RAYMOND J. DOWD

Rights of Publicity: Elvis, Marilyn, and the Federal Courts

Why does Elvis Presley's estate control the lucrative rights to licensing photographs that contain Elvis's image and Marilyn Monroe's estate have no such rights? And how did it come about that federal courts have become a major forum for enforcing these seemingly inequitable laws?

America's athletes, politicians, experts, and celebrities make fortunes by endorsing products, services, and vacation destinations. In connection with this lucrative industry, federal courts are frequently called upon to interpret a type of intellectual property known as "rights of publicity." The right of publicity is an outgrowth of the right of privacy, but the two rights protect fundamentally different interests and must be analyzed separately. The right of privacy, which protects the right to an individual's self-esteem and dignity, ends at the person's death. The right of publicity, on the other hand, is an intellectual property right that protects the pecuniary right and interest in the commercial exploitation of a celebrity's identity. Because the right of publicity is a property right, rather than a dignitary right, it can extend beyond death and can be bought and sold.[1] Rights of publicity do not generally require evidence of consumer confusion.[2]

In some states, a right of publicity during an individual's life as well as after his or her death is recognized by statute. New York and Wisconsin have expressly re- jected a post-mortem right of publicity altogether. In still other states, the right of publicity itself and its extent is uncertain and has not been defined.[3] For example, a U.S. district court in Pennsylvania recently held that a user of a 13-second recording of a deceased announcer's voice required the permission of the announcer's estate. Rejecting the argument that the copyright laws preempt Pennsylvania's right of publicity laws, the court permitted a recovery since use of the voice was a "misappropriation of identity."[4] New York's statute dealing with the right of publicity confers the right to use an actor's image only within the state of New York so uses in Germany would not be prohibited.[5]

This patchwork of laws has created difficulty for federal courts. For example, in 2001, the Sixth Circuit found a right of publicity under Michigan law, even though no court in Michigan had expressly recognized such a right. The Sixth Circuit upheld an injunction enforceable only in those states recognizing a post-mortem right of publicity.[6] The Tenth Circuit recently permitted a case to proceed to a jury trial in which, after terminating an employee, the employer distributed promotional material with the name of the well-known employee who had been terminated.[7] The Illinois Right to Publicity Act enacted in 1999 prohibits using a person's name in a domain name or a metatag to sell pornography.[8]

The basic rule that all attorneys should know in tackling right of publicity questions is the following: If a client (even a nonprofit organization or a government agency) wishes to use a living person's image for purposes of trade or advertising, the client must get a written release. If the attorney is unsure about what constitutes trade or advertising, it is important to consult the case law, because the answers may vary and there are numerous gray areas.

Rights of publicity arise in contexts involving other legal rights. For example, a client may wish to use a copyrighted photograph in which a person's face appears. Therefore, the second basic rule to remember in dealing with rights of publicity is that your client may need permission from more than one person. Absent certain circumstances—known as "fair use," as described in 17 U.S.C. § 107 and applied in federal case law (related to scholarship, research, criticism, and news reporting, for example)—it is also necessary to obtain permission from the copyright holder of the photograph in question. The person or entity creating the photograph is generally the holder of the initial copyright.

The following scenario presents a simple example of the right of publicity. A magazine takes your photograph in connection with a news story about a community event in which you participated and publishes the photograph. You are not entitled to payment, because this use is not connected with trade or advertising. In addition, because the magazine is engaging in news reporting, the activity is absolutely protected by the First Amendment. Artists using your image without your permission may also be protected by the First Amendment.

But let's take our example a step further: Without your knowledge, the photographer puts the photograph portraying your image in a stock photography

database. You have signed no release and granted no permissions. You later find your photograph on a Web site or in a brochure being used to sell tanning lotion. This use has probably violated your right of publicity.

There are two main reasons that federal courts have developed so much of the case law involving rights of publicity. The first is that rights of publicity are usually tied up with other federal questions, such as copyright or trademark law, thus providing a plaintiff with the option to proceed in federal court. For example, if you are already famous, your persona may be considered a trademark. Use of your image might cause consumer confusion, and you may have federal rights under § 43(a) of the Lanham Act for a false endorsement claim.[9] If you are not famous, you may not have access to such federal rights, which may require proving your fame and showing that you have used your name as a trademark.

The second reason that federal courts have created so much case law dealing with the right of publicity is that many of these cases arise under federal diversity jurisdiction, because the cases involve distribution of goods and services via interstate commerce. The choice of law and choice of forum may determine the outcome in such cases; therefore, filing in a district court located in a friendly state may be critical. A recent federal district court decision extinguishing the alleged post-mortem rights of publicity claimed by the heirs of Marilyn Monroe's residuary estate is illustrative.

In 1994, more than three decades after Marilyn Monroe's death, Indiana passed a law granting celebrities descendible and freely transferable post-mortem rights for 100 years after death. In 1984, California passed a law granting post-mortem publicity rights, whereas New York grants no post-mortem publicity rights to celebrities. After Marilyn Monroe died in 1962, her estate went through probate. In 2001, a Delaware company called Marilyn Monroe LLC, was set up to hold the residuary assets of her estate. Marilyn Monroe LLC licensed CMG Worldwide Inc., an Indiana company, to exploit Marilyn Monroe's rights of publicity. In 2005, CMG threatened the Shaw Family Archives with litigation. The Shaw Family Archives owned and licensed the copyright in many iconic Marilyn Monroe photographs, such as the subway grate shot from "The Seven Year Itch." On Sept. 6, 2006, a T-shirt containing Marilyn Monroe's image from this shot and bearing the label "Shaw Family Archives" was allegedly purchased at an Indianapolis Target store. CMG filed suit in Indiana.

Before being served, the Shaw Family Archives filed suit for a declaratory judgment in the Southern District of New York. After motion practice and a decision involving conflicting interpretations of the law, the suit ended up in New York.[10] On May 7, 2007, Judge Colleen McMahon of the Southern District of New York held that the 1994 Indiana law did not apply retroactively to create rights of publicity that Marilyn Monroe did not possess at the time of her death in 1962.[11] Indiana's post-mortem publicity rights law did not grant any rights to the heirs of Marilyn Monroe, because no such rights existed at the time of Marilyn Monroe's death either in Indiana or in New York or California, the places of her domicile and death. The district court's ruling thus shut down a lucrative licensing operation in Indiana.

Elvis Presley's heirs do not share the fate of Marilyn Monroe's heirs. Elvis Presley died at Graceland in Tennessee, and his rights of publicity are governed by Tennessee law. The U.S. Court of Appeals for the Sixth Circuit has affirmed that Elvis Presley Enterprises Inc. owns numerous federal trademarks and Tennessee publicity rights to photographs of Elvis.[12] Tennessee law does not place any express time limits on post-mortem rights of publicity. Thus Elvis's rights of publicity will support a licensing industry for the foreseeable future.

Concerns about rights of publicity are no longer the exclusive province of celebrities. By virtue of the Internet, average Americans have invested in their online identities for commercial purposes and may be entitled to more than their proverbial 15 minutes of fame. The cases of Marilyn Monroe and Elvis Presley illustrate the uncertain role the rights of publicity will play in interstate commerce for years to come. **TFL**

Raymond J. Dowd is a partner with Dunnington Bartholow & Miller LLP in New York City. He is president of the Southern District of New York Chapter of the FBA and a member of the FBA Editorial Board. He is the author of Copyright Litigation Handbook *(West 2007).*

Endnotes

[1]*Herman Miller Inc. v. Palazetti Imports and Exports Inc.*, 270 F.3d 298, 324–326 (6th Cir. 2001).

[2]*Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003).

[3]*Id.* (collecting cases and surveying state statutes).

[4]*Facenda v. NFL Films Inc.*, 488 F. Supp. 2d 491, 501–503 (E.D. Pa. 2007).

[5]*Cuccioli v. Jekyll & Hyde Neue Metropol Bremen Theater Produktion GMBH & Co.*, 150 F. Supp. 2d 566, 575 (S.D.N.Y. 2001).

[6]*Id.* at 324–328.

[7]*King v. PA Consulting Group Inc.*, 485 F.3d 577, 591–592 (10th Cir. 2007) (invasion of privacy claim).

[8]*Flentye v. Kathrein*, 485 F. Supp. 2d 903 (N.D. Ill. 2007).

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

[10]*Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, 434 F. Supp. 2d 203 (S.D.N.Y. 2006).

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

[12]*Elvis Presley Enterprises, Inc. v. Elvisly Yours Inc.*, 936 F.2d 889 (6th Cir. 1991).