

The Copyright Act's Preemption of Right of Publicity Claims

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The statutory or common law of most states permits claims for misappropriation of one's name or likeness for commercial purposes. Such claims are often referred to as "right of publicity" claims. Although historically treated as a species of the tort of invasion of privacy, such claims are now generally recognized as involving a form of intellectual property, particularly in connection with celebrities who assert not a "right to be left alone" but rather the right to control and profit from the use of their names and images. Such claims may conflict with federal copyright law, particularly with respect to the use of photographs, video, and sound recordings. This is true in particular when the party asserting a right of publicity claim does not hold the copyright to the work at issue.

The Copyright Act contains an express preemption clause, which provides that it preempts conflicting state law to the extent that a state law grants rights equivalent to those granted by the Copyright Act. However, because the Copyright Act does not define *equivalent rights*, there is ambiguity with respect to when the Copyright Act preempts state right of publicity claims. The current split in court decisions, even within the same jurisdiction, reflects this ambiguity.

The courts nominally apply an abstract, two-part test in determining whether right of publicity claims will be preempted. In reality, however, decisions appear to turn on more pragmatic

factors. Recognition that these pragmatic factors may be determinative is important for anyone considering or litigating a right of publicity claim.

General Preemption Principles

The Constitution's Supremacy Clause provides that when state laws conflict with the objectives of federal laws or the Constitution, federal law will control.¹ Federal law preempts state law when (1) Congress expresses a clear intent to preempt state law within a statute; (2) it is clear, despite the absence of explicit preemptive language, that Congress has intended, by legislating comprehensively, to occupy an entire field of regulation; or (3) compliance with both state and federal law is impossible, or the state law stands as an obstacle to execution of congressional purposes and goals.²

Judicial Treatment of the Interaction Between the Right of Publicity and the Copyright Act

Interests Protected by the Right of Publicity

Misappropriation of name or likeness is a state statutory or common law tort. Although state laws vary, they generally provide a cause of action for the use of an individual's name, image, identity, or likeness by another, without permission, for commercial purposes.³ For example, California's right of publicity statute prohibits the use of "another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases . . . without such person's prior consent. . . ."⁴

Interests Protected by the Copyright Act

Section 102 of the federal Copyright Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with

the aid of a machine of device."⁵ A work is fixed in a tangible medium of expression "when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."⁶ Section 106 grants copyright owners the exclusive rights to reproduce their copyrighted work, to prepare derivative works, to distribute copies, to perform the work, and to publicly display the work.⁷ Photographs, movies, video and audio recordings, and other works that may include a person's image or voice are protected by copyright.⁸

Express Preemption of State Laws That Grant Equivalent Rights

Section 301 of the Copyright Act provides thus:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.⁹

Congress created § 301(a) "for the principal purpose of eliminating the dual system of state and federal law and replacing it with a unified federal system."¹⁰

Inconsistent Application of Copyright Preemption to Right of Publicity Claims

The test adopted by the courts for determining whether state law claims are preempted by the Copyright Act is fairly uniform: (1) whether the subject matter of

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the state law claim falls within the subject matter of copyright under § 102 of the Copyright Act and (2) whether the rights asserted under state law are equivalent to rights created by § 601 of the Copyright Act.¹¹ However, both elements of this test present problems and have been the subject of inconsistent interpretations.

Judicial Interpretation of the Subject Matter of Right of Publicity Claims

Courts have struggled in defining whether the subject matter of a right of publicity claim is a person's likeness or voice, i.e., their "persona," or rather the movie, video, photograph, or sound recording containing the person's likeness or voice.¹²

Many courts have held that the use of an individual's persona, not the work in which the persona is depicted, is at issue in a right of publicity claim and that a right of publicity claim is not preempted because a persona cannot be copyrighted and thus the subject matter element of the usual test is not met.¹³ This is the position adopted by two influential treatises.¹⁴ Other courts, however, have focused on the work in which a person's likeness or voice is used.¹⁵

Neither approach is entirely satisfactory. If the subject matter of a right of publicity claim is an individual's non-copyrightable persona, then no right of publicity claim would ever be subject to preemption. Yet courts have frequently found such claims to be preempted. On the other hand, it is certainly possible that a persona depicted in a copyrighted work could be exploited for commercial purposes in a manner that would support a legitimate claim for misappropriation.

Judicial Interpretation of Equivalent Rights

Section 301 does not define what it means for a right asserted in a state law action to be equivalent to one of the rights provided in the Copyright Act. Courts have generally applied the equivalent rights element in one of two ways: a state law right is equivalent to a right protected by copyright law if either (1) no additional element beyond exercise of one of the rights protected by the Copyright Act is required to violate the state law (the "extra element" test), or (2) the state law is violated simply by the exercise of a right protected by the Copyright Act.¹⁶

However, neither of these tests provides a clear or logically consistent basis

for determining whether or when right of publicity claims should be preempted.¹⁷ And in practice, courts tend to conflate the discussion of the equivalent rights element with the analysis of the subject matter element.¹⁸

In fact, although nominally applying the two-part subject matter and equivalent rights test, the courts have in fact taken a different, more pragmatic approach to determining when right of publicity claims will be preempted by the Copyright Act.

Actual Distinctions on Which Preemption Typically Depends

Courts have reached differing conclusions with respect to whether right of publicity claims are preempted by copyright law. However, a few general trends can be identified. First, right of publicity claims are neither consistently preempted nor uniformly allowed; rather, whether a claim is preempted is determined based on the nature of each individual claim. Second, to the extent that the only interest sought to be enforced through a right of publicity claim is the right to control the otherwise authorized reproduction or distribution of copyrighted works (as opposed to the use of a work for advertising purposes or the unauthorized distribution of a work), most courts have found that right of publicity claims are preempted by copyright law. Third, if a celebrity's name, voice, or likeness is used independently of any copyrighted work, a right of publicity claim probably will not be preempted.

A comparison of pairs of cases, often from the same jurisdictions, that reach different conclusions illustrates where most courts will draw the line.

Laws and Downing

For example, compare *Laws v. Sony Music Entertainment, Inc.*,¹⁹ with *Downing v. Abercrombie & Fitch*.²⁰ In *Laws*, the Ninth Circuit held that a right of publicity claim by a performer based on the authorized use of part of a copyrighted song in another song was preempted. The performer had transferred the copyright for her song to a record producer. The record producer licensed the song for sampling, with attribution, in another song. The performer claimed that the use violated her right of publicity. The court said, "Although California law recognizes an assertable interest in the publicity associated with one's

voice, we think it is clear that federal copyright law preempts a claim alleging misappropriation of one's voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium."²¹

On the other hand, in *Downing*, the Ninth Circuit held that a right of publicity claim based on the use of plaintiffs' images and names in a product catalog distributed by Abercrombie & Fitch was not preempted. Abercrombie purchased the rights to a photograph of several famous surfers from the photographer. It used the photograph and the names of the surfers in a product catalog to promote a line of clothing with a surfing theme. The court noted thus:

The photograph itself, as a pictorial work of authorship, is subject matter protected by the Copyright Act. See 17 U.S.C. § 101. . . .

However, it is not the publication of the photograph itself, as a creative work of authorship, that is the basis for Appellants' claims, but rather, it is the use of the Appellants' likenesses and their names pictured in the published photograph.²²

The Ninth Circuit subsequently distinguished the *Downing* case as follows:

Abercrombie went well beyond mere republication of the photograph. Without obtaining plaintiffs' consent to use their names and images, it also offered t-shirts exactly like those worn by the plaintiffs in the photo. We noted that the photograph itself was within the subject matter protected by the Copyright Act. But Abercrombie had not merely published the photograph. Rather, it published the photo in connection with a broad surf-themed advertising campaign, identified the plaintiffs-surfers by name, and offered for sale the same t-shirts worn by the plaintiffs in the photo. By doing so, it had suggested that the surfers had endorsed Abercrombie's t-shirts.²³

Daboub and Brown

Similarly, compare *Daboub v. Gibbons*²⁴ with *Brown v. Ames*,²⁵ both from the Fifth Circuit. In *Daboub*, the Fifth Circuit held that a right of publicity claim based on the performance and recording by the band ZZ Top of a

song written, performed, and recorded by another band many years earlier was preempted. The court found that plaintiffs' right of publicity claims "center[ed] on the improper copying of the song, an interest clearly protected by the Copyright Act."²⁶

On the other hand, in *Brown*, the Fifth Circuit held that a right of publicity claim by musicians based on the use of their names and likenesses on CDs and cassettes containing their copyrighted songs and on catalogues and posters promoting the CDs and cassettes was not preempted. The court noted thus:

[T]he tort of misappropriation of name or likeness protects a person's persona. A persona does not fall within the subject matter of copyright. It does not consist of "a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution." Furthermore . . . appellees' names and likenesses do not become copyrightable simply because they are used to identify the source of a copyrighted work. Therefore, their misappropriation claims do not fit the terms of § 301 preemption.²⁷

The Court distinguished its prior decision in *Daboub* as follows:

In *Daboub*, the plaintiffs alleged that ZZ Top had both infringed their copyright in and misappropriated one of their songs, and this Court held that section 301 of the Copyright Act preempted the state law misappropriation claim. The crucial difference between the two cases is that in *Daboub* the basis of the misappropriation claim, as well as the copyright infringement claim, was the song itself, bringing it within section 301's ambit, whereas here the basis of the misappropriation claim was defendants' use of plaintiffs' names and/or likenesses.²⁸

Baltimore Orioles and Toney

A similar contrast can be seen between *Baltimore Orioles v. Major League Baseball Players Ass'n*²⁹ and *Toney v. L'Oreal USA, Inc.*³⁰ In *Baltimore Orioles*, the Seventh Circuit held that baseball players' rights of publicity did not allow them to control the videotaping and broadcast of baseball games. Even though the court concluded that the baseball games themselves were not copyrightable, once they were fixed

in the tangible medium of videotape, they fell within the subject matter of the Copyright Act; and the rights asserted by the players to control the distribution or display of the video were equivalent to rights protected by the act.

Toney addressed a right of publicity claim by a model who had agreed to the use of her photograph in advertising and promoting hair care products for a limited period. A successor to ownership of the product line used the photograph beyond the agreed time. The Seventh Circuit held that the claim was not preempted. The court noted thus:

Applying the facts of this case to the requirements for preemption, we find that Toney's identity is not fixed in a tangible medium of expression. There is no "work of authorship" at issue in Toney's right of publicity claim. A person's likeness—her persona—is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this. . . . Unlike copyright law, "commercial purpose" is an element required by the [state right of publicity statute]. . . . Clearly the defendants used Toney's likeness without her consent for their commercial advantage. The fact that the photograph itself could be copyrighted, and that defendants owned the copyright to the photograph that was used, is irrelevant to the IRPA claim. The basis of a right of publicity claim concerns the message—whether the plaintiff endorses, or appears to endorse the product in question.³¹

AMCIPP Division and The Romantics

Recent cases have continued this pattern of reaching different conclusions under apparently comparable circumstances. For example, in *Brown v. AMCIPop Division*,³² an Illinois appellate court recently affirmed the denial of a motion to dismiss claims made by singer James Brown (subsequently deceased) against stock photography agency Corbis for licensing photographs of him for use by others. Brown did not dispute that Corbis held or had properly licensed the copyrights to the photographs. Nonetheless, it held that because it was "possible that the photos as displayed on Corbis's Internet Web page can be interpreted as tangible, the Publicity Act as applied here would not preempt copyrights."³³

The court did not explain why the photos being in some tangible form precluded copyright preemption (an odd conclusion, given that works are not subject to copyright protection unless fixed in a tangible medium). Nor did it explain its statement that the Illinois Publicity Act "would not preempt copyrights" when, in fact, the issue presented was precisely the contrary, i.e., whether the Copyright Act preempted Brown's right of publicity claim. This decision is troubling because it could prevent a photographer from licensing a photograph of a celebrity to anyone.

On the other hand, in *The Romantics v. Activision Publishing, Inc.*,³⁴ a federal court in Michigan held that the use of the song "What I Like About You" in the highly successful Guitar Hero video game could not support a right of publicity claim. Plaintiffs, members of the band that originally recorded the song, did not dispute that they were not the copyright holders nor that the video game producer had obtained a license to use the song from the music publisher that owned the copyright. The court held that "[p]laintiffs' 'identity' claims to the sound of the Song are essentially claims regarding the licensing of a copyrighted work, falling squarely within the 'subject matter' of the Copyright Act."³⁵

Thus, these two recent cases involving the conveyance of apparently valid copyright licenses reached entirely different conclusions.

Making Sense of It All

The cases described above do not turn on subject matter (i.e., whether the work at issue is copyrightable or is, at least, the kind of work to which the Copyright Act applies). Each of the cases rejecting preemption involved works (photographs depicting plaintiffs) that were within the subject matter of the Copyright Act.

Nor do the cases turn on any equivalency of the rights protected by copyright and by the right of publicity. Particularly in the *Downing*, *Toney*, and *Brown* cases, the right of publicity claim indisputably overlapped and interfered with the exercise of rights provided by the Copyright Act, i.e., the right to reproduce and display a copyrighted work.

Rather, in cases involving copyrighted works that include some aspect of an individual's persona, it appears that preemption usually turns on the specific use made of the copyrighted work. The

common elements of the cases finding that there is no preemption are as follows: (1) some use of the work beyond merely selling or distributing copies of the work itself, particularly the use of the image or work for purposes of advertising and promotion; and (2) an implication of endorsement by or association with the person depicted, particularly if he or she is a celebrity.³⁶

In addition, courts have often considered, either explicitly or implicitly, whether the case involves the authorized use of a copyrighted work.

A Pragmatic Test for Preemption

The right of publicity often conflicts not only with the Copyright Act's grant of affirmative rights to copyright holders and the public but also with the purposes of copyright protection.³⁷ The failure of courts to preempt the right of publicity in appropriate circumstances is harmful to copyright holders, licensees, and the public. It may deprive copyright holders of rights expressly granted by the Copyright Act and thereby limit the value of their works. It also disrupts the legitimate expectations of licensees, who have used works in reliance on licenses granted by copyright holders. Moreover, inconsistent and unpredictable application of federal preemption creates uncertainty for everyone involved: celebrities, copyright holders, and licensees. This results, perversely, in increased litigation because those who use copyrighted works cannot predict the consequences of a particular course of conduct and adjust their conduct accordingly and because the parties involved in a dispute cannot confidently predict the outcome and reach a resolution based on realistic expectations.

It is obviously impossible to establish any test that will produce a predictable result in all cases. This is particularly true because the right of publicity embraces several aspects of an individual's persona, i.e., name, image, voice, and "style," each of which may be treated quite differently under copyright law.

However, a clear safe harbor from certain right of publicity claims should be established so that those who comply with the requirements of the Copyright Act can be assured that they will not be subjected to liability under unpredictable interpretations of state law. At a minimum, right of publicity claims should be preempted unless the use at issue (1)

goes beyond the reproduction, display, distribution, or sale of a copyrighted or copyrightable work containing a person's name, likeness, or voice, for example a photograph, movie, or audio recording; and (2) states or implies the endorsement of products or services. Unless these elements are present, a right of publicity claim is the equivalent of a copyright claim and should be preempted. If the work at issue is reproduced, displayed, distributed, or sold by a copyright holder or licensee and does not suggest any endorsement, there should be no liability even if an individual's persona is used for a commercial purpose.

Whether or not the courts expressly embrace such a test, practitioners should recognize that it is being applied. Preemption should be considered in all cases in which right of publicity claims do not meet these criteria.

Conclusion

The Copyright Act preempts inconsistent state law claims. However, right of publicity claims are neither uniformly preempted nor uniformly exempt from preemption. The nominal test for preemption of right of publicity claims has produced a confusing and inconsistent body of law. At present, it is difficult to predict whether a right of publicity claim will be preempted by the Copyright Act. Whether representing claimants or defendants, practitioners need to consider the possibility of preemption in any case asserting a right of publicity claim. In doing so, they should focus on the pragmatic factors that the courts have employed in determining whether right of publicity claims are preempted rather than the abstract principles nominally employed in conducting the preemption analysis. ■

Endnotes

1. U.S. CONST. art. VI, § 1, cl. 2.
2. *See, e.g., Capital Cities Inc. v. Crisp*, 467 U.S. 691, 698–99 (1984).
3. *See, e.g., Rogers v. Grimaldi*, 875 F.2d 994, 1003–04 (2d Cir. 1989); *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1918 (1996).
4. CAL. CIV. CODE § 3344 (West 2007).
5. 17 U.S.C. § 102(a) (2007).
6. 17 U.S.C. § 101 (2007).
7. 17 U.S.C. § 106 (2007).
8. 17 U.S.C. § 102 (2007).
9. 17 U.S.C. § 301(a).
10. P. Stephen Fardy, *Feet of Clay: How the Right of Publicity Exception Undermines*

Copyright Act Preemption, TEX. INTELL. PROP. L.J. 443, 445–46 (Spring 2004).

11. *See, e.g., Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1137–38 (9th Cir. 2006); *Brown v. Ames*, 201 F.3d 654, 657 (5th Cir. 2000); *NBA v. Motorola, Inc.*, 105 F.3d 841, 848 (2d Cir. 1997).

12. Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 233–34 (Nov. 2002).

13. *See, e.g., Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003–05 (9th Cir. 2001); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005).

14. D. NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1][c] (1999); MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY § 11.13[C] (1997).

15. *See, e.g., Laws*, 448 F.3d at 1142 (“[Plaintiff’s] state tort action challenges control of the artistic work itself and could hardly be more closely related to the subject matter of the Copyright Act.”); *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1920–21, (1996) (“Here, in contrast, it was not merely appellants’ likenesses which were captured on film—it was their dramatic performances which are, as we have seen, copyrightable.”).

16. Rothman, *supra* note 12, at 227–28.

17. *Id.* at 229, 231.

18. *See, e.g., Downing*, 265 F.3d at 1004–05; *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362 (2000).

19. *Laws*, 448 F.3d at 1134.

20. *Downing*, 265 F.3d at 994.

21. *Laws*, 448 F.3d at 1141.

22. *Downing*, 265 F.3d at 1004.

23. *Laws*, 448 F.3d at 1141.

24. 42 F.3d 285 (5th Cir. 1995).

25. 201 F.3d 654 (5th Cir. 2000).

26. *Daboub*, 42 F.3d at 289.

27. *Brown*, 201 F.3d at 658 (citations omitted).

28. *Id.* (citation omitted).

29. 805 F.2d 663 (7th Cir. 1986).

30. 406 F.3d 905 (7th Cir. 2005).

31. *Toney*, 406 F.3d at 910.

32. 873 N.E.2d 954 (2007).

33. *Id.* at 963.

34. 532 F. Supp. 2d 884 (E.D. Mich. 2008).

35. *Id.* at 888–89.

36. The *Brown* decision appears to depart from this pattern, allowing a right of publicity claim to proceed even though Corbis's conduct amounted to no more than conveying the copyright work itself and there was no evidence of any implication of endorsement. However, the superficial and confused reasoning of that decision suggests that it is, and will remain, an outlier that does not reflect or establish a trend in the law.

37. Rothman, *supra* note 12, at 204.