Protect Your Identity with the Right of Publicity

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Your clients probably understand that if they distribute a copyrighted image without permission, they can be liable for copyright infringement. They no doubt also know that by using another's trademarked name or logo with their own products or services, they can be liable for trademark infringement. What they may not realize, however, is that names, images, or other "indicia of identity" of another person, even if not protected by copyright or trademark, may still be protected under the legal doctrine known as the "right of publicity." If your client were to use such a protected name or image in commerce (to sell or advertise a product, for example), he could be liable for violating the right of publicity of the individual depicted. In most states, the right of publicity is afforded to every person, famous or not.

In three of the most famous right of publicity cases, the courts protected the individuals in circumstances where the advertisers did not use their actual voice, signature, or image.

What is the right of publicity?

In a nutshell, the right of publicity gives an individual the right to prohibit the use of one's name, voice, signature, photograph, likeness, or other forms of identity in connection with sales, advertising, or other commercial activities.[1] Some courts characterize the right of publicity as a property right while others describe it as a personal right.[2]


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The Third Restatement of Unfair Competition defines a right of publicity violation as "using without consent the person's name, likeness, or other indicia of identity for purposes of trade . . . ."[3] States that have codified the right of publicity include Washington,[4] California,[5] and Utah.[6] Both Washington and California's right of publicity statutes define a violation as using that person's name, voice, signature, photograph, or likeness in connection with selling or advertising any products or services without consent.[7] Washington and California also both distinguish between an "individual" (any person) and a "personality" (an individual whose identity "has commercial value").[8] Utah defines a right of publicity violation as an advertisement that implies that the individual approves or endorses the subject matter of the advertisement, when the individual has not consented to such advertisement.[9]

The right of publicity is unique and distinct from its siblings, trademark and copyright (although at times the three overlap).

Comparison of the right of publicity with trademark and copyright

These three types of intellectual property—trademark, copyright, and right of publicity—are similar, but distinct. Trademark law protects a "word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others."[10] Protected marks are those used in commerce.[11] Overlap between trademark and right of publicity can develop in scenarios where a person's name or likeness are used in connection with a commercial activity and thus receive trademark protection.[12] Trademark rights are generally created upon the first commercial use of the mark.[13] Right of publicity typically does not require prior commercial use of one's name or likeness to be established.[14]

A copyright may protect any original work or authorship that is fixed in a tangible medium, such as a written piece, audio recording, or photograph.[15] A copyright exists as soon as the work is created.[16] The person who created the work is the owner of the copyright, unless she created it as a "work for hire," in which case the person or entity that commissioned the work is the copyright owner.[17] Thus, if a photographer took a person's picture, the photographer would own a copyright to the picture. If a third person later wanted to use that picture to sell a product, the third person not only would need to obtain a copyright license from the photographer to avoid liability under copyright law, but additionally would need to receive consent from the subject of the photograph to avoid violating the subject's right of publicity.

Illustrative cases

Courts that have considered the right of publicity have interpreted "indicia of identity" very broadly. In three of the most famous right of publicity cases, the courts protected the individuals in circumstances where the advertisers did not use their actual voice, signature, or image.

Midler v. Ford Motor Co.[18]

Ford Motor Company approached singer/actress Bette Midler about using excerpts of her song *Do You Want to Dance* from her 1973 album *The Divine Miss M*. Midler's manager immediately declined Ford's offer, at which point Ford hired Midler's backup singer Ula Hedwig to imitate Midler. Hedwig was instructed to "sound as much as possible like the Bette Midler record" (but to omit a few "'ahhs' unsuitable for the commercial"). After hearing the commercial, many people though that Midler was the singer in the commercial.[19]

Midler sued for violation of her publicity rights. On appeal, the Ninth Circuit found that voice is a distinctive component of one's identity and held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort . . . ."[20]

Carson v. Here's Johnny Portable Toilets, Inc.[21]

In 1976, a company named "Here's Johnny Portable Toilets, Inc." (the self-proclaimed "World's Foremost Commodian") began renting and selling its "Here's Johnny" portable toilets. The Eastern District of Michigan determined that the right of publicity only applied to "'name or likeness,' and 'Here's Johnny'

did not qualify."[22] On appeal, the Sixth Circuit reversed, holding that the phrase "Here's Johnny" identified Carson and accordingly, Here's Johnny Portable Toilets, Inc. violated Carson's publicity rights even though it did not use his name or likeness.[23]

White v. Samsung Electronics America, Inc.[24]

Samsung Electronics America published an advertisement that depicted a robot version of *Wheel of Fortune*'s Vanna White without her consent.[25] White sued Samsung, alleging a violation of her right of publicity. The Central District of California dismissed White's claims on summary judgment because the ads did not appropriate her "name or likeness."[26]

The Ninth Circuit reversed, holding that the relevant inquiry is *whether* there was an appropriation of the person's identity, not *how* the appropriation was effected.[27] As the Sixth Circuit held in *Carson v. Here's Johnny*, an identity can be misappropriated by different means than simply using a person's name or likeness.[28] Because the Samsung advertisement evoked White's identity (by portraying a robot possessing several of her famous characteristics), it violated her right of publicity.[29]

Right of publicity in Idaho

Courts in Idaho have not yet considered the right of publicity, nor has the state legislature enacted legislation to codify the right of publicity. However, the lack of treatment here does not mean your clients can ignore this doctrine. Of course, they can be haled into court in other jurisdictions that recognize the right of publicity. It is also possible that Idaho courts could apply right of publicity laws from other forums as a result of choice of law provisions or rules.[30]

One *could* expect that Idaho courts might enforce a common law right of publicity here if confronted with the question, based on this trend: courts in every state that have been presented with the issue, save two, have implemented publicity rights. Additionally, the legislatures of the two states where courts declined to recognize a right of publicity, Nebraska and New York, created a statutory right to publicity following each court's refusal to recognize the right.[31]

If (or when) Idaho courts or the state legislature recognize a right of publicity similar to other states, such a law would protect the publicity rights of everybody, from celebrities living in Sun Valley or McCall, to engineers and scientists at INL, to potato farmers throughout the state.

The Ninth Circuit reversed, holding that the relevant inquiry is whether there was an appropriation of the person's identity, not how the appropriation was effected.

Conclusion

Although the concept of right of publicity may overlap somewhat with trademark and copyright law, the right of publicity is a useful doctrine to prevent others from using one's indicia of identity in commerce without consent, even if not covered by trademark or copyright. Courts have held that virtually any identifying characteristic is an "indicium of identity" protectable under the right of publicity. Armed with familiarity of this concept, you can better advise your clients on protecting their own right of publicity and avoiding violations of the right of publicity of others.

About the Author

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Endnotes

[1] *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 837 (Cal. 1979) (right of publicity is "the right of each person to control and profit from the publicity values which he has created or purchased" (citations omitted)); *see also Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

[2] *5* § 46 (1995).

[4] Wash. Rev. Code §§ 63.60.010 *et seq.* (2008).

[5] Cal. Civ. Code § 3344 (2010).

[6] Utah Code §§ 45-3-1 *et seq.* (1999).

[7] Cal. Civ. Code § 3344(a); Wash. Rev. Code § 63.60.050.

[8] Cal. Civ. Code § 3344.1(h); Wash. Rev. Code § 63.60.020. In California, a personality's publicity rights are protected for 70 years after the death of the deceased personality. Cal. Civ. Code § 3344.1(g). In Washington, a personality's publicity rights are protected for 75 years after death while a mere individual's publicity rights are protected for only 10 years. Wash. Rev. Code § 63.60.040.

[9] Utah Code § 45-3-3.

[10] U.S. Patent and Trademark Office (USPTO), Basic Facts About Trademarks, 1 (2010), *available at* http://www.uspto.gov/trademarks/basics/index.jsp (follow "Basic Facts About Trademarks" hyperlink) (last visited April 4, 2011).

[11] *Id.*

[12] *Lugosi v. Universal Pictures*, 25 Cal. 3d at 818 ("The tie-up of one's name, face and/or likeness with a business, product or service creates a tangible and saleable product in much the same way as property may be created by one who organizes under his name a business to build and/or sell houses").

[13] USPTO, Basic Facts About Trademarks, 1.

[14] *E.g.*, Wash. Rev. Code § 63.60.030(2) ("A property right [in the use of his or her name, voice, signature, photograph, or likeness] exists whether or not such rights were commercially exploited").

[15] U.S. Copyright Office, Copyright in General, (2006), http://www.copyright.gov/help/faq/faq-general.html (last visited April 4, 2011).

[16] *Id.*

[17] *E.g., Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (2003).

[18] *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1989)

[19] *Id.* at 461-62.

[20] *Id.* at 463.

[21] *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

[22] *Id.* at 833.

[23] *Id.* at 835-36 ("If the celebrity's identity is commercially exploited, there has been an invasion of his right").

[24] *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (petition for rehearing denied, 989 F.2d 1512 (9th Cir. 1993)).

[25] According to the court, the robot Vanna White did not depict White's "likeness," but it imitated her hair, clothing, jewelry, and her role on *Wheel of Fortune*. *Id*. at 1396.

[26] *Id.* at 1396-7.

[27] *Id.* at 1398.

[28] *Id.*

[29] *Id.* at 1399.

[30] *Love v. Associated Newspapers, Ltd.*, 611 F. 3d 601, 609-11 (9th Cir. 2010) (applying choice of law analysis to determine which forum's right of publicity doctrine should apply).

[31] Neb. Rev. St. § 20-202 (2010); N.Y. Civ. Rights § 50 (2011).