

limit the right of publicity, courts have developed a variety of tests for drawing a line between the property rights encapsulated in the right of publicity and the free speech rights enshrined in the First Amendment.¹⁶² As suspected, these tests are not always consistent.¹⁶³ Moreover, some courts find First Amendment interests outweigh the property rights under the right of publicity without articulating any specific test.¹⁶⁴

In *Comedy III Productions, Inc. v. Saderup, Inc.*,¹⁶⁵ the defendant made a charcoal drawing of the Three Stooges that he sold on t-shirts and as lithographs.¹⁶⁶ Although the drawings were original artistic works created by defendant, they were very lifelike in nature.¹⁶⁷ Therefore, selling them on shirts and as lithographs clearly implicated the right of publicity.¹⁶⁸ Nevertheless, according to the court, the underlying property interest embodied in the right of publicity was inseparable from the defendant's First Amendment right to freely create original artistic works.¹⁶⁹ The California Supreme Court, noting the conflict between the right of publicity and the First Amendment, articulated what was to become known as the transformative use test:

¹⁶² Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 769 (D.N.J. 2011) (describing how courts use several balancing tests to determine if First Amendment free speech rights limit a right of publicity action); see also Franke, *supra* note 141, at 963 (describing how the transformative test and the predominant use test are most commonly used tests); W. Webner & Leigh Lindquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171, 185 (2004) (quoting *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001)) (noting that state's interest in protecting labor of performing artist must be balanced against promoting free expression).

¹⁶³ See CHISUM ET AL., *supra* note 50, § 6G[4][c] at 758 (noting recent case law inconsistent with regard to interaction of First Amendment and right of publicity); see also Hart, 808 F. Supp. 2d at 774 (describing how general consensus does not exist with regard to how to balance First Amendment free speech rights with the property rights protected by right of publicity).

¹⁶⁴ See, e.g., *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823–24 (8th Cir. 2007).

¹⁶⁵ 21 P.3d 797 (Cal. 2001).

¹⁶⁶ *Id.* at 800–01.

¹⁶⁷ *Id.* at 811.

¹⁶⁸ *Id.* at 802.

¹⁶⁹ *Id.* at 802–03.

A California statute grants the right of publicity to specified successors in interest of deceased celebrities, prohibiting any other person from using a celebrity's name, voice, signature, photograph, or likeness for commercial purposes without the consent of such successors. The United States Constitution prohibits the states from abridging, among other fundamental rights, freedom of speech. In the case at bar we resolve a conflict between these two provisions. . . . We formulate . . . what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.¹⁷⁰

The transformative use test¹⁷¹ is borrowed in part from the fair use test utilized in copyright law¹⁷² to determine when the perpetrators of certain infringing actions should be exempted from liability in light of First Amendment concerns.¹⁷³ Application of the test in this case was relatively easy because defendant's drawings were very lifelike renderings of the Three Stooges.¹⁷⁴ The difficult issue for future courts will be to determine how transformative a work must be to outweigh a right of publicity claim because this test is inherently vague and uncertain.¹⁷⁵

¹⁷⁰ *Id.* at 799.

¹⁷¹ See *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 407 (Cal. Ct. App. 2011) (noting that, under the transformative use test, the question is whether the work at issue has been so transformed that it is predominantly defendant's expression rather than merely a celebrity likeness); see also Donna Cunningham, *Political Parody Collides with the Right of Publicity: The Case of the Bobblehead Governor*, 21 *MIDWEST L.J.* 119, 126–27 (2007) (discussing the transformative use test).

¹⁷² 17 U.S.C. § 107 (2006).

¹⁷³ See *Comedy III Prods., Inc.*, 21 P.3d at 807–08 (rejecting wholesale adoption of the fair use test while adopting the first factor of the four-factor fair use test, which requires an analysis of the “the purpose and character of the use” and is codified in the copyright law at 17 U.S.C. § 107(1)).

¹⁷⁴ *Id.* at 811.

¹⁷⁵ See generally Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 *HOUS. L. REV.* 903, 916–25 (2003) (critical discussion of the transformative use test).

In *Doe v. TCI Cablevision*,¹⁷⁶ a professional hockey player named Tony Twist objected to defendant's use of a comic book character sharing his name.¹⁷⁷ The Missouri Supreme Court, noting the conflict between the right of publicity and the First Amendment,¹⁷⁸ indicated that a balancing test should be used to determine which right prevails.¹⁷⁹ The court rejected the transformative use balancing test adopted by the California Supreme Court in *Comedy III Productions, Inc.* in favor of the predominant use test.¹⁸⁰ Under this test, the court sought to determine whether the predominant use of the Mr. Twist's identity in defendant's comic books sought to exploit the commercial value of his identity, triggering a right of publicity action¹⁸¹ or whether the predominant use was as expressive content—such as a parody—which is constitutionally-protected speech that trumps the right of publicity.¹⁸² The court concluded:

[T]he . . . reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.¹⁸³

*ETW Corp. v. Jireh Publishing, Inc.*¹⁸⁴ involved an artist, Rick Rush, who created paintings of famous athletes and sporting events.¹⁸⁵ The defendant was authorized to produce and sell limited edition prints made from Mr. Rush's paintings.¹⁸⁶

¹⁷⁶ 110 S.W.3d 363 (Mo. 2003) (en banc).

¹⁷⁷ *Id.* at 365.

¹⁷⁸ *See id.* at 372 (noting that this conflict has been a difficult issue and that courts have generally struggled with it).

¹⁷⁹ *See id.* at 373–74 (discussing the different balancing tests available).

¹⁸⁰ *See id.* at 374.

¹⁸¹ *Id.*

¹⁸² *Id.* at 375.

¹⁸³ *Id.* at 374.

¹⁸⁴ 332 F.3d 915 (6th Cir. 2003).

¹⁸⁵ *Id.* at 918.

¹⁸⁶ *Id.*

Specifically, these were prints of a painting commemorating the famous golfer Tiger Woods' victory at the Masters Tournament in Augusta, Georgia.¹⁸⁷ In contrast to the drawing in *Comedy III Productions, Inc.*, which only contained a realistic likeness of the Three Stooges,¹⁸⁸ the print included more than a mere likeness of Mr. Woods. It included other individuals and references to the Masters Tournament and the Augusta golf course on which it is played.¹⁸⁹ Overall it portrayed a historic event in the sports world.¹⁹⁰ The court noted the tension between the right of publicity and the First Amendment¹⁹¹ and identified the Restatement (Third) of Unfair Competition¹⁹² as providing the test for balancing these rights.¹⁹³ Under this approach, the First Amendment prevails if a person's identity is primarily used to communicate information or ideas such as for news reporting, biographies, novels, plays, or movies.¹⁹⁴ In contrast, the right of publicity prevails if a person's name or likeness is used solely to attract attention to a work that is unrelated to the person, or if the work at issue contains substantially false information.¹⁹⁵ The court also noted that despite its reliance on the Restatement, the transformative use test utilized in *Comedy III Productions, Inc.* could be helpful, though not controlling.¹⁹⁶ Ultimately, the court concluded that the artist's First Amendment rights outweighed Mr. Woods' right of publicity.¹⁹⁷ This result seems consistent with both the Restatement and the transformative use test since the artist added substantial original work to the painting such that it was significantly transformative.¹⁹⁸ The painting was clearly communicating that Mr. Woods won the Masters Tournament,

¹⁸⁷ *Id.*

¹⁸⁸ *See id.* at 936.

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

¹⁹¹ *Id.* at 931.

¹⁹² *See id.*; RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46–48.

¹⁹³ *ETW Corp.*, 332 F.3d at 931.

¹⁹⁴ *Id.* at 930.

¹⁹⁵ *Id.* at 930–31.

¹⁹⁶ *See id.* at 936.

¹⁹⁷ *Id.* at 938.

¹⁹⁸ *Id.*

which is a historic event in the sports world and thus argues for a broader range of permissible uses of an individual's persona.¹⁹⁹

Additionally, other policy concerns outweigh application of the labor and unjust enrichment theories in intangible property law. Under the common law, a novel idea is generally not legally protectable from unauthorized third party use unless it is a "well-developed" idea.²⁰⁰ This requirement is typically described as the concrete or concreteness requirement.²⁰¹ Under this approach, a purely abstract idea is usually not entitled to property protection regardless of its value or the effort entailed in developing it.²⁰² Some courts have even held that an abstract idea cannot be the subject of a contractual agreement.²⁰³

An identical result is reached under patent law.²⁰⁴ There, an abstract idea is likewise not eligible to be considered for utility patent protection.²⁰⁵ For example, even if a researcher spent years and millions of dollars developing a mathematical formula that describes previously unknown relationships in physics, it would not be eligible for patent protection²⁰⁶—even if the potential economic value of the formula was significant.²⁰⁷ However, a

¹⁹⁹ *Id.*

²⁰⁰ *See Tate v. Scanlan Int'l, Inc.*, 403 N.W.2d 666, 671 (Minn. Ct. App. 1987) (legal protection only extended to ideas that are both novel and well-developed); *see also Sellers v. Am. Broad. Co.*, 668 F.2d 1207, 1210 (11th Cir. 1982) (action for misappropriation of idea only allowed if idea is both novel and concrete).

²⁰¹ *Scanlan Int'l, Inc.*, 403 N.W.2d at 672 (concrete requirement satisfied if idea sufficiently complete so that it can be used without the need for any significant development before it can be implemented).

²⁰² *See Smith v. Recrion Corp.*, 541 P.2d 663, 669 (Nev. 1975) (legal protection only extends to abstract ideas that are both novel and concrete). *See generally Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 460 (6th Cir. 2001) (typically ideas must be both novel and concrete in order to be protected as property).

²⁰³ *See, e.g., Scanlan Int'l, Inc.*, 403 N.W.2d at 671 (idea must be both novel and concrete to be subject of a contract).

²⁰⁴ *See generally Jennings v. Brenner*, 255 F. Supp. 410 (D.D.C. 1966) (a contract cannot consist of an abstract idea).

²⁰⁵ *Id.* at 412.

²⁰⁶ *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) ("Einstein could not patent his celebrated law that $E=mc^2$ nor could Newton have patented the law of gravity.").

²⁰⁷ *See Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U.S. 364, 384 (1942). *See Diamond*, 447 U.S. at 309 ("The laws of nature, physical phenomena, and abstract ideas have been held not patentable."); *In re Fisher*, 421 F.3d 1365, 1371, 1373 (Fed. Cir.

machine that utilizes the formula to complete a specific task would be patent-eligible.²⁰⁸

By contrast, copyright law denies protection to all ideas and information, not just abstract ideas.²⁰⁹ This is reflected in the delineation between ideas, which go unprotected, and copyright law's protection of original means of expressing ideas.²¹⁰ A news organization, for example, may spend substantial money maintaining an overseas news bureau. Based on substantial expenditures, the news organization publishes a series of articles that reveal previously secret information about governmental activities. Anyone is free to use the information disclosed in the articles even though such use potentially amounts to free riding or unjust enrichment.²¹¹ Copyright law does not protect such information.²¹² Only the form of expression of the information in the articles is protected.²¹³ Therefore, a third party could not copy the articles verbatim, but they could extract and use the information in the articles.²¹⁴ A competing news organization may even be able to freely use the information in its original news stories.²¹⁵

2005) (basic scientific discoveries that are only useful for engaging in further research are ineligible for patent protection).

²⁰⁸ See generally *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. 498, 507 (1874) (“An idea of itself is not patentable, but a new device by which it may be made practically useful is.”).

²⁰⁹ 17 U.S.C. § 102(b) (2006); *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1234 (3d Cir. 1986) (ideas not protected by copyright).

²¹⁰ See *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (copyright law protects expression of an idea but not the idea itself); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (copyright only protects form of expression of idea but not idea itself).

²¹¹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

²¹² *Id.*

²¹³ *Id.*

²¹⁴ *Id.*

²¹⁵ See *id.* at 353–54. Although copyright law may be inapplicable in this situation, the Supreme Court did enjoin one news-gathering organization from free riding on the work of a competing news-gathering organization under a common law unfair competition theory generally referred to as a misappropriation action. *Int'l News Serv. v. Associated Press*, 248 U.S. 215 (1918). However, this theory has rarely been successful in subsequent disputes. See Andrew Beckerman-Rodau, *Ideas and the Public Domain: Revisiting INS v. AP in the Internet Age*, 1 N.Y.U. J. INTELL. PROP. & ENT. LAW 1, 15

Trademark law recognizes and protects investments in marketing and branding efforts that infuse a trademark with a substantial mental association.²¹⁶ For example, the law protects the mental association that exists when a consumer sees the word “Coke” or “Toyota” on an appropriate product.²¹⁷ Nevertheless, in the interest of promoting competition, unauthorized use of a trademark is permitted in comparative advertising.²¹⁸ Unauthorized use of a trademark is also permitted for purposes of social commentary,²¹⁹ parody,²²⁰ artistic expression,²²¹ and news reporting²²² consistent with First Amendment rights. Finally, unauthorized third party commercial use of a trademark is generally permissible if such use does not result in a likelihood of confusion among the intended consumer group.²²³

Likewise, trade secrets law does not rely exclusively on a labor or unjust enrichment theory for its justification. Although it allows protection for a broad range of information that provides an economic advantage over competitors,²²⁴ it also allows free riding

(2011) (critical discussion of *International News Service* advocating elimination of the misappropriation action).

²¹⁶ See, e.g., *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987) (trademark law protects property interest in a trademark).

²¹⁷ See, e.g., *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (“A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he had been led to believe he wants . . .”).

²¹⁸ See *SSP Agric. Equip., Inc. v. Orchard-Rite, Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979) (using competitor’s trademark in a comparative advertisement is allowable absent consumer confusion or misrepresentations).

²¹⁹ See *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 44 (2d Cir. 1994).

²²⁰ See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490 (2d Cir. 1989) (finding the use of trademark in parody of Cliffs Notes study guide not actionable under trademark law).

²²¹ See, e.g., *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1281 (11th Cir. 2012) (finding the use of trademarks in original paintings of college football players not actionable under trademark law).

²²² Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT’L L. 405, 413 (2010).

²²³ See *Int’l Jenson, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 827 (9th Cir. 1993). See generally *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003) (noting that trademark law protects consumers from confusion, but if a trademark enters the common vocabulary and becomes a cultural reference it is no longer serving a trademark function and First Amendment rights then trump trademark rights).

²²⁴ See Uniform Trade Secrets Act § 1(4) (1985); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995) (“A trade secret is any information that can be used in

under certain circumstances.²²⁵ For example, a company may spend millions of dollars developing a new product line, but each individual product might sell for only a few hundred dollars. A competitor could buy the product, reverse engineer it and, based on its findings, it could then manufacture and sell a copy of the product.²²⁶ This might allow the competitor to free ride by avoiding the costly research and development work done by the original company that created the product. Such action is legally permissible despite the fact that it ultimately amounts to free riding.²²⁷

The above approaches under the common law, patent law, copyright law, trademark, and trade secrets law may seem unfair from the perspective of a labor and unjust enrichment theory. Without negating the value of these theories, the question then becomes whether there are competing underlying policies that weigh against the labor and unjust enrichment theories. In general, the importance of allowing abstract ideas and information to be part of the public domain traditionally has been viewed as a competing and superseding policy.²²⁸ Sometimes this policy is

the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.”).

²²⁵ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 cmt. a (1995) (“The freedom to compete in the marketplace includes, in the absence of patent, copyright, or trademark protection . . . the freedom to copy the goods, methods, processes, and ideas of others.”).

²²⁶ Reverse engineering is the process of “starting with the known product and working backward to divine the process which aided in its development or manufacture.” *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 476 (1974).

²²⁷ See *id.* (noting that reverse engineering is legally permissible under trade secrets law).

²²⁸ In *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting), Judge Kozinski stated:

[I]t may seem unfair that much of the fruit of a creator’s labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system’s very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means by which intellectual property law advances the progress of science and art. We give authors certain exclusive rights, but in exchange we get a richer public domain.

Id.

found in the critical importance of the First Amendment freedom of speech rights, which must be strongly protected in a democracy.²²⁹ In the commercial context, the desire to promote competition may also provide justification for treating some things as part of the public domain and therefore denying them property protection.²³⁰ Finally, the importance of information to the public generally may sometimes outweigh giving private ownership to intangibles.²³¹ Nevertheless, such concerns should never totally outweigh intangible property rights, which are also critical to the existence of both a democracy and a free enterprise economic system.²³² The issue then becomes how to provide property protection for a person's persona without overreaching and interfering with these competing concerns.

IV. ASSOCIATION-BASED RELATIONSHIPS VS. CONFUSION-BASED RELATIONSHIPS

As previously discussed, right of publicity actions can be viewed on a continuum that includes both confusion-based and association-based relationships. Confusion-based relationships include situations where a person's name or likeness is used in commercial advertising, creating a likelihood that consumers will

²²⁹ See *U.S. v. Carrier*, 672 F.2d 300, 305 (2d Cir. 1982) (free dissemination of ideas is an essential element of democracy). See also *Palko v. Conn.*, 302 U.S. 319, 326–27 (1937) (Cardozo, J.) (noting freedom of thought and speech are indispensable to nearly every other form of freedom).

²³⁰ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 1 cmt. a (1995) (“Freedom to engage in business and to compete for the patronage of prospective customers is a fundamental premise of the free enterprise system.”).

²³¹ See, e.g., *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (mathematical formulas such as $E=mc^2$ or the discovery of a new mineral or plant are not patentable subject matter); see also *Parker v. Flook*, 437 U.S. 584, 585 (1978) (discovery of new and useful mathematical formula not patent-eligible subject matter); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (scientific truth even if expressed as a mathematical formula not patentable); see also *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293(2012) (laws of nature, natural phenomena, mental processes, and abstract ideas not eligible for patent protection). *Accord Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010).

²³² See generally *White*, 989 F.2d at 1517 (Kozinski, J., dissenting) (noting importance of balances built into intellectual property law between what a creator owns and what portion of such creations are free for everyone to use as part of the public domain).

believe the person endorses or approves of the advertised product.²³³ Typically, the use of the name or picture of a celebrity in an advertisement without any type of disclaimer will per se cause consumers to believe the person endorses or approves of the product in the advertisement.²³⁴ Such a result should be actionable. In contrast, mere references that conjure associations with a person do not automatically create a likelihood that consumers will be confused as to whether the person endorses or approves of the product.²³⁵ However, if such likelihood is shown to exist, then a confusion-based action should be permitted.²³⁶

Further along the continuum are association-based relationships where commercial advertising causes consumers to associate the product or the advertisement with a celebrity but such consumers do not believe the celebrity endorsed or approved of the advertised product.²³⁷ For example, in the previously discussed *Carson* case the court concluded that selling portable toilets with the advertising phrase “Here’s Johnny” could cause consumers to make an association with Mr. Carson even though consumers would not think he endorsed or was affiliated with the business in any way.²³⁸ Likewise, David Letterman has made his humorous top ten lists famous.²³⁹ As a result, using a top ten list in advertising could create a mental association with Mr. Letterman.²⁴⁰ For example, LexisNexis produced the following advertising brochure:

²³³ See e.g., *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983).

²³⁴ See *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 627 n.8 (S.D.N.Y. 1985) (“When a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement.”).

²³⁵ See generally *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (noting that the Sixth Circuit has created an eight-factor test to determine the likelihood of confusion).

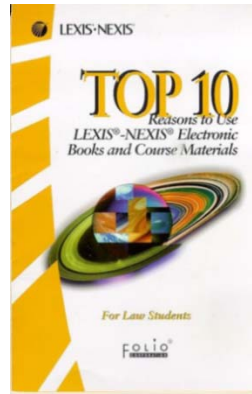
²³⁶ *Id.* at 925–26.

²³⁷ See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149–50 (9th Cir. 2002).

²³⁸ *Carson*, 698 F.2d at 836.

²³⁹ An archive of Mr. Letterman’s Top Ten lists is available at http://www.cbs.com/late_night/late_show/top_ten/ (last visited Oct. 7, 2012).

²⁴⁰ Numerous websites and books dedicated to top ten lists exist. See, e.g., *The Top Tens*, available at <http://www.the-top-tens.com/> (last visited Oct. 7, 2012); *Top Tenz*, available at <http://www.toptenz.net/> (last visited Oct. 12, 2012).



The above advertisement is likely to produce, at most, an association-based relationship with Mr. Letterman rather than a confusion-based relationship. Such a relationship should not be barred by a potential right of publicity action.

The following advertisement for a 2004 Michael Moore film²⁴¹ may have also created an association-based relationship—but not a confusion-based relationship—with Ray Bradbury, author of the famous book *Fahrenheit 451*.²⁴² Nevertheless, this should not be a basis for a right of publicity action by Mr. Bradbury. Likewise, President George W. Bush should not have a right of publicity action merely because his picture was used in an advertisement to commercialize a movie. It is unlikely that consumers will believe President Bush would have endorsed a movie critical of his presidency.

²⁴¹ [HTTP://WWW.FAHRENHEIT911.COM/ABOUT/POSTER/](http://www.fahrenheit911.com/about/poster/) (last visited Oct. 12, 2012). See <http://www.michaelmoore.com/books-films/fahrenheit-911> (last visited Oct. 7, 2012).

²⁴² RAY BRADBURY, *FAHRENHEIT 451* (1953).



Moreover, confusion-based relationships do not need protection via the right of publicity; such relationships are already protected generally by trademark and unfair competition law.²⁴³ Today, the scope of subject matter protectable as a trademark or service mark is very broad.²⁴⁴ For example, it is possible for a celebrity to register his or her name as a trademark and/or service mark under federal trademark law.²⁴⁵ Unfair competition actions

²⁴³ See J. Thomas MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 28.14 (4th ed. 2012) (noting that falsity is not a necessary element of infringement of the right of publicity, where this could easily be proven via trademark infringement).

²⁴⁴ See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (green-gold color of press pads used by dry cleaners can be a trademark); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (pink color of fiberglass insulation recognized as a trademark); Registration No. 2,007, 624 (mark for goats on a roof of grass for restaurant services); Registration No. 3,155,702 (sensory or touch trademark registered for the feel of a velvet-textured covering on a bottle of wine); GOLDSTEIN & REESE, *supra* note 2, at 256–57 (three-dimensional product packages can be protected as trademarks); Douglas D. Churovich, *Scents, Sense or Cents?; Something Stinks in the Lanham Act: Scientific Obstacles to Scent Marks*, 20 ST. LOUIS U. PUB. L. REV. 293, 294–95 (2001) (discussing trademark registration of a scent that was applied to thread and yarn). See generally Gary Myers, *Statutory Interpretation, Property Rights, and Boundaries: The Nature and Limits of Protection in Trademark Dilution, Trade Dress, and Product Configuration Cases*, 23 COLUM.-VLA J.L. & ARTS 241 (2000) (discussing expansion of trademark rights today).

²⁴⁵ See 15 U.S.C. § 1052(e)(4), (f) (2006) (allowing surname to be registered as trademark provided it has acquired distinctiveness); see also Russell Jacobs, *Recapturing Rareness: The Significance of Surname Rareness in Trademark Registration Determinations*, 50 IDEA 395 (2010) (discussing registering names as trademarks). The

are also permitted and have been broadly construed under federal trademark law such that they apply even in the absence of an existing trademark.²⁴⁶ Both trademark infringement actions and unfair competition actions, which are also available under state law, are premised on protecting the consuming public from actual or potential deception.²⁴⁷ As a general rule, the legal standard used in such actions under both federal and state law is whether a substantial number of people in the intended consumer market are likely to be confused with regard to some aspect or characteristic of the product or service being sold.²⁴⁸ This includes creating a likelihood that someone—typically a celebrity—endorses or approves of a product or service when in reality that is untrue.²⁴⁹ Hence, any use of a celebrity’s name or likeness would be actionable as trademark infringement or unfair competition if members of the intended consumer market are likely to incorrectly believe the celebrity endorses or supports the product or services

musicians Beyoncé Knowles and Jay-Z filed trademark application for the name of their daughter, Blue Ivy Carter. Although the trademark application has initially been rejected by the Patent and Trademark Office, it is still pending. See Roxanne Roberts & Amy Argetsinger, *The Reliable Source*, WASHINGTON POST (Feb 3, 2012, 1:39 PM), http://www.washingtonpost.com/blogs/reliable-source/post/blue-ivy-the-trademark-feds-move-fast-on-rights-to-beyonce-and-jay-zs-babys-name/2012/02/03/gIQAOTDGNQ_blog.html.

²⁴⁶ See *Kournikova v. Gen. Media Commc’ns, Inc.*, No. CV 02-3747 GAF, 2002 U.S. Dist. LEXIS 25810, at *17 (C.D. Cal. Aug. 9, 2002) (“A celebrity may bring a false endorsement claim for the unauthorized use of her identity if such use is likely to confuse consumers as to the celebrity’s sponsorship or approval of the product.”). See generally *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (unfair competition action under 15 U.S.C. § 1125(a) is a new federal tort what covers more than trademark infringement and it should be construed broadly to remedy unfair competitive actions).

²⁴⁷ See *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2007).

²⁴⁸ See *Ga. Pac. Consumer Prods., LP v. Von Drehle Corp.*, 618 F.3d 441, 449 (4th Cir. 2010) (“[T]he tests for trademark infringement and unfair competition under the Lanham Act are essentially the same as that for common law unfair competition . . . ; all focus on the likelihood of confusion as to the source of the goods involved.”); see also *Karl Storz Endoscopy-Am., Inc. v. Surgical Techs., Inc.*, 285 F.3d 848, 854 (9th Cir. 2002) (test for trademark infringement is whether consumers will be likely to be confused as to source or origin of relevant product or service); *Storball v. Twentieth Century Fox Film Corp.*, 1993 U.S. Dist. LEXIS 20455, at *4 (C.D. Cal. Nov. 8, 1993) (unfair competition claim based on false endorsement requires showing a likelihood that consumers will be confused “as to the origin, approval, or endorsement of the product”).

²⁴⁹ See generally MCCARTHY, *supra* note 243, § 28.15.

his name or likeness is associated with.²⁵⁰ This same standard should apply even if the name or likeness of the celebrity is not used, such as in the *Carson* case.²⁵¹ The ultimate controlling issue should be whether consumers are likely to be confused.

Therefore, neither trademark infringement nor unfair competition law would render the use of a person's name or likeness actionable in the absence of any likelihood of consumer confusion.²⁵² Typically, the line is drawn to support a robust public domain, to engender free competition, and to accommodate First Amendment free speech considerations.²⁵³ This means a certain amount of free riding must be tolerated without the ability to bring legal action barring it.²⁵⁴ For example, one common over-the-counter painkiller is better known via its trademark or brand name, *TYLENOL*,²⁵⁵ than by its generic product name, acetaminophen or paracetamol.²⁵⁶ This is a consequence of substantial advertising and marketing expenditures by the maker of the *TYLENOL* brand of acetaminophen.²⁵⁷ Hence, some

²⁵⁰ See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992).

²⁵¹ See *MCCARTHY*, *supra* note 243, § 28.15.

²⁵² See *Kournikova v. Gen. Media Comm'ns, Inc.*, No. CV 02-3747 GAF, 2002 U.S. Dist. LEXIS 25810, at *17 (C.D. Cal. Aug. 9, 2002) (“A celebrity may bring a false endorsement claim for the unauthorized use of her identity if such use is likely to confuse consumers as to the celebrity’s sponsorship or approval of the product.”).

²⁵³ See *generally* *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1402 (9th Cir. 1992) (Alarcon, J., dissenting) (noting that when protecting intellectual property, the court must balance competing interests between protecting the creation and investment of intellectual property while preventing monopolies that would inhibit creative expressions).

²⁵⁴ See *generally* *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting) (noting careful balances built into intellectual property law which allow the public to use things created by others).

²⁵⁵ See *Too Much Acetaminophen over Time May Damage Liver*, USA TODAY, Nov. 23, 2011, available at <http://www.usatoday.com/news/health/story/health/story/2011-11-23/Too-much-acetaminophen-over-time-may-damage-liver/51369772/1>.

²⁵⁶ See Acetaminophen, PUBMED HEALTH, <http://www.ncbi.nlm.nih.gov/pubmedhealth/PMH0000521/> (last visited June 22, 2012) (for information on acetaminophen).

²⁵⁷ See Jerry Knight, *Tylenol’s Maker Shows How to Respond to Crisis*, WASH. POST, Oct. 11, 1982. See *generally* *At 50, Tylenol Brand Still Gaining Steam*, ASSOCIATED PRESS, available at http://www.msnbc.msn.com/id/9879888/ns/health-health_care/t/tylenol-brand-still-gaining-steam/ (last visited June 22, 2012) (discussing success of brand).

competitors, as shown below, who are free to make and sell generic versions of acetaminophen, place labels on their products which inform consumers that their product is equivalent to or should be compared to TYLENOL.²⁵⁸



Such conduct allows the above sellers to free ride on the value of the TYLENOL brand without the costs of creating the strong mental association with that brand. However, as long as the labeling is true and it does not cause a likelihood of consumer confusion, such free riding is not actionable under unfair competition law, nor is it trademark infringement because it only creates an association-based relationship between the product and the TYLENOL brand.²⁵⁹ Despite any unjust enrichment from such free riding, it can be justified on the basis of enhancing competition among acetaminophen makers.²⁶⁰ Furthermore,

²⁵⁸ For Equate image see <http://www.walmart.com/ip/Equate-Extra-Strength-Value-Pack-Acetaminophen-Non-Aspirin/10324477> (last visited July 27, 2012); for Walgreens image see <http://www.drugstore.com/walgreens-childrens-pain-reliever-acetaminophen-meltaways-bubble-gum/qxp369209> (last visited July 27, 2012).

²⁵⁹ See *SSP Agric. Equip., Inc. v. Orchard-Rite, Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979) (using competitor's trademark in a comparative advertisement is allowable absent consumer confusion or misrepresentations).

²⁶⁰ See *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1408 (9th Cir. 1992) (Alarcon, J., dissenting) (noting that when protecting intellectual property, the court must balance competing interests between protecting the creation and investment of intellectual property while preventing monopolies that would inhibit creative expressions).

prohibiting the generic makers from marking their product as being comparable or equivalent to TYLENOL would amount to barring truthful commercial speech.²⁶¹

The above types of association-based relationships should not be actionable.²⁶² Under this approach, Mr. Carson could not have pursued a right of publicity action in the *Carson* case.²⁶³ Likewise, Ms. White would be unable to pursue a right of publicity action in the *White* case absent a showing that a confusion-based relationship existed which caused consumers to be likely to believe the advertisement's use of a robot on a television game show set to sell Samsung products was endorsed by Ms. White.²⁶⁴

Limiting the right of publicity to confusion-based relationships may render the cause of action redundant and therefore unnecessary because, as noted above, trademark law and unfair competition law generally already make such conduct actionable. Additionally, this approach allows application of the previously-developed delineation in intellectual property law between marketplace conduct that is permissible, and conduct that is impermissible trademark infringement or unfair competition.

The effect of this approach is actually limited because many right of publicity disputes involve confusion-based relationships, so a trademark or unfair competition theory could often have provided relief in lieu of the right of publicity.²⁶⁵ It is only conduct that would allow a right of publicity action for an association-based relationship that would be eliminated.

For example, Bette Midler was involved in a right of publicity action that involved a sound-alike singer imitating Ms. Midler's voice without her permission in a Ford automobile commercial.²⁶⁶

²⁶¹ See generally Leaffer, *supra* note 46, at 1364 (arguing a right of publicity action should be based on unfair competition or trademark theory rather than a property misappropriation theory).

²⁶² *Id.* at 1373.

²⁶³ See *supra* text accompanying notes 56–75.

²⁶⁴ See *supra* text accompanying notes 76–92.

²⁶⁵ *Id.* at 1364.

²⁶⁶ *Midler v. Ford Motor Co.*, 849 F.2d 460, 460 (9th Cir. 1988).

The song involved—“Do You Want to Dance?”²⁶⁷—was protected via copyright and it was used pursuant to a license from the copyright owner.²⁶⁸ The company used the sound-alike singer after Ms. Midler refused an offer to participate in the commercial.²⁶⁹ The evidence established that the sound-alike singer sounded enough like Ms. Midler to cause some consumers to believe Ms. Midler performed for the commercial.²⁷⁰ This is an example of a confusion-based relationship that should be actionable under an unfair competition theory²⁷¹ and possibly also

²⁶⁷ BETTE MIDLER, *Do You Want to Dance?*, on THE DIVINE MISS M (Atlantic Records 1972).

²⁶⁸ *Midler*, 849 F.2d at 462.

²⁶⁹ *Id.* at 461.

²⁷⁰ *Id.* at 461–62.

²⁷¹ However, the court appeared to deny an unfair competition action due to a lack of economic injury to Ms. Midler. The court stated “we do not find unfair competition here. One-minute commercials of the sort the defendants put on would not have saturated Midler’s audience and curtailed her market. Midler did not do television commercials. The defendants were not in competition with her.” *Id.* at 462–63. Interestingly, Ms. Midler subsequently changed her mind and did a car commercial for Honda in 2011. *See* YOUTUBE, <http://www.youtube.com/watch?v=GhyLD2tWcKU> (last visited on June 25, 2012). The court’s requirement that Ms. Midler must be a competitor who suffers economic damages is contrary to other unfair competition actions, which frame the controlling issue as a question of whether consumers are likely to be confused. *See, e.g.,* Allen v. Nat’l Video, Inc., 610 F. Supp. 612, 625 (S.D.N.Y. 1985) (one purpose of unfair competition action under federal Lanham Act, 15 U.S.C. § 1125(a), is to protect consumers from wide variety of untrue representations about goods and services provided in commerce). Consequently, if a likelihood of consumer confusion exists with regard to whether Ms. Midler was actually singing in the commercial, then she should be able to assert unfair competition, and her remedy should be damages and possibly an injunction barring playing the commercial in the future. *See generally* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (finding singer Tom Waits successfully asserted an unfair competition claim for unauthorized use of a sound-alike in a radio commercial). Although the remedy available for unfair competition has traditionally been damages and/or injunctive relief, that may be different today following the Supreme Court decision *eBay, Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837 (2006). In *eBay*, the Court overruled precedent which held that a patent owner was entitled to a permanent injunction against continuing infringement after a trial on the merits found infringement. *Id.* at 1840–41. The Court held that a patent owner was entitled to damages but that injunctive relief was up to the discretion of the trial judge. *Id.* at 1839. *See generally* Andrew Beckerman-Rodau, *The Supreme Court Engages in Judicial Activism in Interpreting the Patent Law in eBay, Inc. v. MercExchange, L.L.C.*, 10 TUL. J. TECH. & INTELL. PROP. 165, 166 (2007) (critical analysis of the *eBay* decision). Although the *eBay* decision arose in the context of a patent infringement dispute, its holding is not limited to patent law disputes. *See* Mark P. Gergen, John M. Golden & Henry E. Smith,

under a trademark infringement action.²⁷² Nevertheless, the court utilized a right of publicity theory and treated the sound of Ms. Midler's voice as a pure common law property right.²⁷³ This gave her the right to control who used it without regard to countervailing considerations.²⁷⁴

In a similar case, a singer who sounded like Tom Waits was used in a radio commercial to sell SalsaRio Doritos, a snack food.²⁷⁵ Like Ms. Midler, Mr. Waits is a well-known singer who had a policy of not doing commercials.²⁷⁶ In both cases, evidence of actual confusion existed.²⁷⁷ Based on the distinctive voice of Mr. Waits, which was captured by the sound-alike singer, a jury found liability under a right of publicity theory and a federal unfair competition theory.²⁷⁸ As for the federal unfair competition claim,

The Supreme Court's Accidental Revolution? The Test for Permanent Injunctions, 112 COLUM. L. REV. 203, 205 (2012). The trend in favor of damages in lieu of injunctive relief has also been seen in real property disputes. For example, a permanent injunction was the traditional remedy for interference with the use and enjoyment of real property due to a finding that a neighboring landowner was engaged in a nuisance. *See* *Boomer v. Atl. Cement Co., Inc.*, 257 N.E.2d 870, 872 (N.Y. Ct. App. 1970) (noting rule that injunction was traditional remedy for an ongoing nuisance); *see also* *Morgan v. High Penn Oil Co.*, 77 S.E.2d 682 (N.C. 1953) (remedy for nuisance was permanent injunction). Nevertheless, some judicial decisions have awarded damages in lieu of a permanent injunction thereby allowing the unwanted condition to continue subject to payment for such conduct. *See, e.g., Boomer*, 257 N.E.2d at 873 (overruling the traditional remedy and allowing the party creating the nuisance to continue the activity upon payment of monetary damages for present and future nuisance).

²⁷² In light of *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 171–73 (1995), almost anything that is source-indicating can be registered as a trademark today. This includes music and other sounds that have been registered as trademarks under federal law. *See, e.g., THE SOUND OF THE FAMOUS TARZAN YELL*, Registration No. 2,210,506; *see also* *Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, 75 U.S.P.Q.2d 1269, 1274 (E.D. Pa. 2005) (noting sound can be a trademark); Melissa E. Roth, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 469 (2005) (sound trademarks registerable in the United States). *See generally* Rita Heimes, *Trademarks, Identity, and Justice*, 11 J. MARSHALL REV. INTELL. PROP. L. 133, 137 (2011) (colors, sounds, smells, and product packaging can be trademarks).

²⁷³ *Midler*, 849 F.2d at 463.

²⁷⁴ *Id.* at 463–464.

²⁷⁵ *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096 (9th Cir. 1992).

²⁷⁶ *Id.* at 1097.

²⁷⁷ *Id.* at 1111.

²⁷⁸ *Id.* at 1096.

the court rejected any requirement that Mr. Waits be in competition with regard to the sale of Doritos.²⁷⁹ Instead, the court styled the claim as a false endorsement claim²⁸⁰ and upheld the jury's finding that in light of all the circumstances "consumers were likely to be misled by the commercial into believing that [Mr.] Waits endorsed SalsaRio Doritos."²⁸¹ Interestingly, the court found some of the damages awarded for the right of publicity action and the unfair competition claim to be duplicative, so a portion of the damages were vacated.²⁸²

In *Allen v. National Video, Inc.*,²⁸³ the defendant, a person who looked like the well-known filmmaker and actor Woody Allen, was used in advertisements to take advantage of his resemblance to Mr. Allen.²⁸⁴ Mr. Allen brought an action asserting unfair competition and violation of his right to publicity.²⁸⁵ The court declined to resolve the right of publicity action because it concluded that the dispute could be resolved under unfair competition law.²⁸⁶ The court held that an unfair competition action available under federal law²⁸⁷ should be broadly construed to protect consumers from misrepresentations about products and services made available in commerce.²⁸⁸ Additionally, the unfair competition action should cover unfair competitive practices that cause actual or potential consumer deception.²⁸⁹ The court enjoined use of defendant's image in the advertisements at issue after finding a violation of the federal unfair competition statute.²⁹⁰ The court's holding rested on a finding that the advertisements

²⁷⁹ *Id.* at 1110.

²⁸⁰ *Id.* at 1106–11.

²⁸¹ *Id.* at 1111.

²⁸² *Id.* at 1112. Nevertheless, the court upheld an award of \$2.6 million that was comprised of compensatory damages, punitive damages, and attorney fees. *Id.* at 1096.

²⁸³ 610 F. Supp. 612 (S.D.N.Y. 1985).

²⁸⁴ *Id.* at 618.

²⁸⁵ *Id.* at 617, 632.

²⁸⁶ *Id.* at 625. It should be noted that a right to publicity action in the relevant jurisdiction in this case—New York—was constrained by statute such that it was more narrowly applied than in other jurisdictions. *Id.* at 624 n.5.

²⁸⁷ *Id.*; 15 U.S.C. § 1125(a) (2006).

²⁸⁸ *Allen*, 610 F. Supp. at 625.

²⁸⁹ *Id.*

²⁹⁰ *Id.* at 630.

would be likely to confuse consumers into believing that Mr. Allen was either appearing in the advertisements or that he endorsed or approved of the advertisement with defendant's image.²⁹¹ The court noted that it was relying on the well-established likelihood of confusion analysis utilized in federal trademark infringement actions²⁹² because this analysis is "the heart of a successful claim"²⁹³ under both federal and state trademark infringement actions and even under state unfair competition law actions.²⁹⁴

In *Wendt v. Host International, Inc.*,²⁹⁵ the owner of the intellectual property rights to the television show *Cheers*

²⁹¹ *Id.* at 628–30.

²⁹² This analysis requires the court to consider the following factors in deciding if a likelihood of confusion exists:

- 1) the strength of plaintiff's marks and name;
- 2) the similarity of plaintiff's and defendant's marks;
- 3) the proximity of plaintiff's and defendant's products;
- 4) evidence of actual confusion as to source or sponsorship;
- 5) sophistication of the defendant's audience; and
- 6) defendant's good or bad faith.

Id. at 627 (applying the above factors, the court substituted the likenesses of defendant and Mr. Allen for the references to marks in the factors). Most courts apply the same or similar factors in analyzing likelihood of confusion. *See, e.g.,* AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir. 1979) (factors considered in determining likelihood of confusion in trademark infringement action: strength of the mark; proximity of the goods; similarity of the marks; evidence of actual confusion; marketing channels used; type of goods and the degree of care likely to be exercised by the purchaser; defendant's intent in selecting the mark; and likelihood of expansion of the product lines); *Naked Cowboy v. CBS*, 2012 U.S. Dist. LEXIS 23211, at *15 (S.D.N.Y. Feb. 23, 2012) (factors considered in federal trademark infringement action and federal unfair competition action: the strength of plaintiff's mark; the similarity of the parties' marks; the proximity of the parties' products in the marketplace; the likelihood that the prior user will bridge the gap between the products; actual confusion; the defendant's good or bad faith in adopting the mark; the quality of defendant's product; and the sophistication of the relevant consumer group); *see also* *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983).

²⁹³ *Allen*, 610 F. Supp. at 627 (quoting *Standard & Poor's Corp. v. Commodity Exchange, Inc.*, 683 F.2d 704, 708 (2d Cir. 1982)).

²⁹⁴ *See id.*; *accord* *Food Scis. Corp. v. Nagler*, No. 09-1798, 2010 U.S. Dist. LEXIS 112072, at *5 (D.N.J. 2010). *See generally* *Summit Entertainment, LLC v. B.B. Dakota Inc.*, 2011 U.S. Dist. LEXIS 151582, at *20 (C.D. Cal. 2011) (noting the same likelihood of confusion test applies to federal and state trademark infringement and unfair competition actions).

²⁹⁵ 125 F.3d 806 (9th Cir. 1997).

authorized the creation of airport bars that resembled the bar in the television show.²⁹⁶ Additionally, animatronic robotic figures that resembled Norm and Cliff, two characters on the show, were placed in the bars,²⁹⁷ although the figures were called Bob and Hank.²⁹⁸ George Wendt and John Ratzenberger were the actors who played the Norm and Cliff characters in the television show.²⁹⁹ They brought an action arguing that the use of the Bob and Hank robots in the bars violated their rights of publicity and their federal unfair competition rights³⁰⁰ despite the fact that the facial features of the robots were totally different than the facial features of Mr. Wendt and Mr. Ratzenberger.³⁰¹ The appellate court reversed the trial court's dismissal of the action on a motion for summary judgment.³⁰² The appellate court held that the right of publicity action involved factual questions that a jury must decide.³⁰³ Additionally, the appellate court, consistent with the decisions discussed above, held that the federal unfair competition action was a false endorsement claim³⁰⁴ that should be analyzed under the traditional test for likelihood of confusion³⁰⁵ to determine if consumers would believe, based on the robotic figures in the bars, that Mr. Wendt and Mr. Ratzenberger endorsed the airport bars based on the *Cheers* television show.³⁰⁶

In light of the above discussion, it is clear that a person should have a legal cause of action when his or her persona is used commercially to create a confusion-based relationship between a

²⁹⁶ *Id.* at 809.

²⁹⁷ *Id.*

²⁹⁸ *Id.* at 811.

²⁹⁹ *Id.*

³⁰⁰ *Id.* at 809.

³⁰¹ *See id.* (finding no similarity between the robots and Mr. Wendt and Mr. Ratzenberger and noting they had totally different facial features).

³⁰² *Id.* The case was subsequently settled and it is presumed Mr. Wendt and Mr. Ratzenberger were compensated in return for ending the litigation. *See* ERIC FREYFOGLE & BRADLEY KARKKAINEN, PROPERTY LAW: POWER, GOVERNANCE, AND THE COMMON GOOD 426 (2012).

³⁰³ *Wendt*, 125 F.3d at 810–12.

³⁰⁴ *Id.* at 812.

³⁰⁵ *Id.*

³⁰⁶ *See id.* at 812–13 (“The issue is whether a consumer would be confused as to Wendt and Ratzenberger’s association with or sponsorship of [the airport] bars.”).

good or service and the person. However, a cause of action should not typically be available if only an association-based commercial relationship is created. This negates the need for the right of publicity cause of action in many contexts because an unauthorized confusion-based relationship is already actionable under an unfair competition or trademark infringement action.

Additionally, commercial speech likely to confuse or mislead consumers is not typically entitled to First Amendment protection.³⁰⁷ Therefore, limiting the right of publicity to confusion-based relationships greatly minimizes the need for courts to resolve the difficult conflicts between the right of publicity, which usually involves commercial speech, and the First Amendment.

Nevertheless, a right of publicity action may be viable in the limited context when a famous persona is involved.

V. RIGHT OF PUBLICITY AND TRADEMARK DILUTION

Dilution law provides an exception to the distinction between commercial conduct that creates a confusion-based relationship³⁰⁸ and commercial conduct that merely creates an association-based relationship.³⁰⁹ It allows a cause of action for trademark dilution in situations where an infringement action is not viable.³¹⁰ Dilution

³⁰⁷ *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001).

³⁰⁸ A trademark infringement action represents a confusion-based relationship. *See* 15 U.S.C. § 1114(1)(2006) (providing for trademark infringement action under federal trademark law based on certain conduct that “is likely to cause confusion, or to cause mistake, or to deceive”).

³⁰⁹ *See id.* § 1125(c) (providing a federal cause of action for trademark dilution); *see also* 54 PA. CONSOL. STAT. § 1124 (2012) (providing a state statutory cause of action for trademark dilution under Pennsylvania law). Some states recognize a common law dilution action. *See, e.g., Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 424 (6th Cir. 1999) (“Ohio courts recognize a common law cause of action for dilution.”).

³¹⁰ In contrast to trademark infringement actions, trademark dilution actions do not require any consumer confusion. *See* 15 U.S.C. § 1125 (c)(1) (stating no actual or likelihood of confusion necessary for dilution under federal law). In *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 167 (4th Cir. 2012), the court noted that the purpose of trademark infringement law is to prevent consumer confusion but this is not the premise for dilution actions. *See also PPG Indus., Inc. v. Clinical Data, Inc.*, 620 F. Supp. 604, 606–07 (D. Mass. 1985) (finding consumer confusion not necessary for dilution under Massachusetts state dilution law). *See generally* I.P. Lund Trading ApS v. Kohler Co.,

actions are based on the existence of an unauthorized association-based commercial relationship.³¹¹ Arguably, a dilution action recognize a property right in a trademark per se, in contrast to trademark infringement law which typically only recognizes a property right in the mental association created in the minds of the intended consumers when they see a trademark affixed to a product.³¹² The broad range of protection provided by dilution is mitigated by a requirement that such a cause of action is only available for a limited number of trademarks³¹³—only famous

163 F.3d 27, 48–49 (1st Cir. 1998) (describing how dilution can occur absent any consumer confusion and even if non-competing goods are involved).

³¹¹ See generally 15 U.S.C. § 1125(c)(1), which states:

[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, *regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury*. *Id.* (emphasis added).

³¹² See generally Matthew Slowik, *Ahead of the Curve? The Effect of the Trademark Dilution Revision Act of 2006 on the Federal Circuit*, 18 FED. CIR. B.J. 349, 362 (2008) (describing how many commentators concerned about dilution right becoming a per se property right in trademark).

³¹³ In *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 169–70 (Cal. Ct. App. 2010) (quoting *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999)), the court stated:

[D]ilution is a cause of action invented and reserved for a select class of marks—those marks with such powerful consumer associations that even non-competing uses can impinge on their value. Dilution causes of action, much more so than infringement and unfair competition laws, tread very close to granting “rights in gross” in a trademark. In the infringement and unfair competition scenario, where the less famous a trademark, the less the chance that consumers will be confused as to origin, a carefully-crafted balance exists between protecting a trademark and permitting non-infringing uses. In the dilution context, likelihood of confusion is irrelevant. If dilution protection were accorded to trademarks based only on a showing of inherent or acquired distinctiveness, we would upset the balance in favor of over-protecting trademarks, at the expense of potential non-infringing uses.

We view the famousness prong of both dilution analyses [i.e., under federal law and California law] as reinstating the balance—by carefully limiting the class of trademarks eligible for dilution protection, Congress and state legislatures granted the most potent

trademarks are entitled to dilution protection.³¹⁴ “Famous” trademarks are, quite simply, marks that are widely known by the general public.³¹⁵ Additionally, the traditional remedy permitted is injunctive relief³¹⁶—in contrast to trademark infringement law, which allows both monetary damages and injunctive relief.³¹⁷ This dilution action can be viewed as an attempt to protect the trademark owner’s investment in his or her mark, when the investment has resulted in the trademark becoming very strong and widely known to consumers.³¹⁸

By analogy, the analysis that justifies a trademark dilution action should apply to a right of publicity action. Only celebrities who have become famous (in the trademark law sense that they are widely known by the general consuming public) should be able to assert a right of publicity action based on showing an unauthorized association-based commercial transaction.³¹⁹ A lesser-known

form of trademark protection in a manner designed to minimize undue impact on other uses.

Therefore, to meet the “famousness” element of protection under the dilution statutes, “a mark [must] be truly prominent and renowned.”

Id.

³¹⁴ See 15 U.S.C. § 1125(c)(1) (2006); see also *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012) (noting that whether a trademark is famous is a threshold question for purposes of a federal dilution action).

³¹⁵ See 15 U.S.C. § 1125(c)(2)(A) (“A mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”).

³¹⁶ See *Greater Lansing Ass’n of Realtors v. Mentzer-Amundson*, No. 210504, 2000 Mich. App. LEXIS 1236, at *18 (Mich. Ct. App. 2000); see also 15 U.S.C. § 1125(c)(1) (stating the remedy for dilution under federal law is injunctive relief).

³¹⁷ See *id.* §§ 1114, 1116 (permitting damages for trademark infringement and allowing injunctive relief for trademark infringement).

³¹⁸ Christopher R. Perry, *Trademarks as Commodities: The “Famous” Roadblock to Applying Trademark Dilution Law in Cyberspace*, 32 CONN. L. REV. 1127, 1130–31 (2000) (noting that the purpose of trademark infringement action is to protect consumers from being confused but purpose of trademark dilution action is to protect investment of trademark owner in famous trademark).

³¹⁹ Disagreement exists with regard to whether a right of publicity action is available to everyone or only to celebrities. The leading commentator on the right to publicity believes all people should have the right. See MCCARTHY, *supra* note 1, § 4:3 at 205–06. However, not all commentators agree. See *id.* §§ 4:14–16 at 219–26. Likewise, judicial decisions are also split. See *Curran v. Amazon.com, Inc.*, No. 2:07-0354, 2008 U.S. Dist. LEXIS 12479, at *14–15 (S.D.W.Va. 2008). Compare, e.g., *Donchez v. Coors Brewing*

celebrity would be limited to asserting a trademark infringement or unfair competition action based on an unauthorized confusion-based commercial transaction. This would enable a celebrity who has invested sufficient time, energy, and money to become widely known to the general public to protect that investment.

VI. PROPOSED FRAMEWORK FOR THE RIGHT OF PUBLICITY

Courts generally disagree on the *prima facie* elements of a common law right of publicity action.³²⁰ However, the leading commentator states the following elements:

Co., 392 F.3d 1211, 1220 (10th Cir. 2004) (indicating right of publicity action not available to a non-celebrity), *with* *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d, 713, 717 (Cal. Ct. App. 2000) (indicating California right of publicity statute not limited to celebrities).

³²⁰ *See, e.g.*, *Abdul-Jabbar v. Gen. Motors Corp.*, 75 F.3d 1391, 1398 (9th Cir. 1996) (stating that under California law, *prima facie* elements are “(1) the defendant’s use of plaintiff’s identity; (2) the appropriation of plaintiff’s . . . [identity] to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury”); *Blair v. Nev. Landing P’ship*, 859 N.E.2d 1188, 1191–92 (Ill. App. Ct. 2006) (stating that under Illinois law, a plaintiff must show “an appropriation of one’s name or likeness, without one’s consent, for another’s commercial benefit”); *Brasel v. The Hair Co.*, 976 So. 2d 390, 392 (Miss. Ct. App. 2008) (stating that under Mississippi law, “a plaintiff must show that the defendant: (1) appropriated his name or likeness, (2) without consent, (3) for use in a commercial enterprise”); *Arnold v. Treadwell*, No. 283093, 2009 WL 2136909, at *4 (Ct. App. Mich. 2009) (stating that under Michigan law, “a plaintiff must prove (1) that she has a pecuniary interest or significant commercial value in her identity, and (2) that the defendants engaged in commercial exploitation of her identity”); *Brill v. Walt Disney Co.*, 246 P.3d 1099, 1102 (Okla. Civ. App. 2010) (stating that under Oklahoma law, which adopted the Restatement (Second) of Torts definition, “[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy”); *Henley v. Dillard Dept. Stores*, 46 F. Supp. 2d 587, 590 (N.D. Tex. 1999) (stating that under Texas law, *prima facie* elements are “(1) the defendant appropriated the plaintiff’s name or likeness for the value associated with it, and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) there was some advantage or benefit to the defendant”). Likewise, the *prima facie* elements of a statutory right of publicity action also vary. *See, e.g.*, *Blair*, 859 N.E.2d at 1192 (Ill. App. Ct. 2006) (applying the Illinois statute which states: “[a] person may not use an individual’s identity for commercial purposes during the individual’s lifetime without having obtained previous written consent from the appropriate person or persons”); *Molina v. Phoenix Sound Inc.*, 747 N.Y.S.2d 227, 230 (App. Div. 2002) (stating that under New York’s statute, a plaintiff must show “(i) usage of plaintiff’s name, portrait, picture, or voice, (ii) with the state of New York, (iii) for purposes of advertising or trade, (iv) without plaintiff’s written consent”); *Brill*, 246 P.3d at 1103 (stating that under Oklahoma’s statute a plaintiff must

- (1) *Validity* Plaintiff owns an enforceable right in the identity or persona of a human being; and
- (2) *Infringement* (A) Defendant, without permission, has used some aspect of identity or persona in such a way that plaintiff is identifiable from defendant's use; and (B) Defendant's use is likely to cause damage to the commercial value of that persona.³²¹

Typically, the third element above is presumed when some identifiable aspect of a person's persona is used in a commercial context without permission.³²² Usually, the traditional remedy of injunctive relief has been available.³²³ Recovery of damages generally requires proof of appropriate commercial injury.³²⁴

Generally, when the name or likeness of a celebrity is used without permission with regard to the sale of a product or service an unfair competition claim can also be brought.³²⁵ Under federal

establish "(1) Defendants knowingly used [plaintiff's] name or likeness, (2) on products, merchandise or goods, (3) without [plaintiff's] prior consent").

³²¹ MCCARTHY, *supra* note 1 § 3:2, at 120–21.

³²² *Id.* § 3:2, at 122.

³²³ *Id.*

³²⁴ *Id.* § 3:2, at 122–23. Typically, appropriate damages for a right of publicity action are commercial in nature. For example, such damages could include the typical rate paid to a particular celebrity for use of his or her image in an advertisement, lost licensing opportunities, or the profits earned by an infringer. *See generally id.* §§ 11:30–11:35 at 751–73 (detailed discussion of damages). Nevertheless, in *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1103 (9th Cir. 1992), the court noted that in an appropriate case, in addition to commercial damages, mental distress damages as a result of causing humiliation or embarrassment are recoverable. And, punitive damages may also be awarded. *Id.* at 1104–06.

³²⁵ Just as disagreement exists with regard to whether a right of publicity action is limited to celebrities, the same issue arises with regard to whether a false endorsement claim under 15 U.S.C. § 1125(a)(1)(A) is limited to celebrities. *See, e.g., Uhlig LLC v. Shirley*, 2011 U.S. Dist. LEXIS 31833, at *19 (D. S.C. 2011) (false endorsement action only available to celebrity). *But see Arnold v. Treadwell*, 642 F. Supp. 2d 723, 735 (E.D. Mich. 2009) (celebrity status not a requirement for false endorsement action). A trademark infringement action may also be available if the celebrity has registered their name or other characteristic as a trademark or service mark. The elements of a trademark infringement action are: (1) plaintiff must show ownership of the mark; and (2) consumer confusion is likely to result from defendant's use of the mark. *Rearden LLC v. Rearden Commerce Inc.*, 103 U.S.P.Q.2d 1161, 1168–69 (9th Cir. 2012).

law such claims are typically referred to as false endorsement actions³²⁶ and require the plaintiff to establish:

- (1) its mark is legally protectable;
- (2) it owns the mark;
- (3) the defendant's use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff's sponsorship or approval of those goods or services.³²⁷

Additionally, the mark must be used in interstate commerce³²⁸ for the above action, although analogous state-based actions are available when purely intrastate commerce is involved.³²⁹

Based on the statute³³⁰ and its judicial interpretation, the word *mark* is broadly construed to include “any word, term, name, symbol, or device, or any combination thereof.”³³¹ This includes both registered and unregistered marks as well as the use of a person's name, likeness, or any other indicia that identifies the person.³³² Often, any unauthorized reference to a celebrity in a commercial context will trigger a successful false endorsement claim because such use will generally make it likely that consumers believe the celebrity endorses or approves of the product or service and therefore a confusion-based association will exist.³³³ Of course, relying on a false endorsement action eliminates the small number of disputes where only an associational connection is made by consumers between the

³²⁶ 15 U.S.C. § 1125(a)(1)(A) (2006).

³²⁷ *Facenda v. Nat'l Football League*, 542 F.3d 1007, 1014 (3d Cir. 2008).

³²⁸ *Uhlig LLC v. Shirley*, 2011 U.S. Dist. LEXIS 31833, at *19 (D. S.C. 2011).

³²⁹ *See, e.g., Hubbs Mach. & Mfg. v. Brunson Instrument Co.*, 635 F. Supp. 2d 1016, 1019 (E.D. Mo. 2009) (stating that under Missouri law: “[u]nfair competition is a species of commercial hitchhiking which the law finds offensive, and, therefore, prohibits. The law of unfair competition is but a reaffirmation of the rules of fair play. It aims to effect honesty among competitors by outlawing all attempts to trade on another's reputation—it gives the crop to the sower and not to the trespasser. In so doing it strives to protect the buying public from deception”).

³³⁰ 15 U.S.C. § 1125(a)(1)(A).

³³¹ 15 U.S.C. § 1125(a)(1).

³³² *Facenda*, 542 F.3d at 1014; *see also Amazon, Inc. v. Cannondale Inc.*, No. 99 N 571, 2000 U.S. Dist. LEXIS 17864, at *18–19 (D. Colo. 2000) (noting that celebrity persona is the mark at issue in a false endorsement claim).

³³³ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 939 (6th Cir. 2003).

product or service and the celebrity.³³⁴ Under this approach, an unfair competition action, such as a false endorsement action, can substitute for a right of publicity action whenever a confusion-based association is created by a commercial use of a person's persona.³³⁵

Commercial use of a person's persona should typically not be actionable if only an association-based connection exists between the person and the product or service he or she is associated with. This approach preserves a robust public domain where references to celebrities and others can be made freely as long as there is no likelihood of consumer marketplace confusion. This result simplifies to some extent the difficulty of distinguishing between a person's reputational interests and First Amendment free speech considerations since little justification exists for cloaking misleading and confusing commercial speech with First Amendment protection.³³⁶ However, one exception to this limitation can be gleaned or borrowed from trademark dilution law.

Under dilution law,³³⁷ a limited number of trademarks that are deemed famous³³⁸ are granted an extra layer of protection.³³⁹ This protection arises from a commercial use that creates an association-based relationship even if no confusion-based relationship exists.³⁴⁰ To be famous, the trademark must be

³³⁴ 15 U.S.C. § 1125(a)(1)(A); *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 156 (Cal. Ct. App. 2010) (denying motion for preliminary injunction because there was insufficient information to prove false endorsement even though there was an associational connection).

³³⁵ *ETW Corp.*, 332 F.3d at 924.

³³⁶ *See generally* *Kasky v. Nike, Inc.*, 45 P.3d 243, 251 (Cal. 2002) (finding that misleading or deceptive speech entitled to little of any First Amendment protection).

³³⁷ 15 U.S.C. § 1125(c) (federal dilution). State dilution statutes also exist. *See, e.g.*, FLA. STAT. § 495.151 (2012); OR. REV. STAT. § 647.107 (2012).

³³⁸ 15 U.S.C. § 1125(c)(1).

³³⁹ *See id.*

³⁴⁰ *See* *Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP*, 109 Cal. Rptr. 3d 143, 170 (Cal. Ct. App. 2010) (noting that likelihood of confusion is not relevant in a dilution action). Federal law makes a dilution action available "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." 15 U.S.C. § 1125(c)(1). Dilution actions apply to a very limited class of trademarks that have such strong consumer associations that unauthorized non-competing uses by a third

“widely recognized by the general consuming public.”³⁴¹ If a celebrity reaches this status, a right of publicity action should be available even if commercial use of the celebrity persona only creates an association-based relationship. Arguably, this provides an extra level of legal protection for a limited number of celebrities, just as dilution law provides an extra level of protection for the limited number of trademarks that have attained an unusually high level of marketplace recognition.

Admittedly, this approach will make it virtually impossible for non-celebrities to successfully assert an action because they will be unable to satisfy the famous requirement. They will also be unlikely to demonstrate any likelihood of confusion as required by an unfair competition action.³⁴² Nevertheless, non-celebrities would still have the option of asserting a right of privacy action in appropriate cases to protect their personas from public humiliation or emotional distress.

Analogizing to unfair competition and trademark law allows courts to apply the rich body of precedent that exists in those areas of law. This will create more certainty with regard to what are protectable property interests and what should be freely available in the public domain. Finally, it will allow the right of publicity to fit within the genus of intellectual property law by applying the same balancing of competing interests that is endemic to the other species of intellectual property law.

CONCLUSION

The right of publicity represents the newest species of intellectual property. However, its parameters can best be described as a work in progress over the past several decades. Some judicial decisions greatly expanded the right by focusing primarily on protecting celebrities from unauthorized free riding. This has included commercial use of a person’s name, likeness, or anything that conjures up an association with the celebrity even if

party can negatively affect the mark’s value. See *Franklin Mint Co.*, 109 Cal. Rptr. 3d at 169–70 (quoting *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999)).

³⁴¹ 15 U.S.C. § 1125(c)(2)(A).

³⁴² 15 U.S.C. §§ 1114(1), 1125(a)(1)(A) (2006).

consumers would be unlikely to believe the person approved of or endorsed the product or service involved. Other judicial decisions recognized that the right must be balanced against competing concerns such as promoting competition, accommodating freedom of speech concerns, and maintaining a robust public domain comprised of things that are free for all to use. Such balancing has long been a part of the traditional bodies of intellectual property law. This well-developed balancing approach should be adopted and made applicable to the interest protected by the right of publicity by utilizing the traditional likelihood of consumer confusion standard applied in trademark and unfair competition actions. This would allow right of publicity actions when a person's persona is used in a confusion-based commercial activity but not when only an association-based commercial relationship is involved. Additionally, in light of the broad scope of modern trademark law and the broad application of unfair competition actions, virtually any confusion-based commercial activity could be redressed under trademark law and/or unfair competition law using a likelihood of confusion standard in lieu of a right of publicity action. This approach is consistent with the underlying utilitarian justification for intellectual property law, which primarily seeks to enlarge the public domain by incentivizing innovators and creators by providing limited property rights for a variety of creative products. By analogy to the rights granted to famous trademarks pursuant to dilution theory, additional protection for association-based commercial use of a person's persona should be limited to famous individuals who are widely known by the general public.