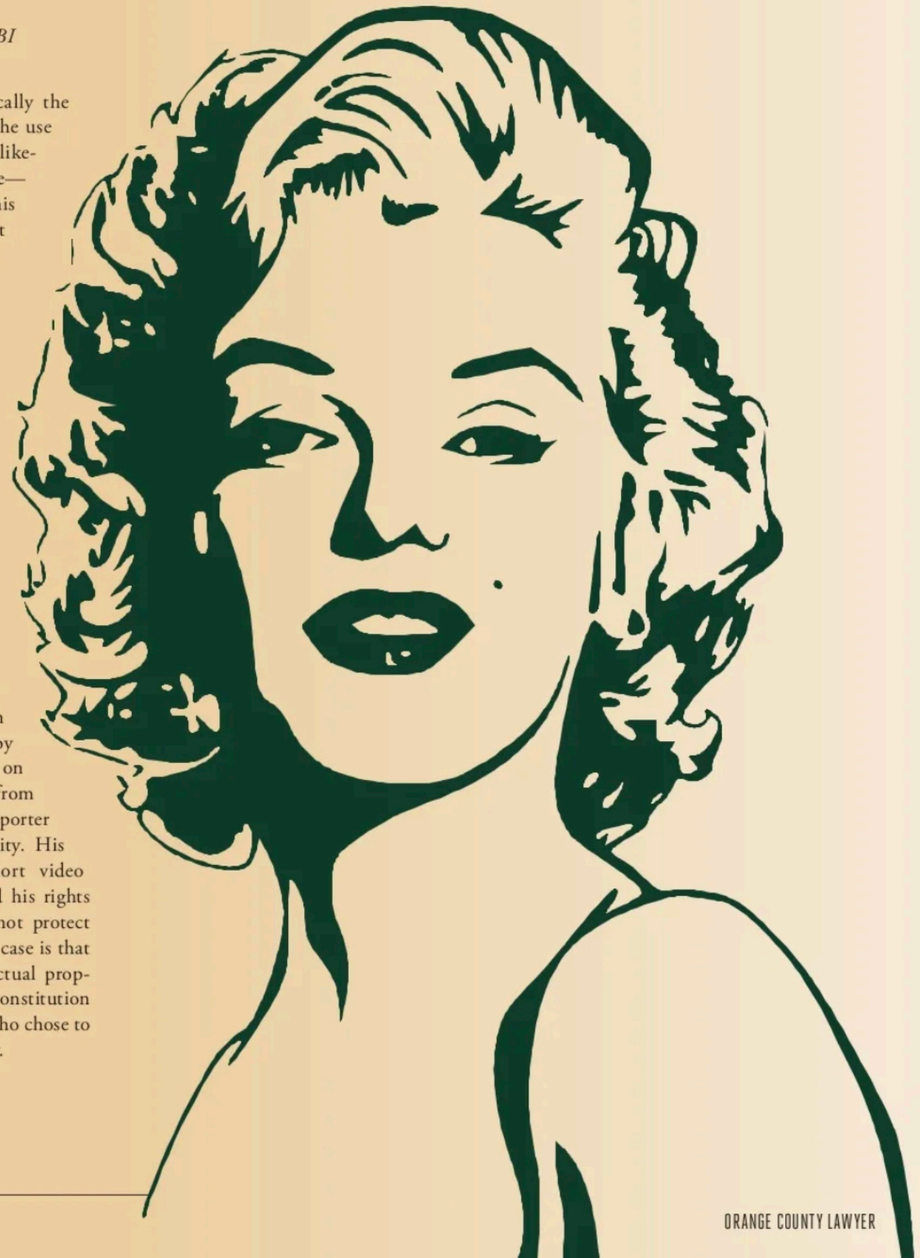
SHOULD THERE BE A NATIONAL RIGHT OF PUBLICITY LAW?

by PETER R. AFRASIABI



The right of publicity is basically the right of a person to control the use of one's identity—be it name, likeness, voice, photo, or signature—in advertising and commerce. This right of publicity takes root, if at all, in state common and codified laws that seek to redress offenses to individuals that cause pain and injury. In California, the right was codified in 1972 in Section 3344 of the Civil Code. In the late 1970s, the United States Supreme Court took a case that involved an Ohio right of publicity claim involving the human cannonball. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 564–65 (1977). There, the Court found that the First and Fourteenth Amendments of the United States Constitution did not prevent the petitioner, a performer whose entire live "human cannonball" act was recorded by a reporter and later broadcast on television without his consent, from bringing a claim against the reporter based on Ohio's right of publicity. His persona—his act—was that short video sequence, so showing it abridged his rights and the First Amendment did not protect the news provider. The net of the case is that state laws protecting this intellectual property right were lawful and the Constitution offered little protection to those who chose to usurp another's rights of publicity.

Currently, thirty-five states recognize a version of the right of publicity, and twenty-two of those allow it to be freely transferred or descended. But state laws vary drastically both as to the scope and nature of the right, what constitutes infringement, the defenses to the right, and—in the case of celebrities (or people who otherwise commercially exploited their right of publicity in their lifetime)—the extent to which there is a post-mortem right of publicity.

Discord Among States: Marilyn Monroe Versus James Dean

Perhaps the best example of the discord in state laws and the dramatic impact that results is seen in comparing the situation of Marilyn Monroe and James Dean. Both were icons of Hollywood who died young. And both have names and personas that have the potential for great economic exploitation to this day. But the locus of their death determines whether or not their heirs have an asset.

Marilyn Monroe died in New York which, until 2021, had no post-mortem right of publicity law. That meant her estate literally had no such state right, even to be acquired through probate or the estate process. In *Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, 692 F.3d 983 (9th Cir. 2012), after years of protracted litigation by the successor entity to Marilyn Monroe's estate that claimed to own her right of publicity, the federal courts finally addressed the existence of the claimed right. And the Ninth Circuit held that the estate had no such right to even exploit because she died in New York: "Because no right of publicity existed in New York in 1962, Monroe's right of publicity was extinguished at her death, and did not become a part of her estate." *Id.* at 993 & n.12.

The Ninth Circuit concluded, poignantly, by quoting Marilyn Monroe herself on this issue of who could own her: "We observe that the lengthy dispute over the exploitation of Marilyn Monroe's persona has ended in exactly the way that Monroe herself predicted more than fifty years ago: 'I knew I belonged to the public and to the world, not because I was talented or even beautiful but because I had never belonged to anything or anyone else.'" *Id.* at 1000.

On the other hand, James Dean died in California. And California law recognizes a post-mortem right of publicity for the Estate of James Dean, a right that today lasts seventy years past his death in 1955. Cal. Civil Code. § 3344.1. Thus, the state in which a celebrity dies determines whether that celebrity's persona belongs to their heirs or the public domain.

Beyond that, states vary in how long the right lasts post-mortem, ranging from forty years in Florida to 100 years in Indiana. *Compare* Ind. Code § 32-36-1-1 *with* Fla. Stat. § 540.08. States differ even on the substantive scope of what is protected, with Indiana protecting the extremely broad concept of a "personality" (Ind. Code §§ 32-36-1-6) and other states more narrowly limited to name, likeness, signature, or voice (Cal. Civ. Code § 3344) or even just name and likeness (Wisconsin Stat. § 995.50(2)). States also differ on the scope of fair use defenses, with California adopting a transformative fair use defense that looks to whether a defendant has added significant expression itself instead of literal copies and Missouri instead looking to the intent of the defendant. *Compare Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 405-07 (2001) *with Doe v. TCI Cablevision*, 110 S.W.3d 363, 370–72, 373–74 (Mo. 2003). Some states offer treble damages, statutory damages, punitive dam-

ages, and/or attorney's fees, and some only compensatory damages. *Compare* Ariz. Rev. Stat. § 12-761(c) *with Doe v. TCI Cablevision,* 110 S.W.3d 363 (Mo. 2003). Some states even purport to grant rights to those who died elsewhere, even when they never had a connection to the state. *See* Ind. Code § 32-36-1-1(a) (Indiana provides a right of publicity regardless of domicile, citizenship, or residency).

In Marilyn Monroe's case, the California legislature specifically enacted a law to make California's right of publicity applicable to her estate to address the ruling that the estate had no rights given New York law. *See* Cal. Civ. Code § 3344.1(o) & (p), amended by S.B. 771 in 2007. The *Marilyn Monroe* court denied the estate the use of that law on judicial estoppel grounds, but it leaves open the question of whether a state can provide such broad rights for future cases. 692 F.3d at 995-1000. Some judges have found such broad state rules—for example, where one state passes intellectual property laws that may prejudice the interests of other states—violative of the dormant commerce clause. *See White v. Samsung Elecs. Am., Inc.,* 989 F.2d 1512 (9th Cir. 1993) (dissent from denial of rehearing); *Goldstein v. California*, 412 U.S. 546, 558 (1973) ("state intellectual property laws can stand only so long as they don't 'prejudice the interests of other States.'").

All of this yields one conclusion: uncertainty. For businesses and content creators wanting to build and create from the stock of society, all of this inexorably leads to massive confusion as to what one may or may not do in advertising and commercial activities depending upon whether their behavior somehow touches a given state. And in today's age, most commercial activities involve the use of a website to advertise and sell products and services, a medium of nationwide reach.

Concerning litigation, this also leads to forum shopping for a plaintiff to find the best forum to drag a defendant into given varying liability standards, fair use standards, and the remedies available.

Discord Between State and Federal Law: Nancy Sinatra Versus Bette Midler

In light of the federal Lanham Act and its potential for rights that last forever, perhaps all is not lost for Marilyn Monroe's heirs nor for James Dean's heirs in 2025 at seventy years past his death. The Lanham Act generally prohibits the use of marks or symbols, or false or misleading statements of fact or designations of origin, in commerce that are likely to cause confusion as to affiliation or endorsement. 15 U.S.C. § 1125(a). And the Monroe Estate has claimed federal trademark rights in her name and signature. Courts have affirmed the existence of those specific rights as well as the use of the Lanham Act to address certain aspects of rights that we may otherwise consider ensconced within the traditional right of publicity. Thus, in *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC,* 364 F. Supp. 3d 291 (S.D.N.Y. 2019), the court held that even if no right of publicity existed at her death, the Lanham Act existed and so Ms. Monroe had some set of federally protectible trademark rights to her name, signature, prevention of false endorsement, and the like, and those were properly descendible. *Id.* at 306-09.

> [A]side from the state versus state discordance, there is even discord between what can be protected state-wise and federal-wise.

However, the Lanham Act is a crude instrument to skin the right of publicity issue, an instrument that requires very different factual showings and settings to find liability, and which is not centrally built around addressing the right of a person to control their identity. Instead, it is generally built around prohibitions on trademark infringements that are likely to cause consumer confusion. 15 U.S.C. § 1125(a). From this, if a person's name is used in commerce to advertise a product without consent, one can distill a false endorsement claim under Section 1125. But these claims can require complicated showings of secondary meaning—namely, that consumers associate the estate's mark of "Marilyn" with, say, cosmetics—and consumer confusion as tested by a complex, expert-driven, multi-factor test between the plaintiff and defendant's uses, none of which is required when one is centrally focused in state right of publicity law.

One way to look at how similar fact patterns can fare differently under state right of publicity law and the federal Lanham Act is to look at the appropriation of a celebrity's voice, which brings us to Nancy Sinatra and Bette Midler. In *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712 (9th Cir. 1970), Goodyear Tire made a commercial with an unseen female singer and women in high boots and "mod" clothing evocative of Sinatra's recorded performances of the song that she had famously performed, "These Boots Are Made for Walkin'." Goodyear secured a license to use the song for its commercial from the copyright owner (which was not Sinatra, who instead was the performer who popularized the song). Sinatra alleged a federal trademark claim, arguing that the song and the arrangement had acquired "a secondary meaning" that was protectible; i.e., the song itself functioned as a trademark indicative of her such that any use always connoted her. Moreover, she alleged that Goodyear had tried to have her perform the song for their commercial, but she had refused. However, the Ninth Circuit rejected such an expansive use of the Lanham Act to protect her voice or likeness as associated with the song because to give federal trademark rights would clash with copyright law where Goodyear had rights to use the song and because it was not viable to allege that a song had acquired secondary meaning to its performer. *Id.* at 717-18.

On nearly identical facts, Bette Midler fared better under state right of publicity law that required no such showings. In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), Ford created an ad campaign meant to inspire nostalgic sentiments through the use of famous songs from the 1970s. Midler was asked to sing "Do You Want to Dance" from one of her albums; she refused. Subsequently, the company hired a voice-impersonator of Midler and, as in the Sinatra situation, secured a proper license from the music's copyright owner before using the song with the voice-impersonator for the commercial. Ford did not use Midler's name or image in the commercial, only what sounded like her voice. Seeking to avoid *Sinatra*, no doubt, Midler filed a state right of publicity suit (in federal court based on diversity jurisdiction). And the Ninth Circuit faulted Ford:

> Why did the defendants ask Midler to sing if her voice was not of value to them? Why did they studiously acquire the services of a sound-alike and instruct her to imitate Midler if Midler's voice was not of value to them? What they sought was an attribute of Midler's identity. Its value was what the market would have paid for Midler to have sung the commercial in person . . . the human voice is one of the most palpable ways identity is manifested.

Id. at 463. From there, the court 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 in California." *Id.*

Thus, aside from the state versus state discordance, there is even discord between what can be protected state-wise and federal-wise.

Uniform Standards in the Technology Age

The other four branches of intellectual property law all have national standards. Copyright and patent law are exclusively federal in nature; trademark and trade secret are concurrently federal and state. It's time that the fifth area of intellectual property—the one closest to a person's identity—find a uniform set of national standards. These standards are needed to protect the owners of the right along with third parties so they may know the clear boundaries of what they may and may not use in commerce. The sheer uncertainty created by the patchwork of different state standards, and the forum shopping issues attendant to that, have created a morass of confusion and uncertainty as to what is legal and what is not, the very uncertainty the law should strive to avoid.

Beyond the patchwork of different legal rules across jurisdictions, technology is also a massive driver of the need for a uniform set of rules. For example, new technologies that allow deepfake videos of people or voices, which technologies are employed on the internet or in augmented or virtual reality, will require courts with nationwide reach to address when misused. Thus, if you Google "Tom Cruise deepfake," you will see funny videos on YouTube of what looks and sounds like Tom Cruise hamming it up, yet it's not him. And in the case of Val Kilmer, who lost his voice due to throat cancer, there is now sound technology that has enabled, through software, to recreate his voice such that, quite literally, you'd think it's the Iceman himself talking to you. For that, check out Sonantic's technology and a YouTube audio log of Val Kilmer speaking again. These technologies, of course, can quickly cascade to improper infringement cases: imagine the business benefits attendant to a video of Morgan Freeman proclaiming, "This is the best [law firm] [car] [you pick] I have ever seen."

Worse yet, there is the case of deepfake or revenge pornography applications designed to cause profound damage to others in what is at root their rights of publicity and privacy. This technology is already employed, and it is well-documented in terms of the damage. Recently, in codifying a dead celebrity right of publicity, New York specifically created causes of action to address these very technology abuses society now confronts, and its law serves as a good blueprint for Congress in this technology age. *See* New York Civ. Rights Law § 50-f(2). These deepfake uses, and the damage therefrom, amplify across subject matter when one ponders what we may "see" Dr. Fauci, Tucker Carlson, Kamala Harris, local politicians, celebrities, school board members, our kids, or even you or your adversary, allegedly saying or doing in future deepfake video releases. The means to combat these growing issues emanating from the rapidly evolving technologies that can impinge upon one's right to control one's own likeness and identity is centrally the right of publicity, not a weak bending of trademark law. (Beyond the above, in other technology areas, advances have led to a growing worldwide business of highly realistic adult sex dolls which, in time, will of course see theft of any given person's or celebrity's likeness).

What may have started over a century ago as a localized right relating to emotional harm and injury from misuse has morphed into a powerful and important economic right that, now, with modern technology advances, has come full circle to one that also encapsulates deep personal harm and damage from misuse. The need for national standards to protect this fifth aspect of intellectual property law is here and now.

Peter R. Afrasiabi *is an intellectual property litigator at One LLP and has litigated right of publicity cases in different state and federal courts. He can be reached at pafrasiabi@onellp.com.*