

## **NON-HUMAN PERSONS AND THE RIGHT OF PUBLICITY**

**By Stacy Allen, Emilio B. Nicolas and Megan Honey\***

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\* Stacy Allen is a litigation, intellectual property and media law partner resident in the Austin, Texas, office of Jackson Walker L.L.P. Emilio B. Nicolas is an entertainment and media law associate resident in the Austin, Texas, office of Jackson Walker L.L.P. Megan Honey is a litigation associate resident in the Austin, Texas, office of Jackson Walker L.L.P.

## NON-HUMAN PERSONS AND THE RIGHT OF PUBLICITY

Originally viewed as an extension of the right of privacy, the right of publicity has developed into a free-standing property interest in the commercial value of one's identity (or "persona").<sup>1</sup> Courts and legislatures have been overwhelmingly unwilling to extend the right of publicity beyond human individuals to non-human "persons" like partnerships and corporations, with the limited exception of music groups. Despite the weight of precedent, the application of traditional privacy-based limitations upon the right of publicity may come under increasing attack by non-human plaintiffs seeking to expand their available remedies.

### I. Defining the Right of Publicity

The right of publicity is a creature of state law and generally defined as "the right of a person to control the commercial use of his or her identity."<sup>2</sup> In other words, it prohibits the unauthorized commercial use of the elements or indicia that uniquely identify a person.<sup>3</sup> To establish a prima facie case for the violation of the right of publicity, a plaintiff must generally plead the following elements: (1) standing to sue, i.e., that plaintiff is the owner or exclusive licensee of a recognizable identity; (2) that defendant has made a commercial use (or appropriation) of one or more indicia of said identity; (3) that plaintiff did not authorize such appropriation; and (4) that such appropriation resulted in economic harm to the plaintiff.<sup>4</sup> The indicia of identity protected by the right of publicity were initially viewed as one's name or likeness.<sup>5</sup> But as the right of publicity developed, so did the list of indicia of identity, which some courts have found to include look-a-likes, sound-a-likes, voices, styles, distinctive phrases, distinctive objects, biographical information, settings strongly associated with particular celebrities, fictional characters or roles strongly associated with particular celebrities who portrayed the same, and signature music styles.<sup>6</sup> Another development is the sometimes expressed view that the right of publicity is a new and distinct form of intellectual property interest in the *commercial use* of one's identity.<sup>7</sup>

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<sup>1</sup> The term "persona" is often used in place of the term "identity" to encompass those elements which identify a person as protected by the right of publicity. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY & PRIVACY*, §4:46 (2d ed. 2008). As used herein, the terms "identity" and "persona" shall be construed to include each other.

<sup>2</sup> J. THOMAS MCCARTHY, *supra* note 1, at §§ 1:7, 4:46; MARK S. LEE, *ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW*, § 3:2 (2007).

<sup>3</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (2008) ("[o]ne who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49"); J. THOMAS MCCARTHY, *supra* note 1, at § 4:46; *see University of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co., Inc.*, 703 F.2d 1372, 1377 (Fed. Cir. 1983) (suggesting the alleged indicia of identity must point uniquely to the plaintiff).

<sup>4</sup> *See, e.g., Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 408 (Cal. Ct. App. 2001); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (plaintiff must establish the defendant commercially exploited the plaintiff's identity without consent to obtain a commercial advantage); *Prima v. Darden Restaurants, Inc.*, 78 F. Supp. 2d 337, 349 (N.J. 2000) (quoting J. THOMAS MCCARTHY, *supra* note 1, at § 4.14[A]).

<sup>5</sup> *ETW Corp.*, 332 F.3d at 930 (6th Cir. 2003); *see* J. THOMAS MCCARTHY, *supra* note 1, at § 4:46.

<sup>6</sup> MARK S. LEE, *supra* note 2, at §§ 3:55–3:66 (2007); Krissi Geary, *Tribute Bands: Flattering Imitators or Flagrant Infringers*, 29 S. ILL. U. L.J. 481, 487–88 (2005).

<sup>7</sup> *ETW Corp.*, 332 F.3d at 928 (6th Cir. 2001) (characterizing the right of publicity as an intellectual property right); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1200 (S.D.N.Y. 1983); J. THOMAS MCCARTHY, *supra* note 1, at §§ 1:3 & 1:8 ("[t]he right of publicity is a state-law created intellectual property right whose infringement is a commercial tort of unfair competition"); Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP.

## II. Dissecting the Right of Publicity

The right of publicity is distinguishable from all other personal and property rights.<sup>8</sup> It is well accepted that “[t]he principal historical antecedent of the right of publicity is the right of privacy.”<sup>9</sup> The theory of privacy was first advanced by Samuel D. Warren and future United States Supreme Court Justice Louis D. Brandeis in their groundbreaking law review article “The Right of Privacy,” which argued for the recognition of a common law “right to be let alone.”<sup>10</sup> Seventy years later, Dean William Prosser expanded this concept of a common law right of privacy by developing four independent privacy torts that were “soon adopted in the Second Restatement of Torts and ha[ve] been accepted by nearly all courts in the United States.”<sup>11</sup> These four privacy torts include: (1) the invasion of privacy by intrusion into private affairs; (2) the invasion of privacy by public disclosure of private facts; (3) the invasion of privacy by false light; and (4) the invasion of privacy by appropriating some aspect of an individual’s identity for commercial gain.<sup>12</sup> It is the latter of these privacy torts that gives rise to the right of publicity, an independent right that seeks “to recognize the commercial value of an individual’s identity, as opposed to compensate him or her for the hurt feelings caused by unauthorized invasion of an individual’s ‘privacy’ in the media.”<sup>13</sup>

The first case to recognize the right of publicity as independent from the right of privacy was the Second Circuit decision in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>14</sup> In *Haelan Laboratories*, the plaintiff, a chewing gum manufacturer, brought suit against a competitor for tortious interference with contractual relations.<sup>15</sup> The plaintiff alleged that several professional baseball players granted the plaintiff the exclusive right to use their photographs in connection with baseball cards that were sold with the plaintiff’s chewing gum products.<sup>16</sup> The plaintiff further alleged that the defendant induced the baseball players to breach their exclusive contract

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PROBS. 203, 216 (1954) (“[t]he right of publicity must be recognized as a property (not a personal) right, and as such capable of assignment and subsequent enforcement by the assignee”).

<sup>8</sup> See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 571 (1977) (distinguishing violation of the right of publicity from the traditional privacy torts, and analogizing its goals “to the goals of patent and copyright law”); see also *Experience Hendrix, LLC v. Electric Hendrix, LLC*, No. C07-0338-TSZ, 2008 WL 3243896, at \*4 (W.D. Wash. Aug. 7, 2008) (“[t]rademark rights and publicity rights are distinct rights that are analyzed under different standards”).

<sup>9</sup> E.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (2008); MARK S. LEE, *supra* note 2, at § 3:3.

<sup>10</sup> MARK S. LEE, *supra* note 2, at § 3:3 (citing Samuel D. Warren & Louis D. Brandeis, *The Right of Privacy*, 4 HARV. L. REV. 193 (1890)).

<sup>11</sup> J. THOMAS MCCARTHY, *supra* note 1, at §§ 1:19; MARK S. LEE, *supra* note 2, at § 3:3; see Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

<sup>12</sup> J. THOMAS MCCARTHY, *supra* note 1, at §§ 1:19 (2d ed. 2008); MARK S. LEE, *supra* note 2, at § 3:3; see Prosser, *supra* note 11, at 389 (“[t]he law of privacy comprises four distinct kinds of invasion of four different interests of the plaintiff, which are tied together by the common name, but otherwise have almost nothing in common except that each represents an interference with the right of the plaintiff, in the phrase coined by Judge Cooley, ‘to be let alone’”).

<sup>13</sup> MARK S. LEE, *supra* note 2, at § 3:3.

<sup>14</sup> 202 F.2d 866 (2d Cir. 1953).

<sup>15</sup> *Id.* at 867.

<sup>16</sup> *Id.*

with the plaintiff by granting the defendant the right to also use their photographs in connection with the defendant's competing baseball cards.<sup>17</sup>

In response, the defendant argued that the contract between the plaintiff and the baseball players was “nothing but a release of liability” and, thus, “vested in [the] plaintiff no ‘property’ right or other legal interest which [the] defendant’s conduct invaded.”<sup>18</sup> In other words, the “defendant’s position was that all that the baseball players’ contract consisted of was a release or waiver of the right to sue for an invasion of ‘privacy’ – no more.”<sup>19</sup>

The Second Circuit disagreed and instead held that the baseball players – as persons prominent in the various media of the time – had a proprietary interest in “the publicity value” of their photographs, that the baseball players could validly transfer such an interest to another person or entity “ ‘in gross,’ i.e., without an accompanying transfer of a business or of anything else,” that the contract at issue was an exclusive grant of such an interest from the baseball players to the plaintiff, and that the plaintiff had a valid claim against the defendant “if [the] defendant used that player’s photograph during the term of plaintiff’s grant and with knowledge of it.”<sup>20</sup> Writing for the Second Circuit, Judge Jerome Frank called this new, independent right to control one’s identity the “right of publicity.”<sup>21</sup>

After *Haelan Laboratories*, various states began to recognize this new right, whether by way of common law, statute, or both.<sup>22</sup> Today, a majority of jurisdictions recognize some form of a right of publicity, “although there remains some judicial confusion about whether a ‘privacy’ or ‘property’ right is at stake”<sup>23</sup>, and the quilt-work nature of these varying state laws makes it difficult to offer sweeping pronouncements.

### III. Distinguishing the Right of Publicity

Various rationales in support of a right of publicity have been advanced by courts and scholars. Appearing to believe that fame and celebrity are often more a matter of luck than industry, the editors of the Restatement (Third) of Unfair Competition offer a somewhat skeptical assessment of these rationales:

Like the right of privacy, the right of publicity protects an individual’s interest in personal dignity and autonomy. With its emphasis on commercial interests, the right of publicity also secures for plaintiffs the commercial value of their fame and prevents the unjust enrichment of others seeking to appropriate that value for themselves. The right to

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<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> J. THOMAS MCCARTHY, *supra* note 1, at § 1:26.

<sup>20</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953).

<sup>21</sup> *Id.* at 868 (“[t]his right might be called a ‘right of publicity’ ”); J. THOMAS MCCARTHY, *supra* note 1, at § 1:26 (“Judge Jerome Frank was apparently the first to coin the term ‘right of publicity’ . . . ”).

<sup>22</sup> For example, California recognizes both a common law and a statutory right of publicity. *Gionfriddo*, 94 Cal. App. 4th at 408 (“[i]n California the right of publicity is both a common law right and a statutory right”).

<sup>23</sup> MARK S. LEE, *supra* note 2, at § 3:3; *see Zacchini*, 433 U.S. at 578 (“[p]etitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it”).

prohibit unauthorized commercial exploitation of one's identity allows a person to prevent harmful or excessive commercial use that may dilute the value of the identity. Although proof of deception or confusion is not an element of liability under ... [the right of publicity, it] indirectly affords protection against false suggestions of endorsement or sponsorship. Some decisions also invoke an incentive rationale analogous to that supporting the recognition of exclusive rights under copyright and patent law.

The rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets. The commercial value of a person's identity often results from success in endeavors such as entertainment or sports that offer their own substantial rewards. Any additional incentive attributable to the right of publicity may have only marginal significance. In other cases the commercial value acquired by a person's identity is largely fortuitous or otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection. In addition, the public interest in avoiding false suggestions of endorsement or sponsorship can be pursued through the cause of action for deceptive marketing. Thus, courts may be properly reluctant to adopt a broad construction of the publicity right.<sup>24</sup>

Following this lead, most courts have taken a restrictive approach to the question of standing to assert the right of publicity, although not everyone agrees.

In his acclaimed article that is considered “the foundation stone of the right of publicity,”<sup>25</sup> Professor Melville B. Nimmer identified two policy considerations that he believed provide compelling support for the right of publicity: “[F]irst, the economic reality of pecuniary values inherent in publicity and, second, the inadequacy of traditional legal theories in protecting such publicity values.”<sup>26</sup> Of the two, the former – the need to protect against the inherent unfairness in allowing the exploitation of one's identity without just compensation – appears to be the most compelling because it is the one that best distinguishes the right of publicity from the right of privacy.<sup>27</sup>

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<sup>24</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (2008) (“rationale for protection”).

<sup>25</sup> J. THOMAS MCCARTHY, *supra* note 1, at § 1:27.

<sup>26</sup> Melville B. Nimmer, *supra* note 7, at 215.

<sup>27</sup> *Zacchini*, 433 U.S. at 573 & 576 (“the State's interest in permitting a ‘right of publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment ... [t]he rationale for (protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will” (internal quotations omitted)); *Bi-Rite Enters.*, 555 F. Supp. at 1198 (the right of publicity “prevents unjust enrichment by providing a remedy against exploitation of the goodwill and reputation that a person develops in his name or likeness through the investment of time, effort, and money”); *Ventura v. Titan Sports, Inc.*, 65 F.3d 725, 730 (8th Cir. 1995) (right to publicity protects pecuniary, not emotional, interests); *Bear Foot, Inc. v. Chandler*, 965 S.W.2d 386, 389 (Mo.Ct.App. 1998) (right of publicity protects a person from losing the benefit of his or her work in creating a publicly recognizable persona); *Haelan Labs.*, 202 F.2d at 868 (“it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways”).

Unlike the right of privacy and its tort of appropriation, which provides recovery for mental or emotional distress, the right of publicity gives rise to a tort claim to recover for commercial loss.<sup>28</sup>

While there has been much confusion generated by the semantic distinction between “privacy” and “publicity,” the courts have now come to recognize that the two rights are clearly separable and rest on quite different legal policies: the right to privacy protects against intrusion upon an individual’s private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual’s personality for commercial exploitation.<sup>29</sup>

Because the rights of privacy and publicity are separate and distinguishable, arguments against the assertion of the right of publicity by non-human persons that are grounded in principles of privacy law may not be dispositive,<sup>30</sup> nor may those that contend that such publicity rights are already protected by other areas of intellectual property law.<sup>31</sup>

A patent is the governmental grant of a right to exclusively make, use or sell a useful, novel and non-obvious invention – which includes, by statute, a process, machine, manufacture, or composition of matter – for a specified period of time.<sup>32</sup> It is thus unlikely that a person’s identity both qualifies as an “invention” and also satisfies the additional statutory requirements for patentability.<sup>33</sup>

Similarly, copyright protection extends to a limited scope of matter, namely an original work of authorship – including literary, musical, dramatic, pantomime, choreographic, pictorial, graphic, sculptural, audiovisual, sound recording, or architectural works – fixed in a tangible medium of expression from which the work can be perceived, reproduced, or otherwise communicated.<sup>34</sup> A person’s identity has been found to fall outside the subject matter of copyright because indicia of

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<sup>28</sup> *Doe v. McFarlane*, 207 S.W.3d 52, 75 (Mo. Ct. App. 2006) (“[t]he misappropriation of name tort protects against intrusion upon an individual’s private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual’s identity for commercial exploitation” (internal quotations omitted)); see J. THOMAS MCCARTHY, *supra* note 1, at § 1:40; see also *supra* at note 27.

<sup>29</sup> J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:6 (4th ed. 2008); see *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 571 (1977) (distinguishing violation of the right of publicity from the traditional privacy torts).

<sup>30</sup> For example, Professor McCarthy argues against any expansion of the right of publicity beyond the individual, and describes the proposal “that the right of publicity be stretched to cover the ‘persona’ of a company and its trademarks ... [as] both radical and drastic”, but acknowledges that “the right of publicity to a group involves policy considerations different from those involved in extending the appropriation brand of the right of privacy.” J. THOMAS MCCARTHY, *supra* note 1, at § 4:42.

<sup>31</sup> *Experience Hendrix*, 2008 WL 3243896, at \*4 (“[t]rademark rights and publicity rights are distinct rights that are analyzed under different standards”); MARK S. LEE, *supra* note 2, at § 3:1 (“[w]hile copyright and patent law protect what you create, and trademark law protects what you symbolize, right of publicity law protects who you are”).

<sup>32</sup> 35 U.S.C. § 101 (2006); *State St. Bank & Trust v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 2003).

<sup>33</sup> See *State St. Bank & Trust*, 149 F.3d at 1370 (“any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35 ...”).

<sup>34</sup> 17 U.S.C. § 102 (2006); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003 (9th Cir. 2001).

identity themselves do not consist of an original writing or other fixed work of authorship within the meaning of the 1976 Copyright Act, as amended, or the Copyright Clause of the United States Constitution.<sup>35</sup> Accordingly, the right of publicity can be distinguished from copyright law.<sup>36</sup>

It is more difficult, however, to distinguish the right of publicity from the law of unfair competition, including trademark and trade dress, especially where non-human plaintiffs are concerned. Such difficulty may stem from the origins of the two within American jurisprudence as compared to other areas of intellectual property law. Like trademark law, the right of publicity is originally a creature of state common law and is thus more malleable in its scope.<sup>37</sup> Both provide remedies for the misappropriation of identifying characteristics unique to a given plaintiff.

Conversely, it may be argued that the right of publicity is unaccounted for by trademark law because both seek to protect different proprietary interests. Trademark law seeks to protect certain words, names, symbols, devices, or any combination thereof that the holder uses in commerce to indicate the source of origin of its particular goods and services and to distinguish the same from those sold or provided by others.<sup>38</sup>

In contrast, it has been observed that the right of publicity protects more than words, names, symbols, devices, or any combination thereof, such as styles and biographical information.<sup>39</sup> Further, such indicia of identity need not necessarily be used in commerce because they themselves are the very items of value being exploited for financial gain due to their ability to *identify* someone (or, arguably, something) with value attributable to the self. “The inquiry under a right of publicity action is whether there was a commercial appropriation of one’s identity without consent ... [whereas] [t]he proper inquiry when analyzing a trademark right in a famous name is whether the mark in question will falsely suggest a connection with the famous person,” which is why federal trademark law has been found not to preempt the right of

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<sup>35</sup> *Jarvis v. A&M Records*, 827 F. Supp. 282, 297 (D.N.J. 1993); *Bi-Rite Enters.*, 555 F. Supp. at 1201 (“[t]he intangible proprietary interest protected by the right of publicity simply does not constitute a writing ... and therefore falls outside of the preemption standards established by Congress in the copyright law”); *Downing*, 265 F.3d at 1004 (“[a] person’s name or likeness is not a work of authorship within the meaning of 17 U.S.C. § 102”); *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000) (“[a] persona does not fall within the subject matter of copyright ...”); MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1][c] (2008).

<sup>36</sup> In limited circumstances, however, a few courts have held that the right of publicity was preempted by copyright law when the claim arose from the unauthorized *recording of an individual’s performance* or the unauthorized use of an individual’s image in an advertisement when the individual appeared as a *fictional character*. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1136 (9th Cir. 2006) (unauthorized recording of performance); *Stanford v. Caesars Entm’t, Inc.*, 430 F. Supp. 2d 749, 759 (W.D.Tenn. 2006) (unauthorized use of image of fictional character).

<sup>37</sup> See *Enter. Rent-A-Car v. Advan. Rent-A-Car*, 330 F.3d 1333, 1338 (Fed. Cir. 2003).

<sup>38</sup> 15 U.S.C. § 1127 (2006) (defining “trademark”); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992) (discussing underlying policies of the Lanham Act); *Colt Def. v. Bushmaster Firearms*, 486 F.3d 701, 705 (1st Cir. 2007); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt c (2008).

<sup>39</sup> See MARK S. LEE, *supra* note 2, at §§ 3:55-3:66; see also Krissi Geary, *supra* note 6, at 487–88.

publicity.<sup>40</sup> Such preemption could only exist if a court or legislature were to expand the right of publicity in a manner that narrows the rights encompassed by federal trademark law.<sup>41</sup>

The same may be said for the law of trade dress, which protects the “total image and overall appearance” of a product or business and “may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”<sup>42</sup> As noted by the United States Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.*, trade dress law is subject to the same restrictions and limitations as traditional trademark law, such as the need to prove likelihood of confusion – limitations not applicable to the right of publicity.<sup>43</sup>

Opponents of extending the right of publicity to non-human business entities argue that trademark law and unfair competition-related theories including passing off, false designation of origin, false endorsement, trade libel and false advertising already provide adequate and well-considered protection to the words and symbols which are the indicia of identity of corporations and other fictitious “persons”, and that recognizing a right of publicity “exception” would swallow the whole:

If the right of publicity is stretched to cover the various indicia of business entities, it will not “add to” the law of trademarks, it will replace and substitute for it. Such a move would constitute a major change and dislocation of the law. The carefully constructed and finely tuned rules of trademark law were crafted over the last 150 years to reach a balanced accommodation between fair competition and free competition, between the right to prevent confusion of buyers and the right of others to compete. Replacement of all this with the relatively raw and brash newcomer of the right of publicity would demand that the whole legal structure of business identity be rebuilt from the ground up. To make such a radical change in the basic structure of business and commercial law would demand a very persuasive reason to jettison the status quo. Thus, the proposition to “extend” the right of publicity from real humans to make-believe “legal persons” is a very radical and far-reaching proposal. Once the unraveling begins, it is difficult to see where it will end.<sup>44</sup>

#### **IV. Expanding the Right of Publicity**

Not surprisingly, early right of publicity decisions focused on individual celebrities because celebrities have a higher degree of notoriety and, thus, more readily identifiable indicia of

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<sup>40</sup> *Experience Hendrix*, 2008 WL 3243896, at \*4.

<sup>41</sup> *Bi-Rite Enters.*, 555 F. Supp. at 1201 (pursuant to the Supremacy Clause of the United States Constitution, the Lanham Act does not “prevent states from creating rights against forms of unfair competition broader than those encompassed in the federal statute”).

<sup>42</sup> *Taco Cabana*, 505 U.S. at 764 n. 1 (internal quotations omitted).

<sup>43</sup> *Id.* at 773–74 (“the protection of trademark and trade dress under §43(a) [of the Lanham Act] serves the same statutory purpose of preventing deception and unfair competition ... [t]here is no persuasive reason to apply different analysis to the two.”). Those claiming under their rights of publicity, by contrast, need not show deception.

<sup>44</sup> J. THOMAS MCCARTHY, *supra* note 1, at § 4:44.



identity.<sup>45</sup> Now, the majority view is that the right of publicity also extends to non-celebrities, so long as there is proof of a recognizable identity,<sup>46</sup> with damages potentially higher for celebrities whose broader fame may increase the commercial value of their identities.<sup>47</sup> Still, courts remained reluctant to extend the right of publicity beyond individual persons.

In *Bi-Rite Enterprises, Inc. v. Button Master*, a music merchandising company and several associated rock music groups – including Judas Priest, Molly Hatchett, Devo, Styx, and Iron Maiden, and their individual members – and solo performers Neil Young and Pat Benatar brought suit in the Southern District of New York against a company for the unauthorized manufacture and distribution of “buttons and other novelty items bearing among other things the marks of the plaintiff ... [rock music groups and solo performers] and other rock groups.”<sup>48</sup> In addition to claims for unfair competition and trademark infringement, the plaintiffs asserted claims for violation of their rights of privacy *and* publicity.<sup>49</sup> In an opinion written by District Judge Sofaer, the court granted summary judgment in favor of the plaintiffs on their right of publicity claims, *including* the right of publicity claims of the rock music groups.<sup>50</sup>

In clumping the rock music groups together with the other individual plaintiffs, Judge Sofaer stated only that:

As individuals, plaintiffs Neil Young and Pat Benatar are entitled to summary judgment for violation of their right of publicity. The group Performers also qualify for summary judgment. While only one court has apparently recognized a group’s right of publicity, *see Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1213 (N.D.Ill. 1982), the rationale for protecting that interest extends to groups that have “persona” sufficiently strong to meet the requirements applied to individuals. ...

... A group that develops market value in its persona should be *as* entitled as an individual to publicity rights in its name. ... The rationale for protecting the right of publicity does not justify treating similarly situated plaintiffs differently merely because one is an individual and one is a group member.<sup>51</sup>

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<sup>45</sup> *See, e.g., Haelan Labs.*, 202 F.2d at 868 (professional baseball players had a commercial, proprietary interest in their names and likenesses); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622 (N.Y. App. Div. 1977) (“there is no question but that a celebrity has a legitimate proprietary interest in his public personality”).

<sup>46</sup> *See, e.g., CAL. CIV. CODE* §§ 3344, 3344.1 & App. B-1 (West 2008); N.Y. CIV. RIGHTS §§ 50 & 51 (McKinney 2008); *but see, e.g., Cox v. Hatch*, 761 P.2d 556, 564 (Utah 1988) (holding that fame or notoriety is required for an individual to have a right of publicity).

<sup>47</sup> *See, e.g., Canessa v. J.I. Kislak, Inc.*, 235 A.2d 62, 75 (N.J. Super. Ct. Law Div. 1976) (the distinction between celebrities and others “is relevant only to the question of damages”); *see also Haelan Labs.*, 202 F.2d at 868 (“it is common knowledge that many prominent persons (especially actors and ball-players) ... would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways”).

<sup>48</sup> 555 F. Supp. 1188, 1191 (S.D.N.Y. 1983).

<sup>49</sup> *Id.* at 1197.

<sup>50</sup> *Id.* at 1199 & 1201.

<sup>51</sup> *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1199 & 1200 (S.D.N.Y. 1983).

In other words, Judge Sofaer found that certain music groups had developed a valuable identity, and that there was no reason for denying a music group the right to protect its proprietary “persona” against the unfairness inherent in allowing another to exploit the same without just compensation.<sup>52</sup>

Some observers have criticized *Bi-Rite Enterprises* for its lack of a reasoned analysis:

In that one case, Judge Sofaer stated that, “A group that develops market value in its persona should be entitled as an individual to publicity rights in its name.” He then concluded that, “The rationale for protecting the right to publicity [sic] does not justify treating similarly situated plaintiffs differently merely because one is an individual and one is a group member.

Judge Sofaer’s first sentence is a conclusion, not a reason. It is difficult to know what to make of the second sentence in view of the words “group member.” No one has ever suggested that an individual’s identity is any less protectable merely because he or she is a member of a group. Perhaps he meant to say “group,” not “group member.” If so, he did not articulate why the “rationale” of the right of publicity justifies this unusual extension over a critical legal boundary which has traditionally formed the limit of both privacy and publicity rights.<sup>53</sup>

The handful of other decisions addressing the subject are equally short on analysis.<sup>54</sup>

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<sup>52</sup> *Id.* at 1200; see *Gallina v. Giacalone*, 655 N.Y.S.2d 317, 320 (N.Y. Sup. Ct. 1997) (“[f]or nearly 100 years, beginning with *Messer v. ‘The Fadettes’*, 168 Mass. 140, 46 N.E. 407 [1897], courts in this country have protected the right of a musical group to its name from predatory encroachment by rival entertainers” (alteration in original)).

<sup>53</sup> J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY & PRIVACY*, § 4:42 (2d ed. 2008) (alterations in original).

<sup>54</sup> *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1056–57 (C.D.Cal. 2004) (right of publicity claim preempted by copyright law when advertiser used sound recording of music group’s signature song in commercial, but not preempted when advertiser used distorted versions of the signature song’s title in advertising and signage in advertiser’s store); *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 348 (M.D. Tenn. 1993) (citing *Bi-Rite Enters.*, 555 F. Supp. at 1199) (holding that defendants’ use of the “distinctive” name “The Beatles” in defendants’ advertising and promotional materials violated Tennessee’s right of publicity statute because “the stage name of a group of individuals is entitled to the same protection as the name of one of the individuals which compose that group”); *Brockum Co. v. Blaylock*, 729 F. Supp. 438, 446 (E.D.Pa. 1990) (stating without explanation that “[a] musical group, as well as an individual performer, has a protectable right of publicity”); *Winterland Concessions Co. v. Creative Screen Design, Ltd.*, 214 U.S.P.Q. 188, 190 (N.D.Ill. 1981) (holding that plaintiff merchandiser had standing to bring action for violation of the right of publicity transferred to it from “the plaintiff entertainers and musical groups”); *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1213 (N.D.Ill. 1981) (stating without explanation that “the right of publicity encompasses the right of each of the plaintiff entertainers and music groups to have the sole right to commercially exploit their name and likeness”); see *Bear Foot, Inc. v. Chandler*, 965 S.W.2d 386, 389 (Mo. Ct. App. 1998) (denying a corporation the right of publicity without explanation); see also *Romantics v. Activision Publ’g, Inc.*, 574 F. Supp. 2d 758, 763-65 (E.D.Mich. 2008) (denying music group The Romantics relief for use of their “sound” in videogame “Guitar Hero Encore: Rock’s the 80’s” because the use was not commercial, the “sound” was not distinctive, and, regardless, “Michigan never has recognized ... a right of publicity in the sound of a voice, even if distinctive, nor has it recognized a right of publicity in a combination of voices”).

Similarly, a state appellate decision refusing to extend the right of publicity to corporations did so in a conclusory manner.<sup>55</sup> While corporations repeatedly have been held to lack standing to bring claims for violation of the right of privacy because “[a] corporation is a fictitious person and has no ‘feelings’ which may be injured in the sense of the tort,”<sup>56</sup> a non-human plaintiff might contend that this rationale does not necessarily extend to claims grounded in the right of publicity, which is focused on economic loss, not emotional distress.<sup>57</sup>

## V. The Case For And Against Further Expansion of the Right of Publicity

Whether adequately explained or not in the handful of reported decisions that have addressed the issue, the extension of the right of publicity to music groups begs the following questions: Should the right extend further to business entities beyond loose amalgamations of human individuals, such as partnerships and corporations? What arguments by a non-human plaintiff in favor of such an expansion of traditional publicity rights might a defendant expect to encounter? What arguments can be made in defense of limiting the right of publicity to human persons?

Once liberated from the underpinnings of the right of privacy (and its focus on injury to an individual’s *feelings*), the rationale for limiting the right of publicity to human plaintiffs is arguably less clear. If misappropriating the monetary value of one’s unique identity without consent or compensation is instinctively unfair, then why, it might be argued, is it any less

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<sup>55</sup> In *Bear Foot, Inc. v. Chandler*, a Missouri court of appeals held that a plaintiff corporation could not state a claim upon which relief could be granted for an alleged violation of the right of publicity because “there is no right of publicity in a corporation . . . .” 965 S.W.2d at 389. The only rationale provided was as follows: “While some states have recognized a right of publicity in individuals or the deceased, we do not believe that a corporation has such a right. The right of publicity creates a cause of action only for misappropriation of a person’s likeness.” *Id.* (citing *Haelan Labs. v. Topps Chewing Gum, Inc.*, 202 F.2d 867 (2d Cir. 1953)).

<sup>56</sup> *Ion Equip. Corp. v. Nelson*, 110 Cal. App. 3d 868, 878 (Cal. Ct. App. 1980). Examples of cases where the courts have denied relief to entities for violation of the common law right of privacy include the following: *Aids Counseling & Testing Centers v. Group Television, Inc.*, 903 F.2d 1000, 1004 n.1 (4th Cir. 1990) (“[w]e also note that corporations do not enjoy the same right of privacy that individuals do . . . [i]ndeed it seems very unlikely that a corporation can ever state a cognizable claim for false-light invasion of privacy”); *Felsher v. Univ. of Evansville*, 755 N.E.2d 589, 595 (Ind. 2001) (non-profit corporation has no right of privacy); *CAN Fin. Corp. v. Local 743 of Int’l Bhd. Of Teamsters, Chauffeurs, Warehousemen and Helpers of Am.*, 515 F. Supp. 942, 946–47 (N.D. Ill. 1981) (“[m]any courts that have considered the question have concluded that a corporation cannot maintain an action for invasion of the right of privacy and we believe this represents the better reasoned approach”); *Ion Equip.*, 110 Cal. App. 3d at 878 (“a corporation does not have a common law right to privacy and therefore cannot bring an action for invasion of privacy”); *Rosenwasser v. Ogoglia*, 172 A.D. 107, 108–09 (N.Y. App. Div. 1916) (partnership has no common law right of privacy because “[t]he essential character of an association for business does not require for its work a right of privacy which is afforded to an individual as a private person”); RESTATEMENT (SECOND) OF TORTS § 652I cmt. c (2008) (“[a] corporation, partnership or unincorporated association has no personal right of privacy”). Courts have also denied relief to entities for violation of the statutory right of privacy because the legislatures limited the definition of a “person” or “individual” to a natural or living person, not juridical persons. *Shubert v. Columbia Pictures Corp.*, 72 N.Y.S.2d 851, 858 (N.Y. Sup. Ct. 1947) (“Plaintiff Trebuhs Realty Company, Inc. . . . does not come within the statutory category of a living person”); *Rosenwasser*, 172 A.D. at 109 (“the [New York] Legislature by expression makes a distinction between person, firm or corporation in its enumeration of those who are prohibited [from asserting a statutory right of privacy]”).

<sup>57</sup> Some states have resolved this question by enacting right of publicity statutes which define a plaintiff in a way which expressly excludes non-human persons. See, e.g., N.Y. Civil Rights Law §§ 50 and 51 (prohibiting the commercial use of the name or picture of “any living person”); Fla. Stat. Ann. §540.08(1)(prohibiting the commercial use of the name or picture of “any natural person”); Wis. Stat. Ann. §895.50(2)(b)(protecting the identity of “any living person”).

reproachable when the victim is non-human? Similarly, if the interest protected is the objective commercial value of a person's identity as set by the market (as opposed to his subjective feelings), then why is such a loss any less deserving of a remedy when sustained by, for example, a corporation? Such a corporation could argue that it invests its resources into building its commercial "identity" in much the same way that an individual does (or is purported to). If so, then why should it matter that one victim is human and the other is not when both are "persons" in the eyes of the law?<sup>58</sup> Is not the interest in exploiting the economic value of one's identity indistinguishable, regardless of the "person" involved?

That other areas of the law provide some measure of protection to business entities may not, in itself, settle the matter conclusively. First, it can be argued that those laws carry with them their own barriers that could work to deny a remedy where one would otherwise be available to a human plaintiff asserting his or her right of publicity. For instance, a corporate plaintiff seeking redress for the unauthorized exploitation of its identity by another may not be entitled to protection under federal trademark or trade dress law if it cannot prove that the various indicia of its identity constitute a protectable or famous mark or trade dress, that there exists a likelihood of confusion or that the defendant has made an unauthorized use of the trademark or trade dress in commerce.<sup>59</sup> Similarly, other unfair competition laws can require a false suggestion of endorsement or that the defendant be a competitor.<sup>60</sup> Nor does the right of publicity concern itself with protection against deception in the marketplace. Rather, the right of publicity serves to protect the person whose identity is misappropriated, not the consumer who might be deceived.

Second, plaintiffs commonly assert overlapping and/or complementary theories of recovery on the same facts. When pondering the future of the newly-created right of publicity over fifty years ago, Professor Nimmer appears to have anticipated a future non-human plaintiff's argument that pre-existing intellectual property law is not good enough:

[S]ince animals, inanimate objects, and business and other institutions all may be endowed with publicity values, the human owners of these non-human entities should have a right of publicity (although no right of privacy) in such property, and this right should exist (unlike unfair competition) regardless of whether the defendant is in competition with the plaintiff, and regardless of whether he is passing off his own products as those of the plaintiff.<sup>61</sup>

Cases that involve Lanham Act claims are necessarily fact intensive. If the trier of fact concludes the facts presented do not satisfy the more restrictive elements of trademark or trade

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<sup>58</sup> See *H&M Associates*, 109 Cal. App. 3d at 409–10.

<sup>59</sup> See 15 U.S.C. §§ 1114 & 1125 (2006); see also *1-800 Contacts v. WhenU.com, Inc.*, 414 F.3d 400, 408 (2d Cir. 2005) (strictly applying the Lanham Act definition of "use in commerce," the court held that the defendant did not "use" the plaintiff's trademark "in the manner ordinarily at issue in an infringement claim ... [because it did not] not 'place' 1-800 [Contacts] trademarks on any goods or services in order to pass them off as emanating from or authorized by [the plaintiff]").

<sup>60</sup> See, e.g., MARK S. LEE, *supra* note 2, at § 2:9 ("[u]nlike false advertising theories, the right of publicity is infringed by unpermitted, identifiable and commercial use of the persona, per se").

<sup>61</sup> Nimmer, *supra* note 7, at 216.

dress infringement or dilution, but would nonetheless satisfy the elements of a right of publicity violation, then why, it might be argued, should that remedy be denied for the sole reason that the plaintiff is a corporation and not a human?

Defendants seeking to counter such arguments would start by pointing to the absence of case law supporting a wholesale extension of publicity rights to non-human plaintiffs, but need not stop there. While it is hardly surprising that institutional plaintiffs bristling at the restrictive aspects of trademark law would want to circumvent those limitations by means of a broader right of publicity focused only on misappropriation, should they not first be required to articulate routinely recurring factual situations for which traditional unfair competition laws do not provide them an adequate remedy? As argued by Professor McCarthy:

Those who propose that the right of publicity be stretched to cover the “persona” of a company and its trademarks unabashedly admit that they seek a new label to justify a radical expansion of the rights of trademark owners. They wish to break out of what they consider to be the constricting mold of the likelihood of confusion test of trademarks. Their proposal is both radical and drastic. Persuasive reasons are required to explain and justify such an expansion of traditional rights. The burden is upon the proponents to convince us of the need, merits and rationale of such a radical change. They have yet to meet this heavy burden of persuasion.<sup>62</sup>

Such an argument would appeal to cautious courts reluctant to proceed down a slippery slope toward subsuming trademark law without a justification more compelling than “why not”.

Similarly, defendants could point to the concern expressed by some courts about “[t]he tension between right of publicity and the First Amendment ... .”<sup>63</sup> More than one court and commentator have noted the dangers inherent in an overly broad right of publicity to the right of debate, creativity, commercial speech and competition.<sup>64</sup> As Professor Michael Madow has observed, a broad right of publicity facilitates private censorship.<sup>65</sup> By extension, courts should be extremely cautious about expanding that “private censorship” to corporations and similar entities, which already have at their disposal trademark, copyright, and other intellectual property claims. Any expansion of the right of publicity (including granting standing to non-human entities), it can be argued, is at the cost of individual and communal First Amendment rights.

So too, the argument that corporations and partnerships are also “persons” in the eyes of the law for whom the same remedies are available in analogous circumstances can be countered, for that argument ignores the very difference between humans and fictitious “legal persons” which has been observed to be at the heart of the right of publicity:

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<sup>62</sup> J. THOMAS MCCARTHY, *supra* note 1, at § 4:45.

<sup>63</sup> See *Comedy III Prods. v. Gary Saderup, Inc.*, 25 Cal. 4<sup>th</sup> 387, 396-398 (2001).

<sup>64</sup> See *id.*; see also *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989); *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 959 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972-73 (10th Cir. 1996); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal. L. Rev. 127, 137-38 (1993).

<sup>65</sup> Madow, *supra* note 64, at 137-38.

Undoubtedly the right of publicity is analogous to trademarks in some respects. It is also analogous to copyright, defamation, and the various forms of invasion of privacy. The right of publicity is also analogous to both real and personal property. However, to look only at the points of resemblance to neighboring legal rights is to lose sight of the basic reason which emboldened courts to integrate the right of publicity into the law. That basic reason is the uniqueness of the human identity. The most persuasive rationale which gave rise to and continues to provide reasoned support for the right of publicity is that human identity is a natural and self-evident property right. Once the right of publicity is hauled beyond this supporting structure of human identity, it loses the support of its foundation.<sup>66</sup>

Thus, while distinct from each other, the rights of privacy and publicity can be said to share a uniquely human quality that reasonably deprives non-human legal entities of standing to assert either.

It remains the case that arguments for extension of the right of publicity beyond individuals and music groups to other juridical entities fly in the face of long-standing judicial precedent against such an expansion, the availability of alternative intellectual property remedies, and First Amendment and other policy considerations. However, as a result of *Bi-Rite Enterprises* and its progeny, and in the absence of limiting statutory language in a given jurisdiction, aggressive non-human plaintiffs whose other legal remedies are imperfect may resort to pleading a cause of action sounding in right of publicity. To avoid falling victim to such a test case, media organizations should be familiar with the applicable statutes and case law of relevant jurisdictions, the legal distinctions between human and non-human persons, and fundamental First Amendment principles and law.

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<sup>66</sup> J. THOMAS MCCARTHY, *supra* note 1, at § 4:45 (internal footnote omitted).