To avoid preemption, should the right of publicity be subject to limiting doctrines like those of copyright law, particularly fair use? As you read in the Note on Rights of Publicity, Chapter 4.D, pages 265-67 *supra*, the right has become extremely broad, protecting almost anything that conjures up a celebrity's image. The following excerpt from Judge Kozinski's dissent in the Ninth Circuit's denial of en banc rehearing in *White v. Samsung Electronics America, Inc.* (described briefly in that Note) discusses the relationship between copyright preemption and the scope of publicity rights.

White v. Samsung Electronics America, Inc.

989 F.2d 1512 (9th Cir. 1993) (en banc)

KOZINSKI, J., with whom O'SCANNLAIN, J. and KLEINFELD, J. join, dissenting from the order rejecting the suggestion for rehearing en banc. . . .

II

. . . The ad that spawned this litigation starred a robot dressed in a wig, gown and jewelry reminiscent of Vanna White's hair and dress; the robot was posed next to a Wheel-of-Fortune-like game board. . . . The caption read "Longest-running game show. 2012 A.D." The gag here, I take it, was that Samsung would still be around when White had been replaced by a robot.

Perhaps failing to see the humor, White sued, alleging Samsung infringed her right of publicity by "appropriating" her "identity." . . .

[The panel majority held that t]he California right of publicity can't possibly be limited to name and likeness. If it were, the majority reasons, a "clever advertising strategist" could avoid using White's name or likeness but nevertheless remind people of her with impunity, "effectively eviscerat[ing]" her rights. To prevent this "evisceration," the panel majority holds that the right of publicity must extend beyond name and likeness, to any "appropriation" of White's "identity" — anything that "evoke[s]" her personality. . . .

III

But what does "evisceration" mean in intellectual property law? Intellectual property rights aren't like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant. They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation. I can't publish unauthorized copies of, say, *Presumed Innocent*; I can't make a movie out of it. But I'm perfectly free to write a book about an idealistic young prosecutor on

trial for a crime he didn't commit. So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I "eviscerated" Scott Turow's intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy. . . .

. . . Intellectual property rights aren't free. They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.

This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us: The relatively short life of patents; the longer, but finite, life of copyrights; copyright's idea-expression dichotomy; the fair use doctrine; the prohibition on copyrighting facts; the compulsory license of television broadcasts and musical compositions; federal preemption of overbroad state intellectual property laws; the nominative use doctrine in trademark law; the right to make soundalike recordings. All of these diminish an intellectual property owner's rights. All let the public use something created by someone else. But all are necessary to maintain a free environment in which creative genius can flourish.

The intellectual property right created by the panel here has none of these essential limitations: No fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of "appropriation of identity," claims often made by people with a wholly exaggerated sense of their own fame and significance. . . . Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own. The public will be robbed of parodies of celebrities, and our culture will be deprived of the valuable safety valve that parody and mockery create. . . .

IV

The panel, however, does more than misinterpret California law: By refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act. Samsung didn't merely parody Vanna White. It parodied Vanna White appearing in "Wheel of Fortune," a copyrighted television show, and parodies of copyrighted works are governed by federal copyright law.

Copyright law specifically gives the world at large the right to make "fair use" parodies, parodies that don't borrow too much of the original. . . . Federal copyright law also gives the copyright owner the exclusive right to create (or license the creation of) derivative works, which include parodies that borrow too much to qualify as "fair use." . . .

The majority's decision decimates this federal scheme. It's impossible to parody a movie or a TV show without at the same time "evok[ing]" the "identit[ies]" of the actors. You can't have a mock *Star Wars* without a mock Luke Skywalker, Han Solo and Princess Leia, which in turn means a mock Mark Hamill, Harrison Ford and Carrie Fisher. You can't have a mock *Batman* commercial without a mock Batman, which means someone emulating the mannerisms of Adam West or Michael Keaton. . . . The public's right to make a fair use parody and the copyright owner's right to license a derivative work are useless if the parodist is held hostage by every actor whose "identity" he might need to "appropriate." . . .

. . . It's our responsibility to keep the right of publicity from taking away federally granted rights, either from the public at large or from a copyright owner. We must make sure state law doesn't give the Vanna Whites and Adam Wests of the world a veto over fair use parodies of the shows in which they appear, or over copyright holders' exclusive right to license derivative works of those shows. In a case where the copyright owner isn't even a party — where no one has the interests of copyright owners at heart — the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit.

V

The majority's decision also conflicts with the federal copyright system in another, more insidious way. Under the dormant Copyright Clause, state intellectual property laws can stand only so long as they don't "prejudice the interests of other States." . . . [T]he right of publicity isn't geographically limited. A right of publicity created by one state applies to conduct everywhere, so long as it involves a celebrity domiciled in that state. If a Wyoming resident creates an ad that features a California domiciliary's name or likeness, he'll be subject to California right of publicity law even if he's careful to keep the ad from being shown in California. . . .

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. Under the majority's approach, 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.

This is an intolerable result, as it gives each state far too much control over artists in other states. 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. . . .

VII

For better or worse, we *are* the Court of Appeals for the Hollywood Circuit. Millions of people toil in the shadow of the law we make, and much of their livelihood is made possible by the existence of intellectual property rights. But much of their livelihood — and much of the vibrancy of our culture — also depends on the existence of other intangible rights: The right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun, the cultural icons of our time.

In the name of avoiding the "evisceration" of a celebrity's rights in her image, the majority diminishes the rights of copyright holders and the public at large. In the name of fostering creativity, the majority suppresses it. Vanna White and those like her have been given something they never had before, and they've been given it at our expense. I cannot agree.

NOTES AND QUESTIONS

1. What do you think of Judge Kozinski's dissent? Can you translate it into a legal argument using the two-pronged analysis of §301? Can you translate it into a legal argument that relies on the Supreme Court's intellectual property preemption cases?

2. Does the First Amendment require limits on the right of publicity? In *Comedy III Productions, Inc. v. Saderup*, 25 Cal. 4th 387 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002), the court concluded that some (but not all) speech about celebrities must be shielded from right of publicity claims:

> Because celebrities take on public meaning, the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And because celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity images can be an important avenue of individual expression. . . .
>
> . . . [T]he very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the celebrity's meaning. . . .
>
> But having recognized the high degree of First Amendment protection for noncommercial speech about celebrities we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. . . .

Id. at 397-99. To separate protected from unprotected expression in the right of publicity context, the court adopted a test modeled loosely on copyright's fair use doctrine:

> . . . [T]he first fair use factor — "the purpose and character of the use" . . . does seem particularly pertinent to the task of reconciling the rights of free expression and publicity. . . .
>
> . . . [W]hen 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. . . .
>
> Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word "expression," we mean expression of something other than the likeness of the celebrity.

Id. at 404-06. The court held that the disputed creations — T-shirts bearing defendant's drawing of the Three Stooges — were insufficiently transformative and affirmed an award of damages and attorneys' fees totaling $225,000.

Because rights of publicity are state rights, federal courts adjudicating California right of publicity claims are bound by the judicially crafted limit on the right of publicity announced by the *Saderup* court. Would the *Saderup* rule have changed the result in *White v. Samsung*? Note that unlike the T-shirts at issue in *Saderup*, Samsung's television commercials would be considered "commercial speech," which the Supreme Court has defined as speech proposing a commercial transaction. *See Va. Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976). The *Saderup* court noted in passing that "the right of publicity may often trump the right of advertisers to make use of celebrity figures." *Saderup*, 25 Cal. 4th at 396. Should some commercial speech about celebrities also be excused under a transformative use standard? Would the Samsung commercials qualify?

3. Look again at footnote 22 in the *Baltimore Orioles* case, page 732 *supra*. What if the TV station were broadcasting Zacchini's human cannonball act as part of its news broadcast? Should the station be able to broadcast it in its entirety? Note that *Brown v. Ames* describes the first

element of the tort as involving misappropriation "not . . . for a newsworthy purpose." 201 F.3d 654, 658 (5th Cir. 2000). Does this approach adequately safeguard First Amendment interests?

4. Does *Saderup* strike an appropriate balance between the public's need to evoke symbols of its time and the interests of the firms and individuals that create those symbols in recouping their investments?

5. Should the right of publicity exist at all? After you read the next section on misappropriation, a tort that is both more expansive and existed before the right of publicity, consider whether publicity rights are necessary.