

Intellectual Property Expansion: The Good, the Bad, and the Right of Publicity

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INTRODUCTION

My first reaction upon being asked to write about the right of publicity was, “Oh no, not another right of publicity article!” Is there really anything left to say about this topic, given the proliferation of writing on it in the last ten to fifteen years? A lot has been said about the right of publicity, most of it negative. The right of publicity, analysts say, is out of control.¹ They say it promotes censorship and “redistributes wealth upwards.”² The right of publicity creates significant tension and, indeed, threatens core values of free speech.³ The right of publicity, in short, has a lot of analytical problems and yet, like all other forms of intellectual property (“IP”), has expanded faster than Steven Segal’s waistline in recent years.⁴ In this piece, I would like to sketch how the expansion of the right of publicity fits into the rest of IP expansion, with a focus on trademark law and copyright law in the area of artistic creation.

The right of publicity shares the closest doctrinal similarity to trademark law.⁵ Furthermore, virtually every celebrity right of publicity case is co-joined with a Lanham Trademark Act claim.⁶ Right of publicity cases, like trademark claims, make sense and are typically uncontroversial when they occur in a zone of pure commerce, such as advertising use. Both claims become problematic when they move toward artistic-related uses.⁷

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¹ See, e.g., Gil Peles, *The Right of Publicity Gone Wild*, 11 UCLA ENT. L. REV. 301, 301 (2004) (noting that the right of publicity “is now utilized more than ever before”).

² See, e.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 136–37 (1993).

³ See John Tehranian, *Whither Copyright? Transformative Use, Free Speech, and an Intermediate Liability Proposal*, 2005 BYU L. REV. 1201, 1228–29.

⁴ See, e.g., Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 226 (2005) (remarking that the “current right of publicity . . . has expanded to allow claims against an ever-increasing range of conduct”).

⁵ See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1164 (2006) (remarking that “the right of publicity has more in common with trademark law than with copyright”).

⁶ See, e.g., *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002).

⁷ See K.J. Greene, *Abusive Trademark Litigation and the Incredible Shrinking Confusion Doc-*

Similarly, IP expansion in copyright, trademark, and right of publicity contexts makes sense and is socially beneficial when it promotes great artistic incentives and freedom to create. It causes problems when it impinges upon creative freedom and unduly reduces accumulation of the public domain. My thesis is that IP expansion should look to enhance artistic creation at the bottom of the entertainment ecosystem, where the real creativity has always originated, rather than at the top of distribution, where the public domain tends to be the most burdened and the net gains to social productivity are the most attenuated.

In keeping with the theme of my work of recent years, I will use African-American cultural production as a starting point of analysis. My reasons for doing so are three-fold: first, black cultural production is at the center of expressive creativity in American culture and has been since the slave songs of the 1800's and blues and jazz of the 1900's, up through the rap music of today.⁸ Second, black artists can stand in for socially and economically disadvantaged persons of all groups—blacks have been at the “bottom of the barrel” of American society until very recent times. Third, as blacks have become upwardly mobile within society, their treatment illustrates how economic stratification skews the benefits of IP protection.

I. THE “BEEF” BETWEEN IP RESTRICTORS AND EXPANSIONISTS

Using an analogy for hip-hop music, where a long-running dispute, or “beef,” has existed between East and West Coast rappers, in recent years a “beef” has emerged between two camps, the IP Restrictors and the IP Expansionists. The divide typically features “rights holders, their investors and representatives” on the one side and “[liberal] academics . . . consumer advocates, and civil libertarians” on the other.⁹ In rap “beefs,” someone often ends up getting shot. In IP “beefs,” no one has been shot to date or, at least, there is no record of violence; but there can be considerable sniping among academics, as any attendee at events such as American Association of Law Schools (“AALS”) IP section meetings and various IP scholars’ forums around the country can attest.¹⁰

trine—Trademark Abuse in the Context of Entertainment Media and Cyberspace, 27 HARV. J.L. & PUB. POL'Y 609, 617 (2004) (distinguishing artistic use from purely commercial use).

⁸ K.J. Greene, “Copynorms,” *Black Cultural Production, and the Debate Over African-American Reparations*, 25 CARDOZO ARTS & ENT. L.J. 1179, 1186–87 (2008) [hereinafter *Copynorms*].

⁹ Peter K. Yu, *Anticircumvention and Anti-Anticircumvention*, 84 DENV. U. L. REV. 13, 16 (2006) (describing different camps in debate over digital rights management in the IP context).

¹⁰ Ann Bartow, *When Bias is Bipartisan: Teaching About the Democratic Process in an Intellectual Property Republic*, 52 ST. LOUIS U. L.J. 715, 716 (2008) (remarking that “[s]ome of the fiercest policy debates in academic intellectual property law are over the proper level of monopolistic protection the legal system should provide for copyrights, patents, and trademarks”).

A. IP “Restrictors” or Low Protectionists

Broadly, IP Restrictors, sometimes referred to as “low protectionists,”¹¹ contend that IP protection has expanded too wide and far in recent decades and wish to put the miscreant genie of IP expansion back in the bottle. IP Restrictors are said to believe that the “public domain and copyright are inversely correlated: if one grows, the other must shrink.”¹² To IP Restrictors, maintaining a robust public domain is vital, given its primary function of providing “raw material for other works.”¹³ IP Restrictors include many of the leading scholars in intellectual property.¹⁴ A scholar at the forefront of the anti-expansionist front is Larry Lessig, who contends that IP expansion “locks down” culture and depletes the public domain.¹⁵

B. IP “Expansionists” or High Protectionists

In opposition to IP Restrictors are the IP Expansionists, also known as “high protectionists.”¹⁶ IP Expansionists are concerned that weak IP protection will lead to a tragedy of the commons “if intellectual works are too readily appropriated . . . and advocate strong . . . intellectual property rights . . . as the solution for this tragedy.”¹⁷ Expansionists, it is said, “view exemptions and privileges on the part of users or future creators as a tax on rights holders and have considerable sympathy for thinly disguised ‘sweat-of-the-brow claims.’”¹⁸ Perhaps the biggest IP Expansionist is Congress, which in recent years seems to never have met an IP bill it did not like. Worse still, leading IP analysts such as Mark Lemley contend that “[t]o a disturbing extent, Congress in recent years seems to have abdicated its role in setting intellectual property policy to the private interests who appear before it.”¹⁹ State legislation also seeks to expand IP protection in the area of

11 Justin Hughes, *Copyright and Incomplete Histographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 998 (2006) (referring to “those who opposed strong intellectual property [rights] . . . as the ‘low protectionists’ or ‘IP restrictors’”).

12 Paul M. Schwartz & William Michael Treanor, Eldred and Lochner: *Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 YALE L.J. 2331, 2337 (2003).

13 Steven D. Jamar, *Copyright and the Public Interest from the Perspective of Brown v. Board of Education*, 48 HOW. L.J. 629, 638 (2005).

14 Schwartz & Treanor, *supra* note 12, at 2343.

15 See LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* (2004).

16 Deborah Tussey, *iPods and Prairie Fires: Designing Legal Regimes for Complex Intellectual Property Systems*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 105, 115 (2007).

17 *Id.*

18 James Boyle, *Cultural Environmentalism and Beyond*, 70 LAW & CONTEMP. PROBS. 5, 11 (2007) (quoting James Boyle, *Enclosing the Genome?: What the Squabbles over Genetic Patents Could Teach Us*, in PERSPECTIVES ON PROPERTIES OF THE HUMAN GENOME PROJECT 97, 107–08 (F. Scott Kieff ed., 2003)).

19 Mark A. Lemley, *The Constitutionalization of Technology Law*, 15 BERKELEY TECH. L.J. 529, 532 (2000). Perhaps no one writes as prolifically and with such perceptiveness as Professor Lemley. My best line, I thought at least, was during a recent presentation at a fabulous conference on the right of publicity at Chapman Law School. I had a PowerPoint slide with a quote from Lemley and, being short on time, I zoomed past the slide, saying, “Who cares what Lemley thinks?” The IP academics in the

right of publicity.²⁰ IP Expansionists think more of good thing can't be bad and pooh-pah the notion that IP legislation and court decisions impose costs on society that outweigh the benefits.

Admittedly, like “the Sneetches” of Dr Seuss—some who had stars on their bellies and others who did not, and were subsequently mixed up in McMonkey McBean’s star-off machine—it can be hard to tell who is who on the roster of IP Restrictors and Expansionists.²¹ My own work, for example, could fall into both camps. When it comes to trademark expansion and particularly dilution, as well as the presumption of entitlement to injunctive relief in the motion picture copyright infringement context, I might be seen as a staunch Restrictionist.²² In contrast, critics might well see my work on black blues artists (advocating for distributive and corrective justice) as an expansion of IP rights.²³

The IP expansion versus restriction debate sets up some interesting contrasts and paradoxes. “Progressive” scholars are often in the Restrictionist camp, while corporate actors, and those we would typically deem conservative, are in the Expansionist camp. The notion of remuneration for black artists is progressive, yet it would be opposed by a strict Restrictionist. Similarly, an artists’ rights movement is progressive in tone, yet IP restrictions could reduce those rights at the time they are expanding for corporate actors and conglomerates. To date, there is little in the way of concrete normative principles to guide determinations of when IP expansion is good or IP restriction is bad.

C. The “Beat Down” of IP Restrictors by Congress and the Courts

The beef between IP Restrictors and Expansionists, in hip-hop terms, is a “beat down”²⁴—that is, a rout—in favor of the Expansionists. Each area of IP protection—copyright, trademark, and patent—has grown through legislation and judicial decisions.

1. Copyright Law Expansion

The expansion of copyright protection in the law has been no less than stunning, leading commentators to note that “the last century has witnessed a radical expansion in the scope of protections afforded copyright own-

crowd roared; the rest of the audience looked puzzled.

²⁰ See Patrick McGreevy, *A Bid to Protect Stars’ Images*, L.A. TIMES, July 23, 2007, at B1 (noting that proposed California legislation will expand retroactive post-mortem rights of publicity for non-relatives of dead celebrities).

²¹ See DR. SEUSS, *The Sneetches*, in THE SNEETCHES AND OTHER STORIES 3 (1961).

²² See Greene, *supra* note 7, at 614 (contending that trademark litigation in the context of expressive works imposes unjustified social costs); see also K.J. Greene, *Motion Picture Copyright Infringement and the Presumption of Irreparable Harm: Toward a Reevaluation of the Standard for Preliminary Injunctive Relief*, 31 RUTGERS L.J. 173 (1999) [hereinafter *Motion Picture*] (calling into question automatic grants of injunctive relief in the motion picture context).

²³ See *Copynorms*, *supra* note 8.

²⁴ UrbanDictionary.com, *Beat Down*, <http://www.urbandictionary.com/define.php?term=beat+down> (last visited Mar. 24, 2008).

ers.”²⁵ We could begin with protection of copyright owners—typically, major record label distributors—in sound recordings in 1971.²⁶ The 1980’s were relatively quiet on the copyright front, besides the Bern Amendments on the international side.²⁷ An artist-friendly amendment, the Visual Artists’ Rights Act (“VARA”), was enacted in 1990.²⁸ The law applied only to artists working in a fine art medium and was enacted, not out of solicitude for artists’ rights, but rather to comply with international obligations to protect “moral rights.”²⁹

Congress increased the scope of criminal copyright infringement in 1997.³⁰ Congress also added protection to sound recording owners for digital audio transmissions in 1995.³¹ In 1998, Congress passed landmark legislation to protect copyright owners’ rights on the internet.³² In 1998, Congress significantly extended the term of copyright.³³ Further, Congress enhanced damages for copyright infringement in 1999.³⁴

Copyright expansion has taken place at such a robust clip, analysts contend that in recent years “copyright has become . . . propertized. The duration and scope of copyright have expanded so much that they now resemble the ‘fee simple’ ownership held by landowners.”³⁵ Courts too can stand in as IP Expansionists—most famously, in the Supreme Court’s refusal to strike down the Copyright Term Extension Act (“CTEA”), which added an additional twenty years to existing copyrights.³⁶ The charge against the CTEA was led by Professor Lessig himself.³⁷ Nonetheless, a “beat down” of the restrictive view occurred in the Supreme Court.

2. Trademark Law Expansion

Just as copyright law protection has skyrocketed, analysts have similarly remarked that the “expansion of trademark rights has been particularly

²⁵ Tehranian, *supra* note 3, at 1210. Tehranian sets forth numerous consequences of the “dramatic theoretical shift in the underpinnings of copyright law . . .” *Id.* at 1211.

²⁶ See Sound Recording Protection Act, Pub. L. No. 92-139, 85 Stat. 390 (1971).

²⁷ See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

²⁸ Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 102 Stat. 5128 (1990) (codified as amended at 17 U.S.C. § 101 (2000)).

²⁹ *Id.*

³⁰ No Electronic Theft Act, Pub. L. No. 105-147, 111 Stat. 2678 (1997). The No Electronic Theft Act (“NET”) significantly enhanced liability for criminal copyright liability. See Eric Goldman, *A Road to No Warez: The No Electronic Theft Act and Criminal Copyright Infringement*, 82 OR. L. REV. 369, 373 (2003).

³¹ Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (1995).

³² Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

³³ Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

³⁴ Pub. L. No. 106-44, 113 Stat. 221 (1999).

³⁵ Michael A. Carrier, *The Propertization of Copyright*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 345, 345 (Peter K. Yu ed. 2007).

³⁶ See *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

³⁷ *Id.* at 191.

... dramatic”³⁸ Congress extended trademark protection for “intent to use” applications in 1998.³⁹ In 1995, Congress passed legislation that federalized the state law doctrine of trademark dilution.⁴⁰ In 1998, Congress extended trademark protection to mark holders.⁴¹ A similar dynamic of expansion has impacted patent law, where commentators have contended that IP expansion has become self-regenerative: “The assertion of or demand for property rights by some engenders the assertion of or demand for related property rights by others.”⁴²

Analysts have attributed the expansion of IP rights to two factors: the trend to treat IP rights as pure property rights, and the increase in value of intellectual property goods, which have become “a crucial set of corporate assets in the new information economy.”⁴³ IP expansion, it is said, creates tension with the notion of democratic culture: as “media companies have sought in increasingly aggressive ways to protect their existing rights and expand them further[,]” a serious danger is posed to freedom of expression.⁴⁴ Perhaps the most striking example of the willingness of rights holders in IP to use the law aggressively is the litigation strategy of the music industry, led by the Recording Industry Association of America (“RIAA”). The RIAA, at the behest of large record labels, has instituted thousands of lawsuits against digital file-sharers, as well as numerous suits against companies that produce file-sharing software.⁴⁵ Clearly, the purpose of the RIAA lawsuits was to intimidate and instill fear.⁴⁶ IP Restrictors, such as Professor Lessig, reject economic incentive theory by contending that “property rights in intellectual ideas enable owners to control their own works and ultimately stifle the creative process of others.”⁴⁷

³⁸ Greene, *supra* note 7, at 611; *see also* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1896 (2007) (noting that “courts, with some help from Congress, significantly broadened trademark law in the twentieth century”).

³⁹ Brooke J. Egan, Comment, *Lanham Act Protection for Artistic Expression: Literary Titles and the Pursuit of Secondary Meaning*, 75 TUL. L. REV. 1777, 1780 (2001).

⁴⁰ Federal Trademark Dilution Act of 1995, 15 U.S.C.A. § 1051 (2006).

⁴¹ Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, 112 Stat. 3064 (1998).

⁴² Sabrina Safrin, *Chain Reaction: How Property Begets Property*, 82 NOTRE DAME L. REV. 1917, 1921 (2007).

⁴³ Ben Depoorter, *The Several Lives of Mickey Mouse: The Expanding Boundaries of Intellectual Property Law*, 9 VA. J.L. & TECH. 4, ¶ 32 (2004) (quoting Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900-2000*, 88 CAL. L. REV. 2187, 2235 (2000)).

⁴⁴ Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 18 (2004).

⁴⁵ *See* Mark F. Schultz, *Fear and Norms and Rock & Roll: What Jambands Can Teach Us About Persuading People to Obey Copyright Law*, 21 BERKELEY TECH. L.J. 651, 659–60 (2006).

⁴⁶ *See id.* at 660.

⁴⁷ *See* Sonia K. Katyal, *Ending the Revolution*, 80 TEX. L. REV. 1465, 1472 (2002) (reviewing LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* (2001)).

II. THE RIGHT OF PUBLICITY AS AN EASY TARGET FOR IP RESTRICTORS

The right of publicity, like other forms of IP, has “shown a remarkable tendency to expand along some dimensions,”⁴⁸ particularly as to protected indicia of identity. Although it is contended that the right of publicity “is both hard to object to and hard to support[.]”⁴⁹ the right of publicity makes an easy target for IP Restrictors, especially as it moves outside the commercial realm and into the dimension of expression. While there is abundant scholarship critiquing the right of publicity, there are few truly robust defenses of the doctrine or its theoretical rationales. Most of those that exist are by students, not academics.⁵⁰

A. The Right of Publicity and its Fundamentally Weak Justifications

In recognition of costs imposed by intellectual property ownership, IP protections require analytical and pragmatic justification for their existence.⁵¹ IP Restrictionists point to justifications for limiting protection of intangible works by noting that exclusive rights in intangible IP works “can impose more costs on the public than can exclusion rights over tangibles.”⁵² Some of the social costs of IP protection include anticompetitive distortion, interference with creative production of works, and asymmetrical investment in research and development.⁵³

Much has been written about the growing tendency to treat IP just like any other form of property. To merely treat IP like any other form of property is fallacious: “real property and intellectual property analogies are unsatisfying from more than a theoretical point of view; they have direct impact on the manner in which benefits are distributed as between right-holders and the public.”⁵⁴ As Professor Litman has remarked, “To agree to treat a class of stuff as intellectual property, we normally require a showing that, if protection is not extended, bad things will happen that will outweigh the resulting good things.”⁵⁵

48 David Westfall & David Landau, *Publicity Rights as Property Rights*, 23 *CARDOZO ARTS & ENT. L.J.* 71, 91 (2005).

49 *Id.* at 122.

50 See, e.g., Seth A. Dymond, Note, *So Many Entertainers, So Little Protection: New York, The Right of Publicity, and the Need for Reciprocity*, 47 *N.Y.L. SCH. L. REV.* 447 (2003) (arguing that New York should expand right of publicity protection to commensurate levels of California and Tennessee).

51 See Harry First, *Controlling the Intellectual Property Grab: Protect Innovation, Not Innovators*, 38 *RUTGERS L.J.* 365, 369 (2007) (remarking that “[p]roperty rights (and intellectual property rights) are justified only by their social utility”).

52 Wendy J. Gordon, *Authors, Publishers, and Public Goods: Trading Gold for Dross*, 36 *LOY. L.A. L. REV.* 159, 159 (2002).

53 Safrin, *supra* note 42, at 1966–67.

54 Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *NOTRE DAME L. REV.* 397, 409 (1990).

55 Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717, 1729 (1999).

The right of publicity has inherently weak theoretical justifications compared to the IP regimes of patent and copyright law. It is said that the “weakness of the rationales generally proffered for the right of publicity undermines the argument that there is a compelling or substantial government interest to limit dissemination of image copies.”⁵⁶ In the case of patent law—which provides wonderful useful inventions and concomitant products such as Viagra—and copyright law—which results, theoretically, in an expanded array of film, music, theatre, literature, dance, and computer programs (huh?)—the justification seems self-evident. Patent and copyright law both find their basis in the Constitution,⁵⁷ and, despite contentions by a few scholars (such as Ray Ku) that copyright has outlived its usefulness in the digital age,⁵⁸ scholars for the most part agree that these regimes serve a valuable social function.⁵⁹ Trademark law, unlike copyright, patent, and right of publicity, is not based on incentive theory, but rather in theories of economic efficiency in connection with reduced consumer search costs. In contrast, as Professor Stacey Dogan has posited, the theoretical justifications for the right of publicity are far more elusive.⁶⁰ Numerous scholars have outlined the fundamentally weak basis of publicity rights in connection with theoretical rationales for intellectual property.⁶¹

B. Economic Incentive Theory

Incentive theory comprises the main theoretical basis for copyright and patent protection. Incentive theory posits that, if the law did not provide an economic incentive for authors and inventors, society would see less production of artistic creation and scientific invention.⁶² In contrast to trademark and copyright, where economic analyses are fruitful and multiply, it has been noted that “few economic analysts of the law have studied the right of publicity.”⁶³ The Supreme Court has only touched upon publicity rights once—in a weird case involving a news station’s unauthorized rebroadcast of a cannonball act⁶⁴—setting forth an economic incentive rationale for the right of publicity.⁶⁵

⁵⁶ F. Jay Dougherty, *All the World’s not a Stoooge: The “Transformativeness” Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1, 69–70 (2003).

⁵⁷ See U.S. CONST. art. I, § 8, cl. 8.

⁵⁸ See Raymond Shih Ray Ku, *The Creative Destruction of Copyright: Napster and the New Economics of Digital Technology*, 69 U. CHI. L. REV. 263 (2002).

⁵⁹ See, e.g., Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900–2000*, 88 CAL. L. REV. 2187 (2000); Tehranian, *supra* note 3.

⁶⁰ See Dogan & Lemley, *supra* note 5, at 1162.

⁶¹ See, e.g., Dougherty, *supra* note 56, at 69 (remarking upon the “weakness of the rationales generally proffered for the right of publicity . . .”).

⁶² See, e.g., Carl H. Settlemeyer III, Note, *Between Thought and Possession: Artists’ “Moral Rights” and Public Access to Creative Works*, 81 GEO. L.J. 2291, 2291 (1993) (noting that economic incentives are a “fundamental assumption of the [U.S.] copyright system . . .”).

⁶³ Vincent M. de Grandpré, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 77 (2001).

⁶⁴ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

⁶⁵ See *id.* at 575 (holding that broadcast of plaintiff’s cannonball act deprived plaintiff of the eco-

On the one hand, it is hard to argue against incentive theory in the abstract—we have concrete proof that the United States leads the world in creative and technological production.⁶⁶ On the other hand, the treatment of a highly creative group—African-American music artists and composers who operated without creative incentives—hints that incentive theory itself might well be fundamentally flawed. There has been little, if any, “systematic study of the effects of such [intellectual property rights] on the hundreds of [IP] industries that they are designed to encourage.”⁶⁷ Skeptics question the utility of patent and copyright incentives, noting that “other incentive structures exist to stimulate the creation of new works and inventions”⁶⁸ Putting that aside, the right of publicity hardly seems self-evident at all; there is no tangible end-product and it is difficult to quantify the value of “fame.”

Moreover, numerous analysts note that it seems silly to suggest that individuals need an added incentive to become famous. Professor Kwall has argued that “creativity is spurred largely by incentives that are noneconomic [sic] in nature.”⁶⁹ Analysts have long noted that our society already rewards successful athletes, actors, and entertainers for their contributions with sizable sums of money, amply compensating them for their “sweat equity.”⁷⁰ Commentators have noted that it might even be possible for a misappropriation to “actually increase the celebrity’s market power for future endorsements.”⁷¹

Other commentators posit that “[n]ot a shred of empirical data exists to show that anyone would change her behavior with regard to her primary activity . . . [as a sports star or entertainer] if she knew in advance that, after achieving fame, she would be unable to capture licensing fees from . . . [merchandising].”⁷² If one becomes a famous rock star, she gets a fat recording contract, a film deal, and a perfume line, *a la* J. Lo. Accordingly, publicity rights in fact do “not provide any meaningful incentives for creativity, and they can be attacked as an unfair redistribution of wealth from

conomic value of the act under Ohio right of publicity law). The *Zacchini* court held that the right of publicity “provides an economic incentive” for performers. *Id.* at 576.

⁶⁶ See 142 CONG. REC. S12201, S12207–08 (daily ed. Oct. 2, 1996) (statement of Sen. Specter) (“American business and investors have been extremely successful and creative in developing intellectual property and trade secrets. America leads the nation’s [sic] of the world in developing new products and new technologies.”).

⁶⁷ Tussey, *supra* note 17, at 118.

⁶⁸ Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. & TECH. L. REV. 189, 216 (2006).

⁶⁹ Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1970 (2006).

⁷⁰ Fred M. Weiler, Note, *The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity*, 13 CARDOZO ARTS & ENT. L.J. 223, 243 (1993). Weiler notes that the economic incentive argument in connection with the right of publicity “fails to distinguish between the entertainment value generated by celebrities and the value of what is secured by a right of publicity.” *Id.* at 244.

⁷¹ Matthew Savare, Comment, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 171 (2004).

⁷² Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL J. ART & ENT. L. 283, 306 (2000).

consumers to famous people.⁷³ Incentive theory is ill-suited to justify the right of publicity.

C. Incentives and “Toxic” Fame

One of the purported benefits of trademark law is that it adds to social utility by encouraging mark-holders to invest in quality product and services. The economic perspective of trademark law posits that trademark “provides incentives to create higher quality products and that consumers will benefit from the higher quality.”⁷⁴ Assuming that the right of publicity is an analytical cousin of trademark, the economic incentive paradigm of quality can be analogized to the infamous glove in the O.J. Simpson case—it simply does not fit. This is because the right of publicity applies to both the famous and the infamous; that is, to “Einstein as well as Frankenstein.”⁷⁵

If celebrities are analogues to trademark producers, in modern society there may in fact be reduced incentives to create a “higher quality product” vis-à-vis persona. We live in the age of “toxic” fame, where celebrities often seem to engage in outlandish and anti-social behavior, which increases value in marketability. In the world of celebrity “hip-hop,” for example, it is a badge of honor to be incarcerated, and a badge of shame to testify or “snitch” on unlawful conduct.⁷⁶ Professor Paul Butler, in a thoughtful exploration of hip-hop’s impact on criminal law, argues that to “say hip-hop destigmatizes incarceration understates the point: Prison, according to the artists, actually stigmatizes the government.”⁷⁷

As the careers of MC Hammer and Vanilla Ice both demonstrate, lack of “street cred” can be fatal to a continuing career in the industry. Toxic fame is certainly not limited or generic to the hip-hop nation alone. Celebrities such as Britney Spears, Paris Hilton—whose only talent seems to be the ability to generate attention for being famous—and Lindsay Lohan, have all had well-publicized problems with alcohol and drug addiction.

D. Misappropriation Rationales

This great republic was essentially built upon “takings” from people—land from Native Americans and Mexico, labor from African slaves and Chinese rail workers. However, a bedrock principle of American law dic-

⁷³ Gerard N. Magliocca, *From Ashes to Fire: Trademark and Copyright in Transition*, 82 N.C. L. REV. 1009, 1039 (2004).

⁷⁴ Chad J. Doellinger, *A New Theory of Trademarks*, 111 PENN. ST. L. REV. 823, 842 (2007) (citing work of William M. Landes and Richard A. Posner). But Doellinger contends that concepts of “property, incentives and the public domain . . . have no relevance to trademark jurisprudence.” *Id.* at 857.

⁷⁵ This phrase is borrowed from an Anthony Robins motivational tape.

⁷⁶ See Paul Butler, *Much Respect: Toward A Hip-Hop Theory of Punishment*, 56 STAN. L. REV. 983, 997–98 (2004).

⁷⁷ *Id.* at 997. He contends that hip-hop culture “justifies rather than excuses some criminal conduct.” *Id.* at 998.

tates that we not reward “free-riders”—those who would appropriate value created by others and thus “reap where [they have] not sown”⁷⁸ This can be seen in recent debates about the role of welfare in our society and the indelible image of the “welfare queen”—an inner-city black woman who lives lavishly off the government dole.⁷⁹ The stereotype of the welfare queen is a classic free-rider metaphor. The misappropriation doctrine is a broad principle that “posit[s] that the inherent wrongfulness of some acts requires intervention by the state to prevent undesirable outcomes and to deter socially reprehensible acts.”⁸⁰ In intellectual property law there is great concern for “free-riders” who take the benefits established by others.

In the right of publicity context, commercial use of a celebrity’s or non-celebrity’s image would appear to be a clear-cut case of free-riding. So, for example, where a portable toilet manufacturer decided to call its product, “Here’s Johnny, The World’s Foremost Comedian,” it sought to trade off of the fame of comedian Johnny Carson, reaping a premium off of a fame it had not sown.⁸¹ However, leading scholars are openly disdainful of a broad free-rider metaphor of misappropriation. Richard Posner, for example, has called for jettisoning misappropriation as “the overarching principle that would rationalize intellectual property law as a whole and provide guidance for altering, perhaps expanding, the scope of that law.”⁸²

Posner calls upon the recognition that “free riding on intellectual property is not always a bad thing[.]”⁸³ In the right of publicity context, Posner contends that no celebrity expects to fully externalize all gains in the value of image: a celebrity

is unlikely to invest less than he would otherwise do in becoming a movie star or other type of celebrity merely because he’ll be unable to appropriate the entire income [arising from use of name or likeness]; there is free riding but not the type that threatens to kill the goose that lays the golden eggs⁸⁴

Similarly, Professor Lemley openly “disses” the free riding paradigm, arguing that “there is no need to fully internalize benefits in intellectual property” and that such efforts will result in a net loss to society and invite anti-social behavior, such as rent-seeking.⁸⁵

⁷⁸ See *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918). This case is the foundational basis for IP misappropriation doctrine.

⁷⁹ The “Welfare Queen” stereotype arose during Ronald Reagan’s 1976 presidential campaign, and was based on the belief in a “sexually irresponsible [person] who bred children just to fatten her welfare check and then wasted the money recklessly on herself.” Dorothy E. Roberts, *Privatization and Punishment in the New Age of Reproductives*, 54 EMORY L.J. 1343, 1345 (2005). An irony of the stereotype was that “African-Americans have never constituted a majority of those on welfare.” Peter Edelman, *Welfare and the Politics of Race: Same Tune, New Lyrics?*, 11 GEO. J. ON POVERTY L. & POL’Y 389, 392 (2004).

⁸⁰ Greene, *supra* note 7, at 617.

⁸¹ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983).

⁸² Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621, 621 (2003).

⁸³ *Id.* at 625.

⁸⁴ *Id.* at 634.

⁸⁵ Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1032 (2005).

E. The “Overexposure” Rationale

Many celebrities carefully guard and limit use of their images; perhaps the greatest in this respect was actress Greta Garbo, who famously wanted “to be let alone.”⁸⁶ This is in sharp contrast to pop singer Janet Jackson, who in 2004, had an infamous “wardrobe malfunction” on national television—at the Super Bowl, no less.⁸⁷ Janet’s brother, Michael Jackson, holder of the record for best-selling album, *Thriller*,⁸⁸ was also accused of overexposure of a different body part.⁸⁹ Overexposure in the celebrity context results in a diminished career; in slang, it is known as being “played out.”⁹⁰ In economic parlance, “the identity of celebrities may be over- . . . exploited . . . [resulting in] negative externalities.”⁹¹ However, the unholy marriage of the entertainment industry and advertising has made it much more likely that we will see the accumulation of profit from greater use of celebrity images.⁹² It is noted that

[a]dvertising executives, in a concerted effort to improve their business, are attempting to reinvent the marriage between advertising and entertainment . . . industries . . . [by] expanding product placements in films and television shows, creating shows around products, becoming sole sponsors of . . . shows . . . [and further exploiting celebrity image].⁹³

The over-exposure rationale for publicity rights—sometimes called a theory of allocative efficiency—posits that, if the law allows unlimited use of a celebrity’s image, that image will be worth less over time, as the public will grow tired of it.⁹⁴ Professor Lemley has noted that the Federal Circuit has endorsed the “overexposure” theory and contends that overexposure theory, “is not only distinct from, but indeed largely at odds with, the classic [economic] incentive story.”⁹⁵ The overexposure theory is very close, if not identical, to a dilution-by-blurring theory. Under the Lanham Act, a “famous” trademark is entitled to protection against dilution.⁹⁶ Blurring occurs “when a third party uses a famous mark to identify its own product

⁸⁶ Peter B. Flint, *Greta Garbo, 84, Screen Icon who Fled her Stardom, Dies*, N.Y. TIMES, Apr. 16, 1990, <http://www.nytimes.com/specials/magazine4/articles/garbo1.html>.

⁸⁷ Keith Olbermann, *Countdown with Keith Olbermann: Janet Jackson’s Wardrobe Malfunction*, MSNBC.COM, Feb. 3, 2004, <http://www.msnbc.msn.com/id/4147857/>.

⁸⁸ MICHAEL JACKSON, *THRILLER* (Sony Records 1982).

⁸⁹ See Mike Brooks et al., *Jackson Booked on Suspicion of Molestation*, CNN.COM, Nov. 25, 2003, <http://www.cnn.com/2003/LAW/11/20/jackson/>.

⁹⁰ UrbanDictionary.com, *Played Out*, <http://www.urbandictionary.com/define.php?term=played+out> (last visited Mar. 16, 2008).

⁹¹ de Grandpré, *supra* note 63, at 103.

⁹² See Matthew Savare, Comment, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 179–80 (2004).

⁹³ *Id.*

⁹⁴ See McKenna, *supra* note 4, at 269–70 (citing Landes and Posner’s contention that “overgrazing on identity leads to “face wearout,” a reduction in the value of one’s persona due to declining interest in the person as her persona is increasingly used”).

⁹⁵ Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 142 (2004).

⁹⁶ 15 U.S.C. § 1125(c) (2000).

in a nonderogatory way.”⁹⁷ The theory underlying dilution is that, if the law permits willy-nilly use of a trademark, even if no consumer confusion is evident, there is still harm to the mark-holder, who has invested goodwill in its mark.

Dilution law, however, has been subject to scathing critique, particularly the theory of dilution-by-blurring, which lacks almost any objective evidence of harm in the trademark context. It is said that the “mismatch between dilution’s stated purpose and hidden goal, [of preventing free-riding on famous marks, leaves dilution as] a clumsy and largely incoherent doctrinal device.”⁹⁸ In *Moseley v. V Secret Catalogue, Inc.*, the Supreme Court attempted to put a limitation on dilution theory by requiring proof of actual dilution.⁹⁹ However, Congress soon overturned that decision legislatively at the behest, and for the benefit of, large corporate mark-holders.¹⁰⁰ Analysts have discounted the overexposure theory.

F. Personality Theory

A much stronger candidate as a justification for publicity rights is personality theory, although it was frowned upon in dicta in the *Zacchini* case.¹⁰¹ Scholars such as Justin Hughes have tied personality theory, of which moral rights doctrine is a subset, to the right of publicity.¹⁰² The philosophical basis of personality theory draws from the works of Hegel and Kant.¹⁰³ European regimes, under the auspices of the “droit moral,” recognize that there are intangible characteristics of IP that cannot be quantified in pure economic terms.¹⁰⁴

Professor Roberta Kwall is a leading proponent of the use of moral rights type personality theory in the right of publicity context.¹⁰⁵ Kwall posits that doctrinal similarities exist between moral rights doctrine and the right of publicity—notably, that both doctrines “seek to protect the integrity of texts by rejecting fluidity of interpretation by the public in favor of the

⁹⁷ Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1058 (2006).

⁹⁸ David J. Franklyn, *Debunking Dilution Doctrine: Toward a Coherent Theory of the Anti-Free-Rider Principle in American Trademark Law*, 56 HAST. L.J. 117, 117 (2005).

⁹⁹ See 537 U.S. 418, 433 (2003).

¹⁰⁰ See *Louis Vuitton Malletier v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

¹⁰¹ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

¹⁰² Justin Hughes, “Recoding” *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 924 (1999). For an interesting critique of Hughes’ thesis, see Sarah LaVoi, *The Value of Recoding Within Reason: A Review of Justin Hughes’ “Recoding” Intellectual Property and Overlooked Audience Interests*, 14 DEPAUL-LCA J. ART & ENT. L. 171, 172 (2004) (contending that Hughes’ work “overlooks the importance of some recoding freedom as a tool necessary for valuable cultural revolution”).

¹⁰³ Linda J. Lacey, *Of Bread and Roses and Copyrights*, 1989 DUKE L.J. 1532, 1541–42.

¹⁰⁴ “Droit moral” is French for “moral rights.” Two of the main rights consist of the right to be known as the author of the work (paternity), and the right to prevent mutilations or distortions of the work that are prejudicial to the author’s honor or reputation (integrity). See Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 5 (1985).

¹⁰⁵ Roberta Rosenthal Kwall, *Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights: A Blueprint for the Twenty-First Century*, 2001 U. ILL. L. REV. 151.

author's interpretation," and that both doctrines "focus on assaults to the author's reputation and personality."¹⁰⁶ Professor Kwall's approach would focus less on distinctions between commercial and non-commercial use, but rather on "misappropriations or mutilations of one's persona in situations where damage to the human spirit, rather than economic harm, is the focus."¹⁰⁷ Right of publicity restrictionists, such as Professor Dougherty, point out that a personality theory of the doctrine "does not provide a rationale for a *property* type right which is assignable and descendible—in other words a right of publicity, as understood in U.S. jurisprudence."¹⁰⁸

However meritorious personality theory may be in the context of the right of publicity, it carries a double-edged sword for artistic development. For example, conduct that constitutes a "mutilation" might or might not be actionable as defamatory. However, defamation law sets very high standards of proof and injury to prevent conflict with First Amendment principles,¹⁰⁹ and, indeed, the harshest criticism of the right of publicity focuses on the harm it can inflict on free expression.

G. The Right of Publicity as the Cesspool of IP Expansion

The right of publicity might be seen as the cesspool of accumulated "gunk" arising out of the expansion of IP. At its worse, we see rich celebrities, such as Tiger Woods, who sought to enjoin a painter from selling art depicting his image at the historic 1997 Masters tournament,¹¹⁰ or, more recently, former celebrities, such as the late Evel Knievel, attempting to enjoin rapper Kanye West from re-enacting Knievel's 1970's era motorcycle jump across the Colorado River in West's rap video.¹¹¹ Another way of looking at the right of publicity, however, is from the perspective of artists' rights. When we think of musical artists, for example, one cannot help but note that, as soon as artists establish a successful music career, they attempt to move out of the music industry.

The music industry is well known for its overreaching and exploitative conduct, with standard contracts described by music artists as "unconscionable, indentured servitudes, and . . . impossible . . ." ¹¹² Recent years have witnessed bankruptcies of top-selling artists and royalty disputes that reveal

¹⁰⁶ See *id.* at 158.

¹⁰⁷ *Id.* at 166.

¹⁰⁸ See, e.g., F. Jay Dougherty, Foreword, *The Right of Publicity—Towards a Comparative and International Perspective*, 18 LOY. L.A. ENT. L.J. 421, 443 (1998).

¹⁰⁹ *New York Times v. Sullivan*, 376 U.S. 254, 279–80 (1963) (holding that the constitution guarantees "a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with 'actual malice' . . .").

¹¹⁰ *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915, 918 (6th Cir. 2003).

¹¹¹ Associated Press, *Evil Knievel Sues Kanye West Over Video*, MSNBC.COM, Dec. 12, 2006, <http://www.msnbc.msn.com/id/16171599>.

¹¹² Tracy C. Gardner, *Expanding the Rights of Recording Artists: An Argument to Repeal Section 2855(b) of the California Labor Code*, 72 BROOK. L. REV. 721, 722 (2007) (internal quotations omitted).

sharp business practices and sham accounting.¹¹³ The same can be said for the film industry, where a recent lawsuit claims that, despite worldwide profits of billions of dollars, the film distributors of the *Lord of the Rings* have failed to pay gross profits to the estate of Tolkien.¹¹⁴ These cases illustrate that the nature of IP expansion has been to reward entertainment conglomerates, with proportionally little “trickle down” to artists and creators. For example, it is said that while the record label of multi-platinum artist Toni Braxton “is estimated to have received net profits between sixty and seventy million dollars from her record sales Braxton only received approximately five million dollars, or less than three percent of the gross.”¹¹⁵ The right of publicity, then, ends up being a cesspool where music and other artists suck up the dregs of IP protection.

IP expansion, economic analysts say, also encourages “rent seeking”—opportunistic conduct by actors seeking to extract surplus value from IP protection—often with consequences that add deadweight losses to society, such as frivolous and semi-frivolous litigation, demands for excessive damages, and claims for injunctive relief in the classic “holdover” sense. I call this conduct IP “nihilism.” It is a mindset that says, “Let’s find a case where we can go after a major studio or record label or TV network for the most trivial violation of IP rights, demand an injunction, and extract a large settlement plus attorney’s fees.” The film studios, record labels, and RIAA’s of the world have made it a priority to pursue every claim of trademark or copyright infringement possible through cease and desist letters and, in the case of RIAA, mass litigation against consumers.¹¹⁶

In the trademark context, I characterized this conduct as “abusive trademark litigation.”¹¹⁷ Much right of publicity litigation could similarly be characterized as abusive in nature—plaintiffs bringing claims where there are no real damages or significant non-economic damages, either as rent-seekers or to send a “message” regarding boundary intrusion on a property right. If creators were truly the beneficiaries of their creativity—for example, if we had a copyright and contract system in the music industry that paid fair compensation—perhaps we might not need a “cesspool” of residual right of publicity claims.

¹¹³ See, e.g., *id.*

¹¹⁴ Janet Shprintz, *Tolkien Estate Sues New Line*, VARIETY, Feb. 11, 2008, <http://www.variety.com/article/VR1117980703.html>.

¹¹⁵ David C. Norrell, Comment, *The Strong Getting Stronger: Record Labels Benefit from Proposed Changes to the Bankruptcy Code*, 19 LOY. L.A. ENT. L.J. 445, 456 (1999).

¹¹⁶ See, e.g., Ray Beckerman, *How the RIAA Litigation Process Works* (Jan. 11, 2008), http://info.riaalawsuits.us/howriaa_printable.htm.

¹¹⁷ Greene, *supra* note 7, at 614.

III. RIGHT OF PUBLICITY STORIES

Stories are a way of helping to understand how abstract legal principles work in the “real” world.¹¹⁸ Right of publicity stories reveal three facets of the publicity rights. Too little protection results in dignitary harms that society should find unacceptable, but too much protection supports restrictionist arguments that the right of publicity dampens creative cultural activity. Individuals at the lower end of the social hierarchy—the non-celebrity and the “Aunt Jemima”—can suffer exploitation with no restriction on the use of image in both expressive and commercial settings. Famous individuals, such as rapper, Chuck D., can show dignitary harm from use of persona. On the other hand, the dignitary interests of a cultural icon, such as Rosa Parks, might need to take a back seat in the context of creative expression. Additionally, the case of 50 Cent reflects ambivalence between those who trade in “toxic” fame and those concerned with dignity/moral rights.

A. The Under-Protection of Non-Celebrities

Although under a majority view the right of publicity protects both celebrities and non-celebrities alike,¹¹⁹ it is not often called “the celebrity right of publicity” for nothing. While the right of publicity might be said to overprotect celebrities, it tends to under-protect non-celebrities: non-celebrities merely have a theoretical right of publicity that “is often neglected in practice.”¹²⁰ Much like federal trademark dilution law,¹²¹ which seems to provide the most protection to the big companies that need it the least, the right of publicity provides little protection to the “little person” who arguably needs protection from well-financed entities, such as film producers and record labels.

This point was brought home to me quite vividly when I did a consultancy project on the right of publicity a few years ago. Our client was a non-celebrity whose photographic image was used fairly extensively in a major Hollywood motion picture without his consent. Under California’s right of publicity statute, set forth in Civil Code section 3344,¹²² it was unlikely he could assert a claim. This is because the statutory right of publicity in California requires use in advertising or merchandising,¹²³ and it is

¹¹⁸ See generally JANE C. GINSBURG, ROCHELLE COOPER DREYFUS, *INTELLECTUAL PROPERTY STORIES* 2–4 (2006).

¹¹⁹ See, e.g., Jordan Tabach-Bank, *Missing the Right of Publicity Boat: How Tyne v. Time Warner Entertainment Co. Threatens to “Sink” the First Amendment*, 24 LOY. L.A. ENT. L.J. 247, 254 (2004) (noting that a majority of jurisdictions extend “protection to non-celebrities on the theory that fame or notoriety goes to the endgame of commercial damages, not to the existence of the right”).

¹²⁰ Claire E. Gorman, *Publicity and Privacy Rights: Evening Out the Playing Field for Celebrities and Private Citizens in the Modern Game of Mass Media*, 53 DEPAUL L. REV. 1247, 1248 (2004).

¹²¹ See The Lanham Trademark Act, 15 U.S.C. § 1125(a) (2000).

¹²² CAL. CIV. CODE § 3344 (West 2008).

¹²³ *Id.* (prohibits use of a person’s “name, voice, signature, photograph, or likeness . . . on or in

doubtful at best that the Code would include motion picture use as advertising use.

However, California provides the broadest protection to identity appropriation under state common law.¹²⁴ The common law right of publicity in California does not require use in advertising, but rather use “to defendant’s advantage.”¹²⁵ Clearly, the motion picture studio’s use here was to its advantage—out of a large universe of images, it chose our client’s, and developed script around use of the image. However, it is doubtful a non-celebrity could prevail where his photo or likeness is displayed in a motion picture in California. The studio attorneys vehemently and repeatedly cited the case of *Polydoros v. Twentieth Century Fox Film Corp.*¹²⁶ in defending the claim.

In *Polydoros*, the plaintiff sued a motion picture studio and its producers for use of his childhood image as “Squints” Palledorous in the hit film “*The Sandlot*.”¹²⁷ The film’s director was a childhood friend of Mr. Polydoros and reconstructed the image of his friend for the fictional character “Squints,” which was also plaintiff’s childhood nickname.¹²⁸ In rejecting plaintiff’s right of publicity claims, the *Polydoros* court gave precedence to First Amendment values of free expression for a film producer over the interests of the plaintiff.¹²⁹

Our legal team counter-argued that the display of a photographic image in a motion picture is very different from reconstructing the persona of a childhood friend. The use of Squints Palledorous was transformative in nature; the exhibition of an image in a film is not—nothing was changed in exhibiting the image.¹³⁰ If the studio’s position is correct, it would mean that the image of any American can be displayed and incorporated as a fictional element in a film without that person’s consent. That sounds terribly wrong, at least from a privacy perspective. It is also wrong today to assume that there is always little economic gain in taking the name and likeness of non-famous individuals. The reality television explosion demonstrates the value of non-celebrity images through the use of using unknown

products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products . . . without . . . prior consent . . .”).

¹²⁴ See Tara B. Mulrooney, *A Critical Examination of New York’s Right of Publicity Claim*, 74 ST. JOHN’S L. REV. 1139, 1159 (2000) (noting that California’s protection of publicity rights is broader than New York’s; it even “adds a person’s signature to the list of protected attributes . . .”).

¹²⁵ *Eastwood v. Sup. Ct.*, 198 Cal. Rptr. 342, 347 (Ct. App. 1983).

¹²⁶ 79 Cal. Rptr. 2d 207 (Ct. App. 1997).

¹²⁷ *Id.* at 208.

¹²⁸ *Id.*

¹²⁹ *Id.* at 210.

¹³⁰ See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (the court grafted the transformative test from copyright’s fair use doctrine to uphold an artists rendering of a charcoal drawing of the Three Stooges as protected conduct, noting expression that is “a literal depiction or imitation of a celebrity for commercial gain” is a violation of publicity rights). The use of copyright standards in right of publicity cases has been harshly criticized. See Dogan & Lemley, *supra* note 5, at 1187 (contending that drawing analogies between copyright law and the right of publicity “is both misleading and dangerous”).

“actors” in their shows.

Even had the client been able to establish liability on the claim in the face of *Polydoros*, his damages—due to lack of commercial value to his identity—would have been negligible, if cognizable at all. A non-celebrity’s harms will be wholly non-economic in nature, given the lack of any marketable value for image. Here an interesting doctrinal conundrum occurs. Typically, where harms cannot be quantified, courts often grant injunctive relief. However, injunctive relief in the expressive context of film carries severe free speech dangers. Notwithstanding those dangers, courts do not hesitate to grant injunctive relief as a matter of course in both the copyright and trademark context—it is axiomatic that copyright infringement triggers an automatic presumption of irreparable harm.¹³¹ In contrast, in the right of publicity context and expressive use, courts rarely grant preliminary injunctions, and there is no automatic presumption of harm as in the copyright and trademark context.¹³²

For non-celebrities then, the right of publicity is essentially a “right without a remedy.”¹³³ Even where a non-celebrity plaintiff can establish a claim, problems in establishing damages will foreclose an effective cause of action. For some analysts, this is considered a good thing, as they deem it “folly . . . [to] exten[d] the right of publicity to noncelebrities [sic] who cannot demonstrate that their identity has any significant commercial value.”¹³⁴ However, denying a publicity claim to a non-celebrity discounts personality rationales of personhood. Even if good reasons exist to restrict publicity claims in the non-celebrity conduct—and, some exist, particularly threats to free expression—the reasons for providing some protection to non-celebrities seem compelling. Arguments against non-celebrity right of publicity claims,¹³⁵ regardless of merit, in effect value commercial speech over rights of personhood.¹³⁶

B. MC Hammer: The Tale of Overexposure

Perhaps no artist was hotter in the early 1990’s on the hip-hop scene than MC Hammer. From around 1990 through 1991, he produced a string of hits, including “Let’s Get It Started”¹³⁷ and “U Can’t Touch This.”¹³⁸

¹³¹ For an overview of preliminary injunctive relief in the copyright context, see *Motion Picture*, *supra* note 22.

¹³² See, e.g., *Michaels v. Internet Entm’t Group*, 5 F. Supp. 2d 823 (C.D. Cal. 1998) (limiting injunctive relief of TV star Pamela Anderson for use of name and likeness in the context of a self-made sex tape marketed by defendants, but granting full injunctive relief under copyright claim).

¹³³ There is a “common law principle, recognized by the Supreme Court as early as *Marbury v. Madison*, that a right without a remedy is not a right at all.” *Doe v. County of Ctr., Pa.*, 242 F.3d 437, 456 (3d Cir. 2001).

¹³⁴ See Alicia M. Hunt, Comment, *Everyone Wants to be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 NW. U. L. REV. 1605, 1610 (2001).

¹³⁵ See *id.* at 1611.

¹³⁶ *Id.* at 1610.

¹³⁷ M.C. HAMMER, *Let’s Get it Started*, on LET’S GET IT STARTED (Capitol Records 1988).

¹³⁸ M.C. HAMMER, *U Can’t Touch This*, on PLEASE HAMMER, DON’T HURT ‘EM (Capitol Records

Along the way he generated millions of dollars in album sales, as well as allegations of copyright infringement.¹³⁹ He might be most famous—not for the catchy music and amazing dance moves he created—but for blowing millions of dollars with extravagant spending and a huge “posse,” which was reputed to have cost him around \$500,000 per month.¹⁴⁰ By 1992, his career had flamed out, and he declared bankruptcy in 1996.¹⁴¹ He lost pretty much everything, perhaps most tragically, the catalog and copyright ownership of his songs.¹⁴²

Hammer is an example of an artist who was overexposed. In addition to recording songs and touring, he performed in television commercials for Taco Bell,¹⁴³ and even had a Saturday morning cartoon for children featuring his image.¹⁴⁴ We could probably find other examples of artists whose careers suffered due to overexposure. My short list would include the Spice Girls, Pee Wee Herman, and Vanilla Ice. A warning sign of overexposure is the proliferation of parodies about an artist or individual. In the case of Vanilla Ice and Hammer, the parodies could be particularly vicious.¹⁴⁵ As a result, it becomes “uncool” to buy records or attend performances of the artist. Clearly, there is something intuitively attractive about an overexposure theory. Even skeptics of overexposure concede that tedium with a persona “may be accelerated, at least in terms of chronological time, as a result of overexposure.”¹⁴⁶

However, attempting to prove causation between decline of the value of persona and overexposure is likely a fruitless task. Moreover, the examples of overexposure result not from publicity right violations, but from overuse by celebrities themselves. Still, if a link could be established between overexposure and decline of value of persona, it would perversely lend credence to the much-maligned theory of dilution by blurring.

C. Aunt Jemima: The Tale of Misappropriation/Unjust Enrichment

Aunt Jemima is a seminal figure in trademark law. One of the early leading cases on a core trademark doctrine (the related goods doctrine) involved the question of whether a defendant could use the mark “Aunt Je-

1990); see also Steve Huey, MC Hammer Biography, All Music Guide, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:kifrxq95ld6e~T1> (last visited Mar. 18, 2008) [hereinafter Hammer Biography].

¹³⁹ Hammer Biography, *supra* note 138.

¹⁴⁰ See *id.*; see also Norrell, *supra* note 115, at 455–56.

¹⁴¹ Hammer Biography, *supra* note 138.

¹⁴² *MC Hammer Sells Back Catalog*, YAHOO! MUSIC, July 21, 2006, <http://music.yahoo.com/read/news/34343748>.

¹⁴³ IMDB.com, M.C. Hammer, <http://www.imdb.com/name/nm0358479/otherworks> (last visited Mar. 12, 2008).

¹⁴⁴ Hammer Biography, *supra* note 138.

¹⁴⁵ See, e.g., Vanilla Ice Parody with Jim Carrey, <http://www.youtube.com/watch?v=XoWdYYKdbLI>; MC Hammer Parody, <http://www.youtube.com/watch?v=plkyqmck9B8>; WEIRD AL YANKOVIC, *I Can't Watch This*, on OFF THE DEEP END (Volcano Ent. 1992) (parody of M.C. Hammer's song, *U Can't Touch This*).

¹⁴⁶ McKenna, *supra* note 4, at 270.

mima” for pancake syrup, in light of the fact that the complainants had, to that point, limited their production to self-rising flour.¹⁴⁷ The Second Circuit held that it could not, spawning the “Aunt Jemima” doctrine, as it is known, to this day.¹⁴⁸ The right of publicity story, like much of the history of blacks in IP law, is less well known. In the late 1800’s, the R.T. Davis Mill and Manufacturing Company was looking for a “mammy” type black woman to be the marketing face for its pancake mix. Reputedly, the first Aunt Jemima was a woman named Nancy Green, who assigned her rights to the use of her image for \$5.00.¹⁴⁹ How much is the image of Aunt Jemima worth? By way of example, we could look to a recent case involving “Taster’s Choice” Coffee. In *Christoff v. Nestle USA, Inc.*,¹⁵⁰ a former model named Christoff sued Nestle USA for misappropriation of his likeness on the Taster’s Choice line of coffee products. At trial, the jury awarded Christoff \$330,000 in damages and over \$15,000,000 in profits.¹⁵¹ On appeal, the judgment was reversed.¹⁵² The case is currently being reviewed by the California Supreme Court.¹⁵³

D. Chuck D: The Tale of Personality/Moral Rights

Hip-hop music, also known as “rap,” is an African-American art form that has been subject to legal analysis in the IP context, primarily for controversies over digital sound sampling. One of the pioneer rap groups that emerged in the late 1980’s was Public Enemy.¹⁵⁴ As a lawyer at a New York law firm, I had the privilege of representing Public Enemy in the early/mid 1990’s. The lead rapper, Chuck D., was involved in a lawsuit that arose when McKenzie River Corporation—at the time, maker of the forty ounce malt liquor, St. Ides—used a snippet of Chuck D’s voice in one of its beer commercials.¹⁵⁵ Chuck D. had long vehemently denounced the sale of the “40” in black communities and was outraged over the use. He sued the brewer for copyright infringement, trademark infringement, and violation of the right of publicity.¹⁵⁶ At the time of suit, California had a more favor-

¹⁴⁷ *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 408 (2d Cir. 1917), *cert. denied*, 245 U.S. 672 (1918).

¹⁴⁸ *Id.* at 412; *see also, e.g.*, *Triumph Hosiery Mills, Inc. v. Triumph Int’l Corp.*, 308 F.2d 196, 199 (2d Cir. 1962) (referring to the “Aunt Jemima Doctrine”); *S. C. Johnson & Son, Inc. v. Johnson*, 175 F.2d 176, 179 (2d Cir. 1949) (same); *Quality Inns Int’l v. McDonald’s Corp.*, 695 F. Supp. 198, 211 (D. Md. 1988) (same); Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 780 (2004) (same).

¹⁴⁹ MARILYN KERN-FOXWORTH, *AUNT JEMIMA, UNCLE BEN, AND RASTUS: BLACKS IN ADVERTISING, YESTERDAY, TODAY, AND TOMORROW* (1994).

¹⁵⁰ *Christoff v. Nestle USA, Inc.*, No. B182880, 2007 Cal. App. LEXIS 1137 (Ct. App. June 29, 2007), *rev. granted*, No. S155242, 2007 Cal. LEXIS 12762 (Oct. 31, 2007).

¹⁵¹ *Id.* at *1.

¹⁵² *Id.* at *58.

¹⁵³ *Christoff*, No. S155242, 2007 Cal. LEXIS 12762.

¹⁵⁴ Steven Thomas Erlewine, *Public Enemy Biography*, All Music Guide, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:kifixq95ld6e-T1> (last visited Mar. 19, 2008).

¹⁵⁵ *Chuck D: ‘This One’s Not For You’: Battling Malt Liquor*, ENT. WKLY, Sept. 27, 1991, *available at* <http://www.ew.com/ew/article/0,,315630,00.html>.

¹⁵⁶ *Id.*

able right of publicity law than New York. The New York right of publicity statute, set forth in sections 50 and 51 of the New York Civil Rights Law, provided a claim for commercial appropriation of name, likeness, portrait, and picture.¹⁵⁷ In contrast, California has both a common law right of publicity, which merely requires a use to “defendant’s advantage” and a statutory right of publicity that prohibits use in advertising or merchandising.¹⁵⁸ Moreover, at the time of the Chuck D. suit, California provided protection to voice, a protection not available in New York until 1995.¹⁵⁹ The Chuck D. lawsuit against the malt liquor company shows the personality rationale for the right of publicity at its nadir. The harm to the artist is not primarily economic, but personal in nature. It is doubtful, for example, that Chuck D. actually lost record sales as a result of the advertisement, yet the overall harm to reputation and dignity was significant. The flip side of this case is the misappropriation facet—the malt liquor company was clearly using the artist’s voice as a form of free-riding. However, even if one does not believe the free-rider rationale holds weight, the dignitary harm is undeniable.

E. Cultural Lockdown

The right of publicity, like other forms of IP, has the capacity to chill expression and reduce the public domain. Like trademark law—which “removes certain uses of . . . words, phrases, images, and product designs from the public domain, leaving other uses available to the public”—the right of publicity limits access to cultural icons of celebrity and can remove “certain uses of the person’s name or likeness from the public domain.”¹⁶⁰ It falls into that category of law that facilitates the great lockdown of culture excoriated by commentators, such as Larry Lessig.¹⁶¹ A range of conduct, from fan web sites to music production that appear socially beneficial and consistent with the “marketplace of ideas,” is suddenly transformed into illegal conduct.

F. 50 Cent: Free-riding and Misappropriation

Rapper Curtis Jackson, better known as “50 Cent,” is perhaps the anti-Chuck D. Whereas Public Enemy had a vibrant and controversial message of black empowerment and eschewed materialism, 50 Cent was a street thug living in the Jamaica, Queens section of New York City, reputedly

¹⁵⁷ N.Y. CIV. RIGHTS LAW §§ 50–51 (1992).

¹⁵⁸ *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 313 (Ct. App. 2001) (explaining that the common law right of publicity is recognized in California and provides protection against the “appropriation” of a plaintiff’s name or likeness for the defendant’s advantage”).

¹⁵⁹ Joseph J. Beard, *Clones, Bones and Twilight Zones: Protecting the Digital Persona of the Quick, the Dead and the Imaginary*, 16 BERKELEY TECH. L.J. 1165, 1231–32 (2001).

¹⁶⁰ Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 220 (2002) (emphasis omitted).

¹⁶¹ See generally LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* (2001).

selling drugs for a living.¹⁶² In 2000, he was involved in a drug deal gone bad that resulted in him being shot nine times.¹⁶³ “Fiddy” survived, signed a record deal with Columbia Records, and then moved on to Universal Music Group.¹⁶⁴ In 2003, 50 Cent became a household name and an international rap superstar with release of his album, “*Get Rich or Die Tryin’*.”¹⁶⁵ Jackson did indeed “get rich” and famous, although one might question if his success falls into the category of “toxic fame” elucidated above.

With success in the entertainment business come lawsuits; Jackson has been on both the giving and receiving end of litigation. In the right of publicity context, Jackson sued an auto dealer in 2004 for a print ad that featured the rapper’s picture, a reference to a Dodge Magnum, and the phrase, “Just Like 50 Says!”¹⁶⁶ The car dealer’s use of Jackson’s image would, no doubt, fall into the category of misappropriation on a theoretical level. It is a classic example of a defendant “reaping where it has not sown.” There is nothing derogatory about the ad, ruling out a “personality” based theory of recovery, nor could it be said that the use would depress any economic incentive of Jackson to cultivate his fame.

On the other end of the spectrum, an online advertising company decided to run a pop-up banner ad on the Internet that featured Jackson’s likeness and was entitled “Shoot the Rapper” and “win \$5,000 or five free ringtones GUARANTEED.”¹⁶⁷ Users were directed to aim and click their mouse to shoot the image. Jackson filed suit for trademark and right of publicity appropriation and sought damages for \$1 million plus punitive damages. There is some irony in the notion that Jackson claimed he was personally offended by the ad,¹⁶⁸ given his graphic lyrics which glorify violence and the “player-pimp” lifestyle. Unlike the print ad using “Fiddy”’s image to promote car sales, the pop-ad here could arguably be deemed a form of social commentary or satire.

Should the case of 50 Cent be treated the same as that of Chuck D.? I think not. 50 Cent trades in violence, which is, by definition, what “gangsta” rappers do. He can hardly claim serious dignitary harm in his image being used in a pop-up ad. That is not to say he should not be entitled to some damages; but these should be proven, not assumed.

¹⁶² Jason Birchmeier, 50 Cent Biography, All Music Guide, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:wbfpxqjldse> (last visited Mar. 19, 2008) [hereinafter 50 Cent Biography].

¹⁶³ See Natalie Finn, *50 Cent Takes Aim at Shooting Game*, E! ONLINE NEWS, July 20, 2007, <http://www.eonline.com/news/article/index.jsp?uuiid=b6b5dfa2-fb8a-4e87-8dfe-7535de774aac>.

¹⁶⁴ *Id.* Jackson was subsequently sued by the doctor who treated him for his gunshot wounds; according to the suit, Jackson failed to pay over \$30,000 in medical bills due and owing. *Doctor Sues Rapper 50 Cent*, BBC NEWS ONLINE, May 7, 2003, <http://news.bbc.co.uk/1/hi/entertainment/music/3006357.stm>.

¹⁶⁵ 50 CENT, *GET RICH OR DIE TRYIN’* (Interscope Records 2003); see also 50 Cent Biography, *supra* note 162.

¹⁶⁶ Sarah Hall, *50 Cent In Da Court*, YAHOO! MUSIC, Aug. 23, 2005, <http://music.yahoo.com/read/news/23168868>.

¹⁶⁷ Finn, *supra* note 163.

¹⁶⁸ *Id.*

CONCLUSION

The right of publicity, for the most part, lacks substantial analytical support among the universe of intellectual property rationales and reflects what is bad, and even ugly, among the breakneck expansion of intellectual property rights. Those favoring a restrictive approach to IP expansion express legitimate concerns about the threat of IP to a robust public domain, creative outputs, and freedom of expression. Those concerns however, must be tempered by recognition of personhood interests of a dignitary nature and the impact of restriction on a society that is stratified along race, gender, and economic lines. Aunt Jemima is not similar to Tiger Woods. Further, IP restrictionists should also be sensitive to stratification within the world of artists, who often find their performance undervalued and appropriated without redress. The same concern applies to non-celebrities, who often find they have a “right” with no true remedy.

