
**JUST ANOTHER BROWN-EYED GIRL:
TOWARD A LIMITED FEDERAL RIGHT
OF PUBLICITY UNDER THE LANHAM
ACT IN A DIGITAL AGE OF CELEBRITY
DOMINANCE**

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I. INTRODUCTION

Imagine this: Elle, an attractive blonde, brown-eyed female in Boston becomes an overnight celebrity for her YouTube video series, “Chasing Rings,” in which she bemoans the modern dating world in the form of her self-produced rap songs. In each video, Elle wears a different pink shirt. As her video blog continues to gain popularity, a New York clothing company develops an online advertising campaign supporting the legalization of gay marriage. The campaign is displayed on online news and social networking sites. One of the men featured in the ad wears a long blonde wig, has large brown eyes, and wears a pink tank top; the other is dressed in traditional male garb. The ad states, “He liked it, but he couldn’t put a ring on it.” The phrase, closely paralleling a well-known pop lyric, is used with pop celebrity Beyoncé’s permission. Elle, a law student, decides that this ad appears to reference her and decides to sue under her state-law right of publicity. Since the ads were displayed nationally, she hires an attorney to sue under Indiana law because she thinks she has the best chance of

winning her case in that state. After initial discovery, the gay rights campaign agrees to settle the case for five million dollars because it thinks that Elle is likely to prevail. The ad campaign is shut down and the company is forced to downsize.

This kind of case has been seen with increasing frequency in recent years, and the results are alarming. In some instances, the right of publicity now allows modern celebrities to recover in the state with the laws most favorable to their cases, to obtain rewards for purported exploitations of even the most mundane characteristics of their identity, and to quell free speech when it comes within the bounds of their theoretical commercial value. The right of publicity has become an expansive litigation machine for celebrity “brands,”¹ and while it is a valid legal protection, the right needs to be overhauled to address these pressing concerns.

The right of publicity is a state law concept that protects the use of a person’s name, likeness, or other distinguishing characteristics from unauthorized commercial use. Under the Restatement of Unfair Competition, used to create and define many states’ statutes and common law concepts, the right of publicity is violated when one “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.”² The right of publicity is a relatively new legal concept,³ and its nature and even its very existence have been in constant flux since its creation.⁴ Scholars have discussed its necessity, rationale, and characteristics, but the right is still defined differently in many states⁵ and is, therefore, applied inconsistently across the nation.

The right of publicity generally protects those whose identity is imbued with commercial value—celebrities including artists, athletes, and

1. See Steven C. Clay, Note, *Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts*, 79 MINN. L. REV. 485, 487–501 (1994) (describing the legal evolution of the right of publicity doctrine).

2. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

3. See generally *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (first recognizing the right of publicity).

4. See Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. 227, 232–39 (1999) (describing the history and development of the right of publicity).

5. See, e.g., Lee Goldman, *Elvis Is Alive, but He Shouldn't Be: The Right of Publicity Revisited*, 1992 BYU L. REV. 597, 625–28 (1992) (discussing eliminating the right of publicity); Goodman, *supra* note 4, at 235–39 (discussing the diversity among state laws in California, New York, Indiana, Tennessee, and Georgia); Usha Rodrigues, Note, *Race to the Stars: A Federalism Argument for Leaving the Right of Publicity in the Hands of the States*, 87 VA. L. REV. 1201, 1212–18 (2001) (analyzing the various justifications for the right of publicity).

public figures.⁶ The expansion of technology to create constant streams of media and communication has encouraged an increased fixation on the lives of these celebrities. Video games now include popular music and sports stars, advertisers use platforms like celebrity Twitter accounts to target new markets, and YouTube has created an entirely new class of celebrities.⁷ As the platforms for the exploitation of celebrity identities expand, the importance of defining the contours and limits of the right of publicity increases.

These most recent manifestations of the digital age, coupled with the increasing inconsistency of the application of the right of publicity and the trend toward its expansion, have necessitated that the right be defined, unified, and limited. This Note proposes that this outcome be achieved by establishing a federal right of publicity through the Lanham Act.⁸

A federal right of publicity under the Lanham Act would serve to address the three major concerns about the right of publicity in the digital age. The first concern is that due process is being undermined by the potential for forum shopping caused by varied state laws.⁹ The second concern is that the right of publicity has been expanded in some states to include protection of minute elements of a person's identity.¹⁰ This expansion threatens to allow an often-privileged class to recover for potentially frivolous lawsuits. The third concern is that the right of publicity has the ability to infringe on First Amendment rights and that states have failed to develop consistent and effective tests to protect the freedom of speech in right of publicity cases.¹¹

6. Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity "Wheel" Spun Out of Control*, 45 U. KAN. L. REV. 329, 338–43 (1997). Langvardt discusses in greater detail the individuals who are commonly protected by the right of publicity. He asserts that although all individuals may have an inherent right of publicity, the cases involving the right of publicity are nearly always brought by celebrities. *Id.* at 338–40. Political figures often waive the right because they are placed in the realm of political speech. *Id.* at 341–42. Therefore, this Note will discuss the right of publicity in the context of its protection of celebrities.

7. See HAMISH PRINGLE, *CELEBRITY SELLS* 107–67 (2004) (discussing marketing techniques for incorporating celebrities and the increased importance of these techniques in modern advertising through expanded media outlets).

8. Lanham Act, 15 U.S.C. § 1051 (2006).

9. See *Experience Hendrix, L.L.C. v. HendrixLicensing.com, Ltd.*, 766 F. Supp. 2d 1122, 1137 (W.D. Wash. 2011) (discussing the applicability of the laws of the forum versus the laws of the parties' respective domiciles); *infra* Part IV.B.1 (examining due process concerns regarding the right of publicity).

10. See Langvardt, *supra* note 6, at 366–99 (discussing in detail cases expanding the right of publicity to include celebrities' voices, nicknames, associated phrases, and characters played leading up to and following *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992)).

11. See Gloria Franke, Note, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 960–79 (2006) (reviewing the various tests for

Part II will address the history of and rationales for the right of publicity in the United States. Part III will discuss the modern setting of the right of publicity in the realm of media and technology. Part IV will address the inconsistencies of the right of publicity and the major modern concerns about the right of publicity in the context of recent case law. Part V will discuss how a federal right of publicity will help alleviate these concerns and will briefly analyze the arguments against federalizing the right. Part VI will discuss the Lanham Act and its significance for the right of publicity. Finally, Part VII will set forth the framework for a federal right of publicity under the Lanham Act, including tests derived from trademark law, and Part VIII will conclude. This Note focuses on creating a fair, limited right of publicity in the digital age through the Lanham Act.¹²

II. THE EXISTENCE OF THE RIGHT OF PUBLICITY

A. HISTORY¹³

The right of publicity evolved out of the legal theories of privacy and property. The original recognition of a separate right of publicity came from the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*¹⁴ In that case, the court focused on the commercial value of a celebrity's image, stating that, "far from having their feelings bruised through public exposure of their likenesses, [celebrities] would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."¹⁵ The right was more fully analyzed in 1954 when Melville Nimmer addressed the need for protection of a celebrity's commercial right beyond the nonassignable right to privacy, which only reached instances of "[o]ffensive use" and was virtually always waived by the public nature of a celebrity's fame.¹⁶ The right of publicity was initially intended to protect commercial value directly linked to the evolving

First Amendment protection in the right of publicity).

12. This Note does not attempt to establish a finalized federal right of publicity and does not discuss the elements of descendability or transferability.

13. For a complete, detailed history of the development of the right of publicity, see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 148–78 (1993).

14. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 866 (2d Cir. 1953).

15. *Id.* at 868.

16. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 206–09 (1954).

identity of a “celebrity” based on the popularity of film and television.¹⁷ The right was developed because of technological advancements that created celebrities and provided platforms for their commercial gain, and therefore, it is logical that the right continues to evolve to meet the needs of modern technology and media.

The Supreme Court addressed the right of publicity only once, in 1977.¹⁸ The decision in *Zacchini v. Scripps-Howard Broadcasting Co.* gave credibility to the legal theory of the right of publicity, but did little to define its reach. The Court established that First Amendment protections would not create a complete ban on the commercial rights of a performer,¹⁹ but it left plenty of openings for an array of different understandings about what kinds of speech might interfere with the right of publicity and what kinds would be protected. In the subsequent years, therefore, the right was able to expand, contract, and evolve at the will of the states in a seemingly haphazard fashion, as discussed below.²⁰ Most importantly, however, in *Zacchini* the Court did draw a distinction between the right of privacy and the right of publicity in pointing out the inherent commercial nature of publicity.²¹

The right of publicity is one of this country’s younger legal theories, but it has evolved based on its intrinsic link to technology. The right has only been recognized some sixty years, and it is, therefore, well situated to undergo a drastic overhaul. Because there is relatively little precedent, it would be less burdensome to reestablish the right as a federal law, preempting state law, and create a coherent body of law to be uniformly applied.

17. Franke, *supra* note 11, at 952–53 (“[Nimmer] argued that the legal theories available were inadequate to protect the commercial interests celebrities have in their identities, and while ‘the concept of privacy which Brandeis and Warren evolved fulfilled the demands of Beacon Street in 1890,’ he doubted that the concept ‘satisfactorily [met] the needs of Broadway and Hollywood in 1954.’” (alteration in original) (quoting Nimmer, *supra* note 16, at 203)).

18. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578–79 (1977) (holding that a state “may as a matter of its own law privilege the press [in right of publicity cases, but that] the First and Fourteenth Amendments do not require it to do so”).

19. *Id.* at 578–79.

20. See *infra* Part IV.A (discussing the problematic nature of state variations on the right of publicity).

21. *Zacchini*, 433 U.S. at 573.

B. POLICY RATIONALES

1. Proposed Policy Considerations Behind the Right of Publicity

The Supreme Court defined the rationale for the right of publicity as a “straightforward one of preventing unjust enrichment by the theft of good will.”²² The discussion over the need for the right, however, has sparked a debate about the social and economic purposes of the right and the incentives that it creates, one which has been anything but straightforward. Three major schools of thought have evolved regarding the policy reasons behind the right of publicity.²³

The first revolves around the moral rights of a person to protect his or her identity and to be rewarded for the hard work and labor that a person invests in creating an identity.²⁴ This theory tends to mirror the foreign copyright concept of moral rights that the United States has generally rejected.²⁵ Intellectual property rights in the United States are designed to encourage creativity through financial incentives, not as inherent moral or natural rights.²⁶

Moral rights are not widely accepted in the United States and, therefore, provide a slim justification for the need to protect a person’s commercial value. In addition, the commercial value of a person is partially the individual’s inherent traits and partially the hard work of, often, a group of people who are not given protection under the right of publicity.²⁷ Neither of these aspects of the protected portion of a person’s identity fits neatly into an inherent moral right to the protection of work and creativity.

The second policy theory encompasses two economic theories behind the right of publicity. It centers on either the theory of the tragedy of the commons or the desire to promote an investment in a valuable identity by

22. *Id.* at 576 (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 *LAW & CONTEMP. PROBS.* 326, 331 (1966)).

23. *See* Franke, *supra* note 11, at 953–58 (discussing moral, economic, and consumer protection rationales behind the right of publicity).

24. Nimmer, *supra* note 16, at 216.

25. *See* Amy M. Adler, *Against Moral Rights*, 97 *CALIF. L. REV.* 263, 266–71 (2009) (discussing the theory of moral rights, their general rejection in the United States, and the Visual Artists Rights Act, which incorporates moral rights only into the sphere of visual art).

26. *See id.* at 266–71; Christian G. Stallberg, *Towards a New Paradigm in Justifying Copyright: An Universalistic-Transcendental Approach*, 18 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 333, 353–54 (2008) (discussing the policies behind copyright law, including economic incentives, and analyzing the best justifications for the right of publicity moving forward).

27. Sean D. Whaley, *“I’m a Highway Star”*: *An Outline for a Federal Right of Publicity*, 31 *HASTINGS COMM. & ENT. L.J.* 257, 263–64 (2009).

providing economic incentives. The tragedy of the commons theory views publicity as a resource that can be diluted or even destroyed by overuse, and seeks to protect the original owner from such a loss in value.²⁸ The incentive approach mirrors the justifications for copyright and patent that seek to “promote the [p]rogress of [s]cience and useful [a]rts.”²⁹ If identities can be viewed as valuable to society and as useful tools of business, then it would be important to continue to incentivize celebrities to establish and protect these identities. These theories are criticized on the basis that identity is not actually a resource that can be used up and does not have the same value to society as a science or art, nor is an incentive to become famous needed because non-rights-based incentives already exist.³⁰

The third common justification for the right of publicity is the need to protect consumers. This rationale is directly linked to the theories behind trademark law.³¹ The theory is that, in order to prevent consumer confusion, there must not be an unauthorized link to a brand or, in the case of publicity, to a person. This justification has been attacked on the grounds that there are some violations of the right of publicity in which consumers may not be confused.³²

2. Recommended Policy Considerations for Redefining the Right of Publicity

In order to establish an appropriate justification for the right of publicity, it is important to analyze the groups to whom the right has value and those for whom it might be a detriment. Individuals who have developed an identity that has commercial value in society value the right of publicity. A name, likeness, or other trait only has value if it is recognizable. Therefore, the primary classes of people who value the right of publicity are those who have acquired fame such as artists, athletes, and public figures.³³ From an economic standpoint, these individuals have

28. *Id.* at 261–62.

29. U.S. CONST. art. I, § 8, cl. 8. *See also* Stallberg, *supra* note 26, at 353–54.

30. *See* Madow, *supra* note 13, at 205–28 (describing publicity as a collateral source of income); Whaley, *supra* note 27, at 266–67 (describing publicity as a secondary effect of labor).

31. 15 U.S.C. § 1125(a)(1) (2006) (providing a private right in civil action for redressing “confusion . . . mistake, or . . . de[ce]ption”) associated with “origin, sponsorship, or approval” of products and services). *See also* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1706 (1999) (discussing trademark law’s traditional goal of preventing consumer confusion while also addressing additional rationales and changing trends in trademark).

32. Franke, *supra* note 11, at 958.

33. Some states recognize that the right could apply to any person, but nearly all cases brought under the right of publicity are by celebrities. Therefore, this Note addresses the right of publicity in the context of this group. *See* Langvardt, *supra* note 6, at 338–39 (asserting the same and citing cases

value to society because their talents and identities create revenue in a variety of industries. However, they are not a class requiring special protection.³⁴ Because their identities have commercial value, they also have bargaining power. These individuals already have the established rights of all individuals. This additional right is legitimate only to protect a valuable commercial asset. This asset is similar to acquiring a recognizable brand. A brand is valuable because consumers have a positive association with it and it has commercial power.³⁵

The right of publicity may also be of value to consumers who rely on endorsements of specific individuals to make choices regarding products and events. Since the inherent value in the right of publicity is the potential for financial gain from a person's identity, it flows naturally that the right also encompasses the protection of those consumers from which that gain is harvested.

The right of publicity can be detrimental to speakers. Speakers may be other commercially valuable brands speaking through advertisements. This commercial speech has limited First Amendment protection.³⁶ However, speakers may also be social commentators, reporters, or artists, and this class of people has a powerful First Amendment right to expressive speech.³⁷

Therefore, the rationale behind the right of publicity must be narrowly tailored to support a right that protects the pecuniary value of a celebrity's identity, encourages the growth of that value to protect the individuals who hold it, and protects the consuming population, but does not overstep the boundaries of free speech. The right of publicity should protect an individual's right to define his commercial value and encourage him to generate revenue by using and licensing that value. It should also protect

supporting this assertion).

34. Cf. *Madow*, *supra* note 13, at 136–37 (“[T]he right of publicity redistributes wealth upwards.”).

35. See *Henri's Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 365 (7th Cir. 1983) (Coffey, J., dissenting) (discussing the value of brand loyalty).

36. See *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68–69 (1983) (stating that commercial speech that is not unlawful or misleading may not be suppressed except to directly advance a significant government interest).

37. See, e.g., *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (discussing film as protected expressive speech despite its potential commercial value); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1189 (9th Cir. 2001) (finding that a magazine was entitled to full First Amendment protection that limited an actor's right of publicity); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (finding that trading cards were social commentary that required full First Amendment protection for expressive speech); *Franke*, *supra* note 11, at 960–65 (discussing the interaction of the types of speech and the right of publicity).

consumers who rely on an increasing variety of endorsements to make purchasing decisions.³⁸ These policies do not infringe on the protection of free speech because they do not seek to protect against the use of a name or likeness to creatively express an artistic vision or social commentary. Those kinds of works would not lie within the licensable economic value of an individual's identity.

Celebrities have, in effect, become a unique kind of brand.³⁹ In the age of increasing technology and nontraditional marketing, the focus of the right of publicity must be isolated to protecting branding value and enabling that value to increase by also protecting against consumer confusion. These policy goals closely mirror those of trademark law,⁴⁰ which focus on protecting consumers and enabling companies to increase brand loyalty. Therefore, the valid policy considerations for the right of publicity indicate that the right could appropriately be linked to trademark law under the Federal Lanham Act.

III. THE AGE OF THE OVERNIGHT CELEBRITY, NONTRADITIONAL MARKETING, AND NATIONAL MEDIA EXPOSURE

It is no secret that modern technology has impacted many areas of the law. The right of publicity, which is designed to protect celebrities and the use of their image and likeness in commercial media, is, of course, impacted strongly by the evolution of technology and media. As discussed above, the right was created to protect celebrities' commercial value because of the trend of using celebrities as marketing tools. This intrinsic link between the right of publicity and the evolution of media and entertainment through technology means that these fields should advise the legal community as to how the right should evolve. There are three main media and technology trends that should be considered in determining the future of the right of publicity: (1) the increasing number of celebrities through the phenomenon of "overnight" celebrities; (2) the growing exploitation of the commercial value of identity based on new marketing

38. See *infra* Part III.B (discussing expanding media platforms).

39. See JEAN-NOËL KAPFERER, *THE NEW STRATEGIC BRAND MANAGEMENT: CREATING AND SUSTAINING BRAND EQUITY LONG TERM* 132 (2d ed. 1997) (discussing brand management, including ways to reinforce brand loyalty); Madow, *supra* note 13, at 164–66 (describing the increased commoditization of fame and its usefulness in marketing). See generally JO PIAZZA, *CELEBRITY, INC.: HOW FAMOUS PEOPLE MAKE MONEY* (2011) (discussing the branding power of celebrities such as Ashton Kutcher, Angelina Jolie, and Tim McGraw).

40. See Lemley, *supra* note 31, at 1709–10 (explaining the prevalence of assigning trademarks without assigning their "accompanying business assets or goodwill").

techniques and Internet-based media platforms; and (3) the interstate nature of the Internet. These three trends, coupled with the three major concerns about the right of publicity discussed below,⁴¹ serve as the basis for federalizing the right of publicity through the Lanham Act.

A. OVERNIGHT CELEBRITIES

The right of publicity protects celebrities who have developed identities that have commercial value to others. This class does not require additional special protection. Additionally, the advent of the overnight celebrity creates an even greater concern about protecting a class of people that not only has the resources and bargaining power of other celebrities, but also may fail to provide tangible contributions to society. As in the hypothetical about Elle, the development of media outlets such as YouTube and Twitter enable people to develop a commercially valuable following through an increasing number of platforms.⁴² Many of these so-called celebrities may have a great deal of commercial success for a very limited period of time.⁴³ A person can now have a recognizable commercial identity by creating a single entertaining video, such as the “People Say” videos.⁴⁴ Once such people have established recognizable identities, they may have grounds to sue for use of tangential elements of their identity that are not linked to their original commercial success.

While there is no reason that these celebrities should not have the same rights as other persons to recover for nonconsensual uses of their name and likeness, the trend of overnight celebrities serves to display further why an expansive right of publicity can be overprotective of an increasingly large class of celebrities who may not be contributing any long-term artistic or entertainment value to society.

41. See *infra* Part IV.B.

42. See Jenna Wortham, *ROFLCon: It's Not Easy Being Memes*, WIRE (Apr. 25, 2008, 12:54 AM), <http://www.wired.com/underwire/2008/04/its-hard-out-he/> (discussing the advent of the “microcelebrity”).

43. See *id.* (discussing the difficulty of “maintaining the buzz”).

44. See, e.g., Derrick Cole, Jenn Hovick & Brittany Ludwig, *Shit Single Girls Say*, YOUTUBE (Jan. 2, 2012), <http://www.youtube.com/watch?v=47aS3uSCHLc>; Elena Crevello & Heidi Niedermeyer, *Shit People Say in LA*, YOUTUBE (Jan. 23, 2012), <http://www.youtube.com/watch?v=1xzA-Op1soo>; Kyle Humphrey, Juliette Lewis & Graydon Sheppard, *Shit Girls Say—Episode 1*, YOUTUBE (Dec. 12, 2011), <http://www.youtube.com/watch?v=u-yLGIH7W9Y>.

B. EXPANDING MEDIA PLATFORMS

The right of publicity is a valuable right that deserves some protection. A celebrity is entitled to exploit his identity for commercial gain at his discretion. As the platforms for this exploitation increase, the value of this right also increases, necessitating the establishment of a coherent and limited right of publicity. Celebrity endorsement has become a valuable marketing tool, and producers are using celebrities not just in traditional television advertisements, but also through new media techniques.⁴⁵ Celebrities are gifted with brand-name items to wear as promotions, they are paid to “tweet” about specific products, products are placed in films with big name celebrities, celebrities host club events, and celebrities are used in web-based advertising and on Facebook events and advertisements.⁴⁶ These are valuable endorsements for both the celebrity and the brand. Consumers, consequently, rely on these endorsements, make positive connections with brands, and develop brand loyalties based on loyalties to particular celebrities.⁴⁷

If celebrity marketing is a valuable asset, then producers need to be given a clear standard of when and how they may use portions of a celebrity’s identity, and consumers need to be protected from confusion surrounding the authenticity of a celebrity endorsement. The increase in the use of celebrity marketing in the era of modern technology has made identity a valuable commercial asset, establishing a need to protect that asset from hidden infringement in media sources. However, it also establishes a growing need to protect consumers and avoid frivolous lawsuits by celebrities with ever-growing marketing bankrolls.

C. TECHNOLOGY AS INTERSTATE COMMERCE

The right of publicity concerns the use of a person’s identity in commerce and is often implicated in the context of advertising or

45. See Leah W. Feinman, Note, *Celebrity Endorsements in Non-Traditional Advertising: How the FTC Regulations Fail to Keep Up with the Kardashians*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 97, 101–03 (2011) (discussing the transition from traditional marketing to valuable new media marketing involving celebrities and analyzing the FTC’s attempt to regulate these new avenues of marketing).

46. See *id.* at 110–17 (discussing modern forms of celebrity endorsement, including the use of social media, gifting products to celebrities to use, and payment of celebrities to mention or wear certain products).

47. See Adam Hirschfeld, Note, *Celebrity Misrepresentation & the Federal Lanham Act: The Public Fights Back*, 78 ST. JOHN’S L. REV. 233, 235–36 (2004) (discussing the need to protect consumers from false celebrity endorsements and even advancing a federal cause of action for consumers in these cases).

marketing. These forms of media have become almost entirely national because of the growth of the Internet. All of the new platforms and marketing techniques discussed above exist in an Internet-driven culture that allows constant access to these platforms via computers, phones, and tablets across the country and the world. The idea that state law controls a right that exists almost entirely in national media including television, radio, and most significantly, through Internet portals, is unsettling.⁴⁸ State laws vary immensely regarding the right of publicity, and because any potentially infringing work is typically distributed nationally and some states lack domicile requirements, lawsuits can be brought in the state offering the most expansive right of publicity. As with the other intellectual property rights that exist primarily in the realm of national media, federal laws calling upon Congress's interstate commerce powers create consistent standards to protect against forum shopping and provide adequate remedies.

IV. IDENTIFYING THE PROBLEMS WITH THE CURRENT RIGHT OF PUBLICITY

The right of publicity has evolved over the past sixty years into an expansive and inconsistent right. This Note discusses the variations of the right of publicity and addresses three of the major concerns that these variations present.

A. VARIATIONS OF THE RIGHT OF PUBLICITY

The right of publicity varies considerably between states. Certainly, any law that is governed by state statutory and common law is subject to variations. However, there are several variances in the right of publicity laws that raise particular concerns that are not present in other areas of law. The following is an overview of some of the current state and common law rights of publicity. The included sampling will help to point out areas of distinction that are particularly problematic.

Twenty-seven states currently recognize the right of publicity,⁴⁹ some by statute and some through common law. Some of the major areas of

48. See Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Statute Is Necessary*, COMM. LAW., Aug. 2011, at 14 (lamenting that “numerous lawsuits have been brought against [out-of-state] defendants for violations of [state] right of publicity law[s] by celebrities . . . who have had little or no connection to [the state]”).

49. Krishan Thakker, *The Federalism Case Against a Federal Right to Publicity*, 2011 U. DENV. SPORTS & ENT. L.J. 95, 113–115 (2011).

variation include (1) the protected features of an individual's identity, (2) the domicile requirement, (3) the extent of postmortem protection, and (4) the application of injunctive remedies.

1. Scope of Protected Elements of the Individual

The most common scope of the right of publicity is the protection of name or likeness, but likeness has been interpreted to mean a variety of things. The California statutory law, which is one of the most expansive right of publicity laws, protects elements of identity including "name, voice, signature, photograph, or likeness."⁵⁰ The common law in states such as California and Michigan have even found protection for features such as mottos⁵¹ and the implication of a person through use of a robot.⁵² On the other hand, states such as Massachusetts only protect a "name, portrait or picture."⁵³

2. Domicile Requirements

Many states only give standing in a right of publicity suit for an individual who is domiciled within that state. Interestingly, however, some states, including California, Kentucky, Florida, Oklahoma, Virginia, Indiana, Washington, and Utah, do not require domicile in order to bring suit.⁵⁴ An individual, therefore, could sue in the state seemingly most favorable to the case, and these rules can vary from state to state. The variance of states' domicile requirements presents an alarming issue of forum shopping. Laws are typically designed to reduce the issue of forum shopping since it can create an unfair advantage for one of the parties in a case. Under the current right of publicity laws, forum shopping issues seem to go uncorrected.⁵⁵ With the expansion of technology, most potential violations of the right of publicity are through works transmitted nationally or internationally over the Internet and other expansive media platforms. As in the Elle hypothetical above, a plaintiff could sue under Indiana's broad protections, even though she does not reside in Indiana, because the

50. CAL. CIV. CODE § 3344(a) (West 2012).

51. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836 (6th Cir. 1983) (protecting an entertainer's right of publicity associated with an often used catch phrase on an entertainer's show).

52. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (finding error in the lower court's summary judgment against a celebrity for using a robot to appropriate her identity).

53. MASS. GEN. LAWS ch. 214, § 3A (2012).

54. 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 6 (2d ed. 2004).

55. Cf. Thakker, *supra* note 49, at 119–22 (discussing the potential forum shopping issues of the right of publicity, but arguing that they are resolved by some states' choice of law statutes).

allegedly unlawful material is distributed nationally via the Internet. This can lead to inconsistent outcomes and unfairness.

3. Postmortem Protection

The extent of protection under the right of publicity after death is another factor that varies greatly among states.⁵⁶ Certainly property that has continuing value after death is more valuable. Therefore, these major discrepancies among states increase the desire of an individual and his family to take advantage of forum shopping to increase the right's value. Although the determination of a number of years for a right to extend may appear to be arbitrary, all other intellectual property rights have a set duration that provides clarity and reliability.⁵⁷ However, as the state laws currently stand, one's publicity rights after death vary from state to state: in California, the right of publicity extends for seventy years after death;⁵⁸ in Indiana, it is one hundred years;⁵⁹ but in New York, the right ends at death.⁶⁰ The value of human characteristics should be something that is not unique to the state in which a person happens to pass away or the state in which his or her family feels would be most beneficial to obtain financial gain from his or her life's work. Additionally, there may be no basis at all for the protection of personal characteristics of a living person to extend beyond death.⁶¹

4. Relief

Finally, the variations of state remedies for the right of publicity are an area of concern. Again, because most products and advertisements are displayed to a far-reaching market due to advances in technology, there are serious concerns about the enforcement of injunctions and other remedies. Therefore, it is very difficult to determine how remedies should be enforced in the other affected states, especially when it comes to injunctive relief. As Goodman points out,

If a defendant infringes one's right of publicity, the remedy is usually a permanent injunction. This is because monetary damages alone are often an inadequate remedy in such cases. Relief should be limited to an injunctive order when infringers acted without knowledge or malice, and

56. See MCCARTHY, *supra* note 54, § 9.8 (arguing against a descendible right of publicity).

57. See 17 U.S.C. § 302(a) (2006) (setting forth the seventy-year duration of a copyright after the author's death); 35 U.S.C. § 154(a)(2) (2006) (setting a twenty-year term for patents).

58. CAL. CIV. CODE § 3344.1(f)(3) (West 2012).

59. IND. CODE ANN. § 32-36-1-8 (West 2012).

60. N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 2013).

61. See MCCARTHY, *supra* note 54, § 9.8 (arguing against a descendible right of publicity).

where no measurable damages are found. Injunctive relief under the present regime of state laws has raised jurisdictional problems. Such unsettled jurisdictional issues further demonstrate the need for a unified federal statute. For instance, New York courts have held that violations of the right of publicity apply to activities only within the state and, therefore, out-of-state sales are not enjoined. In contrast, Michigan law has been used to enjoin infringement activities in any state regardless of whether the other states recognize the right of publicity.⁶²

Varied remedies increase forum shopping and also lead to inconsistent results that may be difficult to enforce.⁶³ In the interest of efficiency, it is essential that remedies be consistently applied and that relief is fair regardless of the state in which the action is brought.

All four of these major variations make it difficult or nearly impossible for marketers or creators to determine when and where it is appropriate to use portions of a celebrity's identity.⁶⁴ Because it is unlikely that most modern products or advertisements will be displayed in only one state, and because there are limited means to predict in what state an individual will sue, self-policing the industry becomes difficult. This problem can also lead to heightened litigation costs and burdens on state courts with broad rights of publicity. The right of publicity is so intertwined with new media that a new legal standard must be created cautiously to protect celebrities' commercial value without enabling crafty lawyers or clients to take advantage of obscure state laws. A federal right of publicity would solve the issue of forum shopping by creating clear nationally applied standards to help decrease the unfair outcomes of the current right of publicity and help limit needless litigation.

B. THREE MAJOR CONCERNS ABOUT THE CURRENT RIGHT OF PUBLICITY

There are three major problems that can be identified based on the modern technological and celebrity-focused backdrop of the right of publicity and the variances between state laws described above. These three problems are not exhaustive, but represent this author's view of the distinct issues facing the modern right of publicity that can be addressed through a federal right of publicity under the Lanham Act.

62. Goodman, *supra* note 4, at 262–63.

63. *Id.* at 243–44.

64. *Id.* at 244.

1. Due Process

Some right of publicity statutes do not require the plaintiff to be domiciled in the state in which he or she brings suit. These statutes enable plaintiffs to choose a forum that best complements the kind of suit they wish to bring. As addressed above, this can lead to forum shopping and unpredictable results that make it difficult for producers to accurately predict how they may properly use elements of a celebrity's identity. In 2011, a right of publicity statute was challenged on due process grounds for the first time. This challenge demonstrates the increased concern with the expansion of the right of publicity in some states and the forum shopping concerns that arise because of these statutes. In *Experience Hendrix, L.L.C. v. HendrixLicensing.com, Ltd.*, one district court took a stab at minimizing the expansion of its state's own right of publicity.⁶⁵ The new Washington right of publicity statute in question was enacted in 2008 and reads in pertinent part:

Every individual or personality has a property right in the use of his or her name, voice, signature, photograph, or likeness. Such right exists in the name, voice, signature, photograph, or likeness of individuals or personalities deceased before, on, or after June 11, 1998 The property right does not expire upon the death of the individual or personality, regardless of whether the law of the domicile, residence, or citizenship of the individual or personality at the time of death or otherwise recognizes a similar or identical property right. The right exists whether or not it was commercially exploited by the individual or the personality during the individual's or the personality's lifetime This chapter is intended to apply to all individuals and personalities, living and deceased, regardless of place of domicile or place of domicile at time of death.⁶⁶

The case related to products bearing Jimi Hendrix's name. Experience Hendrix had been licensed certain rights to Hendrix's trademarks and copyrights.⁶⁷ However, Hendrix had died while domiciled in New York and it was determined that his right of publicity did not pass on to his heirs under New York law.⁶⁸ When suit was brought in Washington, the question of choice of law became very important.⁶⁹ Because Washington, by statute, ignores the domicile of the personality, the court had to determine if it

65. *Experience Hendrix, L.L.C. v. HendrixLicensing.com, Ltd.*, 766 F. Supp. 2d 1122, 1149 (W.D. Wash. 2011).

66. WASH. REV. CODE § 63.60.010 (2012).

67. *Experience Hendrix*, 766 F. Supp. 2d at 1127.

68. *Id.*

69. *Id.* at 1132–33.

should override the decision regarding the extinction of Hendrix's right of publicity based on his domicile in New York.⁷⁰ The court determined that, since the statute would require Washington to contradict New York's determination, the lines of the statute stating "regardless of the place of domicile or place of domicile at time of death" were an unconstitutional violation of due process.⁷¹

The court's reasoning on the due process issue used the Supreme Court standard that a state "must have a significant contact or significant aggregation of contacts, creating state interests, such that choice of its law is neither arbitrary nor fundamentally unfair."⁷² The court found that the ability to forum shop and supersede a state law in the place where a personality was domiciled was in fact arbitrary and unfair.⁷³

This case marks the first time that a court has found a right of publicity statute unconstitutional. Other statutory and common law rights of publicity allow the same kind of forum shopping. This case opens the door to strike down other clauses of right of publicity statutes or at least spark a discussion about the expansion of the right. The due process concerns raised by *Experience Hendrix* demonstrate that the right of publicity is ripe for change. The proposed federalization of the right would solve any future ambiguities about the constitutionality of any state's rights of publicity.

2. Protecting Too Many Elements of a Person's Identity

The right of publicity has expanded in some states from protection of a celebrity's clearly identifiable name or image to protection of an array of traits including voice, catchphrase, nickname, and groupings of similar physical traits.⁷⁴ This expansion has opened the door to a slew of seemingly frivolous lawsuits in which celebrities recover for the use of small elements of their identities or a combination of physical attributes that appear to indicate their identities. Many of these suits take place in California. *White v. Samsung Electronics America, Inc.*⁷⁵ was a landmark case in California that has been targeted as the decision that overextended

70. *Id.* at 1135–36.

71. *Id.* at 1141 (quoting WASH. REV. CODE § 63.60.010 (2012)).

72. *Id.* at 1135 (quoting *Phillips Petroleum Co. v. Shutts*, 472 U.S. 797, 818 (1985)).

73. *Id.* at 1137–38.

74. Langvardt wrote an excellent article addressing the many concerns with the expansion of the right of publicity to protect smaller aspects of a celebrity's identity and explaining the main types of cases that went beyond the traditional right of publicity in the context of the development of the *White* decision and its aftermath. *See generally* Langvardt, *supra* note 6.

75. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1408 (9th Cir. 1992).

the protections of the right of publicity and enabled many frivolous modern cases.⁷⁶

In *White*, Vanna White, the well-known hostess of “Wheel of Fortune,” sued Samsung over a commercial that used a robot possessing traits similar to her in an environment reminiscent of the show.⁷⁷ She sued successfully under the common law right of publicity, which is not “confined” to the protection of name and likeness only.⁷⁸ The court found that the robot’s blonde wig, attractive female features, and the action of shifting lettered tiles was sufficiently similar to White’s identity to constitute the unauthorized commercial exploitation of that identity.⁷⁹ The court found that, because there had been some indication by scholars that the right of publicity might extend beyond just name and likeness, it should apply to anything that would indicate a celebrity’s characteristics.⁸⁰ As the dissent noted, the statutory right would not implicate the commercial, but now under common law, the court was expanding the right beyond what the legislature had decided to include.⁸¹

On the appellate panel review denying rehearing of the case and rejecting en banc consideration, Judge Kozinski’s dissent discussed in detail the precise concerns that *White* raised for the future of the right of publicity. He saw the decision as something “dangerous”⁸² and discussed the fact that the law now protected “anything that remind[ed] the viewer” of a celebrity and that the right would now encroach on free speech and creativity.⁸³ Judge Kozinski was concerned that the right of publicity lacked the structure and exceptions provided by the other intellectual property rights⁸⁴ and also discussed that those outside of California would be affected by this expansive right as well.⁸⁵

To a great extent, Judge Kozinski’s fears are coming true. The expanded California right of publicity allows top celebrities to assert that

76. Cf. Thakker, *supra* note 49, at 104–05 (stating that the *White* case, which suggested that “anything that brings to mind a celebrity may be actionable,” is “the ultimate expansion of [California’s right of publicity] law”).

77. *White*, 971 F.2d at 1396–97.

78. *Id.* at 1397.

79. *Id.* at 1399.

80. *Id.* at 1397–98.

81. *Id.* at 1403 (Alarcon, J., concurring in part and dissenting in part).

82. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting).

83. *Id.* at 1515.

84. *Id.* at 1516.

85. *Id.* at 1518–19. See also Thakker, *supra* note 49, at 105–08 (discussing Judge Kozinski’s dissent in detail).

even small parts of their identities are being unlawfully indicated in a commercial setting. Several recent suits perfectly display how the *White* case has encouraged celebrities to sue for use of elements of their identities that would not have formerly provided grounds for suit. None of these cases have yet made it to trial, but the swift settlements in all the cases indicate that the celebrity had a valid claim.

In 2009, Paris Hilton sued Hallmark for the use of her image and catchphrase “That’s Hot” in a greeting card with her head attached to a waitress’s body as a play on Hilton’s show “The Simple Life.”⁸⁶ She claimed that the elements of the card together represented her identity, and the Ninth Circuit agreed that the claims should not be dismissed because the card was not “transformative” as a matter of law.⁸⁷ The case settled in the fall of 2010.⁸⁸ Similar to *White*, the case seemed to rest on the surrounding context in which the elements were used, not on the actual identity of the plaintiff.⁸⁹ In 2010, Lindsay Lohan sued E*Trade for its commercial featuring a baby that was referred to as “Lindsay” and was called a “milkaholic.”⁹⁰ Lohan argued that the name Lindsay and the trait of alcoholism, although relatively generic, together might indicate to the public that the commercial was connected to her.⁹¹ The case settled profitably for Lohan in late 2010, demonstrating that she had a valid enough claim to proceed with litigation.⁹² In 2011, Kim Kardashian sued Old Navy for an advertisement with an attractive dark-haired, brown-eyed, stylish female, claiming that the woman was being used to represent Kardashian and to confuse people into thinking that it was her in the advertisement.⁹³ It did not reference Kim or show any image of her, yet she argued that the characteristics in sum would appear to reference her to the

86. *Hilton v. Hallmark Cards*, 599 F.3d 894, 899 (9th Cir. 2010).

87. *Id.* at 911.

88. Eriq Gardner, *That’s Hot: Paris Hilton Settles Hallmark Lawsuit*, REUTERS (Sept. 26, 2010, 9:04 PM), <http://www.reuters.com/article/2010/09/27/us-hilton-idUSTRE68Q04Z20100927>.

89. *Hilton*, 599 F.3d at 911.

90. Jonathon Stempel, *Lindsay Lohan Sues Over “Milkaholic” E*Trade Ad*, REUTERS (Mar. 9, 2010, 3:00 PM), <http://www.reuters.com/article/2010/03/09/us-lohan-etradelawsuit-idUSTRE6283HD20100309>. For a video of the commercial at issue, see *The 2010 E Trade Commercial From Superbowl*, YOUTUBE (Feb. 7, 2010), <http://www.youtube.com/watch?v=5QS9rIZejaw>.

91. See Stempel, *supra* note 90.

92. See Christie D’Zurilla, *Lindsay Lohan, E-Trade Settle Milkaholic Baby Lawsuit*, L.A. TIMES (Sept. 20, 2010, 4:57 PM), <http://latimesblogs.latimes.com/gossip/2010/09/lindsay-lohan-etradelawsuit-milkaholic-baby-lawsuit-poll.html>.

93. Anthony McCartney, *Kim Kardashian Sues Old Navy Over Lookalike in Ads*, USA TODAY, (July 21, 2011, 10:08 AM), http://www.usatoday.com/money/advertising/2011-07-21-kim-kardashian-old-navy_n.htm. For a video of the commercial at issue, see *Super C.U.T.E. | Old Navy Commercial*, YOUTUBE (Feb. 17, 2011), <http://www.youtube.com/watch?v=98KPM-qR7Vs>.

public. The case settled for an undisclosed sum.⁹⁴

There appears to be a dangerous trend developing in the wake of the *White* case.⁹⁵ The precedent that even a small feature of a major celebrity, or the sum of general characteristics a celebrity has, cannot be copied has the potential to chill certain creative works⁹⁶ and expand the number of lawsuits in California.⁹⁷

3. The First Amendment and Inconsistent Outcomes

Judge Kozinski's concerns about the expansion of the right of publicity were linked directly to First Amendment concerns. He feared that the right of publicity was infringing on free speech and that the right lacked the First Amendment protections that are firmly in place in other areas of intellectual property.⁹⁸ Concerns about the right of publicity's interaction with free speech are not alleviated by the tests that are in place. States have applied a variety of tests⁹⁹ including the newsworthy exception test,¹⁰⁰ the fair use test,¹⁰¹ the transformative test,¹⁰² and the predominant use test.¹⁰³ These tests are applied inconsistently, and consequently, creators cannot confidently determine whether their works will fall within the realm of the protected speech or will infringe on the right of publicity. This issue implicates free speech concerns because it serves to effectively chill some forms of creative speech.

Two recent cases display the reality of the inconsistent application of the First Amendment tests and highlight the difficulties that this presents for creators. These cases each relate to a recent video game by Electronic Arts, *NCAA Football 09*. The game sparked lawsuits by football players

94. *Kim Kardashian and Old Navy Settle Ad Lawsuit*, CBSNEWS.COM (Aug. 29, 2012, 3:06 PM), http://www.cbsnews.com/8301-31749_162-57502783-10391698/kim-kardashian-and-old-navy-settle-ad-lawsuit/.

95. See Clay, *supra* note 1, at 501–10 (discussing rationales for narrowing the right of publicity for celebrities); Langvardt, *supra* note 6, at 420–21 (asserting that the *White* decision left the right of publicity in California “dangerously open-ended”).

96. Langvardt, *supra* note 6, at 408.

97. See *id.* at 420–21.

98. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513–16 (9th Cir. 1993) (Kozinski, J., dissenting).

99. Franke discusses each of the free speech tests applied to the right of publicity and advocates for a “primary motivation” test that considers whether the use was motivated primarily by commercial gain. Franke, *supra* note 11, at 979–82.

100. See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978).

101. See, e.g., *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1356–58 (D.N.J. 1981).

102. See, e.g., *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807–10 (Cal. 2001).

103. See, e.g., *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

who claim that, although the games do not use their actual names, the characters are made to look like specific players and use their statistics and college teams. In light of the Supreme Court's recent decision that video games represent protected expressive speech, these cases are a particularly good example of the need to clarify the constitutional protections as they relate to the right of publicity.¹⁰⁴ The outcomes of these cases were different even though the suits were identical claims against the same creative work.

In *Keller v. Electronic Arts, Inc.*, Samuel Michael Keller, a former college football star at Arizona State University, sued under, among other things, California's right of publicity.¹⁰⁵ Electronic Arts attempted to assert a First Amendment defense, which the court found invalid.¹⁰⁶ Under this defense in California, a defendant must show that the challenged work is transformative or that its value is not derived primarily from the personality's fame.¹⁰⁷ It is a test that closely mirrors the copyright defense of fair use.¹⁰⁸

To determine whether a work is transformative, a court must inquire into "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word 'expression,' we mean expression of something other than the likeness of the celebrity."¹⁰⁹

The court found that because Keller was presented in the game in the same context in which he existed in real life, there were not enough transformative elements to constitute protected speech.¹¹⁰

In *Hart v. Electronic Arts, Inc.*, another player brought a suit in regard to the same video game under New Jersey's common law right of

104. *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2738, 2741–42 (2011) (finding that video games are "protected speech" and that restriction of them cannot be "overinclusive").

105. *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719, at *6–8 (N.D. Cal. Feb. 8, 2010).

106. *Id.* at *11–16.

107. *Id.* at *13.

108. 17 U.S.C. § 107 (2006).

109. *Keller*, 2010 U.S. Dist. LEXIS 10719, at *13 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001)).

110. *Id.* at *16.

publicity.¹¹¹ Interestingly, the New Jersey court chose to apply the same transformative use test as did the California court.¹¹² However, here the court found that the First Amendment protected the same game using a different player in an identical manner.¹¹³ The court focused on the unique fictional elements of the game environment and the fact that users could manipulate the players to change their skills, appearance, and statistics.¹¹⁴ The opinion acknowledged that *Keller* had a different outcome but argued that the California court failed to look at the modification features of the game and the fantastical settings.¹¹⁵ The court also performed an analysis under another First Amendment defense test used in other circuits for the right of publicity. The “*Rogers* test” is grounded in trademark principles.¹¹⁶ It is “a two-prong test that asks: (1) whether the challenged work has relevance to the underlying work; and (2) if the challenged work is relevant, whether the title misleads the public as to the source of content of the work.”¹¹⁷ Use of another’s identity in a novel, play, or motion picture is also not ordinarily an infringement. However, “if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability.”¹¹⁸ Moreover, “use of a person’s name and likeness to advertise a novel, play, or motion picture concerning that individual is not actionable as an infringement of the right of publicity.”¹¹⁹ The court found that this test also weighed toward a finding of protected speech because, although the player certainly was relevant to the underlying work, the use of his likeness would not confuse consumers into thinking that he was endorsing the game.¹²⁰

These cases point to the clear discrepancies between courts’ applications of the First Amendment protections to the right of publicity. Following these decisions, any other players wanting to sue Electronic Arts will go to California and obtain relief, while *Hart* becomes a kind of “guinea pig.” The protection of free speech has become an increasing point

111. *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

112. *Id.* at 776–87.

113. *Id.* at 786–87.

114. *Id.* at 783–84.

115. *Id.* at 787–88.

116. *Id.* at 788.

117. *Id.* at 793 (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

118. *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 336 (E.D. Pa. 1996) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995)) (applying the *Rogers* test in a Pennsylvania right of publicity case).

119. *Id.*

120. *Hart*, 808 F. Supp. 2d. at 793.

of contention in the technological era,¹²¹ and as discussed, the right of publicity is linked to technological developments. It seems ludicrous that the same “expression,” used in the same manner, could be both protected and unprotected. The other intellectual property rights maintain consistent tests for the protection of free speech.¹²² While the fair use doctrine applies a series of factors that can be weighed differently, the test has evolved through precedent to create a coherent standard of protection.¹²³ The implication of the inconsistency of First Amendment protections under the right of publicity is that creators will be hesitant to produce creative works that may be connected in any way to celebrity identities.

V. TOWARD A FEDERAL RIGHT OF PUBLICITY

A federal right of publicity could serve to eliminate the major concerns addressed in this Note. A federal right of publicity would eliminate the due process concerns raised by *Experience Hendrix* as well as forum shopping concerns. It would also give Congress the opportunity to properly evaluate the policy goals of the right of publicity in order to place limits on the scope of the right’s protection and put First Amendment protections in place.

The right of publicity evolved out of the state law theories of privacy and property, but is no longer analogous to those rights.¹²⁴ It is a distinctive right that can be federalized to best define its reach.¹²⁵ Some contend that the right of publicity is grounded in property law and is part of a state’s power.¹²⁶ Others contend that the right is centered on privacy rights, another area of state protection.¹²⁷ However, neither of these frameworks

121. See G. Edward White, *The First Amendment Comes of Age: The Emergence of Free Speech in Twentieth-Century America*, 95 MICH. L. REV. 299, 302 (1996) (discussing a new framework for the analysis of free speech and its evolution in the modern era).

122. See 17 U.S.C. § 107 (2006) (setting forth the fair use doctrine in copyright); Rodrigues, *supra* note 5, at 1217–18 (discussing how the likelihood of confusion doctrine in trademark law under 15 U.S.C. § 1125 has been seen to prevent infringement on free speech rights in the trademark doctrine).

123. See Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2541 (2009) (arguing that fair use is a coherent and easily applicable doctrine).

124. Cf. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162–63 (2006) (discussing the imperfect comparison of the right of publicity to either privacy or property); Thakker, *supra* note 49, at 98–99 (addressing the need to keep the right of publicity in the realm of state laws because of its hybrid nature).

125. Others argue that the distinctive nature of the right should point toward allowing each state to determine the reach of the right. See Thakker, *supra* note 49, at 122–27.

126. See Rodrigues, *supra* note 5, at 1225–27 (comparing the right of publicity to community property to argue that the right of publicity should remain a state law).

127. Robert T. Thompson, III, Comment, *Image as Personal Property: How Privacy Law Has*

actually fits the right of publicity in the modern era. The right of publicity is about the commercial value of an identity. It is not an actual tangible property that is distributed but is instead an ongoing value that can be licensed. The property elements of the right of publicity are congruent to intellectual properties, which are found exclusively in federal law. The right of publicity no longer has a strong connection to privacy law. A person cannot license his or her right of privacy.¹²⁸ In fact, individuals whose personae have commercial value forego the right of privacy for those elements in order for them to gain recognition and develop value.¹²⁹ Because the right of publicity is now incongruent with its roots in state property law or privacy law, these roots do not restrict the availability of a federal right of publicity.

Some scholars argue against a federal right of publicity because the law needs time to evolve.¹³⁰ However, there is no reason that a federal statute cannot evolve in its content and interpretation. Certainly, other federal rights have evolving doctrines. The theory of fair use in copyright evolved over time to create the well-known factors that have even been applied to the right of publicity.¹³¹

Some commentators have also contended that a federal right of publicity would destroy states' ability to compete for celebrities.¹³² While it may be true that there is commercial value in having a population of entertainers or other personalities in a state, it does not follow that the current right of publicity protects these interests. First, most personalities live in a state because it is their place of employment or the home of their family. Second, some states protect persons from other states so those states already maintain a "trump card." In addition, most celebrities are already centered in entertainment hubs such as Los Angeles, New York, and Nashville. There is no evidence of an influx of celebrities into states enacting expansive rights of publicity.

Congress has the power to enact a federal right of publicity through the Commerce Clause. The Commerce Clause¹³³ has evolved to include

Influenced the Right of Publicity, 16 UCLA ENT. L. REV. 155, 175–78 (2009).

128. Nimmer, *supra* note 16, at 205–06, 209.

129. *Id.* at 205–06, 209–10.

130. See Dogan & Lemley, *supra* note 124, at 1186–90 (discussing incentive models and copyright); Thakker, *supra* note 49, at 122–27 (arguing that it is premature to create a federal right of publicity); Rodrigues, *supra* note 5, at 1210–12 (arguing that states should experiment with different right of publicity laws).

131. See Samuelson, *supra* note 123, at 2546 (discussing the adaptability of the fair use doctrine).

132. Thakker, *supra* note 49, at 126–27; Rodrigues, *supra* note 5, at 1209–11.

133. U.S. CONST. art. I, § 8, cl. 3.

any area that “exerts a substantial economic effect on interstate commerce,” even in the aggregate.¹³⁴ There is no doubt that the use of portions of an individual’s identity for financial gain substantially affects interstate commerce, since most of the purportedly infringing activity occurs through national media sources and the Internet.

Not only does Congress have the power to create a federal right of publicity to preempt state law, but it would also be a logical step to combine the right with the other intellectual property rights. Copyright, patent, and trademark are traditionally viewed in a similar light as the protections for creative elements, and the laws are used to stimulate innovation and promote commercial success. A person’s identity obtains commercial value through the “creation” of a recognizable persona. These elements often require an entire team of experts to create and sustain them.¹³⁵ Some argue that these elements should be protected more like copyright.¹³⁶ However, they lack the same “expressive” nature that copyright includes.¹³⁷ Other scholars who have proposed federalizing the right of publicity have recommended creating an entirely separate right with the “best” elements of state-created rights.¹³⁸ This Note argues that the Lanham Act provides the most solid and congruent foundation for a federal right of publicity.

134. *Wickard v. Filburn*, 317 U.S. 111, 125 (1942).

135. *Whaley*, *supra* note 27, at 263–64.

136. *See, e.g., Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 798, 804–05 (Cal. 2001).

137. As Dogan and Lemley explained,

The copyright analogy, however, is both misleading and dangerous. First, and most importantly, the economic rationale for copyright law—that market failure would occur in the absence of the legal right—simply does not apply in the right of publicity context. As Diane Zimmerman points out, “[n]ot a shred of empirical data exists to show that [celebrities] would . . . invest less energy and talent” in becoming famous without a publicity right, particularly since the law provides protection primarily to those who are “already handsomely compensated” and for whom additional protection is unlikely to provide much marginal incentive. Even if celebrities would make such an additional investment, it is not at all clear that society should want to encourage fame for fame’s sake. Unlike copyright law—which aims to promote the production of valuable works of authorship that enhance the quality of discourse and understanding in our society—the right of publicity rewards those who, with luck, hard work, or accident of birth, happen to join the ranks of the famous. Because the right of publicity does not encourage the production of any identifiable value, the copyright analogy cannot support the right.

Dogan & Lemley, *supra* note 124, at 1187–88 (alterations in original) (footnotes omitted).

138. *See, e.g., Whaley*, *supra* note 27, at 259–60 (advocating the creation of a federal right of publicity law that “outlines important details about the justification behind the right, the nature, scope and contours of the right”).

VI. BACKGROUND OF THE LANHAM ACT AND ITS APPLICABILITY TO THE RIGHT OF PUBLICITY

Trademark law evolved from common law principles into federal statutory law protecting the use of marks in commerce. Congress passed the Lanham Act in 1946 through its Commerce Clause power.¹³⁹ The Act was designed to protect trademark holders from unfair competition and to protect consumers from deception.¹⁴⁰ Trademark law was developed as a kind of “intangible property” right.¹⁴¹ It focuses on the commercial value of a brand and awards the “owner’s expenditure of time, money, and effort to create a positive consumer response to the mark.”¹⁴² Trademark law, then, is designed to allow recovery for the improper use of a mark, in connection with the sale of goods, that is likely to confuse the public.¹⁴³ This focus on use in commerce with a likelihood of misleading the public serves as a “built-in” protection against violations of the First Amendment.¹⁴⁴ The Lanham Act requires that businesses register their marks in order to be protected by the federal statute and gain national protection,¹⁴⁵ and in order to be registered, the mark must be sufficiently distinctive and be used in commerce.¹⁴⁶ All of these tests help to limit the right while protecting the value of commercial marks and promoting the development of consumer goodwill.

The Lanham Act contains a specific cause of action for “false designation of origin” for the use of a word, name, symbol or the like in commerce that is likely to confuse the public as to the source of the

139. Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 59, 61–63 (1996).

140. Michael S. Mireles, Jr., *Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law*, 44 *IND. L. REV.* 427, 439 (2011).

141. Patricia Kimball Fletcher, *Joint Registration of Trademarks and the Economic Value of a Trademark System*, 36 *U. MIAMI L. REV.* 297, 307 (1982). This article provides an excellent background history and explanation of trademark rights beyond the discussions set forth for the purposes of this Note.

142. *Id.*

143. 15 U.S.C. § 1114(1)(a) (2006).

144. Stephanie Dotson Zimdahl, Comment, *A Celebrity Balancing Act: An Analysis of Trademark Protection Under the Lanham Act and the First Amendment Artistic Expression Defense*, 99 *NW. U. L. REV.* 1817, 1829 (2005). The article also discusses some criticisms of the “likelihood of confusion” test’s ability to fully protect free speech in the context of trademarks. *Id.* at 1830.

145. A trademark may still have protection in a limited geographic area in which it has become distinctive through common law if it was used in commerce in that region prior to the registration of a similar mark. *See* *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1395, 1397–98 (3d Cir. 1985).

146. *See infra* Part VII.A.1.

good.¹⁴⁷ Already, many right of publicity cases also include a claim for “false designation of origin” under the Lanham Act.¹⁴⁸ Lanham Act claims allow for recovery of actual or statutory damages and frequently courts grant injunctions to prevent any further infringing use of a confusingly similar mark.¹⁴⁹

Just as trademark evolved into a federal right,¹⁵⁰ the right of publicity is ripe for its journey into the realm of federal intellectual property law. The right of publicity has evolved into less of a privacy concept and more of a property concept¹⁵¹ that is similar to trademark as a kind of intangible property that falls under the umbrella of intellectual property with commercial value. In fact, “[b]oth laws are concerned not with the encouragement of new creation, like other forms of IP rights, but with the protection of names in the context of commercial uses.”¹⁵² The Lanham Act, therefore, provides the most congruent framework for a federal right of publicity.¹⁵³

The modern right of publicity appears to be unconnected to a desire for privacy or to a common law protection of property.¹⁵⁴ Right of publicity

147. 15 U.S.C. § 1125(a).

148. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 918–19, 926 (6th Cir. 2003) (involving a false endorsement claim against a sports artist by the licensing agent of golfer Tiger Woods); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 999, 1007–09 (9th Cir. 2001) (involving Lanham Act claims by surfers against a clothing company for its use of their photograph and names in a catalog); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 966–68 (10th Cir. 1996) (involving Lanham Act claims against parody trading card creator by professional baseball players association); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399–1401 (9th Cir. 1992) (involving a lawsuit by the Wheel of Fortune hostess against Samsung for a commercial the company created).

149. 15 U.S.C. §§ 1116–1117 (relating to injunctive relief and damages for Lanham Act claims).

150. Goodman, *supra* note 4, at 240.

151. Dogan & Lemley, *supra* note 124, at 1172–75.

152. *Id.* at 1190.

153. *Id.* at 1191.

Logically, the right of publicity has more in common with trademark law than with copyright. The right of publicity protects a celebrity's interest in her name and likeness, much as trademark law protects a business's name and other trademarks. Both areas of law give rights-holders some measure of control over the meaning of their identities by permitting them to control the use of associated symbols. The Lanham Act has traditionally accomplished this end by preventing commercial uses of trademarks that are likely to confuse consumers regarding either the source of goods or the affiliation, endorsement, or sponsorship of those goods by the trademark owner. The right of publicity aims to do the same thing for celebrities by preventing the use of a celebrity's name or likeness in advertising or promotion to falsely suggest that she has endorsed the advertised product. Both forms of legal protection promote not only the rights-holder's interests, but also those of the public. Trademark holders and celebrities can prevent the deceptive appropriation of the meaning associated with their goodwill and identity, while consumers can buy products with confidence in the truth of assertions about who makes, sponsors, endorses, and stands behind those goods.

Id. at 1164 (footnotes omitted).

154. See E. Leonard Rubin, *Rights of Publicity and Entertainment Licensing*, COMPUTER &

suits are brought to help celebrities control the use of their identities and to protect commercial gain from that use. This is exactly the focus of trademark law, which enables companies to exploit their brands as they wish to help foster brand loyalty and increase commercial success. Trademark is strongly tied to the valuable essence of one or many people's life work. When Steve Jobs passed away, his image was literally meshed into the Apple icon in memorial of him.¹⁵⁵ His identity was a brand and the brand was his identity. There is something very analogous about these concepts. Brands create emotional appeals so that others will feel compelled, connected, and loyal to them, and celebrities seek to create the same kind of following.

The Lanham Act offers a practical and coherent solution to creating a limited federal right of publicity that is in line with the policy goals discussed above, in order to protect the commercial value of individual identities and to protect consumers from confusion. Some would argue that the right of publicity should be eliminated¹⁵⁶ and melded completely into the existing claims for false designation of origin under the Lanham Act,¹⁵⁷ or federalized separately using the best elements of state rights.¹⁵⁸ However, this paper argues that there is an inherent value to the right's protection of a person's commercial value; the Lanham Act provides established tests that would address the existing concerns about the right of publicity and would efficiently and effectively protect celebrities and consumers.

INTERNET LAW., Apr. 2011, at 9, 9.

155. Christina Ng, *Steve Jobs: Apple Logo Re-Imagined to Pay Tribute*, ABCNEWS.COM (Oct. 6, 2011, 2:48 PM), <http://abcnews.go.com/blogs/technology/steve-jobs-apple-logo-re-imagined-to-pay-tribute>.

156. Goldman, *supra* note 5, at 625–28.

157. “In fact, one legal scholar has said that a Lanham Act false endorsement claim is the federal equivalent of the right of publicity.” *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (citing Bruce P. Keller, *The Right Of Publicity: Past, Present, and Future*, 1207 PLI CORP. LAW AND PRAC. HANDBOOK 159, 170 (2000)).

158. *See, e.g.*, Whaley, *supra* note 27, at 259–60.

VII. PROPOSED FEDERAL RIGHT OF PUBLICITY UNDER THE LANHAM ACT

A. THE TESTS

1. Distinctiveness and Commercial Value: A Two-Prong Test

a. Distinctiveness

In trademark law, a mark is valid only if it has obtained a certain level of distinctiveness.¹⁵⁹ If a mark is or has become generic, that is, it is associated with a type of item as opposed to a brand, it is not protected, for example, “Hot Dog Stand” or “Thermos.”¹⁶⁰ If it is descriptive, for example, “Raisin Bran,” it is only protected if it has taken on a “secondary meaning.”¹⁶¹ If a mark has become associated strongly with a brand, not just with the type of product that it appears to describe, then it may be protected.¹⁶² Words that are considered suggestive or arbitrary, for example “7-Eleven” or “Kodak,” are always protected, because they are only associated with the specific brand and not with a general type of product.¹⁶³ This test prevents businesses from taking ownership of words that are necessary to describe a product. Such a restriction could prevent others from joining the market because they would be unable to readily identify their product.

These tests should be applied to the protected characteristics of a person’s identity. Of course, the application is different when it comes to a person’s appearance, voice, phrase, gesture, name, and so forth, but the trademark test can easily be adapted to fit into this framework. Applying these limitations would prevent the continued expansion of the right of publicity to traits that are not unique, as has been seen in the California line of cases following *White*, and would help reduce the right’s implications on free speech.

159. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790–91 (5th Cir. 1983), *abrogated by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

160. *Id.* at 790.

161. *Id.* at 790–91.

162. *See id.* at 791. The plaintiff “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

163. *Zatarains*, 698 F.2d at 791.

i. Generic

Characteristics that are shared by many people would be considered generic. When taken separately these traits would have no protection. As discussed below, some generic traits may be able to gain protection when grouped with a significant number of other traits that, when viewed together, could be found to be unique. A name like Lindsay would be generic, as would the trait of alcoholism. Millions of people share these traits and they would therefore not be protected. The traits of beauty or brown eyes similarly would not be protected, as was seen in Kim Kardashian's lawsuit.¹⁶⁴

ii. Descriptive Plus Secondary Meaning

Characteristics that may not be shared by many people, but that are not intrinsically linked to the concept of identity, would be placed in this category. This category would enable some of the more quirky individual traits of celebrities to be protected. The court would look to see if a catchphrase, an atypical speaking pattern, or a unique style of dress had become so synonymous with a certain individual that it had developed a "secondary meaning"¹⁶⁵ and would not be commercially linked to any other person. The "primary significance" test for the right of publicity would analyze whether the public would associate the trait primarily with the celebrity or with general human traits.¹⁶⁶ If, for example, Elle always wore the same pink shirt in her videos such that it could be shown that the public associated that style exclusively with her, then she might be able to recover for use of that "look."

iii. Unique

Unique traits would always be protected. This category would replace and combine trademark's suggestive and arbitrary categories. Someone's full name or full likeness would fall in this category since people would not likely share those traits. This category would be designed to protect elements that are so inherently linked to a person's identity that there is an automatic and strong connection between the trait and the individual. To the extent that a full name is common enough that it might fall into the descriptive category, however, the secondary meaning test would provide a solution if the name were still truly commercially synonymous with a

164. See *supra* text accompanying notes 93–94.

165. See *supra* note 161.

166. See *Kellogg*, 305 U.S. at 118 (requiring that the public relate the primary significance of a term with the producer of a product, not the product itself).

specific individual holder of that name. Name and likeness are the traditionally protected features under the right of publicity, so this test maintains the original attributes of the right as first defined.

iv. Unique Combinations and the Sliding Scale

The courts would have to view the complete scope of the elements of the individual's identity used and decide if, when taken together, they created something unique enough to be protected. The sheer volume of weaker elements, when put together, might constitute a protected identity, but in the end it would have to be apparent that the individual is the only person that comes to mind when these traits are viewed together. In trademark and in trade dress, a combination of words or elements may become protectable when viewed as a whole rather than as separate elements.¹⁶⁷

Kim Kardashian would have a difficult time arguing that long brown hair, brown eyes, a curvaceous body, and a beautiful face were unique traits possessed, even in combination, only by her, and that those four elements had somehow developed into an identity that only she possessed. Lindsay Lohan would be hard pressed to argue that a common first name and a common trait of alcoholism were sufficient to show that the commercial was using her identity.

The right of publicity analysis would also include a sliding scale comparable to the idea of "thick" and "thin" copyright. In copyright law, a collection of elements with only the lowest level of creativity may be protected, but the level of creativity is taken into account in the other portions of the copyright analysis.¹⁶⁸ In the right of publicity, the strength of the individualism of the traits would be put on a sliding scale with the commercial value test described below.¹⁶⁹

167. *Clicks Billiards Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001) ("[I]n evaluating functionality as well as the other elements of a trade dress claim, it is crucial that we focus *not* on the individual elements, but rather on the overall visual impression that the combination and arrangement of those elements create."); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) ("Words which could not individually become a trademark may become one when taken together.").

168. *See, e.g., Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (discussing that while a unique organization of unprotected facts in a telephone book may have the requisite level of copyright to obtain some protection, the copyright was a thin one and would be less likely to succeed on a claim for infringement).

169. Langvardt discusses a similar test that legislators should consider after *White*:

The personal and unique attribute limitation would be implemented by means of the following proposed test. To qualify for protection under the right of publicity, the supposed attribute must: (a) be likely to produce exclusive (or near-exclusive) identification of the celebrity in the minds of consumers; (b) stem from the celebrity's individual characteristics or efforts;

The goal of the distinctiveness test is to eliminate the ability to sue for either the creative use of elements or for elements that are not sufficiently valuable to validate relief. The test is the first step in protecting against the expansion of the right into frivolous suits by major celebrities and the chilling of free speech.¹⁷⁰

b. Commercial Value

In trademark law, a mark can only be registered or recognized under common law if it has been used in commerce.¹⁷¹ This test would need to be modified in the context of the right of publicity. A person need not have already exploited or licensed his or her image for it to maintain commercial value.¹⁷² In the context of the right of publicity, the commerce test would not evaluate whether a particular trait had been used in commerce, but instead whether it has apparent commercial value.¹⁷³ This evaluation would be performed in tandem to the distinctiveness analysis. If a trait or combination of traits is sufficiently unique that it creates public interest in it, it likely has commercial value. This Note does not endeavor to create the precise factors that would be balanced to determine commercial value, but they would include the extent of the individual's ability to be identified, previous commercial exploitation, length of time using the unique traits in a public context, and potential marketable uses for the trait. Like common law trademark, an identity could have commercial value in a limited area and thus be protected there, but would not be protected for use of the traits in other geographic areas.¹⁷⁴ For example, the Mayor of South Bend, Indiana may be a valuable endorsement in the local area, but the Mayor's voice may lack commercial value in another market and thus will become unprotected in that market.

(c) not be a trait, quality, or talent commonly shared by large numbers of persons; and (d) not depend, for purposes of whether the public associates it with the celebrity, upon a particular copyrighted work or other property owned by another party.

Langvardt, *supra* note 6, at 441.

170. Cf. Franke, *supra* note 11, 945–46 (discussing the need to find a coherent First Amendment test for the right of publicity).

171. 15 U.S.C. § 1051(a) (2006). A trademark holder may also file an “intention to use” application, but the holder must still show actual commercial use within six months of the application. 15 U.S.C. § 1051(b).

172. Although some state statutes do require this, this author sees no need for that requirement as it could overly limit the right and force celebrities to license their identity against their will or desires.

173. There has been discussion of noncelebrities' right of publicity, although most cases are brought by celebrities. This issue is resolved by the “commercial value” test described because it limits suits to individuals and traits that have an actual commercial value and are recognizable. For more information about the idea of limiting the noncelebrity right of publicity, however, see generally 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 (2001).

174. *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1395, 1397 (3d Cir. 1985).

This analysis will be most important in two types of borderline cases. If a trait or combination of traits requires secondary meaning, then the burden would be on the plaintiff to show that those traits have established a clear association with a certain individual in a certain area and could be used to create revenue. The test would also serve to exclude some otherwise protectable unique elements. The burden in that situation would be to show that an individual name or likeness was sufficiently present in commerce and that it had an inherent commercial value. For example, although the name of a first grade teacher, Joey Sunshine, may generally be considered a unique trait, it may not be protected if it is found that the name could not be used to produce revenue and that the name was not of commercial value to Joey. Generic elements would not even make it to the commercial value phase of the analysis.

2. Infringing Material Used in Commerce

In order for a suit to be brought under trademark law, the allegedly infringing mark must be used in commerce.¹⁷⁵ Likewise, under the new right of publicity, a suit could be brought only against a protected trait used in commerce.

3. Likelihood of Confusion

The final essential element of trademark law is that infringement exists only when there is a likelihood of confusion among consumers. The factors set forth in *AMF Inc. v. Sleekcraft Boats* remain controlling: the strength of the mark, the proximity of the goods, the similarity of the marks, evidence of actual confusion, marketing channels used, type of goods, intent, and likelihood of expansion into the same market.¹⁷⁶ The factors are weighed on a case-by-case basis to determine infringement.¹⁷⁷

This test can be applied to the right of publicity to help avoid its expansion into the realm of free speech. Some states have actually adopted a confusion test as the First Amendment test.¹⁷⁸ Here the analysis would

175. 15 U.S.C. § 1127 (2006). *See also* *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 124, 127–31 (2d Cir. 2009) (discussing the use-in-commerce requirement in the context of the Google search engine).

176. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

177. *Id.* at 349–54.

178. “[T]he *Rogers Lanham Act* test is a two-prong test that asks: (1) whether the challenged work has relevance to the underlying work; and (2) if the challenged work is relevant, whether the title misleads the public as to the source of content of the work.” *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 793 (D.N.J. 2011) (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

have to vary from the trademark factors, however. The essential point is whether the commercial value established in the test described above is being exploited. If a consumer would believe that the traits depicted would have been licensed by the individual to whom they are uniquely connected, then there would be a showing of confusion. Again, this paper does not seek to set forth the precise factors to test for the likelihood of confusion in the context of the right of publicity, but factors would include the extent of similarity, strength of the uniqueness of the claimed traits, evidence of actual confusion, evidence of the use of the claimed traits in similar commercial settings, and likelihood of expansion into that market.

This test would serve to protect the right of publicity from reaching into the realm of protected free speech, either commercial or expressive. Theorists have realized that this kind of test would be useful in carving out a “parody” type exception, as exists in copyright, for the right of publicity.¹⁷⁹ There is value in using popular icons to make creative works, either to comment on society, create humor, or create beauty. This test would also encompass the traditional “newsworthy” exception from the right of publicity,¹⁸⁰ since a consumer would not assume that a report about a celebrity or the factual circumstances of his life would be sponsored by that celebrity. The confusion test is not a panacea for the problems of the intersection between free speech and the right of publicity. However, when used in conjunction with the other tests there is a stronger basis for limiting the right, and having a consistent test would eliminate the problems that arise when free speech can be denied and allowed in the same instance as was seen in the *Electronic Arts* cases. Further, the test requires the burden of showing confusion to be put on the plaintiff rather than requiring the defendant to prove the elements of a First Amendment defense. Critics of connecting the right of publicity to trademark contend that trademark requires “potential deception” and so does not cover the right of publicity,¹⁸¹ but this is exactly where the right should be limited.

VIII. CONCLUSION

The right of publicity has developed and expanded dangerously to create inconsistent outcomes in different states, allow recovery for frivolous suits by already dominant celebrities, and tread on the heels of the

179. A likelihood of confusion test “would probably have the practical effect of granting a parody exception to the right of publicity.” Rodrigues, *supra* note 5, at 1217–18.

180. See, e.g., *Toffoloni v. LFP Publ’g Group, LLC.*, 572 F.3d 1201, 1208 (11th Cir. 2009) (discussing the newsworthiness exception to Georgia’s right of publicity law).

181. Thakker, *supra* note 49, at 117.

First Amendment. Based on its roots and its evolution in the digital age, the right of publicity should focus on promoting the protection of the commercial value of a celebrity's actual identifiable traits and protecting consumers from improper endorsements. In the age of modern technology, more and more celebrities exist through increased media exposure and the growing number of media platforms. These celebrities also have more opportunities to exploit their right of publicity, and this exploitation is occurring almost exclusively through nationally distributed works. This new digital age brings focus to the problems associated with the current right of publicity. The right creates due process concerns, enables forum shopping, risks infringing First Amendment rights, allows windfalls for wealthy celebrities, and has become expansive enough to enable suits for general traits.

The right of publicity evolved out of privacy and property rights, but it has become a unique hybrid right that relates closely to the theories behind intellectual property rights. Trademark's hallmark tests offer a clear framework for creating a right of publicity that protects reasonable traits and does not infringe on free speech. By placing the right of publicity into the Lanham Act, but maintaining its identity as a distinct protection, the right of publicity will be able to continue to evolve in a controlled manner. Requiring a distinctiveness test including secondary meaning and a showing of commercial value, and implementing the consumer confusion test to further protect free speech and allow for creativity, comment, and parody, will enable the right of publicity to maintain its integrity and protect the valuable "brands" built by celebrities' unique assets. This scheme will also avoid the many problems it has developed including forum shopping, inconsistent outcomes, and frivolous lawsuits.

A limited, but clear, right of publicity would benefit celebrities who would be able to plan the exploitation of their personae and understand the probable outcomes of a suit. It would also protect consumers from confusion through false endorsement. It would protect producers and enable them to predict whether a use will be considered protected speech. Finally, it would also protect the court system and the general public from a stream of petty lawsuits and the use of forum shopping.

The right of publicity is ripe for change. It is a right that developed out of the use of media and consequently must adapt to the evolution of media and technology. The Lanham Act provides a solid framework to promote appropriate policy goals and enable coherent outcomes. The right of publicity must be refined; it should develop within the bounds of federal intellectual property. For Elle and Kim, their traits as blondes and brown-

eyed girls may have to lose their power, but the rest of us will be glad to see valuable celebrity traits protected properly in a right of publicity that is housed within a stronger and more disciplined legal home.

