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# **WE'RE NOT GONNA TAKE IT!: LIMITING THE RIGHT OF PUBLICITY'S CONCEPT OF GROUP IDENTITY FOR THE GOOD OF INTELLECTUAL PROPERTY, THE MUSIC INDUSTRY, AND THE PEOPLE**

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## I. INTRODUCTION

Who would not want to be a rock star? Offering artistic creativity in exchange for fortune, fame, and adoring fans makes music a gilded career path. Once rock stars have rooted their names, faces, music, and personality in America's pop consciousness, they gain another route to the big bucks: endorsements. The right of publicity is the legal mechanism that allows both individual celebrities *and* musical groups to control the marketable value of their celebrity identity, the currency of their public persona.<sup>1</sup>

Cases addressing the right of publicity of a musical group are exceptionally rare. When compared to the abundance of cases litigating publicity rights in individuals, decisions involving a band's right of publicity represent a microscopic fraction.<sup>2</sup> This Note examines the recognition of publicity rights in musical groups and the unique considerations called for by this recognition. To provide proper perspective, this Note's initial sections trace the origins of the right of publicity and its eventual universal incorporation into American jurisprudence. The Note then addresses the significant jurisdictional variation in both definition and application of the right of publicity.<sup>3</sup> Next, attention turns to a string of landmark right of publicity cases tracking the evolving concept of celebrity persona and the incremental departure from the original identifiers of name and likeness. The cases, when viewed collectively, demonstrate a legal trend in certain jurisdictions toward a more inclusive and unpredictable concept of identity. This Note will then critically examine *White v. Samsung Electronics America, Inc.*<sup>4</sup> and argue that it was a drastic and unsound extension of the right of publicity in employing an ill-defined, potentially expansive conception of marketable identity with the potential to encroach upon other areas of intellectual property. The next section explores the few cases where courts extended the right of publicity to musical groups. This extension beyond a traditional legal boundary has remained relatively unnoticed, but this Note argues that the recognition of a right of publicity in musical groups is a development that warrants attention and critical thinking. Next, this Note will comment on the legal considerations warranted by the expansion of the right of publicity to musical groups, including the potential for the chilling of creativity and depletion of the public domain presented when operating under the broad vision of identity advocated in *White*.<sup>5</sup> To illustrate the

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<sup>1</sup> See *infra* notes 23–25 and accompanying text.

<sup>2</sup> See 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 4:43 (2d ed. 2006) (noting the lack of cases in which courts have recognized a group's right of publicity).

<sup>3</sup> See *infra* notes 42–53 and accompanying text.

<sup>4</sup> 971 F.2d 1395 (9th Cir. 1992).

<sup>5</sup> *Id.* at 1399.

potential, real-world implications of an expansive concept of group identity, this Note will explore the effect of a group right of publicity on a hypothetical up-and-coming rock band, "The Hypos." Finally, this Note proposes that courts narrowly define the concept of a musical group's identity to curtail the right of publicity's threat to other intellectual property doctrines, the music industry and the public domain.

## II. THE BIRTH OF THE RIGHT OF PUBLICITY

The right of publicity is "the inherent right of every human being to control the commercial use of his or her identity."<sup>6</sup> The right of publicity is a relatively modern legal doctrine rooted in the earlier-recognized right of privacy.<sup>7</sup> Privacy law, in enforcing "the right to be let alone,"<sup>8</sup> sought to protect individuals from the indignity and mental trauma that arose when a person's identity was circulated in an unauthorized commercial use.<sup>9</sup> Courts soon began applying the principles of privacy law to protect people from a wider range of intrusions.<sup>10</sup> Eventually, courts utilized the right of privacy as a means to protect private individuals, usually celebrities, from unwanted or unauthorized publicity.<sup>11</sup>

Some courts found the privacy doctrine awkward and unwieldy when dealing with people who actively sought the spotlight.<sup>12</sup> Celebrity plaintiffs did not desire that no one make use of their identity for commerce or promotion. Rather,

<sup>6</sup> 1 MCCARTHY, *supra* note 2, § 1:3.

<sup>7</sup> Steven C. Clay, Note, *Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts*, 79 MINN. L. REV. 485, 487 (1994).

<sup>8</sup> *Olmstead v. United States*, 277 U.S. 438, 478 (1928) (Brandeis, J., dissenting), *quoted in* 1 MCCARTHY, *supra* note 2, § 1:12.

<sup>9</sup> 1 MCCARTHY, *supra* note 2, § 1:7.

<sup>10</sup> Clay, *supra* note 7, at 487.

<sup>11</sup> See *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 78 (Ga. 1905) (recognizing a violation of common law property rights where defendant used plaintiff's photo in an advertisement without permission); *Miller v. Madison Square Garden Corp.*, 28 N.Y.S.2d 811, 813 (Sup. Ct. 1941) (holding defendants' unauthorized publication of the plaintiff's picture in a program for a sporting event to violate plaintiff's statutory right of privacy).

<sup>12</sup> See, e.g., *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 171 (5th Cir. 1941) (holding that famous college football player could not recover under the right of privacy for a beer company's unauthorized use of player's picture in a promotional calendar because he had actively sought fame); *Paramount Pictures, Inc. v. Leader Press, Inc.*, 24 F. Supp. 1004, 1008 (W.D. Okla. 1938) (finding that, while Oklahoma law recognized a right of privacy, the right did not extend to prominent or well-known persons), *rev'd on other grounds*, 106 F.2d 229 (10th Cir. 1939).

Other courts employed different legal doctrines to protect the commercial value of celebrities' identities. See *Chaplin v. Amador*, 269 P. 544, 546 (Cal. Ct. App. 1928) (applying unfair competition doctrine to protect Charlie Chaplin's identity, including his dress, hair, makeup, mannerisms, etc., from unauthorized use in defendant's motion picture).

famous claimants in early right of privacy cases wanted the power to decide when and how their identity was used and to be compensated for the use.<sup>13</sup> Their grievance, then, was grounded more in economics than the emotional interest that traditionally supported the right of privacy.<sup>14</sup> By the middle of the 20th century, there was an obvious need for a new legal theory, distinct from privacy, to protect the commercial value of identity.<sup>15</sup>

The seminal case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>16</sup> is generally understood as the first recognition of an independent right of publicity.<sup>17</sup> In *Haelan*, the Second Circuit artfully sidestepped the confusion of celebrity privacy law and instead focused on the pecuniary worth of the celebrity identity.<sup>18</sup> *Haelan* concerned a contract dispute between a famous baseball player and a chewing gum manufacturer who claimed the exclusive use of the player's photograph in connection with the sale of gum.<sup>19</sup> The defendant, a competitor in chewing gum sales, induced the baseball player to breach his contract by obtaining permission to use his photograph for the promotion of their own gum.<sup>20</sup> When the plaintiff sued, the defendant claimed that using the photo violated only the ballplayer's right of privacy.<sup>21</sup> According to this theory, the plaintiff could not sue the defendant to enforce a right unique to the player that cannot be assigned.<sup>22</sup> The *Haelan* court rejected this argument, holding that:

[I]n addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . . Whether it be [sic] labelled a "property" right is immaterial; for here, as often elsewhere, the tag

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<sup>13</sup> 1 MCCARTHY, *supra* note 2, § 1:7.

<sup>14</sup> *Id.*

<sup>15</sup> See Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 791 (1990); see also Melvin Nimmer, *The Right to Publicity*, 19 LAW & CONTEMP. PROBS. 203, 213-14 (1954) (recognizing the clumsiness of applying privacy, unfair competition, contract, and defamation theories to celebrity publicity claims).

<sup>16</sup> 202 F.2d 866 (2d Cir. 1953).

<sup>17</sup> See J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture - The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM. J.L. & ARTS 129, 131 (1995) (stating that the right of publicity was created in 1953 by Judge Jerome Frank in the *Haelan* case); Pesce, *supra* note 15, at 790-91 ("The right of publicity made its debut in the landmark case of *Haelan Laboratories v. Topps Chewing Gum*.").

<sup>18</sup> *Haelan*, 202 F.2d at 867.

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

property simply symbolizes the fact that courts enforce a claim which has pecuniary worth.<sup>23</sup>

The court emphasized that the legal interest to be protected by the "right of publicity" was a proprietary one distanced from any emotional interest: "[I]t is common knowledge that many prominent persons . . . far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."<sup>24</sup>

In the immediate fallout of *Haelan*, courts were hesitant to embrace or apply a new, untested property right.<sup>25</sup> This hesitancy sprung in part from judicial conservatism, but it also arose from plaintiffs' attorneys' difficulties in arguing for the enforcement of an infant right they could scarcely define.<sup>26</sup> Despite courts' cautious approach to the right of publicity, legal scholars engaged in lively debate over both the merits and theoretical underpinnings of the right.<sup>27</sup> While these academic disputes produced little practical effect in courtrooms, they both ensured that the right of publicity would not stagnate after *Haelan* and clarified the most contentious issues concerning the right.

The right of publicity finally gained widespread recognition in the Supreme Court's only right of publicity case, *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>28</sup> The plaintiff in *Zacchini* was a daredevil whose "human cannonball" act consisted of being shot from a cannon and propelled over 200 feet into a safety net.<sup>29</sup> The defendant, a television broadcasting station, videotaped and then aired the plaintiff's entire fifteen second act on the news.<sup>30</sup> The plaintiff filed suit in Ohio state court, claiming that the defendant had appropriated his "professional

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<sup>23</sup> *Id.* at 868.

<sup>24</sup> *Id.*

<sup>25</sup> 1 MCCARTHY, *supra* note 2, § 1:29.

<sup>26</sup> *Id.*

<sup>27</sup> Compare William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 392-93 (1960) (proposing the recognition of a tort for unauthorized appropriation of identity for advertising or trade purposes, and stating that this right was based in property rather than human dignity), and Harry Kalven, Jr., *Privacy in Tort Law: Were Warren and Brandeis Wrong?*, 31 L. & CONTEMP. PROBS. 326, 331 n.36 (1966) (advocating a tort for the unauthorized appropriation of identity supported by a commercial rationale separate from privacy), with Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 989-90 (1964) (accepting a right to prevent the exploitation of the commercial value of identity, but stressing that the right is rooted in the protection of human dignity rather than in any proprietary interest).

<sup>28</sup> 433 U.S. 562 (1977).

<sup>29</sup> *Id.* at 562.

<sup>30</sup> *Id.* at 564.

property" without first gaining authorization.<sup>31</sup> The Ohio courts held that while the defendant's actions constituted infringement of the right of publicity, the defendant had a First Amendment privilege as a news report on a matter of public interest.<sup>32</sup> The Supreme Court reversed the Ohio decision, holding that First Amendment free speech concerns did not permit the defendant to broadcast the plaintiff's entire performance and thereby negatively impact the economic value of the performance.<sup>33</sup>

Commentators have suggested that the holding in *Zacchini* is extremely narrow and thus rarely controlling in right of publicity cases.<sup>34</sup> The claim in *Zacchini* differed from the more frequent right of publicity claims in that it "did not involve the classic type of use of identity in commercial advertising, it involved the reproduction of a performance."<sup>35</sup> In addition, the "harm threatened in most right of publicity cases is not to the celebrity's ability to earn a living or the market for her primary talents, but rather to her ability to exploit the value of what has resulted from her fame."<sup>36</sup>

Despite the fact that the *Zacchini* holding hinged on uncommon and narrow facts, Justice White's majority opinion brought legitimacy and clarity to publicity rights.<sup>37</sup> The Court, in using the term "right of publicity" frequently and precisely throughout the opinion, presented the right of publicity as an established legal principle and not a jurisprudential fad.<sup>38</sup> The *Zacchini* opinion also functioned to illuminate the murky foundations and rationale behind the right. The Court distanced the right of publicity from the right of privacy in noting that the former "focus[es] on the right of the individual to reap the reward of his endeavors and [has] little to do with protecting feelings or reputation."<sup>39</sup> The Court also expressed concerns over unjust enrichment in observing that "[N]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."<sup>40</sup> The *Zacchini* Court asserted that the policy behind publicity rights mirrored the rationale of patent and copyright law, noting that "encourag[ing] . . . individual

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<sup>31</sup> *Id.*

<sup>32</sup> *Id.* at 565.

<sup>33</sup> *Id.* at 574-75.

<sup>34</sup> See 1 MCCARTHY, *supra* note 2, § 1:33 (stating that *Zacchini* presented a "narrow set of facts"); Fred M. Weiler, *The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity*, 13 CARDOZO ARTS & ENT. L.J. 223, 233 (1994) (positing that "performance value" cases make up only 2% of right of publicity cases).

<sup>35</sup> 1 MCCARTHY, *supra* note 2, § 1:33.

<sup>36</sup> Weiler, *supra* note 34, at 234.

<sup>37</sup> *Id.*

<sup>38</sup> 1 MCCARTHY, *supra* note 2, § 1:33.

<sup>39</sup> *Zacchini*, 433 U.S. at 573.

<sup>40</sup> *Id.* at 576 (quoting Kalven, *supra* note 27, at 331).

effort by personal gain is the best way to advance public welfare through the talents of authors and inventors.' ”<sup>41</sup> *Zacchini*, then, served to legitimize the doctrine of publicity rights and to focus attention on the primarily economic nature of and policy underlying right of publicity claims.

### III. THE LACK OF UNIFORMITY IN RIGHT OF PUBLICITY LAW

The unpredictable and often contradictory case law of publicity rights disputes suggests that defining a right of publicity and discerning when that right has been infringed is a trying task. Some of this contradiction can be attributed to the lack of jurisdictional uniformity regarding publicity rights.<sup>42</sup> No federal statute exists to protect the right of publicity.<sup>43</sup> This means that those seeking to enforce a right of publicity must operate under state common law or state statutory law.<sup>44</sup>

As of 2005, the courts of eighteen states have explicitly recognized the right of publicity as existing under the common law.<sup>45</sup> Of those eighteen states, seven also have statutory provisions that could be read to protect the commercial value of identity.<sup>46</sup> Ten states have statutes that, though termed “privacy statutes,” are worded in such a way as to provide protection for publicity rights.<sup>47</sup> Added up, then, twenty-eight states currently recognize a right of publicity.<sup>48</sup> This does not mean, however, that publicity rights receive uniform protection across those twenty-eight jurisdictions. States differ in the degree of protection afforded to publicity rights.<sup>49</sup> Those states known for entertainment industries (and the celebrities working in those industries) such as California, New York, and Tennessee are inclined to offer more protection for publicity rights.<sup>50</sup>

Despite the substantial variation between state common and statutory publicity rights law, there are three elements that are universally necessary for a successful claim. The plaintiff “must possess a commercially valuable interest in his or her name, likeness, or some other recognizable personal attribute.”<sup>51</sup> Additionally, the defendant “must have made an unauthorized, commercial use

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<sup>41</sup> *Id.* (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

<sup>42</sup> Krissi Geary, Comment, *Tribute Bands: Flattering Imitators or Flagrant Infringers*, 29 S. ILL. U. L.J. 481, 489 (2005).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> 1 MCCARTHY, *supra* note 2, § 6:3.

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> *Id.*

<sup>49</sup> Geary, *supra* note 42, at 489.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 490.



of this interest.”<sup>52</sup> Finally, “this unauthorized use must cause some kind of damage and not be either privileged or incidental.”<sup>53</sup>

#### IV. EXPANDING THE CONCEPT OF IDENTITY TO INCLUDE IDENTIFYING INDICIA BEYOND NAME AND LIKENESS

Since the first recognition of publicity rights in *Haelan*, courts have had difficulty determining “the extent to which a use must evoke or appropriate a celebrity’s identity before violating his or her right of publicity.”<sup>54</sup> The case of *Motschenbacher v. R.J. Reynolds Tobacco Co.*<sup>55</sup> provides an early example of the shift toward a broader understanding of what constitutes a celebrity’s “identity.” In that case, the plaintiff, a famous race car driver, claimed the misappropriation of his “name, likeness, personality and endorsement in [a] nationally televised advertisement for Winston cigarettes.”<sup>56</sup> The plaintiff sought injunctive relief and damages for the defendant’s violation of his California common law right of publicity.<sup>57</sup> The District Court granted summary judgment because the driver in the ad was “unrecognizable and unidentified,” and because “a reasonable inference could not be drawn that he is, or could reasonably be understood to be [the] plaintiff.”<sup>58</sup>

*Motschenbacher* differed from the usual right of publicity claims in that the plaintiff did not claim the misappropriation of his physical image. Rather, he alleged that although the driver in the ad was not himself recognizable, the race car, which embodied the individualized features of the plaintiff’s car, could reasonably lead people to think that the driver standing by the car was the plaintiff.<sup>59</sup> The Ninth Circuit found this argument persuasive, holding that the distinctive markings on the race car “present[ed] a method of identification sufficient to infer that the person driving the car was the plaintiff.”<sup>60</sup> *Motschenbacher* was a groundbreaking decision because it recognized that identity,

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<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> Clay, *supra* note 7, at 494.

<sup>55</sup> 498 F.2d 821 (9th Cir. 1974).

<sup>56</sup> *Id.* at 822.

<sup>57</sup> *See id.* (“Lothar Motschenbacher appeals . . . in his suit seeking injunctive relief and damages for the alleged misappropriation of his name, likeness, personality, and endorsement . . .”).

<sup>58</sup> *Id.* at 822.

<sup>59</sup> *Id.* at 827.

<sup>60</sup> Lisa M. Gigliotti, *Beyond Name and Likeness: Should California’s Expansion of the Right of Publicity Protect Non-Human Identity?*, 83 TRADEMARK REP. 64, 72 (1993); *see also* Pesce, *supra* note 15, at 800 (noting that the *Motschenbacher* court found that the car’s peculiar markings sufficiently identified the plaintiff).

for the purpose of commercial exploitation, includes additional indicators of identity (here, a physical object) beyond mere name and likeness.<sup>61</sup>

The New York Court of Appeals fostered an even more expansive definition of identity in the case of *Lombardo v. Doyle, Dane & Bernbach, Inc.*<sup>62</sup> The plaintiff, Gary Lombardo, was a band leader who had developed the famous personality of "Mr. New Year's Eve" by conducting an orchestra at New Year's Eve celebrations.<sup>63</sup> The defendant, an advertising agency, wished to feature the plaintiff in a television commercial in the context for which he was famous: playing "Auld Lang Syne" surrounded by the balloons and party hats associated with bringing in the New Year.<sup>64</sup> When negotiations fell through, the defendant decided to shoot the same commercial but replace the plaintiff with an actor who did not physically resemble the plaintiff but used "the same gestures, musical beat, and choice of music . . . with which plaintiff had been associated in the public's mind for decades."<sup>65</sup> The plaintiff filed suit claiming that his statutory right of publicity had been violated.<sup>66</sup> The *Lombardo* court found that the plaintiff's identity of "Mr. New Year's Eve" "ha[d] some marketable status" and that "the combination of New Year's Eve, balloons, party hats, and 'Auld Lang Syne' in this context might amount to an exploitation of that carefully and painstakingly built public personality."<sup>67</sup>

The concept of a "public persona" in *Lombardo* extends much further than the identity implicated in *Motschenbacher*. The *Motschenbacher* court found actionable appropriation of identity when an advertisement used a physical object whose "markings were . . . peculiar to the plaintiff's cars."<sup>68</sup> The contested ad in *Lombardo*, however, portrayed a scenario and accessories for which the plaintiff was famous, but neither the context of the New Year's Eve party nor the accompanying objects were exclusively associated with "Mr. New Year's Eve." While Lombardo had achieved public prominence as an orchestra leader at New Year's Eve parties, he was not the only leader of such parties, he had no proprietary interest in the traditional song "Auld Lang Syne,"<sup>69</sup> and the physical

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<sup>61</sup> See *Motschenbacher*, 498 F.2d at 826; see also *Int-Elect Eng'g, Inc. v. Clinton Harley Corp.*, No. C-92-20718, 1993 WL 557639, at \*4 (N.D. Cal. June 24, 1993) (denying motion to dismiss on plaintiff's claim that custom-painted motorcycle was motorcycle company's "likeness").

<sup>62</sup> 396 N.Y.S.2d 661 (App. Div. 1977).

<sup>63</sup> *Id.* at 622.

<sup>64</sup> *Id.*

<sup>65</sup> *Id.* at 623.

<sup>66</sup> *Id.* at 621.

<sup>67</sup> *Id.* at 622.

<sup>68</sup> *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

<sup>69</sup> "Auld Lang Syne" was written by Scottish poet Robert Burns in 1788. *Robert Burns—Biography*, [http://en.wikipedia.org/wiki/Robert\\_Burns](http://en.wikipedia.org/wiki/Robert_Burns) (last visited Sept. 27, 2006).

objects used in the commercial were commonplace at New Year's Eve parties. *Lombardo*, then, signified a major step in the evolution of identity within the right of publicity.<sup>70</sup> *Motschenbacher* expanded the definition of identity beyond name and likeness to include physical object identifiers unique to the plaintiff. The *Lombardo* court's concept of "public personality" stretched publicity rights even further in finding that certain contexts, associated with but not unique to the plaintiff, were sufficient indicators of identity.<sup>71</sup> By recognizing the plaintiff's actionable publicity rights in this instance, the *Lombardo* court "essentially gave Lombardo a monopoly on the commercial use of the traditional New Year's Eve party."<sup>72</sup>

In addition to embracing a wider definition of celebrity identity, the *Lombardo* court cited an additional rationale behind the protection of publicity rights. Where *Haelan* and *Motschenbacher* focused on a celebrity's ability to control the commercial value of his identity, *Lombardo* emphasized the consumer's interests.<sup>73</sup> Without elaborating on exactly why the defendant's use was "completely unfair," the fact that the advertisement "amount[ed] to a deception of the public" led the *Lombardo* court to find the actionable violation of the right of publicity.<sup>74</sup>

Fast on the heels of the decisions in *Motschenbacher* and *Lombardo*, courts continued to draw more elements under the scope of publicity rights' concept of identity. In *Carson v. Here's Johnny Portable Toilets, Inc.*, the Sixth Circuit held that a catch phrase may become so inextricably linked to a celebrity as to constitute a part of his identity under the right of publicity.<sup>75</sup> In that case, the plaintiff, famous late-night television magnate Johnny Carson, objected to the defendant's use of the phrase "Here's Johnny" on its portable toilets.<sup>76</sup> Johnny Carson had

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<sup>70</sup> Christopher Man, *The Scope of Intellectual Property's Protection of Stylistic Rights*, 47 WASH. U. J. URB. & CONTEMP. L. 213, 235 (1995).

<sup>71</sup> *Lombardo*, 396 N.Y.S.2d at 622; see also *Onassis v. Christian Dior-N.Y., Inc.*, 472 N.Y.S.2d 254, 257, 262-63 (Sup. Ct. 1984) (finding plaintiff's right of publicity infringed by defendant's advertisement placing a look-alike of former First Lady Jacqueline Onassis in a context for which she was publicly known—a "legendary private affair").

<sup>72</sup> See Man, *supra* note 70, at 235; see also Weiler, *supra* note 34, at 240 (noting that the commercial did not use Lombardo's name or a look-alike but instead "created a certain context with visual and auditory cues . . . that cumulatively suggested Lombardo" and questioning whether the expansion of public personality in *Lombardo* might be so drastic as to extend to the plaintiff a proprietary interest in several aspects of a traditional New Year's Eve party). But see 1 MCCARTHY, *supra* note 2, § 4.13 (asserting that Lombardo's "manner of conducting and the style of his orchestra playing 'Auld Lang Syne' [were] quite distinctive").

<sup>73</sup> See Weiler, *supra* note 34, at 239 (suggesting that *Lombardo* introduced a new justification for the right of publicity based on "the prevention of consumer deception by advertisers"); see also *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (invoking the public's right to be free from deception in advertising as rationale behind actionable right of publicity claim).

<sup>74</sup> *Lombardo*, 396 N.Y.S.2d at 665.

<sup>75</sup> *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833, 837 (6th Cir. 1983).

<sup>76</sup> *Id.* at 833.

been introduced by that phrase at the beginning of every episode of his enormously successful television show.<sup>77</sup> The Sixth Circuit held that this was an unauthorized appropriation of Carson's identity despite the fact that the phrase did not include Carson's name, the nickname "Johnny" was not distinctive, the context of the use was not one for which the plaintiff was associated, and the plaintiff did not himself use the phrase.<sup>78</sup> The *Carson* court stated that "a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes."<sup>79</sup> This principle, stated so matter-of-factly, signified a major expansion of the right of publicity.

Following *Lombardo*, *Carson* advocates the protection of identifying attributes that are associated *with* but not unique *to* the celebrity. *Carson* outstrips *Lombardo*, however, in acknowledging a decidedly more open-ended and inclusive concept of "identity." The *Carson* court found context and the likelihood of consumer deception immaterial to evaluating what constitutes a violation of publicity rights.<sup>80</sup> The court did not care that there was little chance of the public imputing Carson's endorsement or ownership of the toilets based on the phrase.<sup>81</sup> Rather, the *Carson* court stressed that, so long as the defendant intended to associate its products with any aspect of the celebrity's identity, the right of publicity provided an actionable claim against such a use.<sup>82</sup>

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<sup>77</sup> *Id.* at 832.

<sup>78</sup> *Id.* at 832–37.

<sup>79</sup> *Id.* at 837.

<sup>80</sup> See *Man*, *supra* note 70, at 238 (proposing that, under the analysis employed in *Carson*, "once something becomes associated with a person, the right of publicity will protect it"); see also *Pesce*, *supra* note 15, at 802 (arguing that the expansive reading of identity and form of analysis in *Carson* diverged from the "purposes underlying the right of publicity: providing incentives to performers and creators to innovate, preventing the unjust enrichment of appropriators, and preventing deceptive trade practices").

<sup>81</sup> *Carson*, 698 F.2d at 837.

<sup>82</sup> *Id.* California courts further expanded the concept of celebrity identity to include distinctive voice in *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988). In *Midler*, defendant advertising agency asked to use plaintiff's song in a commercial. *Id.* at 461. When she refused, defendant decided to hire another woman to sing the same song and encouraged her to imitate plaintiff to the best of her ability. *Id.* This woman sounded strikingly similar to Midler. *Id.* at 461–62. The Ninth Circuit recognized identity beyond name and likeness, concluding that human voice is "as distinctive and personal as a face . . . one of the most palpable ways identity is manifested . . . [thus] [t]o impersonate [one's] voice is to pirate her identity." *Id.* at 463. Operating under this understanding of identity, the court held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." *Id.*

# V. THE VANNA WHITE CASE: THE OUTER FRINGE OF THE IDENTITY CONCEPT

It is unlikely that a single right of publicity case has received more attention or criticism than the Ninth Circuit's decision in *White v. Samsung Electronics of America, Inc.*<sup>83</sup> In *White*, Samsung Electronics (Samsung) ran a series of print advertisements, each ad depicting an item of current popular culture and one of their products set in the twenty-first century.<sup>84</sup> One of these portrayed a metallic robot dressed in a blonde wig, a gown, and jewelry, which the defendant advertising agency selected to resemble the hair and dress of Vanna White, hostess of the enormously popular game show "Wheel of Fortune."<sup>85</sup> The ad placed the robot next to a "game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous . . . [and] [T]he caption of the ad read: 'Longest-running game show. 2012 A.D.'"<sup>86</sup> When Samsung ran the ad in multiple national publications, White filed a variety of claims, including the violation of her California common law right of publicity.<sup>87</sup> White's claim reached the Ninth Circuit after the District Court granted summary judgment to the defendants on all claims.<sup>88</sup>

The Ninth Circuit began its analysis of White's right of publicity action by acknowledging that the ad had not used Vanna White's name or likeness.<sup>89</sup> The *White* court noted, however, that "the common law right of publicity is not so confined."<sup>90</sup> The court then briefly discussed *Motschenbacher*, *Carson*, and *Midler* as three cases illustrating that the idea of misappropriated "identity" central to a right of publicity claim covers various indicia of persona beyond simply name or likeness.<sup>91</sup> The court proposed that the common law right of publicity not only "reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity."<sup>92</sup> The *White* court stated that, "the more popular the celebrity, the greater the number of people who recognize her . . . [t]he identities of the most popular celebrities are not only the most

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<sup>83</sup> 971 F.2d 1395 (9th Cir. 1992).

<sup>84</sup> *Id.* at 1396.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 1396-97.

<sup>89</sup> *Id.* at 1397.

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 1398.

<sup>92</sup> *Id.*

attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.”<sup>93</sup>

The majority analysis in *White* stressed the folly of any attempt to set down a fixed list identifying attributes, the appropriation of which would constitute a violation of publicity rights.<sup>94</sup> Rather than focusing on the means by which celebrity identity was appropriated, the court narrowed the pertinent inquiry to *whether* the celebrity's identity has been commercially exploited, regardless of the means.<sup>95</sup> Looking to the cumulative pictorial details of the ad, the court determined that “the individual aspects of the advertisement . . . [v]iewed together leave little doubt about the celebrity the ad is meant to depict.”<sup>96</sup> The Ninth Circuit held that *White* had an actionable claim for the violation of her sole right to exploit her “celebrity identity value,” the right protected by the common law right of publicity. After the Ninth Circuit upheld *White*'s right to sue, the jury awarded her \$403,000.<sup>97</sup> Though *White* provoked a scathing dissent and triggered a deluge of critical legal scholarship, it remains good law. The decision holds appreciable weight because it remains binding precedent over California's federal courts, courts that have traditionally played a leading role in shaping right of publicity litigation.<sup>98</sup>

The *White* court worded the majority opinion to sound like the simple application of mainstream, traditional principles of publicity rights. In reality, the holding represented a groundbreaking expansion of the right of publicity.<sup>99</sup> The reasoning employed in *White* constituted a break from more traditional methods of analysis. Where earlier courts tackled the issue of whether various attributes composed one's “identity,” the Ninth Circuit simplified the analysis such that “if the advertiser uses visual or auditory cues that indirectly evoke a celebrity's

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<sup>93</sup> *Id.* at 1399.

<sup>94</sup> *See id.* at 1398 (“A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with a tenth.”).

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 1399.

<sup>97</sup> David S. Welkowitz, *Catching Smoke, Nailing Jell-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. INTELL. PROP. L. 67, 68 (1995).

<sup>98</sup> *See* Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control*, 45 U. KAN. L. REV. 329, 330–31 (proposing that the *White* decision might have a considerable effect on litigation in jurisdictions in which it is not binding because of the deference that Ninth Circuit decisions are given in cases concerning publicity rights).

<sup>99</sup> *See id.* at 330 (concluding that *White* “handed celebrities a new property right with greatly expanded boundaries”); *see also* Welkowitz, *supra* note 97, at 73 (describing the right of publicity laid down in *White* as “broadly defined” and “a link in a chain of continually more expansive decisions by the Ninth Circuit”).

persona, then the advertiser has infringed that celebrity's right of publicity."<sup>100</sup> Thus, the White court advocated a simplified analysis with the central inquiry being not *how* celebrity identity was misappropriated, but only *whether* it was appropriated. Operating under the narrowed analysis of *White* strips the right of publicity of crucial limiting principles and severs the right from traditional philosophical underpinnings.

The *White* majority understood its holding to follow directly from the earlier right of publicity decisions of *Motschenbacher*, *Carson*, and *Midler*.<sup>101</sup> The court was correct in recognizing those cases as instances where courts' conception of celebrity identity went beyond name or likeness.<sup>102</sup> The *White* court failed to note, however, that the decisions in *Midler* and *Motschenbacher* turned largely on the likelihood that the viewer would believe that the plaintiff was involved in the ad.<sup>103</sup> More importantly, the identifying characteristics presented in those advertisements were the only information evoking the identity of the individual.<sup>104</sup> With nothing to dispel the notion that the plaintiffs were the source of the attributes at issue, the ads in those cases could lead, or perhaps even attempted to lead, consumers to the logical conclusion that the plaintiffs were involved in or had authorized the commercial.<sup>105</sup> The contentious ad in *White* was quite different. There, the ad depicted a metallic robot with "crude features," not a

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<sup>100</sup> Weiler, *supra* note 34, at 257; see also Weikowitz, *supra* note 97, at 75 (stating that, under the Ninth Circuit's analysis, the only requisite for an actionable common law right of publicity claim "was that the advertisement taken as a whole . . . including the fact that the robot was in a Wheel of Fortune set, evoked the image of Vanna White").

<sup>101</sup> See *White*, 971 F.2d at 1398 (citing earlier cases for the proposition that "identity," for the purpose of a right of publicity claim, constitutes attributes beyond name and likeness).

<sup>102</sup> *Id.*

<sup>103</sup> See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (stating that after the commercial was aired, the sound-alike "was told by many personal friends that they thought it was Midler singing the commercial"); *Motshenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1997) (noting that viewers of the commercial concluded that the drivers in the ad was the plaintiff).

<sup>104</sup> *White*, 971 F.2d at 1404 (Alarcon, J., concurring in part, dissenting in part).

<sup>105</sup> See *id.* (noting that in all three cases, *Motschenbacher*, *Carson*, and *Midler*, there was a "common theme . . . that identifying characteristics unique to the plaintiffs were used in a context in which they were the only information as to the identity of the individual . . . which made it appear that the plaintiff was the person identified in the commercial [leading to the conclusion that] [t]he commercials affirmatively represented that the plaintiffs were involved"). But see *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983) (finding consumer confusion an unnecessary element for an actionable right of publicity claim in saying "[i]t is our view that, under the existing authorities, a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes"). Thus, consumer confusion and false endorsement considerations were vital to the reasoning of *Motschenbacher* and *Midler*, but were found unimportant in *Carson*.

human being.<sup>106</sup> Unlike the other cases cited in support of the majority holding in *White*, it was manifest that the ad was not depicting the plaintiff and there was nothing to indicate she had authorized the ad.<sup>107</sup> Thus, the false endorsement and consumer confusion rationales for finding an actionable right of publicity claim present in *Motschenbacher* and *Midler* were lacking in *White*. The *White* court, working with an analysis stressing the irrelevance of *how* the advertiser appropriated identity, neglected to mention this major distinction.

The holding of *White* also departs dramatically from those in *Motschenbacher*, *Carson*, and *Midler* in its understanding of the relationship between identifying characteristics and the plaintiff's "celebrity identity." In the trio of supporting cases cited by the majority, the identifying characteristics were unique to the plaintiff.<sup>108</sup> In *White*, however, the Ninth Circuit found an actionable claim for misappropriated identity through the defendant's depiction of the robot's wig, gown, jewelry, stance, and positioning next to the well-known game board of Wheel of Fortune.<sup>109</sup> The court reasoned that the cumulative effect of several visual cues, when viewed together, amounted to an appropriation of White's identity.<sup>110</sup> None of these identifying characteristics were, however, unique to the plaintiff, as they were in the trio of supporting cases. As Judge Alarcon pointed out in his dissent, "an attractive appearance, a graceful pose, blond hair, an evening gown, and jewelry are attributes shared by many women."<sup>111</sup>

The majority conceded that the game board was the only identifier, in itself, that could remind the viewer of White.<sup>112</sup> The Wheel of Fortune set was not unique to White, nor could it be said to comprise her "identity." The Wheel of Fortune game board may have reminded the viewer of Vanna White, but it could also remind the viewer of the show's longtime host, Pat Sajak, the show itself, or game shows in general.<sup>113</sup> The Ninth Circuit, then, removed a crucial limiting mechanism from an already problematic legal doctrine: the requirement that

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<sup>106</sup> *White*, 971 F.2d at 1406 (Alarcon, J., concurring in part, dissenting in part).

<sup>107</sup> *Id.* at 1404; see also Langvardt, *supra* note 98, at 406–07 (observing that Judge Alarcon, in his partial dissent, distinguished *White* from *Motschenbacher*, *Carson*, and *Midler* in that the use of a robot in *White* made it patently clear that the subject in the challenged ad was not Vanna White herself).

<sup>108</sup> In *Motschenbacher*, 498 F.2d at 822. The identifying characteristics were signature markings on a car unique to the plaintiff alone. *Id.* In *Carson*, 698 F.2d at 832. The identifying characteristic was a phrase only used on the plaintiff's famous television show. 849 F.2d at 463. In *Midler*, the identifying characteristic was the plaintiff's distinctive singing voice.

<sup>109</sup> *White*, 971 F.2d at 1399.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 1405 (Alarcon, J., concurring in part, dissenting in part).

<sup>112</sup> *Id.* at 1399.

<sup>113</sup> See Langvardt, *supra* note 98, at 407 (highlighting the fact that the Wheel of Fortune game board could call to mind several different people and concepts).



aspects of celebrity identity be unique to the celebrity.<sup>114</sup> In the place of this limiting factor, the Ninth Circuit left an ill-defined and open-ended boundary for determining when an advertiser has appropriated a celebrity's identity.

The *White* majority found strength in the rejection of a set "laundry list" of identifying characteristics, the appropriation of which could constitute a violation of publicity rights, positing that pesky and elusive advertisers could always find a new way to filch celebrity identity.<sup>115</sup> By refusing to recognize a set list of identifiers, the *White* court created a very open-ended legal right. The identity-regardless-of-means concept advocated in *White* also reduced predictability with publicity rights.<sup>116</sup> While recognizing a fixed "laundry list" of identity characteristics might seem formalistic and rigid, it would provide advertisers with guidance as to what types of advertisements the law prohibits and give celebrities an idea of how far their legal "identity" extends.<sup>117</sup>

In his persuasive dissent, Judge Alarcon marked another significant expansion from *White*. The majority failed to discriminate between attributes of Vanna White's identity and "attributes of the *role* she plays" as a game show hostess.<sup>118</sup> Alarcon argued that the right of publicity, in protecting the commercial value of celebrity "identity," does not protect against mere reminders of a role or character that the plaintiff celebrity played, attributes that are not unique to the plaintiff.<sup>119</sup> He acknowledged that "anyone seeing the commercial advertisement would be reminded of Vanna White. 'Any performance by another female celebrity as a game-show hostess, however, will also remind the viewer of Vanna White because Vanna White's celebrity is so closely associated with the role.'"<sup>120</sup> According to Judge Alarcon, then, the majority holding in *White* granted celebrities a proprietary interest for the mere association with a particular role. The majority, in failing to

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<sup>114</sup> See *id.* at 417 (characterizing *White* as a "drastic departure from the unifying theme of previous decisions" and noting that "[t]he unique and personal characteristics usually necessary for a protectible identity attribute were nowhere to be found in the facts").

<sup>115</sup> See *White*, 971 F.2d at 1399; see also Welkowitz, *supra* note 97, at 420 (observing that the *White* court's depiction of guarding against specific means of identity appropriation as "impossible" was unique to that court and that other courts, such as that in *Midler*, simply added new identifiers under the umbrella of "identity").

<sup>116</sup> See *White*, 971 F.2d at 1398 ("The right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable.").

<sup>117</sup> See Welkowitz, *supra* note 97, at 75.

<sup>118</sup> *White*, 971 F.2d at 1404 (Alarcon, J., concurring in part, dissenting in part).

<sup>119</sup> See *id.*; see also *Nurmi v. Peterson*, No. CV88-5436-WMB, 1989 WL 407484 (C.D. Cal. Mar. 31, 1989) (holding that use of a character that bears a resemblance to another is not actionable under California's common law right of publicity where the defendant's use of the character "Elvira" used some of the props, clothes, and mannerisms characteristic of the plaintiff's character "Vampira").

<sup>120</sup> *White*, 971 F.2d at 1405 (Alarcon, J., concurring in part, dissenting in part).

mark the distinction between the performer and the role they perform, razed another constraint on the right of publicity.

In a fierce dissent to the denial of a rehearing en banc,<sup>121</sup> Judge Kozinski sounded off on the catastrophic fallout he envisioned from *White*. Kozinski saw *White* not as an expansion of the preexisting right of publicity, but as the creation of an unwarranted new tort imposing liability on advertisers for "simply . . . evok[ing] the celebrity's image in the public's mind."<sup>122</sup> He stressed that the majority's holding obliterated the traditional publicity rights boundaries of "a celebrity's name, voice, signature, or likeness" and false endorsement.<sup>123</sup> Kozinski suggested that, rather than protecting the value of celebrity identity, the majority's decision gave "White an exclusive right not in what she looks like or who she is, but in what she does for a living."<sup>124</sup> The impact, Judge Kozinski opined, would fall upon the public in the form of a depleted public domain and the stifling of the creativity of future generations.<sup>125</sup> Intellectual property law, Kozinski stated, is "full of careful balances between what's set aside for the owner and what's set aside for the rest of us."<sup>126</sup> *White* tilted this balance to favor celebrities by swelling the concept of identity to an unmanageable breadth, granting property rights in roles, and advocating a vague, unwieldy standard for future right of publicity cases.

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<sup>121</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1515 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc).

<sup>122</sup> *Id.* at 1514 (Kozinski, J., dissenting from denial of rehearing en banc).

<sup>123</sup> *Id.* at 1515 (Kozinski, J., dissenting from denial of rehearing en banc); see also Gigliotti, *supra* note 60, at 73–74 (predicting that the right of publicity recognized in *White*, in protecting identifiers of the role *White* played on television, would also grant *White* an action against any new hostess on *Wheel of Fortune*, as she would inevitably remind the public of *White*'s role as letter turner). Applying the standard advanced in *White* could prove more complicated with a different factual background. Vanna White had an unusually persuasive claim that her role on television constituted her identity. Unlike actors in traditional movies and sitcoms, *White* was a one-role celebrity who used her actual name and did not engage in fictional dialogue or plots. This made her television role more difficult to separate from her celebrity "identity." Imagine the case of an actor who has played several characters on several different television shows. Under *White*, it is arguable that the actor would have an actionable right of publicity if an advertisement reminded the viewer of any character that the actor played.

<sup>124</sup> *White*, 989 F.2d at 1515 (Kozinski, J., dissenting from denial of rehearing en banc).

<sup>125</sup> See *id.* at 1515–16 (Kozinski, J., dissenting from denial of rehearing en banc) (forecasting the danger that the *White* decision could present to the public domain).

<sup>126</sup> See *id.* at 1516 (Kozinski, J., dissenting from denial of rehearing en banc) (offering the idea-expression dichotomy and fair use doctrines of copyright as examples of striking the balance between providing incentives for creation and ensuring a rich public domain). Judge Kozinski understood the contentious advertisement to be a comedic parody of both Vanna White and "Wheel of Fortune." *Id.* at 1517. Because parodies are recognized exceptions to the federal copyright act, Judge Kozinski thought *White*'s claim should have been preempted by the federal Copyright Act. *Id.*

*White* is lastly vulnerable for advocating a legal right out of step with the underlying principles originally used to justify publicity rights. The *White* court reasoned that because Vanna had "marketable celebrity identity value," which required the expending of "considerable energy and ingenuity," the law should protect the celebrity's "sole right to exploit this value."<sup>127</sup> This rationale, a hybrid of labor-desert and unjust enrichment theories, appears perfectly reasonable at first glance. After examining exactly *how and why* Samsung evoked Vanna White in their ad, however, it becomes clear that recognizing an actionable right of publicity claim accomplishes the objectives of neither theory. The gist of the labor-desert theory is that the celebrity has "carefully and painstakingly" crafted a public image until it reaches marketable status (i.e., until advertisers want to pay for it).<sup>128</sup> This rationale is incongruous with the facts of *White* because, as previously stated, the Samsung ad reminded the public of White's role on Wheel of Fortune but it *did not appropriate any aspects of her identity*. The only identifying characteristic in itself sufficient to identify White was the game board, but "the Wheel of Fortune props and indicia are not the product of White's own energy, talent, or money."<sup>129</sup> White would obviously lack a claim if she relied solely on the robot dressed in the wig, gown, and jewelry as the appropriation of her identity.<sup>130</sup> Thus, any labor-desert justification for White's actionable right of publicity case is unpersuasive as she lacked any proprietary interest in the essential indicia linking the advertisement to her.<sup>131</sup>

Any effort to support *White* through an unjust enrichment rationale is equally ineffective. The prevailing reason an advertiser uses a celebrity in an ad is to associate the product advertised with the particular image or "star quality" of that celebrity in hopes of framing the product in a favorable light.<sup>132</sup> The right of publicity allows celebrities to exploit this star quality, as property, and control its association with products. Under an unjust enrichment rationale, companies should have to compensate the celebrity to associate their "star quality" with products, as opposed to "free-riding" on the fame that a celebrity has accrued herself.<sup>133</sup> In *White*, Samsung was not seeking to use Vanna White's positive star

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<sup>127</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

<sup>128</sup> *Weiler*, *supra* note 34, at 241 (quoting *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661, 664 (App. Div. 1977)).

<sup>129</sup> *Gigliotti*, *supra* note 60, at 75.

<sup>130</sup> *Id.*

<sup>131</sup> *See id.* (noting that *White* gives celebrities a proprietary interest in external objects, that such an interest could potentially be controlled through licensing, and that this outcome could intrude upon the intellectual property interests of those who own the show Wheel of Fortune and believe they are the sole owners of the game board and all the show's indicia).

<sup>132</sup> *Welkowitz*, *supra* note 97, at 77.

<sup>133</sup> *See Nimmer*, *supra* note 15, at 214 (delineating various rationales underlying the right of

power to sell its products or to create any relationship between the product and plaintiff. In fact, Samsung was not depicting Vanna White the individual but instead depicting a robot playing the role that Vanna White plays on television.<sup>134</sup> This was not an instance of harnessing White's star power to sell a product.<sup>135</sup> Samsung merely used Vanna White's television role as a somewhat comical cultural reference point to accentuate that their products were durable enough to last well into the future.<sup>136</sup> Samsung, then, was not commercially enriched through any appropriation of White's identity. Thus, the right of publicity laid down in *White* outgrew the foundational policy objectives of publicity rights. This suggests that, by discarding any analysis as to *how* the advertiser used identity, the right of publicity laid down in *White* was one bereft of its core policy objectives.

The bottom line is that not all uses of celebrity identity should constitute a wrongful appropriation.<sup>137</sup> There is unquestionable merit in the protection of a celebrity's identity value and in the discouragement of "free-riding" upon this identity by advertisers. To fulfill these goals, however, courts must look to *how* celebrity identity is used, something the *White* analysis cautioned against. Cases applying traditional notions of identity do a better job of guarding against "uses that exploit the core commercial value of the celebrity, the star quality."<sup>138</sup> Without recognizing these critical boundaries, *White* created a broad, unwieldy new right, removed from its original rationale with a potential for plundering the traditional bounty of the public domain.

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publicity, including an "unjust enrichment" rationale).

<sup>134</sup> See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) ("Samsung didn't use [White's] name, voice, or signature, and it certainly didn't use her likeness. The ad just wouldn't have been funny had it depicted White or someone who resembled her—the whole joke was that the game show host(ess) was a robot, not a real person.").

<sup>135</sup> See Welkowitz, *supra* note 97, at 78 (observing that "the purpose [of the ad] was not to associate the qualities of Vanna White with the qualities of Samsung VCRs").

<sup>136</sup> See *id.* at 77–79 (positing that Vanna White's role in the Samsung ad was merely as a symbol of something that could be replaced by a robot in the future and asserting that, although the ad might cast White's role in a negative light in implying that her work could be performed by a machine, celebrities should not have a legal right to control or "spin" the way the public perceives them).

<sup>137</sup> *Id.* at 79.

<sup>138</sup> See Welkowitz, *supra* note 97, at 79–80 (arguing for a right of publicity limited to those advertisements that "seek[] to associate the positive values of [a] celebrity with [a] product").

## VI. THE RECOGNITION OF A RIGHT OF PUBLICITY IN MUSICAL GROUPS

The only cases expanding the right of publicity beyond the individual celebrity recognized publicity rights in musical groups.<sup>139</sup> The first such case, *Winterland Concessions Co. v. Creative Screen Design*, concerned the printing and selling of unauthorized t-shirts in the parking lots and streets surrounding musical concerts.<sup>140</sup> The plaintiff, a concession company and licensee of the publicity rights of such high-profile acts as the Grateful Dead, Fleetwood Mac and Journey, sued the makers and distributors of "bootleg" t-shirts for trademark infringement under Section 43(a) of the Lanham Act and for the violation of the performers' publicity rights.<sup>141</sup> *Winterland*, the plaintiff, proceeded under the theory that the defendants had violated the publicity rights of the performers, both individual and group musical acts, by using their names and likenesses on the t-shirts.<sup>142</sup> The *Winterland* court found the evidence sufficient to support the plaintiff's recovery for both trademark infringement and for the violation of the right of publicity.<sup>143</sup> The court matter-of-factly recognized an actionable right of publicity in a group for the first time but neither acknowledged this unprecedented move nor delineated the rationale behind the extension.

In *Apple Corps Ltd. v. A.D.P.R., Inc.*, the Middle District of Tennessee acknowledged that Tennessee's Personal Rights Protection Act protected The Beatles' right of publicity.<sup>144</sup> In that case, the defendants were a tribute band.<sup>145</sup> Tribute bands are musical groups that perform live shows in which they copy the music, look, stage presence, and persona of an established, widely popular band.<sup>146</sup> In addition to imitating The Beatles to the best of their ability in concerts, the defendants distributed advertising posters for performances depicting the band members in the style and arrangement of a famous Beatles album cover.<sup>147</sup> To the *Apple Corps* court, this constituted a violation of the plaintiff's statutory right of

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<sup>139</sup> 1 MCCARTHY, *supra* note 2, § 4:41.

<sup>140</sup> *Winterland Concessions Co. v. Creative Screen Design, Ltd.*, No. 80 C 5389, 1981 WL 59411 (N.D. Ill. Nov. 6, 1981).

<sup>141</sup> *Id.*

<sup>142</sup> *Id.*

<sup>143</sup> *Id.*

<sup>144</sup> *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 348 (M.D. Tenn. 1993). See Tennessee Personal Rights Protection Act, Tenn. Code Ann. § 47-25-1105(a) (1988 & Supp. 1993) for text of the statute.

<sup>145</sup> *Apple Corps*, 843 F. Supp. at 345.

<sup>146</sup> See Geary, *supra* note 42, at 482-83; see also *Apple Corps*, 843 F. Supp. at 345 ("[The defendant tribute band's] objective [was] to look and sound as much like The Beatles as possible. Toward that end, the group imitate[d] the overall appearances, hairstyles, dress, mannerisms, voices, equipment and musical performances of The Beatles.") (citations omitted).

<sup>147</sup> *Apple Corps*, 843 F. Supp. at 342-48.

publicity.<sup>148</sup> The defendants argued that the Tennessee statute only protected "individuals,"<sup>149</sup> while the plaintiff was a musical group.<sup>150</sup> The court responded that "[c]ertainly, the stage name of a group of individuals is entitled to the same protection as the name of one of the individuals which compose the group."<sup>151</sup> After concluding that a musical group was a protectible individual under the statute, the court found that The Beatles' right of publicity had been violated because the defendants' concert ads, in using The Beatles name, look-a likes, and an arrangement identical to that of a Beatles' album cover, "were using the likenesses of the Beatles to promote their shows."<sup>152</sup> The court enjoined the tribute band from using the name The Beatles, the names John, Paul, George, and Ringo, or picturing the actual Beatles or look-a likes on advertisements.<sup>153</sup>

In *Bi-Rite Enterprises, Inc. v. Button Master*, the Southern District of New York acknowledged a right of publicity in musical groups.<sup>154</sup> The facts of *Bi-Rite* were similar to those of *Winterland*. The plaintiff, the exclusive licensee of various entertainers, sought recovery for the defendants' unauthorized sale of novelty items bearing the names, symbols, and likenesses of individual performers and rock bands represented by the plaintiff.<sup>155</sup> *Bi-Rite* brought a variety of claims including false designation of origin under Section 43(a) of the Lanham Act, trademark dilution, interference with New York's statutory right of privacy, and the violation of the performers' publicity rights.<sup>156</sup> While the court denied the plaintiffs summary judgment on most of their claims, the court granted summary judgment for the violation of the rights of publicity of both the individuals and musical groups and found the plaintiffs entitled to both damages and injunctive relief.<sup>157</sup>

Judge Sofaer justified the recognition of a group right of publicity in saying "the rationale for protecting that interest [the right of publicity] extends to groups

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<sup>148</sup> *Id.* at 349.

<sup>149</sup> Tenn. Code Ann. § 47-25-1105(a).

<sup>150</sup> *Apple Corps*, 843 F. Supp. at 348.

<sup>151</sup> *Id.*

<sup>152</sup> *Id.* at 349; see also *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1361 (D.N.J. 1981) (holding that Elvis Presley's right of publicity had been violated where an impersonator put on a live concert imitating the appearance, dress, and mannerisms of Presley, and the purpose of the performance functioned primarily as a means of commercial exploitation and did not offer any contributing information, personal creativity, or cultural information); *Onassis v. Christian Dior-N.Y., Inc.*, 472 N.Y.S.2d 254, 263 (Sup. Ct. 1984) (finding Jacqueline Onassis' right of publicity violated where a look-alike was used in a magazine advertisement).

<sup>153</sup> *Apple Corps*, 843 F. Supp. at 348-49.

<sup>154</sup> *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983).

<sup>155</sup> *Id.* at 1191.

<sup>156</sup> *Id.* at 1191-92.

<sup>157</sup> *Id.* at 1201.

that have 'persona' sufficiently strong to meet the requirements applied to individuals . . . [as] [t]he theoretical underpinnings of the right of publicity are distinct from the more personal components of the right of privacy."<sup>158</sup> The court concluded that:

Privacy decisions limit actions to individuals, because the right of privacy is intended to protect individual personality and feelings . . . [t]he right of publicity . . . seeks to protect the commercial value acquired by names and likenesses due to investments of time, energy, money, and talent. It protects the persona – the public image that makes people want to identify with the object person, and thereby imbues his name or likeness with commercial value marketable to those that seek such identification. A group that develops market value in its persona should be *as* entitled as an individual to publicity rights in its name. The rationale for protecting the right to publicity [sic] does not justify treating similarly situated plaintiffs differently merely because one is an individual and one is a group member" (emphasis in original) (citations omitted).<sup>159</sup>

#### VII. CONSIDERATIONS UNIQUE TO THE RIGHT OF PUBLICITY TO MUSICAL GROUPS

The few cases in which courts have recognized a right of publicity in musical groups all lacked thorough explanations of exactly why courts should extend a traditionally personal right to a non-human entity. The *Bi-Rite* court offered the most methodical acknowledgement and rationalization.<sup>160</sup> The court justified the expansion from single celebrity to musical group by pointing out that publicity rights are proprietary and not linked to human dignity or emotions.<sup>161</sup> The *Bi-Rite* court reasoned that, because the right of publicity protects the commercial value of persona, and groups, like individuals, invest time and money in developing marketable persona, groups successful enough to achieve a marketable persona should be able to control the exploitation of this persona through publicity rights.<sup>162</sup> This formula, however, neglects to "articulate why the 'rationale' of the

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<sup>158</sup> *Id.* at 1999.

<sup>159</sup> *Id.*

<sup>160</sup> *See id.*

<sup>161</sup> *Id.*

<sup>162</sup> *Id.*

right of publicity justifies this unusual extension over a critical legal boundary which has traditionally formed the limit of both privacy and publicity rights."<sup>163</sup>

Extending the right of publicity beyond the individual to a group raises unique considerations that have yet to be mentioned in group publicity rights cases.<sup>164</sup> First and foremost, musical groups, though consisting of individuals, are distinct entities with legal rights distinguishable from those of the individual members. Non-human entities such as corporations and partnerships must police any purported "persona" through the more stable doctrines of trademark law. Moreover, the concept of celebrity identity, so nebulous after *White*, would be even more unwieldy as applied to a musical group. This difficulty with line-drawing could lead courts' protection to extend beyond marketable persona into style, which is the rightful property of the public domain. While these considerations went wholly unnoticed in those cases where courts allowed bands to assert right of publicity actions, the potential consequences of broad publicity rights in musical groups demands judicious thinking and formation of workable boundaries.

#### A. COURTS SHOULD EXPRESSLY RECOGNIZE THAT MUSICAL GROUPS ARE DIFFERENT FROM INDIVIDUALS

Courts generally conclude that the right of publicity is limited to natural persons.<sup>165</sup> Until the *Winterland* court extended the right of publicity to musical groups,<sup>166</sup> publicity rights actions had only concerned individual human identities.<sup>167</sup> This limitation sprung from the fact that publicity rights evolved from the preexisting right of privacy, a right protecting a person's emotions, dignity, and the right to be left alone.<sup>168</sup> Those decisions expanding publicity rights to include musical groups were less than clear as to whether they were allowing the group entity a historically personal action.<sup>169</sup> The *Bi-Rite*<sup>170</sup> and *Apple Corps*<sup>171</sup> courts justified protecting a group's right of publicity, in part, by depicting

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<sup>163</sup> 1 MCCARTHY, *supra* note 2, § 4:41.

<sup>164</sup> See *id.* (positing that the recognition of publicity rights in groups "involves policy considerations different from those involved in extending the appropriation brand of the right of privacy").

<sup>165</sup> See *Lawrence v. Ylla*, 55 N.Y.S.2d 343, 352 (Sup. Ct. 1945) (refusing to extend statutory right of publicity to plaintiff's dog and concluding that the right of publicity is limited to human beings).

<sup>166</sup> *Winterland Concession Co. v. Creative Screen Design, Ltd.*, No. 80 C 5389, 1981 WL 59411 (N.D. Ill. Nov. 6, 1981).

<sup>167</sup> See 1 MCCARTHY, *supra* note 2, § 4:41.

<sup>168</sup> See *supra* notes 16–24 and accompanying text.

<sup>169</sup> See 1 MCCARTHY, *supra* note 2, § 4:43.

<sup>170</sup> *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1999 (S.D.N.Y. 1983).

<sup>171</sup> *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 348 (M.D. Tenn. 1993).



a musical group as a group of individuals, any of which unquestionably has a right of publicity.<sup>172</sup> Those courts, however, extended the right of publicity not to the individuals in the group, but to collective entity of the *group itself*.<sup>173</sup>

In many ways allowing musical groups a right of publicity seems very natural. Incentive, labor-desert, and unjust enrichment rationales apply to the cultivation of the persona of a musical group as much as they do to an individual artist. Just as an individual performer or actor may spend years toiling in obscurity building value in his or her identity, so too may a musical group. When a musical group develops a public persona, it is producing the same social good and creative expression as an individual who works alone. In protecting the value of the identity of a musical group, the right of publicity provides the same incentive to create in groups as it does in individuals. For example, the members of Nirvana spent several years playing for small crowds and smaller money before becoming the poster children for grunge music and the dissatisfied youth of the early 1990s. After gaining this public persona, a company wishing to harness this group identity to more effectively sell products would be unjustly enriched by employing Nirvana's identity without paying them for it. Although individual celebrities and musical groups are similar in the development of marketable persona and the policies justifying that persona's protection, musical groups differ from individuals in several key ways.

The collective entity of the musical group is conceptually distinctive from the individuals who comprise the group; a rock band is simply greater than the sum of its parts. For instance, the band, The Beatles, is much more than just John, Paul, George and Ringo. While each member had a unique, personal persona, it was the collective entity that became the cultural icon, not the singular contributions of four individuals. It was The Beach Boys that became synonymous with surf rock and not the members of The Beach Boys. In these and numerous other examples, the persona of the collective entity has distinctive value that transcends the identity of its composite members. An individual, on the other hand, is a singular unit.

#### B. THE RECOGNITION OF A RIGHT OF PUBLICITY IN MUSICAL GROUPS: CROSSING A HISTORICAL LEGAL BOUNDARY

There are plenty of groups that are comprised of individuals that cannot, as a group entity, assert a claim for the violation of a right of publicity.

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<sup>172</sup> See 1 MCCARTHY, *supra* note 2, § 4:41 (noting that "[n]o one has ever suggested that an individual's identity is any less protectable merely because he or she is a member of a group" and suggesting that "[p]erhaps [Judge Sofaer] meant to say 'group,' not 'group member'").

<sup>173</sup> See *supra* notes 145–59 and accompanying text.

Corporations, partnerships, organizations and institutions have been uniformly denied any right of publicity.<sup>174</sup> Musical groups, on the other hand, represent the only collective entity presently allowed a right of publicity action.<sup>175</sup> In many ways, however, a band more closely resembles a commercial brand name than an individual. For instance, popular musical groups, like incorporated businesses, use commercial names, service marks and trademarks to denote the origins of their music and merchandise.<sup>176</sup> The famous Aerosmith logo,<sup>177</sup> for instance, implicates the music, merchandise, and identity of the group itself, not some cryptic amalgam of the identities and contributions of Steven Tyler, Joe Perry, Brad Whitford, Tom Hamilton, and Joey Kramer. In *Pump, Inc. v. Collins Management, Inc.*, the commonality between a musical group and a company led the District Court of Massachusetts to deny a rock group's claim under the state's right of publicity statute.<sup>178</sup> The plaintiff, an incorporated musical group, sought damages for the defendant rock band's use of plaintiff group's name, a registered trademark, as an album title.<sup>179</sup> The court found the plaintiff's reliance misplaced, saying "[s]ection 3A is designed to apply to the misappropriation of private names and likenesses, not *commercial names and trademarks* . . . [I]t appears that Pump, Inc. is attempting to force a square peg in a round hole."<sup>180</sup> Thus, where other courts have found the right of publicity applicable to bands, the *Pump* court concluded the opposite, understanding musical groups to be a commercial entity and thus unable to state a claim under publicity rights.

Sufficiently recognizable musical groups can be distinguished from other collective entities in that any of the members, as an individual, would have a right of publicity, whereas the people making up a partnership, organization or corporation would not. Still, courts must acknowledge that, in recognizing a right of publicity in a musical group, they have created a legal exception and crossed the personal boundary traditionally linked to the right of publicity.

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<sup>174</sup> 1 MCCARTHY, *supra* note 2, § 4:41; *see also* Univ. of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp., 256 N.Y.S.2d 301, 305 (App. Div. 1965) (stating that corporations, partnerships, and unincorporated associations do not have a right of publicity).

<sup>175</sup> 1 MCCARTHY, *supra* note 2, § 4:41.

<sup>176</sup> *See* Bi-Rite Enter., Inc. v. Button Master, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983) (protecting the publicity value of the names *and symbols* of musical groups).

<sup>177</sup> *See* Pump, Inc. v. Collins Mgmt., Inc., 746 F. Supp. 1159, 1164 (D. Mass. 1990) (stating that the musical group Aerosmith affixes a logo that is a federally registered trademark to all their recordings and products).

<sup>178</sup> *Id.* at 1172. *See* MASS. GEN. LAWS ch. 214, § 3A (1986) for text of statute.

<sup>179</sup> *Pump*, 746 F. Supp. at 1172.

<sup>180</sup> *Id.* (emphasis added).

## C. THE RIGHT OF PUBLICITY'S THREAT TO TRADEMARK LAW

Corporate symbols, in addition to signifying the origin of products, are associated with the overall spirit or persona of the company. Take, for example, the trademark of Harley Davidson Motorcycles. The familiar orange, black, and white insignia lets the consumer know that certain motorcycles and merchandise are genuine Harleys, but it also brings to mind the bold, rebellious, non-conformist persona the company has so painstakingly cultivated. While commentators have championed the right of publicity as a means of policing "trademark 'personas,'" <sup>181</sup> case law and statutory law have flatly denied publicity rights to corporations and organizations. <sup>182</sup> The holders of commercial marks instead must monitor the use of their symbols and logos through the false designation of origin arm of the federal Lanham Act. <sup>183</sup> Proving trademark infringement under the Lanham Act is generally a more difficult task than proving a violation of the right of publicity. <sup>184</sup> This difficulty arises from the Lanham Act's requirement of a likelihood of consumer confusion. <sup>185</sup> The right of publicity lacks any consumer confusion requirement. <sup>186</sup> After *White*, the test for determining exactly what marketable "identity" is and how much was taken is ill-defined and erratic. <sup>187</sup> While businesses must tackle the Lanham Act's more demanding test, musical groups, acting as collective entities, have been allowed to police their symbols through the right of publicity. <sup>188</sup> This seems at best inconsistent, and at worst, the first step down the slippery slope toward the adoption of right of publicity doctrine in the traditional province of trademark law.

Allowing the right of publicity to encroach upon trademark law is a bad idea. Softening the standards of trademark law to those of the right of publicity would "constitute a major change and dislocation of the law." <sup>189</sup> The logos of musical

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<sup>181</sup> See Nimmer, *supra* note 15, at 216 (proposing a right of publicity in animals, inanimate objects, businesses, and other institutions); Ellen P. Winner, *Right of Identity: Right of Publicity and Protection for a Trademark's "Persona,"* 71 TRADEMARK REP. 193, 196-97 (1981) (noting a similarity between the persona of a human being and the "persona of a trademark" and advocating the use of the right of publicity to protect the "'fad' value" of a business name).

<sup>182</sup> 1 MCCARTHY, *supra* note 2, § 4.43.

<sup>183</sup> Lanham Trademark Act § 43(a), 15 U.S.C. § 1125(a) (2005).

<sup>184</sup> 1 MCCARTHY, *supra* note 2, § 4.43.

<sup>185</sup> 15 U.S.C. § 1125(a).

<sup>186</sup> See *supra* notes 51-53 and accompanying text. While proving a likelihood of consumer confusion is not an element of a right of publicity claim, courts have looked to consumer confusion as to endorsement or authorization in publicity rights cases.

<sup>187</sup> See *supra* notes 112-17 and accompanying text.

<sup>188</sup> See *supra* notes 139-59 and accompanying text.

<sup>189</sup> 1 MCCARTHY, *supra* note 2, § 4.43.

groups perform the same function as corporate trademarks and should be enforced through the same legal machinery. Musical groups could adequately protect the use of their symbols, denoting the collective entity of the group and the group's products, through the false designation of origin doctrine. Forcing bands to control commercial symbols through the more established framework of trademark law would create more predictable, uniform results. Moreover, it would not demand "the whole legal structure of business identity be rebuilt from the ground up."<sup>190</sup>

Applying trademark law would also help to clarify the complicated issue of enforcing a historically personal right in a mark signifying a collective group. This proposition would not wholly eradicate publicity rights in musical groups. It would only require courts to deem the symbols of musical groups distinct from the group's persona. Bands could still prevent the unauthorized commercial appropriation of their more personal identifiers, group name, and likeness (portrait of picture) through the right of publicity.

#### D. THE EVER-CHANGING CONCEPT OF CELEBRITY IDENTITY

Absent a federal right, American jurisdictions enforce publicity rights through a combination of statutory and common law. Jurisdictions often differ in the vigilance with which they protect the commercial value of celebrity.<sup>191</sup> Those states providing the most protection, California in particular, have generally prescribed a more liquid conception of marketable persona. The concept of celebrity identity has swelled to encompass inanimate objects, the human voice, phrases, characters and contexts.<sup>192</sup> If defining persona is difficult with individual celebrities, putting your finger on the persona of a group presents an even more daunting task. Advancing under the framework of *White*, nearly anything that conjures up the persona of a celebrity could constitute a violation of the right of publicity.<sup>193</sup> Musical groups, inherently comprised of more than one person, have the potential for near-endless identifying attributes, any of which could evoke the musical group in the mind of the public.

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<sup>190</sup> *Id.*

<sup>191</sup> See *supra* notes 68–74 and accompanying text.

<sup>192</sup> See *supra* notes 66–177 and accompanying text.

<sup>193</sup> See Weiler, *supra* note 34, at 269 (proposing that after the *White* decision, "the advertiser who reminds viewers of a celebrity within a commercial is strictly liable for publicity infringement"); Gigliotti, *supra* note 60, at 75 (stating that *White* makes it clear that "the appropriation of one's identity need not be accomplished by the duplication of a human attribute or of anything personal, even when not owned by the plaintiff").

## E. WHAT EXACTLY IS THE "PERSONA" OF A MUSICAL GROUP?

The *Motschenbacher* court concluded that the plaintiff's identity had been appropriated by an ad's unauthorized depiction of a racecar suspiciously similar to the plaintiff's.<sup>194</sup> Because the signature design was unique to the plaintiff, the court concluded, the ad could reasonably lead the public to infer the plaintiff's endorsement.<sup>195</sup> Under this reasoning, it follows that a famous musician who customizes and stylizes his or her instrument would have a valid publicity rights claim were an advertisement to picture a nearly identical instrument.<sup>196</sup> Take, for example, Bootsy Collins, funk pioneer, bassist for Funkadelic, and owner of the famous, star-shaped "Space Bass."<sup>197</sup> Under *Motschenbacher*, the "Space Bass," an inanimate object uniquely tied to Collins, would constitute part of his identity. An advertisement picturing a star-shaped bass, even one that was not the "Space Bass," would likely remind the public of both Collins and of his band, Funkadelic. Applying the *White* standard, one could make strong arguments that the advertiser had violated the publicity rights of both Collins and Funkadelic.

No band in history has more carefully crafted their persona than KISS. The band is likely more memorable for their multitude of gimmicks than their music: "Decked in outrageously flamboyant costumes and makeup, the band fashioned a captivating stage show featuring dry ice, smoke bombs, elaborate lighting, blood spitting and fire breathing."<sup>198</sup> The great pains the band took to foster persona resulted in sold-out concerts and a lucrative market for their merchandise.<sup>199</sup> Applying California's expansive common law right of publicity, there are numerous attributes that could potentially embody the persona of KISS. Is their signature makeup part of the group's persona? Do the trappings of their infamously over-the-top stage shows (pyrotechnics, use of blood, lighting, etc.)

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<sup>194</sup> See *supra* notes 59–60 and accompanying text.

<sup>195</sup> *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

<sup>196</sup> There are abundant examples of famous and recognizable customized instruments. For instance, legions of Grateful Dead fans would likely recognize Jerry Garcia's customized, tiger-imprinted Irwin guitar, "Tiger." Jerry Garcia-Biography, [http://en.wikipedia.org/wiki/Jerry\\_Garcia](http://en.wikipedia.org/wiki/Jerry_Garcia) (last visited Oct. 25, 2006). Blues fans could recognize B.B. King's legendary guitar, "Lucille." The list could go on and on. B.B. King-Biography, [http://en.wikipedia.org/wiki/B.B.\\_King](http://en.wikipedia.org/wiki/B.B._King) (last visited Oct. 25, 2006).

<sup>197</sup> Bootsy Collins appeared in a 2005 commercial advertising Cingular's latest cell phone. Darla Mac Blog, [http://darlamack.blogs.com/darlamack/cingular\\_news\\_info\\_tips\\_and\\_tricks/index.html](http://darlamack.blogs.com/darlamack/cingular_news_info_tips_and_tricks/index.html) (last visited Oct. 25, 2006). The ad consisted of several famous singers and musicians cramming into a phone booth. *Id.* Bootsy Collins appeared with his "Space Bass." *Id.* No other performers in the commercial held instruments.

<sup>198</sup> *KISS History*, <http://www.KISShistory.net> (last visited Sept. 8, 2006).

<sup>199</sup> KISS had "two comic books released by Marvel[] . . . pinball machines, makeup and masks, board games, and a live-action TV movie." *Id.*

fall within the band's identity? Would KISS have a valid right of publicity claim if another musical group, say "The Hypos," inspired by KISS's ability to turn gimmicks into dollars, distributed concert ads showing the band in full costume, makeup, and in the act of fire breathing? Gary Lombardo built marketable persona in the context of a New Year's Eve orchestra.<sup>200</sup> Has KISS developed marketable persona in the context of a fire breathing, blood-spitting concert spectacle?

#### F. PREVENTING THE LOOTING OF THE PUBLIC DOMAIN

In the previous Bootsy Collins and KISS hypotheticals, were courts to allow right of publicity claims, both the public and the music industry would suffer. While bundling signature instruments, makeup, costumes and concert features together into the concept of persona would give artists more protection against the misappropriation of their star power, it would come at the cost of chilled creativity and instability within intellectual property law. An advertisement depicting "The Hypos" in face-paint and costumes will almost undoubtedly evoke the persona of KISS in the mind of the public. This does not, however, mean that KISS should be entitled to legal redress. While "The Hypos" are clearly indebted to KISS, all they have taken *is style* and style is *an idea*.

The downside of KISS's larger than life stature is that, at some point, their collective identity became both a rock band and a symbol; a mesh of ideas.<sup>201</sup> KISS has become a cultural symbol; they represent any band propelled more by gimmicks and aggressive marketing than artistic pretensions. Strong policy considerations support preventing musical groups, or any celebrities for that matter, from controlling cultural symbols and style through the right of publicity.<sup>202</sup> These are the same considerations underlying the idea-expression dichotomy in copyright law.<sup>203</sup> The idea-expression dichotomy seeks to balance the interests of the copyright holder, in protecting the work itself, against the

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<sup>200</sup> See *supra* notes 62–74 and accompanying text.

<sup>201</sup> See Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 S.C. L. REV. 783, 804 (1996) (proposing that once a celebrity gains secondary meaning in the eyes of the public "a celebrity may lose control over his or her persona in the same way that a trademark owner can lose control over its property when its mark becomes used generically").

<sup>202</sup> See Nicholas J. Jollymore, *Expiration of the Right of Publicity – When Symbolic Names and Images Pass into the Public Domain*, 84 TRADEMARK REP. 125, 126–27 (1994) (highlighting the role of the public in creating the persona of celebrities and proposing that celebrities be denied right of publicity actions when their names or images take on secondary meaning).

<sup>203</sup> See Man, *supra* note 70, at 244 (stating that the idea-expression dichotomy of copyright law functions to prevent artists control of style).

interest of the public in free-flowing ideas, including those ideas embodied in the work.<sup>204</sup> This critical limiting feature of copyright law would thwart any attempt by KISS to copyright the idea of the face-painted, costumed, flamboyant rock band. There is, however, no idea-expression dichotomy in the right of publicity. The absence of this limiting mechanism makes the right of publicity, particularly when applied to musical groups, a unique threat to the public domain.

#### G. LIMITING WHAT CONSTITUTES A MUSICAL GROUP'S IDENTITY TO PROTECT BANDS OF THE FUTURE

When the concept of identity spreads beyond name and likeness to include various other indicia of persona, it becomes increasingly difficult to determine where identity ends and style begins. Courts must limit what constitutes a musical group's persona under the right of publicity to ensure that style remains in hands of the public. Outlying identifying attributes such as makeup, costumes, musical instruments, and stage antics should be understood to fall outside a musical group's protectable persona and within the group's unprotected style. Drawing the line of identity at a group's name and image (picture or portrait) would allow bands to police the value of their star power without littering the creative landscape for future musical groups.<sup>205</sup> In addition, recognizing this boundary would provide the right of publicity with the balancing features characteristic of other intellectual property doctrines.

This line drawing is especially important when taking into account modern trends in the music industry. Musicians are selling fewer and fewer recordings in the age of Internet downloads.<sup>206</sup> As a result, bands are earning a higher percentage of their overall income through touring and live performances.<sup>207</sup> To draw crowds to their concerts, bands must aggressively advertise through posters, flyers, and entertainment magazines.<sup>208</sup> Musical groups should be able to market themselves assertively without the looming presence of a right of publicity claim. In *Apple Corps*, a Beatles tribute band was held to have appropriated the likeness

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<sup>204</sup> See *Feist Publ'g, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991) (explaining the role of the idea-expression dichotomy in protecting the public domain).

<sup>205</sup> See Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 252 (2002) (arguing that the right of publicity should protect name and likeness but not apply to an abstract concept of persona).

<sup>206</sup> See Peter Spellman, *The Future of Music Careers: Quantum Career Development in an Transforming Industry*, FUTURE OF MUSIC COALITION, Mar. 2003, [http://futureofmusic.org/articles/spellman\\_musicianbiz.cfm](http://futureofmusic.org/articles/spellman_musicianbiz.cfm) ("Of the 35,000 albums released last year by the recording industry, less than 5000 sold more than 1,000 units.").

<sup>207</sup> MusicSuccessOnline.com, <http://www.musicsuccessonline.com> (last visited Sept. 7, 2006).

<sup>208</sup> Spellman, *supra* note 206.

of The Beatles by depicting the core of their act, an uncanny resemblance to the Fab Four, on a promotional poster.<sup>209</sup> While *Apple Corps* was an extreme case, involving a tribute band seeking to look as much like The Beatles as possible, the application of the right of publicity to band promotion is troublesome.

Were a court to work within the framework of *White*, a poster that merely evoked the identity of a well-known band could constitute a violation of that group's publicity rights whether or not the ad intended to appropriate that band's persona. Suppose "The Hypos" market an upcoming concert by promoting the heart of their shtick. They pose fully costumed, faces painted, with bloody mouths in front of a stage adorned with fire. This would remind most people of KISS. However, concluding that the poster sufficiently evoked KISS's collective persona to constitute a violation of its right of publicity would stretch the right beyond reasonable bounds. This result could chill the ability of future bands to market their acts and make profitable touring more difficult. If courts refused to recognize identity beyond name and likeness, however, The Hypos would have undoubtedly appropriated neither, leaving them free to aggressively promote their raucous identity and stage show. This outcome would ensure that musical groups could borrow style and conduct the unfettered promotion necessary to keep afloat in the modern music industry.

#### VIII. CONCLUSION

The development of the right of publicity has been a necessary and fundamental positive. Celebrities should be able to guard the value of their persona, but sketching the outer edges of identity can be a devilish task. The vision of protectible identity championed in *White*, however, unquestionably stretched the right of publicity beyond the scope of reason. While the doomsday scenario painted by Judge Kozinski in *White*<sup>210</sup> has yet to play out, courts need to acknowledge the instability of the right of publicity and its potential to undermine the critical balance sought by intellectual property law. Celebrities and musical groups deserve the right to control how and if the marketable value of their persona is used. Although the maturation of the right of publicity has been a positive legal development, the controversial decision in *White* expanded the publicity rights to a troubling extent.

Cases extending the right of publicity to musical groups have been few and far between. Despite the rarity of this occurrence, stretching a legal right traditionally limited to an individual to a collective group entity should not be taken lightly.

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<sup>209</sup> See *supra* notes 144–53 and accompanying text.

<sup>210</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1515 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc).



Publicity rights in musical groups raise unique, relatively unexplored legal implications on other intellectual property doctrines and the music industry. Courts must recognize that bands, despite their personal dimensions, also bare a resemblance to commercial brand names. Though courts have applied the right of publicity to the symbols of musical groups, this is a myopic practice with the potential to blur the borders of publicity rights and trademark law. To forestall the encroachment of the right of publicity into trademarks, courts addressing the right of publicity of a musical group should limit the notion of group identity to name and likeness. Musical groups would retain the ability to protect the use of their group symbols through the more stable avenues of trademark law.

Defining the contours of celebrity identity is an uncommonly puzzling legal undertaking. While cases involving name and likeness are more manageable, the recognition of celebrity persona in additional indicia, more distanced from the personal roots of publicity rights, is unworkable and dangerous as applied to musical groups. Where previous decisions addressing group publicity rights have taken an *ad hoc* approach to defining group identity, persuasive policy considerations demand limiting actionable claims to the misappropriation of name and likeness. A broad conception of group identity has the potential to drag ideas and style, the property of the public domain, within the right of publicity's protection. Even the most cautious step toward offering musical groups proprietary rights in style could have disturbing effects on the bands of the future. It is time for courts to acknowledge the continued expansion of the right of publicity and, by providing the concept of identity with responsible boundaries, strike a blow for stable intellectual property law, a robust public domain and the health of the music industry.

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