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Phone: +1 212 537 6331 | Fax: +1 212 537 6371 | customerservice@portfoliomedia.com

Defending Right Of Publicity Claims

Monday, November 13, 2006 --- On January 27, 2005, a California jury awarded $15.6 million to a commercial model for two hours' work. In 1986, Russell Christoff, who later became known as the familiar face on the label of Taster's Choice coffee, posed for a two-hour photo shoot for the Nestle company.

He earned $250 and a promise that he would be paid $2,000 more if his image were used to promote Taster's Choice. Christoff never heard back from Nestle, and assumed his image had not been selected.

Sixteen years later, he saw his face on a jar of Taster's Choice. The rest is history. He won his suit for violation of his right of publicity – the jury awarded him $330,000 for the use of his image, plus 5% of Nestle's profits from its Taster's Choice brand.

Commercial models and session musicians, relatively low-paid workers in the entertainment and advertising fields, are beginning to understand the money that can be made in the litigation business. Combined with the ease with which someone's image or voice can be spread around the world on the Internet, right of publicity claims are fertile ground for lawsuits and emerging legal doctrines.

This article discusses two potential defenses to these claims; specifically, the arguments that such claims may be preempted by the Copyright Act and/or the Communications Decency Act.

In Laws v. Sony Music Entertainment Inc., 448 F.3d 1134 (9th Cir. 2006), the court held that plaintiff's claim for commercial misappropriation of her voice was preempted by the Copyright Act.

Plaintiff, a professional singer, complained that a sample of a song she recorded had been included in another song without her consent, thus violating her right of publicity under California law. Cal. Civ. Code § 3344 (1997) (creating liability for the use of another's "name, voice, signature, photograph, or likeness" on products or merchandise without such person's consent).

The defendant argued that Laws' claim was preempted by § 301 of the Copyright Act. Under § 301, a state law claim is preempted when two conditions are met: first, the state law must protect the same rights as are conferred by § 106 of the Act; and second, the state law must protect the same subject matter as is provided for by §§ 102 and 103 of the Act.

Here, the rights to create copies and derivative works of the first song were clearly rights protected by copyright. 17 U.S.C. § 106 (2000).

The defendant in Laws maintained that the subject matter at issue fell within the Copyright Act as well, arguing that, because § 102 of the Copyright Act extends copyright protection to "original works of authorship fixed in any tangible medium of expression," and defines a "work of authorship to include "sound recordings," Laws' claim fell within the subject matter of copyright. 17 U.S.C. § 101 (2000).

Laws anticipated this argument and contended that the right of publicity is substantially different from the rights of a copyright owner. Laws argued that while a copyright claim protects rights in a work of art, a right of publicity claim concerns the right to protect one's persona and identity.

She had recent law on her side. Five years earlier, in Downing v. Abercrombie and Fitch, 265 F.3d 994 (9th Cir. 2001) the court of reversed a holding preempting a right of publicity claim. In Downing, the defendant published a clothing catalogue using photographs and names of the plaintiffs, well-known surfing figures, without their authorization.

The Downing court recognized that the photograph was a pictorial work of authorship, and thus subject matter protected by the Copyright Act. The court held that it was not the publication of the photograph that was the basis of the claim; it was the use of the plaintiffs' names and likenesses: "'A Right of Publicity claim' is not [about] a particular picture or photograph of plaintiff.

Rather, what is protected by the Right of Publicity is that very identity or persona of the plaintiff as a human-being…" J. Thomas McCarthy, The Rights of Publicity and Privacy, § 11.13(C) 72-73 (1997).

In Toney v. L'Oreal U.S.A. Inc., 406 F.3d 905 (7th Cir. 2005), the court held that a right of publicity claim was not preempted. In Toney, plaintiff was a professional model who consented to the use of her likeness for a limited period on hair care product packaging.

Finding that the Illinois statute protected an individual's persona and identity, the court held that "Toney's identity is not fixed in a tangible medium of expression" and was not within the subject matter of copyright; thus the claim was not preempted. 406 F.3d at 910. See also Stanford v. Ceasars Entm't Inc., 430 F. Supp. 2d 749 (W.D. Tenn. 2006) (distinguishing Toney, and finding preemption of publicity claim because plaintiff was photographed as a character, and not as himself, so therefore his identity was not at issue).

The parties eventually settled on terms that have not been publicly disclosed.

Despite these precedents, Laws found that the right asserted was equivalent to a right encompassed by copyright. Laws held that Downing was different because the defendant had not only used the plaintiffs' pictures, but had also used their names as well.

The Laws court had more difficulty distinguishing Toney, where only the plaintiff's picture was used. Stating that it "express[es] no views on the correctness of Toney . . ." the court stressed that while the defendants in Toney had owned the copyright in the photograph and had agreed with Toney on certain limitations on its use, the defendant in Laws had not. 448 F.3d at 1142.

This may be a distinction without a difference, for the preemption test does not turn on who own a particular copyright. We are of the view that Laws and Toney are at odds with each other and we look forward to learning what other courts may say about this in the future.

A related issue is whether right of publicity claims based upon Internet uses are precluded by Section 230(e) of the Communications Decency Act (§ 230). The most recent federal court of appeals to run into this issue avoided it. In Almeida v. Amazon.com, Inc., 456 F.3d 1316 (11th Cir. 2006), the plaintiff's photograph was on the cover of a book sold on the Amazon.com web site.

Plaintiff had previously allowed the photographer a limited right to use her image. Plaintiff sued Amazon.com for violation of Florida's right of publicity statute. Fla. Stat. § 540.08 (1997).

The district court held that the defendant was immune from suit under § 230(c)(1), which says that no provider of an interactive computer service shall be "treated as the publisher or speaker of any information provided by another information content provider." In other words, since Amazon.com was not the original creator of the content, it could not be held liable.

On appeal, plaintiff argued that § 230 immunity was inapplicable, because § 230(e)(2) expressly provides that "nothing in this section shall be construed to limit or expand any law pertaining to intellectual property."

Since, according to plaintiff, the right of publicity is a "law pertaining to intellectual property," she should be entitled to proceed with her claim. Amazon.com argued that the right of publicity is a state law tort claim, akin to defamation, and is thus preempted.

Although the court's opinion recited both sides' arguments, it ultimately side-stepped the issue by holding that plaintiff did not state a claim under the Florida's statute: "Amazon did not use Almeida's image for trade, commercial, or advertising purposes as those terms are used in the statute." 456 F.3d at 1325.

Since the photo was not used to "directly promote" Amazon's product or service, the court found that plaintiff did not state a claim. The court declined to rule on the CDA issues, thus adding nothing to the jurisprudence about whether the right of publicity claim is an intellectual property right.

The strength of these new arguments, preemption of right of publicity claims by the Copyright Act or by the Communications Decency Act, may turn on whether the right of publicity is regarded as an intellectual property right, or a personal right akin to the right of privacy.

If the right is a property right, then the right itself may fall within the ambit of copyright. If, however, the right is construed more as a personal right to prevent others from using one's person or identity, like the right of privacy, which is a tort-based claim, then the claim may not fall within the subject matter of copyright. In such case, § 230 can apply, and the defendant may be shielded from liability.

Whether the right of publicity is more property based or privacy based cannot be stated with any certainty under these recent publicity decisions. One thing, however, seems clear. The Taster's Choice jury did not award the plaintiff a multimillion dollar award in order to compensate for his lost privacy and hurt feelings.

Indeed, the very amount of the award was calculated according to the market value of his services and the profits his image yielded to Nestle – something for which the California statute expressly provides. The Christoff case is currently being appealed . . .so stay tuned. We hope the decisions in Christoff and other cases will shed much needed light on publicity rights, copyright, and the interplay between the two.

--By Dori Ann Hanswirth and Joanna Wasick, Hogan & Hartson LLP

Ms. Hanswirth is a partner, and Ms. Wasick an associate, in the New York office of Hogan & Hartson LLP.