

C. THE RIGHT OF PUBLICITY

The state law right of publicity¹ had its genesis in privacy-related concerns, but the right has evolved as a right separate from that of privacy and rests on a different policy basis. While the right of privacy protects against certain intrusions on a person's dignity, the right of publicity protects individuals against unauthorized (and uncompensated) appropriation of their identities for commercial purposes.

Although all individuals have rights of publicity, most disputes involve celebrities.² Such suits illustrate the difference between the rights of privacy and publicity:

Well known personalities connected with [the entertainment] industries do not seek . . . "solitude and privacy". . . . Their concern is rather with publicity, which may be regarded as the reverse side of the coin of privacy. . . . [A]lthough the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.

Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 203-04 (1968), cited in 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §28:4 at 28-6 (2003).

Courts have recognized the right of publicity as a property right and its infringement as a commercial tort. In general, to sustain a cause of action for infringement of the right of publicity, the plaintiff must show that she has a right in the identity (often also called "persona") at issue and that right was infringed by unauthorized use likely to cause damage to the identity's commercial value.

Recall the two requirements of §301(a) that must be satisfied before the Copyright Act will preempt a state law cause of action. On its face, a right of publicity claim seems to survive a preemption analysis because the "work" that is the subject of the action is not a "work[] of authorship . . . fixed in a tangible medium of expression and . . . within the subject matter of copyright." 17 U.S.C. §301(a). Instead, the work is a person's identity. Unfortunately, matters are not so simple. The identity is often portrayed in a medium associated with copyrighted works. Consider the following two cases.

===== *Baltimore Orioles, Inc. v. Major League Baseball
Players Association*
===== 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987)

ESCHBACH, J.: The primary issue involved in this appeal is whether major league baseball clubs [the Clubs] own exclusive rights to the televised performances of major league baseball players [the Players] during major league baseball games. . . .

[As part of their argument, the players alleged that the televised performances infringed their rights of publicity. The court determined that the telecasts were copyrightable and the

1. Some states have codified the right in statutes, while in others it remains a common law doctrine. In some states, such as California, individuals may have rights under both the relevant statute and common law.

2. Individuals may also sue for invasion of privacy for appropriation of their names or likenesses by another for commercial benefit, and most non-celebrities choose this route.

baseball clubs owned the copyrights in the telecasts rather than the players. It then turned to the question whether the Copyright Act preempted the right of publicity claims.]

2. Preemption under 17 U.S.C. §301(a)

Although the Clubs own the copyright to the telecasts of major league baseball games, the Players claim that broadcasts of these games made without their express consent violate their rights to publicity in their performances. For the reasons stated below, we hold that the Clubs' copyright in the telecasts of major league baseball games preempts the Players' rights of publicity in their game-time performances.

[The court then quoted §301(a) and noted its two-prong test for preemption:] First, the work in which the right is asserted must be fixed in tangible form and come within the subject matter of copyright as specified in §102. Second, the right must be equivalent to any of the rights specified in §106. . . .

a. Section 102 Test

The works in which the Players claim rights are the telecasts of major league baseball games. . . . [T]he telecasts are fixed in tangible form because they are recorded simultaneously with their transmission and are audiovisual works which come within the subject matter of copyright. The first condition for preemption is, therefore, satisfied.

The Players argue, however, that the works in which they claim rights are their performances, rather than the telecasts of the games in which they play, and that performances *per se* are not fixed in tangible form. They contend that, since the works in which they assert rights are not fixed in tangible form, their rights of publicity in their performances are not subject to preemption. We disagree. . . . The Players' performances are embodied in a copy, *viz*, the videotape of the telecast, from which the performances can be perceived, reproduced, and otherwise communicated indefinitely. Hence, their performances are fixed in tangible form, and any property rights in the performances that are equivalent to any of the rights encompassed in a copyright are preempted.

It is, of course, true that unrecorded performances *per se* are not fixed in tangible form. Among the many such works not fixed in tangible form are "choreography that has never been filmed or notated, an extemporaneous speech, 'original works of authorship' communicated solely through conversations or live broadcasts, and a dramatic sketch or musical composition improvised or developed from memory and without being recorded or written down." House Report at 131, *reprinted in* 1976 U.S. Code Cong. & Ad. News at 5747. Because such works are not fixed in tangible form, rights in such works are not subject to preemption under §301(a). Indeed, §301(b), which represents the obverse of §301(a), expressly allows the states to confer common law copyright protection upon such works. . . . Nonetheless, once a performance is reduced to tangible form, there is no distinction between the performance and the recording of the performance for the purpose of preemption under §301(a). Thus, if a baseball game were not broadcast or were telecast without being recorded, the Players' performances similarly would not be fixed in tangible form and their rights of publicity would not be subject to preemption. *See* Nimmer, §1.08[C] (using the example of a live broadcast of a baseball game). By virtue of being videotaped, however, the Players' performances are fixed in tangible form, and any rights of publicity in their performances that are equivalent to the rights contained in the copyright of the telecast are preempted.²²

22. An example illustrates this point. Take the case of *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), in which Hugo Zacchini sued a television station for violating his right of publicity by broadcasting the

The Players also contend that to be a “work[] of authorship that . . . [is] fixed in a tangible medium of expression” within the scope of §301(a), a work must be copyrightable. They assert that the works in which they claim rights, namely their performances, are not copyrightable because they lack sufficient creativity. They consequently conclude that because the works in which they claim rights are not works within the meaning of §301(a), their rights of publicity are not subject to preemption. There is a short answer to this argument. Congress contemplated that “[a]s long as a work fits within one of the general subject matter categories of section 102 and 103, . . . [section 301(a)] prevents the States from protecting it even if it fails to achieve Federal copyright because it is too minimal or lacking in originality to qualify.” House Report at 131, *reprinted in* 1976 U.S. Code Cong. & Ad. News at 5747. Hence, §301(a) preempts all equivalent state-law rights claimed in any work within the subject matter of copyright whether or not the work embodies any creativity. Regardless of the creativity of the Players’ performances, the works in which they assert rights are copyrightable works which come within the scope of §301(a) because of the creative contributions of the individuals responsible for recording the Players’ performances. Therefore, the Players’ rights of publicity in their performances are preempted if they are equivalent to any of the bundle of rights encompassed in a copyright.²⁴

b. Section 106 Test

A right under state law is “equivalent” to one of the rights within the general scope of copyright if it is violated by the exercise of any of the rights set forth in §106. . . . [A] right is equivalent to one of the rights comprised by a copyright if it “is infringed by the mere act of reproduction, performance, distribution or display.” . . .

In particular, the right to “perform” an audiovisual work means the right “to show its images in any sequence or to make the sounds accompanying it audible.” 17 U.S.C. §101 (definition of “perform”). Thus, the right to perform an audiovisual work encompasses the right to broadcast it. *See* House Report at 63, *reprinted in* 1976 U.S. Code Cong. & Ad. News at 5676-77 (“[A] broadcasting system is performing when it transmits . . . [a] performance . . . ; a local broadcaster is performing when it transmits the network broadcast;

entirety of his human cannonball act. *Zacchini* was decided before §301(a) became effective, but let us suppose that the same case arises again today. Assuming that *Zacchini* did not videotape or otherwise record his performance, his human cannonball act would not be fixed in tangible form and could not be copyrighted. Nonetheless, because the work in which he asserts rights would not be fixed in a tangible medium of expression, his right of publicity in his performance would not be subject to preemption. Thus, if a television station were to broadcast his act, he still could sue successfully for violation of his right of publicity in his performance. Merely that the television station might videotape its telecast would not grant the station a copyright in the broadcast of *Zacchini*’s performance or preempt *Zacchini*’s right of publicity. To be “fixed” in tangible form, a work must be recorded “by or under the authority of the author,” here *Zacchini*. *See* 17 U.S.C. §101 (definition of “fixed”). Because *Zacchini* did not consent to the telecast, the broadcast could not be “fixed” for the purpose of copyrightability and *Zacchini*’s right of publicity would not be subject to preemption.

Assume, however, that *Zacchini*, after the fashion of championship prize fights, transmitted his live act over closed-circuit television and simultaneously recorded it for later broadcast over a cable television network, and that the satellite signal for the closed-circuit show was intercepted and rebroadcast by a television station. *Zacchini* sues the station for violation of his copyright and his right to publicity. He would prevail on the copyright infringement claim only. . . . [B]ecause his act was videotaped, the work in which he asserts rights would be fixed in tangible form and thus copyrightable. Assuming *arguendo* that a right of publicity is equivalent to one of the rights encompassed in a copyright—a subject that we soon shall take up—his right of publicity in his performance would be preempted. . . .

24. The Players’ rights of publicity in their performances are preempted only if they would be violated by the exercise of the Clubs’ copyrights in the telecasts. A player’s right of publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player’s name to advertise its product . . . placed the player’s photograph on a baseball trading card . . . or marketed a game based upon the player’s career statistics. . . .

a cable television system is performing when it retransmits the broadcast to its subscribers. . . .”); *see also* Nimmer, §8.14[B]. Hence, a right in a work that is conferred by state law is equivalent to the right to perform a telecast of that work if the state-law right is infringed merely by broadcasting the work.

In this case, the Players claim a right of publicity in their performances. As a number of courts have held, a right of publicity in a performance is violated by a televised broadcast of the performance. . . . Indeed, from the start of this litigation, the Players consistently have maintained that their rights of publicity permit them to control telecasts of their performances, and that televised broadcasts of their performances made without their consent violate their rights of publicity in their performances. . . . Because the exercise of the Clubs’ right to broadcast telecasts of the games infringes the Players’ rights of publicity in their performances, the Players’ rights of publicity are equivalent to at least one of the rights encompassed by copyright, *viz.*, the right to perform an audiovisual work. Since the works in which the Players claim rights are fixed in tangible form and come within the subject matter of copyright, the Players’ rights of publicity in their performances are preempted.

The Players argue that their rights of publicity in their performances are not equivalent to the rights contained in a copyright because rights of publicity and copyrights serve different interests.²⁸ In their view, the purpose of federal copyright law is to secure a benefit to the public, but the purpose of state statutory or common law concerning rights of publicity is to protect individual pecuniary interests. We disagree.

The purpose of federal copyright protection is to benefit the public by encouraging works in which it is interested. To induce individuals to undertake the personal sacrifices necessary to create such works, federal copyright law extends to the authors of such works a limited monopoly to reap the rewards of their endeavors. . . . Contrary to the Players’ contention, the interest underlying the recognition of the right of publicity also is the promotion of performances that appeal to the public. The reason that state law protects individual pecuniary interests is to provide an incentive to performers to invest the time and resources required to develop such performances. In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), the principal case on which the Players rely for their assertion that different interests underlie copyright and the right to publicity, the Supreme Court recognized that the interest behind federal copyright protection is the advancement of the public welfare through the encouragement of individual effort by personal gain, *id.* at 576 . . . and that a state’s interest in affording a

28. The Players cite to four opinions to support their assertion that §301(a) does not preempt the right of publicity. *See Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 289 (2d Cir. 1981) (Mansfield, J., dissenting), *cert. denied*, 456 U.S. 927 (1982); *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *Apigram Publishing Co. v. Factors Etc., Inc.*, No. C 78-525, slip op. (N.D. Ohio July 30, 1980) (available on LEXIS); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 850, 603 P.2d 425, 448, 160 Cal. Rptr. 323, 346 (1979) (Bird, C.J., dissenting). Each opinion is premised upon an erroneous analysis of preemption. The *Factors* dissent, the *Bi-Rite* court, and the *Lugosi* dissent assert without discussion that the right of publicity is not preempted because the work that it protects—a public figure’s persona—cannot be fixed in a tangible medium of expression. We disagree. Because a performance is fixed in tangible form when it is recorded, a right of publicity in a performance that has been reduced to tangible form is subject to preemption.

The *Apigram* court stated without extended discussion or citation to authority that the right of publicity is not preempted because it requires additional elements other than the reproduction, performance, distribution or display of a copyrighted work. We disagree. . . . Contrary to the belief of the *Apigram* court, the right of publicity does not require an invasion of personal privacy to make out a cause of action. It is true that the rights of publicity and of privacy evolved from similar origins; however, whereas the right of privacy protects against intrusions on seclusion, public disclosure of private facts, and casting an individual in a false light in the public eye, the right of publicity protects against the unauthorized exploitation of names, likenesses, personalities, and performances that have acquired value for the very reason that they are known to the public. . . . Because the right of publicity does not require a qualitatively different additional element, it is equivalent to a copyright and is preempted to the extent that it is claimed in a tangible work within the subject matter of copyright.

cause of action for violation of the right to publicity “is closely analogous to the goals of patent and copyright law.” *Id.* at 573. . . . Because the right of publicity does not differ in kind from copyright, the Players’ rights of publicity in their performances cannot escape preemption. . . .

==== *Brown v. Ames*
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==== 201 F.3d 654 (5th Cir. 2000)
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JONES, J.: Appellants Collectibles and Ames principally appeal the district court’s determination that appellees’ state law claims for violation of their rights of publicity are not preempted by the Copyright Act. The misappropriation consisted of appellants’ unauthorized use of appellees’ names and likenesses to market appellees’ musical performances on CD’s and audio cassettes for which appellants also lacked copyrights. Because a person’s name and likeness in themselves are not copyrightable, and because the state law tort for misappropriation does not conflict with federal copyright law, appellees’ claims are not preempted. . . .

I. Factual and Procedural History

Collectibles is a record label that distributes and sells music recordings, especially repackaged vintage recordings. Ames is a music producer specializing in Texas blues. Appellees are individual blues musicians, songwriters, music producers or heirs of such.

Around 1990, Ames, d/b/a Home Cooking Records, licensed to Collectibles for commercial exploitation master recordings that included performances by appellees. The written license agreements also purported to give Collectibles the right to use the names, photographs, likenesses and biographical material of all those whose performances were on the master recordings. . . . Using the master recordings, Collectibles manufactured and distributed cassettes and CD’s, as well as music catalogs, with the names and sometimes the likenesses of the performers on or in them. . . .

In 1994, appellees sued Ames, Collectibles and Jerry and Nina Greene, the owners of Collectibles. . . . Appellees’ actions for copyright infringement, violations of the Lanham Act and for misappropriation of name or likeness under Texas state law proceeded to a jury trial. . . . The jury . . . found that the defendants had misappropriated the names and likenesses of the appellees and had infringed (in the case of Collectibles, innocently) copyrights held by some of the appellees. . . .

Collectibles and Ames have appealed. . . . [T]hey assert [*inter alia*] that the Copyright Act preempts the misappropriation claims. . . .

II. Discussion . . .

In Texas, the tort of misappropriation provides protection from the unauthorized appropriation of one’s name, image or likeness. . . . It is best understood as a species of the right of publicity or of privacy. . . . To prevail, a plaintiff must prove that (1) the defendant misappropriated the plaintiff’s name or likeness for the value associated with it and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) the defendant derived some advantage or benefit. . . .

Appellants argue strenuously that appellees have not presented an independent action for misappropriation. Because appellees’ names and/or likenesses were used to identify their