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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@portfoliomedia.com

Copyright Preemption And The Right Of Publicity

--By Gil Peles, Proskauer Rose LLP

Law360, New York (April 29, 2010) -- Your client is a world famous pop musician named Red. Red's signature image is derived from her obsession with the color red. In fact, Red has never been seen in public wearing anything other than a red outfit. Red meticulously protects and controls all uses of her image.

Red signed a contract with a video game company to allow her likeness to be used as a character in the company's latest hit game, Pop Hero. Red's contract provides permission to use her likeness for the limited purpose of having her character in the game wear her signature outfit while singing her latest hit song -- "Scarlet."

To Red's horror, the company included a secret feature in the video game that allows a game player to manipulate her character to wear blue and green outfits while singing various songs not affiliated with Red. The video game company defends the feature, claiming that their copyright ownership of the video game precludes any claim by Red. What do you do?

This guest column will explore the interaction between copyright law and the right of persons to control the use of their name or likeness, or their right of publicity. Specifically, it will evaluate circumstances where copyright law will preempt a right of publicity claim. Illustrated by Red's Pop Hero dispute, the guest column will demonstrate that the specific nature of each right of publicity claim determines whether the claim can proceed.

Rights Protected by the Right of Publicity and Copyright Law

The right of publicity is a state-law based intellectual property right of a person to control the commercial use of his or her identity.[1] The right of publicity is currently recognized, either in statutory or common law form, in nearly every state.[2] California, for example, recognizes both a statutory and common law right of publicity.[3] California Civil Code section 3344 authorizes recovery of damages by any living person whose "name, photograph, or likeness" has been used without his consent for commercial purposes.[4]

California's right of publicity laws have been successfully invoked against a company that produced an advertisement featuring a robot version of game-show hostess

Vanna White,[5] a company that hired a sound-alike singer to imitate iconic singer Tom Waits in a commercial,[6] and a clothing catalogue that displayed pictures of famous surfers next to Abercrombie clothes.[7]

In contrast to the right of publicity, copyright law seeks to protect “original works of authorship fixed in any tangible medium of expression.”[8] “Works of authorship” include literary, musical, film, and dramatic works.[9] The Copyright Act grants rights “to reproduce the copyrighted work in copies,” “to prepare derivative works based upon the copyrighted work,” “to distribute copies ... to the public,” and “to display the copyrighted work publicly.”[10]

Unlike copyright, the “subject matter” of a right of publicity claim is not a particular performance, picture, or sound clip.[11] Rather, the right of publicity protects “the very identity or persona of the plaintiff as a human being.”[12] Thus, “[w]hile copyright in a given photograph may be owned by the person depicted in it, the exact image in that photograph is not the underlying “right” asserted in a Right of Publicity case.”[13] Instead, the names, identities, and personas of the persons depicted in a copyrightable picture are the subject matter of a right of publicity dispute.

Both copyright law and the right of publicity encourage an individual’s investment in his or her artistic labors.[14] While the two doctrines offer different types of protection, they necessarily interact because a person’s likeness or image will almost always be depicted in a copyrightable work. Consequently, courts are forced to balance the rights of copyright owners with the rights of the subjects of copyrighted works.

As the Ninth Circuit Court of Appeals has noted, “[o]n the one hand, we recognize that the holder of a copyright does not have ‘a license to trample on other people’s rights.’ On the other hand, however, the right of publicity is not a license to limit the copyright holder’s rights merely because one disagrees with decisions to license the copyright.”[15]

Copyright Preemption of the Right of Publicity

The interplay between copyright and the right of publicity produces more disarray and volatility than perhaps any other pair of intellectual property rights.[16] Over the past decade, various courts have attempted to clarify the boundaries between the two types of claims.

For example, in *Downing v. Abercrombie & Fitch*, the defendant clothing company obtained a copyright license of a photograph of the plaintiffs, famous surfers, and used the photograph in a clothing catalogue.[17] The catalogue showcased the surfers’ images and names next to the company’s clothing line.[18] The catalogue also offered for sale replicas of the surfers’ clothing, essentially presenting the surfers as models of the replica clothing line.[19] The surfers asserted a misappropriation of their rights of publicity. The clothing company countered by arguing that the claims were preempted by federal copyright law. [20]

The Ninth Circuit Court of Appeals rejected the clothing company’s preemption argument, holding “it is not the publication of the photograph itself, as a work of

creative authorship, that is the basis for [the surfers'] claims, but rather, it is the use of the [surfers'] likenesses and their names ..."[21] The court emphasized that claims for misappropriation of a person's "name or likeness" are not preempted by the Copyright Act, "notwithstanding the fact that [such] names or likenesses are embodied in a copyrightable photograph." [22]

On the other end of the spectrum, in *Laws v. Sony Music Entertainment, Inc.*, singers Jennifer Lopez and L.L. Cool J obtained a copyright license of a sound clip of the plaintiff's musical recording. [23] The singers then incorporated the licensed sound clip into a new song that became a hit. [24] The plaintiff sued the singers' record label, alleging a misappropriation of her name and voice by the use of her sound clip. [25]

The Ninth Circuit Court of Appeals held the plaintiff's right of publicity claims to be preempted by the Copyright Act because the claims were not derived from the plaintiff's "personal" identity or her voice, but rather the use of her copyrighted sound clip performance. [26] The court noted that 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." [27]

Similarly, in *Fleet v. CBS, Inc.*, actors sued CBS, owners of the copyright of a film in which they performed. [28] After the production of the film, the parties became embroiled in a dispute over the actors' salary amount. [29] The actors claimed the producer had not paid them and CBS's distribution of the film, without proper payment of the actors, violated their rights of publicity. [30]

The California Court of Appeal held the actors' right of publicity claims to be preempted by federal copyright law because the publicity claims were essentially derived from the copyrighted performances in the film and not the actors' identities. [31] According to the court: "[a] claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted." [32]

Reconciling *Abercrombie*, *Laws* and *Fleet* leads to the following conclusion: courts will look at the essence of a right of publicity claim to ascertain whether the claim is based on the misappropriation of an identity or the infringement of a copyright.

If the right of publicity claim is essentially a repackaged claim for the misappropriation of a specific copyright, such as the sound recording in *Laws* or the film in *Fleet*, the claim will be preempted by copyright law. In contrast, where the plaintiff's claims are based on a noncopyrightable personal attribute, such as the surfers' names and identities in *Abercrombie*, the claim will not be preempted.

Application to Pop Hero

Turning back to our scenario, Red seeks to assert a claim against the makers of Pop Hero for including a feature that allows a game player to manipulate her character likeness. Red will argue that such a feature is in breach of her contract with the company and in violation of her right of publicity. In response, the video game

company will assert that Red's claims are preempted by the company's ownership of the video game's copyright.[33]

Here, the video game company's preemption argument is unlikely to succeed. The company's alleged breach of contract involves its impermissible use of Red's name and likeness and not the impermissible use of a sound clip, performance, or the Pop Hero video game as a whole. In short, similar to the surfers in Abercrombie, the rights asserted by Red are not copyrightable and, accordingly, not preempted by the Copyright Act. [34]

Conclusion

Demonstrated by Red's hypothetical, each client's specific facts must be carefully evaluated prior to the filing of a right of publicity action. A claim that is premised on the misappropriation of a performance, film clip, or sound recording will likely be preempted by the Copyright Act. However, a claim based on the misappropriation of a likeness or identity will not be preempted even though the likeness is included in a copyrightable product.

--By Gil Peles, Proskauer Rose LLP

Gil Peles is an associate with Proskauer Rose in the firm's Los Angeles office and has represented various celebrities related to the misappropriation of their rights of publicity.

The opinions expressed are those of the author and do not necessarily reflect the views of Portfolio Media, publisher of Law360.

[1] J. Thomas McCarthy, The Rights of Publicity and Privacy, § 1:3 (2d ed. 2009).

[2] See website rightofpublicity.com/statutes (chronicling 19 states with statutory recognition of the right of publicity and 28 more states with common-law recognition).

[3] Comedy III v. Saderup, 25 Cal. 4th 387, 391 (2001).

[4] California Civil Code § 3344.

[5] White v. Samsung Electronics America, Inc., 971 F. 2d 1395 (9th Cir. 1992).

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

[7] *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

[8] 17 USCS § 102(a)

[9] *Id.* The Copyright Act lists eight general categories of copyrightable works: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works; (4) choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures; (7) sound recordings; and (8) architectural works.

[10] 17 U.S.C. § 106, *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 977 (9th Cir. 1987) (overruled on other grounds)

[11] The Copyright Act preempts state law claims if (1) the work at issue falls within the “subject matter” of the Act and (2) the rights that the plaintiff asserts under state law are “equivalent” to those protected by the Act. 17 U.S.C. § 301(a); *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209, 1212 (9th Cir. 1998)

[12] *Downing*, 265 F.3d at 1004 (quoting *McCarthy, Rights of Publicity and Privacy* § 11.13[C] at 11-72-73).

[13] *Id.*

[14] *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006).

[15] *Id.*

[16] See 1-1 *Nimmer on Copyright* § 1.01 (Noting that the interaction between copyright law and the right of publicity “has seen more volatility than just about any other doctrine canvassed throughout this treatise. Tremendous disarray punctuates the cases.”)

[17] *Downing*, 265 F.3d at 999-1000.

[18] *Id.*

[19] *Id.* at 1000.

[20] *Id.*

[21] *Id.* at 1003.

[22] *Id.* at 1004.

[23] *Laws*, 448 F.3d at 1136.

[24] *Id.*

[25] *Id.*

[26] *Id.* at 1141.

[27] *Id.*

[28] 50 Cal. App. 4th 1911, 1916 (1996).

[29] *Id.* at 1915.

[30] *Id.*

[31] *Id.* at 1924.

[32] *Id.*

[33] See, e.g., *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 58, 50 Cal. Rptr. 3d 607,615 (2006) (explaining that “[v]ideo games are expressive works entitled to as much First Amendment protection as the most profound literature.”).

[34] See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1031-32 (3d Cir. 2008) (holding that a sportscaster’s breach of contract and right of publicity claims were not preempted by copyright where the sportscaster’s contract allowed the

defendant to use the sportscaster's voice recordings in context of sports broadcasts, but not in context of television advertisements for videogame).
