the Time Finally Come for a National Standard?

"Listen, lad, you're going to walk in my shoes now. Don't . . . let anybody hurt us or our widows."<sup>1</sup>

—Stan Laurel

"Dead Men Don't Bite."<sup>2</sup>

—Robert Lewis Stevenson

## I. INTRODUCTION

Fame is a double-edged sword. One side cuts in a manner that can add great financial value to a celebrity's marketability and even the commercial value of their name and likeness. The other side requires long hours of hard work and determination along with the discipline that is required to maintain an achieved level of status. However, when a famous person dies, his fame, wealth, name, likeness and, in effect, his hard work and determination, are subject to numerous standards of the assignability and descendibility of something called "publicity."

In 1980, the Sixth Circuit in *Memphis Development Foundation v. Factors Etc., Inc.*<sup>3</sup> stated that recognizing a descendible right of publicity would not "enlarge the stock or quality of the goods, services, artistic creativity, information, invention or entertainment available."<sup>4</sup> Yet, the posthumous disposition of the publicity of that case's subject, Elvis Presley, refutes this argument. Upon Presley's death in 1977, the Presley estate was valued at a mere \$4.9 million.<sup>5</sup> The expenses required to maintain the estate would ultimately have ex-

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1. Kleinfield, *Publicity Rights of Stars: The Living, and the Dead*, N.Y. Times, Nov. 22, 1981, § 3, at 9, col. 1. Stan Laurel made this statement from his deathbed to Larry Harmon. Mr. Harmon, who owned the licensing rights of Stan Laurel and Oliver Hardy, along with the celebrities' widows, later prevailed in a suit against Hal Roach Studios on a descendible right of publicity theory. See *infra*, notes 17, 18, 35-50 and accompanying text.

2. R. STEVENSON, *TREASURE ISLAND* 87 (spec. ed. 1941).

3. 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953 (1980). See also *infra* notes 4, 11, 139-153 and accompanying text.

4. *Memphis Dev. Found.*, 616 F.2d at 960.

5. Hilburn, *Eternal Revenue; Elvis' Millions Were Disappearing When Priscilla Presley Took Charge and Rebuilt the King's Fortune*, L.A. Times, June 11, 1989, (magazine), at 10.

hausted the estate's holdings by 1993, the year Presley's sole heir, Lisa Marie Presley, would inherit the estate.<sup>6</sup> Before June 1989, under the guidance and business savvy of the late entertainer's ex-wife/co-executor, Priscilla Presley, and co-executors Joseph Hanks and the National Bank of Commerce in Memphis, and a four-man management team, Presley's estate had risen to over seventy-five million dollars with an estimated fifteen million dollars in annual gross income.<sup>7</sup>

More recently, the estate of Marilyn Monroe has become an issue. Monroe left one quarter of her publicity residuals to her psychotherapist, Marianne Kris.<sup>8</sup> The remainder was left to her famed acting coach, Lee Strasberg.<sup>9</sup> Because both legatees have since died, the ownership and control of Monroe's publicity rights were in question some twenty-seven years after Monroe's death.<sup>10</sup> The disputes between the Kris estate and the Strasberg estate concerning the licensing of Monroe's image, and the Presley estate, demonstrate how important the "stock or quality of the goods, services, artistic creativity, information, invention or entertainment available"<sup>11</sup> actually are

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6. *Id.* The probate court decided that Lisa Marie Presley will inherit the estate in 1998 rather than in 1993, in order to keep the estate under the successful guidance of the co-executors and management team who rejuvenated the estate. *Id.*

7. *Id.* Adding another facet to her duties, Priscilla Presley serves as an executive producer, a position that holds the highest level of control, for a new television series documenting the beginning of Presley's career between the years of 1954-1958, which debuted in February, 1990. *Daily Variety*, Dec. 21, 1989, at 3, col. 4. This "highly unusual arrangement," necessary to secure the publicity rights from Presley's estate, gives Ms. Presley "full" veto power over creative decisions." *Id.*

8. Anderson, *Marilyn's Money: Heirs Wrangle for Control of Licensing Monroe's Image*, A.B.A. J., Oct. 1, 1989, at 22.

9. *Id.*

10. *Id.* Marianne Kris died in 1980 leaving her interest in the Monroe publicity rights to the Hampstead Child-Therapy Clinic; Lee Strasberg died in 1982 leaving his portion of the interest in the Monroe publicity rights to his wife Anna. *Id.* The dispute concerned two issues with regard to the Kris estate. First, whether Kris had more than a life estate to the publicity rights, and second, if so, whether the clinic, renamed the Anna Freud Centre for the Psychoanalytic Study and Treatment of Children was, in fact, the Hampstead Child Therapy Clinic which was named as legatee in Kris' will. *Id.* Regarding the Strasberg estate, Mrs. Strasberg, was named in the spring of 1989 as Monroe's administratrix. Prior to her appointment as administratrix, Mrs. Strasberg had maintained tight control over the licensing rights through the exercise of a veto power which she held pursuant to an agreement with the Anna Freud Centre. *Id.* This agreement provided that both Mrs. Strasberg and the Anna Freud Centre could veto licensing proposals. *Id.* In opposition to Mrs. Strasberg's motion for appointment as administratrix, the Anna Freud Centre argued that the Monroe estate had lost many valuable licensing contracts because Mrs. Strasberg had been too cautious or inactive in co-managing the estate. *Id.* Hearings concerning the residual publicity rights were set to resume in the fall of 1989. *Id.* On Monday, March 12, 1990, a New York court ordered that the Anna Freud Centre was entitled to one-fourth of Monroe's estate, which represented Kris' interest. *Daily Variety*, Mar. 13, 1990, at 20, col. 5.

11. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 959-60, *cert. denied*, 449 U.S. 953 (1980). See *supra* note 4 and *infra* notes 139-153 and accompanying text.

to the heirs and legatees of a famous individual.

This comment discusses six major areas concerning the descendible right of publicity as it stands today. Part II traces the development of the common law right of publicity as well as its statutory development in eleven states which acknowledge and protect a right of publicity. In Part III, the descendible right of publicity is examined through seminal case law, emphasizing the diversity of decisions concerning the right of publicity. Part IV analyzes several of the existing state statutes and their differences. Part V explores the resulting conflict between the first and fifth amendments of the Constitution in right of publicity cases. Part VI advocates and summarizes the need for a national statute to protect an individual's right of publicity.

## II. THE HISTORY OF THE RIGHT OF PUBLICITY

The right of publicity was first recognized in 1953 in the seminal decision of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>12</sup> involving a contractual dispute concerning a number of baseball players who had sold the "exclusive" rights to their names and likenesses to more than one baseball card company.<sup>13</sup> The court recognized that a person "has a right in the publicity value of his photograph" and that "this right might be called a 'right to publicity.'"<sup>14</sup> This right is defined as a "reaction of the public to [a person's] name and likeness, which may be fortuitous or which may be managed or planned, and endows the name and likeness of the person involved with commer-

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Interestingly, three years later, the Sixth Circuit took a divergent view of the right of publicity for the living from that taken in *Memphis Dev. Found.*, in a case surrounding Johnny Carson and portable toilets. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). The court stated that:

First, "the right of publicity vindicates the economic interests of celebrities, enabling those whose achievements have imbued their identities with pecuniary value to profit from their fame." . . . Second, the right of publicity fosters "the production of intellectual and creative works by providing the financial incentive for individuals to expend the time and resources necessary to produce them." . . . Third, "[t]he right of publicity serves both individual and societal interests by preventing what our legal tradition regards as wrongful conduct: unjust enrichment and deceptive trade practices."

*Id.* at 838 (Kennedy, J., dissenting) (quoting *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC. 111, 116-22 (1980)) (emphasis added).

12. 202 F.2d 866 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

13. *Id.* at 867.

14. *Id.* at 868.

cially exploitable opportunities.”<sup>15</sup> While the *Haelan* court did not specifically label the right of publicity a property right, the court stated that such a label is “immaterial . . . as . . . the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth.”<sup>16</sup> However, because no national consensus or federal statute developed following the *Haelan* decision, each state or district court which subsequently addressed this issue has determined its own view of the right.

In reaching its decision, each state or district court has decided first whether a right of publicity actually exists,<sup>17</sup> and if so, whether that right is assignable or descendible.<sup>18</sup> However, “much confusion is generated by the notion that the right of publicity emanates from the classic right of privacy.”<sup>19</sup> Dean William Prosser proclaimed that a remedy for the appropriation of a person’s name or likeness for commercial purposes emerges from the personal right of privacy.<sup>20</sup> Under this analysis, the right of publicity is a personal right and extinguishes upon the death of the person.<sup>21</sup> The result is that courts differ in their approach to this issue: some courts do not recognize any right of publicity, some courts use the Prosser analysis and view

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15. *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 824, 603 P.2d 425, 431, 160 Cal. Rptr. 323, 329 (1979).

16. *Haelan*, 202 F.2d at 868.

17. See *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 843 (S.D.N.Y. 1975) (individual’s commercial right in name and likeness is distinct from his right of privacy); *Groucho Marx Productions, Inc. v. Day & Night Co.*, 523 F. Supp. 485, 487 (S.D.N.Y. 1981) (although never explicitly recognized by New York State courts, the district court agreed with other federal courts that New York nevertheless recognizes a right of publicity), *rev’d*, 689 F.2d 317, 320 (2d Cir. 1982) (the court of appeals reversed on grounds that California law, not New York law, applied and that under California law, a right of publicity exists); *Lombardo v. Doyle Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622, 396 N.Y.S.2d 661, 664 (App. Div. 1977) (right of proprietary interest in publicity unequivocally exists).

18. See *Reeve v. United Artists*, 572 F. Supp. 1231, 1235 (N.D. Ohio 1983) (complaint dismissed with prejudice as the right of publicity is not descendible under Ohio common law), *aff’d per curiam*, 765 F.2d 79, 80 (6th Cir. 1985) (right of publicity seen as part of the invasion of privacy and, therefore, extinguished at death); *Price*, 400 F. Supp. at 843-46 (right of publicity is assignable and descendible); *Lombardo*, 58 A.D.2d at 621-22, 396 N.Y.S.2d at 664 (the right to publicity, i.e., the property right in one’s name, photograph and image, is not inhibited by limitations placed on the right of privacy; the right of privacy is not assignable nor descendible); *Groucho Marx Productions, Inc.*, 689 F.2d 317, 320 (2d Cir. 1982) (right of publicity is not descendible in California).

19. *Price*, 400 F. Supp. at 843.

20. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960). Prosser wrote that the personal right of privacy included protection against four invasions: (1) “[i]ntrusion upon the plaintiff’s seclusion or solitude, or into his private affairs”; (2) “[p]ublic disclosure of embarrassing private facts about the plaintiff”; (3) “[p]ublicity which places the plaintiff in a false light in the public eye”; and (4) “[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness.” *Id.* (emphasis added).

21. D. Beiderman, R. Berry, E. Pierson, M. Silfen, & J. Glasser, LAW AND BUSINESS OF THE ENTERTAINMENT INDUSTRIES 557 (1987) [hereinafter LAW AND ENTERTAINMENT].

it as an element of the personal right of privacy, and some courts separate the right of publicity from the right of privacy,<sup>22</sup> viewing it as a property interest.<sup>23</sup>

Upon establishing a proprietary right of publicity, even though most states have then agreed that such a right is descendible,<sup>24</sup> many states require that a finding of descendibility requires that the celebrity must have exploited his name or likeness in some manner during his lifetime. Some courts even provide that the right to publicity descends only to the extent and manner in which the celebrity exploited his name and likeness during his lifetime.<sup>25</sup> In effect, a celebrity such as Bette Midler who does no commercial endorsements<sup>26</sup> has a great concern as to how her publicity right will be

22. *Id.* at 558.

23. See *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 846 (S.D.N.Y. 1975).

24. *Reeves v. United Artists*, 572 F. Supp. 1231, 1233 (N.D. Ohio 1983).

25. See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977) [hereinafter *Factors I*], *aff'd*, 579 F.2d 215 (2d Cir. 1978) [hereinafter *Factors II*] (right of publicity descendible because it was exploited during lifetime), *cert. denied*, 440 U.S. 908 (1979). See *infra* notes 51-54, 70, 80, 176-177 and accompanying text; *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978) (those seeking to establish a descendible right of publicity must prove that the celebrity exploited his name and likeness in such a manner that demonstrated that he was aware of its value). See *infra* notes 51-59 and accompanying text; *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981) (no descendible right of publicity since King did not exploit name and likeness commercially during his lifetime), *rev'd per curiam*, 694 F.2d 674 (11th Cir. 1983) (on grounds that under Georgia law, King need not have commercially exploited his right to publicity during his lifetime in order for the right of publicity to be descendible). See *infra* notes 58, 157-158 and accompanying text; *Groucho Marx Productions, Inc. v. Day and Night Co., Inc.*, 523 F. Supp. 465, 490-91 (S.D.N.Y. 1981) (right of publicity is descendible in New York provided person exploited the right during lifetime); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 818-20, 603 P.2d 425, 428-29, 160 Cal. Rptr. 323, 326-27 (1979) (right of publicity must be exercised during life and is only descendible as to those specific items and products endorsed during life). See *infra* notes 87-89; *Groucho Marx Productions, Inc.*, 689 F.2d 317, 323 (2d Cir. 1982) (right of publicity in California is either not descendible or descendible only for those items which were vehicles of exploitation during life). See *infra* notes 86-91.

26. *Midler v. Ford Motor Co.*, 849 F.2d 460, 461-62 (9th Cir. 1988). After learning that Midler did not do commercial endorsements, Ford Motor Company's advertising agency, Young & Rubicam, used a sound-alike voice imitating Midler's rendition of "Do You Want to Dance?" in a television commercial. Because she was still living, the California right to publicity statute, which protects the deceased person only, did not apply. CAL. CIV. CODE § 990(a) (West Supp. 1989). However, because the statute protects a deceased person's voice as a property right, and because by analogy the common law rights are also property rights, the court cited the statute to support its holding. *Midler*, 849 F.2d at 463. The court held that because Ford's advertising agency had attempted to hire Midler by contacting her agent, and when they were unable to secure her services employed one of Midler's back-up singers to imitate Midler, they had, in effect, appropriated Midler's distinctive voice for commercial purposes. *Id.* The court,

viewed on a national level once she dies. Although Midler won her case in California concerning the appropriation of her voice for an automobile commercial,<sup>27</sup> upon her death her rights may not be as secure in those states which would provide protection only for publicity rights exploited during her lifetime.<sup>28</sup>

As more states have become concerned with the lack of legislative protection for a descendible right of publicity, eight states have adopted statutes which specifically protect these rights.<sup>29</sup> In New York, the state senate and assembly have considered such a bill for the past two years.<sup>30</sup> As with similar state statutes, deceased celebrities' heirs have played a major role in the proposed New York legislation.<sup>31</sup> On February 15, 1988, celebrity heirs, such as John Wayne's son, Michael Wayne, W.C. Fields' grandson, Everett Field, and Clark Gable's son, John Clark Gable, testified on behalf of the proposed legislation.<sup>32</sup> A similar hearing was held again on May 15, 1989, in conjunction with the resubmission of the proposed bill.<sup>33</sup> Although the bill failed in both attempts due to concerns of an undue burden on first amendment rights, the proponents, New York State Senator Emanuel R. Gold and New York State Assemblyman Alan G. Havesi, plan to continue to support the bill in order to secure the celebrities' right of publicity in New York.<sup>34</sup>

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however, added that this holding did not render every commercial imitation as actionable. *Id.*

27. *Id.* Recently, on remand, Ford Motor Company, an original defendant, was dismissed because of insufficient evidence. *Daily Variety*, Oct. 31, 1989, at 1, col. 4. A federal jury awarded Midler \$400,000 in damages against the advertising agency involved. *Id.*

28. See *infra* note 92 and accompanying text.

29. Gordon & Honig, *The Celebrity Rights Act*, *THE ENT. AND SPORTS LAW*, Summer-Fall 1988, at 2. See, e.g., CAL. CIV. CODE § 990 (West 1982 & Supp. 1989); FLA. STAT. ANN. § 540.08(1)(c) (West 1988); KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984); NEB. REV. STAT. § 20-208 (1987); OKLA. STAT. ANN. tit. 21, § 839.1 (West 1983 & Supp. 1989); TENN. CODE ANN. § 47-25-1103 (1988); TEX. PROP. CODE ANN. §§ 26.001-26.015 (Vernon 1984 & Supp. 1989); VA. CODE ANN. § 8.01-40 (Supp. 1989). Other states have statutorially recognized a publicity right, but have not included descendible rights within their statutes. See, e.g., MASS. GEN. LAWS ANN. ch. 214, § 3A (West 1989); UTAH CODE ANN. §§ 45-3-2 to 45-3-6 (1988).

30. Gordon & Honig, *supra* note 28, at 1.

31. W.C. Fields' grandson, Everett Field, assisted in drafting the California Statute. *Id.* Priscilla Presley and the Presley estate management team were instrumental in securing legislation in Tennessee. Hilburn, *supra* note 5.

32. Gordon & Honig, *supra* note 29, at 1.

33. Telephone interview with John J. McPadden, Legislative Director for New York State Senator Emanuel R. Gold, Deputy Minority Leader (October 13, 1989).

34. *Id.*

### III. THE COMMON LAW DESCENDIBLE RIGHT OF PUBLICITY AND THE LACK OF NATIONAL CONSISTENCY

#### *A. Right of Publicity Claims*

In the thirty-six years since the *Haelan* decision, the common law right of publicity has been subjected to numerous interpretations. The resulting standards have imposed an inconsistent basis of relief for those whose predecessors' names and likenesses have been appropriated. New York and federal district courts have been particularly vulnerable to this vacillation in the law.

Following *Haelan*, the ownership of the publicity rights of comedians Stan Laurel and Oliver Hardy was contested.<sup>35</sup> Laurel Hardy's widow Lucille Hardy Price, and Laurel and Hardy Feature Productions<sup>36</sup> entered into an agreement with Larry Harmon on March 21, 1961, "which granted Harmon the right to acquire in perpetuity the *exclusive* right to utilize and merchandise the names, likenesses, characters and characterizations of Laurel and Hardy."<sup>37</sup> Hal Roach Studios (Roach) held the copyrights to all "Laurel and Hardy" films<sup>38</sup> and believed that, under various contracts between the comedians and the studio, Roach controlled the publicity and merchandising rights.<sup>39</sup> Price, Harmon, and Ida K. Laurel sued Roach for misappropriation of the comedians' publicity rights in federal district court in New York.<sup>40</sup> Given no federal statute, this case illustrated the analysis that the courts must use.<sup>41</sup>

Although the language of the early movie contracts did purport to grant Roach the exclusive publicity rights,<sup>42</sup> the court held that

35. *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975).

36. *Id.* at 838 n.2. This was a corporation formed in 1939 that actually employed the two comedians to produce motion pictures.

37. *Id.* at 838 (emphasis added).

38. *Id.*

39. *Id.* On January 21, 1971, Roach sold the same exclusive rights purported to be owned by Harmon to Richard Feiner & Company, which conveyed the international rights to the Overseas Programming Companies, Ltd. *Id.*

40. *Id.* at 838-39.

41. See *supra* notes 17-25 and accompanying text.

42. An example of one of these provisions states that:

The second party [Hardy] expressly gives and grants to the first party [Roach] the sole and exclusive right to photograph any and all of his acts, poses, plays, and appearances of any and all kinds, and the right to record and/or reproduce his voice and all instrumental and/or musical and/or other sound effects of any and all kinds during the term hereof, and to produce or reproduce the same by any method whether now known or not, and the first party shall have the exclusive and complete control, right, title and property and the right of copyright in and to all the foregoing things, and any and all



"[t]hese provisions . . . are always expressly limited to the 'term' of the contract."<sup>43</sup> Thus, the completion of these contracts terminated Roach's control of the comedians' names and likenesses. The court also found that another contract provision in which Laurel and Hardy had retained their right to make commercial endorsements during the term of the movie contracts was essential in determining that neither party had intended to relinquish control of their publicity rights beyond the term of the contracts.<sup>44</sup>

With the contract issues decided, the court addressed the contention that the comedians' names and likenesses were public domain. Remaining consistent with *Haelan*, the court distinguished the common law right of publicity from the statutorily protected right of privacy<sup>45</sup> and concluded that the right of publicity was a distinct property right under New York common law.<sup>46</sup> The next question the court answered was "whether the right of publicity terminates upon the death of the individual or whether it is descendible."<sup>47</sup> This case actually combined the assignability and descendibility of the right since Stan Laurel was alive when the contract with Harmon was formed.<sup>48</sup> Although the court recognized that the statutory right of privacy terminated upon death, the court emphasized the "purely commercial nature of the protected right . . . [of publicity and saw] no logical reason to terminate this right upon death of the person protected."<sup>49</sup> On the basis of this decision and shortly thereafter, Harmon was able to require a windshield-wiper blade company to purchase a licensing agreement before mounting its advertising campaign featuring the Laurel and Hardy characters.<sup>50</sup>

By 1978, federal interpretation of common law in New York suggested an additional element in proving the prima facie case of appropriation of a deceased person's name or likeness. A plaintiff who claims that he is the holder of another's right to control the usage of that other person's name or likeness for commercial purposes must

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parts thereof, as well as in and to the name of the second party for any of such purposes during the term hereof and perpetually in connection with all productions in which the second party appears under the provisions hereof, as fully and completely and to all intents and purposes, as the second party could or would have enjoyed the same in the absence of this agreement.

Price v. Hal Roach Studios, Inc., 400 F. Supp. 836, 840 n.3 (S.D.N.Y.).

43. *Id.* at 841.

44. *Id.*

45. N.Y. Civ. Rights Law §§ 50, 51 (McKinney 1976 & Supp. 1989). Under these sections it is a misdemeanor (§ 50) and a tort (§ 51) to use a living person's "name, portrait or picture . . . for advertising purposes or for purposes of trade . . . without having first obtained" that person's written consent. *Id.*

46. *Price*, 400 F. Supp. at 843-44.

47. *Id.* at 844 (footnotes omitted).

48. *Id.* at 844 n.8.

49. *Id.* at 844.

50. Klienfield, *supra* note 1, at 9, col. 1.

prove that the person exploited that right during his lifetime.<sup>51</sup> On the heels of this suggested element, the court in *Hicks v. Casablanca Records*<sup>52</sup> further refined the additional element by defining "exploited." The court explained that "a party claiming the right [of publicity] must establish that the decedent acted in such a way as to evidence his or her own recognition of the extrinsic commercial value of his or her name or likeness, and *manifested that recognition in some overt manner.*"<sup>53</sup> The court provided examples such as having made an assignment of the right or posing for bubble gum cards, as in *Haelan*, which would demonstrate that the decedent had made an overt act during his lifetime.<sup>54</sup>

*Hicks* concerned the famed mystery novelist Agatha Christie. Christie's heir and assignees attempted to stop the distribution of a film and a book which depicted her publicized mysterious eleven-day disappearance in 1926.<sup>55</sup> The book and movie fictionalized Christie's disappearance and included scenes which portrayed her in an unfavorable light as being mentally unstable and plotting the murder of her husband's mistress.<sup>56</sup> In its analysis, the court acknowledged that Christie had exploited her name to the point that it was "almost synonymous with mystery novels."<sup>57</sup> Although the defendants, the book and movie companies, argued that the type of exploitation required for a descendible right of publicity must be "exercised . . . independently of that thing for which the grantor was known,"<sup>58</sup> the

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51. *Factors II*, 579 F.2d 215, 222 (2d Cir. 1978), cert. denied, 440 U.S. 908 (1979). See *supra* note 25 and *infra* notes 87-92, 135, 176-177 and accompanying text. The *Factors II* court noted that because Elvis Presley had exploited his publicity right during his life, the court "need not . . . decide whether the right would survive the death of a celebrity if not exploited during the celebrity's life." *Factors II*, 579 F.2d at 222 n.11.

52. 464 F. Supp. 426 (S.D.N.Y. 1978).

53. *Id.* at 429 (emphasis added).

54. *Id.*

55. *Id.* at 428-29. Rosalind Christie Hicks, the sole heir to the rights of Agatha Christie's work, and the assignees, Agatha Christie, Ltd. and William Collins Sons & Co., Ltd., were the plaintiffs in the action. The heir and assigns, in their quest to enjoin the distribution of the film and the book, were unable to use theories such as defamation and the right to privacy because these are personal rights which terminate with death. *Id.* at 429.

56. *Id.*

57. *Id.* at 428.

58. *Id.* at 429 n.6. Even Martin Luther King, Jr. was not safe from such a fate. *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981), rev'd per curiam, 694 F.2d 674 (11th Cir. 1983) [hereinafter *King*]. American Heritage sought endorsements from the Center concerning the production and sales of a plastic bust of Dr. Martin Luther King, Jr. *King*, 508 F. Supp. at 856. Regardless of the fact that the Center declined as to any kind of par-

court found that Christie had sufficiently exploited her name under their interpretation for the heir and assignees to receive protection for her right of publicity.<sup>59</sup>

*Price* and *Hicks* demonstrate the analysis a court must undertake in resolving these issues.<sup>60</sup> The focus now turns to some of the inconsistencies that arise when federal courts interpret other states' laws or states begin to develop their own common law concerning the right of publicity.

In another high-profile case, *Groucho Marx Productions, Inc. v. Day and Night Co., Inc.*,<sup>61</sup> a New York federal district court implemented the same analysis as previously described and found that the Marx Brothers' right of publicity was protected after their deaths.<sup>62</sup> The case centered around the musical comedy *A Day in Hollywood/A Night in the Ukraine*.<sup>63</sup> During the second act of the musical, three characters take the stage as Groucho, Harpo and Chico Marx, otherwise known as the Marx Brothers. Although the play makes no reference to the Marxes by name, the script requires "three principle performers to reproduce the appearance and comedy style made memorable by Groucho, Chico, and Harpo."<sup>64</sup>

The plaintiffs in this case maintained that they held the publicity rights of the Marxes for various reasons. Groucho Marx Productions,

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ticipation, American Heritage commenced producing and marketing the unauthorized plastic busts. *Id.* at 856-57.

When the Center, King's administratrix Coretta Scott King, and Motown Records (Motown owned the copyright to certain speeches of which commemorative copies were also being sold) brought suit, a district court in Georgia took notice that, although Georgia common law recognized a right of publicity, *id.* at 862, "King did not exploit his public personality to his commercial advantage by endorsing products or selling merchandise bearing his name or image" during his lifetime. *Id.* at 865. The issue of descendibility was one of first impression in Georgia, and this court held that without similar inter vivos exploitation it would not find a descendible right of publicity. *Id.* The Center and estate failed in acquiring an injunction preventing the manufacture and sale of the busts. *Id.*

Fortunately, the Eleventh Circuit in *King*, 694 F.2d 674 (11th Cir. 1983), stated unequivocally, via an opinion by the Supreme Court of Georgia in answer to certified questions from the court of appeals, that Georgia common law recognized the right of publicity, *id.* at 677-80; that the right is assignable during life and survives the assignor upon death, *id.* at 680-82; and that the decedent need not exploit or commercialize his name or likeness during his lifetime to preserve the descendibility of the right. *Id.* at 682-83.

59. *Hicks v. Casablanca Records*, 464 F. Supp. 426, 429-30 (S.D.N.Y.). Although the court recognized the assignable right of publicity, and that Christie had sufficiently exploited her name, the court ruled that the film and book could not be enjoined based on first amendment considerations. *Id.* at 433. See *infra* notes 264-271 and accompanying text.

60. See *supra* notes 17-26 and accompanying text.

61. 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd*, 689 F.2d 317 (2d Cir. 1982).

62. *Groucho Marx Productions, Inc. v. Day and Night Co., Inc.*, 523 F. Supp. 485, 494 (S.D.N.Y. 1981).

63. *Id.* at 486.

64. *Groucho Marx Productions, Inc.*, 689 F.2d 317, 319 (2d Cir. 1982).

Inc. claimed that it held the rights of Julius (Groucho) Marx and Leo (Chico) Marx through contractual agreements.<sup>65</sup> While he was still living, Groucho assigned his rights to the company. Chico's widow, Mary Marx Fusco, was assigned the rights she acquired through the residual benefits of Chico's will.<sup>66</sup> Plaintiff Susan Marx, Adolf (Harpo) Marx's daughter, claimed ownership of Harpo's publicity rights as trustee of his last will and testament.<sup>67</sup>

The court in *Groucho Marx Productions* was consistent with other New York district courts and held that there was a common law right of publicity in New York,<sup>68</sup> and that the right was transferable.<sup>69</sup> The court also agreed that in order for the right to be descendible, it must be proved that the Marxes exploited their right of publicity during their lifetime.<sup>70</sup> The court used the *Hicks* definition of "exploited" in its analysis.<sup>71</sup>

Rejecting the defendants' argument that the comedians' *inter vivos* commercial exploitation of publicity rights needed to be different from that for which they were famous, the court reasoned that since Groucho made an assignment of his name and likeness and that since "[e]very appearance, contract and advertisement involving the Marx Brothers signified recognition by the performers of the commercial value of [the] unique characters they portrayed,"<sup>72</sup> Groucho, Chico, and Harpo Marx had sufficiently exploited their right of publicity.<sup>73</sup> Therefore, the descendible right was protected.<sup>74</sup> The court also rejected the premise that such celebrities must "tie-up" their names and likenesses by endorsing products and establishments so as to pre-

65. *Groucho Marx Productions, Inc.*, 523 F. Supp. at 486.

66. *Id.*

67. *Id.*

68. *Id.* at 487.

69. *Id.* at 488.

70. *Id.* at 490. The court cited *Factors II*, 579 F.2d 215, 222, (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (holding that because Elvis Presley exploited his right during his lifetime, it was descendible). See *supra* note 25 and *infra* notes 80, 176-77 and accompanying text.

71. *Groucho Marx Productions, Inc. v. Day and Night Co., Inc.*, 523 F. Supp. 485, 490 (S.D.N.Y. 1981). See *supra* notes 52-54.

72. *Id.* at 491.

73. *Id.* at 491-92.

74. *Id.* at 492. There were first amendment hurdles that the plaintiffs also had to overcome in order to prevail. The court found that the musical was not protected by the first amendment because it was not a biographical depiction of the Marx Brothers nor was it a parody of the Marx Brothers. Instead, the play completely reproduced the actions and appearances of the Marxes as they themselves would have portrayed the roles. *Id.* at 493. This appropriation of a person's entire act is not protected by the first amendment. *Id.* at 494. See *infra* notes 264-71 and accompanying text.

serve their descendible right of publicity as "wholly illogical."<sup>75</sup>

Although the Marx Brothers' case was originally decided based upon federal interpretation of New York common law,<sup>76</sup> on appeal,<sup>77</sup> the Second Circuit took a much closer look at the question of diversity which, given no federal statute on the right of publicity, was the basis of the suit in federal court.<sup>78</sup> Although a federal diversity suit may be brought in the state in which all the defendants reside,<sup>79</sup> the court cited their recent decision in *Factors Etc., Inc. v. Pro Arts, Inc.*<sup>80</sup> The court maintained that since the issue concerned a proprietary interest, the state law which determines the existence of the person's property interest should govern.<sup>81</sup>

Upon their deaths, all three Marx Brothers were residents of California.<sup>82</sup> Groucho Marx Productions was incorporated in California.<sup>83</sup> Groucho's *inter vivos* assignment of his rights to Groucho Marx Productions, Harpo's will, Chico's estate, and his widow's assignment of his rights to the production company, all transpired in California and were governed by California law.<sup>84</sup> Susan Marx, who was a plaintiff in behalf of Harpo's estate, was also a resident of California.<sup>85</sup> The court stated that "[t]hrough the conduct alleged to impair plaintiffs' rights occurred in New York, the existence of their rights must be determined under the law of California."<sup>86</sup>

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75. *Id.* at 490-92. *Cf.* note 25 and accompanying text (this position would be acceptable to Bette Midler's potential heirs as she does not do commercial endorsements).

76. *Id.* at 487. The court explained that New York state courts had not explicitly recognized a common law right of publicity. *Id.* The determination that New York did recognize such a right was a conclusion drawn by federal district courts sitting in New York. *Id.*

77. *Groucho Marx Productions, Inc.*, 689 F.2d 317 (2d Cir. 1982).

78. *Id.* at 319-20. Although the plaintiffs had originally brought a federal question cause of action under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1976), the case in the lower court was decided upon the common law right of publicity. *Id.* at 319. Therefore, the federal jurisdiction of the case rested entirely on diversity. *Id.*

79. 28 U.S.C. § 1391(a) (1983). "A civil action wherein jurisdiction is founded only on diversity of citizenship may . . . be brought only in the judicial district where all plaintiffs or all defendants reside . . ." *Id.*

80. 496 F. Supp. 1090 (S.D.N.Y. 1979) [hereinafter *Factors III*] *rev'd*, 652 F.2d 278 (2d Cir. 1981) [hereinafter *Factors IV*], *cert. denied*, 456 U.S. 927 (1982). *See infra* notes 105, 145, 184-92 and accompanying text.

81. *Groucho Marx Productions, Inc.*, 689 F.2d at 319-20 (citing *Factors IV*, 652 F.2d at 281). In *Factors IV*, the court concluded that because Elvis Presley was domiciled in Tennessee when he died, the company to which Presley had assigned his right of publicity when he was alive was incorporated in Tennessee, the company to which the rights were ultimately assigned was incorporated in Tennessee, and the contracts in the above assignments were constructed under Tennessee law, the court should look to Tennessee law to determine whether there was a valid property right transferred at all. *Factors IV*, 652 F.2d at 281.

82. *Groucho Marx Productions, Inc.*, 689 F.2d 317, 320 (2d Cir. 1982).

83. *Id.*

84. *Id.*

85. *Id.*

86. *Id.*

In applying California law, the court did not find a clear answer. The Second Circuit identified three possible views as to California's common law of the descendible right of publicity: California recognizes no descendible right;<sup>87</sup> California recognizes a descendible right which protects against the appropriation of a name or likeness from posthumous endorsements of the same nature as were made during life;<sup>88</sup> or, California recognizes a descendible right of publicity which protects against any appropriation of name or likeness.<sup>89</sup> Expressly rejecting the third alternative,<sup>90</sup> the court decided that under California law, the defendant-appellants, Day and Night Company, could

87. *Id.* at 321. In its analysis of the first view, the court used *Guglielmi v. Spelling-Goldberg Productions*, 73 Cal. App. 3d 436, 140 Cal. Rptr. 775 (1977) (opinion deleted from 73 Cal. App. 3d, *vacated*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979)). *Groucho Marx Productions, Inc.*, 689 F.2d at 320. In *Guglielmi*, Rudolf Valentino's nephew and legal heir sued Spelling-Goldberg Productions for the unauthorized use of his uncle's name and likeness to solicit commercial sponsorship for a fictional television depiction of Valentino's life. *Guglielmi*, 25 Cal. 3d at 862-63, 603 P.2d at 455-56, 160 Cal. Rptr. at 354-55. The Supreme Court of California, sitting *en banc*, reemphasized that, based on *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979), which they had decided two days earlier, a right of publicity exists but is terminated at death. Therefore, Valentino's right of publicity was not descendible. *Guglielmi*, 25 Cal. 3d at 861, 603 P.2d at 455, 160 Cal. Rptr. at 353. Although the court in *Groucho Marx Productions, Inc.* found this case conclusive as to California law, they continued to analyze *Lugosi* in order to investigate all avenues of interpretation. *Groucho Marx Productions, Inc.*, 689 F.2d at 320.

88. *Id.* at 321. The court used *Lugosi* for this analysis. *Id.* at 320-22. Bela Lugosi, famous for his leading role in *Dracula*, had signed an agreement in his 1930 contract for the film, giving Universal Pictures the right to use his name, likeness, and voice as "Count Dracula" "in connection with the advertising and exploitation of the said photoplay." *Lugosi*, 25 Cal. 3d at 816 n.2, 603 P.2d at 426 n.2, 160 Cal. Rptr. 323 n.2 (emphasis added). Lugosi died in 1956 and Universal continued to use Lugosi's likeness for merchandise. *Id.* at 817, 603 P.2d at 427, 160 Cal. Rptr. at 325. Lugosi's wife and son sued Universal for this continued appropriation of Lugosi's likeness. Although the *Lugosi* court held that any right of publicity must be exercised during one's lifetime, *id.* at 824, 603 P.2d at 431, 160 Cal. Rptr. at 329, it made reference to a hypothetical situation where Lugosi's heirs might have been protected as to a specific item or product had Lugosi established a business and exploited his name and likeness in connection with that item or product during his life. *Id.* at 819-20, 603 P.2d at 429, 160 Cal. Rptr. at 327. The Second Circuit stated that "[a]t most, California would recognize a descendible right of publicity that would have enabled the heirs to prevent others from using Lugosi's name and likeness on T-shirts or any other product he had promoted during his life." *Groucho Marx Productions, Inc.*, 689 F.2d at 321-22.

89. *Id.* at 321. The New York court then specifically rejected this broad scope of the descendible right of publicity under California law. *Id.* at 321-22. The *Lugosi* court specifically stated that even if Lugosi had exploited some product or item during his lifetime, and assuming that the California courts recognized such a descendible publicity right as to that product or item, the heirs would still not have "the right to exploit their predecessor's name and likeness to commercial situations he left unexploited." *Lugosi*, 25 Cal. 3d at 823-24, 603 P.2d at 431, 160 Cal. Rptr. at 329.

90. See *supra* note 89 and accompanying text.

not be liable for infringing upon the Marx Brothers' right of publicity.<sup>91</sup> The court reasoned that even with the slightly broader interpretation espoused in *Lugosi v. Universal Pictures*, the Marx plaintiff-appellees' claim failed because the Marx Brothers did not have "connection[s] with particular commercial situations—products and services . . . [which would be recognized in California] as a descendible right of publicity that protects against an original play using . . . [the celebrities'] likeness[es] and comedic style."<sup>92</sup>

Although the above discussion demonstrates that federal district and appellate courts in New York have ruled on the issue of the descendible right of publicity, these courts, bound to follow state substantive law in a diversity suit,<sup>93</sup> did not have an actual state decision on the issue to use as a guide for the federal decisions. New York state courts did not actually address the issue of a descendible right of publicity until *Southeast Bank, N.A. v. Lawrence*.<sup>94</sup>

Southeast Bank was the representative of the estate of playwright Thomas "Tennessee" Williams.<sup>95</sup> Williams was known for maintaining exclusive control over the production of his works and the use of his name.<sup>96</sup> Williams would not allow his name to be associated with anything over which he did not have direct control or where he did not have the ability to ascertain the use of his name based on another's control.<sup>97</sup> The defendant, Jarick Productions, owned a theatre in New York City which its principals, Jack and Richard Lawrence, wished to renovate and rename the "Tennessee Williams." Southeast Bank made unsuccessful attempts to preclude the use of Williams' name by contacting the Lawrences to alert them that the estate had not consented to such usage of Williams' name.<sup>98</sup> Ignoring

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91. *Groucho Marx Productions, Inc.*, 689 F.2d at 323.

92. *Id.* (footnote omitted). The plaintiff-appellees pointed out to the court that all three of the Brothers promoted various products during their lives. *Id.* at n.7. However, these products ranged from Plymouth automobiles to Smirnoff vodka. *Id.* As the products had nothing to do with a play or musical, they did not allow the plaintiff-appellee to protect the likenesses of the Marx Brothers from use in a play.

93. *Erie Railroad Co. v. Thompkins*, 304 U.S. 64, 78 (1938).

94. 104 A.D.2d 213, 213, 483 N.Y.S.2d 218, 219 (1984), *rev'd*, 66 N.Y.2d 911, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985). ("Can the representative of the estate of a deceased public figure assert the right of publicity after his death? This novel issue is presented to us on this appeal.")

Although the court in *Lombardo v. Doyle, Dane & Barnbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977) alluded to a descendible right of publicity, the court never clearly formulated a statement on the issue. "[W]hile a cause of action under the Civil Rights Law is not assignable during one's lifetime and terminates at death, the right of publicity, i.e., the property right in one's name, photograph and image is under no such inhibition." *Id.* at 621, 396 N.Y.S.2d at 664.

95. *Southeast Bank, N.A.*, 104 A.D.2d at 213, 483 N.Y.S.2d at 219.

96. *Id.* at 214, 483 N.Y.S.2d at 219. Williams had actually made provisions in his will that upon his death, his works should not be altered. *Id.*

97. *Id.*

98. *Id.* at 215, 483 N.Y.S.2d at 220. The Lawrences maintained that the use of Wil-

Southeast Bank's notice, the Lawrences continued renovation, erected a marquee with Williams' name, planned rehearsals, and began to mount an advertising campaign for the theatre's opening. Southeast subsequently brought suit to enjoin the production company from using Williams' name for the theatre based upon the right of publicity<sup>99</sup> and for what the court phrased as Southeast Bank's inability "to ensure that the quality of the productions presented there would meet the standard set by 'Tennessee Williams.'"<sup>100</sup>

In its analysis, the court cited the New York case, *Lombardo v. Doyle*, which stated "that 'there is no question but that a celebrity has a legitimate proprietary interest in his public personality.'"<sup>101</sup> Regarding *inter vivos* exploitation to protect the descendibility of the right, the court held that although such exploitation is not required under New York state law,<sup>102</sup> Williams had exploited his name during his lifetime by writing an autobiography and by associating himself with various support groups and lending his name to their causes.<sup>103</sup>

The court concluded that Williams' right of publicity did survive his death and, as his representative, Southeast Bank was awarded an injunction against the defendant's use of Williams' name.<sup>104</sup> Unfortunately, this case was later reversed by the Court of Appeals in New York based upon choice of law principles similar to those seen in *Groucho Marx Productions, Inc. and Factors IV*.<sup>105</sup>

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Williams' name was "to honor the memory and contributions of one of America's greatest playwrights." *Id.* However, the court, summarizing both its and Southeast's point of view, stated that the purpose was for "deriving financial benefit from the use of such an illustrious name." *Id.* at 220, 483 N.Y.S.2d at 223. The court added that theatres such as the "Helen Hayes" and the "Eugene O'Neil" were only named after permission was granted from their namesakes. *Id.*

99. *Id.* at 215-16, 483 N.Y.S.2d at 220.

100. *Id.* at 215, 483 N.Y.S.2d at 220.

101. *Id.* at 216, 483 N.Y.S.2d at 221 (quoting *Lombardo v. Doyle Dane & Burnbach, Inc.*, 58 A.D.2d 620, 622, 396 N.Y.S.2d 661, 664 (1971)). See *supra* notes 17, 18 and 94.

102. *Southeast Bank, N.A.*, 104 A.D.2d at 218-219, 483 N.Y.S.2d at 222 (quoting *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 846 (1975)), *rev'd*, 66 N.Y.2d 911, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985). See *supra* note 35. *Contra*, *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 222 (2d Cir. 1978) (Second Circuit held that New York state law requires exploitation during lifetime); see *supra* notes 25 and 70 and *infra* notes 176-77. *Groucho Marx Prod., Inc. v. Day & Night Co.*, 523 F. Supp. 485, 491 (S.D.N.Y. 1981) (district court in New York held that descendibility requires exploitation during lifetime); see *supra* notes 25 and 70.

103. *Southeast Bank, N.A.*, 104 A.D.2d at 218, 483 N.Y.S.2d at 222.

104. *Id.* at 220, 483 N.Y.S.2d at 223.

105. See *supra* note 81. The resulting opinion of *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985) provided yet another example of the inconsistencies in this field of the law based upon the equivocal state laws, com-



Just one week after the lower court decision in *Southeast Bank* allowing a descendible right of publicity, and after numerous previously discussed federal court decisions applying New York state law dating back to 1953 with *Haelan*, New York's highest state court ruled that the state *did not* recognize a proprietary right of publicity separate from the personal rights, which are provided by New York's Civil Rights statutes and extinguishable upon death!

In *Stephano v. News Group Publications, Inc.*,<sup>106</sup> the plaintiff was a

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mon or statutory, as applied to the situation at bar. The court of appeals ruled that the lower court had failed to use the appropriate choice of law principles of New York and Florida, Williams' domicile upon his death. Citing numerous authorities including *Groucho Marx Productions, Inc.*, and *Factors IV*, the court of appeals stated that "questions concerning personal property rights are to be determined by reference to the substantive law of the decedent's domicile." *Southeast Bank*, 66 N.Y.2d at 912, 489 N.E.2d at 745, 498 N.Y.S.2d at 776. The court of appeals then applied the Florida statute covering such publicity rights. The statute, which is written very narrowly, only grants a descendible right of publicity to an inter vivos licensee and to a spouse or child of the decedent. *Id.* at 912, 489 N.E.2d at 745, 498 N.Y.S.2d at 776 (citing FLA. STAT. ANN. § 540.08 (West 1988)). Because Williams had no surviving spouse or child, and had not licensed his right of publicity during his lifetime, the right extinguished upon death and could not now be enforced by a representative on Williams' behalf. *Id.*

In another decision which demonstrates rulings based on choice of law principles, the Second Circuit, in *Rogers v. Grimaldi*, 695 F. Supp. 112 (S.D.N.Y. 1988), *aff'd*, 875 F.2d 994 (2d Cir. 1989), used Oregon common law to render a decision concerning actress Ginger Rogers' right of publicity. Rogers, who is "among that small elite of the entertainment world whose identit[y] [is] readily called to mind by just . . . [her] first name[]], particularly [in] the pairing 'Ginger and Fred,'" *id.* at 996, brought suit in federal court seeking an injunction against the distribution of the defendants' film, "Ginger and Fred." *Id.* at 997. The film was not a biographical depiction of the famous dance team, but rather a fictional story of an Italian dance team who came to be known as Italy's "Ginger and Fred." *Id.* Although Rogers' primary claim was based upon § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), she also sought relief under a right of publicity claim. *Id.*

Citing *Southeast Bank, N.A.*, the court held that this claim must be determined based upon Oregon state law, the state of Rogers' domicile. *Rogers*, 875 F.2d at 1002. Although no Oregon cases have directly decided the status of the right of publicity in that state, the Oregon Supreme Court, in *Anderson v. Fisher Broadcasting, Co.*, 300 Or. 452, 712 P.2d 803 (1986), did make reference to the right of publicity and its distinction from the right of privacy, thereby implicating that the right of publicity is a separate proprietary interest. The Oregon court stated in the dictum that "[w]hen actors, athletes or other performers object, not to a loss of anonymity, but to unauthorized exploitation of their valuable public identities, the remedy should reflect the wrongful appropriation of a 'right to publicity' that has economic value to the plaintiff as well as to the defendant, rather than damages for psychic distress at a loss of 'privacy.'" *Id.* at 459, 712 P.2d at 812 (emphasis added). The Second Circuit cited *Anderson* in deciding *Rogers*, stating that since *Anderson* did not resolve a right of publicity claim, the Second Circuit would have to predict how Oregon courts would settle such a claim. *Rogers*, 875 F.2d at 1002 (footnote omitted).

Basing their decision on Oregon's concern for freedom of expression, the Second Circuit ruled that Rogers could not prevail on a right of publicity claim "unless the title [of the film] was 'wholly unrelated' to the movie or was 'simply a disguised commercial advertisement for sale of goods or services.'" *Id.* at 1004 (quoting *Guglielmi v. Spelling-Goldberg Prod.*, 25 Cal. 3d 860, 865 n.6, 603 P.2d 454, 457 n.6, 160 Cal. Rptr. 352, 355 n.6 (1979) (Bird, C.J., concurring) and *Frosch v. Grosset & Dunlop, Inc.*, 75 A.D.2d 768, 769, 427 N.Y.S.2d 828, 829 (1980)).

106. 64 N.Y.2d 174, 474 N.E.2d 580, 485 N.Y.S.2d 220 (1984).

professional model who agreed to allow his likeness to be used in a photographic layout for a fall fashion article in *New York* magazine.<sup>107</sup> One week prior to the publication of the issue in which the layout was to be published, the defendant published a different photo of the model taken during the same photo session for a *New York* magazine regular feature article focusing on new and unusual trends in the New York area.<sup>108</sup> The plaintiff felt that the use of the photo in the additional issue of the magazine was an infringement upon his common law right of publicity.<sup>109</sup> The caption of the unauthorized photo contained an advertisement for the jacket.<sup>110</sup>

The court traced the development of the common law right of publicity as a separate and distinct right from privacy and reasoned that because the New York Civil Rights Law under sections 50 and 51

parallels the common-law right of privacy . . . [and] generally provides remedies for any commercialization of the individual's personality without his consent[,] . . .<sup>111</sup> the "right of publicity" is encompassed under the Civil Rights Law as an aspect of the right of privacy, which, as noted, is exclusively statutory in this State, [and] the plaintiff cannot claim an independent common-law right of publicity.<sup>112</sup>

Although the *Stephano* court conceded in a footnote that at the time of the decision there was no need to rule on the transferability, assignability, or descendibility of the right of publicity,<sup>113</sup> the court cited the Prosser theory which defines publicity as a rudiment of the

107. *Id.* at 179, 474 N.E.2d at 581-82, 485 N.Y.S.2d at 221-22.

108. *Id.* at 179-80, 474 N.E.2d 581-82, 485 N.Y.S.2d 221-22.

109. *Id.* The plaintiff's primary claim was an infringement upon his statutorily protected civil rights under New York law. See *supra* note 45 and accompanying text.

110. The plaintiff alleged that the unauthorized photo was an exploitation of his likeness for trade or advertising without consent or payment. *Stephano*, 64 N.Y.2d at 179-83, 474 N.E.2d at 581-84, 485 N.Y.S.2d at 221-24. The caption read: "Yes Giorgio—From Giorgio Armani. Based on his now classic turn on the bomber jacket, this cotton-twill version with 'fun fur' collar features the same cut at a far lower price—about \$225. It'll be available in the stores next week.—Henry Post Bomber Jacket/Barney's, Bergdorf Goodman, Bloomingdale's." *Id.* at 179, 474 N.E.2d at 582, 485 N.Y.S.2d at 222.

111. *Id.* at 183, 474 N.E.2d at 584, 485 N.Y.S.2d at 224 (citing Prosser, *supra* note 20, at 403 (citations omitted)).

112. *Id.* (footnote omitted). Upon reaching this conclusion, the court of appeals analyzed the case based upon the right to privacy as expressed in sections 50 and 51 of the New York Civil Rights Law. *Stephano v. News Group Publications, Inc.*, 64 N.Y.S.2d 174, 184, 474 N.E.2d 580, 584, 485 N.Y.S.2d 220, 224 (1984). The court explained that the plaintiff could offer no direct proof as to the unauthorized publication being an advertisement rather than a newsworthy item in a regularly featured article discussing trends in merchandise, and therefore reversed the decision and granted summary judgment to the defendant. *Id.* at 184-87, 474 N.E.2d at 584-87, 485 N.Y.S.2d at 224-27.

113. *Id.* at 183 n.2, 474 N.E.2d at 584 n.2, 485 N.Y.S.2d at 224 n.2.

right of privacy.<sup>114</sup> As previously discussed, under the Prosser analysis such a right is a personal right rather than a proprietary right and is extinguished upon death.<sup>115</sup> Therefore, it appears that the right of publicity is not descendible in the state of New York.<sup>116</sup>

Ohio is another state which does not recognize a descendible right of publicity. The film *Raging Bull* was a biographical dramatization of boxer Jake LaMotta. Within the first two minutes of the film, LaMotta's character, played by Robert DeNiro, defeats the character of J.R. Jimmy Reeves, played by Floyd Anderson.<sup>117</sup> Boxing records proved that Reeves was the actual winner of the fight.<sup>118</sup> Reeves' widow and administratrix, Louise, brought suit in behalf of Reeves' estate against the producers, writers, and even DeNiro and Anderson, claiming that they had "misappropriated the name, identity, character, ability and performance of Jimmy Reeves, thereby depriving Reeves' estate of a *property right* and violating Reeves' right of publicity."<sup>119</sup> The court went on to analyze the right of publicity in much the same manner that has been discussed in this article.<sup>120</sup> In its application of Ohio substantive law, the court used the seminal case of *Zacchini v. Scripps-Howard Broadcasting, Co.*,<sup>121</sup> where the Ohio Supreme Court specifically noted that the right of publicity was not a property right but rather a personal right stemming from the right of privacy.<sup>122</sup> The court denied Reeves' estate relief by concluding that the law in Ohio, emphatically stated in *Zacchini I*, recognizes no descendible right of publicity.<sup>123</sup>

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114. *Id.* at 183, 474 N.E.2d at 584, 485 N.Y.S.2d at 224.

115. *See supra* notes 20 and 21 and accompanying text.

116. S. HALPERN, *THE LAW OF DEFAMATION, PRIVACY, PUBLICITY AND "MORAL RIGHTS"* 579 (1988). The court of appeals of New York had a second opportunity to rule upon the descendibility of the right of publicity when *Southeast Bank, N.A. v. Lawrence* came before the court about one year later. As previously discussed, the case was reversed based upon choice of law principles. *See supra* note 104 and accompanying text. However, the court, having decided that Florida law controlled the disposition of the case, stated that they did "not pass upon the question of whether a common-law descendible right of publicity exists in this State [of New York]." *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 911, 912, 489 N.E.2d 744, 745, 498 N.Y.2d 775, 777 (1985).

117. *Reeves v. United Artists*, 572 F. Supp. 1231, 1232 (N.D. Ohio 1983), *aff'd per curiam*, 765 F.2d 79 (6th Cir. 1985).

118. *Reeves*, 572 F. Supp. at 1232.

119. *Id.* (emphasis added).

120. *Id.* at 1233-35.

121. 47 Ohio St. 2d 224, 226, 351 N.E.2d 454, 456 (1976) [hereinafter *Zacchini I*], *rev'd on other grounds*, 433 U.S. 562 (1977) [hereinafter *Zacchini II*].

122. *Reeves*, 572 F. Supp. at 1232 (citing *Zacchini I*, 47 Ohio St. 2d at 226, 351 N.E.2d at 456). The importance of this case is grounded in the constitutional issues which arise in publicity cases. *See infra* notes 264-69 and accompanying text.

123. *Reeves*, 572 F. Supp. at 1235.

### B. *The Elvis Presley Estate*

Probably the most litigious estate concerning matters of publicity rights is that of Elvis Presley. The estate has taken more than twenty-four claims to court regarding publicity licensing rights.<sup>124</sup> Although the estate has grounds for publicity claims literally from coast to coast, the executive director of Graceland, Jack Soden, prefers to strategically choose those court battles which challenge only the most egregious infringements of the entertainer's name and likeness.<sup>125</sup>

One of the early cases, *Factors Etc., Inc. v. Creative Card Co.*,<sup>126</sup> was argued in federal district court in New York shortly after Presley died<sup>127</sup> and well before the *Stephano* decision.<sup>128</sup> Presley had entered into numerous contracts with his exclusive manager, Colonel Tom Parker, as early as March 26, 1956, which gave Parker the merchandising rights to Presley's name and likeness.<sup>129</sup> In January of 1974, Parker, Presley, and a third party formed the corporation, Boxcar Enterprises, Inc., which then acted as the contracting entity for the licensing of the publicity rights.<sup>130</sup> Two days after Presley's death, Boxcar Enterprises, a plaintiff in this action, granted an exclusive licensing right for all merchandise with Presley's name or likeness to Factors Etc., Inc., also a plaintiff in *Factors Etc.*<sup>131</sup> The two plaintiffs sought to enjoin the Creative Card Company from producing or selling any merchandise with Presley's name or likeness, specifically including posters.<sup>132</sup>

Because the conclusive issue was whether the assignment of Presley's publicity rights between Boxcar Enterprises and Factors Etc. was valid, the court examined whether the *inter vivos* assignment

124. Hilburn, *supra* note 5, at 10.

125. *Id.*

126. 444 F. Supp. 279 (S.D.N.Y. 1977).

127. Presley died on Aug. 16, 1977, *id.* at 280, and the decision of this case was rendered Oct. 12, 1977. *Id.* at 279.

128. See *supra* notes 106-116 and accompanying text.

129. 444 F. Supp. at 280-281.

130. *Id.* at 281.

131. *Id.* This three year exclusive licensing contract between Boxcar Enterprises and Factors Etc., with renewal options, apparently lasted until 1983 when Colonel Parker agreed to sever all ties with the Presley estate in a settlement brought on by allegations against Parker contained in a report prepared by a court ordered guardian for Presley's sole (then minor) heir, Lisa Marie. Hilburn, *supra* note 5; see also *supra* note 123 and accompanying text. The allegations against Parker consisted of a breach of duty to Presley and the estate stemming from onerous contractual agreements between Presley and Parker that were still in effect. *Id.*

132. *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 280 (S.D.N.Y. 1977).

survived Presley's death. In the analysis, the court, with reference to similar Second Circuit decisions, proclaimed that there is a recognized assignable and descendible proprietary right of publicity in New York.<sup>133</sup>

Although there was no cited reference to New York case law supporting such a proclamation, the court made an astute observation concerning the use of the Prosser analysis<sup>134</sup> as to the right of publicity. The court reasoned that Prosser's view to the appropriation of one's name and likeness, as viewed under the right of privacy theory, is inappropriate because it fails to take into account situations where the person has already taken financial advantage of his publicity rights and that this "valuable property has more to do with unfair competition than it does with the right to be left alone."<sup>135</sup> Quoting *Zacchini II*, the court added:

The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get for free some aspect of the plaintiff that would have market value and for which he would normally pay.<sup>136</sup>

Following the deduction that the right of publicity is a proprietary descendible right, the court thoroughly discussed the issues of jurisdiction and venue<sup>137</sup> and granted the injunction against Creative Card.<sup>138</sup>

Three years later, the Sixth Circuit, in a particularly acerbic opinion against the Presley interest, denounced the entire idea of a descendible right of publicity and reversed an injunctive order

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133. *Id.* at 282.

134. *See supra* notes 19-21, 111 and accompanying text.

135. *Factors Etc., Inc.*, 444 F. Supp. at 283. This emphasis on situations where the individual realized the financial value of his name or likeness during life appears to be the forebearer of jurisdictions requiring such exploitation during life as a necessary element for a descendible right of publicity upon death. *See supra* notes 25, 51, 87-92 and accompanying text.

136. *Factors Etc., Inc.*, 444 F. Supp. at 283 (quoting *Zacchini II*, 433 U.S. 562, 576 (1977), quoting Kalven, *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

137. *Factors Etc., Inc.*, 444 F. Supp. at 286-88. The critical issue here was venue. Creative Card, an Illinois corporation, argued that they did not meet the minimum contacts requirement needed to trigger the New York long-arm statute (currently codified at N.Y. CIV. PRAC. L. & R. § 302(a)(2) (McKinney Supp. 1989)) as construed in the interpretation of 298 U.S.C. § 1391(a) (1983), which allows a suit to be heard in the venue where the cause of action arose. *Factors Etc., Inc.*, 444 F. Supp. at 286-88. The court explained that because Creative Card sold approximately \$7000 worth of Presley posters in the first eight months of 1977, minimum contacts were established. Additionally, because Creative Card maintained a representative in New York, minimum contacts would probably be established even without the poster sales. *Id.*

Creative Card argued that the case should have been heard in the Northern District Court of Illinois. *Id.* at 288. Based upon the inconsistent decisions between jurisdictions, the defendants probably wished to argue the case in a district that had not addressed the issue of the right of publicity.

138. *Id.*

protecting Presley's likeness.<sup>139</sup> Factors Etc., still acting as the exclusive licensing representative, had received an injunction at the district court level against the Memphis Development Foundation.<sup>140</sup> The nonprofit foundation was planning the construction of a memorial statue in Memphis, Tennessee, featuring Presley's likeness.<sup>141</sup> In order to raise funds for the memorial, the foundation solicited donations. Those people donating in excess of twenty-five dollars to the memorial fund received an eight-inch pewter replica of the proposed memorial statue.<sup>142</sup> Factors Etc.'s lower court injunction would have allowed the memorial to be built, but would have halted the "sale" of the statuettes.<sup>143</sup>

The court recognized that recent cases determined the right of publicity to be a property right, separate and distinct from the personal right of privacy, and that such cases found the right to be descendible.<sup>144</sup> However, the court pointed out that this was a case of first impression for the Tennessee courts, the operative substantive law to be followed by this federal court, and that the Sixth Circuit would have to base its decision upon, among other things, the "policy considerations . . . and certain moral presuppositions concerning death, privacy, inheritability and economic opportunity."<sup>145</sup>

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139. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980). See also *supra* notes 3, 4, 11 and accompanying text.

140. *Memphis Dev. Found.*, 616 F.2d at 957. The district court held that Factors Etc., as assignee of Presley's "right of publicity," did control the exclusive licensing agreement as to Presley's posthumous publicity rights. *Id.*

141. *Id.*

142. *Id.*

143. *Id.*

144. *Id.* at 953.

145. *Id.* The court also addressed practical hypothetical problems that would result by recognizing a descendible right of publicity. *Id.* at 959. Supposedly insurmountable issues such as which persons would be entitled to the protection, length of time given for such protection, and other "judicial line-drawing" considerations were posited. *Id.* However, "[t]he parade of horrors conjured by the Sixth Circuit in *Memphis Development . . . is unreal.*" *Factors IV*, 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting), *cert. denied*, 456 U.S. 927 (1982). Judge Mansfield continued by describing how these problems are easily resolved and outweighed by the policy of observing the descendible publicity rights.

Although Mansfield's opinion is not controlling in *Factors IV*, it is an excellent discussion espousing the policy considerations behind the recognition of the descendible publicity right. The basic theme of his argument is that publicity rights represent the fruits of an individual's investment in the commercial development of the use of his personality. . . . Where the publicity right is developed through commercial investment and exploitation of the individual during his lifetime, it should be treated just the same as any other intangible property right owned by him and be devisable or descendible at death. Further, the public policy of providing incentives for individual enterprise and investment of capi-

Having previously discussed the court's view in this case with regard to the potential future value in a celebrity's right of publicity,<sup>146</sup> it is now necessary to explore this court's views concerning the justice of allowing a celebrity's publicity rights to be uncontrollably exploited. The court stated that:

It seems fairer and more efficient for the commercial, aesthetic, and political use of the name, memory and image of the famous to be open to all rather than to be monopolized by a few. . . . The memory, name and pictures of famous individuals should be regarded as a common asset to be shared, an economic opportunity available in the free market system.<sup>147</sup>

The inference to be drawn from this passage is that the court believes it is fair, given our "political and economic system,"<sup>148</sup> that Lisa Marie Presley, Elvis Presley's sole heir, should lose everything her father built for her, including her home, Graceland,<sup>149</sup> in order to protect unauthorized private vendors in their sale of "everything from a copy of Elvis' death certificate to bottles of 'Elvis Sweat.'"<sup>150</sup> Perhaps the court based its view on the idea that Factors Etc.'s control of commercialization was unnecessary because this, after all, was Elvis Presley. "When Presley's name comes into play: 'Everyone thinks there is no end to the money.'"<sup>151</sup>

Interestingly, in support of its view, the court espoused the view that "[c]ommercialization of . . . [this virtue of leaving a good name to one's children] after death in the hands of [the celebrity's] heirs is contrary to our legal tradition and somehow seems contrary to the moral presuppositions of our culture."<sup>152</sup> Contradicting itself, the court seemed to forget that it was Factors Etc. seeking the injunction *against* Memphis Development Foundation which was in effect commercializing this virtue "after death" by distributing statuettes of Presley to the exclusion of his heirs, violating that "moral presupposition[] of our culture."<sup>153</sup>

Arguably, Presley's entourage is very involved with the exploita-

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tal and energy argues for allowing an individual to pass the fruits of his labors along to others after his death.

*Id.*

146. See *supra* notes 3-4 and accompanying text.

147. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 960 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

148. *Id.*

149. Hilburn, *supra* note 5, at 10. See also *supra* notes 5-7 and accompanying text.

150. Hilburn, *supra* note 5, at 10.

151. *Id.* (quoting Jack Soden, executive director of Graceland).

152. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 959 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

153. *Id.* The Tennessee legislature rejected the Sixth Circuit's reasoning by enacting the Personal Rights Protection Act of 1984, TENN. CODE ANN. §§ 47-25-1101 to -1108 (1988). The Tennessee courts have also expressly disapproved of the descendible right. See *State ex. rel. Elvis Presley Int'l Mem. Found. v. Crowell*, 733 S.W.2d 89, 95 (Tenn. App. 1987).

tion of his name and likeness,<sup>154</sup> but often these types of suits are brought by the heirs to curtail unauthorized or inappropriate usage of their ascendant's name or likeness. In *Hicks v. Casablanca Records*,<sup>155</sup> Agatha Christie's sole legatee sought injunctive relief against the distribution of a motion picture and book that framed the real-life Christie in a fictional situation which cast her in a false light.<sup>156</sup> The plaintiffs in *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.*<sup>157</sup> were trying to curtail the production and distribution of plastic busts of Dr. Martin Luther King, Jr.'s likeness because they considered this to be an "unflattering and unfitting" exploitation.<sup>158</sup> Rudolf Valentino's nephew sued for an injunction and damages from the production of a television film fictionalizing the acting legend's life in a demeaning manner.<sup>159</sup> Tennessee Williams' representative sought an injunction for the removal of the playwright's name from a Broadway theatre because the estate would not be able to maintain quality control over the productions performed there.<sup>160</sup> Similarly, in testimony in support of the New York Celebrity Rights Act,<sup>161</sup> Everett Field, W.C. Fields' grandson, displayed a commercialized poster of the great comedian depicting him in the nude.<sup>162</sup> At the same hearing, John Clark Gable testified that since his "father was the King of Hollywood—people are capitalizing on his name" by means of "demeaning posters, greeting cards and T-shirts."<sup>163</sup>

An excellent example of both the importance of the control of publicity rights and the inconsistency of views between jurisdictions is the six-year legal battle between Factors Etc. and Pro Arts, Inc. *Fac-*

154. Hilburn, *supra* note 5. See *supra* notes 5-7 and accompanying text. There are currently approximately 2,700 licensed "Elvis" items and the sales of such souvenirs were \$750,000 in 1988. *Id.*

155. 464 F. Supp. 426 (S.D.N.Y. 1978).

156. *Id.* at 428-29. See also *supra* notes 52-59 and accompanying text.

157. 694 F.2d 674 (11th Cir. 1983). See also *supra* notes 25 and 58 and accompanying text.

158. 694 F.2d at 683.

159. Guglielmi v. Spelling-Goldberg Prod., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979). See also *supra* note 87 and accompanying text.

160. Southeast Bank, N.A. v. Lawrence, 104 A.D.2d 213, 483 N.Y.S.2d 218 (N.Y. App Div. 1984), *rev'd*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775 (1985). See also *supra* notes 94-105 and 116 and accompanying text.

161. Gordon & Honig, *supra* note 29, at 2; see also *supra* notes 30-32.

162. Gordon & Honig, *supra* note 29, at 2. See also *supra* notes 30-32 and accompanying text.

163. Gordon & Honig, *supra* note 29, at 1-2.



tors Etc., Inc. v. Pro Arts, Inc. (Factors I)<sup>164</sup> was originally decided the day following *Factors Etc., Inc. v. Creative Card Co.*<sup>165</sup> The dispute in *Factors I* also centered around the sale of a Presley poster. On August 19, 1977, three days after Presley's death, Pro Arts published a poster featuring a photo of Presley entitled "IN MEMORY" with the dates "1935-1977" below the photo.<sup>166</sup> Pro Arts did not notify Factors Etc. of the printing until several days after the poster was on the market, at which time Factors Etc. informed Pro Arts that Factors Etc. held the exclusive licensing rights, and that this poster had been manufactured and distributed without consent.<sup>167</sup> However, Pro Arts "beat" Factors Etc. to the courthouse by filing suit in the Northern District of Ohio,<sup>168</sup> Pro Arts' state of incorporation,<sup>169</sup> seeking a declaratory judgment that it had not infringed on the rights of Factors Etc.<sup>170</sup> Upon learning of the suit, Factors Etc. immediately brought suit in the Southern District of New York as a companion suit to *Factors Etc., Inc. v. Creative Card Co.*<sup>171</sup>

Pro Arts argued in *Factors I* that the New York district court lacked jurisdiction over Pro Arts, that venue was improper, and that the case should be transferred to the Northern District of Ohio where the same issue was pending.<sup>172</sup> *Factors I* relied heavily on the decision in *Factors Etc., Inc. v. Creative Card Co.* and determined that jurisdiction and venue were proper on the same grounds.<sup>173</sup> Reasoning that because there was already a similar claim before the court in *Factors Etc., Inc. v. Creative Card Co.*, and that the sole issue in these cases, the exclusive ownership of Presley's publicity rights, was only a small matter in the Ohio dispute, the court also denied venue trans-

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164. *Factors I*, 444 F. Supp. 288 (S.D.N.Y. 1977). See *supra* note 25 and accompanying text.

165. 444 F. Supp. 279 (S.D.N.Y. 1977). *Factors Etc., Inc. v. Creative Card Co.* was decided on October 12, 1977, while *Factors I* was decided on October 13, 1977.

166. *Factors II*, 579 F.2d 215, 217 (2d Cir. 1978). See *supra* note 25 and accompanying text.

167. *Id.*

168. *Id.*

169. *Factors I*, 444 F. Supp. at 290; see *supra* note 25.

170. *Factors II*, 579 F.2d at 217.

171. *Factors I*, 444 F. Supp. 288, 289 (S.D.N.Y. 1977).

172. *Id.* at 289-90.

173. *Id.* at 290-91. See also *supra* note 137 and accompanying text. In *Factors I*, as in *Factors Etc., Inc. v. Creative Card Co.*, jurisdiction was based upon the New York long-arm statute, N.Y. CIV. PRAC. L. & R. § 302(a)(2) (McKinney 1972 & Supp. 1989), which allows jurisdiction over tort causes of action occurring within New York. *Factors I*, 444 F. Supp. at 291.

However, for venue to be properly laid under 28 U.S.C. § 1391(2) (1983), sufficient minimum contacts must be found to conclude that the cause of action arose within New York. *Factors I*, 444 F. Supp. at 291. The court determined that Pro Arts had sold at least \$9000 worth of "Elvis" posters in New York through October 6, 1977, thereby establishing minimum contacts. *Id.* However, regardless of the sales figures, Pro Arts did not dispute that they were doing business in New York. Thus, venue was properly laid under 28 U.S.C. § 1391(c) (1983). *Factors I*, 444 F. Supp. at 291.

fer to the Northern District of Ohio.<sup>174</sup>

Based upon its findings in *Factors Etc., Inc. v. Creative Card Co.*, the court awarded Factors Etc. a preliminary injunction against Pro Arts' sale of the memorial posters as well as any other usage of the Presley name or likeness.<sup>175</sup> This decision was affirmed in *Factors II* without any substantial incident except that the opinion conclusively stated that Factors Etc. would probably prevail on the merits via its exclusive agreement with Boxcar Enterprises<sup>176</sup> because the "right to exploit the Presley name and likeness . . . [was] exercised during Presley's life, [and thus had] survived his death."<sup>177</sup>

Because the result of *Factors I* and *Factors II* was only a preliminary injunction, the parties came before the district court of New York once again to decide the ultimate outcome as to Presley's publicity right in this dispute.<sup>178</sup> However, by the time of this hearing, *Memphis Development Foundation v. Factors Etc., Inc.*<sup>179</sup> had been decided against the descendible right of publicity in Tennessee as interpreted by a federal court.<sup>180</sup> Pro Arts argued that the district court should follow suit.<sup>181</sup> The court reaffirmed the Second Circuit's view as to the descendible right of publicity by restating that "Factors possesses the exclusive right to print and distribute Elvis Presley memorabilia, a right which was validly transferred to it from

174. *Factors I*, 444 F. Supp. at 291-92; see also *supra* note 25. The court also made reference to *Zacchini II*, 433 U.S. 562 (1977), noting that Ohio courts had recognized a "right of publicity." The court determined that the same issue before the New York court would not result in inconsistent holdings. *Factors I*, 444 F. Supp. at 292. But see *supra* notes 121-23 and accompanying text. In *Reeves v. United Artists*, 572 F. Supp. 1231 (N.D. Ohio 1983), *aff'd per curiam*, 765 F.2d 79 (6th Cir. 1985), the district court of Ohio reached the exact opposite result in applying *Zacchini I*. Although reversed on other grounds, *Zacchini I* was still controlling law promulgated by the Ohio Supreme court as to whether the right of publicity, existing as a personal right rather than a property right, thereby extinguished at death. *Reeves*, 572 F. Supp. at 1235.

175. *Factors I*, 444 F. Supp. at 291-92.

176. *Factors II*, 579 F.2d 215, 222 (2d Cir. 1978); see *supra* note 25. See *supra* notes 130-31 and accompanying text concerning the agreement between Boxcar Enterprises and Factors Etc.

177. *Factors II*, 579 F.2d at 222. The court added a footnote stating that the court did not address the issues as to whether the right would have survived without Presley's *inter vivos* exploitation. *Id.* at 222 n.11. Many courts believed that such exploitation was required based upon *Factors II*. For resulting ramifications of this requirement, see *supra* notes 25, 70, 102 and accompanying text.

178. *Factors Etc., Inc. v. Pro Arts, Inc.*, (*Factors III*), 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd* 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); see also *supra* note 80.

179. 616 F.2d 956 (6th Cir. 1980).

180. See *supra* notes 139-151 and accompanying text.

181. *Factors III*, 496 F. Supp. at 1094.

Boxcar following Presley's death.'"<sup>182</sup> The *Factors III* court granted a permanent injunction against Pro Arts as to the posters and any usage of Presley's name or likeness.<sup>183</sup>

In their appeal to the Second Circuit, Pro Arts finally drove their case home to Tennessee with a reversal of Factors Etc.'s injunction in *Factors IV*.<sup>184</sup> *Factors IV* accepted *Factors I, II, and III's* determinations as to the appropriate jurisdiction and venue over Pro Arts via New York's long-arm statute and Pro Arts' minimum contacts, but questioned why none of the courts had addressed the choice of law issue.<sup>185</sup>

Presley was domiciled in Tennessee when he died. Also, Boxcar Enterprises was a Tennessee corporation. In addition, the contractual license agreement concerning Presley's publicity rights between Boxcar Enterprises and Factors Etc. was formed under and governed by Tennessee law. Therefore, the Second Circuit determined that the dispute should be decided according to Tennessee law.<sup>186</sup>

At that time, federal interpretation of Tennessee law still recognized no descendible right of publicity.<sup>187</sup> Judge Newman of the Second Circuit speculated that had he been a Tennessee Supreme Court justice or a judge on the Sixth Circuit when *Memphis Development Foundation v. Factors Etc., Inc.* was decided, he probably would have upheld a descendible right of publicity.<sup>188</sup> Although the Second Circuit noted that federal courts of appeals are not bound to follow decisions rendered in sister circuits,<sup>189</sup> Judge Newman stated that the issue becomes "whether, and under what circumstances, a ruling by a court of appeals, interpreting the common law of a state within its circuit, should be regarded as authoritative by the other federal courts of the nation."<sup>190</sup> The Second Circuit stated that courts of ap-

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182. *Id.* at 1095 (quoting *Factors II*, 579 F.2d 215, 222) (2d Cir. 1978). The court rejected two additional arguments: that Pro Arts owned the copyright to the photo used in the poster; and that a contract with Factors Etc. authorized Pro Arts to manufacture and sell the posters. *Id.* at 1095-1103.

183. *Id.* at 1104.

184. *Factors IV*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982). See also *supra* note 80.

185. *Factors IV*, 652 F.2d at 280.

186. *Id.* at 281. The *Factors IV* court's analysis was used in *Groucho Marx Productions, Inc.*, 689 F.2d 317 (2d Cir. 1982), and resulted in a reversal as well. See *supra* note 81 and accompanying text.

187. See *supra* notes 139-50 and accompanying text.

188. *Factors IV*, 652 F.2d at 282. In his dissent, Judge Mansfield pointed out that if the majority of the panel of three judges "would 'probably uphold a descendible right of publicity, were [they] sitting on the Tennessee Supreme Court' (Maj. Op., p. 282), and the third [judge] would certainly do so, . . . we should so hold rather than retreat behind unsupportable deferential niceties." *Id.* at 286 (Mansfield, J., dissenting).

189. *Id.* at 281 (footnote omitted).

190. *Id.* at 282. Judge Mansfield, however, offers a perceptive insight to Judge Newman's statement of the issue: "Here there was *no interpretation of any Tennessee law* by the Sixth Circuit, only a declaration of what that court thought would be a

peals should not create uncertainty in another circuit's jurisdiction by contradicting another circuit's rulings unless it can be clearly seen that the other circuit court made an erroneous interpretation of the law of the state.<sup>191</sup> Accordingly, the Second Circuit in *Factors IV* reversed the decision and found for Pro Arts, in deference to the Sixth Circuit.<sup>192</sup>

*Factors V*,<sup>193</sup> *VI*,<sup>194</sup> and *VII*,<sup>195</sup> were a series of roller-coaster decisions for each party. Once Pro Arts had received a judgment reversing the injunction against them, they went back to the district court of New York in *Factors V* seeking damages from Factors Etc. for a wrongful injunction.<sup>196</sup> However, Factors Etc. retaliated with a request for a summary judgment, or at least a stay of judgment, based upon another Tennessee case which, decided in the interim between *Factors IV* and *V*, had declared that the right of publicity was descendible.<sup>197</sup> The district court granted Factors Etc.'s stay, allowing them to petition the Second Circuit for a rehearing.<sup>198</sup>

In *Factors VI*, the Second Circuit appraised the situation based upon Tennessee's recent case law regarding the descendible right of publicity in *Commerce Union Bank v. Coors*,<sup>199</sup> and yet another Tennessee decision, *Lancaster v. Factors Etc.*,<sup>200</sup> which was rendered in the interim between *Factors V* and *VI*.<sup>201</sup> The *Lancaster* court ruled

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preferable general common law rule for that state." *Id.* at 284 (Mansfield, J., dissenting) (emphasis in original). The real issue was how much deference does one court of appeals show another, especially where the

Sixth Circuit's decision [in *Memphis Development Foundation v. Factors Etc., Inc.*] in fact in no way depended on existent local law or methods . . . [nor] makes . . . [any] effort, as is sometimes done, to determine what other states the Tennessee courts tend to look to . . . much less to be guided by analogous principles of Tennessee law.

*Id.* at 285 (citations omitted).

191. *Factors IV*, 652 F.2d 278, 282-83 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982).

192. *Id.* at 283.

193. *Factors Etc., Inc. v. Pro Arts, Inc.*, 541 F. Supp. 231 (S.D.N.Y. 1982) [hereinafter *Factors V*], *reh'g denied*, 701 F.2d 11 (2d Cir. 1983).

194. *Factors Etc., Inc. v. Pro Arts, Inc.*, 701 F.2d 11 (2d Cir.) [hereinafter *Factors VI*], *vacated by*, 562 F. Supp. 304 (S.D.N.Y. 1983).

195. *Factors Etc., Inc. v. Pro Arts, Inc.*, 562 F. Supp. 304 (S.D.N.Y. 1983) [hereinafter *Factors VII*].

196. *Factors V*, 541 F. Supp. at 232.

197. *Id.* at 232 (citing *Commerce Union Bank v. Coors of Cumberland, Inc.*, 7 Media L. Rep. 2204 (BNA) (1981)).

198. *Factors V*, 541 F. Supp. at 234.

199. 7 Media L. Rep. 2204 (BNA) (1981).

200. 9 Media L. Rep. 1109 (BNA) (1982).

201. *Factors VI*, 701 F.2d 11, 12 (2d Cir. 1983). *Factors IV* was decided against Factors Etc. on June 29, 1981. *Factors IV*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S.

against a descendible right of publicity.<sup>202</sup> Although the Second Circuit explained that *Commerce Union Bank* and *Lancaster* should be viewed equally, the court took notice that *Lancaster* "may even have a special pertinence since it involves a claim by [Factors Etc.] . . . who are plaintiffs in the instant litigation with respect to a descendible right of publicity concerning Elvis Presley."<sup>203</sup> The Second Circuit claimed that the two Tennessee decisions "afford[] . . . no basis for considering the law of Tennessee to have authoritatively been changed since" its decision in *Factors IV*.<sup>204</sup>

After more than six years of litigation, with enormously vacillating results due to the lack of national standards for a descendible right of publicity, the Factors Etc.-Pro Arts dispute was conclusively resolved in *Factors VII*.<sup>205</sup> The parties returned to the district court of New York to resolve the issue of damages incurred by Pro Arts as the result of a wrongful injunction.<sup>206</sup> Factors Etc. had posted a bond after its first preliminary injunction in *Factors I*.<sup>207</sup> As "damages for wrongful injunction are limited to the amount of the bond,"<sup>208</sup> the defendant's award was not to exceed the amount of the previously posted bond of one hundred thousand dollars.<sup>209</sup>

Although the Presley retinue, despite *Factors I* through *VII*, has had its share of successes,<sup>210</sup> every step into the legal realm of a dif-

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927 (1982). *Commerce Union Bank*, recognizing a descendible right of publicity, was decided on Oct. 2, 1981, *Commerce Union Bank*, 7 Media L. Rep. at 2204. As a result, *Factors V* granted Factors Etc. a judgment stay on May 11, 1982. See *supra* note 198 and accompanying text. *Lancaster*, rejecting a descendible right of publicity, was decided on Nov. 24, 1982. 9 Media L. Rep. at 1109. *Factors VI* was decided on Jan. 12, 1983. *Factors VI*, 701 F.2d at 11.

202. *Factors VI*, 701 F.2d at 12 (citing *Lancaster*, 9 Media L. Rep. 1109 (BNA) (1982)).

203. *Id.*

204. *Id.* (footnote omitted).

205. 562 F. Supp. 304 (S.D.N.Y. 1983).

206. Factors Etc. did not contest a summary judgment in Pro Arts' favor due to the decision in *Factors VI*. *Factors VII*, 562 F. Supp. 304, 306 (S.D.N.Y. 1983).

207. See *supra* notes 164-75 and accompanying text. Factors Etc. did claim that Pro Arts was barred from receiving damages for a wrongful injunction because they had not contested the discharge of the bond after Factors Etc.'s award of a permanent injunction in *Factors III*. *Factors VII*, 562 F. Supp. at 306.

208. *Id.* at 308.

209. *Id.*

210. Another interesting decision is that of *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). The case centered around an Elvis impersonator, Russen, who had appropriated virtually every nuance of Presley's act, and was performing from coast to coast under the title, "The Big El Show." *Id.* at 1348-50. Although the Estate could not enjoin Russen from performing entirely, the suit was successful in severely limiting Russen's use of various paraphernalia and imagery that was recognizably identified with Presley. *Id.* at 1381-82. In its evaluation of a preliminary injunction, the District Court of New Jersey addressed Presley's publicity rights, and concluded that, although not specifically termed the "right of publicity," the New Jersey Supreme Court's decision in *Edison v. Edison Polyform Mfg.*, 73 N.J. Eq. 136, 67 A. 392 (1907), established a proprietary right of publicity. *Estate of Presley*, 513 F.

ferent state or jurisdiction is a gamble. Judge Newman's concern for jurisdictional uncertainty professed in *Factors IV*<sup>211</sup> can only be alleviated by a federal statute setting guidelines and conclusively establishing the elements for a right of publicity claim. As previously mentioned, eight states have promulgated such statutes.<sup>212</sup> Several of these statutes are examined in section IV.

#### IV. STATE STATUTORY RECOGNITION OF A DESCENDIBLE RIGHT OF PUBLICITY

##### A. Virginia

Virginia's statute,<sup>213</sup> a fairly straightforward law, protects both the living and the dead's name and likeness from being used without "written consent" in advertising or trade.<sup>214</sup> A person wishing to use the name or likeness of another for such purposes must obtain consent from the protected individual. If such individual is dead, consent may be obtained from the spouse, any next of kin, or a parent or guardian if the individual is a minor.<sup>215</sup> The statute does not explicitly define who has standing to bring suit, but states that "such persons [who did not consent] may maintain a suit in equity" against the infringing party.<sup>216</sup>

The party bringing suit may seek both injunctive relief and actual damages stemming from the infringement. If the plaintiff can prove a knowing unauthorized appropriation of his name or likeness, he may also recover punitive damages from the defendant.<sup>217</sup> Finally, the statute imposes a statute of limitations in which suit may be brought which is equal to "twenty years after the death of such person."<sup>218</sup>

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Supp. at 1354. The district court added that, in light of such decisions as *Factors Etc., Inc. v. Creative Card Co.*, see *supra* notes 124-136 and accompanying text, such a property right is descendible. *Estate of Presley*, 513 F. Supp. at 1355 (footnote omitted); see also, *Apigram Publishing Co. v. Factors Etc., Inc.*, No. C 78-525 (N.D. Ohio July 30, 1980) (common law right of publicity not preempted by § 301 of the U.S. Copyright Act of 1976).

211. *Factors IV*, 652 F.2d 278, 282-83 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982). See also *supra* note 191 and accompanying text.

212. See *supra* note 29.

213. VA. CODE ANN. § 8.01-40 (Michie 1989).

214. *Id.* § 8.01-40(A).

215. *Id.*

216. *Id.*

217. *Id.*

218. *Id.* § 8.01-40(B).

## B. Kentucky

This statute specifically states that Kentucky recognizes that a person's name or likeness has a commercial value and, therefore, is a property right.<sup>219</sup> Under Kentucky law there is a distinction drawn between the personal right of privacy which is extinguished upon death, and the "right of protection from appropriation from some element of an individual's personality for commercial exploitation, [which] *does not* terminate at death."<sup>220</sup>

Curiously, the second paragraph of the section places limits upon a public figure. This paragraph sets a fifty-year statute of limitations for claims from the public figure's date of death, and requires written consent from the executor or administrator for any usage of the name or likeness of the deceased.<sup>221</sup> The statute is unclear as to whether a nonpublic figure is subject to any of these limitations.

## C. Texas

Similar to Virginia, the Texas statute<sup>222</sup> offers standing to bring suit to a broad group, but in a much more structured format.<sup>223</sup> Listed under the property title of the Texas code, the statute emphatically states that the use of one's "name, voice, signature, photograph, or likeness after the death of the individual" is a property right.<sup>224</sup> In Texas, the individual need not have exploited his name or likeness during his lifetime as the statute protects those whose name or likeness may "have commercial value after that time."<sup>225</sup> The individual can freely transfer, convey, or assess his property right,<sup>226</sup> or the party in interest may do so after the individual's death.<sup>227</sup>

A person claiming ownership under the statute must be either one to whom the interest was transferred during the individual's life, or, in the event of no transfer, the property right vests in the surviving

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219. KY. REV. STAT. ANN. § 391.170 (Michie 1984).

220. *Id.* § 391.170(1) (emphasis added).

221. *Id.* § 391.170(2).

222. TEX. PROP. CODE ANN. § 26.001-26.015 (Vernon Supp. 1989).

223. *See also* FLA. STAT. ANN. § 540.08, which affords standing to the surviving spouse or children to bring suit for the misappropriation of the deceased's name or likeness. FLA. STAT. ANN. § 540.08(c) (West 1988); OKLA. STAT. ANN. tit. 21 §§ 839.1-839.3, which allows "the surviving spouse, personal representatives or a majority of the adult heirs of a deceased person," whose name or likeness has been misappropriated, to seek damages. OKLA. STAT. ANN. tit. 21, § 839.2 (West Supp. 1989). The Oklahoma statute also considers the unauthorized usage of a name or likeness of the living, as well as the dead, as a misdemeanor. *Id.* § 839.1.

224. TEX. PROP. CODE ANN. § 26.002 (Vernon Supp. 1989). Interestingly, the statute is for the protection of a deceased's name and likeness and does not affect the publicity rights of the living. *Id.* § 26.014.

225. *Id.* § 26.003(2).

226. *Id.* § 26.004(a).

227. *Id.* § 26.004(b).

spouses or children and grandchildren. The statute also lays out forced participation percentages based upon the living number of heirs.<sup>228</sup> However, it is the person who owns more than one-half interest that maintains standing to bring suit.<sup>229</sup>

Interestingly, like any property statute, the Texas Code encourages recordation as a manner of preserving one's interest in a deceased's right of publicity. By fulfilling various statutory requirements such as, "name and date of death of the deceased"<sup>230</sup> and a registration fee of twenty-five dollars,<sup>231</sup> the party in standing will thereby have "prima facie evidence of a valid claim to a property right"<sup>232</sup> should it be necessary to bring suit for misappropriation. The encouragement to register is bolstered with a clause which restricts the owner of a publicity right from exercising that right during the first year following the death of the individual *unless* the owner registers ownership.<sup>233</sup>

Although the Texas statute is very thorough, there is a danger of the property right being extinguished one year after death if the deceased did not transfer his publicity right during life and there is no surviving heir as defined by the statute.<sup>234</sup> The statute also only protects the publicity rights of the deceased for fifty years from the date of death.<sup>235</sup> In addition, explicitly permitted uses by the media exist in order to protect the constitutionality of the statute.<sup>236</sup> Finally, damages awarded to the party in interest amount to a statutory minimum of \$2500, with the addition of actual damages if greater than the statutory minimum, profits from the unauthorized usages, punitive damages, and attorney's fees and costs.<sup>237</sup>

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228. *Id.* § 26.005(a), (b).

229. *Id.* § 26.005(c).

230. *Id.* § 26.006(b)(1).

231. *Id.* § 26.006(f).

232. *Id.* § 26.007(a).

233. *Id.* § 26.008(b).

234. *Id.* § 26.010.

235. *Id.* § 26.012(d). Unlike Virginia, Kentucky, Florida, Oklahoma and Texas, which impose a fixed statute of limitations as to the length of time the heirs may bring suit or control exclusive use, Tennessee's statute, TENN. CODE ANN. §§ 47-25-1103 to -1107 (1988), sets the termination where it can be shown that the owner of the publicity rights has not exercised them for two years subsequent to ten years following the death of the individual. TENN. CODE ANN. § 47-25-1104(2). It appears that this was an influence from the Presley estate. See *supra* note 31 and accompanying text.

236. TEX. PROP. CODE ANN. § 26.012(a), (b), (c) (Vernon Supp. 1989).

237. *Id.* § 26.013.



#### D. New York

Currently, New York does not have a statute which protects the descendible right of publicity. However, there has been a bill before the New York Senate for the past two years concerning the issue.<sup>238</sup> The bill serves as an amendment to the previously enacted Civil Rights Law which protects the name and the likeness of the living.<sup>239</sup> Modeled after the current California publicity statute, section 990 of the California Civil Code,<sup>240</sup> the proposed New York bill defines the right of publicity as a property right regardless of whether the right was exploited during life.<sup>241</sup> The amendment provides for free transfer and descendibility of the right and also sets a termination date of fifty years following the death of the individual.<sup>242</sup> The party in interest is ambiguously defined as "the legal representative or successor-in-interest"<sup>243</sup> and provides relief in the form of a statutory minimum of \$750, punitive damages if the misappropriation was done knowingly, as well as attorney's fees and costs.<sup>244</sup>

As in Texas, the proposed New York bill vigorously encourages recordation of ownership by requiring such before the successor-in-interest may recover any damages.<sup>245</sup> The registration similarly will also serve as prima facie evidence of ownership in a suit.<sup>246</sup> If the deceased did not affect an *inter vivos* transfer and there are no surviving heirs, the right of publicity is extinguished upon death.<sup>247</sup>

Although the authors of the proposed bill have taken great strides in preventing any constitutional conflicts, the biggest obstacle in its ratification has been such concerns.<sup>248</sup> The authors implicitly state that "[t]he use of a name, voice, signature, photograph or visual image in any constitutionally protected form of expression shall not constitute a use for which consent is required under this section."<sup>249</sup> The proposed bill continues to state that the person bringing suit must prove that the unauthorized use was clearly for commercial purposes.<sup>250</sup> These provisions, along with a separate clause concerning permitted uses by the media,<sup>251</sup> have been unsuccessful in alleviating the New York Senate's fears of an unconstitutional amendment

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238. S. 5053-A, 1989-1990 Reg. Sess. § 58 (1989) [hereinafter *Celebrity Rights Act*].

239. N.Y. CIV. RIGHTS LAW, §§ 50, 51 (McKinney Supp. 1989).

240. Gordon & Honig, *supra* note 29, at 21.

241. *Celebrity Rights Act*, *supra* note 238, § 58(1).

242. *Id.*

243. *Id.* § 58(2).

244. *Id.*

245. *Id.* § 58(6).

246. *Id.* § 58(6)(c).

247. *Id.* § 58(5).

248. Gordon & Honig, *supra* note 29, at 2.

249. *Celebrity Rights Act*, *supra* note 238, § 58(3)(a).

250. *Id.* § 58(3)(b).

251. *Id.* § 58(7).

to the Civil Rights Law.<sup>252</sup> Consequently, New York, the sight of numerous cases and confusion as to the descendible right of publicity, must continue in the ambiguity of uncertain case law.

### *E. California*

As the California statute<sup>253</sup> is virtually identical to the bill proposed in New York, which was formulated from the California statute,<sup>254</sup> the discussion regarding California does not merit repetition. However, the interesting fact about the California statute is that it was recently tested in a case involving the heirs of John Wayne. *Wayne Enterprises v. The Upstairs Gallery*<sup>255</sup> centered around a series of Andy Warhol silkscreens of the late actor. One of the silkscreens was viewed at The Upstairs Gallery in Los Angeles, and the suit resulted.

The issue in *Wayne Enterprises* was whether the unauthorized prints of John Wayne were protected by the first amendment.<sup>256</sup> Evidently, in an order dated April 20, 1988, Judge Hintz of the Los Angeles Superior Court declared that section 990 of the California Civil Code was per se unconstitutional.<sup>257</sup> The plaintiff justifiably theorized that declaring the statute as unconstitutional "has implications [that go] far beyond the Warhol images. By declaring Civil Code § 990 unconstitutional, the Order threatens to inflict a serious blow to the merchandising and entertainment industries, which depend heavily upon recognition and protection of such rights."<sup>258</sup>

Fortunately, what was perceived as a catastrophic event for the future of descendible publicity rights in California was what seems to be nothing more than an inadvertent error on the part of Judge Hintz. However, the judge was not at fault. The defendants, in their summary motion

incorporated their prior papers, [and] they pulled a fast one and . . . stuck in the bit about unconstitutionality [sic] that was *never* addressed in any papers whatsoever. Now D [defendant] must know the lie but to think that P [plaintiff] didn't catch it is crazy. Strike the order, wherever it is, that was signed 4-

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252. Gordon & Honig, *supra* note 29, at 2.

253. CAL. CIV. CODE § 990 (West Supp. 1990).

254. Gordon & Honig, *supra* note 29, at 22.

255. *Wayne Enter. v. The Upstairs Gallery*, No. C627183 (L.A. Super. Ct. Sept. 8, 1989) (dismissed with prejudice).

256. Plaintiff's Memorandum of Points and Authorities on a motion for reconsideration at 5-11, *Wayne Enter.*, No. C627183.

257. *Id.* at 3-4.

258. *Id.* at 4.

20-88 and make D [defendant] draft a new one.<sup>259</sup>

Although the order was struck,<sup>260</sup> the parties settled out of court and the suit was later dismissed with prejudice.<sup>261</sup> The issue of the constitutionality of section 990 remains open.

## V. CONSTITUTIONAL ISSUES

Many of the cases in the publicity rights area of the law must contend with the inherent conflict between the first and fifth amendments of the Constitution.<sup>262</sup> In resolving the issue, the courts must weigh the equity in protecting a decedent's proprietary publicity rights against the protection of free expression mandated by the first amendment.<sup>263</sup>

The seminal decision in this conflict is *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>264</sup> In the famous case, Zacchini was a circus performer whose specialty was being shot out of a cannon. While performing in Ohio, a reporter from the respondent's television station captured the performance on film after Zacchini had asked him not to film the act.<sup>265</sup> The film of Zacchini's fifteen second performance was later shown on respondent's news program.<sup>266</sup> The Ohio Supreme Court recognized that the plaintiff had a right of publicity, but ruled that the respondent's first amendment privilege in the broadcast of news outweighed the plaintiff's right of publicity.<sup>267</sup>

However, the United State Supreme Court disagreed. Zacchini did not ask for an injunction against the respondent; he merely wanted compensation for the publication of his performance, this being in no conflict with first amendment rights.<sup>268</sup> The Court reversed the Ohio

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259. Judge Hintz's notes of record on June 9, 1988, *Wayne Enter.*, No. C627183 (emphasis in original).

260. Order entered June 14, 1988, *Wayne Enter. v. The Upstairs Gallery*, No. C627183 (L.A. Super. Ct. Sept. 8, 1989) (dismissed with prejudice).

261. *Wayne Enter.*, No. C627183.

262. See, e.g., *Hicks v. Casablanca Records*, 464 F. Supp. 426, 430-33 (S.D.N.Y. 1978) (right of publicity exists and is descendible, but does not attach where the subject matter is of a fictional literary property or motion picture protected by the first amendment); *Groucho Marx Prod., Inc. v. Day & Night Co., Inc.*, 523 F. Supp. 485, 492-94 (S.D.N.Y. 1981) (descendible right of publicity exists, and where the defendant has appropriated the decedent's performance, the first amendment does not protect the forum even if it is a theatrical play), *rev'd on other grounds*, 689 F.2d 317, 318 n.2 (2d Cir. 1982) (stating that regardless of the fact that a descendible right of publicity does not exist in the proper state's law, defendant had a substantial first amendment argument).

263. U.S. CONST. amend. I.

264. 433 U.S. 562 (1977); see also *supra* note 121.

265. 433 U.S. at 563-564.

266. *Id.* at 564.

267. *Id.* at 565 (citing *Zacchini v. Scripps-Howard Broadcasting Co. (Zacchini I)*, 47 Ohio St. 2d 224, 225, 351 N.E.2d 454, 455 (1976)).

268. 433 U.S. at 577-78.

Supreme Court's ruling that denied Zacchini recovery.<sup>269</sup>

This case lays the foundation necessary to propose a theory concerning cases where the protection of the first amendment outweighs injunctive relief in right of publicity cases. The fifth amendment provides that "private property shall not be taken for public use, without just compensation."<sup>270</sup> Accordingly, when a court must succumb to first amendment considerations which mandate that the press and other expressionists have a right to disseminate material which may infringe upon a *proprietary* right of publicity, there should be monetary relief for actual damages in the alternative in those states that recognize it as such. As actual damages are often difficult to determine in this area, statutory damages such as those in the various existing state statutes could be imposed.<sup>271</sup> However, such a statute would probably have to be nationally implemented.

## VI. CONCLUSION

This comment has thoroughly traced the development and the use of the publicity rights cause of action. The intent was to demonstrate the necessity of a federal statute which addresses more specifically a descendible right of publicity.

This proposition is supported by the inconsistency of jurisdictional common law and the federal courts' struggles to determine how state courts will rule if the issue was before them. An additional burden is placed upon these courts and the parties involved when the dispute turns on a first amendment issue. "A national rule on the right of publicity would serve a useful function in resolving the First Amendment and practical economic problems raised by the conflict between publicity rights and free speech."<sup>272</sup>

Congress has the power "[t]o promote the . . . useful Arts, by securing for limited Times to Authors and Inventors exclusive Right to their respective Writings and Discoveries."<sup>273</sup> "[T]he State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment . . . [and] is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the re-

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269. *Id.*

270. U.S. CONST. amend. V.

271. See *supra* notes 238, 245, 255 and accompanying text.

272. Gordon & Honig, *supra* note 29, at 23.

273. U.S. CONST. art 1, § 8, cl. 8.

ward of his endeavors."<sup>274</sup> Drawing such a parallel, as seen in Part IV of this comment, several states have enacted or are working toward such statutes which address the issues. As misappropriation of celebrities' names and likenesses becomes increasingly more profitable, and given the increasing ability of these spurious vendors to compete on a national and even global level, jurisdictional and venue questions will continue to plague this field of law with ambiguity unless there is federal statutory guidance.

J. STEVEN BINGMAN

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274. *Zacchini II*, 433 U.S. 562, 573 (1977).