

**CAN THE LANHAM ACT PROTECT TIGER WOODS?
AN ANALYSIS OF WHETHER
THE LANHAM ACT IS A PROPER SUBSTITUTE
FOR A FEDERAL RIGHT OF PUBLICITY**

*By Barbara A. Solomon**

I. INTRODUCTION

Marketers of everything from golf balls to gourmet popcorn and beer to beauty products seek celebrity endorsements and they pay handsomely for them. Indeed, it has been reported that approximately 20% of all television advertising features a well-known individual from the world of sports, television, movies or music.¹ Cellular provider T-Mobile paid \$20 million to actress Catherine Zeta-Jones to endorse its phone service, while Pepsi has paid singer Beyoncé Knowles and Nike has paid golfer Tiger Woods tens of millions of dollars to endorse their products. Death does not bring an end to the ability of a celebrity to endorse a product. *Forbes* magazine has for the last four years put out a list of the top-earning dead celebrities. Marilyn Monroe's image has been used to promote VISA, VOLKSWAGEN and other products and services resulting in earnings of \$8 million to her estate and making her the sixth top earning dead celebrity for 2004.

But when a celebrity's likeness is appropriated for commercial purposes without payment, what legal recourse does the celebrity have? It is surprising, given our celebrity-obsessed culture, that there is no effective means for a celebrity (or anyone else) to obtain nationwide or uniform protection against the misappropriation of one's likeness.

While the majority of U.S. states recognize a statutory or common law right of publicity to protect against the appropriation of one's likeness for commercial purposes, the laws provide, at best, patchwork relief. What may violate the right of publicity statute in one state may be lawful in a neighboring state. Indeed, there are significant differences in state laws recognizing the right

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1. 1999 Illinois State University study cited in Matt Schiering, *Celebrity Endorsements; Red Carpet Branding*, Brandweek, Sept. 15, 2003.

of publicity, including: (1) what is covered by the right of publicity;² (2) whether the right is descendible or survivable; (3) how long the right lasts if it does survive death; (4) who can exercise the right of publicity; (5) whether the persona sought to be protected has to have acquired fame before a claim can be brought; and (6) whether the right of publicity extends to non-domiciliaries of the state. As a result, no one state's right of publicity law can provide national protection.³

Recognizing these issues, the Intellectual Property Law Section of the American Bar Association (ABA) has proposed federal legislation to protect an individual's right of publicity to the extent the individual's identity is used in commerce for commercial purposes. The proposed law would prospectively preempt inconsistent state laws. This proposal has not yet been adopted by the ABA as a whole, however, and federal legislation appears far off.⁴ In the absence of a federally protected right of publicity, many plaintiffs have turned, usually unsuccessfully, to the Lanham Act and, specifically, to claims for unfair competition and false endorsement to protect against the unauthorized use of their likenesses. As discussed below, the Lanham Act cannot fill the role of a federal right of publicity making many of the arguments against a federal right of publicity simply unfounded.

II. SUMMARY

Although the Lanham Act was not originally enacted to protect the property right in one's personal likeness or image, it is commonly invoked for this purpose. However, the Lanham Act imposes significant hurdles to those athletes, celebrities, actors and others who turn to its provisions to redress claims for the commercial misappropriation of their likenesses. Should this come as a surprise? No. The Lanham Act was designed to protect interests different from those protected by state laws governing the misappropriation of one's name, likeness or persona. Yet surprisingly enough, organizations that have opposed a federal right of publicity have done so in part on the grounds that the Lanham Act provides sufficient relief. This article explores the differences between the rights protected by the Lanham Act and the right of publicity, the attempts made to enact a right of

2. For example, misappropriation of one's voice is included in only a handful of state's laws, namely, California, Indiana, Nevada, Oklahoma, Texas and New York.

3. In *BMW v. Gore*, 517 U.S. 599 (1996) the U.S. Supreme Court held that a state may not use its laws to prohibit conduct that may be lawful in other states, or to induce a defendant to change its nationwide policies. *Id.* at 572-73.

4. The effort to enact such a cause of action by amending the Lanham Act is discussed in Section III.B., *infra*.

publicity and challenges the two main objections to a federal right of publicity, namely that the Lanham Act provides sufficient protection and that a federal right of publicity will somehow intrude on the First Amendment in a way that the Lanham Act does not.

III. LIMITS ON THE RIGHT OF PUBLICITY AND THE LANHAM ACT TO PROTECT ONE'S LIKENESS

A. Comparison of Right of Publicity and the Lanham Act

The right of publicity and the protections of the Lanham Act are rooted in different histories, are addressed to different conduct and are meant to protect different interests.

1. Right of Publicity

State claims for violation of the right of publicity are derived from the common law tort of invasion of the right of privacy. The origin of the privacy tort is an 1890 article in the *Harvard Law Review* by Samuel Warren and Louis Brandeis, which summarized pre-existing case law that touched on privacy rights. The privacy tort appears to have been first adopted by the Georgia Supreme Court in 1905 in *Pavesich v. New England Life Insurance Co.*⁵ Early cases define privacy torts generally as “the right to be let alone,”⁶ which right encompassed appropriation of the plaintiff's name or likeness for the defendant's advantage, intrusion, disclosure of private facts and false light. Some states have since adopted all of these classifications, making each a separate tort; others have not.⁷

The right of publicity branch of the privacy tort separated itself from the other privacy claims in 1953 when the United States Court of Appeals for the Second Circuit coined the term “right of publicity.” In considering claims arising out of a baseball player's grant of rights to two different chewing gum companies to use his photograph to promote their product, the court rejected the argument that a person's right of privacy is limited to “a personal and non-assignable right not to have his feelings hurt by” the publication of his picture and recognized as an independent right

5. 122 Ga. 190 (1905). See *Restatement (Second) of Torts*, § 652A, comment a (1977).

6. *Restatement (Second) of Torts*, § 652A, comment a (1977).

7. *Id.* § 652A.

“a right of publicity.”⁸ As the court held, such a right protects the economic value of one’s name or likeness.

Some version of the right of publicity is recognized in 42 states; by statute in 18 states⁹ and by common law in 35 states (of which 11 also have statutes).¹⁰ The gist of a claim for misappropriation of right of publicity, whether under statute or at common law, is that it is improper to make unauthorized use of another’s name or likeness for one’s own use or benefit. The right of publicity protects an individual from having his or her name or likeness commercially exploited and protects the economic value or drawing power of one’s persona.¹¹ The purpose of the right of publicity is to prevent a third party from taking some aspect of a person that has market value and for which the third party would normally have to pay.¹²

The right of publicity is not absolute. Among the most notable exceptions to the cause of action are incidental use of a name or likeness, the use of a name or likeness for matters of legitimate public interest or concern, or other uses that would be protected by the First Amendment. *See* Section III.E., *infra*. Further limitations on the right of publicity have been created through state statutes

8. *Haelan Laboratories v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

9. California, Florida, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington, Wisconsin.

10. Alabama, Alaska, Arizona, Arkansas, California, Colorado, Connecticut, Delaware, Florida, Georgia, Hawaii, Illinois, Indiana, Kansas, Louisiana, Maine, Maryland, Michigan, Minnesota, Mississippi, Missouri, Nevada, New Jersey, New Mexico, North Carolina, Ohio, Oklahoma, Pennsylvania, South Carolina, Tennessee, Texas, Utah, Vermont, West Virginia, Wisconsin. Some states, such as California, Florida, Illinois, Indiana, Nevada, Ohio, Oklahoma, Tennessee, Texas, Utah and Wisconsin recognize the right of publicity both under statute and in common law. Other states recognize the claim under common law only and a few recognize it by statute only, specifically Massachusetts, Nebraska, New York, Rhode Island, Virginia, Washington. The remaining states have neither statute nor case law. These states include Iowa, Oregon, South Dakota and Wyoming.

11. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 106 Cal. Rptr. 2d 126, (2001), *cert. denied*, 534 U.S. 1078 (2002). A prerequisite for a claim of right of publicity is that the person’s name or likeness was actually used. In *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40 (N.D. Ill. 1996), plaintiff asserted that his likeness was used without permission in a home version of a video game. The court rejected the right of publicity claim on the ground that plaintiff’s likeness had been extensively altered prior to being incorporated into the game and was thus not recognizable. Further, the court rejected plaintiff’s claim that his right of publicity was invaded by defendant’s use of a character that was allegedly based on the plaintiff. The court noted that to prevail, the plaintiff would have had to show that his identity was inextricably intertwined in the public mind with the cartoon character, a showing that was not made. *See also DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30, 52-53 (E.D.N.Y. 1994) (rejecting claim of right of publicity where no reasonable jury could find that the plaintiff’s public personality as the Karate Kid was so notorious that the public identified plaintiff exclusively with this persona).

12. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1997).

that may address everything from what may be appropriated (*e.g.*, voice) to who may assert a claim, to the nature of permissible or prohibited uses.¹³

2. Lanham Act

Whereas the right of publicity protects the pecuniary right and interest in the commercial exploitation of one's identity,¹⁴ the Lanham Act was enacted primarily to protect consumers from misrepresentations or deceptions and to protect trademark owners from the misperception that they are associated with or endorse a product.¹⁵ The Lanham Act's goal is not to protect "the person or entity that originated the ideas or communications that 'goods' embody or contain."¹⁶ Over the years, through amendments to the Lanham Act and court interpretations, the scope and protection of the Lanham Act has expanded to cover more general notions of unfair competition and false advertising. Yet the gist of a Lanham Act claim requires consumer perception that the plaintiff is somehow associated with, sponsors or endorses defendant's goods or services.

Notwithstanding the fact that the right of publicity and the Lanham Act address different interests, plaintiffs often try to use Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and, specifically, claims for false endorsement and unfair competition, as a substitute for a federal right of publicity claim. Such efforts have not met with great success. Claims under the Lanham Act, unlike claims for violation of the right of publicity, face barriers that include the statutory fair use defense (15 U.S.C. § 1115(b)(4)), the judicially created nominative fair use defense, lack of likelihood of confusion and lack of protectable rights. For this reason, as noted by one court, "[a]lthough publicity rights are

13. For example, the Ohio state statute has a limitation for commercial uses. *See* Ohio Revised Code § 2741.02 (prohibiting use of an individual's persona "for a commercial purpose"). However, Ohio common law recognizes a claim even if the defendant's use of plaintiff's name or likeness is not commercial. *See Zacchini v. Scripps-Howard Broad. Co.*, 47 Ohio St. 2d 224 (Ohio 1976), *reversed on other grounds*, 433 U.S. 562 (1977).

14. *Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc.*, 270 F.3d 298, 325 (6th Cir. 2001). The right created by the publicity prong of the right of privacy tort "is in the nature of a property right. . . ." *Restatement (Second) of Torts*, § 652C, comment a (1977).

15. *Mattel Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003). The legislative history of the Lanham Act makes clear that there is a "sound public policy" in the protection of trademarks, which is the same as the "protection of good will, to prevent diversion of trade through misrepresentation, and the protection of the public against deception. . . ." S. Res. No. 1333, 79th Cong. 2d Sess. (1946), U.S.C.C.A.N. 1277.

16. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32-38 (2003) (holding that the phrase "origin of goods" in Lanham Act Section 43(a) does not require attribution to authors).

related to laws preventing false endorsement, they offer substantially broader protection.”¹⁷

There are some celebrities who have been able to successfully use the Lanham Act to redress what were essentially right of publicity claims.¹⁸ For instance:

- Jesse Jackson obtained relief against a company that sold a video tape of his address to the 1988 Democratic National Convention in packaging that bore his name and likeness on the grounds that the public might believe that the tapes were approved or produced by him.¹⁹
- Woody Allen stopped the use of look-alikes in ads for a video club.²⁰
- The cellist Mstislav Rostropovich defeated a motion for summary judgment to dismiss his claim that the use of his likeness on CDs featuring his early performances would cause consumers to believe he had endorsed the CDs.²¹

Whether protection will be granted is uncertain, however, and many celebrities have not been on the winning side. For instance:

- Tiger Woods was unable to use the Lanham Act to stop distribution of limited edition prints featuring his image.²²
- Bobby Seale was unable to prevent the use of his likeness in a brochure accompanying a CD soundtrack to the film “Panther.”²³

17. *Cardtoons v. Major League Baseball Players*, 95 F.3d 959, 967 (10th Cir. 1996), *cert. denied*, 531 U.S. 873 (2000); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1515 (9th Cir. 1993) (the right of publicity “is not aimed at or limited to false endorsements . . . ; that’s what the Lanham Act is for”) (Kozinski on dissent).

18. One need not be a celebrity to pursue a claim under state right of publicity laws. However, to pursue claims under the Lanham Act, fame is needed and thus the focus on celebrity cases in this article. *See, e.g., Albert v. Apex Fitness Inc.*, 44 U.S.P.Q.2d 1855 (S.D.N.Y. 1997) (non-celebrity model could not recover under Lanham Act when photograph of model was used in advertisement without permission); *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40 (N.D. Ill. 1996) (to succeed on a false endorsement claim, plaintiff must be a “celebrity” or have public recognition); *Newton v. Thomason*, 22 F.3d 1455 (9th Cir. 1994) (recognized but not widely-known country and western singer had no claim under the Lanham Act against producers of television series “Evening Shade,” which had a character with singer’s name).

19. *Jackson v. MPI Home Video*, 694 F. Supp. 483 (N.D. Ill. 1988).

20. *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985).

21. *Rostropovich v. Koch Int’l Corp.*, 34 U.S.P.Q.2d 1609 (S.D.N.Y. 1995), *reh’g denied*, 36 U.S.P.Q.2d (S.D.N.Y. 1985).

22. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003), *reh’g en banc denied*, 2003 U.S. App. LEXIS 19044 (Sept. 8, 2003).

23. *Seale v. Gramercy Pictures*, 964 F. Supp. 918 (E.D. Pa. 1997), *aff’d*, 156 F.3d 1225 (3d Cir. 1998).

- Babe Ruth's daughters were unable to prevent depictions of the Babe in a baseball calendar.²⁴
- The heirs of Diana Princess of Wales were unable to prevent the use of her likeness on plates and other commercial products.²⁵

B. Attempts to Enact a Federal Right of Publicity Statute

Given the difficulties faced by plaintiffs who have tried to apply the Lanham Act to right of publicity cases and the lack of uniformity of state right of publicity laws, several major legal organizations and associations, including the International Trademark Association (INTA) and the American Bar Association (ABA), and leading commentators, including Professor Thomas McCarthy, have urged the adoption of a federal right of publicity statute. The ABA has adopted the most developed proposed legislation in the form of a series of proposed amendments to the Lanham Act.

The push for a federal right of publicity goes back to at least 1994, when the Board of Directors of INTA undertook to examine whether the Lanham Act should be amended to address the right of publicity. On March 3, 1998, the Right of Publicity Subcommittee of the Issues and Policy Committee of INTA requested that INTA's Board of Directors adopt a resolution calling for the introduction of legislation in the U.S. Congress to create a federal right of publicity that would preempt all state and common law. The proposed statute would have been descendible and transferable for a fixed term after death, and would have exempted from liability uses that constituted fair use, that were protected under the First Amendment or that were otherwise uses in connection with news, biography, history, fiction, commentary and parody.

The ABA has led the way in drafting proposed legislation. The most recent iteration is in the ABA's 2001-2002 Annual Report. The proposed legislation starts with a "recognition" of publicity rights by providing that "[t]he right to control and to choose whether and how to use an individual's identity for commercial purposes is recognized as each individual's right of publicity."²⁶ An

24. *Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1998).

25. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002). The author represented the Estate of Diana Princess of Wales and the trustees of the Princess of Wales Memorial Fund in their appeal to the Ninth Circuit of the district court's decision granting summary judgment to the Franklin Mint.

26. *Proposed Federal Right of Publicity Act*, § 3, 2001-2002 Annual Report, ABA Section of Intellectual Property Law, Committee on Federal Trademark Legislation

“individual” is defined as a living or deceased person, regardless of whether that person’s identity was used commercially during the person’s lifetime.²⁷ All rights under the Proposed Legislation are transferable, although if not properly transferred upon the death of an individual with no living relatives, rights will terminate.²⁸

The core of the proposed legislation is found in Section 7:

§ 7. Limitations regarding use of an individual’s identity.

(a) A person may not use an individual’s identity for commercial purposes in commerce during the individual’s lifetime without having obtained previous written consent from the appropriate person or persons specified in Section 5 of this Act or their authorized legal representative as such representative is defined under the applicable state law.

(b) If an individual’s death occurs after the effective date of this Act, a person may not use that individual’s identity for commercial purposes in commerce for 50 years after the date of the individual’s death without having obtained previous written consent from the appropriate person or persons specified in Section 5 of this Act.

Siding with the law of states like California, Florida, Illinois, Indiana, Kentucky, Nevada, Ohio, Oklahoma, Tennessee, Texas, Virginia and Washington, the proposed legislation provides for descendibility of an individual’s publicity rights.²⁹ The 50-year postmortem period set forth in the proposed legislation is characterized by the ABA as a balance of “the desire of an individual to have his immediate heirs receive the benefit of his identity but does not extend so far as to make it difficult to litigate over the issue.”³⁰ Unlike some state statutes, such as those in Oklahoma, Texas and Washington that contain provisions that extend privacy rights back to before the statute was enacted, the proposed legislation does not “reach back” on the ground that it

(available in <http://www.abanet.org/intelprop/annualreport04/content/01-02/COMMITTEE%20NO%20201.pdf>.) (hereinafter, the “Proposed Legislation”).

27. *Id.* § 2.

28. *Id.* § 6.

29. *Id.* § 4. Such a proposal is at odds with the statutory law of Massachusetts, New York and Wisconsin, among others, which do not recognize descendible rights.

30. “Specific Issues Addressed by Proposed Legislation,” 2001-2002 Annual Report, ABA Section of Intellectual Property Law, Committee on Federal Trademark Legislation, at 31 (available in <http://www.abanet.org/intelprop/annualreport04/content/01-02/COMMITTEE%20NO%20201.pdf>.) (hereinafter, “Comments on Proposed Legislation”). Those states whose statutes recognize posthumous rights extend them for varying amounts of time. The most generous states are Indiana and Oklahoma, both of which protect rights for 100 years after death. Tennessee and Washington State are the least generous, with rights limited to 10 years after death. The 50 year post-mortem period is found in the statutes of Illinois, Kentucky, Nevada and Texas.

would be unfair to those who have made contractual agreements based on their understanding of prior law.³¹ The act provides for injunctive relief, recovery of actual damages and profits, and, in certain circumstances, attorneys' fees.³²

The proposed legislation also "recognizes important freedom of speech and artistic rights in the exemptions it creates"³³ in Section 8(b), which provides that the act does not apply to:

- (1) use of an individual's identity in an attempt to portray, describe, or impersonate that individual in a live performance, an original work of fine art, play, book, article, musical work, film, radio, television, or other audio, visual, or audio-visual work, provided that the performance, work, play, book, article, or film does not constitute in and of itself a commercial advertisement for a product, merchandise, goods, or services;
- (2) use of an individual's identity for any news, public affairs, or sports broadcast or account, or any political campaign;
- (3) use of an individual's name in truthfully identifying the person as the author of a particular work or program or the performer in a particular performance;
- (4) promotional materials, advertisements, or commercial announcements for a use described under paragraph (1), (2), or (3) of this subsection; or
- (5) use of photographs, videotapes, and images by a person, firm, or corporation practicing the profession of photography ("professional photographer") to exhibit in or about the professional photographer's place of business or portfolio, specimens of the professional photographer's work, unless the exhibition is continued by the professional photographer after written notice objecting to the exhibition has been given by the individual portrayed.³⁴

These enumerated exceptions are a nod to both existing state laws that contain similar provisions and to courts and commentators that have expressed First Amendment concerns when dealing with the right of publicity.

Section 14 of the proposed act preempts all state right of publicity laws. According to the ABA, preemption is "important to create the consistent body of law that will help those who want to use another's identity right understand the risk involved. . . . Without preemption, the addition of a federal right will merely

31. *Id.* at 32.

32. Proposed Legislation, *supra* note 26, at §§ 9-12.

33. Comments on Proposed Legislation, *supra* note 30, at 32.

34. Proposed Legislation, *supra* note 26, at § 8.

further complicate an already confusing body of law by adding yet another layer of law to the mix.”³⁵

The ABA has not found broad support for its proposals either internally or externally. Because of concerns expressed by other committees of the ABA, the proposed legislation has never been presented to the ABA House of Delegates. The Committee on Communications and Media Law of the Association of the Bar of the City of New York (the “Association”), in a letter to the ABA House of Delegates in 2003, stated that it believed that the ABA’s proposed Right of Publicity Act “is entirely unnecessary.” Among the concerns raised by the Association were the fact that the proposed act would create a federal right that goes beyond the scope of existing law, noting specifically that many states have rejected a right of publicity or a descendible right of publicity as the ABA proposed; that the ABA’s proposed act could threaten speech and creates a risk to First Amendment expression; and that an individual’s name and likeness are already adequately protected. In a subsequent letter on January 29, 2004, the Committee on Copyright and Literary Property and the Committee on Communications and Media Law of the Association repeated their lack of support for the ABA’s proposal and recommended that the Association as a whole oppose the proposed legislation. In addition to the concerns noted in 2003, the Association stated that celebrities whose names or likenesses have been appropriated may sue under Section 43 of the Lanham Act. While the Association acknowledged that Section 43 of the Lanham Act is limited to false or misleading speech, whereas the right of publicity, including the proposed federal right of publicity offered by the ABA has no such limitation, it still claimed that the proposed legislation is not necessary.

The Association also has challenged the proposed legislation on the grounds that it could inhibit free speech and add to the “chilling effect” on speech. Yet courts have been careful to limit the application of the state rights of publicity and to accord First Amendment protection to expressive works. *See* Section III.E., *infra*. There is no reason why courts could not continue this balance when applying a federal right of publicity.

C. Using the Lanham Act to Protect Likeness

While some commentators³⁶ and those who oppose a federal right of publicity have suggested that the availability of a false endorsement claim obviates the need for an express federal right of

35. Comments on Proposed Legislation, *supra* note 30, at 32-33.

36. Usha Rodriguez, *Race to the Stars: A Federalism Argument for Leaving the Right of Publicity in the Hands of the States*, 87 Va. L. Rev. 1201, 1209 (2001).

publicity, as discussed below it is a poor substitute at best. It is a legal fiction to suggest that a person's interest in protecting against the commercial appropriation of his image can or even should be protected by the Lanham Act, whose function is to protect consumers from confusion. If a consumer is not likely to be confused as to endorsement, does this necessarily mean that a person's likeness has not been misappropriated? Of course not. Quite simply, the likelihood of confusion standards and non-constitutional defenses applicable to Lanham Act cases have no bearing on whether someone commercially exploited another's likeness without consent.

That the Lanham Act is not an exact fit for a plaintiff seeking redress for the unauthorized use of his or her likeness is apparent from the face of the statute. Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any ... symbol, or device ... or any false designation of origin, false or misleading description of fact, or false or misleading misrepresentation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person ... shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

There is no mention of a person's likeness in the statute. There is no indication that commercial appropriation of a likeness itself is actionable.

Still, courts have applied Section 43(a) to protect people against the unauthorized use of their likenesses in connection with the promotion or sale of commercial products where such use suggests endorsement.³⁷ In fact, in misappropriation of likeness cases brought under the Lanham Act, the courts have accepted two different theories, one for false endorsement and one for infringement of an unregistered trademark.

37. *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997), *cert. denied*, 531 U.S. 811 (2000); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993).

1. Claims for False Endorsement

The more popular claim under the Lanham Act arising out of the commercial use of one's likeness is for false endorsement. As explained by the Ninth Circuit:

A false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product.³⁸

The gist of such a claim is that the unauthorized use of someone's image in connection with commercial products or services may falsely imply that the person has endorsed or approved the goods or services. One court has gone so far as to state that when a celebrity "appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement."³⁹ False endorsement is more readily found when the celebrity has a significant level of recognition among the segment of the society for whom the defendant's product or service is intended and when there is some relationship between the fame of the celebrity and the defendant's product or service that is being promoted. Thus, for example, a court found that some legendary surfers stated a claim against Abercrombie & Fitch for using their photographs in a quarterly magazine with an obvious surf theme that was designed to help sell Abercrombie's goods. Abercrombie clearly was using the celebrity status of the plaintiffs as surfers to promote its own product.⁴⁰

Claims for false endorsement under the Lanham Act do not require the use of a strict likeness in order to create liability.⁴¹ If a device or symbol is used that conjures up the celebrity, it can serve as the basis for a claim. Thus, the Lanham Act was invoked to protect the "Wheel of Fortune" game show personality Vanna White against Samsung Electronics' use of a robot dressed in a wig, gown and jewelry designed to resemble Vanna White.⁴² Similarly, in a case involving a commercial for DINTY MOORE

38. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

39. *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 627 n.8 (S.D.N.Y. 1985).

40. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

41. *Allen*, 610 F. Supp. at 628, noting that unlike the right of publicity laws the Lanham Act extends beyond misuse of a strict likeness to cover the misappropriation of a general persona. *Accord, White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (extending claim to symbols that evoke another's persona).

42. *White*, 971 F.2d at 1401.

beef stew featuring a trio of black women with bouffant hair, wearing sequined gowns and singing the merits of the product to the tune of the Motown hit “Baby Love,” the court recognized that the Lanham Act could extend to the use of the “persona of ‘The Supremes.’”⁴³

Unfortunately, the courts have not established a uniform test for false endorsement under the Lanham Act. In the Second, Sixth, and Ninth Circuits, courts assess the “likelihood of confusion” factors used in routine trademark infringement cases, including strength of the mark, relatedness of goods, similarity of the mark, similarity of marketing channels, consumer sophistication and evidence of actual confusion, among other factors.⁴⁴ As these factors do not neatly apply where the use of a likeness is at issue, the courts have had to make certain adjustments. Thus, the “mark” refers to the celebrity’s likeness or persona; “strength” refers to the celebrity’s level of fame or recognition, including the degree of fame among the consumers of defendant’s goods; and the “similarity of the goods” requires a comparison between the reasons for the celebrity’s fame and the alleged infringer’s products.⁴⁵ Applying these adjusted factors, a court found that where a bicycle company used the likeness of a member of a mountain bike race team in its catalogs, the plaintiff’s “mark” was strong because she was known to the bicycle company’s customer base, and the parties’ “goods” were similar because the plaintiff’s fame rested on her success as a cyclist.⁴⁶

The Third Circuit, on the other hand, considers claims of false endorsement to be a species of false advertising and requires a plaintiff to prove that the use of the celebrity’s likeness sends a false message. As with any false advertising case under the Lanham Act, if defendant’s use does not on its face clearly show endorsement (*i.e.*, literal falsity), the plaintiff must prove by survey evidence that the message communicated to consumers is false.⁴⁷

43. *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1241 (C.D. Cal. 1987).

44. *Allen*, 610 F. Supp. at 627; *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 920 (6th Cir. 2003); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000), *reh’g en banc denied*, 2000 U.S. App. LEXIS (Oct. 30, 2000); *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997).

45. *Wendt*, 125 F.3d at 812.

46. *Amazon Inc. v. Cannondale Inc.*, 56 U.S.P.Q.2d 1568, 1576 (D. Colo. 2000), *remanded on other grounds*, 61 U.S.P.Q.2d 1047 (10th Cir. 2001) (notwithstanding the relatedness of the goods, the cyclist lost the case on summary judgment with the court finding no likelihood of confusion based on the lack of actual confusion, high degree of consumer care and *de minimis* use of the likeness).

47. *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 930 (E.D. Pa. 1997), *aff’d*, 156 F.3d 1225 (3d Cir. 1998); *See also Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149 (9th Cir.

Regardless of what specific test is applied, all courts that apply the Lanham Act theory of false endorsement to what essentially is a right of publicity claim must consider whether consumers perceive the use at issue as falsely suggesting approval. Yet such perception is irrelevant to the interests protected by the right of publicity laws. To suggest, therefore, that a federal right of publicity is not necessary because the interests at issue are protected by the Lanham Act—as some opponents of a federal cause of action have—has the net effect of significantly limiting the scope of relief available for a claim for misappropriation of likeness and the plaintiff's ability to properly redress the injury that a right of publicity is intended to address.

2. Claims for Infringement of Trademark Rights

Providing a different basis for a celebrity's claim under the Lanham Act, some courts have held: "Celebrities have standing to sue under § 43(a) because they possess an economic interest in their identities akin to that of a traditional trademark holder."⁴⁸ Using this rationale, some celebrities have asserted trademark rights in their image and have sought relief for infringement of an unregistered mark under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(i).⁴⁹

To prevail on such a claim, a celebrity must show that he or she owns valid trademark rights in the property being protected, namely the celebrity's likeness, and that the likeness identifies and distinguishes that person's goods from those of others.⁵⁰ For a likeness to be protected as a trademark it must have a meaning independent of the person; it must refer not just to the individual but to the goodwill of a commercial enterprise.⁵¹ By way of example, the likeness of Paul Newman identifies a well-known celebrity. Yet his appearance also serves as a trademark to identify his line of food products.

Of all the celebrities who have asserted this type of claim, few have succeeded. Even the success of Elvis Presley, or more

2002) (noting that because the ads did not explicitly say that products were authorized this suggested that they were not endorsed).

48. *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003), *cert. denied*, 124 S. Ct. 925 (2003).

49. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (noting that § 43(a) provides a federal cause of action for infringement of an unregistered trademark).

50. *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990) (purpose of a trademark is to designate source of a product); *Two Pesos, Inc.*, 505 U.S. at 768.

51. *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) (noting that there are "no rights in a trademark apart from the business with which the mark has been associated").

precisely his estate—one of the few to make this theory work⁵²—was limited. *See* Section III.D.3., *infra*. The reason for the repeated failure is that plaintiffs have difficulty showing that their likenesses have acquired a meaning beyond merely identifying the individuals. While this requirement makes sense given the Lanham Act's goal to protect against confusion as to the source or endorsement of commercial goods or services, it has no connection to the rationale behind a claim for violation of a right of publicity and has no place in protecting against the misappropriation of one's likeness. The requirements for protection of trademarks under the Lanham Act and the elements of a claim for unauthorized commercial exploitation of one's likeness simply do not mesh.

D. Barriers to Lanham Act Claims

Right of publicity claims and Lanham Act claims involving use of a celebrity's name or likeness generally share the requirements that (1) a person's name or likeness is used, (2) without consent, (3) for commercial purposes. However, built into the Lanham Act are defenses not applicable to right of publicity claims and that have the tendency to limit the ability of the Lanham Act to redress claims for misappropriation of one's persona.⁵³

1. Fair Use

The defense of fair use often has been used to block a celebrity's Lanham Act claim arising out of the misappropriation of his or her identity or likeness. There are two types of fair use, statutory fair use⁵⁴ and the judicially-created doctrine of nominative fair use established by the United States Court of Appeals for the Ninth Circuit.⁵⁵ Both provide a complete defense to claims for trademark infringement, unfair competition and false endorsement.

52. *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). In what may be an analogous case, it was reported in January 2004 that a Los Angeles jury found that an unauthorized tribute show featuring a Frank Sinatra impersonator violated the rights of Frank Sinatra's estate. *Sheffield Ent. Inc. v. Main Event, Inc.*, 02 CV 3927 (C.D. Cal. Dec. 23, 2003). It was unclear from the report as to whether the claim concerned the misuse of the Sinatra name (the show was called "Sinatra: The Main Event") or the use of Mr. Sinatra's likeness.

53. The First Amendment acts as a defense to both causes of action. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 926 (6th Cir. 2003). *See* Section III.E., *infra*.

54. 15 U.S.C. § 1115(b)(4).

55. *See New Kids On The Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

(a) Statutory Fair Use

Section 33(b) of the Lanham Act provides that if the defendant makes “a use, otherwise than as a mark . . . of a term or device which is descriptive and used fairly and in good faith only to describe the goods or services of [the infringing] party” fair use will be found.⁵⁶ In the First, Second, Fourth and Fifth Circuits, the fair use defense is available regardless of whether there is a likelihood of confusion.⁵⁷ By contrast, the Ninth Circuit has held that in order to prevail on a fair use defense, the party asserting the defense must establish that its use of the term in question did not lead to customer confusion.⁵⁸ On January 9, 2004, the United States Supreme Court granted certiorari to resolve the split in the circuits.⁵⁹

While there are very few published decisions in which statutory fair use was alleged as a defense to the misappropriation of a likeness, one can certainly see a basis for the application of the defense. For example, if somebody is selling reproductions of furniture, it might be useful to show pictures of the people who originally designed the furniture, especially if the people are well known.⁶⁰ The problem, however, is that often when dealing with celebrity likenesses the party exploiting the celebrity likeness is doing little more than selling a reproduction of the celebrity, whether it be on a calendar, poster or T-shirt. In connection with the sale of such products, one might claim that the fair use defense applies since the likeness is being used to describe the product. Indeed, one court found such an argument persuasive.⁶¹ Such an

56. 15 U.S.C. § 1115(b)(4)

57. *Leathersmith of London Ltd. v. Alleyn*, 695 F.2d 27, 30 (1st Cir. 1982), *cert. denied*, 459 U.S. 1209 (1983); *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997); *Shakespeare Company v. Silstar Corp. of America, Inc.*, 110 F.3d 234, 240 (4th Cir. 1997), *cert. denied*, 522 U.S. 1046 (1998); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 271 (5th Cir. 1999).

58. *KP Permanent Make-Up, Inc. v. Lasting Impression, Inc.*, 328 F.3d 1061, 1072 (9th Cir. 2003), *cert. granted*, 124 S. Ct. 981 (2004).

59. *KP Permanent Make-Up, Inc. v. Lasting Impression, Inc.* 124 S. Ct. 981 (2004). Arguments took place on October 5, 2004. The United States, in its amicus brief, supported the petitioner's view that fair use can be found even if there is confusion, as did four other amici (including AIPLA, INTA, and the Private Label Manufacturers Association). The Society of Permanent Cosmetic Professionals filed an amicus brief in favor of respondent. One has to question the approach of the Ninth Circuit. If there is no likelihood of confusion there would be no Lanham Act violation and, therefore, no need to even apply the fair use defense. Thus, the approach seems to read the defense out of the statute.

60. *See Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 318 (6th Cir. 2001) (allowing as an exception to an injunction the right to use the name and likeness of the furniture designers Charles and Ray Eames to fairly identify furniture).

61. *New York Racing Assoc., Inc. v. Perlmutter Publ'g, Inc.*, 1996 U.S. Dist. LEXIS 11764 (N.D.N.Y. 1996) (noting that use of images of Saratoga racetrack on products was a fair use since they were used to describe horse racing at Saratoga).

application of the fair use defense not only would overshadow the Lanham Act claims, but also would be contrary to the purpose behind and the protections afforded by the right of publicity.

(b) Nominative Fair Use

Unlike the statutory fair use defense, which is found in the text of the Lanham Act, nominative fair use is an outgrowth of court decisions and replaces completely the likelihood of confusion analysis. The defense first appeared in a dispute over the use of the band name New Kids On The Block in a poll sponsored by a newspaper that asked its readers to vote on who in the band was the reader's favorite or whether the band was a turn-off.⁶² The court was faced with the question of whether a defendant who uses a plaintiff's mark to refer to the plaintiff is liable for trademark infringement or unfair competition. The court recognized that such use did not fit within the definition of statutory fair use, which addresses uses of the plaintiff's mark to describe the defendant's own product. In creating the "nominative fair use" defense, the Ninth Circuit noted that "it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark."⁶³ For example, while you could refer to the New York Yankees as the team of baseball players from the Bronx, it is far simpler and easier to understand if you refer to them as the Yankees.

To successfully assert the defense, the alleged infringer must show that:

- (1) The product in question is not readily identifiable without use of the trademark;
- (2) Only so much of the mark is used as is reasonably necessary to identify the product; and
- (3) The user of the mark does nothing that would suggest sponsorship by the trademark holder.⁶⁴

The nominative fair use defense started small in the Ninth Circuit allowing a newspaper to use the trademark NEW KIDS ON THE BLOCK in connection with a poll about the group. Since then, the boundaries of the nominative fair use defense have expanded into far more commercial purposes. Playboy was barred by the nominative fair use defense from prohibiting a former Playmate of the Year from using the PLAYBOY and PLAYMATE trademarks in metatags and banner ads for a website that advertised photos for sale, advertised memberships in a photo club

62. *New Kids On The Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992).

63. *Id.* at 306.

64. *Id.*

and promoted a former playmate's services as a spokesperson.⁶⁵ Obviously, the PLAYBOY marks were not being used for purposes of comparison or criticism but at least they were being used for point of reference.

In another application of the nominative fair use defense, the court found that the use of BARBIE dolls in artwork criticizing the values and ideals that BARBIE has come to symbolize is protected as a nominative fair use.⁶⁶ In fact, the court found that the defense rendered Mattel's claims for trade dress infringement groundless and unreasonable and awarded costs and fees to the defendant of over \$1.75 million dollars.⁶⁷

In this author's opinion, the most radical and commercial application of the nominative fair use defense concerned the use of the late Princess Diana's likeness on or to promote plates, dolls, and jewelry made by the Franklin Mint without the endorsement or authorization of the Princess' estate or heirs. After discussing the derivation of the nominative fair use defense, the Ninth Circuit first set forth the circumstances under which the defense is applicable. The court noted that the nominative fair use analysis should be applied "in cases where the defendant has used the plaintiff's mark to describe the plaintiff's product, even if the defendant's ultimate goal was to describe his own product. By contrast, courts should use the traditional classic fair use analysis in cases where the defendant has used the plaintiff's mark only to describe his own product, and not at all to describe the plaintiff's product."⁶⁸

In holding that the nominative fair use defense allowed the Franklin Mint to use Princess Diana's likeness without permission on plates, dolls and jewelry, the court noted that "[t]here is no substitute for Franklin Mint's use of Princess Diana's *likeness* on its Diana-related products. . . . We therefore hold that Princess Diana's physical appearance is not readily identifiable without the use of her likeness."⁶⁹ In reaching its decision, the court assumed that the Franklin Mint had the right in the first instance to make products bearing Diana's likeness. What gave Franklin Mint that right was never stated. Yet if we are to assume, as the court did, that marketers have the right to sell products featuring a celebrity's name and likeness, then no celebrity would be able to establish a claim for false endorsement under the Lanham Act.

65. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796 (9th Cir. 2002).

66. *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810-11 (9th Cir. 2003).

67. *Mattel, Inc. v. Walking Mountain Prods.*, 2004 U.S. Dist. LEXIS 12469 (C.D. Cal. 2004).

68. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1152 (9th Cir. 2002).

69. *Id.* at 1153 (emphasis in original).

How do you sell a golf shirt featuring Tiger Woods or a statue of soccer superstar David Beckham if you cannot make prominent reference to their likenesses?

The nominative fair use defense has not caught on in all of the circuits. The Sixth Circuit has declined to adopt it entirely.⁷⁰ District courts in the Third and Fourth Circuit have declined to apply the doctrine since it has not been adopted at the circuit level.⁷¹ As to the other circuits that have adopted the nominative fair use defense, specifically the Second, Fifth and Seventh Circuits, none have applied the defense to a claim for the misappropriation of a likeness and it is not clear if, outside the Ninth Circuit, the defense would be extended that far.⁷²

2. No Likelihood of Confusion

While the Lanham Act has been used as a vehicle for asserting a right of publicity claim, if there is nothing about defendant's use of plaintiff's likeness that implies personal endorsement the claim generally will be dismissed.⁷³ This requirement often has been the most significant single hurdle to obtaining relief.⁷⁴ Moreover, even if confusion as to endorsement is found, the courts will not necessarily enjoin the use of the plaintiff's likeness but instead

70. *PACCAR, Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003).

71. *See Basic Fun, Inc. v. X-Concepts LLC*, 157 F. Supp. 2d 449, 456 (E.D. Pa. 2001); *National Fed'n of the Blind, Inc. v. Loompanics Enters., Inc.*, 936 F. Supp. 1232, 1241 (D. Md. 1996).

72. *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 156 (2d Cir. 2002), *remanded on other issues*, 2003 U.S. Dist. LEXIS 3065 (2003); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998), *reh'g denied*, 1998 U.S. App. LEXIS 29648 (1998); *R.J. Reynolds Tobacco Co. v. Premium Tobacco Stores, Inc.*, 2001 WL 747422 (N.D. Ill. 2001).

73. *Albert v. Apex Fitness Inc.*, 44 U.S.P.Q.2d 1855, 1856 (S.D.N.Y. 1997).

74. *WWE v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003) (summary judgment dismissing Lanham Act claims granted where use of WWE wrestling characters was in context of broad spoof of WWE, its characters and attitudes and thus no likelihood of confusion); *Seale v. Gramercy Pictures*, 964 F. Supp. 918 (E.D. Pa. 1997), *aff'd*, 156 F.3d 1225 (3d Cir. 1998) (after bench trial, Lanham Act claim dismissed for lack of evidence showing any likely or actual confusion); *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166 (D.D.C. 1992) (summary judgment dismissing James Brown's claims where no evidence that consumers believed plaintiff had endorsed or approved use of likeness); *Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990) (summary judgment granted where no reasonable jury could find that use of Babe Ruth's photos in a calendar suggested sponsorship); *Amazon Inc. v. Cannondale Inc.*, 56 U.S.P.Q.2d 1568, 1576 (D. Colo. 2000) (summary judgment granted to defendant notwithstanding findings that celebrity's persona was a strong mark, that defendant used cyclist's persona to sell goods and that the goods were associated with the celebrity cyclist such that "it would be reasonable for a consumer to be confused as to [the celebrity's] association with [the defendant]").

may simply require a disclaimer or language to correct any misimpression caused by the use of the celebrity's likeness.⁷⁵

Proving a likelihood of confusion or false endorsement is not an element of a right of publicity claim. A defendant using the likeness of a third party is getting a commercial benefit. Why else would he use it? Whether consumers are confused is irrelevant. Yet plaintiffs seeking nationwide protection of their persona though the Lanham Act must meet a standard inapplicable to their claim. Applying the Lanham Act analysis ignores the basic premise of the right of publicity statute, namely that there is a value to a person's likeness and that the unauthorized commercial use of that likeness is something for which a person should be compensated.

3. Lack of Protectable Rights

Symbols, such as the uniform of the Dallas Cowboy Cheerleaders, the car used in the "Dukes of Hazzard" television show, the color of the TIFFANY box or the shape of the classic COCA-COLA bottle are protected as trademarks. On the other hand, regardless of how well recognized a person may be, if his or her likeness refers only to the individual, the likeness is not and cannot be protected as a mark.⁷⁶ Put another way, a person's appearance may be protected as a trademark only if the appearance no longer primarily identifies the individual but instead symbolizes a particular business, product or company.⁷⁷ People, celebrities included, are not walking trademarks. A celebrity possesses no trademark rights in his every picture or depiction. Only those images used consistently in connection with a business, product or service, so as to identify the origin of specific goods or services, qualify for protection.

Using this rationale, the United States Court of Appeals for the Sixth Circuit held that the appearance of the Rock & Roll Hall of Fame could not be protected as an unregistered trademark under the Lanham Act because the plaintiffs had not used any one depiction of the museum with any consistency.⁷⁸ The United States Court of Appeals for the Second Circuit denied protection to images of Babe Ruth that appeared in a baseball calendar without

75. *CBS, Inc. v. Gusto Records, Inc.*, 403 F. Supp. 447, 449 (M.D. Tenn. 1974) (while finding that use of singer Charlie Rich's likeness violated Lanham Act, court only required use of disclaimer).

76. For purposes of discussion it is assumed that the celebrity does not own a federal trademark registration for his or her likeness.

77. *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990).

78. *Rock & Roll Hall of Fame v. Gentile Productions*, 134 F.3d 749, 755 (6th Cir. 1998), *reh'g denied en banc*, 1998 U.S. App. LEXIS 4957 (1998).

his daughter's consent, noting that it cannot be said "that every photograph of Ruth serves this origin-indicating function."⁷⁹ Elvis Presley's estate sought protection of his likeness, claiming it served as a service mark. The court rejected such a broad claim of rights but did accord trademark status to one specific pose.⁸⁰ Most recently, Tiger Woods was denied protection of his likeness as an unregistered trademark because there was no one particular image used consistently in connection with specific goods.⁸¹ In what could be the death knell for these types of claims, at least in the Sixth Circuit, the *Tiger Woods* court held "as a general rule, a person's image or likeness cannot function as a trademark."⁸²

Whether someone's likeness functions as an actual trademark is irrelevant to the issue of whether the person's likeness was commercially exploited or misappropriated by a third party without consent in violation of the right of publicity. Imagine a set of coffee cups each of which features the likeness of one of the members of the Boston Red Sox, the 2004 World Series champions. A court would likely find that the baseball players did not have protectable trademark rights. Yet the misappropriation of the players' likenesses is real. To suggest, as opponents of a federal right of publicity statute do, that the Lanham Act is an appropriate substitute for a federal right of publicity ignores this distinction between Lanham Act and right of publicity claims.

E. The First Amendment— A Defense to Lanham Act and Right of Publicity Claims

One of the major concerns to those opposed to a federal right of publicity and a stumbling block toward enactment of such a law is that a federal right of publicity would limit First Amendment rights. Yet courts applying the right of publicity laws have been very sensitive to the First Amendment. If a celebrity's likeness is being used as part of an expressive work such as a parody, to convey an expressive message, or to make a comment or criticism, the use of the likeness will be protected under the First Amendment.⁸³ Indeed, it can be argued that courts are more consistent in applying the First Amendment to right of publicity claims than they have been when applying the First Amendment to claims under the Lanham Act for false endorsement.⁸⁴

79. *Pirone*, 894 F.2d at 583.

80. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364 (D.N.J. 1981).

81. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 923 (6th Cir. 2003).

82. *Id.* at 922.

83. *Id.* at 924.

84. Application of the First Amendment to Lanham Act claims for false endorsement is not uniform. In fact, there are at least three different approaches used by the federal courts

Many state right of publicity statutes contain an explicit First Amendment defense. For example, under the California statute, use of somebody's name or likeness in connection with news, public affairs, sports broadcasts, or accounts of political campaigns cannot give rise to a right of publicity claim.⁸⁵ In Nebraska, the right of publicity does not apply to the publication, printing, display or use of a name or likeness of any person in any print, broadcast, telecast or other news medium or publication as part of a bona fide news report or presentation or non-commercial advertisement having a current or historical public interest.⁸⁶ Texas allows for the use of a deceased individual's likeness in a play, book, film, radio program, television program, magazine or newspaper article, political or newsworthy material, works of fine art and for advertisements or commercial announcements concerning these uses.⁸⁷ Along similar lines, the Ohio right of publicity statute specifically exempts the use of an individual's persona "in connection with any news, public affairs, sports broadcast, or account."⁸⁸ And Florida law states that the right of publicity does not apply to the use of a name or likeness "in any newspaper, magazine, news broadcast or telecast, or other news medium or publication as part of any bona fide news report or presentation having a current and legitimate public interest and where such name or likeness is not used for advertising purposes."⁸⁹

Even where a First Amendment exception is not specifically written into the state law, the First Amendment is still considered as a defense to right of publicity claims.⁹⁰ The application of the

to balance First Amendment protections against the protections of the Lanham Act. The Tenth Circuit, in *Cardtoons v. Major League Baseball Players*, 95 F.3d 959, 970 (10th Cir. 1996), factored the First Amendment into the traditional likelihood of confusion analysis. The Eighth Circuit in *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987), looked at whether there were alternative means for an artist to convey his or her idea in determining whether First Amendment protection should apply. The Second, Fifth, Sixth and Ninth Circuits determine whether the use of the image at issue is relevant to the underlying work. If it is, the court then determines whether anything about the use explicitly misleads as to the source of the work. Under this approach, the court will find the Lanham Act applicable only where the public interest in avoiding confusion outweighs the public interest in free expression. *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989); *ETW*, 332 F.3d at 937; *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003).

85. Cal. Civ. Code § 3344.1(j).

86. Neb. Rev. St. § 20-202.

87. V.T.C.A., Property Code § 26.012.

88. Ohio Rev. Code § 2741.02(D)(1).

89. Fla. Stat. § 5408(3)(a).

90. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977); see also *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) noting that no claim for violation of a right of publicity will be found if the use of a person's likeness is in connection

First Amendment to a right of publicity claim provides a balance between the competing concerns of freedom of speech and commercial misappropriation of a person's identity. Celebrities could not use a right of publicity statute to control their images by censoring disagreeable portrayals or to insulate themselves from parody, lampoon or criticism. As the Tenth Circuit held: "Parodies of celebrities are an especially valuable means of expression because of the role celebrities play in modern society. . . . Because celebrities are an important part of our public vocabulary, a parody of a celebrity does not merely lampoon the celebrity, but exposes the weakness of the idea or value that the celebrity symbolizes in society. . . . In order to effectively criticize society, parodists need access to images that mean something to people, and thus celebrity parodies are a valuable communicative resource. Restricting the use of celebrity identities restricts the communication of ideas."⁹¹ As noted by Judge Kozinski in his dissent from the Ninth Circuit's opinion in the *Vanna White* case, "the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them."⁹² Following this rationale, the United States Court of Appeals for the Tenth Circuit accorded First Amendment protection to trading cards that bore parodies of recognizable major league baseball players.⁹³ Indeed, it is not just flesh and blood celebrities whose images must be available for communicative purposes. BARBIE has been found to have transcended her purpose of identifying a product of Mattel and has now assumed a cultural significance that may be criticized, parodied and lampooned.⁹⁴

Where the use of a celebrity likeness is for purely commercial purposes, the courts have held that the First Amendment does not bar a right of publicity claim. But where the use of a likeness is transformed into more than a mere imitation of the celebrity, the First Amendment defense will prevail.⁹⁵ It was First Amendment

with the publication of matters in the public interest including publications about people about whom there is a legitimate and widespread public interest.

91. *Cardtoons v. Major League Baseball Players*, 95 F.3d 959, 972 (10th Cir. 1996). See also *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 937-38 ("celebrities have come to symbolize certain ideas and values in our society and have become valuable means of expression in our culture").

92. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting).

93. *Cardtoons v. Major League Baseball Players*, 95 F.3d 959, 972 (10th Cir. 1996).

94. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 898-900 (9th Cir. 2002), *cert denied*, 123 S. Ct. 993 (2003); *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 811 (9th Cir. 2003).

95. Applying this test, the Supreme Court of California found that the use of characters on the cover of a comic book that evoked the musician brothers Johnny and Edgar Winter had significant creative elements that transformed them into something more than mere

considerations that led the United States Court of Appeals for the Ninth Circuit to rule against Dustin Hoffman in a suit for violation of the California right of publicity statute and the Lanham Act after a magazine published an article that used computer technology to alter famous film stills so as to make it appear that the actors were wearing fashions from the Spring of 1997. Dustin Hoffman, in his role as Tootsie, was represented wearing a spaghetti-strap, cream-colored silk evening dress and high-heeled sandals. The court concluded that the First Amendment protected the use of Dustin Hoffman's image since the photograph did not merely advance a commercial message. Rather, the overall article was found to be "a combination of fashion photography, humor and visual and verbal editorial comment on classic films and famous actors."⁹⁶

Of course, while it is easy to state the rule that expressive works are entitled to First Amendment protection that trumps the right of publicity,⁹⁷ it is not always clear when the use of a celebrity's likeness is protected art or speech and when it is merely commercial exploitation. Also unclear is who decides if something is art. Yet, this dilemma is not particular to a right of publicity claim. The same challenge is faced in a Lanham Act claim. Thus, while a reproduction of a celebrity's likeness in bronze⁹⁸ and a painting of Tiger Woods⁹⁹ have been deemed art, images of the Three Stooges on T-shirts and lithographs were not considered worthy of First Amendment protection.¹⁰⁰ The defining line is not whether the product on which the celebrity's likeness appears is

celebrity likeness and was therefore protected by the First Amendment. *Winter v. D.C. Comics*, 66 U.S.P.Q.2d 1954, 1957 (Cal. 2003). Similarly, in *WWE v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413-45 (W.D. Pa. 2003), the court dismissed right of publicity claims arising from the alleged misappropriation of the personas of professional wrestlers Dwayne "The Rock" Johnson, Steve "Stone Cold Steve Austin" Williams, and Mark "Undertaker" Calloway where Big Dog's representation of the wrestlers as dogs poked fun at societal icons and "added significant artistic and imaginative expression. . . ."

96. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001). By contrast, in *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1002 (9th Cir. 2001), professional surfers whose pictures were used in an Abercrombie & Fitch Spring Quarterly fared far better than Dustin Hoffman. In its Spring 1999 Quarterly, Abercrombie included a section entitled "Surf Nekkid." The court found that "Abercrombie used Appellants' photograph essentially as window-dressing to advance the catalog's surf-theme. The catalog did not explain that Appellants were legends of the sport and did not in any way connect Appellants with the story preceding it. . . . We conclude that the illustrative use of Appellants' photograph does not contribute significantly to a matter of the public interest and that Abercrombie cannot avail itself of the First Amendment defense."

97. *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 354 (S.D.N.Y. 2002).

98. *Simeonov v. Tiegs*, 159 Misc. 2d 54, 602 N.Y.S. 2d 1014 (N.Y. Civ. Ct. 1993).

99. *ETW v. Jireh Publ'g, Inc.*, 332 F.3d 915, 923 (6th Cir. 2003).

100. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 791 (2001).

sold commercially.¹⁰¹ Indeed, works of artistic expression such as novels, poetry, music, painting and sculpture are all made with the hope they will sell. The defining line in the context of a right of publicity or a Lanham Act claim is whether a transformative or creative component has been added to the likeness. In the case of the painting of Tiger Woods, the court found that it was more than a mere literal likeness of Woods, involving as it did a collage of images, and that the artist “added a significant creative component of his own to Woods’ identity.”¹⁰² By contrast, merely copying an image of a celebrity, whether on paintings, T-shirts, or in a stage performance, will not be found to be protected. If it appears that all that is being offered by a defendant is a literal depiction or imitation of a celebrity, even an extraordinarily skillful copy or imitation, it generally will not be granted First Amendment protection.¹⁰³

In addition to the expressive work exception to the right of publicity laws, the courts also recognize a public affairs or newsworthiness exception to the right of publicity. Again, application of this rule often can be difficult. The test of permissible use is not the nature of the publication but whether the publication is illustrative of a matter of legitimate public interest.¹⁰⁴ However, where newsworthy use mixes with advertising use, such use generally is not immunized by the newsworthiness or First Amendment exception.¹⁰⁵

With the burgeoning of reality television and the proliferation of gossip magazines and websites, anything concerning a celebrity, and therefore any use of a celebrity’s image, could be claimed to be furthering the public interest or otherwise newsworthy. Indeed,

101. *Hoepker*, 200 F. Supp. 2d at 354 (noting that art reproduced on commercial products remains art subject to a First Amendment defense).

102. *ETW*, 332 F.3d at 938.

103. See *Comedy III Prods.*, 21 P.3d 791; *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981) (finding that a tribute show to Elvis Presley with an Elvis Presley impersonator serves “primarily to commercially exploit the likeness of Elvis Presley without contributing anything of substantial value to society,” and therefore enjoining the same); *Ali v. Playgirl Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978) (portrait of Muhammad Ali in *Playgirl* magazine violated Ali’s right of publicity under New York law because there was no “informational or newsworthy dimension” to the unauthorized use of Ali’s likeness); *Catherine Bosley v. Wildwett.com*, 310 F. Supp. 2d 914 (N.D. Ohio 2004) (use of images of newscaster Catherine Bosley on a videotape that featured Ms. Bosley at a wet T-shirt contest was not covered by any type of newsworthiness or other First Amendment exception as the images do not contain any editorial content).

104. See *Dallesandro v. Holt & Co.*, 4 A.D.2d 470, 771 (N.Y. App. Div. 1957); *Baugh v. CVS, Inc.*, 828 F. Supp. 745, 754 (N.D. Cal. 1993) (noting that a news provider need not be a traditional news show to merit protection).

105. *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (noting that if the media’s use of a person’s identity is informative or cultural the use is immune but if it merely exploits the individual portrayed immunity will not be granted).

the public's fascination with celebrities has led some newspapers and magazines to provide posters of some of the individuals who are covered in their pages. Is this news? Is this art? Or is this merely commercial exploitation designed to sell more papers?

In a Second Circuit case concerning the inclusion of posters of wrestling stars within the pages of wrestling publications, the plaintiffs conceded the newsworthiness of professional wrestling and that the publication at issue was a bona fide newsstand publication protected by the First Amendment. The court also recognized that news photos generally are entitled to the full protection of the First Amendment. As to whether the large photos folded and stapled inside the magazines were protected by the First Amendment or were distributed for purposes of trade, the court framed the issue as whether the photos were included primarily for their public interest aspect or were merely incidental to a commercial purpose.¹⁰⁶ While the Court framed the question, it never answered it.

The Court of Appeals of California did, in a case brought by Joe Montana, the famed quarterback for the San Francisco 49ers football team. There, a newspaper issued a souvenir section in its Sunday edition devoted exclusively to the football team. The front page of the section bore an artist's rendition of Joe Montana. Within two weeks of the original printing, the front page of the section was reproduced in poster form. Unlike the case of the wrestlers, where the posters were part and parcel of the newsstand publications, in this case the posters were made as a separate product sold separately or given away independent of the newspaper. Given the test formulated in the wrestling case, it would seem that these posters were purely commercial and for purposes of trade. Yet the California court found that the posters were entitled to full First Amendment protection.¹⁰⁷ The Court justified its determination by finding that the posters reported newsworthy events of public interest and that the newspaper had a constitutional right to promote itself by reproducing its originally protected articles or photographs. A similarly broad view of newsworthiness was taken by an Ohio state court in an action arising out of the use of an Olympic athlete's name and likeness on promotional disposable DIXIE cups. Rejecting a claim for

106. *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85, 87-88 (2d Cir. 1989). This test is similar to that formulated by Justice Powell in his dissent in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 581 (1977) where he advocated that the First Amendment trumps the right of publicity unless there is a strong showing that the claim of newsworthiness or public interest "was a subterfuge or cover for private or commercial exploitation."

107. *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 40 Cal. Rptr. 2d 639 (Ct. App. 1995).

misappropriation of the athlete's likeness, the court—like courts refusing to provide Lanham Act protection—held that the “reference to the athletes and their accomplishments was purely informational; there was no implication that the athletes use, supported, or promoted the product.”¹⁰⁸

IV. CONCLUSION

To those who resist a federal right of publicity law because they believe that the Lanham Act provides sufficient coverage, the case law does not bear this out. The Lanham Act does not protect against misappropriation of one's likeness, nor should it, given the different interests protected by the Lanham Act and by state right of publicity laws. To those who believe that a federal right of publicity statute would improperly intrude on First Amendment interests, this too is not borne out by the existing law, which recognizes a strong and rigorous First Amendment defense to right of publicity claims. If there is a consensus that one's persona should be protected from unauthorized commercial use (and the fact that a majority of states have enacted a statute suggests there is), a federal statute to protect the right of publicity may be the only way to accomplish that goal. Clearly, the Lanham Act in its current incarnation is not a proper substitute.

108. *Vinci v. American Can Co.*, 591 N.E.2d 793, 794 (Ohio App. 1990).