

Scope and Justification of the Right of Publicity

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Thank you to Professor June Besek, and thanks to everyone here at Columbia for the invitation. June, to correct one of your introductions here—Mark McKenna is too humble to say so, but in addition to being a widely recognized scholar, he was elected yesterday to the American Law Institute, which is well deserved given his immense contributions to Intellectual Property Law scholarship.¹

Mark and I have talked about this topic, in part in preparation for today, and so a lot of what I say is going to reflect some of what he has said, and I think that is fine. (There are worse things you can say about a scholar than, “oh, he sounds just like McKenna.”) One of the things that has come up in the discussions this morning and on this panel—which considers the scope of the Intellectual Property right of the Right of Publicity, and whether it is an Intellectual Property right or not—is the relationship between scope and justification. Mark’s comments suggest that there is no such relationship with respect to the Right of Publicity; or, that at least it is loose. The biggest contribution of Jennifer’s excellent book is to encourage us to think about the rights of publicity and the rights of privacy as different things that have—for odd historical reasons, some of them with a purpose—been lumped together.² And that we ought to try to think about them more separately and their justifications more separately.

When we say the scope of the right of publicity is problematic, that seems to be because it does not seem to have any limiting principle built into it—at least in terms of the positive definition of the right, as contrasted with negative limitations imposed in service of other policy interests such as freedom of expression. We can flesh out this intuition by looking at the mechanism of justification for the right that we see in the cases. If we say in any particular case, “this plaintiff ought to have the right or obtain the relief they are seeking against this defendant *because*,” the *because* usually does a lot of work. For example, in *Zacchini v. Scripps-Howard Broadcasting*, the

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1. A.L.I., *Members Elected October 2018*, <https://perma.cc/MLB5-R6AW> (last visited Feb. 19, 2019).

2. JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* (Harvard Univ. Press 2018).

because is that the plaintiffs worked really hard on their cannonball act.³ This theory of labor underlies a lot of the conceptualization of the right of publicity in Intellectual Property terms.⁴ But of course, once we accept labor as the justification for Intellectual Property in the Right of Publicity, whenever we invoke the Right of Publicity in a future case the justification comes with it, even if the future case doesn't have the same grounding in the moral claims of labor. This is how the law evolves through precedent and common law development: the scope of these kinds of rights can expand by accretion where the recognition of a right—or some aspect of the scope of the right in one case tethered to a particular justification present in that case—nevertheless adheres in future cases where that justification may not be present.

If we really are looking for an understanding of what the *proper* scope of the Right of Publicity or a Right of Privacy is—if we consider them separate—it ought to be as a matter of positive justification, as a matter of positive definition, and it ought to resist this type of accretion. We can consider some of the justifications that have come up. Some of them are Intellectual Property-like and some of them are not. The first Intellectual Property-like ones are typical copyright and patent justifications, such as Utilitarian Theory and the associated Incentive Thesis. Notwithstanding its presence in *Zacchini*,⁵ utilitarian theory is not a good fit for a lot of cases, if the idea is that we need the right to give people an incentive to create socially valuable things that they would not otherwise create. For example, it is not clear to me that the argument washes with respect to one's personal identity, at least, of the type that we would see protected in the more privacy-oriented cases. And so, keeping those kinds of justifications distinct—and tied to the factual predicates of the cases in which they are asserted—might do some work.

The second type of justification is a trademark theory—the False Endorsement theory that Mark identified as a matter of federal law under The Lanham Act, § 43(a)⁶—which makes sense in False Endorsement cases. But again, not all Right of Publicity cases are False Endorsement cases. *Zacchini*, for example, is not a false endorsement case, nor are most of the privacy-based cases that Jennifer identifies as the historical source of the modern right of publicity.⁷ Moreover, it is not clear—to the extent that the False Endorsement theory is premised as a kind of trademark theory—that it holds up on its own terms. One case that I recall—a district court

3. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

4. See, e.g., *White v. Samsung Elec. Amer.*, 971 F.2d 1395, 1399 (1992) (“Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.”).

5. *Zacchini*, 433 U.S. at 576 (“Ohio’s decision to protect petitioner’s right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court.”)

6. Mark McKenna, *Remarks on The Right of Publicity: Theory and Scope*, 42 COLUM. J.L. & ARTS 337 (2019).

7. Rothman, *supra* note 2, at 11-29.

case from a few years ago, *Amazon vs. Cannondale*,⁸ involved a False Endorsement theory about a celebrity athlete appearing in a catalog without her permission. The court twisted itself around to say that the plaintiff had a trademark in her identity, but that the good with which the mark was associated was *also* her identity.⁹ When we try to justify the right of publicity by analogizing to other areas of Intellectual Property, we do not necessarily end up in a place that we can coherently defend.

The third type of justification I want to talk about is the Privacy justification. There are a lot of people here more expert than I. Jennifer is obviously one of them. Danielle Citron, who we will be hearing from this afternoon, is one of them.¹⁰ And the interaction between privacy interests and First Amendment interests is important and worth talking about and something I do not want to say much about as a substantive matter. I will though say that it is the kind of justification that is irreducibly normative in a way that economic justifications tend not to be. That is to say, when we are talking about what we are entitled to as a matter of our privacy, we are talking about what we have a right to expect of one another as human beings, who have to live together in society, and who ought to treat one another in ways that we would want to be treated ourselves. There are obviously lots of different views on those normative issues, and implementing those views as a matter of positive law is complicated and, I think, a democratic challenge.

But we can draw some inferences from that task for the scope of the right of publicity—again, the subject of this panel. Some specifications of one’s privacy interests might be consistent, for example, with expansion of a privacy right after the death of the individual identified—to the extent that it is the kind of thing that we would expect for our fellow human beings to do for us even after we are gone. A notion of our obligations with respect to the privacy of the dead might indicate that the scope of a post-mortem right of publicity ought to be tailored to that particular set of obligations. For example, it might be the kind of right that can only descend to particular people who we think are very closely identified with the protection of that privacy interest. Or, it might be the kind of right that could be exercised as a right to exclude, but not a right to alienate, or not a right to include, precisely because once you can alienate it, or waive it in some context but not in others, it drives those exercising the right into a market, which takes us into the economic area that we typically associate with the right of publicity rather than privacy.

The final justification that we hear talked about quite a bit is the one I began with: the economic interest that derives from one’s labor. If we are going to try and tie rights, in particular economic rights, to labor, I think we face a number of challenges. This is a challenge that we see in other intellectual property contexts as well. If we

8. *Amazon Inc. v. Cannondale Inc.*, No. 99 N 571, 2000 WL 1800639, at *9 (D. Colo. July 24, 2000).

9. *Id.* (“This is not a typical trademark-infringement case, however. The question in a false-endorsement case is not whether the celebrity is in competition with the alleged wrongdoer, but, rather, whether the alleged wrongdoer has used the celebrity’s identity in such a manner as to confuse consumers as to the celebrity’s sponsorship or endorsement of the product In this case, Ms. Giove’s ‘goods’ are her skill and fame as a mountain bike racer.”).

10. Danielle Citron, *The Roots of Sexual Privacy: Warren and Brandeis & The Privacy of Intimacy*, 42 COLUM. J.L. & ARTS 383 (2019).

think that intellectual property rights attach by virtue of the moral claims of labor, we instantly run into the problem of scope. What is my labor worth, exactly? And why is what my labor is worth something that gives me a legal right to prevent you from accessing something that you want to access? Or doing something that you want to do? This is the question of proportionality, which is a deep complication of Lockean labor theories most famously illustrated by Robert Nozick in the example that he gave of pouring a can of tomato juice into the ocean.¹¹ When you mix your labor with the ocean, does that mean that you are entitled to the ocean? Clearly not.

In the context that we are talking about, where we have performers whose labor might be exploited by someone else without permission, the proportionality question is this: in what context is the performer's labor being exploited, and to what extent is the exploitation something that derives value from the performer's labor, as opposed to from the exploiter and *their* labor? Here, I think of *Comedy III Partners v. Saderup*, where a lifelike but skilled representation of the Three Stooges was put on merchandise by the defendant after the Three Stooges death.¹² There are justifications in that case of an intellectual property right premised on the labor of the people whose only labor was having existed, at least with respect to the t-shirts and things that the defendant was selling.

Where we are dealing with claims that derive from labor—and I think the clearest present-day example is the digital replicas of actors such as Peter Cushing in *Star Wars* and so forth¹³—we run into these questions of proportionality and an inevitable slippery slope. In the digital replicas scenario, the most pressing danger is not that my labor will be taken without my permission. Rather, it is that my labor will become obsolete. It is that you will no longer need an actor when you can have a digital replica doing the same thing. If that is something that concerns us, then I think we need a substantive justification that is far deeper than “I worked hard for this.” We need some justification that addresses how our connection to our labor relates to how we expect to be treated as human beings. That claim is analogous to the privacy interests that underlie the historical claims I discussed earlier. It is, as I said in that context, primarily a democratic, normative, and political challenge.

11. ROBERT NOZICK, *ANARCHY, STATE AND UTOPIA* 175 (1974).

12. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (2001).

13. Joseph Walsh, *Rogue One: The CGI Resurrection of Peter Cushing is Thrilling—but is It Right?*, *GUARDIAN* (Dec. 16, 2016, 3:55 PM), <https://perma.cc/STS4-GTQ2>.