

**FIFTEEN MINUTES OF FAME CAN GENERATE
FIFTEEN DECADES OF ROYALTIES:**

An International Comparative Analysis of Right of Publicity and
Trademark Laws that Create a Monopoly of Economic Benefits Deriving
From an Individual's Name, Image and Likeness¹

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I. INTRODUCTION

The right of publicity, a legal doctrine that has been adjudicated and debated around the world, was first recognized in the United States as a means for protecting and enforcing the economic property interests affixed to the fame and value of one's name and image. A relative recent body of jurisprudence, right of publicity laws are evolving at a rapid pace, resulting in inconsistent regulations and conflicting application of these rights both in the United States and throughout the world.

In many countries, this right was born out of, and remains limited to, a societal interest in protecting the privacy and personal feelings of an individual (*e.g.* defamation). In some nations these rights are enforced only to the extent necessary to protect the consuming public from confusion as to endorsement or sponsorship (*i.e.* "passing-off"). However, many nations are now recognizing the value of such rights as an independent economic property interest, particularly in the field of celebrity entertainment. The ongoing proliferation of global media through satellite television, the Internet, and particularly sites such as YouTube and Second Life, has made an international understanding of these rights essential.

Unlike other areas of intellectual property rights, such as patent, trademark and copyright laws, the United States has yet to adopt a federal statute controlling such rights. Accordingly each state has defined its own bounds and limits of these rights. The differences that have arisen in each state's interpretation and enforcement of these rights reflects controversy and inconsistency that is felt throughout the international legal community, including, as discussed below, in Germany, the United Kingdom and

Australia. Like the United States, these nations have yet to codify a right of publicity in a uniform statute.

Raising perhaps the strongest opposition to a publicity right statute is the endorsement by some jurisdictions of a post-mortem right of publicity. This extraordinary right allows a celebrity's economic interest in its name, image, and likeness to be transferred, and protected, after the death of the celebrity. The global economic impact of these laws cannot be overstated. Forbes Magazine has recently reported that the 13 top "dead celebrities" earned a combined \$194 million in 2008.² Post-mortem rights of publicity have made it possible for the licensing of the name and image of Albert Einstein to generate \$18 million in yearly revenue, and for Marilyn Monroe to achieve \$6.5 million. However, ever-evolving changes in the laws relied on by those who benefit from these royalties may not be as secure as once thought.

For example, despite recent revisions to the State of California's right of publicity statutes, United States District Courts located in both New York and California have held this past year that Marilyn's Monroe's right of publicity cannot be protected and enforced posthumously. This ruling was based solely on the fact that Monroe, at the time of her death, was domiciled in New York, which is a state that does not recognize a post-mortem right of publicity.

By way of another example, enforcement of a right of publicity of actress Judy Garland, even in a nation that recognizes a right of publicity, may very well be foreclosed because Garland was domiciled in the United Kingdom at the time of her death, which is a nation that does not recognize a right of publicity. Thus, a complete understanding of a

celebrity's rights in one nation may require familiarity with whether a foreign nation acknowledges such rights.

Despite the broad reach of most right of publicity laws, there are certain limitations that have been employed both through statute and common law. Most notably is the limit placed on the term of such rights. For example, many states and nations maintain that such rights expire upon the death of the individual. The states that permit these rights to continue posthumously have placed statutory limits on the number of years the monopoly of such rights may be enforced post-mortem.

In the United States and other jurisdictions, trademark laws are often available to fill some of the voids created by restrictions on a right of publicity. Trademark laws are prescribed by most nations through a uniform federal statute that applies consistently throughout the country. This provides a heightened level of predictability. Additionally, so long as a trademark's use continues, or registration is maintained, a trademark is deemed to exist, and may be enforced in perpetuity.

This paper discusses the evolution of the right of publicity laws in the United States as a means for protecting a person's rights in his or her name, image and likeness. It highlights some of the similarities and differences with how these rights are recognized or rejected in Germany, the United Kingdom and Australia. Discussion then follows as to how trademark laws in the United States, Germany, the United Kingdom and Australia have been used to bolster and compliment the rights an individual may have in his or her name, image and likeness.

II. PROTECTING AND EXPLOITING RIGHTS IN ONE'S NAME, IMAGE AND LIKENESS BY CLAIMING A RIGHT OF PUBLICITY

A. RIGHT OF PUBLICITY IN THE UNITED STATES

A relatively new concept in American jurisprudence, the right of publicity has prompted myriad definitions and interpretations, but is generally recognized as “the inherent right of every human being to control the commercial use of his or her identity.”³ The invasion of this right is a tort deriving from the laws of unfair competition. While the right of publicity is an inherent right held by all human beings, for practical reasons, it is typically only invoked by celebrities who can equate economic value with their identity and likeness.⁴

The right of publicity finds its roots from the common law right of privacy, and the two torts are often confused. While clearly related, the right of privacy has been recognized in the United States for over a century⁵ and typically involves an intrusion upon another's right to seclusion or the public disclosure of private or defaming facts. The right of privacy often focuses on personal feelings. In contrast, a right of publicity focuses on the exclusive economic benefit a person is entitled in connection with use of their name or likeness for commercial gain. A use need not be of a private or defamatory nature to support a claim for violation of a right of publicity.

Ideological distinctions between a right of publicity and the traditional fields of intellectual property law have been the subject of much controversy. Opponents of the right of publicity often point to the lack of social benefit derived from a right of publicity, particularly when such rights are recognized post-mortem. These shortcomings are often highlighted by pointing to the patent, copyright and trademark laws. For example, the monopoly afforded a copyright and patent owner derives from the express language of

Article 1, Section 8 of the U.S. Constitution, which states that Congress shall have the power “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”⁶ The limited monopoly provided under trademark law serves the primary purpose of protecting the consuming public from confusion in the marketplace.

Proponents of a right of publicity argue that it too provides social benefits by protecting an individual’s autonomy and inherent right to the fruit’s of one’s labor. This in turn is believed to provide further incentive and stimulus for athletic and artistic achievement. In response, opponents highlight that celebrities are already adequately compensated, financially, for these efforts (and in many instances overly compensated), and the additional economic compensation afforded by the right of publicity monopoly provides only marginal, if any, incentive to stimulate further effort, achievement and a recognizable social benefit.⁷ Additionally, to the extent this property right is extended to all individuals, and not only celebrities, the social benefits become even more elusive.

1. There is No Uniformity Because the Right of Publicity is Not Governed by a U.S. Federal Statute

Unlike other fields of intellectual property such as patents, trademarks and copyrights, the right of publicity in the United States is not created or secured by federal law or statute. Instead, it is a product of state law, with each state’s legislature and courts responsible for shaping their own regulations. To date, more than half of the states in the United States have recognized some form of protection for a right of publicity.⁸ Because

each state can adopt its own rules, the law and bounds of a right of publicity vary greatly throughout this country.

For example, if you look at three of the largest entertainment venues in the United States, namely, New York, Nevada (Las Vegas) and California, the differences in their interpretation and application of a right of publicity is evident. California has both a statutory right of publicity as well as rights that exist at common law. Through the enactment of recent legislation (enacted on October 10, 2007), California now recognizes not only a post-mortem right of publicity, but also extends this post-mortem right to individuals who died prior to California's recognition of such right in 1985.⁹ The broad protection of this statute now extends an ownership interest in the right of publicity to heirs of deceased individuals who died even before California recognized a right of publicity.

California revised this statute to expressly address a decision by a California district court which held that the heirs to Marilyn Monroe's right of publicity could not enforce such rights because at the time of her death, California did not recognize a post-mortem right of publicity.¹⁰ One of the few restrictions is that under California's revised statute, damages are only available to the owner of a deceased person's right of publicity if such rights are registered with the State of California.

New York, in sharp contrast, recognizes very limited rights of publicity. A claim to such rights must be brought exclusively under New York's privacy laws codified at New York Civil Rights Law, Sections 50 and 51.¹¹ Notwithstanding recent efforts to revise New York's statutes, to date, New York has expressly refused to protect or enforce

a post-mortem right of publicity.¹² Once a celebrity dies, its right of publicity ceases to exist and cannot be enforced by the person's heirs.

Falling somewhere in between, a right of publicity in the state of Nevada exists exclusively under Nevada Revised Statute Section 597.800.¹³ While this statute recognizes a post-mortem right of publicity, it holds that such right may not be enforced until the owner registers such rights with the State, and that the failure to timely register may result in a waiver.¹⁴

2. The Right of Publicity Has Been Interpreted Broadly in the United States

The right of publicity in this country has in many instances been interpreted broadly, and has not been limited to simply the unauthorized use of a person's image or name. Instead, the right has been extended to include the distinctive voice of a celebrity, a celebrity's catch phrase, or even characteristics of a fictitious character that the celebrity portrayed. The scope of these rights has been defined through several court decisions which have adjudicated claims brought to protect a wide range of alleged inherent property rights.

In 1988, a California federal court held that a right of publicity can extend to a person's voice when it ruled in favor of renowned singer Bette Midler in a case against the Ford Motor Company.¹⁵ Midler filed suit after Ford, as part of an advertisement to sell its automobiles, imitated Midler's voice in a song that Midler made famous. The Court ruled "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California."¹⁶

In 1983, American television host Johnny Carson was successful in enforcing his right of publicity when a company misappropriated his famous slogan “Here’s Johnny” in an advertisement for portable toilets. The California court held that “a celebrity’s right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes.”¹⁷

Most recently, on September 9, 2008, the United States Federal Court of Appeals for the Third Circuit upheld a Pennsylvania statute which precludes the unauthorized use of an individual’s name, likeness and voice.¹⁸ In that case, the makers of the American football video game entitled “Madden NFL 06” used the voice of famed Philadelphia broadcaster, John Facenda in an advertisement marketing the video game. Although the 22-minute advertisement contained no images of Facenda, and used only 13 seconds of his voice, the Court found this sufficient to support a claim for violation of Facenda’s right of publicity.

In 1992, the famous Wheel of Fortune television game show model, Vanna White was successful in enforcing her right of publicity against a company that created an advertisement that portrayed a robot wearing a long gown, blonde wig, large jewelry, and turning letters on what was designed to be a futuristic “Wheel of Fortune” game show set.¹⁹ In a controversial opinion, the court extended a right of publicity not only to the actual likeness of the individual, but also to certain characteristics of the role that individual played on a television show. The fact that no consumer could reasonably believe the robot was actually Vanna White was inconsequential to court’s finding of liability under California’s right of publicity laws.

A similar, and no less controversial, case involved animatronic robots that were placed in airport bars and were designed to portray certain characters from the American popular television show called Cheers.²⁰ Although the robots exhibited very little resemblance to the television actors themselves, the robots employed traits of the characters that these actors portrayed. The court again took an expansive approach, essentially finding that it was sufficient if the unauthorized use reminded the public of the celebrity, even if the image or likeness of the celebrity had not been used.²¹

3. Post-Mortem Right of Publicity

Perhaps the most influential, and certainly the most controversial expansion of the right of publicity is the recognition that such rights may continue after the death of the individual. To date, nineteen states in the United States recognize some form of a post-mortem right of publicity. Fourteen recognize such right by statute and five recognize a common law post-mortem right of publicity.²² Two states, New York and Wisconsin, have expressly rejected a common law post-mortem right of publicity.²³ New York and Wisconsin have held that any such right must fall under their respective right of privacy statutes, which are limited to living persons.²⁴

Recognition of a post-mortem right of publicity symbolizes a clear break from its historical connection with privacy rights. While privacy rights at all times focus on a living person's inalienable and non-transferable right to personal privacy and to be free from mental distress, the right of publicity now stands as a separate economic property right, bearing closer resemblance to other assignable and transferable rights such as intellectual and real property rights.

The economic importance of posthumous rights around the world, cannot be overstated. On October 27, 2008 Forbes Magazine released its annual list of the top-earning dead celebrities.²⁵ The thirteen names that made up the list combined for a U.S. \$194 million in earnings over the prior 12 months. Topping the list was Elvis Presley, proving the king of Rock ‘n Roll still reigns with earnings that total U.S. \$52 million. Other notable top earners included Albert Einstein, Andy Warhol and John Lennon. Marilyn Monroe, whose estate is discussed in more detail in the following paragraph, was reported as earning U.S. \$6.5 million during the past 12 months.

The debate surrounding post-mortem rights of publicity in the United States is perhaps best exemplified in the recent disputes initiated by the asserted owners of the Marilyn Monroe rights of publicity. In 2005, separate lawsuits involving Monroe’s publicity were commenced on both coasts of the United States, in federal courts in New York²⁶ and California. Monroe died testate on August 5, 1962. Although her will contained no express provision for bequeathment of a “right of publicity” it contained a residuary clause which devised the remainder of her estate to certain individuals.²⁷ In 2005 the alleged owners of Monroe’s post-mortem rights of publicity commenced suit to prevent the merchandising of Monroe’s image by entities claiming to own copyright-protected photographs of Monroe.

In both disputes, the cornerstone inquiry was whether Monroe’s right of publicity was descendible. Recognizing the inconsistent laws pertaining to post-mortem rights in the United States, the courts were first tasked with determining which state’s laws should apply. Because right of publicity is a property right, both courts were bound to the estate laws of the state of Monroe’s domicile at the time of her death.²⁸ There was strong

disagreement, however, as to whether Monroe, at the time of her death, was domiciled in California or in New York. Since New York rejects post-mortem rights, and California acknowledges these rights, resolving where Monroe was domiciled at the time of death appeared to be the deciding factor as to whether Monroe's right of publicity could be enforced after her death.

On May 2, 2007, it appeared that the New York court discovered a way to resolve the lawsuit without rendering a decision as to where Monroe was domiciled at the time of death. The New York court correctly noted that post-mortem rights do not exist in New York. The court also correctly noted that although California now recognizes a post-mortem right of publicity, it did not do so in 1962 when Monroe died. Relying on traditional rules of estate law which govern the bequeathment of property, the court found that under both New York and California law "a disposition by the testator of all his property passes all of the property he was entitled to dispose of *at the time of his death*."²⁹ In other words, "property not owned by the testator at the time of his death is not subject to the disposition by will."³⁰ Accordingly, because neither New York nor California in 1962 recognized a post-mortem right of publicity, Monroe's will was incapable of transferring a right which did not exist at the date of her death.

Only two weeks after the New York court rendered its decision, the California court, on May 14, 2007 issued a similar order. The court likewise held that Monroe at the time of her death was incapable of devising rights she did not then own, including rights of publicity.³¹ The California court expressed its disappointment with this result and concluded its opinion by stating:

The court reaches this conclusion with some reluctance because, as plaintiffs note, at least some personalities who died before passage of the

California and Indiana right of publicity statutes left their residuary estates to charities, which will be “divested” of those rights under the court’s holding. As noted, however, nothing in this order prevents legislatures from enacting right of publicity statutes so as to vest the right of publicity directly in the residuary beneficiaries of deceased personalities’ estates or their successor-in-interest.³²

Remarkably, only a few months after the California court rendered its decision, and invited the California legislature to revisit its right of publicity statute, the legislature responded. On October 10, 2007, California’s right of publicity statute, Section 3344.1, was amended to provide a right of publicity to deceased personalities who died before January 1, 1985. Under California law, celebrities such as Marilyn Monroe who died prior to the date that the state recognized a post-mortem right of publicity, are now deemed to have possessed this property despite the fact that no such right existed at the time of their death.

Notwithstanding the amendments to the California statute, the California court ultimately determined that the evidence showed that Monroe was domiciled in New York at the time of her death. Monroe’s right of publicity, under New York law, was deemed to have extinguished at her death. The New York court endorsed this holding in the parallel case on September 2, 2008.

Although ultimately the courts found that Monroe’s right of publicity cannot be enforced posthumously, the impact of these proceedings (including the constitutionality of the retroactive amendments to the California statute), will inevitably be debated for years. The amendment now makes unlawful certain conduct that at the time it was performed may have otherwise been lawful.

4. Right of Publicity Limitations and Possible Defenses

Notwithstanding the wide breadth that has been afforded the right of publicity in the United States by several courts and state laws, these rights have both statutory and common law limitations and may fall victim to several recognized defenses. To begin with, there are express limitations that have been drafted into all of the state right of publicity statutes. All states mandate that the right of publicity expires either at the time of death, or like copyright law, at a date certain after the person's death.³³ For example, post-mortem rights of publicity under California's statute expire 70 years after the death of the person.³⁴ In Nevada, the rights expire 50 years after death.³⁵

As discussed above, several states including California and Nevada have a registration requirement of post-mortem rights of publicity. In California, the failure to register with the Secretary of State may result in the waiver of any right to collect damages for post-mortem violations. In Nevada, the failure to timely register could result in forfeiture of all rights of publicity.³⁶ Other states require that the right of publicity must have been exploited during the lifetime of the person, failing which, there will be no post-mortem rights.³⁷

One of the most common defenses to a right of publicity claim is the free speech protection of the First Amendment of the U.S. Constitution. There is an inherent tension between the monopoly created by a right of publicity and the fundamental rights of free speech prescribed by the First Amendment. The First Amendment states that "Congress shall make no law . . . abridging the freedom of speech, or of the press . . ."³⁸

The use of an individual's identity or likeness primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation

of a person's right of publicity.³⁹ Thus, the use of a person's name or likeness in news reporting, whether in newspapers, magazines, or broadcast news, does not infringe the right of publicity.⁴⁰ However, if a person's likeness is used in a publication merely for the purpose of exploiting the person's commercial value, or to suggest endorsement or sponsorship, the First Amendment will most likely not offer any protection.

One of the earlier decisions that addressed the First Amendment defense involved a claim brought by famous performer Ginger Rogers against a movie studio that identified her in a movie entitled "Ginger and Fred."⁴¹ The film told the story of two fictional Italian cabaret performers, Pippo and Amelia, who, in their heyday, imitated Rogers and Astaire and became known in Italy as "Ginger and Fred." In rejecting the right of publicity claim, the court held "that the right of publicity did not bar the use of a celebrity's name in a title so long as the item was a literary work and not simply a disguised commercial advertisement for the sale of goods or services."⁴² The court further held that in light of the importance of free expression, the right of publicity cannot bar the use of a celebrity's name in a movie title unless the title was "wholly unrelated" to the movie or was "simply a disguised commercial advertisement for the sale of goods or services."⁴³

The Ginger and Fred case was shortly followed by a California decision regarding an artist's drawing and silk screening on t-shirts of the famous comedy team the Three Stooges.⁴⁴ Here the court recognized that use of a celebrity's likeness may be protected by the First Amendment, and set forth what has been oft cited as the "transformative test." The court stated that:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of

publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.

After carefully outlining the broad scope of protection afforded by the First Amendment, the court ultimately found that the artist could not rely on this defense, because the reproduction of the images of the Three Stooges contained no significant transformative or creative contribution. The “depiction or imitation of the [Three Stooges was] the very sum and substance of the work in question . . . and the work was not so transformed that it has become primarily the defendant's own expression rather than the [Three Stooges’] likeness.”

In 2003, the United States Appeals Court for the Sixth Circuit considered whether famed professional golfer, Tiger Woods had an actionable claim for violation of his right of publicity based on use of his image and name in connection with a painting titled “The Masters of Augusta.” The painting commemorates Woods’ record-setting victory at the Masters’ golf tournament. In finding that the First Amendment precludes a cause of action for right of publicity, that court held that the artwork “consists of much more than a mere literal likeness of Woods. It is a panorama of Woods's victory at the 1997 Masters Tournament, with all of the trappings of that tournament in full view, including the Augusta [golf course] clubhouse, the leader board, images of Woods's caddy, and his final round partner's caddy.” The court concluded that “[a] piece of art that portrays a historic sporting event communicates and celebrates the value our culture attaches to such events” and is therefore protected by the First Amendment.

In a recent case involving the use of American professional baseball players' names and statistics for a fantasy baseball league⁴⁵, the court held that such use violates the right of publicity of the baseball players, but that the use was nonetheless protected by the First Amendment.⁴⁶ The court first noted that the information used in the fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a First Amendment right to use information that is available to everyone. It also recognized an inherent public right to statistics and other information about the game of baseball, identifying baseball as "the national pastime." The court also considered and rejected some of the fundamental policies supporting a right of publicity. Baseball players are already rewarded "handsomely" for their labors, and protecting these names and statistics would unlikely provide any additional incentive for achievement. Likewise, any emotional harm would most likely be caused by a player's actual performance, in which case media coverage of the player's actual performance would have already caused this same harm.

B. RIGHT OF PUBLICITY OUTSIDE OF THE UNITED STATES

The inconsistent application of the right of publicity among the 50 states of the United States mirror some of the differences found in legal systems around the world. As discussed below, Germany, the United Kingdom and Australia have attempted to balance the economic monopoly inherent in a right of publicity, with the importance of free speech, expression and trade.

1. Personality Rights in Germany

Section 12 of the German Civil Code of 1900 prohibits the unauthorized use of another person's name.⁴⁷ Section 22 of the German Act on Copyright in Works of Visual Arts of 1907 provides that a person's portrait may only be exhibited or disseminated with the depicted person's consent.⁴⁸ Prior to 1950, these were the only personality rights afforded to individuals in Germany.

In more recent years the German courts have expanded these rights to provide "an umbrella right that protects different aspects of an individual's personality from unauthorized public exposure, and guarantees the protection of human dignity and the right to freely develop one's personality – the right to autonomous self definition."⁴⁹ Thus by its very nature, Germany's personality rights seem more aligned with U.S. privacy rights rather than rights of publicity. For this reason personality rights historically were not transferable in Germany.

The emphasis placed on the prohibition of the actual portrayal of the individual, rather than the mere association of the person, serves as an interesting distinction from some U.S. cases. Under German law, mere suggestion of sponsorship or endorsement is not enough. Accordingly, it is unlikely that the mimicking robot that merely resembled Vanna White, or the robots that exhibited characteristics of certain characters from the television show Cheers, would support a claim under German law. Similarly the toilet bowl that announced Johnny Carson's famed slogan "Here's Johnny" would also not be actionable, unless one believed it was actually Johnny Carson's voice they were hearing.

Notwithstanding, in one German case, the Federal Supreme Court endorsed a celebrity's right of publicity even though the facial features of the celebrity were not

exploited. In this case, the image of a soccer player, shown from behind, was actionable despite the fact that his facial features were not visible in the photograph.⁵⁰ Here, his stature, posture and haircut made it possible to recognize the soccer player. Because the public would assume this was actually the celebrity soccer player being depicted, there was a cognizable cause of action. However, had a photograph of an actor (i.e. a “double”) who merely resembles the soccer player (rather than the soccer player himself) been used, this would most likely fall outside German law, even if the purpose of the advertisement was to conjure up the image of the actor. The key factual inquiry would be whether the public would recognize that this was merely an actor (double) imitating the soccer player, or whether they would be confused and believe it was the actual soccer player himself. In Germany, the right to protect one’s image does not extend to the right to protect a mere association with the individual.

Similar to the free speech protections recognized in the United States under the First Amendment, Germany provides a defense for using a name or image in reporting a newsworthy event. As in the United States this requires a careful balance of the public’s interest in obtaining newsworthy information, and the commercial and privacy interests afforded celebrities. Typically, German courts exclude use of a celebrity’s image in an advertisement as falling outside the protection of newsworthy events.⁵¹

Although traditionally German courts have not permitted the transfer of one’s personality rights, recent decisions suggest that certain aspects of this right may indeed be evolving. For example, a lawsuit was initiated by a merchandising company that claimed to have acquired all of the personality rights of the famous pop singer, Nena Kerner. Expressly avoiding the question as to whether such rights are actually transferrable, the

court held that the “defendant’s use of Nena’s likeness gave rise to the plaintiff’s right to recover the usual fee for permission to utilize the likeness which is based on Sec. 812(1), Civil Code, and does not require that Nena’s right in her own likeness had been transferred to the plaintiff.”⁵²

The German courts have gone so far, at least in one instance, to recognize that these personality rights may even be descendible. In a case involving right to the name and likeness of actress Marlene Dietrich, a German court considered whether such rights could be enforced after Dietrich passed away on May 6, 1992.⁵³ The court first recognized the difference between non-material interests and interests that have a financial value. Non-material interests involve an intrusion into one’s dignity and respect. These interests were deemed to be inalienable and not transferable. However, the court held that personality rights that are purely of a financial nature, may be transferred and may be descendible. However, this posthumous right differs in one important way from the post-mortem rights of publicity recognized in some part of the United States. In Germany, transfer is only permitted if “the heir can step into the role of the holder of the right of personality and can, in defending the presumed interests of the deceased, proceed in the same way as that person could have done against an unauthorized exploitation.”⁵⁴ The Court outlined this restriction noting:

Finally, it should be pointed out that the powers of the heir derive from the holder of the right of personality and cannot be used in a manner contrary to his presumed wishes. The power of the heir to exploit the elements of the right of personality which are of financial value by taking action against an unauthorised use of the picture or name of a deceased person is therefore not linked to an unlimited positive right of use which could be exploited even against the express or presumed interests of the deceased holder of the personality right. The heir is only allowed to use the opportunities for marketing which exist or continue after the death on taking the deceased’s will into account.⁵⁵

In sharp contrast, in the United States, once the right of publicity is transferred, the new owner may exploit the right in any manner it pleases, even if such use is derogatory, or is contrary to the desires of the deceased celebrity.

2. United Kingdom

Until recently, the United Kingdom did not recognize any right of publicity, and only very limited rights of privacy. These rights have long been held to interfere with the protections of freedom of speech. Even today, the United Kingdom does not recognize a cause of action for an unauthorized commercial use of a person's name or image unless the plaintiff can establish some invasion of privacy, or can show passing off, false advertising or libel. Right of publicity is still not recognized as an independent economic property right. It is for this reason that musical performers the Spice Girls and ABBA "both failed in their attempts to enjoin unauthorized merchandising activities."⁵⁶ In both instances, they were unable to prove that consumers would believe that the performers had endorsed the merchandise."⁵⁷

The U.K. courts have recognized an actionable claim for invasion of a right of privacy when a disclosure concerns matters in which a person has a reasonable expectation of privacy. However, the courts declined to extend this right to a total prohibition of an unauthorized commercial use of one's name or likeness. In *Campbell*, the court enforced the right of privacy finding that a photograph of model Naomi Campbell (leaving a meeting of Narcotics Anonymous) invaded her right to privacy.⁵⁸ Similarly, photographs taken at the wedding of actor Michael Douglas to actress

Catherine Zeta-Jones, were found to be actionable by extending U.K.'s Breach of Confidence laws to cover an invasion of privacy.⁵⁹ In both instances, public dissemination of the photographs resulted in liability, not because it constituted an unauthorized commercial use of the celebrity's likeness, but because it exploited images for which the celebrity possessed a reasonable expectation of privacy.

3. Australia

Australia, like the United Kingdom, does not expressly recognize a right of publicity. Use of a celebrity's name or likeness is generally not actionable unless the celebrity can demonstrate defamation or passing off.⁶⁰ A passing off action is analogous to a claim for unfair competition in the United States, and must demonstrate some form of consumer confusion. While no right of publicity exists, an Australian court may find liability where the use of a celebrity's likeness falsely suggests endorsement or sponsorship by the celebrity.⁶¹ Thus, purely commercial use of a celebrity in an advertisement could be enjoined and result in liability.

An example of a failed effort by a celebrity to stop the unauthorized use of her image was reported in August 2006, when Australian fashion model, Isabel Lucas appeared on the cover of Ralph magazine. After Lucas refused on several occasions to permit her image to be used on a number of men's magazines (including Ralph), Ralph magazine proceeded without authorization to use her image as the cover model for its August 2006 issue.⁶² When questioned, Ralph magazine responded "we haven't run smutty captions or suggestive copy . . . I was very careful not to do that with Isabel: I didn't want to demean her or belittle her."⁶³ Because Ralph magazine's use probably does not rise to the level of passing off or defamation, the success of such a claim would

be doubtful. Indeed, Lucas did not even bother to file a claim. Unlike the United States and Germany, Australia does not recognize an independent economic interest in a right of publicity. Therefore, unless consumer confusion or defamation can be established, celebrities such as Lucas, can be exploited for the sales of goods such as magazines.

III. PROTECTING AND EXPLOITING A NAME AND IMAGE THROUGH TRADEMARK LAW

As discussed above, differing laws throughout the United States, Germany, the United Kingdom and Australia have resulted in several limitations and restrictions on a party's right of publicity. These differences range from a refusal to recognize any right of publicity, to express limitations on the duration and transferability of these rights. Many of these restrictions and limitations can be addressed by employing trademark law to protect a person's name and image.

A. Trademark Law in the United States

Trademark rights in the United States are governed under a federal trademark statute, called the Lanham Act (15 U.S.C. § 1051, *et seq.*), as well as under common law. In the United States, a trademark is defined very broadly and includes any word, symbol or image that serves as an indication of origin or source. Courts have held that even a sound or smell, if they serve the function of identifying source, may be protected as a trademark. In order to establish rights in a trademark, the mark must be used in commerce in connection with goods or services. Rights in a mark only first begin to accrue after actual use of a mark in commerce commences.

The United States recognizes one limited exception to this rule. Under the Trademark Act, a party may file an application for registration of a mark, prior to actual use of the mark. In order to do so, the applicant must verify that at the time of the filing of the application, that the applicant has a bona-fide intent to use the mark in commerce. This is called an “intent-to-use” application and is permitted under Section 1(b) of the Lanham Act. If the applicant demonstrates use within three years after Allowance, the application will be entitled to registration, and the applicant will be afforded trademark rights which date back to the date when the application was initially filed.

So long as a mark continues to be used in commerce, rights in a trademark may be maintained indefinitely. Unlike copyrights, patents, and right of publicity, rights in a trademark, so long as use continues, never expire.

Trademarks may also be freely assigned or licensed. The only restriction is that any transfer of the mark must also include a transfer of the goodwill associated with the mark. This is because a trademark has no independent significance apart from the goodwill it symbolizes. The new entity taking ownership of an existing mark must step into the shoes of its prior owner, so that the consuming public can reasonably assume that the mark symbolizes the same nature and quality of goods and services offered by the previous owner.⁶⁴ Likewise, if a trademark is abandoned through non-use, it may not subsequently be transferred.

A party that acquires rights in a trademark secures the right to preclude others from using the same or similar mark in connection with any goods or services which would result in a likelihood of consumer confusion. A trademark holder is not granted an exclusive monopoly over words and images. A trademark only prevents another from

using such words and images when such use is likely to confuse the consuming public as to the source, origin or sponsorship of such goods.

1. Protecting a Person's Name as a Trademark

The scope of protection afforded a particular trademark depends in large part on the strength of the mark. As a general rule, the more distinctive a mark, the greater the rights its owner will have to exclude others from using similar marks. Courts in the United States categorize trademarks along a spectrum of distinctiveness, based on their capacity to serve a source-identifying function. From strongest to weakest, these categories include: (1) fanciful and arbitrary; (2) suggestive; (3) descriptive; and (4) generic marks.

A person's name in the United States is generally considered to be a descriptive mark that is not entitled to serve as a trademark.⁶⁵ A descriptive mark is a mark that conveys an immediate idea of characteristics or qualities of the goods or services. An example is the use of the mark CREAMY for an ice cream shop. Descriptive marks are not innately distinctive because descriptive marks are not inherently capable of serving as source-identifiers.

Descriptive marks cannot be registered or enforced in the United States unless the owner can establish that the public associates the alleged mark not only with a specific feature or quality of its goods or services, but also with a single commercial source.⁶⁶ The Lanham Act also provides that when a descriptive phrase becomes associated with a single commercial source, the phrase is said to have "acquired distinctiveness" or "secondary meaning," and therefore functions as a trademark. For example, when the public perceives the phrase SPORTS ILLUSTRATED as a brand for a sports magazine

rather than solely a collection of photographs of sporting events, the otherwise descriptive mark is deemed to have "acquired distinctiveness" or "secondary meaning" and may then be entitled to registration and protection.

Additionally, the Lanham Act provides that "proof of substantially exclusive and continuous use" of a designation "for the five years before the date on which the claim of distinctiveness is made" may be accepted as *prima facie* evidence that the mark has acquired distinctiveness as used with the applicant's goods in commerce.⁶⁷

As with all descriptive marks, a person's name may acquire trademark protection if the name has acquired secondary meaning. Secondary meaning in this sense can be achieved when the consuming public, upon hearing a particular name, no longer first thinks of the individual who bore that name, but rather thinks of the source or origin of the goods or services.

For example, names like Ralph Lauren, Calvin Klein, McDonalds and Ford, were once descriptive marks. However, through widespread and consistent use of these words as trademarks, the primary meaning of these words have been submerged and they have acquired secondary meaning. A consumer purchasing a shirt with a CALVIN KLEIN label, or an automobile with a FORD emblem, no longer first thinks of the individuals Calvin Klein and Henry Ford, but instead recognizes such words as an indication of the source of the products.

2. A Person's Image May Serve as a Trademark

Protection of a person's image and likeness may also be acquired through trademark law. As with all trademarks, however, before protection will affix, the image must be used consistently in commerce as a source identifier.

In a lawsuit brought in federal court in the State of New Jersey, the estate of Elvis Presley asserted trademark rights to all recognizable images of the late musical legend Elvis Presley.⁶⁸ The court rejected the sweeping claim to rights in all images of Elvis Presley, finding that trademark law does not protect the likeness of a person as a valid mark. However, the court found that one particular picture of Elvis "dressed in one of his characteristic jumpsuits and holding a microphone in a singing pose is likely to be found to function as a service mark."⁶⁹ The court reached this conclusion because the evidence revealed that this specific image had appeared in promotional and advertising material for concerts and on record albums for several years.⁷⁰ Thus, use of this particular image as a source identifier had achieved secondary meaning and was protectable as a trademark.

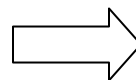
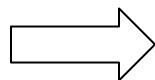
In contrast, in a case brought by the daughters of famous American baseball legend Babe Ruth, the court held that the image of Ruth had not acquired secondary meaning.⁷¹ In that case, the plaintiffs objected to the use of Ruth's likeness in three photographs which appeared in a calendar published by the defendant. The court observed that under some circumstances, a photograph of a person may be a valid trademark--if, for example, a particular photograph was consistently used on specific goods.⁷² In this instance, however, the court rejected plaintiffs' assertion of trademark rights in every photograph of Ruth, holding that a photograph of a human being is not inherently 'distinctive' in the trademark sense of tending to indicate origin.⁷³ The court

noted that Ruth was one of the most photographed men of his generation, a larger-than-life hero to millions and an historical figure. The court found that an ordinarily prudent purchaser would have no difficulty discerning that these photographs are merely the subject matter of the calendar and do not in any way indicate sponsorship.⁷⁴

In the Tiger Woods (*ETW*) case discussed above, the court, consistent with the Babe Ruth case, held that an image of golfer Tiger Woods, alone, was insufficient to serve as a trademark. The court explained:

Here, *ETW* claims protection under the Lanham Act for any and all images of Tiger Woods. This is an untenable claim. *ETW* asks us, in effect, to constitute Woods himself as a walking, talking trademark. Images and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation. They do not distinguish and identify the source of goods. They cannot function as a trademark because there are undoubtedly thousands of images and likenesses of Woods taken by countless photographers, and drawn, sketched, or painted by numerous artists, which have been published in many forms of media, and sold and distributed throughout the world. No reasonable person could believe that merely because these photographs or paintings contain Woods's likeness or image, they all originated with Woods.⁷⁵

This point can be further illustrated by considering the use of the image of famous American basketball player, Michael Jordan. Over the past three decades, Michael Jordan has endorsed several different brands. His affiliation with the world's leading athletic footwear manufacturer, Nike, Inc., is probably best known. For several years, Nike has branded a particular line of basketball footwear with an image of Michael Jordan. This use is depicted below:



Because of its consistent use of this particular image as an identification of source of Nike's basketball footwear, Nike can assert trademark rights in this image of Michael Jordan. However, as discussed in the *Elvis* and *Babe Ruth* cases above, Nike cannot assert sweeping rights in all images of Michael Jordan. In fact, Michael Jordan has licensed his name and image to several different unrelated companies. Nike has acquired certain trademark rights in the image of Michael Jordan, but these rights solely arise out of this one particular depiction.

3. Defenses to Trademark Claims

As discussed above, in order for a party to claim trademark rights in a person's name or image, the party must establish that it has used the name or image as a trademark in commerce in connection with the marketing or sale of goods and services. But the inquiry does not end here. Once trademark rights in a person's name or image is established, it can only be enforced against another's use of that name or image as an identification of source. A party that uses a person's name or image solely to describe the individual, rather than to identify the source of a product or service, will not be liable for trademark infringement. This defense is commonly referred to as "fair use." For example, using the name Ralph Lauren in an article about fashion designers will most likely not constitute infringement. However, placing the name Ralph Lauren on the label of an article of clothing, will almost certainly fall outside the protections of fair use.

Use of another's mark to report a newsworthy event, or for criticism is also protected under the First Amendment's freedom of speech clause. Other common defenses include laches or acquiescence, which occurs when a trademark holder is aware

of the party's infringing use, but takes no action to enjoin such use. Demonstrating that the trademark holder abandoned the mark, or procured such rights through fraud or unclean hands can also provide a defense to a claim of infringement.

B. TRADEMARK RIGHTS IN A PERSON'S NAME AND IMAGE OUTSIDE OF THE UNITED STATES

1. Germany

In addition to the rights afforded celebrities under Germany's right of publicity laws, rights in a person's name and image can also be grounded in Germany's 1995 Trade Marks Act.⁷⁶ Trademark protection in Germany arises from the entry in the register of the German Patent and Trade Mark Office and is subject to a prior application.⁷⁷ Trademark protection may also arise from use of a mark in the course of trade, insofar as the use has acquired secondary meaning as a trademark within the affected trade or circles.⁷⁸ Additionally, trademark protection may accrue under the Act if the mark has achieved notoriety, as defined by the Paris Convention.⁷⁹ Registration of a trademark confers to its owner the exclusive right to use the trade mark in relation to the protected goods and/or services.

A trademark can be renewed indefinitely and, so long as use continues, may last forever. If the renewal fee is not paid every ten years, the registration will be cancelled.⁸⁰ Additionally, if a trade mark is not used within a period of five years after registration, it can be cancelled, upon request or legal action, on grounds of revocation.⁸¹

Trademark owners can sell and assign their trademarks any time.⁸² The owner of a trademark can grant others a license to use the trademark. Similar to the United States,

rights in a trademark must be transferred in connection with at least some of the goods for which the mark has been protected.⁸³

Finally, trademark rights can be acquired by an individual to protect one's name and image. Section 3 of the Trade Marks Act expressly states that "any signs, particularly words, including personal names, designs . . . which are capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as trade marks."⁸⁴ As one German court noted:

The trade mark has since become completely detached from its relationship to a business and the personality of an entrepreneur. It can be acquired without a business (§ 7 of the Trade Marks Act) and it can be transferred and inherited (§ 27(1) of the Trade Mark Act). Even a mark which consists of a person's name or picture is today a non-material property right capable of being freely dealt with.⁸⁵

Similar to the defenses of laches and acquiescence available under U.S. law, the German Trademark Act expressly states a trademark holder who is aware of an infringing use for five consecutive years before instituting action to enjoin such use is prohibited from bringing a claim.⁸⁶ The only exception to this prohibition is if the infringing user had registered or used the mark in bad faith.⁸⁷

2. United Kingdom

The United Kingdom's Trade Marks Act of 1994 defines a trademark "as any sign capable of being represented graphically which is capable of distinguishing goods or services from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."⁸⁸ Trademarks in the United Kingdom may consist of personal names, designs, letters, numbers, smells, sounds and colors.

As in the United States, a person's name or image may be protected as a trademark only if it is distinctive. This requirement has proven to be a hurdle to the protection of a celebrity's name as a trademark in the United Kingdom. Indeed, the more famous a celebrity becomes, the less likely the use of the celebrity's name will be found by a U.K. court to be distinctive as an identification of source of goods and services. Instead, because of the celebrity's fame, the consuming public associates the celebrity's name with the celebrity himself, rather than as an identification of source of a particular product or service.

This issue was highlighted in a U.K. case involving whether the name Elvis Presley could be registered as a trademark. In March of 1999 the U.K. Court of Appeal considered the decision by the Trade Marks office to refuse registration of the marks ELVIS, ELVIS PRESLEY and the signature of "Elvis A Presley."⁸⁹ Citing an earlier case involving a failed effort to secure trademark rights in the mark TARZAN⁹⁰, the court held that the name Elvis had not acquired distinctiveness as a trademark to identify source. The court reasoned that "[w]hen a fan buys a poster or a cup bearing an image of his star, he is buying the likeness, not a product from a particular source."⁹¹

In contrast, under a claim for "passing-off" a well-known celebrity may have a viable cause of action if he can demonstrate that use of his name or image has been used in a manner that results in a false impression that the celebrity endorses or sponsors the product. In order for such a claim to succeed the celebrity must first establish that his name or image has in fact already been used in connection with the merchandising of products, and that some good will has been created in connection with the celebrity's

name as a mark.⁹² These rights will be balanced against a defendant's right to free expression.

3. Australia

Because Australia offers no protection to a celebrity based on a claim to right of publicity, the only available remedies to protect one's economic interest in their name and image reside in trademark law and the common law prohibition against passing off.

Trademark rights in Australia are governed by the 1995 Trademark Act.⁹³ Prior to enactment of the 1995 Trademark Act, the Australian courts narrowly construed whether use of a celebrity's likeness may be actionable under the earlier Trade Practices Act. In 1989 a claim was brought by Australian Olympic long jumper, Gary Honey, after Australian Airlines produced posters of Honey that also included the airline's logo. On Appeal the Full Court of the Federal Court of Australia confirmed the lower court's holding that Honey had not proved that the posters created commercial association between Honey and the airline.⁹⁴ The Court stated, "[w]e are satisfied that viewers of the poster would have perceived it not as an advertisement or promotion for the services being offered by the [airline], but rather as a promotion by the airline of sport."⁹⁵

Under the 1995 Trademark Act, a trademark is broadly defined as "a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person."⁹⁶ The 1995 Trademark Act significantly expanded Australian trademark rights. In addition to the traditional words and symbols protected under trademark law, the 1995 Trademark Act encompassed shape, color, sound and scent.⁹⁷

Section 21 of the 1995 Trademark Act expressly recognizes a trademark as personal property.⁹⁸ As personal property, the trademark may be freely assigned and licensed. Representing a very significant distinction between Australia's trademark law, and the trademark law of most other countries, Section 106(3) of the Act abolished the prohibition against the transfer of trademarks without the accompanying goodwill. Particularly, Section 106(3) states that "[t]he assignment or transmission [of a registered trademark] may be with or without the goodwill of the business concerned in the relevant goods and/or services."⁹⁹

Through a continuing expansion of the common law tort of passing-off, Australia has also provided expanded protection for a celebrity's economic interest in its name and image. The tort of passing off was once limited to solely preventing consumer confusion as to source of the particular goods. It is now recognized as a tool for the protection of merchandising and endorsement rights. Courts in Australia now cite to the tort of passing off as a basis for protecting one's right to promote or sponsor a particular line of goods or services, regardless of whether the celebrity is actually responsible for, or controls, the manufacturing or distribution of such products.¹⁰⁰

The Australian government, through the broad sweeping rights afforded under the 1995 Trademark Act, and the tort of passing off, appears to have filled at least part of the void resulting from its refusal to recognize any publicity rights.

IV. TRADEMARK LAWS MAY SUPPLEMENT OR COMPLIMENT RIGHTS SECURED THROUGH A RIGHT OF PUBLICITY

One of the clear limits of a right of publicity is that it almost always carries a finite term of protection. This potential limitation is in part cured by the trademark laws

discussed above. Each of the nation's trademark laws outlined above dictate that a trademark, so long as its use remains ongoing, can continue in perpetuity without expiration.

In each of the countries discussed in this paper, the trademark laws are controlled by uniform governing statutes. Thus, potential problems with lack of uniformity and predictability of a nation's right of publicity laws, (and in turn evaluating one's rights) are perhaps addressed when rights in a person's name or image are secured through trademark law. These laws also provide for consistent remedies and avenues of recourse.

Securing trademark rights in an individual's name and image may help overcome the potential hurdles of transferability that may sometimes attach to a right of publicity. A trademark, like traditional property, can be freely transferred and licensed. Most nations only permit the transfer of a trademark, if such transfer is accompanied by the goodwill and business used in connection with the mark. However, Australia's 1995 Trade Mark Act abolished even this restriction.

A weakness with using trademark law is that these protections will at all times remain subject to the core trademark principles, including that a trademark must serve the function of identifying source. If another's use of a person's name or image is not likely to cause consumer confusion, there will be no basis for a claim of trademark infringement. In contrast, the owner of a right of publicity may enforce such rights even if the owner has not used his or her name in commerce, and can enforce such rights against a third party defendant, even if no consumer confusion exists.

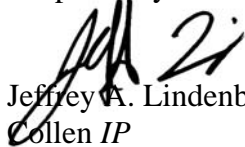
Finally, a right of publicity, at least during the life of the person, cannot be abandoned through non-use. This is also true in most states that recognize a post-mortem

right of publicity. In those states, although there is typically a statutory termination date (providing terms as long as 100 years after the person's death), non-use prior to this expiration will not result in abandonment of the rights.

V. CONCLUSION

Internationally, there are a number of approaches one may take to protect the economic value of names, images and likenesses. As always, the success of such efforts will depend in large part on the country and venue where such rights are sought to be enforced. Rights may be defined based on the domicile of the individual. Securing rights through trademark law (and through related claims such as passing off), may provide more predictability and uniformity. But these laws impose uncompromising restrictions, and in most instances cannot match the sweeping protections of a right of publicity. Until the right of publicity garners additional international recognition, support and uniformity, courts will undoubtedly see an increase in parties who lay claim to a hybrid of these rights in the hopes that the shortcomings and limitations of one area of the law, will be cured by the protections afforded by the other.

Respectfully submitted,



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January 31, 2009

¹ As this is a paper discussing international rights of publicity, it seems prudent to acknowledge that the term "Fifteen Minutes of Fame" as used in the title, derives from the late American artist, Andy Warhol's 1968 statement that "In the future, everyone will be world famous for 15 minutes."

² See, <http://www.forbes.com/2008/10/27/dead-celebrity-earning-biz-media-deadcelebs08_cx_mn_de_1027celeb_land.html>.

³ J. Thomas McCarthy, *The Rights of Publicity and Privacy*, § 1:3 (2d ed., rev. 2002); American Law Institute, *Restatement of Law, Third, Unfair Competition*, §§ 47-47 (1995).

⁴ Statutory protection for post-mortem right of publicity is expressly limited in some states to those individual's whose name, voice, likeness, etc., has commercial value at the time of his or her death. See, e.g., Cal. Civ. Code § 3344.1(h); *Sinkler v. Goldsmith*, 623 F.Supp. 727 (D. Ariz. 1985).

⁵ For example, New York's Right of Privacy Statute was enacted in 1903.

⁶ U.S. Const. art. I, § 8, clause 8.

⁷ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. Ohio 2003).

⁸ J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 28:16 (4th ed., rev. Dec. 2008).

⁹ Cal. Civ. Code § 3344.1; see also, John W. Branch, *No respect for the Dead: Protecting Deceased Celebrity Personality Rights*, Patent and Trademark Journal, Vol. 76, No. 1883 (BNA Sept. 12, 2008).

¹⁰ *Milton H. Greene Archives v. CMG Worldwide Inc.*, 2008 U.S. Dist. LEXIS 22213 (C.D. Cal. Jan. 7, 2008); *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, 2008 U.S. Dist. LEXIS 71690 (C.D. Cal. Mar. 17, 2008).

¹¹ N.Y. Civ. Rights Law §§ 50, 51.

¹² A Bill was recently introduced in New York which aims at revising New York's laws to provide for post-mortem rights of publicity. Because of staunch opposition, to date it has not been approved. A.B. 8836, 2007-08 Reg. Sess. (N.Y. 2007).

¹³ N.R.S. § 597.800.

¹⁴ *Id.* at § 597.800(5); see also, *Fifty-Six Hope Road v. Mayah Collections, Inc.*, 05-cv-1059, D.E. 102 at 6 (D. Nev. 2007).

¹⁵ *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

¹⁶ *Id.* at 463.

¹⁷ *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

¹⁸ *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. Pa. Sept. 9, 2008)

¹⁹ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

²⁰ *Wendt v. Host Int'l.*, 125 F.3d 806 (9th Cir. 1997).

²¹ *Id.* at 811 (holding that "California's common-law right of publicity protects more than the knowing use of a plaintiff's name or likeness for commercial purposes . . . It also protects against appropriations of the plaintiff's identity by other means").

²² J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 28:45 (4th ed., rev. 2007).

²³ J. Thomas McCarthy, *The Right of Publicity and Privacy*, 2 Rights of Publicity and Privacy, § 9:19 (2nd ed. 2007).

²⁴ *Id.*

²⁵ See, <http://www.forbes.com/2008/10/27/dead-celebrity-earning-biz-media-deadcelebs08_cx_mn_de_1027celeb_land.html>.

²⁶ The New York action was initially commenced in federal court in the State of Indiana.

²⁷ *Shaw Family Archives Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309 (S.D.N.Y. 2007).

²⁸ To date, the only state which seems to have carved out a statutory exception to this rule is the State of Washington, which holds that a post-mortem right of publicity shall exist, regardless of whether the domicile of the individual at the time of death does not recognize such rights. See, Wash. Rev. Code § 63.60.010.

²⁹ *Id.* at 315.

³⁰ *Id.*

³¹ *The Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, 2:05-CV-02200 (D.E. 269) (C.D. Cal. May 14, 2007).

³² *Id.* at 36.

³³ An exception to this rule is the State of Tennessee. Tennessee's code states that the post-mortem right continues for 10 years after the death of the individual. It then provides, however, that the right may be terminated if there is proof of non-use for two consecutive years after the initial 10-year term. See, Tenn. Code Ann. § 47-25-1104. It comes as no surprise that the state with the broadest post-mortem terms would be Tennessee, as this is the home state of the late, and still highly revered, Elvis Presley.

³⁴ Cal. Civ. Code § 3344.1.

³⁵ N.R.S. 597.800 *et seq.*

³⁶ *Id.*

³⁷ *Sinckler v. Goldsmith*, 623 F.Supp. 727 (D. Ariz. 1985).

³⁸ U.S. Const. Amend. I.

³⁹ Restatement (Third) of Unfair Competition § 47 (1995).

⁴⁰ *Id.*

⁴¹ *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. N.Y. 1989).

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Comedy III Prods. v. Gary Saderup*, 25 Cal. 4th 387, 409 (Cal. 2001).

⁴⁵ The court described the fantasy baseball league as follows: “Before the commencement of the major league baseball season each spring, participants form their fantasy baseball teams by “drafting” players from various major league baseball teams. Participants compete against other fantasy baseball “owners” who have also drafted their own teams. A participant’s success, and his or her team’s success, depends on the actual performance of the fantasy team’s players on their respective actual teams during the course of the major league baseball season.” *C.B.C. Distrib. & Mktg. v. Major League Baseball Advanced, L.P.*, 505 F.3d 818, 820 (8th Cir. 2007).

⁴⁶ *Id.*

⁴⁷ Ellen S. Bass, *A Right in Search of a Coherent Rationale – Conceptualizing Persona in a Comparative Context: The United States Right of Publicity and German Personality Rights*, 42 U.S.F.L. Rev. 799, 829 (May 2, 2008).

⁴⁸ *Id.*

⁴⁹ *Id.* at 831.

⁵⁰ *Id.* at 837 (*citing*, NJW 1979, 2205 (2205) (*Fussballtor*)).

⁵¹ *Id.* at 840.

⁵² *Id.*, (*quoting*, GRUR 1987, 128 (Nena) *translated in* 19 IIC at 269).

⁵³ *See*, Bundesgerichtshof [BGH] [Federal Court of Justice] Dec. 1, 1999, 143 (translation available at http://www.utexas.edu/law/academics/centers/transnational/work_new/german/case.php?id=726).

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ Mary LaFrance, *Identical Cousins?: On the Road with Dilution and the Right of Publicity*, 24 Santa Clara Computer & High Tech. L.J. 641, 665 (*citing*, *Lyngstad v. Anabas Prods., Ltd.*, [1977] F.S.R. 62 (Ch.); *Halliwell v. Panini* (unreported, June 6, 1997)).

⁵⁷ *Id.*

⁵⁸ *Id.* (*citing*, *Campbell v. Mirror Group Newspapers, Ltd.*, [2004] UKHL 22, [2004] E.M.L.R. 15).

⁵⁹ *Id.* (*citing*, *Douglas v. Hello Ltd.*, [2003] EWHC (Ch) 786, [2003] E.M.L.R. 31).

⁶⁰ *Id.* at 677; Mitchell Silberberg & Knupp, LLP, February 2002 Newsletter; Rosina Zapparoni, *Propertising Identity: Understanding the United States Right of Publicity and Its Implications – Some Lessons for Australia*, 2004 MULR 23 (2004).

⁶¹ *Id.* (*citing*, *Henderson v. Radio Corp. Pty*, 60 N.S.W.St. R. 576, 603-04 (1960) (finding false endorsement where dancers’ images were used on a dance record).

⁶² *See*, Kenneth Nguyen, *Bikini-clad celebrities stripped bare by privacy laws*, *The Age*, August 19, 2006, available online at www.theage.com.au.

⁶³ *Id.*

⁶⁴ J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*” § 18:3 (4th ed., rev. Dec. 2008).

⁶⁵ *Id.* at § 13:2.

⁶⁶ *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 13 (1st Cir. Mass. 2008).

⁶⁷ *See*, Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

⁶⁸ *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

⁶⁹ *Id.* at 1363.

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.*

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- ⁷⁴ *Id.*
- ⁷⁵ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. Ohio 2003).
- ⁷⁶ *See*, 1995 Trade Marks Act § 4 (translation available at <http://www.wipo.int/clea/docs_new/pdf/en/de/de057en.pdf>, *see generally*, Martha P. Sender, *Case Law: Sabel v. Puma*, 5 Colum. J. Eur. L. 135 (1998).
- ⁷⁷ *Id.*, *see also*, <http://www.dpma.de> (website maintained by the German Patent and Trademark Office).
- ⁷⁸ 1995 Trade Marks Act at § 4.
- ⁷⁹ *Id.*
- ⁸⁰ *Id.* at § 47.
- ⁸¹ *Id.* at § 25.
- ⁸² *Id.* at § 27.
- ⁸³ *Id.*
- ⁸⁴ *Id.* at § 3.
- ⁸⁵ *Marlene Dietrich Case* BGH 1 ZR 49/97 (Dec. 1999) (translation available at http://www.utexas.edu/law/academics/centers/transnational/work_new/german/case.php?id=726).
- ⁸⁶ *Id.* at § 21.
- ⁸⁷ *Id.*
- ⁸⁸ *See*, U.K. Trademarks Act 1994, (available online at <http://www.opsi.gov.uk/acts/acts1994/ukpga_19940026_en_2>).
- ⁸⁹ 1997 R.P.D. & T.M. 543 (Ch.) (Eng.) (Laddie, J.); *see also*, <<http://www.ipo.gov.uk/ipcass/ipcass-alphabetical/ipcass-alphabetical-ae/ipcass-elvis.htm>>.
- ⁹⁰ 1970 R.P.D. & T.M. 450 (C.A.) Eng.
- ⁹¹ *Elvis*, 1997 R.P.D. & T.M. at 554; Hayley Stallard, *Symposium International Rights of Publicity: The Right of Publicity in the United Kingdom*, 18 Loy. L.A. Ent. L.J. 565, 569-70 (1998); Alan Story, *Owning Diana: From People's Princess to Private Property*, available online at <<http://webjcli.ncl.ac.uk/1998/issue/5story5.html>> (1998).
- ⁹² *Erven Warnink BV v J Townend & Sons (Hull) Ltd (No.1)* [1979] 2 All E.R. 927 (Eng.); 18 Loy. L.A. Ent. L.J. at 570-71.
- ⁹³ 1995 Trademark Act, available online at <<http://scaleplus.law.gov.au/html/pasteact/2/1223/top.htm>>.
- ⁹⁴ (1990) 18 IPR 185 (Fed CA) at 194; Jeremy Curthoys, *Ambush Marketing and the Sydney 2002 Games (Indicia and Images) Protection Act: A Retrospective*, Murdoch Univ. Elec. J. of Law, Vol. 8, No. 2 (2001).
- ⁹⁵ *Id.*
- ⁹⁶ *Id.* at Section 17.
- ⁹⁷ Hillary May Black, *The Role of Trade Mark Law in the Protection of Celebrity Personality: The Scope of Trademark Protection* (March 2002), available online at <<http://www.findlaw.com/au/articles/default.asp?task=read&id=4620&site=LE>>.
- ⁹⁸ 1995 Trademark Act, *supra* n.67 at § 21.
- ⁹⁹ *Id.* at § 106(3) (emphasis added).
- ¹⁰⁰ Rosina Zapparoni, *Propertising Identity: Understanding the United States Right of Publicity and Its Implications – Some Lessons for Australia*, 2004 MULR 23 (2004) (citing, *Radio Corp. Pty Ltd. v. Henderson*, [1960] NSW 279).