

CONSTITUTIONAL RESTRAINTS ON STATE RIGHT OF PUBLICITY LAWS

Abstract: Over the past fifty years, a new intellectual property right called the right of publicity has evolved under state common law. This Note explores a recurring concern hinted at by several lower courts and dissenting opinions: that current publicity laws offend parts of the Constitution beyond the First Amendment and the Copyright Clause. The existing hodgepodge of state statutory and common law that makes up the right of publicity appears to be a minefield of constitutional hazards. Courts must consider a variety of First Amendment, Copyright Clause, Commerce Clause, Due Process Clause, and Full Faith and Credit Clause issues when resolving publicity rights cases. This Note argues that Congress could simplify this area of the law considerably for plaintiffs, defendants, and courts by creating a preemptive federal right of publicity. Alternatively, the right could remain state-based and still avoid these issues through other approaches.

INTRODUCTION

Over the past fifty years, a new intellectual property right called the right of publicity has evolved under state common law.¹ This modern legal doctrine, where recognized, grants property rights to everyone, allowing each person to control the commercial use of his or her identity.² The right of publicity has been especially valuable to celebrities because their identities carry substantial economic value.³

The states have not universally recognized the right of publicity,⁴ and it is not without its critics.⁵ A recurring criticism is that it endan-

¹ See, e.g., J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3, :4 (2d ed. rev. Mar. 2002); Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35, 36-37 (1998).

² See MCCARTHY, *supra* note 1, § 1:3.

³ See *id.* § 4:3; see also Sean Wood, *Athlete Endorsements Sell*, HAMILTON SPECTATOR, Aug. 26, 2002, at B11, at 2002 WL 24455886 (describing several athletes' recent lucrative endorsement contracts, such as tennis star Venus Williams's \$40 million deal with Reebok).

⁴ See MCCARTHY, *supra* note 1, § 6:3.

⁵ See, e.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127 *passim* (1993); Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. 283, 286 n.8 (2000).

gers First Amendment rights including freedom of speech.⁶ A related objection is that it privatizes too many ideas, facts, and types of information that ought to remain in the public domain.⁷ Others assert that federal rights granted under the Copyright Clause will preempt a plaintiff's publicity rights in many cases.⁸ The right of publicity remains in a period of rapid development as courts and commentators continue to refine its contours and rough edges.⁹ Other evolving aspects of the law, such as constitutional jurisprudence, will also affect its future development.¹⁰

This Note explores a recurring concern hinted at by several lower courts and dissenting opinions, one that has thus far escaped detailed analysis: that current publicity laws offend parts of the Constitution beyond the First Amendment and the Copyright Clause.¹¹ The existing hodgepodge of state statutory and common law that makes up the right of publicity appears to be a minefield of constitutional hazards.¹² Courts must consider a variety of First Amendment, Copyright Clause, Commerce Clause, Due Process Clause, and Full Faith and Credit Clause issues when resolving publicity rights cases.¹³ Congress could simplify this area of the law considerably for plaintiffs, defendants, and courts by creating a preemptive federal right of publicity.¹⁴ Alternatively, the right could remain state-based and still avoid these issues through other approaches.¹⁵

Section I of this Note describes the evolution of the right of publicity, the uses of another's identity that may infringe upon it and the

⁶ See, e.g., Madow, *supra* note 5, at 134; Zimmerman, *supra* note 5, at 295-96.

⁷ See, e.g., Madow, *supra* note 5, at 138-46; Zimmerman, *supra* note 5, at 289-90.

⁸ See, e.g., *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999) (denial of motion for rehearing) (Kozinski, J., dissenting) (arguing that copyright holder's right to exploit the characters played by plaintiff actors should preempt their state publicity rights); *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 676, 79 (7th Cir. 1986) (holding that baseball club's copyright in game telecast preempted players' right of publicity in their athletic performances). *But see* *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (holding that federal copyright protection for sound recordings did not preempt plaintiff's state publicity right to prevent unauthorized use of sound-alike singer); Schuyler M. Moore, *Putting the Brakes on the Right of Publicity*, 9 UCLA ENT. L. REV. 45, 55-56 (2001) (arguing copyright should not preempt publicity rights because they protect different interests).

⁹ See MCCARTHY, *supra* note 1, § 1:38.

¹⁰ See *id.*

¹¹ See *infra* notes 153-321 and accompanying text.

¹² See *infra* notes 153-321 and accompanying text.

¹³ See *infra* notes 153-321 and accompanying text.

¹⁴ See *infra* notes 322-330 and accompanying text.

¹⁵ See *infra* notes 331-333 and accompanying text.

uses it permits, and the common justifications for, and criticisms of, the right.¹⁶ Section II reviews selected case law involving constitutional issues raised by the right of publicity and related torts.¹⁷ Section III then examines constitutional limits on the right of publicity imposed by the Commerce, Due Process, and Full Faith and Credit clauses and discusses ways to avoid the apparent conflicts.¹⁸

I. THE RIGHT OF PUBLICITY

Professor McCarthy, author of the comprehensive treatise on the rights of publicity and privacy, defines the right of publicity as "the inherent right of every human being to control the commercial use of his or her identity."¹⁹ It is an intellectual property right derived under state law, the infringement of which creates a cause of action for the tort of unfair competition.²⁰ Every human being has a right of publicity; it is generally not limited to celebrities.²¹

In most states that recognize it, the right of publicity is a descendible and assignable property right.²² Thus, it also protects against unauthorized post-mortem use of a deceased's identity.²³ Most states that recognize a post-mortem right of publicity limit its duration to no longer than 100 years after death.²⁴ Tennessee's publicity law, however, provides protection for as long as the right holder continually exploits the commercial value of the identity.²⁵

A. History

Several law review articles and key judicial opinions considerably influenced the creation of the right of publicity.²⁶ It traces its origin to

¹⁶ See *infra* notes 19–152 and accompanying text.

¹⁷ See *infra* notes 153–268 and accompanying text.

¹⁸ See *infra* notes 269–336 and accompanying text.

¹⁹ MCCARTHY, *supra* note 1, § 1:3.

²⁰ *Id.*

²¹ *Id.* But see *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 624 (6th Cir. 2000) (stating that only plaintiffs who can show their identities have commercial value can assert the right, but noting that the complained-of use may be enough evidence in itself to show that plaintiff's identity had sufficient commercial value to assert the right).

²² See MCCARTHY, *supra* note 1, §§ 9:17, 10:13. New York and Wisconsin courts have explicitly held that the right is not descendible. *Id.* § 9:19.

²³ See *id.* § 9:17.

²⁴ See *id.* § 6:8.

²⁵ Zimmerman, *supra* note 1, at 46.

²⁶ See MCCARTHY, *supra* note 1, § 1:4.

several of the same sources as the right to privacy.²⁷ In 1890, Samuel D. Warren and Louis D. Brandeis published a seminal article in the *Harvard Law Review* titled *The Right to Privacy*.²⁸ The authors argued that unauthorized public disclosure of truthful but embarrassing facts about one's private life causes an affront to one's human dignity.²⁹ Relying on principles of natural law, they argued that anyone so harmed should have a remedy at law.³⁰ In 1905, state courts began adopting aspects of Brandeis and Warren's theory, holding that common law should protect such privacy rights.³¹ Where courts rejected the theory, some state legislatures enacted right to privacy statutes to protect the right, such as took place in New York.³²

Courts and commentators struggled, however, with the idea and semantics of applying the right to privacy toward celebrities—individuals who actively sought the limelight.³³ Celebrities presented a stark contrast to the typical right to privacy plaintiff who sought to be "left alone."³⁴ Judge Jerome Frank resolved this incongruity by coining the term "right of publicity" in a 1953 United States Court of Appeals for the Second Circuit case, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*³⁵ The parties were two baseball card manufacturers and the case turned on whether a baseball player could assign exclusive rights to produce a card with his photograph to one of the companies.³⁶ The court ruled that this right of publicity was indeed assignable and, unlike the right to privacy, was not a solely personal interest.³⁷

On the heels of this decision, Professor Melville B. Nimmer wrote an influential article that began to flesh out this nascent right.³⁸ In his article, Nimmer explained that the right to privacy provided insufficient protection for the commercial value of one's identity be-

²⁷ See *id.*

²⁸ Samuel D. Warren & Louis D. Brandeis, *The Right To Privacy*, 4 HARV. L. REV. 193 (1890).

²⁹ See *id.* at 196.

³⁰ See *id.* at 213.

³¹ MCCARTHY, *supra* note 1, § 1:17.

³² See *id.* § 1:16.

³³ See *id.* § 1:7.

³⁴ *Id.*

³⁵ 202 F.2d 866, 868 (2d Cir. 1953).

³⁶ See *id.* at 867.

³⁷ See *id.* at 868-69.

³⁸ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

cause it focused on prevention of feelings of indignity and embarrassment that are often not present in cases involving celebrities.³⁹ He also advanced arguments for why this new right should be an assignable property right, distinguished it from unfair competition law, argued that everyone has a right of publicity, and offered a policy justification for the right.⁴⁰

In 1960, Professor William Prosser wrote another prominent article in which he analyzed privacy law and divided it into four distinct torts: intrusion, disclosure, false light and appropriation.⁴¹ Prosser's article was so influential that the 1977 *Restatement (Second) of Torts* adopted his four categories as an accurate restatement of the law.⁴² There is universal judicial acceptance of Prosser's categorization and some state legislatures have gone so far as to codify his framework in their statutory law.⁴³

The intrusion tort focuses on physical invasion into the plaintiff's private affairs.⁴⁴ The disclosure tort is similar to the privacy interest described by Warren and Brandeis, focusing on the public disclosure of embarrassing private facts.⁴⁵ The false light tort is similar to defamation, focusing on the harm that results from presenting the plaintiff to the public in such a way that the public is likely to have an objectionable misperception of the plaintiff.⁴⁶

Prosser's fourth tort of invasion of privacy by appropriation closely resembles the right of publicity.⁴⁷ It focuses on unauthorized use of the plaintiff's identity for commercial purposes with resultant harm to his or her dignity and peace of mind.⁴⁸ Prosser's appropriation privacy tort differs, however, from the right of publicity in two important ways.⁴⁹ First, the privacy right is a personal interest whereas the publicity right is an assignable property right.⁵⁰ Second, courts measure the harm from appropriation by the degree of affront to the plaintiff's

³⁹ See *id.* at 203-04.

⁴⁰ *Id.* at 216, 217; see *id.* at 210-14, 215-16.

⁴¹ William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960).

⁴² RESTATEMENT (SECOND) OF TORTS §§ 652B-E (1977); see MCCARTHY, *supra* note 1, § 1:24.

⁴³ MCCARTHY, *supra* note 1, § 1:24.

⁴⁴ Prosser, *supra* note 41, at 389-92.

⁴⁵ *Id.* at 392-98.

⁴⁶ *Id.* at 398-401.

⁴⁷ See MCCARTHY, *supra* note 1, § 1:23.

⁴⁸ See Prosser, *supra* note 41, at 401-07.

⁴⁹ See MCCARTHY, *supra* note 1, §§ 5:61, :65.

⁵⁰ *Id.* § 5:65.

dignity and peace of mind, whereas they measure the harm from infringement of the publicity right by the economic value of the unauthorized use.⁵¹

B. Recognition

Over the past twenty-five years, the right of publicity has met with increasing, though not universal, recognition by courts, the bar, members of the legal academy, and state legislatures.⁵² As of March 2002, twenty-eight states had provided their citizens with a remedy for infringement of the right of publicity.⁵³ Eleven states provide only common law protection;⁵⁴ ten states provide only statutory protection;⁵⁵ and seven states provide both.⁵⁶ Courts in New York, Nebraska, and Puerto Rico have held that a common law right of publicity does not exist in those territories.⁵⁷

Even though the right of publicity is currently limited to state law, federal courts have nevertheless contributed to its evolution through the exercise of both their diversity jurisdiction and their supplemental jurisdiction with federal claims (such as those for Lanham Act section 43(a) violations involving false representation or service mark infringement).⁵⁸ Federal courts seem comfortable deciding issues of first impression involving state publicity rights, although state courts have subsequently criticized or overruled some of these decisions.⁵⁹

⁵¹ See *id.* § 5:59.

⁵² See *id.* §§ 1:35, 6:4, 6:7; Zimmerman, *supra* note 1, at 38 n.11.

⁵³ McCARTHY, *supra* note 1, § 6:3.

⁵⁴ *Id.* (Arizona, Alabama, Connecticut, Georgia, Hawaii, Michigan, Minnesota, Missouri, New Jersey, Pennsylvania and Utah).

⁵⁵ *Id.* n.9. (Indiana, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Virginia and Washington). But see Zimmerman, *supra* note 1, at 41 n.19 (asserting that several of these states' statutes create a right more akin to that protected by the privacy attribution tort than to the right of publicity).

⁵⁶ McCARTHY, *supra* note 1, § 6:3 n.8 (California, Florida, Illinois, Kentucky, Ohio, Texas and Wisconsin).

⁵⁷ See *id.* § 6:3.

⁵⁸ See 15 U.S.C. § 1125(a) (2000) (Lanham Act § 43(a)); McCARTHY, *supra* note 1, §§ 6:130, :131. See *infra* text accompanying notes 129–145 for further discussion of the Lanham Act.

⁵⁹ See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397–99 (9th Cir. 1992) (holding that California common law protects plaintiff's "identity" when the state's courts had not interpreted it as broadly); *Ackerman v. Ferry*, No. B143751, 2002 WL 31506931, *17 n.13 (Cal.App. 2 Dist. Nov. 12, 2002) (lamenting that the Ninth Circuit Court of Appeals opinion regarding the scope of California publicity law in *White* revealed almost no analysis, limiting its value in determining legislative intent); *Tennessee ex rel. Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89, 97, 99 (Tenn. Ct. App. 1987) (holding that

In 1977, the United States Supreme Court decided *Zacchini v. Scripps-Howard Broadcasting Co.*, the only case it has heard thus far involving the right of publicity.⁶⁰ A news program televised a videotape of a daredevil's entire fifteen-second performance at a local fair, where he was shot from a cannon.⁶¹ The Ohio Supreme Court had held that the First Amendment protected the telecast.⁶² The United States Supreme Court reversed, holding that the broadcast violated the plaintiff's right of publicity because it contained his entire performance without his consent.⁶³ The Court was concerned that such a use could threaten the plaintiff's ability to earn a living as an entertainer, and reasoned that this concern outweighed the strong First Amendment protection afforded newscasts.⁶⁴ Commentators agree that the Court's ruling was so specific to the facts of the case that it provides minimal guidance for the more common right of publicity case, typically involving use of a likeness in advertising or on merchandise.⁶⁵ But *Zacchini* does denote the Court's recognition of the validity of at least a limited state publicity right.⁶⁶

In 1995, the *Restatement (Third) of Unfair Competition* incorporated the right of publicity in sections 46 through 49.⁶⁷ It uses the phrase "for purposes of trade" to describe the types of uses that trigger infringement.⁶⁸ This phrase presumably covers use in advertising, on products, or in association with services.⁶⁹

Tennessee common law recognizes a post-mortem right of publicity, overruling a 1980 Sixth Circuit Court of Appeals decision). The author has been unable to locate any case where a federal court has certified a novel question of state right of publicity law to a state's highest court for resolution. When the Ninth Circuit decided *White*, California had no such certification process in place. See generally Jerome I. Braun, *A Certification Rule for California*, 36 SANTA CLARA L. REV. 935 (1996) (describing certification and proposing such a process for California). The U.S. Supreme Court has urged that lower federal courts strongly consider certification in cases involving state laws whose interpretation is unclear to avoid the potential of a federal court deeming the law unconstitutional due to an overly-broad reading. See *Arizonans for Official English v. Arizona*, 520 U.S. 43, 75-79 (1997).

⁶⁰ 433 U.S. 562 (1977).

⁶¹ *Id.* at 563-64.

⁶² *Id.* at 565.

⁶³ See *id.* at 575.

⁶⁴ See *id.* at 575-76, 578-79.

⁶⁵ See, e.g., *McCarthy*, *supra* note 1, § 8:27; Zimmerman, *supra* note 1, at 49-50.

⁶⁶ See, e.g., *Zacchini*, 433 U.S. at 577; *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1109-10 (9th Cir. 1992).

⁶⁷ RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46-49 (1995).

⁶⁸ *Id.* § 46.

⁶⁹ See *McCarthy*, *supra* note 1, § 1:35.

The American Bar Association has formulated a model statute that, if enacted, would create a federal right of publicity.⁷⁰ A federal right could address some of the problems inherent in a right of publicity derived from state law.⁷¹ Such problems include idiosyncrasies in the protection offered by different states under common or statutory law, questions of which state's law controls a controversy and the potential for plaintiffs to engage in forum shopping to maximize their rights.⁷² The statute could also resolve some of the concerns this Note explores regarding the constitutionality of state publicity laws under the Commerce, Full Faith and Credit, and Due Process Clauses.⁷³

C. *Infringing and Non-infringing Uses*

Infringement of the right of publicity occurs when one makes commercial use of another's identity without permission.⁷⁴ To establish a *prima facie* case of infringement, the plaintiff must satisfy several elements that can vary from state to state.⁷⁵ These elements typically include a showing that the complained-of use is commercial, that it is unauthorized, that it identifies the plaintiff, and that it is likely to harm the economic value of the plaintiff's identity.⁷⁶

The clearest cases of infringement occur when the defendant uses plaintiff's identity in an advertisement for its goods or services without permission.⁷⁷ Use of plaintiff's identity on merchandise or in connection with a service may also satisfy the commercial use element.⁷⁸ Because infringement requires that the plaintiff be identifiable from defendant's unauthorized use, courts have often found infringement where the defendant used elements of a plaintiff's persona other than actual name or likeness.⁷⁹ Uses that approximate a plaintiff's distinc-

⁷⁰ See Zimmerman, *supra* note 1, at 38 n.11.

⁷¹ See *id.*

⁷² See, e.g., MCCARTHY, *supra* note 1, § 11:8; Richard S. Robinson, *Preemption, The Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183, 201-07 (1998); Melinda R. Eades, Note, *Choice of Law and the Right of Publicity: Domicile as an Essential First Step*, 66 BROOK. L. REV. 1301 *passim* (2001) (arguing that the law of plaintiff's place of domicile should first determine the existence of the right, then a second state's law may determine its scope).

⁷³ See *infra* notes 269-330 and accompanying text.

⁷⁴ See MCCARTHY, *supra* note 1, at v.

⁷⁵ See *id.* § 3:2.

⁷⁶ See *id.*

⁷⁷ See *id.* § 7:6.

⁷⁸ MCCARTHY, *supra* note 1, § 7:19. But see Zimmerman, *supra* note 1, at 61-65.

⁷⁹ See MCCARTHY, *supra* note 1, § 4:45.

tive voice, performing style, catch phrase, name, nickname, appearance, fictional characterization, or objects or settings closely associated with the plaintiff have all been sufficient for a finding of infringement.⁸⁰

In contrast, one can freely make unauthorized non-commercial uses of another's identity because such uses do not implicate the right of publicity, which is limited to controlling "commercial uses".⁸¹ Permitted non-commercial uses typically include use of a person's identity in news reports, entertainment, commentary, or literary works (both fiction and non-fiction).⁸² Some limited categories of use, although commercial, do not infringe on the right of publicity because of their incidental nature.⁸³ For example, an advertisement for a music magazine that features covers of back issues where the musicians that appeared on the covers are identifiable would not typically infringe on those musicians' publicity rights.⁸⁴ Courts may also permit uses that are fleeting or insignificant, such as where a full-length film shows one's face for a few seconds.⁸⁵

D. *Tension with the First Amendment*

The First Amendment to the Constitution provides in pertinent part that "Congress shall make no law . . . abridging the freedom of speech"⁸⁶ The right of publicity's restriction on the unauthorized commercial use of one's identity prohibits certain forms of expression; it therefore potentially conflicts with the freedom of speech the First Amendment seeks to protect.⁸⁷

Courts apply a balancing test to determine whether the First Amendment preempts the right of publicity where the unauthorized use is commercial, such as in an advertisement or on actual merchan-

⁸⁰ See *id.*

⁸¹ See *id.* § 1:35.

⁸² See *id.*

⁸³ See *id.* § 7:13.

⁸⁴ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. a (1995) ("A magazine soliciting subscriptions . . . may refer to a past article about a particular celebrity as an illustration of the magazine's customary content."); MCCARTHY, *supra* note 1, § 7:13-15.

⁸⁵ See, e.g., *Preston v. Martin Bregman Prods., Inc.*, 765 F. Supp. 116, 118-19 (S.D.N.Y. 1991); MCCARTHY, *supra* note 1, § 7:18.

⁸⁶ U.S. CONST. amend. I. The Fourteenth Amendment makes this prohibition applicable to the States as well. See *Palko v. Connecticut*, 302 U.S. 319, 326-27 (1937).

⁸⁷ See, e.g., *Cartoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970-72 (10th Cir. 1996); Zimmerman, *supra* note 5, at 295.

dise.⁸⁸ The degree of protection the First Amendment provides in any given circumstance will depend on the content of the challenged speech and the countervailing interest asserted.⁸⁹ The First Amendment may preempt the right of publicity in uses that enjoy the higher levels of First Amendment protection, such as those a court classifies as informing or entertaining.⁹⁰ Entertainers, for example, should typically be able to mimic or parody the distinctive identities of other performers, because First Amendment considerations predominate in such instances of pure entertainment.⁹¹

Such preemption may not take place, however, in uses that a court classifies as commercial speech because the Constitution gives more attenuated protection to such speech.⁹² In such cases, the commercial speech doctrine might not immunize a use that infringes on the right of publicity.⁹³ Courts have typically refused to protect a vendor's unauthorized use of a plaintiff's identity on T-shirts, coffee mugs, lunch boxes, dartboards, playing cards, and the like.⁹⁴ Courts are reluctant to extend free speech protection to such objects because speakers usually do not choose them as media to convey their socially significant speech.⁹⁵ Such objects serve other intrinsic functions, whereas traditional communicative media such as newspapers, magazines, books, and movies do not.⁹⁶

Other commentators argue that the buyer of such objects is a speaker and the seller's effort to facilitate the buyer's speech should therefore warrant protection.⁹⁷ Courts would likely credit this argument to protect political speech, which is entitled to the highest level of constitutional protection, because one who enters into the political arena essentially waives much of her rights of publicity and privacy.⁹⁸ The defendant in such a case, however, is a step removed from the individual whose speech is entitled to protection; the plaintiff's interest is not usually to stifle speech but to be paid for the use of her iden-

⁸⁸ *Cardtoons*, 95 F.3d at 970-72; see McCARTHY, *supra* note 1, § 7:3 at 7-4.

⁸⁹ See McCARTHY, *supra* note 1, § 8:12.

⁹⁰ See *id.* § 7:3.

⁹¹ See *id.* § 8:111.

⁹² See *id.* § 7:3.

⁹³ *Id.* § 8:17.

⁹⁴ See McCARTHY, *supra* note 1, § 7:23.

⁹⁵ See *id.* §§ 7:22, :23.

⁹⁶ See *id.*

⁹⁷ See *id.* § 7:21; Zimmerman, *supra* note 5, at 300.

⁹⁸ See McCARTHY, *supra* note 1, § 7:21.

tity; and any such speech is symbolic and therefore entitled to less protection than pure speech.⁹⁹ All of these factors may make a court less willing to preempt the plaintiff's right of publicity in cases not involving political messages.¹⁰⁰

Property rights arising from the right of publicity also typically outweigh the claim to free speech in cases where the defendant uses the plaintiff's identity as the vehicle to attract attention to its news or entertainment message.¹⁰¹ As the First Amendment also gives individuals the right not to speak, a plaintiff may assert his or her right of publicity to prevent others from using the plaintiff's property as a vehicle for conveying their views if alternative methods of communication exist.¹⁰²

E. Remedies

Plaintiffs can generally obtain injunctive relief enjoining defendants from any further unauthorized use of their identities.¹⁰³ To recover monetary damages, however, a plaintiff must establish and quantify the economic damage from the use.¹⁰⁴ If, for example, the defendant used the plaintiff's image without permission in an advertisement, one measure of damages would be what the defendant would likely have had to pay to entice the plaintiff (or someone whose identity had similar commercial value) to appear in the advertisement.¹⁰⁵ Another possible measure of damages is the resultant loss of economic value of the plaintiff's identity.¹⁰⁶ This could occur, for example, if the complained-of use resulted in a reduced demand for plaintiff's services.¹⁰⁷ In cases of willful infringement, such as where the defendant knew the plaintiff abhorred celebrity endorsements

⁹⁹ *See id.*

¹⁰⁰ *See id.*

¹⁰¹ *Id.* § 8:32 at 8-48.

¹⁰² *See id.* §§ 8:6, :30, :32, :33.

¹⁰³ *McCarthy*, *supra* note 1, § 11:21.

¹⁰⁴ *See id.* § 3:2.

¹⁰⁵ *See id.* § 11:32.

¹⁰⁶ *See id.* § 11:33.

¹⁰⁷ *See id.* For example, suppose Rawlings ran an unauthorized advertisement for its baseball gloves featuring Boston Red Sox shortstop Nomar Garciaparra. Because of this use, Garciaparra might be unable to convince Wilson to hire him to promote its baseball gloves. A reasonable measure of the damages in this scenario, then, might be the going price of a long-term endorsement contract between a baseball player with Garciaparra's All-star status and a baseball glove company. *See id.*

but used the plaintiff's identity in its advertising anyway, juries have awarded, and courts have upheld, substantial punitive damages.¹⁰⁸

F. Policy Justifications

Commentators have advanced several public policy reasons to recognize a right of publicity.¹⁰⁹ These include justifications based on natural rights and fairness, incentives, economic efficiency, and preventing deception.¹¹⁰

First, some consider the right of publicity to be a self-evident property right in one's own identity.¹¹¹ To them, the statement "my identity is *mine*—it is my property, to control as I see fit" is intuitive.¹¹² The right of publicity prevents others from unjustly free riding and benefiting economically from the value one has built up in one's own identity.¹¹³

There is also an incentive justification for the right of publicity.¹¹⁴ This rationale asserts that giving individuals the exclusive right to capitalize on the economic value they build up in their identity encourages them to invest in developing their skills and talents.¹¹⁵ Such investment results in socially desirable behavior, leading to a richer society.¹¹⁶

Some commentators also offer an economic efficiency theory to justify the right of publicity.¹¹⁷ They argue that making an individual the sole arbiter of how and when commercially to use his or her identity helps maximize its economic value.¹¹⁸ If anyone who wants to use the identity can do so at will, such use may dilute any cachet associated with the identity, resulting in a loss of economic value.¹¹⁹ Granting property rights results in efficient allocation of scarce resources

¹⁰⁸ E.g., *Waits*, 978 F.2d at 1104-06 (affirming \$2 million in punitive damages).

¹⁰⁹ See MCCARTHY, *supra* note 1, §§ 2:1-8; see also Madow, *supra* note 5, at 178-240 (describing and critiquing such justifications at length).

¹¹⁰ See MCCARTHY, *supra* note 1, §§ 2:6-8.

¹¹¹ See *id.* § 2:2.

¹¹² *Id.* § 2:1.

¹¹³ See *id.* § 2:2.

¹¹⁴ See *id.* § 2:6.

¹¹⁵ See MCCARTHY, *supra* note 1, § 2:6.

¹¹⁶ See *id.*

¹¹⁷ See *id.* § 2:7.

¹¹⁸ See *id.*

¹¹⁹ See *id.*

and helps ensure that the resource goes to the highest and best use.¹²⁰ Commentators contend the personal property right thus avoids the tragedy of the commons problem of public ownership.¹²¹

A final justification is that assigning property rights in one's identity can help prevent deceptive commercial uses.¹²² This argument provides only modest justification, however, because one can infringe the right of publicity without any use of deception.¹²³ The Lanham Act also already protects against deceptive commercial uses.¹²⁴

G. Comparison with Copyright and Trademark Law

The right of publicity differs in important ways from other intellectual property rights such as copyright and trademark.¹²⁵ For example, a primary distinction between the right of publicity and copyright is that the latter covers "original works of authorship fixed in any tangible medium of expression."¹²⁶ The right of publicity protects one's identity in any form, not just a fixed manifestation of it, such as in a copyrightable photograph.¹²⁷ Personal identity is also outside the statutory subject matter of copyright.¹²⁸

The right of publicity also differs from rights granted under trademark law.¹²⁹ Trademark law, embodied in the Lanham Act, promotes designation of source as a method of preventing consumer confusion and encouraging quality control.¹³⁰ To prove trademark infringement a plaintiff must demonstrate likelihood of confusion.¹³¹ Although certain uses of an individual's identity may confuse consumers as to whether the individual is endorsing a product, an adver-

¹²⁰ See MCCARTHY, *supra* note 1, § 2:7.

¹²¹ See *id.* The tragedy of the commons occurs when individuals waste public goods in a mad dash to consume them before others do; private ownership can lead to more sensible and efficient utilization. See generally Garrett Hardin, *The Tragedy of the Commons*, 162 SCIENCE 1234 (1968).

¹²² MCCARTHY, *supra* note 1, § 2:8.

¹²³ See, e.g., *Cartoons*, 95 F.3d at 975; MCCARTHY, *supra* note 1, § 2:8.

¹²⁴ See, e.g., *Cartoons*, 95 F.3d at 975; MCCARTHY, *supra* note 1, § 2:8.

¹²⁵ See MCCARTHY, *supra* note 1, § 1:3.

¹²⁶ 17 U.S.C. § 102(a); see MCCARTHY, *supra* note 1, § 5:37.

¹²⁷ See MCCARTHY, *supra* note 1, § 5:41.

¹²⁸ *Id.* §§ 1:35, 5:41.

¹²⁹ See *id.* § 1:3.

¹³⁰ See MCCARTHY, *supra* note 1, § 5:6.

¹³¹ *Id.* § 5:11.

tiser can infringe an individual's right of publicity even when it is obvious that the individual is not endorsing the product.¹³²

The right of publicity is similar in several ways to laws protecting against the dilution of trademarks.¹³³ Both are creatures of state law meant to protect intellectual property rights.¹³⁴ Like intellectual property laws in general, both are subject to limits imposed by the First Amendment.¹³⁵ Both also serve to protect goodwill and commercial value built up in the property against commercial uses that may lessen the property's future value.¹³⁶ The state law in both cases represents a patchwork resulting from differing policy decisions of the states, with some states refusing to recognize one or both of the doctrines and often-considerable discrepancies between the laws of any two states.¹³⁷

The two doctrines also differ in significant ways. First, trademark dilution has already made the leap from state law to federal law with the enactment of the Federal Trademark Dilution Act of 1995 (FTDA), which did not explicitly preempt the state laws.¹³⁸ Second, the FTDA and state dilution statutes require a mark to be famous to be entitled to dilution protection, whereas in many states even non-celebrities have publicity rights.¹³⁹ Hence, large, national or international companies use the FTDA to protect against dilutive uses that are often local in scope.¹⁴⁰ In contrast, individuals typically seek protection for infringement of their publicity rights against large, na-

¹³² See *id.*

¹³³ See, e.g., Kristine M. Boylan, *The Corporate Right of Publicity in Federal Dilution Legislation*, Part II, 82 J. PAT. & TRADEMARK OFF. SOC'Y 5, 32 (2000) ("[T]he best analogy between trademark dilution and accepted, existing law rests with the right of publicity."). See generally Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291 (2003).

¹³⁴ See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:67 (4th ed. rev. Mar. 2003).

¹³⁵ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-01 (9th Cir. 2002); *supra* notes 86-102 and accompanying text.

¹³⁶ See 4 MCCARTHY, *supra* note 134, § 24:71.

¹³⁷ See, e.g., *id.* §§ 24:75, :77-82; MCCARTHY, *supra* note 1, §§ 6:3, :8.

¹³⁸ 15 U.S.C. §§ 1125(c), 1127 (2000) (Lanham Act §§ 43(c), 45); see 4 MCCARTHY, *supra* note 134, §§ 24:82-83, :90. For a brief history of dilution law leading up to the enactment of the FTDA, see *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1122-23 (2003).

¹³⁹ See 4 MCCARTHY, *supra* note 134, § 24:81. *But cf. id.* § 24:90 (noting that a trademark dilution defendant's use must be in interstate commerce).

¹⁴⁰ See, e.g., *Moseley*, 123 S. Ct. at 1119 (national lingerie retailer claiming trademark dilution against owners of an adult novelty store named "Victor's Secret" located in a Kentucky strip mall); 4 MCCARTHY, *supra* note 134, § 24:68.

tional or international companies.¹⁴¹ The typical dilution case pits a plaintiff operating on a broader scale against a defendant operating on a narrower scale; the typical publicity rights case has the opposite profile.¹⁴² Third, the primary justification for trademark law is preventing consumer confusion whereas the right of publicity focuses on protecting an individual's property rights.¹⁴³ Fourth, compensatory damages are generally available to publicity rights plaintiffs whereas monetary damages are available under the FTDA only upon a finding of willfulness.¹⁴⁴ Despite these differences, and because of the similarities, this Note examines trademark dilution case law to supplement the somewhat meager case law in the latter area, because some dilution cases address issues identical to those raised by the right of publicity.¹⁴⁵

H. Criticism

The most common criticism of an expansive right of publicity is that it is an unjustifiable restriction on free speech under the First Amendment.¹⁴⁶ Critics assert that celebrities serve as valuable cultural touchstones that anyone should be free to use in formulating expressive speech.¹⁴⁷ There must therefore be a substantial policy reason, they argue, to remove celebrity personas from the public domain.¹⁴⁸ Critics find the policy reasons offered for the right of publicity not compelling enough to justify the limitations on freedom of speech imposed by the right.¹⁴⁹

A second common criticism of the right of publicity is that it can interfere with federal rights granted under the Copyright Act.¹⁵⁰ Crit-

¹⁴¹ See, e.g., *Waits*, 978 F.2d 1093 (singer suing international snack foods company); *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (actors suing international concessionaire).

¹⁴² Compare *Hyatt Corp. v. Hyatt Legal Servs.*, 610 F. Supp. 381 (N.D. Ill. 1985) (international hotel chain claiming trademark dilution against a regional legal services firm), with *White*, 971 F.2d 1395 (game show hostess claiming right of publicity infringement against international electronics corporation).

¹⁴³ See *McCarthy*, *supra* note 1, § 5:6.

¹⁴⁴ See 4 *McCarthy*, *supra* note 134, § 24:99.

¹⁴⁵ See *infra* notes 255-268 and accompanying text.

¹⁴⁶ See, e.g., *Madow*, *supra* note 5, at 134; *Zimmerman*, *supra* note 5, at 292-94.

¹⁴⁷ See, e.g., *Madow*, *supra* note 5, at 142-47.

¹⁴⁸ See, e.g., *Madow*, *supra* note 5, at 134; *Zimmerman*, *supra* note 5, at 313.

¹⁴⁹ See, e.g., *Cardtoons*, 95 F.3d at 976; *Madow*, *supra* note 5, at 238-40; *Zimmerman*, *supra* note 5, at 313.

¹⁵⁰ See *infra* notes 196, 207-210 and accompanying text.

ics argue that federal copyrights should preempt publicity rights arising under state law in cases where the two conflict.¹⁵¹ Any other result, critics also assert, would permit states to interfere with the federal copyright system (over which the Constitution grants Congress exclusive authority) thereby violating the dormant Copyright Clause.¹⁵²

II. THE CONSTITUTION AND THE RIGHT OF PUBLICITY

Under the Supremacy Clause of the United States Constitution, a federal law preempts any state law that conflicts with it, rendering the state law void.¹⁵³ In addition to statutes passed by Congress, federal law includes the provisions of the Constitution itself.¹⁵⁴ This Section examines case law, involving the right of publicity and related commercial torts, to identify constitutional limits that may apply to the right of publicity under state law.¹⁵⁵

A. First Amendment Claims

In 1996, the United States Court of Appeals for the Tenth Circuit case of *Cardtoons, L.C. v. Major League Baseball Players Ass'n* illustrated some of the First Amendment concerns raised by the right of publicity and called into question the justifications for the right.¹⁵⁶ The court's analysis is also applicable to other constitutional issues, which are the principal focus of this Note.¹⁵⁷ In that case, the Tenth Circuit held that *Cardtoons'* First Amendment right to parody baseball players outweighed those players' rights under Oklahoma law.¹⁵⁸ *Cardtoons* sought declaratory judgment that its baseball cards portraying caricatures of major league baseball players and poking fun at their various excesses did not infringe on the players' publicity rights, which the players had assigned to the Major League Baseball Players Association

¹⁵¹ See, e.g., *Baltimore Orioles*, 805 F.2d at 676; *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting).

¹⁵² See, e.g., *Wendt*, 197 F.3d at 1288 (Kozinsky, J., dissenting) ("[A] broad reading of the state right of publicity runs afoul of the dormant Copyright Clause, which preempts state intellectual property laws to the extent they 'prejudice the interests of other States.'" (quoting *Goldstein v. California*, 412 U.S. 546, 558 (1973))); Eades, *supra* note 72, at 1328.

¹⁵³ 1 LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 6-29 (3d ed. 2000).

¹⁵⁴ See *id.* § 6-1.

¹⁵⁵ See *infra* notes 156-268 and accompanying text.

¹⁵⁶ 95 F.3d 959, 976 (10th Cir. 1996); see *supra* notes 109-124 and accompanying text.

¹⁵⁷ See *id.* at 973-76; *infra* text accompanying notes 271-289.

¹⁵⁸ *Id.* at 976.

(MLBPA).¹⁵⁹ The court noted that neither of the First Amendment accommodations in Oklahoma's statute, one for news, the other for uses not directly connected with commercial sponsorship or advertising, applied to Cardtoons' use.¹⁶⁰ It stressed, however, that Cardtoons' speech in this case was entitled to full protection under the First Amendment because it provided "commentary on an important social institution."¹⁶¹ Because the court also held that Cardtoons had infringed on the players' statutory publicity rights, it proceeded to "balance the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property right" to determine which prevailed.¹⁶²

The Tenth Circuit examined each of the common justifications for the right of publicity and found them not to be strong enough, independently or as a group, to justify the speech restriction in this case.¹⁶³ In examining the incentive justification, the court reasoned that "the additional inducement for achievement produced by publicity rights are [sic] often inconsequential because most celebrities with valuable commercial identities are already handsomely compensated."¹⁶⁴ The court reasoned that the efficient allocation of resources justification is not persuasive in non-advertising uses involving parody because celebrities would likely use their control over use of their identities to suppress criticism.¹⁶⁵ The court reasoned that the prevention of consumer deception justification was without merit because the Lanham Act provides for such protection and Cardtoons' cards were not likely to deceive consumers anyway.¹⁶⁶ The court summarily rejected the natural rights justification, remarking, "blind appeals to first principles carry no weight in our balancing analysis."¹⁶⁷ The court then considered the just deserts justification, noted that celebrities "are often not fully responsible for their fame," pointed out that the players in this case were being parodied for socially undesirable behavior and concluded, "there is little right to enjoy [such] fruits."¹⁶⁸

¹⁵⁹ *Id.* at 962-63.

¹⁶⁰ *Id.* at 968.

¹⁶¹ *See Cardtoons*, 95 F.3d at 969.

¹⁶² *Id.* at 972.

¹⁶³ *See id.* at 973-76.

¹⁶⁴ *Id.* at 974.

¹⁶⁵ *Id.* at 975.

¹⁶⁶ *Cardtoons*, 95 F.3d at 975.

¹⁶⁷ *Id.*

¹⁶⁸ *See id.* at 975-76.

The court considered the related justification of preventing unjust enrichment (free riding), but decided such a concern was inapplicable because Cardtoons "added a significant creative component of its own to the celebrity identity and created an entirely new product."¹⁶⁹ Finally, the court examined the prevention of emotional injury justification and reasoned that both the Lanham Act and intentional infliction of emotional distress laws adequately protected against such mental anguish.¹⁷⁰ The court concluded that "the effect of limiting MLBPA's right of publicity in this case is negligible" and that "the justifications for the right of publicity are not nearly as compelling as those offered for other forms of intellectual property, and are particularly unpersuasive in the case of celebrity parodies."¹⁷¹ Accordingly, the court affirmed the district court's finding that Cardtoons' First Amendment right to free expression outweighed MLBPA's right of publicity.¹⁷²

B. *Suggestions of Other Constitutional Claims*

The United State Supreme Court has construed several provisions of the Constitution, including the Commerce,¹⁷³ Copyright,¹⁷⁴ and Due Process¹⁷⁵ Clauses as imposing specific limits on each state's ability to regulate activities that take place outside its borders.¹⁷⁶ These restraints maintain the federal nature of the United States government, in which each state retains sovereignty over matters that it has not specifically delegated to the federal government through its ratification of the Constitution.¹⁷⁷

¹⁶⁹ See *id.* at 976.

¹⁷⁰ See *id.*

¹⁷¹ *Cardtoons*, 95 F.3d at 976.

¹⁷² *Id.* at 962.

¹⁷³ U.S. CONST. art. I, § 8, cl. 3 (the Commerce Clause gives Congress the power "[t]o regulate Commerce . . . among the several States . . .").

¹⁷⁴ *Id.* cl. 8 (the Copyright Clause gives Congress the power "[t]o promote the Progress of . . . useful Arts, by securing for limited Times to Authors. . . the exclusive Right to their respective Writings . . .").

¹⁷⁵ *Id.* amend. XIV, § 1 (the Due Process Clause requires that "[no] State [shall] . . . deprive any person of life, liberty, or property, without due process of law . . .").

¹⁷⁶ *BMW of N. Am., Inc. v. Gore*, 517 U.S. 559, 585-86 (1996) (Due Process); *Kassel v. Consol. Freightways*, 450 U.S. 662, 678-79 (1981) (Commerce Clause); *Goldstein v. California*, 412 U.S. 546, 559 (1973) (Copyright Clause).

¹⁷⁷ See U.S. CONST. amend. X ("The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people."); *BMW*, 517 U.S. at 571 n.16 (1996) ("States are restricted within the orbits of their lawful authority and upon the preservation of which the Government under the

The United States Supreme Court has also ruled that vague laws offend the Due Process Clause.¹⁷⁸ A law is vague, and therefore void, if people "of common intelligence must necessarily guess at its meaning and differ as to its application."¹⁷⁹ A law that does not clearly define the acts it prohibits "impermissibly delegates basic policy matters to . . . judges . . . and juries for resolution on an ad hoc and subjective basis, with the attendant dangers of arbitrary and discriminatory application" and "may trap the innocent by not providing fair warning."¹⁸⁰

The remainder of this Section examines case law that further illuminates these concerns in the context of the right of publicity and other state law commercial torts.¹⁸¹

1. Dormant Commerce Clause

The United States Court of Appeals for the Ninth Circuit, dubbed the "Hollywood Circuit"¹⁸² because its jurisdiction includes California, has had several occasions to construe California publicity rights law and examine its conformance with constitutional principles.¹⁸³ Some of these cases suggest that the right of publicity may be subject to constraints under the dormant Commerce Clause as well as other constitutional provisions.¹⁸⁴ In 1992, in *White v. Samsung Electronics America, Inc.*, a court panel held that California's common law right of publicity gives a cause of action against a defendant's commercial use of any

Constitution depends." (quoting *Huntington v. Attrill*, 146 U.S. 657, 669 (1892)); *TRIBE*, *supra* note 153, § 6-1.

¹⁷⁸ See *Connally v. Gen. Constr. Co.*, 269 U.S. 385, 390, 395 (1926); *supra* note 175 (Due Process Clause); see also *Hill v. Colorado*, 530 U.S. 703, 732 (2000) (stating that a statute is unconstitutionally vague "if it fails to provide people of ordinary intelligence a reasonable opportunity to understand what conduct it prohibits.")

¹⁷⁹ *Connally*, 269 U.S. at 391.

¹⁸⁰ *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972).

¹⁸¹ Although each of this section's cases suggests more than a single constitutional claim, it summarizes each case under the subpart heading corresponding to one of the constitutional issue it raises purely for organizational purposes.

¹⁸² *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (denial of motion for rehearing) (Kozinski, J., dissenting).

¹⁸³ E.g., *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001); *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284 (9th Cir. 1999); *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

¹⁸⁴ See *Wendt*, 197 F.3d at 1288 (Kozinski, J., dissenting); *White*, 989 F.2d at 1518-19 (Kozinski, J., dissenting).

set of a plaintiff's characteristics sufficient to evoke the plaintiff's identity.¹⁸⁵ Vanna White, who had achieved fame for her role as the letter-turner for the game show *Wheel of Fortune*, complained about a print advertisement Samsung was using to promote its electronics products.¹⁸⁶ The advertisement, one of a series that made improbable but humorous predictions of the cultural landscape circa 2010, featured a robot wearing a blond wig, jewelry, a formal dress, and pointing to letters on a set reminiscent of *Wheel of Fortune*.¹⁸⁷ The advertising copy suggested that, although many things would likely change in the future, Samsung's products would keep running.¹⁸⁸ The United States District Court for the Central District of California granted summary judgment in Samsung's favor on White's common law and statutory right of publicity claims, finding that the advertisement did not include White's "likeness," a required element of California's right of publicity statute.¹⁸⁹ On appeal, the Ninth Circuit panel affirmed the district court's finding on the statutory claim, but reversed and remanded for trial on the issue of whether White had a claim under California common law.¹⁹⁰ The court devised that California's common law right of publicity is not limited to protecting against use of any enumerated set of a plaintiff's characteristics, but instead protects any use of one's identity that causes the audience to think of him or her.¹⁹¹

Samsung petitioned for an *en banc* rehearing.¹⁹² Although both the panel and full court declined to rehear the case, Judge Alex Kozinski, joined by Judges O'Scannlain and Kleinfeld, issued a vigorous dissent in which he attacked the panel's holding on several grounds.¹⁹³ Much of the dissent focused on the need to balance publicity rights against free speech rights granted by the First Amendment and argued that the panel had not properly done so here.¹⁹⁴ The dissent, however, also suggested that such a broad right of publicity of-

¹⁸⁵ 971 F.2d at 1398, 1399, 1402.

¹⁸⁶ *Id.* at 1396.

¹⁸⁷ *Id.* at 1396, 1399.

¹⁸⁸ *See id.* at 1396.

¹⁸⁹ *Id.* at 1397.

¹⁹⁰ *White*, 971 F.2d at 1397, 1399, 1402.

¹⁹¹ *See id.* at 1398-99.

¹⁹² 989 F.2d at 1512.

¹⁹³ *See id.* at 1512-22 (Kozinski, J., dissenting).

¹⁹⁴ *See id.* at 1512-17, 1519-21 (Kozinski, J., dissenting).

fends more of the Constitution than just the First Amendment.¹⁹⁵ Invoking the dormant Copyright Clause, Kozinski noted that the Supreme Court has held that "state intellectual property laws can stand only so long as they don't 'prejudice the interests of other States.'"¹⁹⁶ Kozinski asserted that an out-of-state advertiser would be subject to the publicity law of a plaintiff's domicile state even if the advertiser took care not to display the complained-of advertisement there because "[a] right of publicity created by one state applies to conduct everywhere."¹⁹⁷ Kozinski continued:

The broader and more ill-defined one state's right of publicity, the more it interferes with the legitimate interests of other states. A limited right that applies to unauthorized use of name and likeness probably does not run afoul of the Copyright Clause, but the majority's protection of "identity" is quite another story.¹⁹⁸

He also complained that the panel failed to analyze whether the restriction it was divining from the common law was "unconstitutionally vague," suggesting it may not have sufficiently defined "identity" so as to satisfy the requirements of due process.¹⁹⁹

Judge Kozinski found himself dissenting again seven years later when a majority of his colleagues on the Ninth Circuit refused to revisit the panel decision in *Wendt v. Host International, Inc.* in 1999.²⁰⁰ The case involved "[r]obots again," this time animatronic figures sit-

¹⁹⁵ See *id.* at 1517-19 (Kozinski, J., dissenting).

¹⁹⁶ *Id.* at 1518 (Kozinski, J., dissenting) (quoting *Goldstein v. California*, 412 U.S. 546, 558 (1973)).

¹⁹⁷ See *White*, 989 F.2d at 1518 (Kozinski, J., dissenting).

¹⁹⁸ *Id.* at 1519 (Kozinski, J., dissenting).

¹⁹⁹ See *id.* at 1519-20 & n.35 (Kozinski, J., dissenting) (citing *Posada de P.R. Assocs. v. Tourism Co.*, 478 U.S. 328, 347 (1986)). The Supreme Court has repeatedly applied the void-for-vagueness doctrine with stricter scrutiny to laws that threaten First Amendment freedoms. See, e.g., *Coates v. Cincinnati*, 402 U.S. 611, 614 (1971) (ordinance was "unconstitutionally vague because it subjects the exercise of the right of assembly to an unascertainable standard"); *Smith v. California*, 361 U.S. 147, 151 (1959) ("[S]tricter standards of permissible statutory vagueness may be applied to a statute having a potentially inhibiting effect on speech; a man may the less be required to act at his peril here, because the free dissemination of ideas may be the loser."); *Winters v. New York*, 333 U.S. 507, 509 (1948) ("It is settled that a statute so vague and indefinite, in form and as interpreted, as to permit within the scope of its language the punishment of incidents fairly within the protection of the guarantee of free speech is void, on its face, as contrary to the Fourteenth Amendment.");

²⁰⁰ 125 F.3d 806 (9th Cir. 1997), *reh'g denied*, 197 F.3d 1284 (1999) (Kozinski, J., dissenting).

ting at defendant's *Cheers*-themed airport bars.²⁰¹ Host had obtained a license for this use from Paramount, which owned the copyright to the *Cheers* television series.²⁰² To make the bars more inviting, Host decided to create figures that evoked show characters Norm (an overweight and underemployed accountant) and Cliff (a know-it-all postal worker) by making one fat and dressing the other as a mail carrier.²⁰³ Although the figures' faces did not look like the actors who played Norm and Cliff, the actors objected, claiming that Host had infringed their rights of publicity.²⁰⁴ The district court granted summary for the defendants, finding that the robots did not resemble the plaintiffs.²⁰⁵ Relying on *White*, a Ninth Circuit panel reversed, holding that the case presented a jury question as to whether the robots were sufficiently "like" the plaintiffs as to violate their publicity rights.²⁰⁶

Judge Kozinski's dissent, joined this time by Judges Kleinfeld and Tashima, reiterated many of the concerns he expressed in *White*, although he seemed even more disturbed by this case because Host had acquired a license to use the *Cheers* copyrights.²⁰⁷ Kozinski argued that these rights, granted by the federal Copyright Act, should preempt whatever publicity rights the plaintiffs have under the facts of this case.²⁰⁸ He also pointed out that the court's decision put it in conflict with the Seventh Circuit, which had held that the Copyright Act preempts the right of publicity when the latter would prevent ordinary use of the copyrighted work.²⁰⁹ Kozinski then elaborated on his dormant Copyright Clause concern from *White*, asserting that permitting California's expansive publicity right to set the national standard for permissible use of a licensed derivative work creates a "constitutional conundrum."²¹⁰ He also took the panel to task for applying California's publicity laws to Host's out-of-state activities.²¹¹ Thus, Kozinski

²⁰¹ 197 F.3d at 1285 (Kozinski, J., dissenting).

²⁰² *Id.* (Kozinski, J., dissenting).

²⁰³ *Id.* (Kozinski, J., dissenting).

²⁰⁴ *Id.* (Kozinski, J., dissenting).

²⁰⁵ *Id.* (Kozinski, J., dissenting).

²⁰⁶ *Wendt*, 197 F.3d at 1285-86 (Kozinski, J., dissenting).

²⁰⁷ *See id.* at 1286-87 (Kozinski, J., dissenting).

²⁰⁸ *Id.* at 1285-87 (Kozinski, J., dissenting).

²⁰⁹ *Id.* at 1287 (Kozinski, J., dissenting) (discussing *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986)).

²¹⁰ *See id.* at 1288 (Kozinski, J., dissenting).

²¹¹ *Wendt*, 197 F.3d at 1288 (Kozinski, J., dissenting).

suggested a potential Commerce Clause violation might exist when a state applies its anomalous laws extraterritorially.²¹²

2. Due Process Clause

The United States Supreme Court's recent Due Process jurisprudence suggests yet another potential constitutional limit on the scope of the right of publicity.²¹³ In 1996, the Court addressed Due Process and Commerce Clause concerns that can arise in cases involving state-based right of publicity laws in *BMW of North America, Inc. v. Gore*, although the case involved a different commercial tort.²¹⁴ The plaintiff, Dr. Gore, bought a BMW sedan that an Alabama dealer sold him as new.²¹⁵ Nine months later, he brought it to a detailing shop where one Mr. Slick, the proprietor, told him that someone had previously repainted the car.²¹⁶ The defendant admitted to repainting the car before delivery because acid rain had damaged its finish in transit, but denied that it had a duty to disclose this because it did not consider the fact material and had a nationwide policy of nondisclosure for minor repairs.²¹⁷ Dr. Gore claimed that BMW had a duty to disclose it under Alabama's fraud statute because it reduced the value of his car by about ten percent and was therefore material.²¹⁸ A jury agreed with Dr. Gore, awarding him not only his \$4,000 estimated loss of value but also \$4,000,000 in punitive damages.²¹⁹ BMW sought to have the punitive damages set aside as excessive, arguing that its nondisclosure policy complied with all state laws that set forth disclosure obligations for the automotive industry, which only about half of the states had in place.²²⁰ The strictest of these laws compelled disclosure only when the cost of repair exceeded three percent of the vehicle's sticker price; BMW's cost to repaint Dr. Gore's car did not exceed this limit.²²¹ The jury appeared to have calculated the punitive damages award using the number of vehicles nationwide that BMW had re-

²¹² See *id.* (Kozinski, J., dissenting).

²¹³ See *BMW*, 517 U.S. 559.

²¹⁴ See *id.* at 562, 571-72.

²¹⁵ *Id.* at 563.

²¹⁶ See *id.*

²¹⁷ *Id.* at 563-64.

²¹⁸ *BMW*, 517 U.S. at 563-64.

²¹⁹ *Id.* at 565.

²²⁰ *Id.*

²²¹ *Id.* at 564, 565.

paired without disclosure and sold as new as a multiplier; BMW argued the calculation should have excluded all cars sold in states where its conduct was lawful.²²² The trial judge denied BMW's motion and BMW appealed to the Alabama Supreme Court.²²³ The court affirmed the trial court's finding that the award was not excessive, but ruled that the jury had improperly included sales in other jurisdictions in its calculation.²²⁴ It issued a remittitur reducing the punitive damages award to \$2,000,000 based on its analysis of comparative cases where juries awarded punitive damages for misrepresentation of a vehicle's condition.²²⁵

The United States Supreme Court granted certiorari and declared the \$2,000,000 punitive damages award unconstitutionally excessive, in violation of the Due Process Clause of the Fourteenth Amendment.²²⁶ In reaching its decision, the Court seemed especially concerned that Alabama imposed the penalty to deter BMW's lawful conduct outside of Alabama.²²⁷ It noted that automobile disclosure laws were "a patchwork of rules representing the diverse policy judgments of lawmakers in 50 States" and that, whereas Congress has authority to enact a nationwide disclosure policy, "it is clear that no single State could do so, or even impose its own policy choice on neighboring States."²²⁸ The Court stressed that both the Commerce Clause and the need to respect the interests and policy choices of other states limit a state's power to impose undue burdens on interstate commerce.²²⁹ To remain within these limits, the Court opined, a state must be able to justify the sanctions it imposes by its interest in protecting its own consumers and economy.²³⁰ Hence, it held that Alabama could not punish BMW for conduct that was lawful where it occurred and that did not affect Alabama or its citizens.²³¹ The Court also held that Alabama could not impose sanctions on BMW to deter conduct that is lawful in other jurisdictions, noting that "[t]o punish a person because he has done what the law plainly allows him to do is a due proc-

²²² See *id.* at 567.

²²³ *BMW*, 517 U.S. at 566.

²²⁴ *Id.* at 566-67.

²²⁵ *Id.* at 567.

²²⁶ *Id.* at 568, 574-75.

²²⁷ See *id.* at 572-73.

²²⁸ *BMW*, 517 U.S. at 570, 571.

²²⁹ See *id.* at 571, 572, 585.

²³⁰ *Id.* at 572.

²³¹ *Id.* at 572-73.

ess violation of the most basic sort.²³² The element of surprise involved in this case also troubled the Court, which felt that BMW had reasonably relied on state disclosure statutes in implementing a policy that coincided with the strictest extant statute.²³³ The Court stressed that "[e]lementary notions of fairness enshrined in our constitutional jurisprudence dictate that a person receive fair notice . . . of the conduct that will subject him to punishment" and that the Due Process Clause affords basic protection against judgments without notice in cases involving civil penalties.²³⁴ The Court's opinion makes it clear that a state violates the Due Process Clause when it holds a party liable where that party had no way to know its activities were unlawful.²³⁵ This can result particularly when a court seeks to enforce an anomalous common law whose breadth it had not previously articulated.²³⁶

3. Nationwide Injunctions Based on State Law

Courts have been reluctant to issue nationwide injunctions based on violations of one state's law when the complained-of acts are legal in many other states.²³⁷ Although courts typically opine that their jurisdiction over the parties gives them the power to issue such injunctions, they typically defer to notions of comity when limiting the geographic scope of their injunctions.²³⁸ This begs the question of whether issuing nationwide injunctions in such cases may violate the Due Process, Full Faith and Credit,²³⁹ or Commerce Clauses.²⁴⁰ Enjoining lawful acts in State A based on a ruling that they infringe on rights granted by State B would seem to discredit the laws of State

²³² *Id.* at 573 (quoting *Bordenkircher v. Hayes*, 434 U.S. 357, 363 (1978)).

²³³ See *BMW*, 517 U.S. at 565, 574, 577, 579.

²³⁴ See *id.* at 574 & n.22.

²³⁵ See *id.*

²³⁶ See *id.*

²³⁷ See, e.g., *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 327 (6th Cir. 2001); *Hyatt Corp. v. Hyatt Legal Servs.*, 610 F. Supp. 381, 385 (N.D. Ill. 1985).

²³⁸ See, e.g., *Hyatt*, 610 F. Supp. at 383.

²³⁹ U.S. CONST. art. IV, § 1 ("Full Faith and Credit shall be given in each State to the public Acts, Records, and judicial Proceedings of every other State.").

²⁴⁰ See Paul Heald, Comment, *Unfair Competition and Federal Law: Constitutional Restraints on the Scope of State Law*, 54 U. CHI. L. REV. 1411, 1412 (1987) ("issuing nationwide injunctions after deciding multistate unfair competition actions under the anomalous law of a single state . . . can offend the commerce, due process, and full faith and credit clauses of the Constitution.").

A.²⁴¹ Depending on the acts enjoined, State B's issuance of such injunctions may also impermissibly regulate interstate commerce.²⁴²

In 2001, the United States Court of Appeals for the Sixth Circuit, in *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, faced these issues in deciding the scope of an injunction enjoining acts that infringed on the plaintiff's right of publicity under Michigan common law.²⁴³ The case involved two competing furniture companies selling a "potato chip" lounge chair and ottoman originally designed by Charles and Ray Eames exclusively for Herman Miller, Inc.²⁴⁴ Herman Miller had obtained the Eames's publicity rights from their estate in 1990.²⁴⁵ Palazzetti, a New York corporation with its principal office in New York City, marketed reproductions of popular classic furniture styles and began marketing a reproduction of the Eames-designed lounge chair and ottoman in 1989, identifying it as such in advertisements.²⁴⁶ Herman Miller filed suit in the United States District Court for the Eastern District of Michigan, alleging inter alia that Palazzetti's conduct violated its publicity rights in the Eames name.²⁴⁷ The district court held that Michigan law applied to the claim and devised that its common law recognizes a post-mortem right of publicity even though Michigan courts had yet to determine the more basic issue of whether a right of publicity exists at all under its laws.²⁴⁸ After a trial, the jury returned a verdict against Palazzetti on the right of publicity claim.²⁴⁹ The court then issued a permanent, nationwide injunction enjoining Palazzetti from using the names and likenesses of Charles or Ray Eames in conjunction with its furniture.²⁵⁰

Palazzetti appealed the court's recognition of a post-mortem right of publicity under Michigan law as well as its granting of a nationwide injunction.²⁵¹ The Sixth Circuit affirmed the district court's decision on the descendible right of publicity, reasoning that Michigan's clear recognition of a right to privacy sufficiently supported such a find-

²⁴¹ See David S. Welkowitz, *Preemption, Extraterritoriality, and the Problem of State Antidilution Laws*, 67 TUL. L. REV. 1, 77 (1992).

²⁴² See *id.* at 31.

²⁴³ 270 F.3d 298, 326-27 (6th Cir. 2001).

²⁴⁴ *Id.* at 301-02.

²⁴⁵ *Id.* at 302.

²⁴⁶ *Id.* at 304-05.

²⁴⁷ *Id.* at 306.

²⁴⁸ *Herman Miller*, 270 F.3d at 307.

²⁴⁹ *Id.*

²⁵⁰ *Id.*

²⁵¹ *Id.* at 324, 326.

ing.²⁵² The court, however, held that the district court abused its discretion by granting a nationwide injunction because it effectively forced the right of publicity on states that do not acknowledge it.²⁵³ Reasoning that it would be unfair to enforce Michigan law in states such as New York—Palazzetti's primary place of business—that had explicitly rejected a post-mortem right of publicity, the court excluded such states from the scope of the injunction.²⁵⁴

In 1985, the United States District Court for the Northern District of Illinois in *Hyatt Corp. v. Hyatt Legal Services* expressed significant concern over the constitutionality of issuing a nationwide injunction dictated by the United States Court of Appeals for the Seventh Circuit in its remand instructions.²⁵⁵ The Seventh Circuit had held that the defendant's use of the name "Hyatt" probably violated the Illinois anti-dilution statute and granted an injunction enjoining defendant's use of the name "Hyatt Legal Services."²⁵⁶ Although the district court claimed it had the power to issue a nationwide injunction, it decided that there was "a conflict between an interpretation of the anti-dilution law which allows for a nationwide injunction and the commerce clause of the United States Constitution."²⁵⁷ The court noted that the Supreme Court's Commerce Clause jurisprudence prohibits states from (a) directly regulating interstate commerce and (b) incidentally regulating interstate commerce more than is necessary to further the state's legitimate interests.²⁵⁸ Because "[a]dvertising is an inevitable and often vital aspect of interstate commerce," the court reasoned that an injunction prohibiting advertisements disseminated outside of Illinois and intended for consumers of other states appeared to interfere directly with interstate commerce, thereby run-

²⁵² See *id.* at 324–26.

²⁵³ See *Herman Miller*, 270 F.3d at 327.

²⁵⁴ *Id.* at 326–27.

²⁵⁵ 610 F. Supp. at 385–86.

²⁵⁶ *Id.* at 381. The parties agreed the firm (where defendant Joel Hyatt was a partner) could use the name "J. Hyatt Legal Services," subject to certain safeguards. *Id.* at 381, 382. Although the American Bar Association does not require that firm names include the names of any of their members, it does require that advertisements for legal services include the name of at least one lawyer responsible for the advertisement's content. MODEL RULES OF PROF'L CONDUCT R. 7.2(d), 7.5 cmt. (2001).

²⁵⁷ *Hyatt*, 610 F. Supp. at 383.

²⁵⁸ *Id.* at 383 (citing *Edgar v. MITE Corp.*, 457 U.S.624, 640 (1982)).

ning afoul of the Commerce Clause.²⁵⁹ Even if it considered the effects of the regulation on interstate commerce to be incidental rather than direct, the court reasoned that the Commerce Clause would still forbid a nationwide injunction because the incidental effects of such an injunction outweighed the local interests it sought to protect.²⁶⁰ Particularly troublesome to the court was the prospect of an Illinois statute affecting an Ohio legal office's intrastate marketing of its services to clients in Ohio, a state that had no anti-dilution statute.²⁶¹ That "[t]he rights accorded plaintiff by Illinois are not of a nature commonly recognized elsewhere" and that the "policy decisions respecting scope of protection have differed" in various states also contributed to the court's conclusion.²⁶² The court opined that imposing anomalous Illinois law on "those states that have chosen not to pass such a law, in some cases possibly an explicit choice, or upon those who have interpreted their statute differently, seems anathema to our federal system."²⁶³ Nevertheless, the court was compelled to enter the nationwide injunction because that is what the Seventh Circuit had warranted on remand.²⁶⁴ Citing "the strong possibility of a constitutional infirmity," however, it temporarily stayed the injunction as to advertisements not expected to appear in Illinois to give the defendant time to mount an appeal.²⁶⁵

More recently, in 1995 the United States District Court for the Southern District of New York held in *Deere & Co. v. MTD Products, Inc.* that MTD's television advertisements diluted Deere's trademark of a leaping male deer under New York's anti-dilution statute.²⁶⁶ Although claiming it too had the power to issue a nationwide injunction, the court decided that interests of comity strongly favored a limited injunction in this case.²⁶⁷ That approximately half of the states had no anti-dilution law, and that even those states that did may not

²⁵⁹ *Id.* at 383-84; see also Welkowitz, *supra* note 241, at 83 (asserting that a state cannot regulate nationwide advertising, and can only regulate regional advertising via an injunction when the policies of all other affected states would permit such regulation).

²⁶⁰ See *Hyatt*, 610 F. Supp. at 384-85.

²⁶¹ See *id.* at 385.

²⁶² *Id.* at 384, 385.

²⁶³ See *id.* at 385.

²⁶⁴ *Id.*

²⁶⁵ See *Hyatt*, 610 F. Supp. at 386.

²⁶⁶ No. 94 CIV. 2322 (DLC), 1995 WL 81299, *1 (S.D.N.Y. Feb. 28, 1995).

²⁶⁷ *Id.* at *5.

have prohibited MTD's complained-of use, persuaded the court to limit the injunction to the confines of New York State.²⁶⁸

III. ANALYSIS

An analysis of the preceding case law suggests that certain aspects of state-based right of publicity laws may offend provisions of the Constitution beyond the First Amendment and the Copyright Clause.²⁶⁹ In particular, publicity rights may violate the Commerce, Full Faith and Credit, and Due Process Clauses.²⁷⁰

A. *State Right of Publicity Laws Violate the Commerce Clause*

As suggested by several of the cases described in Section II, a state's publicity laws violate the dormant Commerce Clause when they prevent an out-of-state actor from conducting commercial activities that are lawful in the state where they occur.²⁷¹ Upholding broad publicity laws risks allowing a state to set a national advertising standard because nationwide advertisers have to conform their advertising to the strictest laws or else incur the expense of producing multiple advertisements for use in different states.²⁷² Restricting advertising in this manner is an impermissible restraint on interstate commerce.²⁷³

As noted earlier, the United States Supreme Court's Commerce Clause jurisprudence prohibits a state from (a) directly regulating interstate commerce and (b) incidentally regulating interstate commerce more than is necessary to further the state's legitimate inter-

²⁶⁸ *See id.* at *5, *6, *7.

²⁶⁹ *See supra* notes 184–268 and accompanying text.

²⁷⁰ *See id.*

²⁷¹ *See, e.g.,* BMW of N. Am., Inc. v. Gore, 517 U.S. 559, 585 (1996); Hyatt Corp. v. Hyatt Legal Servs., 610 F. Supp. 381, 383–84 (N.D. Ill. 1985).

²⁷² *See, e.g.,* Kassel v. Consol. Freightways, 450 U.S. 662, 674 (1981) (holding a state law regulating the length of trucks invalid under the Commerce Clause because it posed an undue burden on interstate commerce); Wendt v. Host Int'l, Inc., 197 F.3d 1284, 1288 (9th Cir. 1999) (denial of motion for rehearing) (Kozinski, J., dissenting) (arguing that enforcing California's right of publicity beyond California's borders impermissibly sets a national standard for what is an allowable use); Welkowitz, *supra* note 241, at 64 ("[W]hen a state places itself in a position to provide the national standard for conduct, it has crossed the line of legitimate regulation."); Eades, *supra* note 72, at 1330 ("Indiana['s] right of publicity statute] is essentially imposing nationwide restrictions on production because the rational manufacturer is unlikely to alter distribution based on individual differences in state law. The simpler answer is to comply with the most expansive statute . . .").

²⁷³ *See, e.g.,* Kassel, 450 U.S. at 674; Wendt 197 F.3d at 1288 (Kozinski, J., dissenting); Welkowitz, *supra* note 241, at 64; Eades, *supra* note 72, at 1330.

ests.²⁷⁴ As the United States District Court for the Northern District of Illinois reasoned in *Hyatt Corp. v. Hyatt Legal Services*, a state law that restricts advertising outside of that state directly regulates interstate commerce because of the vital role advertising plays in the nation's economy.²⁷⁵ Even if a court deems this effect incidental rather than direct, such regulation seems excessive in light of the local interests publicity laws further.²⁷⁶ To survive Commerce Clause scrutiny, the Court has traditionally required state laws effecting interstate commerce to serve a legitimate local purpose, such as protecting safety or health, which cannot be served as well by less burdensome means.²⁷⁷

Protecting the commercial value of a resident celebrity's identity is probably not a sufficiently compelling state interest to offset the substantial regulatory effect a state's publicity laws can have on interstate commerce.²⁷⁸ The reasons the United States Court of Appeals for the Tenth Circuit gave in *Cardtoons, L.C. v. Major League Baseball Players Association* for holding that the interests served by the right of publicity were too weak to justify restrictions on First Amendment rights also largely support this conclusion.²⁷⁹ Moreover, the argument that a state's common law right of publicity serves a legitimate local purpose seems particularly vulnerable when the state's legislature did not even

²⁷⁴ See *supra* note 258 and accompanying text.

²⁷⁵ *Hyatt*, 610 F. Supp. at 383 (citing *Hunt v. Wash. State Apple Advert. Comm'n*, 432 U.S. 333 (1977)); see also Eades, *supra* note 72, at 1329-30 (noting that Indiana's right of publicity statute imposes significant burdens on interstate commerce by restricting advertising as well as merchandising).

²⁷⁶ See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973-76 (10th Cir. 1996) (reviewing the justifications for the right of publicity and finding them unconvincing); cf. *Hyatt*, 610 F. Supp. at 384-85 (holding that a nationwide injunction would place an excessive burden on interstate commerce in light of the interest sought to be protected by a state's anti-dilution statute, even where the effect on commerce is incidental).

²⁷⁷ See, e.g., *Kassel*, 450 U.S. at 674 (holding a state law regulating the length of trucks invalid under the Commerce Clause because it posed an undue burden on interstate commerce without any significant countervailing safety interest); *Hyatt*, 610 F. Supp. at 384 (asserting that statutes designed to protect health and welfare, as well as purely local interests, are favored over those designed to protect employment, profits and nationwide interests).

²⁷⁸ See, e.g., *Kassel*, 450 U.S. at 674; *Cardtoons*, 95 F.3d at 973-76; *Hyatt*, 610 F. Supp. at 384.

²⁷⁹ See *Cardtoons*, 95 F.3d at 973-76; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995) ("The rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets."); Madow, *supra* note 5, at 178-240 (reviewing justifications offered for the right of publicity and arguing that they are not compelling); Steven C. Clay, Note, *Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts*, 79 MINN. L. REV. 485, 501-06 (1994) (same).

feel compelled to act to protect the interest.²⁸⁰ Such an argument becomes weaker still when a federal court broadens a state's common law, because no state lawmaking body has felt compelled to regard the right as broadly.²⁸¹ This is especially so in states like California, where federal courts have expanded the scope of the right under common law beyond what is granted by statute.²⁸²

The Supreme Court, by upholding a state publicity law in *Zacchini v. Scripps-Howard Broadcasting Co.*, demonstrated that state publicity rights are not per se unconstitutional.²⁸³ *Zacchini*, however, did not involve the regulation of interstate commerce in any fashion because the infringing use was a broadcast on a local news program.²⁸⁴ Moreover, the Court sought to protect *Zacchini's* ability to earn a living, because the newscast appropriated his entire daredevil act.²⁸⁵ As noted earlier, *Zacchini* is not a typical right of publicity case.²⁸⁶ Plaintiffs in most publicity rights cases have primary occupations through which they built up economic value in their identities; the defendants' appropriation is not of their primary act but of this secondary economic value created by their fame.²⁸⁷ The interest protected by publicity laws is not nearly as compelling in these more common cases because the defendants are not threatening the plaintiffs' ability to earn a living.²⁸⁸ Thus, the Court's decision in *Zacchini* does not mean that state right of publicity laws are constitutional in the more typical cases in-

²⁸⁰ See *supra* note 54 for the eleven states that provide only a common law right of publicity.

²⁸¹ See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397-99 (9th Cir. 1992) (holding that California common law protects plaintiff's "identity" even though the state courts had not interpreted it as broadly); cf. *Browning-Ferris Indus. v. Kelco Disposal, Inc.*, 492 U.S. 257, 281 (1989) (Brennan, J., concurring) ("[O]ur scrutiny of awards made without the benefit of a legislature's deliberation and guidance would be less indulgent than our consideration of those that fall within statutory limits.").

²⁸² See *White*, 989 F.2d 1512, 1519 (9th Cir. 1993) (denial of motion for rehearing) (Kozinski, J., dissenting) ("No California statute, no California court has actually tried to reach this far. It is ironic that it is we who plant this kudzu in the fertile soil of our federal system.").

²⁸³ See 433 U.S. 562, 577 (1977).

²⁸⁴ See *id.* at 564.

²⁸⁵ See *id.* at 574-75.

²⁸⁶ See *supra* note 65 and accompanying text.

²⁸⁷ See *id.*

²⁸⁸ See *Zacchini*, 433 U.S. at 576 ("[T]he strongest case for a 'right of publicity' invol[es], not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.").

volving unauthorized use of a celebrity's identity in interstate commerce.²⁸⁹

B. *Vague Right of Publicity Laws Violate the Due Process Clause*

California's common law right of publicity, as articulated by the panels of the United States Court of Appeals for the Ninth Circuit in *White v. Samsung Electronics America, Inc.* and *Wendt v. Host International, Inc.*, violates Due Process.²⁹⁰ The law's prohibition against unauthorized use of another's "identity" is too vague to give parties fair notice of the specific uses that may subject them to liability.²⁹¹

State courts typically limit the right of publicity to the use of a celebrity's name, voice, face, or signature.²⁹² An advertiser can generally avoid using any of these specific characteristics.²⁹³ In *White*, however, the Ninth Circuit expanded the right such that a court may deem anything that happens to remind someone of a celebrity to be a use of that celebrity's identity.²⁹⁴ As Judge Kozinski noted in *White*:

any time anybody in the United States—even somebody who lives in a state with a very narrow right of publicity—creates an ad, he takes the risk that it might remind some segment of the public of somebody, perhaps somebody with only a local reputation, somebody the advertiser has never heard of. . . . So you made a commercial in Florida and one of the characters reminds Reno residents of their favorite local TV anchor (a California domiciliary)? Pay up.²⁹⁵

Under California law, the celebrity would be able to hold the advertiser liable for infringing his or her publicity right, even though any resemblance was purely coincidental, because the common law does

²⁸⁹ See *id.*; see also Eugene Volokh, *The Mechanisms of the Slippery Slope*, 116 HARV. L. REV. 1026, 1090 (2003) ("Zacchini is regularly cited [wrongly] for the very proposition that the Court explicitly refused to decide: that the more common version of the 'right of publicity'—the right to control many uses of one's name or likeness—is constitutional.").

²⁹⁰ See *BMW*, 517 U.S. at 574; *Wendt*, 125 F.3d at 811–12; *White*, 971 F.2d at 1397–99; see also Heald, *supra* note 240, at 1426 (arguing that subjecting a defendant to a nationwide injunction based solely on a single state's anomalous law involves a strong element of surprise, raising potential due process and full faith and credit questions).

²⁹¹ See *BMW*, 517 U.S. at 574; *White*, 971 F.2d at 1397–99.

²⁹² *Wendt*, 125 F.3d at 1286 (denial of motion for rehearing) (Kozinski, J., dissenting).

²⁹³ See *id.*

²⁹⁴ See *id.*

²⁹⁵ *White*, 989 F.2d at 1519 (denial of motion for rehearing) (Kozinski, J., dissenting).

not require intentional appropriation.²⁹⁶ Because such a scenario would expose an advertiser to liability without notice, California's common law right of publicity violates the Due Process Clause on these facts.²⁹⁷ It "fails to provide people of ordinary intelligence a reasonable opportunity to understand what conduct it prohibits," and is therefore unconstitutionally vague.²⁹⁸

C. Courts must tailor remedies to right of publicity claims

Once a court finds a defendant liable for infringing a plaintiff's publicity rights, it must fashion an appropriate remedy.²⁹⁹ Two common remedies are injunctions enjoining the defendant from continuing to infringe the plaintiff's rights, and damages to reflect the economic harm done to the plaintiff.³⁰⁰ A court must tailor each of these remedies with care to avoid constitutional problems.³⁰¹

The principal concern with fashioning an injunction is the geographical extent to which the injunction applies.³⁰² As noted earlier, the notion of issuing an injunction to enjoin out-of-state conduct that was lawful where it occurred troubled the courts in *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, *Deere & Co. v. MTD Products, Inc.*,

²⁹⁶ See *id.* at 1515 n.17 (Kozinski, J., dissenting). Consider the circumstances surrounding British rock musician Peter Gabriel's recent song, *The Barry Williams Show*, criticizing television culture. PETER GABRIEL, *The Barry Williams Show*, on UP (Interscope Records 2002); see Steve Hochman, *For Someone Who's No Fan of the Show, Peter Gabriel Has a Very 'Brady' Moment*, LOS ANGELES TIMES, July 28, 2002, at F62, available at 2002 WL 2492992. Gabriel claims that he chose the name "effectively out of a hat" and did not know that Barry Williams is the actor who played Greg Brady on the 1970s American television series *The Brady Bunch*. *Id.* Although the First Amendment would almost certainly privilege his use of the name, see *supra* notes 90–91 and accompanying text, Gabriel nonetheless gave the actor a cameo role in the song's music video. See Robert Kahn, *A Very Brady Bit Part*, NEWS-DAY, Aug. 19, 2002, at A11, available at 2002 WL 2758680.

²⁹⁷ See *BMW*, 517 U.S. at 574.

²⁹⁸ See *Hill v. Colorado*, 530 U.S. 703, 731 (2000). See also *supra* note 199 for cases where the Court applied the void-for-vagueness doctrine with particularly strict scrutiny to laws that implicated First Amendment freedoms.

²⁹⁹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

³⁰⁰ See *id.* §§ 48, 49. Monetary relief can be determined alternatively on a restitution basis using two measures: the fair market value of the unauthorized use or the defendant's profits attributable to an unauthorized use. *Id.* § 49 cmt. d.

³⁰¹ See, e.g., *BMW*, 517 U.S. at 571–74; *Hyatt*, 610 F. Supp. at 383; Welkowitz, *supra* note 241, at 18 ("In the absence of a uniform federal statute no state can give complete relief to the plaintiff without a potential encroachment on the rights of a sister state.").

³⁰² See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 48 cmt. c.

and *Hyatt*.³⁰³ In *Deere*, The United States District Court for the Southern District of New York invoked considerations of comity in seeking to limit the injunction to only those states where the complained-of action was unlawful.³⁰⁴ Although the *Restatement (Third) of Unfair Competition* notes that issuing "an injunction under state law prohibiting otherwise lawful conduct in another state raises serious concerns," it does not identify those serious concerns with particularity.³⁰⁵ Instead, it notes, "an injunction protecting the right of publicity should ordinarily be limited to conduct in jurisdictions that provide protection comparable to the forum state," thereby avoiding such concerns.³⁰⁶ It also suggests placing the burden on the defendant to request modification of a multi-state injunction, requiring the defendant to show that the conduct is lawful in one or more of the target states.³⁰⁷

The serious concerns the *Restatement* alludes to no doubt include the "strong possibility of a constitutional infirmity" resulting from a state issuing a geographically unlimited injunction.³⁰⁸ To comply with the Commerce and Full Faith and Credit Clauses, courts must limit injunctions in right of publicity cases to just those states where the complained-of use is unlawful.³⁰⁹ Doing otherwise offends the Commerce clause because the forum state would effectively be regulating commerce in other states.³¹⁰ Broad injunctions also offend the Full

³⁰³ See *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 326–27 (6th Cir. 2001); *Deere & Co. v. MTD Prods., Inc.*, 1995 WL 81299, *1, *5–6 (S.D.N.Y. Feb. 28, 1995); *Hyatt*, 610 F. Supp. at 385.

³⁰⁴ *Deere*, 1995 WL 81299 at *5. But see *Welkowitz*, *supra* note 241, at 23 ("The undercurrents of pertinent Supreme Court decisions are more than a principle of simple comity or accommodation. There appears to be a constitutionally mandated . . . structure that prohibits certain extensions of state power . . . that . . . exists to restrict power in the federal system of interstate relations.").

³⁰⁵ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 48 cmt. c.

³⁰⁶ See *id.*

³⁰⁷ See *id.*

³⁰⁸ *Hyatt*, 610 F. Supp. at 386; see, e.g., *Heald*, *supra* note 239, at 1417–27 (discussing constitutional defects of multi-state injunctions under the Commerce, Due Process, and Full Faith and Credit Clauses).

³⁰⁹ Cf. *Hyatt*, 610 F. Supp. at 383 (holding that construing Illinois's anti-dilution law as allowing for a nationwide injunction conflicts with the Commerce Clause); *Welkowitz*, *supra* note 241, at 77 ("[F]ull faith and credit . . . imposes an obligation on states not to overreach by imposing their will in areas properly regulated by other states."). Professor *Welkowitz* argues that the Commerce Clause may be a more suitable provision than the Full Faith and Credit Clause from which to derive limits on a state's power to fashion a remedy. See *Welkowitz*, *supra* note 241, at 77; see also *Heald*, *supra* note 240, at 1420–27 (suggesting that extraterritorial application of a state's anomalous unfair competition law may offend the Commerce and Full Faith and Credit Clauses).

³¹⁰ See, e.g., *BMW*, 517 U.S. at 571–72.

Faith and Credit Clause by effectively extending the forum state's right of publicity to states that do not recognize it (or that have a narrower right).³¹¹ The forum state would be placing its policy judgment regarding the right of publicity above those of other states that have chosen not to prohibit the complained-of use; in so doing, it would not be giving the requisite full credit to the public acts of those other states.³¹² To avoid these infirmities, the burden should be on the court, and not the defendant, to limit the injunction *ab initio* to only those states where the conduct is unlawful.³¹³

Courts must also exercise care in fashioning compensatory damage awards in right of publicity cases by excluding from the calculation the monetary value of damage caused by lawful out-of-state conduct.³¹⁴ The Supreme Court held in *BMW of North America, Inc. v. Gore* that a forum state must disregard out-of-state lawful conduct when calculating damages.³¹⁵ The Court also held that it is inappropriate for a state to use its judicial power to award damages in part to deter a defendant from engaging in lawful out-of-state conduct.³¹⁶ To conform to these requirements, a court must consider precisely where the plaintiff's injury occurred.³¹⁷ Suppose, for example, a court found that a plaintiff's publicity value dropped by \$500,000 because of the defendant's conduct.³¹⁸ One might argue that the injury occurred entirely in the forum state, as would be the case for defamation.³¹⁹ Alternatively, one might argue, perhaps more realistically, that some

³¹¹ See, e.g., *Herman Miller*, 270 F.3d at 327; cf. Eades, *supra* note 72, at 1331 (asserting that Indiana's right of publicity statute, which lacks a domicile requirement, violates "legislative due process" because it overrides the policy choices of the state that controls the disposition of intestate property, which may not recognize a post-mortem right of publicity).

³¹² See Welkowitz, *supra* note 241, at 77. This could be termed a reverse Full Faith and Credit argument, as the Clause is typically construed as requiring a state to enforce judgments rendered in other states. See *Baker v. Gen. Motors Corp.*, 522 U.S. 222, 232-33 (1998). See *supra* note 239 for text of the Full Faith and Credit Clause.

³¹³ But see *supra* note 307 and accompanying text.

³¹⁴ See *BMW*, 517 U.S. at 572-74.

³¹⁵ See *id.* at 573-74.

³¹⁶ See *id.* at 572.

³¹⁷ See *id.* at 574.

³¹⁸ It can be difficult, however, to prove "the amount of loss and a causal connection with the defendant's appropriation." RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 48 cmt. b.

³¹⁹ See, e.g., *Gordy v. Daily News, L.P.*, 95 F.3d 829, 833 (9th Cir. 1996) ("It is reasonable to expect the bulk of the harm from defamation of an individual to be felt at his domicile." (citing *Keeton v. Hustler Magazine, Inc.*, 465 U.S. 770 (1984))); Heald, *supra* note 240, at 1425 (noting that a plaintiff could argue that all the damage it suffers nationwide comes to rest at plaintiff's principal place of business).

part of the injury occurred in each state where the plaintiff's publicity had an economic value and where the defendant's conduct diminished that value.³²⁰ If \$200,000 of the injury occurred in states where the defendant's conduct was lawful, the court must exclude this amount from the damages to comply with *BMW*.³²¹

D. *A Preemptive Federal Right of Publicity Statute or Narrower State Laws Are Alternative Ways of Addressing These Issues*

Several commentators have called for a federal right of publicity to resolve many of the issues raised by the patchwork of state publicity laws.³²² A federal right of publicity statute that preempts state publicity laws, both common and statutory, would solve the Commerce Clause and Full Faith and Credit problems identified in this Note.³²³ As discussed earlier, the Commerce Clause of the Constitution expressly authorizes Congress to regulate interstate commerce while severely restricting states from doing so.³²⁴ Congress has used this power to enact federal trademark laws, which regulate interstate commerce in part via advertising, and could rely on this same authority to enact a federal right of publicity statute.³²⁵ Once such preempting legislation is in place, creating a nationwide standard under federal law, the dormant Commerce Clause and Full Faith and Credit issues raised by state-based publicity rights would evaporate.³²⁶ Such a federal statute should also include provisions to ensure an appropriate balance between publicity rights and those arising under the First Amendment and the Copyright Act.³²⁷

If such a federal right of publicity statute required a plaintiff to prove intent and avoided vague terms such as "identity," it would also address the Due Process concerns identified herein.³²⁸ Such a statute would give defendants fair warning by making it clear precisely what

³²⁰ See *BMW*, 517 U.S. at 573-74.

³²¹ See *id.*

³²² See, e.g., Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 J. ART & ENT. L. 227 (1999); Robinson, *supra* note 72, at 201-07.

³²³ See *supra* notes 271-289, 299-321 and accompanying text.

³²⁴ See *supra* notes 173-177 and accompanying text.

³²⁵ See, e.g., Federal Trademark Dilution Act, 15 U.S.C. §§ 1125(c), 1127 (2000) (Lanham Act §§ 43(c), 45).

³²⁶ See *supra* note 153 and accompanying text.

³²⁷ See *supra* notes 146-152 and accompanying text.

³²⁸ See, e.g., *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting); see also Goodman, *supra* note 322, at 250-277 (describing the scope, and presenting a draft, of proposed federal legislation).

uses would subject them to liability.³²⁹ It could also authorize courts to issue nationwide injunctions and calculate damages without regard to the extent of publicity rights granted under the laws of the various states.³³⁰

As an alternative to federalization, the country's state and federal legislative and judicial branches may instead resolve the constitutional issues raised by state-based right of publicity laws in other ways.³³¹ For example, state publicity laws may grow more similar over time, yielding a clearer set of rules like those found in most other torts recognized under state law.³³² Alternatively, courts could tailor their enforcement of state publicity laws to avoid constitutional problems.³³³

The state-based approach may be favored in the interest of preserving state sovereignty in a federal system.³³⁴ The federal approach, however, has the advantage of creating a true national standard in an area that significantly affects interstate commerce.³³⁵ Such a standard could create a higher degree of certainty for both plaintiffs and would-be defendants than is the case under the state-based system, and likely would be easier for courts to administer.³³⁶

CONCLUSION

Courts must tread carefully when handling right of publicity cases. To avoid constitutional infirmities, they must consider a variety of First Amendment, Copyright Clause, Commerce Clause, Due Process Clause, and Full Faith and Credit Clause issues in reaching decisions and fashioning remedies. Congress could eliminate these hurdles by

³²⁹ See, e.g., *Hill*, 530 U.S. at 731; *BMW*, 517 U.S. at 574.

³³⁰ See *supra* notes 302–321 and accompanying text.

³³¹ See, e.g., *BMW*, 517 U.S. at 572, 573–74; *Herman Miller*, 270 F.3d at 327; *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting).

³³² The *Restatement* can provide consistency in this area as more states follow it. See *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* §§ 46–49. The National Conference of Commissioners on Uniform State Laws could also promulgate a model state statute. See generally Uniform Law Commissioners, at <http://www.nccusl.org>.

³³³ See, e.g., *BMW*, 517 U.S. at 572, 573–74 (disregarding acts that were lawful in the state they took place when determining remedies); *Herman Miller*, 270 F.3d at 327 (limiting geographical scope of an injunction); *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting) (arguing for limiting the right of publicity to appropriation of specific personal characteristics). See also *supra* note 59 and accompanying text for arguments that federal courts should resolve novel issues of state publicity law through certification to the forum state's high court.

³³⁴ See *supra* note 177.

³³⁵ See, e.g., *Hyatt*, 610 F.Supp at 383–84.

³³⁶ See, e.g., Goodman, *supra* note 322, at 228, 242–44.

enacting a preemptive federal right of publicity statute, thereby simplifying this idiosyncratic area of the law. Alternatively, courts must construe and enforce state publicity laws narrowly to avoid constitutional issues.

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