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A COMPARATIVE ANALYSIS OF NAME AND LIKENESS RIGHTS IN THE UNITED STATES AND ENGLAND

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The term right of publicity may appear, at first glance, to be relatively straightforward. However, the struggle of contemporary English and American law to define this term and to apply the rights which stem from it belie such straightforwardness. In the most general language, the right of publicity is the ability of an individual to "own, protect and commercially exploit his own name, likeness and identity."¹ The derogation, for monetary gain of this right, is accomplished by "the use without consent of the name, likeness or voice of another"² and when completed is known in American jurisprudence as the appropriation of personality.³

This form of appropriation is concerned exclusively with the unauthorized taking of an identifiable characteristic of a person, such that its use would be recognized by members of the public.⁴ This comment will not be concerned with other areas that border on this topic, such as defamation, copyright, trademark infringement or unfair competition. Appropriation will be discussed exclusively in relation to the individual characteristics of

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1. Rader, *The Right of Publicity - A New Dimension*, 61 J. PAT. OFF. SOC'Y 228 (1979).

2. Frazer, *Appropriation of Personality - A New Tort?* 99 L.Q. REV. 281 (1983).

3. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

4. *Id.* at 309.

private individuals and celebrities whose names and likenesses comprise a commercial identity.

This comment will initially examine English law regarding appropriation, using as a point of departure the early professional cases. It will then discuss the contemporary standard applied in modern actions under the theory of passing off, tracing the development of the theory. Thirdly, the right of privacy will be examined from the American perspective. The right of publicity, the fourth topic, is derived from the right of privacy. Finally, after a brief look at the extrajudicial source of the rules utilized by the British Advertising Industry, the comment will conclude with a discussion of the author's proposals for future legislation.

I. EARLY ENGLISH "PROFESSIONAL CASES"

The need to control the use of one's own name for commercial purposes was brought before the courts as far back as the year 1847 in the case of *Routh v. Webster*.⁵ *Routh* involved the request for an injunction to prevent the defendant from using the plaintiff's name, which had been incorrectly listed as a trustee in a prospectus issued by the defendant. The decision granting the injunction provided the initial recognition that such unauthorized use of an individual's name was fundamentally unjust. The force of the language used by Lord Langdale in rendering his opinion gave cause for optimism to other plaintiffs similarly situated: "What! Are they to be allowed to use the name of any person they please, representing him as responsible in their speculations, and to involve him in all sorts of liabilities . . . [c]ertainly not!"⁶ The use of an injunction was an effective means by which to protect against defendant Webster's appropriation, but in this case relief was predicated upon a theory of defamation, since the court feared that to hold otherwise would expose the plaintiff to liability.⁷ However, in the years to come, judicial relief in this or any other form was not as readily provided.

5. 50 Eng. Rep. 698 (M.R. 1847).

6. *Id.*

7. *Id.*

The following year produced the case of *Clark v. Freeman*.⁸ Lord Langdale was again requested to grant an injunction to the plaintiff, in this instance a prominent physician, to prevent the defendant from using his name in an advertisement for a fraudulent medicine. The use of the doctor's name was characterized not as a misappropriation, but rather as a potential libel.⁹ Lord Langdale was therefore not concerned with the issue arising out of a claim to protect against unauthorized use, but was instead requested to prevent the plaintiff from being defamed.¹⁰ Although it might appear that the liability which may arise in conjunction with a harmful product might equal that of a business misrepresentation, the injunction was denied.¹¹

Lord Langdale gave as his reason for the abrupt change of position the court's inability to "stay the publication of a libel."¹² However, his reasoning may more accurately be reflected by his comment: "I do not go along with the notion, that this physician, eminent as he is, and an honor to any country, has been seriously injured in his reputation by any such false statements as have been published by the defendant."¹³ Although Langdale described the conduct of the defendant in using the doctor's name without his consent as "disgraceful,"¹⁴ by denying relief he set the stage upon which well-known professionals and celebrities would struggle, mostly without success, to control the use of their names.

The absence of legal protection continued although criticized, for example, by the Earl of Selborne in the case of *In re Riviere's Trademark*.¹⁵ There, the *Clark* case was mentioned as establishing the proposition that unless a business interest is injured, there is no cause of action to sustain an application for injunction. The Earl of Selborne remarked on the artificial distinction between the harm to a business as opposed to a professional interest, stating: "Could not a professional man be injured in his profession by having his name associated with a quack

8. 50 Eng. Rep 759 (M.R. 1848).

9. *Id.*

10. *Id.* at 761.

11. *Id.* at 762.

12. *Id.*

13. *Id.* at 761-62.

14. *Id.* at 762.

15. 26 Ch.D. 48 (C.A. 1884).

medicine?"¹⁶ Unfortunately for professional plaintiffs, damage in the form of loss of respect by contemporaries is not as easily quantifiable as the loss of income or profit to a business.

The effect of *Clark v. Freeman* was felt stongly in the professional cases which followed in its wake. Of striking significance is the case of *Williams v. Hodge & Co.*¹⁷ In that case, the plaintiff was a well respected surgeon whose name was used in conjunction with a catalog advertisement for a standard surgical instrument.¹⁸ The basis of the plaintiff's complaint was that the advertisement would damage his reputation in the eyes of the medical profession, as the instrument offered in the catalogue was of a simple nature.¹⁹ Justice Kay, in delivering his opinion, conceded that "[t]he defendants had no more right to use the name of this eminent medical man than to take his purse."²⁰

In professing a characteristic omniscience assumed by Victorian judges, Justice Kay was compelled to add that he "could not conceive that anyone in the world would suppose this Gentleman's professional name would be in the least damaged by this most unscrupulous use of it."²¹ Here, the judge seems to use the same reasoning that Lord Langdale applied in *Clark*, by focusing on what each perceived to be a lack of monetary injury to a plaintiff physician. In both cases, withholding judicial protection was justified in spite of the ridicule to which the plaintiffs were exposed. Due to the defamatory nature of the defendant's act, the judgment indicates that the use of the surgeon's name as an independent wrong was never considered by Justice Kay. The professional cases, as discussed later, appear to present a significant obstacle to celebrities seeking to vindicate their own rights in appropriation cases.

The first demand for legal recognition of a property right in a name was raised in the case of *Du Boulay v. Du Boulay*.²² The case concerned the appellants' request that the respondent be

16. *Id.* at 53.

17. 4 T.L.R. 175 (1887).

18. *Id.*

19. *Id.*

20. *Id.*

21. *Id.*

22. 2 L.R.-P.C. 430 (1869).

permanently enjoined from assuming as his own the surname of Du Boulay.²³ The respondent's mother had formerly been a slave to the appellant's family, and had for a period of 23 years used the name Du Boulay without interference or objection.²⁴ After hearing all of the evidence, Judge Woodcock gave judgment in favor of the respondent.²⁵ With reference to the claim brought by the appellant, Judge Woodcock expressed his opinion by saying: "Thank [h]eaven, I know of no [l]aw which I can be called on to administer by which such an attempt can be supported."²⁶ The recognition of a proprietary right enabling one to exclude others from adopting a particular name was conclusively denied.²⁷ Although this ruling was intended to benefit only the particular respondent, it did so to the detriment of those who, in a professional capacity, invested time and labor into creating a market from which their name could attract revenue.

The reluctance of English judges to hold in favor of plaintiffs claiming the right to control the uses to which their names were applied continued until the case of *British Medical Association v. Marsh*.²⁸ The defendant in this action had used the initials "BMA" as the name for his chain of drug stores.²⁹ That these particular letters signify to the public the institution better known as the British Medical Association was known by the defendant.³⁰ By taking these letters for his own commercial venture, Mr. Marsh was attempting, the court determined, to mislead the public into believing that his drug stores were associated with one of England's most venerated institutions.³¹ The defendant advanced a most unusual argument in his attempt to exculpate himself, claiming that the initials were in fact nothing more than the first letter of each name in the drug store partnership: "Bushby, Marsh and Atkinson."³² This claim was found by Justice Maugham to be "an obvious and ridiculous un-

23. *Id.* at 431.

24. *Id.* at 431-32.

25. *Id.* at 435.

26. *Id.* at 433.

27. *Id.* at 434-35.

28. 48 R.P.C. 565 (1931).

29. *Id.*

30. *Id.* at 571.

31. *Id.*

32. *Id.*

truth.”³³ Relief in the form of an injunction was granted only due to a finding that “the acts of the defendant tend to injure the plaintiffs in their business both by tending to cause existing members of the Association to leave . . . and to cause qualified medical men not yet members . . . to abstain from joining.”³⁴ Thus, only due to the existence of a tangible monetary loss, was the court willing to provide a remedy.

The unwillingness of the English courts to abandon their rigid posture when faced with individual requests for protection against appropriation is also reflected in the case of *Dockrell v. Dougall*.³⁵ The facts involved another physician, Dr. Dockrell, who had attained distinction as a specialist.³⁶ As plaintiff in this case, he objected to the defendant’s use of his name in an advertisement circular, which purported to link the doctor with an endorsement of a potentially harmful elixir guaranteed to cure gout.³⁷ The plaintiff’s inability to establish a direct financial loss accruing from the advertisement proved fatal to his request for an injunction.³⁸

Judge Williams, having relied on the cases which preceded Dr. Dockrell’s claim, stated: “in this case . . . the plaintiff has failed to prove anything more than the use of his name by the defendant without authority.”³⁹ Having succinctly assessed the basis for the plaintiff’s claim, the denial of relief was ascribed to the lack of precedent to support Dr. Dockrell’s assertion.⁴⁰ Perhaps if the plaintiff had been held responsible for physical injury resulting from the purchase and consumption of the elixir, the court may have had the prerequisite damages upon which to base a recovery for the plaintiff. This holding clearly established that in the absence of pecuniary loss, a professional did not have a property right in his name, and as such was without protection against appropriation. This view was expressed in the concurring judgment of L.J. Romer:

33. *Id.*

34. *Id.* at 576.

35. 80 L.T.R. 556 (1899).

36. *Id.*

37. *Id.*

38. *Id.* at 558.

39. *Id.*

40. *Id.*

It has been contended that the unauthorised use of the plaintiff's name gives a cause of action; that there is a right of property in a man's name so that any use of that name by another will be actionable if the use is unauthorised and may be to the detriment of the plaintiff in his profession. There is no authority for such a proposition; it goes too far and is unsound.⁴¹

This opinion strengthened the foundation on which defendants could escape liability for the appropriation of an individual's name or likeness. By requiring that only the manner in which a plaintiff could demonstrate actual loss was by proving economic injury, the court's narrow construction worked to preclude viable complaints.

*Tolley v. J.S. Fry and Sons, Ltd.*⁴² is one of the most famous of the early appropriation cases. The plaintiff in *Tolley* was a stockbroker by profession, who was well known for his status as an amateur golfer.⁴³ The defendant Fry, a firm which manufactured chocolates, used Tolley's name accompanied by a caricature of him playing golf in an advertisement for their product.⁴⁴ Without obtaining the plaintiff's permission the advertisement appeared in two daily newspapers.⁴⁵ The plaintiff's complaint alleged that a libel had been committed against him: it appeared that he had accepted compensation for the use of his name in conjunction with the product, and the implication that he had been paid in his capacity as a golfer would threaten his amateur standing.⁴⁶

Evidence before the appellate court indicated that the defendant had received a letter from their advertising agents which warned that a suggested second advertisement, involving caricatures of two tennis amateurs, could give rise to potential liability.⁴⁷ This letter read: "[I]n tennis circles, even more than in golf circles, the amateur status must be carefully guarded,

41. *Id.*

42. 1 K.B. 467 (1930).

43. *Id.*

44. *Id.* at 468.

45. *Id.*

46. *Id.* at 467.

47. *Id.* at 469.

hence if Cyril Tolley has any quarrel with us, it is more than likely that both Helen Wills and Betty Nuthall would be upset at our caricaturing them for advertising purposes."⁴⁸ The lack of integrity on the part of the defendant is illustrated by the fact that, knowing sales of Fry Chocolate would be enhanced by an endorsement from Mr. Tolley, the advertisement appeared in two newspapers, and exposed the plaintiff to what was later found to be a libel.⁴⁹

For a brief moment, Mr. Tolley's right to regulate use of his name and likeness was given lucid expression by Judge Greer's statement: "[T]he defendants in publishing the advertisement in question without first obtaining Mr. Tolley's consent, acted in a manner inconsistent with the decencies of life, and in so doing they were guilty of an act for which there ought to be a legal remedy."⁵⁰ The defendant Fry was responsible for the harm and embarrassment suffered by the plaintiff.⁵¹ Although the desire to reap commercial gain at the expense of another is not looked upon favorably in other areas of the law, the drastic need for reform regarding appropriation was ignored by Judge Greer's eventual holding. Judge Greer distinguished the public attention given to Mr. Tolley for his golfing achievement from the status of an anonymous member of society: "Some men and women voluntarily enter professions by which their nature invite publicity . . . [i]t is not unreasonable in their case that they should submit without complaint to their names and occupations and reputations being treated as matters of public interest, and almost as public property."⁵² This holding, taken to the logical extreme, would grant a free license to anyone with creative or financial resources who wished to capitalize upon the fame of others. Although the public has an interest in the personal advances made by a celebrity in his career, Judge Greer's holding confuses the right to obtain information with a personal right which allows only the individual figure to use his talents for commercial exploitation. Judgment was however rendered in favor of the plaintiff.⁵³ In seeking to protect Mr. Tolley's ama-

48. *Id.*

49. *Id.* at 476.

50. *Id.* at 478.

51. *Id.*

52. *Id.* at 477.

53. *Id.* at 476.

teur standing, the claim of libel was included almost as an afterthought.⁵⁴ As noted by a contemporary legal writer, "had the plaintiff been a professional golfer he would not have succeeded in his claim . . . as the adverse imputation would not then have amounted to a libel."⁵⁵

That relief was made available to the plaintiff does not discount the fact that the opinions regarding the case were shortsighted. An amateur athlete usually progresses in his sport until he reaches the standing of a professional. Tolley's future merchandising and endorsement potential were limited by the defendant's advertisement. In addition to safeguarding the plaintiff's status as an amateur, his future earning capacity should also have been recognized.

Unfortunately, the *Fry* case is not helpful in seeking to establish the proposition that an individual has a viable right in and of itself to protect the unauthorized use of his name and likeness. In spite of the fact that judgment was in favor of the plaintiff, the court was unwilling to make an award on the basis of misappropriation of personality. This case illustrates that even where a claim for misappropriation was vindicated, the tort itself remained undeveloped as a result of the other legal remedies upon which relief was predicated. The judgments provided in the professional cases reflect Judge Greer's holding in *Tolley*.⁵⁶ Although disposed to granting protection, he was hindered by the doctrine of precedent and the policy considerations which almost uniformly dictated that recovery should be denied. Aside from the financial losses by plaintiffs, the law should have been sensitive to the element of dignity that is lost by allowing appropriation abuses to occur. Such abuses could be alleviated if English jurisprudence would accept that "any unauthorized exploitation other than for the legitimate purposes of news reporting and free speech may be civil misappropriation."⁵⁷

The English professional cases culminate in *Sim v. H.J.*

54. *Id.* at 475.

55. Coleman, *The Unauthorized Commercial Exploitation Of The Names And Likenesses Of Real Persons*, 7 EUR. INTEL. PROP. REV. 189 (1982).

56. *Tolley v. J.S. Fry & Sons, Ltd.*, 1 K.B. 467, 482 (1930).

57. Coleman, *supra* note 55, at 194.

*Heinz Co. Ltd.*⁵⁸ Here, the defendant, Heinz Company, engaged an advertising firm to prepare several commercials for their product to be directed toward a television audience.⁵⁹ The advertisements involved a cartoon figure which, due to its anonymous form, was itself innocuous, but was accompanied by a voice which impersonated that of the plaintiff, Alistair Sim.⁶⁰ Sim, an actor whose career was confined exclusively to the stage and film industry, sought an injunction against the defendant to prevent the continued broadcast of the television advertisement.⁶¹ He argued that his reputation and notoriety as an actor were compromised by the defendant's use of his voice in conjunction with products which, plaintiff's counsel claimed, "do not represent our client's beliefs and persons listening to the broadcasts would think that our client was prepared, for money, to make statements that he did not believe."⁶²

Of paramount concern to the plaintiff was the fear that his dignity would be lost in the eyes of both members of his profession as well as the viewing public.⁶³ Unlike many famous actors of today, Alistair Sim did not want to be seen to have "traded" on his reputation for the purpose of promoting a commodity such as that produced by the defendant.⁶⁴

Due to the fact that the case involved proceedings for an interlocutory injunction, the central issue, whether a passing off action had in fact occurred, remained unresolved. In spite of the denial of the injunction, Judge McNair noted that "it would seem to me to be a great defect in the law if it were possible for a party, for the purpose of commercial gain, to make use of the voice of another party without his consent."⁶⁵ McNair's holding was consistent with the cases previously discussed in that the absence of tangible damage to the plaintiff was the reason for withholding the requested injunction.⁶⁶ Indeed, had the court been amenable to viewing the case outside the confines of the

58. 1 W.L.R. 313 (1959).

59. *Id.* at 314.

60. *Id.*

61. *Id.* at 314-15

62. *Id.* at 315.

63. *Id.* at 314-15

64. *Id.*

65. *Id.* at 317.

66. *Id.* at 317-18

law of defamation, the matter could have been litigated on the merits as a misappropriation. *Sim v. Heinz* still remains a landmark case in the development of the need for a property right to be recognized in appropriation cases.

The professional cases indicate the refusal by British judges to recognize the tort of misappropriation as applied to the reputation of an individual. While the opinions often reflect disapproval regarding the taking of a name and likeness, they illustrate an effort to link liability with other well established forms of law. As with *Tolley v. J.S. Fry and Sons, Ltd.*, most plaintiffs, otherwise able to recover on a claim of libel, would still be prevented from enjoining defendants, if their likenesses were used for commercial ventures.

The same lack of judicial protection would apply to those businessmen who, unlike the plaintiff in the *Routh* case, sought recovery under a theory other than defamation. Unfortunately, as illustrated by both *Clark* and *Sim*, a claim of defamation may not be sufficient to provide protection against unauthorized use. Application of property law has also proved unsuccessful, as in the *Dockrell* case, when the plaintiff was unable to prevent his reputation from being used by those engaged in the manufacture of a fraudulent medicine.

In cases where relief was granted, there appears to be a tendency on the part of the judges to formulate the remedy to fit within previously recognized causes of action. This is evident in *Pollard*, which relied upon an implied contract, and *Prince Albert*, where a finding for the plaintiff was based upon a breach of confidence.

The judgments above demonstrate the uniform refusal to accept a right pertaining to name and likeness. Although certain cases provide protection, there is a complete absence of litigation under the specific claim of misappropriation. As a result of the consistent refusal on the part of British judges to grant awards based upon the unauthorized taking of one's "personality," it is to the law of passing off that one must turn.

II. PASSING OFF

Initially, the law of passing off was designed to protect traders from misrepresentations which ascribed to one set of goods the goodwill established in another.⁶⁷ This action was later applied to the area of commercial services, although all passing off claims are predicated on the theory that "nobody has any right to represent his goods as the goods of somebody else."⁶⁸ Liability under this action may arise from the straightforward taking of another's trademark, the deceptive use of a product identification scheme and activities in which the public are confused into thinking that the defendant's goods are those of the plaintiff.⁶⁹ Injury is measured by the potential or actual loss of the plaintiff's business, and, in a successful case, will result in both an injunction to restrain the defendant and an award of damages.⁷⁰ This tort may be invoked against those who are unaware of the goods sold by the plaintiff, thus making ineffective a defense based upon innocence.⁷¹

The basic elements necessary to sustain a passing off action have been summarized as: "(1) the plaintiff's own reputation; (2) the defendant's representation; and (3) likelihood of damage to the plaintiff."⁷² The first criteria requires the plaintiff to establish that he owns the goodwill in either the name or reputation of his business.⁷³ A successful commercial reputation, although intangible, is the type of property which passing off seeks to protect.⁷⁴ It is therefore essential that prior to a showing of public confusion, goodwill be proven to exist.⁷⁵ Lord MacNaghten, with what might have been some difficulty, defined goodwill as "the attractive force which brings in custom."⁷⁶ This meaning alone does not suggest a difference between goodwill and reputation.

67. W. CORNISH, *INTELLECTUAL PROPERTY; PATENTS, COPYRIGHT, TRADE MARKS AND ALLIED RIGHTS* 473 (1981).

68. *Reddaway v. Banham*, 13 R.P.C. 199, 204 (H.L. 1896).

69. *Id.* at 204-05.

70. Cornish, *supra* note 67, at 473.

71. *Id.* at 485.

72. *Id.* at 475.

73. *Id.* at 477.

74. *Warnink v. J. Townend & Sons*, App. Cas. 731, 735-38 (H.L. 1979).

75. *Id.* at 739.

76. *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*, App. Cas. 217, 224 (H.L. 1901).

Still, for goodwill to be established, a thriving business interest is required, while reputation may exist independently from commercial ventures.⁷⁷

Although reputation is an important element in assessing goodwill, the two are distinct terms best illustrated by a product which may have a reputation but is bereft of goodwill. Passing off actions protect the goodwill in a product by safeguarding the business which fostered its growth.

To fulfill the second element, a representation which makes difficult the distinction between the defendant's goods or services and those of the plaintiff must be made.⁷⁸ This representation need not be intentional nor fraudulent, but the public must actually believe, or be likely to believe, that they are receiving the plaintiff's product when in fact the goods are derived from another source.⁷⁹ In the absence of a viable defense, the court may infer that a similar name or style of packaging was used by the defendant with the objective of appropriating the plaintiff's goodwill.⁸⁰ Although a plaintiff is not required to prove that deception actually occurred, he or she must demonstrate that a substantial number of the public is likely to be confused.⁸¹ The unlawful association of the defendant's goods with those of the plaintiff will depend upon the existence of a common field of activity.⁸² It is precisely this factor which makes passing off an ineffective remedy for celebrities. The names and likenesses of famous individuals frequently appear on products unrelated to the area in which notoriety was derived. As a result, the common field of activity requirement has made possible merchandising schemes which could have been prevented had the parties been involved in a similar business venture. An overlap in the business enterprises engaged in by the parties is essential, to sustain a claim under this theory, for a difference in product or relevant consumer market can often preclude recovery.⁸³

77. *Anheuser-Busch Inc. v. Budejovicky Budvar*, Fleet Street Rep. 413 (C.A. 1984).

78. *Cornish*, *supra* note 67, at 475.

79. *Warnink*, App. Cas. at 740.

80. *William Edge & Sons, Ltd. v. William Niccolls & Sons, Ltd.*, App. Cas. 693 (H.L. 1911).

81. *Cornish*, *supra* note 67, at 489.

82. *McCulloch v. May, Ltd.*, 2 All E.R. 845, 846 (1947).

83. *Id.* at 851.

The third and final requirement dictates that in the absence of actual injury the plaintiff demonstrate likelihood of damage.⁸⁴ Most frequently, the loss occurs when misled consumers purchase alternative goods.⁸⁵ If the same purchaser becomes dissatisfied with what he believes to be the plaintiff's product, and ceases entirely to buy the goods, the plaintiff's position in the market will be threatened. Damage is therefore closely linked with business goodwill in cases of passing off.⁸⁶ The specific requirements for passing off are discussed in greater detail in the context of the cases to follow. It is interesting to note that, although factual situations bearing all the requirements for sustaining a claim may be presented, recovery is still not easily granted. The courts are reluctant to interfere with fair competition, and must, in passing off actions, balance the plaintiff's proprietary right in his goodwill against the interests of those engaged in a rival business.⁸⁷ Too frequently the balance is in favor of those who capitalize on the popularity of others.

The case of *McCulloch v. May, Ltd.*⁸⁸ is a logical starting point from which to examine the body of law relating to passing off actions. The plaintiff, McCulloch, alleged the unauthorized taking by the defendant of the name made famous by the plaintiff as "Uncle Mac."⁸⁹ Mr. McCulloch was a broadcaster originally employed in 1926 by the British Broadcasting Corporation to present a show entitled "The Children's Hour."⁹⁰ Before each program, he was introduced as "Uncle Mac" and, as a consequence of the overwhelming success of the show, he went on to perform other functions such as charitable fund raiser, recording personality, lecturer and author of children's books, retaining the name Uncle Mac.⁹¹ Unfortunately, Mr. McCulloch/Uncle Mac was disabled, having lost a limb and the sight of one eye.⁹² Due to his physical hardship, the plaintiff was forced to employ a secretary to help him reply to the huge amount of correspon-

84. Cornish, *supra* note 67, at 475.

85. *Warnink*, App. Cas. at 740.

86. *Id.* at 754.

87. *Cadbury Schweppes v. Pub Squash Co. Ltd.*, 1 All E.R. 213 (1981).

88. 2 All E.R. 845 (1947).

89. *Id.* at 848.

90. *Id.* at 846.

91. *Id.* at 847.

92. *Id.*

dence he received, particularly from children.⁹³ These letters contained a brief mention of the plaintiff's disability, and explained why Mr. McCulloch was unable to attend the various functions to which he was invited.⁹⁴

The defendant was the managing director of a company which produced breakfast food.⁹⁵ The plaintiff objected to the marketing of a cereal called "Uncle Mac's Puffed Wheat" which included on the carton a panel which stated in part: "You know the difficulties of travel these days, and will understand that Uncle Mac can't get about as freely as he would like to, but . . . he will always do his best to please his many friends wherever they may be."⁹⁶ Based upon the name of the cereal produced by Mr. May's company, and the inscription on the carton, the plaintiff sought to prove that the defendant was attempting to exploit his personality for economic gain, and brought an action for passing off.⁹⁷

The elements for a passing off action require the plaintiff to show that he was in possession of a protectable property right; that this interest was infringed by the defendant; and that this infringement damaged the plaintiff by confusing the public into thinking that the defendant's "profession, business or goods" could be attributed as belonging to the plaintiff.⁹⁸ Although it may appear that the name and packaging of Uncle Mac's Puffed Wheat could be construed as a blatant attempt by Mr. May to trade on the good reputation of the plaintiff, the court held that an action for passing off could not be sustained.⁹⁹ Judge Winn-Parry began his opinion by stating the familiar principle that: "It is established beyond argument that under the law of England a man is not entitled to exclusive proprietary rights in a fancy name *in vacuo*."¹⁰⁰ This maxim of English jurisprudence was well entrenched in the series of professional cases which existed prior to Judge Winn-Parry's judgment, and its value as a rule of precedent was, in his estimation, better left

93. *Id.*

94. *Id.*

95. *Id.*

96. *Id.* at 848.

97. *Id.* at 849.

98. *Id.*

99. *Id.* at 851.

100. *Id.* at 849.

undisturbed.¹⁰¹

What is most unfortunate about this case is the finding that because “the plaintiff is not engaged in any degree in providing or marketing puffed wheat, how can the defendant, in using the fancy name used by the plaintiff be said to be passing off the goods or the business of the plaintiff.”¹⁰² In dismissing Mr. McCulloch’s claim on the basis that the business of producing puffed wheat was distinct from that of a broadcasting celebrity, the judge significantly altered the potential effectiveness that the tort of passing off could have had in controlling appropriations. The devastating effect of the requirement that there be a causal connection uniting plaintiffs with defendants in such cases was aptly commented on by Mr. Frazer¹⁰³ who pointed out in a recent article:

This requirement would mean that an action in passing off would lie in respect of appropriation of personality only where the plaintiff carried on the same sort of business as the one in which the defendant had appropriated the plaintiff’s personality. A rock star who does not manufacture, or might reasonably be expected to manufacture in the future, mints would have no remedy where his name or likeness is used in an advertisement for them; even a sporting personality who did not also sell sports wear would have no action in analogous circumstances.¹⁰⁴

The difficult position of an English plaintiff in an action for appropriation is not limited to the inconvenience of the common field of activity requirement. Judge Wynn-Parry has taken a rigid stand on the right of personality when he notes: “If I were to accede to the plaintiff’s claim I should, as I see it, not merely be extending quite unjustifiably the scope of the action of passing off, but I should be establishing an entirely new remedy, and that I am quite unprepared to do.”¹⁰⁵

101. *Id.* at 851.

102. *Id.*

103. A solicitor and lecturer in law at the University of Newcastle Upon Tyne.

104. Frazer, *supra* note 2, at 289.

105. *McCulloch*, 2 All E.R. at 851.

In his book, *The Protection of Privacy*, Mr. Wacks, a noted legal writer, describes in detail the array of claims that can be brought to rectify appropriations.¹⁰⁶ But he does not mention that, unless each element of a passing off action is pleaded and proved, the plaintiff's complaint will be deficient and subsequently fail.

The type of wrongdoing that this tort has been designed to correct was described as follows: "the chief purpose of the tort of passing off is to protect traders against a rival who seeks to acquire by means of deception, the plaintiff's reputation."¹⁰⁷ Wacks later concludes that actions such as passing off are lacking in effectiveness, for the requirement that there be a common field of activity and confusion in the mind of the public are often difficult to prove.¹⁰⁸ His treatment of the subject as a viable form of protection is accurate if one considers the remedy in its theoretical state. But in the actual litigation of these cases, the law must be applied in its static form, which includes application of the rigid requirements necessary to sustain a claim under this cause of action. The discrepancy between the factual basis of the claims and the strict requirements of passing off actions has been the source of judicial weakness. A recent article¹⁰⁹ assessed the reticence of the English courts to hear passing off actions:

There has been a regrettable tendency . . . to restrict the scope of the action for passing-off by laying down what appears to be hard and fast rules, which may inhibit courts from dealing with cases on the basis of the particular facts of each. It is regrettable, because, one of the chief virtues of a non-statutory cause of action ought to be its adaptability to changing commercial circumstances and practices.¹¹⁰

The High Court of New South Wales reacted against the insistence on the presence of a common field of activity for

106. R. WACKS, *THE PROTECTION OF PRIVACY* 170 (1980).

107. *Id.* at 169.

108. *Id.* at 170.

109. Morcom, *Character Merchandising - A Right or Mere Opportunity?* EUR. INTEL. PROP. REV., Oct. 1978, at 7.

110. *Id.* at 8.

claims of passing off. The case of *Henderson v. Radio Corporation*¹¹¹ sharply contrasted to the decision in *McCulloch*, for the *Henderson* plaintiff was able to sustain a passing off action without the necessity of establishing that his business was materially similar to that of the defendant.¹¹²

Since the case was tried in a jurisdiction other than England, it was of persuasive authority only. Consequently, *Henderson* had a limited impact in Britain. The case involved the plaintiff Hendersons, professional ballroom dancers, who, as husband and wife, had gained notoriety both in England and Australia.¹¹³ From the time of their emigration to Australia, twelve years before the commencement of this action, they were engaged in the business of public performances as well as teaching their art to private individuals.¹¹⁴ The defendant company was a distributor of record albums in Australia, and placed on the market a record entitled "Strictly For Dancing: Vol 1."¹¹⁵ Without securing the plaintiff's permission, the defendant used a photograph of the Hendersons dancing together on the cover of the album which gave rise to this claim for passing off.¹¹⁶

Judge Sugarman initially granted an injunction to restrain the defendant from selling the album.¹¹⁷ The opinion contains a finding that there was a common field of activity between the demonstrations given by the plaintiff and the defendant's production of a record suitable for dance instruction.¹¹⁸ The plaintiffs claimed that the buying public would be deceived into thinking that the photograph on the album cover constituted an endorsement of the record itself.¹¹⁹ On appeal, Judge Evatt determined that passing off actions were to be applied to those engaged in business.¹²⁰ He construed commercial activity as denoting any form of enterprise.¹²¹ In a strong criticism of Judge

111. R.P.C. 218 (1969).

112. *Id.* at 233.

113. *Id.* at 219.

114. *Id.* at 220.

115. *Id.* at 221.

116. *Id.*

117. *Id.* at 230.

118. *Id.* at 234.

119. *Id.* at 222.

120. *Id.* at 234.

121. *Id.*

Winn-Parry's holding in *McCulloch*, Judge Evatt held that if the parties to a passing off action are involved in a business, "[t]here does not seem to be any reason why it should also be necessary that there be an area, actual or potential, in which their activities conflict."¹²² Judge Manning's concurring opinion altered the traditional requirements for a passing off claim by noting that the existence of a common field of activity was merely a factor in determining if public confusion and damage had occurred.¹²³

In dismissing the appeal, Judge Manning boldly stated "it is going too far to say that the absence of this so called common field of activity necessarily bars a plaintiff from relief."¹²⁴ In spite of the relative ease with which the *Henderson* court "re-wrote" the law of passing off, the overall effectiveness of the judgment is diminished by the fact that the parties were business competitors in fields closely related.¹²⁵ As such, the court's opinion may be classified as dicta. Since *McCulloch* concerned parties with distinct business enterprises, the case is easily distinguished from the claim brought by the Hendersons.

Regardless of the jurisdictional division, the *Henderson* decision did have some impact in England three years later in the case of *Annabel's Ltd. (Berkeley Square) v. Schock*.¹²⁶ In this action for passing off, the common field of activity requirement was described, in a manner similar to that of the *Henderson* court, as a highly relevant consideration.¹²⁷ The facts of the case involved the successful London nightclub called Annabel's.¹²⁸ The defendant company was an escort agency operating under the same name.¹²⁹ The plaintiffs alleged that by adopting the name and identical spelling of their nightclub, the defendant was attempting to establish in the minds of the public that his business was somehow associated with plaintiffs.¹³⁰

122. *Id.*

123. *Id.* at 236.

124. *Id.* at 242.

125. *Id.* at 234.

126. R.P.C. 838 (1972).

127. *Id.* at 845.

128. *Id.* at 839.

129. *Id.*

130. *Id.*

The defendant placed advertisements in several publications including two newspapers and a guide to London.¹³¹ These in turn contained "a great many advertisements of various kinds such as massage therapy, Miss Petal escorts for Paris or London weekends,"¹³² which were followed by the defendant's advertisement.¹³³

The defendant had printed the following advertisement in the Times newspaper: "Annabel's Mayfair Escort Agency [has] intelligent, interesting and high standard girls."¹³⁴ The plaintiff's secretary, Miss Cameron, gave evidence that in her capacity as receptionist she received a total of six incoming telephone inquiries from women who had read the defendant's advertisement and were enthusiastic at the prospect of working as escorts.¹³⁵ Miss Cameron also stated that two women had arrived at the back door of the club and, like those making incoming calls, were curious as to the possibility of working for the defendant.¹³⁶ What is perhaps the most persuasive piece of evidence on the issue of public confusion is the testimony given by the plaintiff's secretary that "a few members of Annabel's Club telephoned about the escort agency, some expressing surprise that the [c]lub should indulge in that field of enterprise and others ironically inquiring as to the service offered by the escort agency."¹³⁷ In his own defense, the defendant produced a faintly credible proposition, claiming that the name "Annabel's" was selected so as to enable his company to be listed on the top of the page in publications listing places of entertainment in alphabetical order.¹³⁸

Judge Russell, in dismissing the defendant's appeal and upholding the award of an injunction stated: "one of the important considerations is whether there is any kind of association . . . in the minds of the public . . . between the field of activities of the plaintiff and . . . [that] of the defendant . . . this is simply a question in the ultimate decision whether there is likely to be

131. *Id.* at 840.

132. *Id.*

133. *Id.*

134. *Id.*

135. *Id.* at 841.

136. *Id.*

137. *Id.*

138. *Id.* at 842.

confusion.”¹³⁹ Here, Judge Russell was not rejecting the requirement established in the *McCulloch* case, that a common field of activity exist. Rather, his judgment focused on the fact that public confusion ensued.¹⁴⁰

Although one legal commentator, Morcom, finds from his reading of the *Annabel* case that “nothing . . . could be a clearer repudiation of the requirement of a ‘common field of activity’ as a rule of law,”¹⁴¹ the opinion delivered by Judge Russell expressly illustrates that common ground did exist between the plaintiff and defendant. In an interesting turn of phrase, this common field of activity was described as follows: “it can be said that Annabel’s [c]lub provides facilities to men for dining and dancing with female partners, [t]urning it round slightly, Mr. Schock’s business is concerned with supplying for men facilities of female partners for the purpose, among other things, of dining and dancing with them.”¹⁴²

The plaintiff was awarded an injunction which Judge Russell upheld on appeal.¹⁴³ The requirement that there be a common field of activity between plaintiff and defendant remained intact after his judgment. Judge Russell’s opinion emphasized the element of public confusion, and did not eliminate or overrule the *McCulloch* holding.

The possibility that the tort of passing off would, under *Henderson* and *Annabel*, expand to protect current forms of misappropriation did not materialize. The hope that the common field of activity requirement would, after *Henderson*, be relaxed, was dashed in the case of *Lyngstad v. Anabas Products Ltd.*¹⁴⁴ This action concerned the Swedish pop group Abba which sought to enjoin the defendants from producing and selling various products such as buttons and t-shirts which contained photographs of the group.¹⁴⁵ Abba contended, like the *Henderson* plaintiff, that members of the public would assume

139. *Id.* at 844.

140. *Id.* at 845.

141. Morcom, *supra* note 109, at 8.

142. *Annabel's*, R.P.C. at 845.

143. *Id.* at 846.

144. Fleet Street Rep. 62 (1977).

145. *Id.* at 65.

that the group had endorsed the defendant's merchandise which would then limit their future licensing potential.¹⁴⁶

Judge Oliver refused the plaintiff's claim,¹⁴⁷ and his holding exhibits the force with which the English courts rejected the *Henderson* case. The common field of activity requirement was conclusively affirmed by his decision, which dismissed the *Henderson* ruling as a misunderstanding by the Australian court of this principle of passing off.¹⁴⁸ Judge Oliver's opinion states: "The expression 'common field of activity' is not, I think, a term of art, but merely a convenient shorthand term for indicating the need for a real possibility of confusion, which is the basis of the action."¹⁴⁹ The determination by the *Lyngstad* court that the public would not be deceived into associating the plaintiff with the goods produced by the defendant resulted in what may be termed a gratuitous license to exploit Abba's fame.

In the same year that the *Lyngstad* case was tried, the copyright owners of cartoon characters called the "Wombles" brought a claim against a company using the same name for rubbish bins produced by the defendant.¹⁵⁰ This case differs slightly from *Lyngstad*, in that the plaintiff had taken advantage of licensing opportunities by franchising various pictures of the characters.¹⁵¹ The fact that the Wombles characters were involved in collecting litter in and around Wimbledon Common was insufficient to establish a common link with the rubbish bins marketed by the defendant.¹⁵² As a result, Judge Walton held in favor of the defendant, finding that the business of licensing copyright material was distinct from cleaning up litter.¹⁵³ This decision implicitly ignored the monetary value that the plaintiff derived from its licensing rights. Judge Walton's opinion also illustrates the unwillingness of English judges to recognize the market value of a licensed name.

Any favorable contribution that the *Henderson* case could

146. *Id.* at 66.

147. *Id.* at 70.

148. *Id.* at 67.

149. *Id.*

150. *Wombles Ltd. v. Wombles Skips Ltd.*, R.P.C. 99, 99 (1977).

151. *Id.* at 101.

152. *Id.* at 102.

153. *Id.*

have made to passing off actions was obviated after the *Lyngstad* and *Wombles* decisions. The opinions reflect a judicial contentment with existing criteria. However, in the Ontario court of appeal, Krouse, a professional football player, attempted to invoke the same protection offered to the Hendersons in his claim against the Chrysler Automobile Company.¹⁵⁴ The appellant, Chrysler, had produced an advertising device called a "spotter" to be used in conjunction with its television campaign to market automobiles to those viewing professional football games.¹⁵⁵ At the center of the spotter appeared a photograph of the respondent wearing his team uniform.¹⁵⁶ Krouse alleged that the use of his photograph amounted to the misappropriation of his right to endorse products which was afforded to him by virtue of his status as a professional athlete.¹⁵⁷ He was awarded damages on a finding that a passing off had occurred.¹⁵⁸

At the appellate level, Judge Estey reversed the lower court's holding, finding that the appellant's business of manufacturing automobiles could not be construed as infringing upon the respondent's activities as a football player.¹⁵⁹ The *Henderson* case was distinguished because the record produced by the defendant appealed to the same section of the consumer market in which the plaintiffs were known, with the result that those purchasing the album would incorrectly associate the parties.¹⁶⁰ Chrysler, on the other hand, was also seeking a trade advantage, but its advertising strategy relied upon an abstract association with the game of football.¹⁶¹ Any potential for confusion in the minds of the public was negated by the fact that the photograph of Krouse depicted him solely as a team member and would not imply that he was endorsing the appellant's product.¹⁶² In denying the respondent's motion for compensation for the use of his personality, Judge Estey commented on the refusal of the Canadian Judiciary to approve such a right: "Progress in the law is not served by the recognition of a right which, while helpful to

154. *Krouse v. Chrysler Canada Ltd.*, 40 D.L.R.3d 15 (1978).

155. *Id.* at 16.

156. *Id.*

157. *Id.* at 19.

158. *Krouse v. Chrysler Canada Ltd.*, 25 D.L.R.3d 49, 69 (1972).

159. *Krouse*, 40 D.L.R.3d at 26.

160. *Id.* at 25.

161. *Id.* at 29.

162. *Id.*

some persons or classes of persons, turned out to be an unreasonable disruption to the community at large and to the conduct of its commerce."¹⁶³ The claim for passing off could not be maintained in light of Krouse's failure to prove that his business endeavors had been interfered with by Chrysler. The requisite element of public confusion is therefore as strictly adhered to in the Canadian courts as it is in England.

The case of *Cadbury Schweppes v. Pub Squash Co. Ltd.*¹⁶⁴ represents a privy council review of passing off as applied in New South Wales. The plaintiff, Cadbury Schweppes, had placed on the Australian market a beverage called "Solo," which was to compete with Coca-Cola.¹⁶⁵ Simultaneously, the plaintiff launched an extensive advertising campaign on both radio and television, which informed the public that Solo was both a man's drink and reminiscent of the type of beverage sold in the past.¹⁶⁶ In the hope that consumers would buy Solo as an alternative to beer, the container in which it was marketed resembled that used for selling beer, complete with an identifiable yellow color and medallion.¹⁶⁷ One year following the successful introduction of Solo, the respondent marketed a beverage called "Pub Squash," which utilized a similar bottle, label and advertising strategy.¹⁶⁸ After a 15% drop in sales, Cadbury Schweppes instituted proceedings against the defendant for passing off.¹⁶⁹ Judge Powell, in the lower court, found that although the defendant had intentionally taken advantage of the plaintiff's marketing success, the drink produced by the defendant was distinct from Solo.¹⁷⁰ As such, the only offense committed by the defendant was a taking of the plaintiff's advertising effort, which in itself did not amount to a passing off.¹⁷¹

On appeal to the privy council, Lord Scarman affirmed the prior ruling, having found that respondent's objective was not to

163. *Id.* at 30.

164. 1 All E.R. 213 (1981).

165. *Id.* at 215.

166. *Id.*

167. *Id.*

168. *Id.* at 216.

169. *Id.* at 217.

170. *Id.* at 220.

171. *Id.*

deceive but was instead to encroach upon a willing market.¹⁷² The appellant was then required to establish that its product derived from the advertising a substantial goodwill entitled to protection.¹⁷³ The privy council was concerned with “the balance to be maintained between the protection of a plaintiff’s investment in his product and the protection of free competition.”¹⁷⁴ Absent proof that the public was confused into thinking that Pub Squash was the beverage produced by the appellant, there was no misappropriation which would justify the court’s intervention to restrict competition.¹⁷⁵ If due to the advertising scheme Solo had become recognizable to consumers, the appellant would have succeeded in the passing off claim, for his “intangible property right” would have been invaded.¹⁷⁶ Lord Scarman’s view indicates the unwillingness of the British courts to grant a monopoly to those using a distinctive advertising scheme. Similarly, passing off actions may prove unsuccessful when used to prevent others from adopting similar marketing strategies, even if accomplished within the same field of business enterprise.

The most recent passing off case, *Warnink v. Townend & Sons*,¹⁷⁷ accurately describes the modern requirements for a cause of action under this doctrine. *Warnink* involved as plaintiff a Dutch manufacturer who imported to England a beverage called “Advocaat,” which consisted of egg yolks, sugar and brandewijn.¹⁷⁸ This product gained a popular reputation and captured a substantial portion of the British market, roughly 75%.¹⁷⁹ The defendants in the action, Keeling, produced a drink from a blend of Cyprus sherry and dried eggs, which they advertised and sold on the English market as “Keeling’s Old English Advocaat.”¹⁸⁰ Owing to the fact that the defendant’s beverage was manufactured in England and contained wine instead of spirits, the excise duty was appreciably lower than that imposed

172. *Id.* at 221.

173. *Id.*

174. *Id.* at 223.

175. *Id.* at 221.

176. *Id.* at 223.

177. App. Cas. 731 (H.L. 1979).

178. *Id.* at 734.

179. *Id.*

180. *Id.* at 735.

on the plaintiffs.¹⁸¹ This price differential was passed on to the purchaser, for Keeling's product was sold at a lower price of 50p per bottle.¹⁸²

When the defendant's sales achieved a strong position in the British market, Warnink brought a claim of passing off to prohibit the defendant's continued sale of what is more accurately known in England as "egg flip," a beverage consisting of virtually the same ingredients as Keeling's Old English Advocaat.¹⁸³

At the trial court level, the plaintiff's motion for judgment was granted, based on a finding that the defendants were misrepresenting their beverage as the genuine Advocaat.¹⁸⁴ However, the Court of Appeal sought to reverse and the case was then sent before the House of Lords.¹⁸⁵ On behalf of Warnink, it was urged that the plaintiffs relied on the goodwill established in the name Advocaat to sustain their dominant position in the British market.¹⁸⁶ "Such a reputation, having been built up, deserves protection and is protected by law . . . Advocaat is a word which attracts business."¹⁸⁷ Warnink contended that the defendant's use of the term Advocaat was a false representation, and as such constituted an appropriation of the plaintiff's goodwill for its own advantage in the same market.¹⁸⁸

Although a false representation is the cornerstone for a passing off action,¹⁸⁹ Lord Diplock restated the requirements necessary to sustain an action. These remain the contemporary standards:

- (1) a misrepresentation;
- (2) made by a trader in the course of trade;
- (3) to prospective customers of his or ultimate consumers of goods or services supplied by him;
- (4) which is calculated to injure the business or goodwill of another trader (in the

181. *Id.*

182. *Id.* at 734.

183. *Id.*

184. *Id.* at 732.

185. *Id.*

186. *Id.* at 735.

187. *Id.*

188. *Id.* at 736.

189. *Id.*

sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.¹⁹⁰

The Court of Appeal noted that this action for passing off departed from the traditional claim, where a plaintiff seeks to prevent a defendant from asserting that his product was in fact produced by the plaintiff.¹⁹¹ Here, Warnink confined itself to contesting the defendant's marketing of their beverage as "Advocaat," and did not contend that there was any misrepresentation as to the actual manufacturing of the beverage.¹⁹² Counsel for the respondents urged that the issue before the court was one of policy, as the decision involved a choice between whether the purchasing public or the long-standing successful manufacturer should reap the benefit of judicial protection.¹⁹³ Citing *Singer Manufacturing Co. v. Loog*, the respondent relied on the *Singer* finding that "[a] trader may lawfully sell a product similar in form to that of a rival trader, referring to that trader's product by name, so long as he does so in such a way as to avoid confusion."¹⁹⁴

In a concurring opinion, Lord Fraser disposed of the defendant's concern that a manufacturer would be benefitted at the expense of the consumer, by noting that "the justification for the passing off action to prevent such misrepresentation continuing is not to protect the public (who might suffer no prejudice from it, if they had never tasted genuine advocaat) but to protect the appellants' property in the goodwill."¹⁹⁵ Having thereby established the party for whose advantage the action was created, the court clarified the policy behind the eventual ruling in favor of the plaintiff.¹⁹⁶ The protection of business goodwill is not a concern paramount to that of the consumers' interests, but is rather a separate and protectable interest be-

190. *Id.* at 742.

191. *Id.* at 751.

192. *Id.*

193. *Id.* at 737.

194. *Id.* at 738 (citing *Singer Mfg. Co. v. Loog*, 8 App. Cas. 15, 22, 26-27, 29-30, 36, 37-38, 38-39 (1982)).

195. *Id.* at 754.

196. *Id.*

longing to those who established the name sought to be appropriated.¹⁹⁷

The defendant also invoked the argument that protecting the plaintiff's right to preserve its reputation could result in opening the floodgates to other producers who would inherit a portion of the competitive market, having invested nothing to warrant the economic benefit.¹⁹⁸ Lord Diplock was unconvinced and stated:

The familiar argument that to extend the ambit of an actionable wrong beyond that to which effect has demonstrably been given in the previous cases would open the floodgates or, more ominously, a Pandora's box of litigation leaves me unmoved when it is sought to be applied to the actionable wrong of passing off.¹⁹⁹

Lord Diplock held for the plaintiff, after finding that the prima facie elements for this tort had been proven.²⁰⁰ "Where . . . there can be discerned a steady trend in legislation which reflects the view of successive Parliaments as to what the public interest demands in a particular field of law, . . . the common law . . . ought to proceed upon a parallel rather than a diverging course."²⁰¹ English judges are constrained by precedent to administer ineffective remedies and have often left the work of protection to public authorities. Diplock's holding provides the incentive for courts to look beyond the past in formulating their opinions. The rigid requirements of passing off weigh heavily upon future plaintiffs who wish to gain from an advancement of the common law. In the absence of any statutory protection, Lord Fraser appealed to the conduct of businessmen in governing their affairs as a guide to protecting individual interests in the market place. "[A]ny established trader is liable to have his goodwill damaged by fair competition, . . . [b]ut . . . where the misrepresentation is likely to cause damage to established traders who own goodwill in relation to that class of goods, busi-

197. *Id.* at 755.

198. *Id.* at 739.

199. *Id.* at 744.

200. *Id.* at 748.

201. *Id.* at 743.

ness morality seems to require that they should be entitled to protect their goodwill."²⁰² As evidenced by the early professional cases, the hope that individual morality will somehow curb the acts of appropriation seems wishful thinking.

III. THE RIGHT OF PRIVACY

In sharp contrast to the inability of English law to guard against appropriation, protection in the United States is extremely well developed and effective. However, the United States courts, like those of the United Kingdom, were fearful of treading into waters without benefit of precedent. The absence of well defined claims and remedies did prove daunting to American courts when first confronted with the new breed of legal right called privacy.²⁰³ It is from this right of privacy that the tort of appropriation of name and likeness developed.²⁰⁴ There was a steady progression from the privacy tort to the modern appeal for the right of publicity.²⁰⁵ The advent of more advanced means of communication and entertainment, which spawned the merchandising and advertising industry, fostered the demand for commercial protection.²⁰⁶ Appropriation claims are derived from the basic right of privacy,²⁰⁷ which will be discussed in the context of the contribution which this body of law made to the right of publicity. When Louis Nizer, respected American attorney and author, examined the initiative taken by the U.S. courts, he correctly analyzed:

[T]he American courts which have accepted the right of privacy as part of their common law have acknowledged that they were motivated by an innate feeling of natural justice The earliest English cases avoided any mention of the right of privacy and attempted to reach a just result by involuted rationalizations and ingenious twisting of ill-fitting principles . . . [t]he recent matter-of-fact, unpretentious recognition of the right, how-

202. *Id.* at 756.

203. Nizer, *The Right of Privacy - A Half Century's Developments* 39 MICH. L. REV. 526, 535-36 (1941).

204. Prosser, *supra* note 3, at 401.

205. *Id.* at 406-07.

206. Nizer, *supra* note 203, at 526.

207. Prosser, *supra* note 3, at 401.

ever, indicates more than anything else that it has become firmly established in our law.²⁰⁸

Indeed, this right, which is now taken almost for granted in much the same way as the fundamental United States constitutional rights, did not appear in the courtroom until the year 1902, in *Roberson v. Rochester Folding Box Co.*²⁰⁹ The State of New York, which was the jurisdiction in which *Roberson* was tried, enacted a statute which had the effect of classifying as a misdemeanor, as well as a tort, the use of the name, portrait or picture of any person for "advertising purposes or for the purposes of trade" without written consent.²¹⁰ It should be noted that this statute was limited in effectiveness to situations bearing factual resemblance to the *Roberson* case, for it did not in itself provide for the creation of a right of privacy.²¹¹ However, Nizer²¹² mentions that its enactment was a result of the disapproval expressed about the *Roberson* case.²¹³ As Louis Nizer reflected: "Designed to fit the facts of one particular case, the statute has never emerged from its shadow . . . In those states which have worked the right of privacy into the fabric of their common law, however, it has grown and altered to fit the changing conditions of modern times."²¹⁴ Thus, the dissenting opinion of Justice Grey met with the approval of the state legislature and, as seen in the cases to follow, the courts of other jurisdictions.

The case of *Pavesich v. New England Life Insurance Co*²¹⁵ represents the initial willingness of the courts to add to the common law a recognized and judicially sanctioned right of privacy. This case, tried in the Supreme Court of Georgia, dealt with a newspaper advertisement for defendant's corporation, the New England Mutual Life Insurance Company.²¹⁶ Included in the advertisement was a likeness of the plaintiff, a private individual by the name of Paolo Pavesich, which was placed next to a pho-

208. Nizer, *supra* note 203, at 535-36.

209. 171 N.Y. 538, 64 N.E. 442 (N.Y. 1902).

210. N.Y. CIV. RIGHTS LAW § 50-1 (Consol. 1903).

211. Nizer, *supra* note 203, at 538.

212. American attorney and renowned legal author.

213. Nizer, *supra* note 203, at 538.

214. *Id.* at 538-39.

215. 50 S.E. 68 (1905).

216. *Id.*

tograph which depicted a poor and unhealthy person.²¹⁷ Underneath was a caption which illustrated the contrast between the photographs by stating: “[t]hese two pictures tell their own story.”²¹⁸ A quotation was attributed to the plaintiff, under his picture, which claimed that he was enjoying the receipt of dividends from an insurance policy with defendant’s company.²¹⁹ Another caption referred to the poor individual who, by not following the plaintiff’s example, was now destitute.²²⁰ The picture of the plaintiff which appeared in the advertisements was made without his knowledge or consent.²²¹ The claim brought by the plaintiff to protect his right of privacy was predicated on his insistence that as an individual member of society he was entitled to control the use for which his likeness was taken.²²² The court contended that the plaintiff was not surrendering his personal liberty in exchange for the benefits conferred by society.²²³ The court further stated that natural law should prevail, in the absence of precedent, to afford protection to individuals who suffer unauthorized exploitation of their likenesses, as personal dignity is harmed.²²⁴ The court interpreted the plea that natural law should find expression in the judiciary to mean that “[w]hen the law guarantees to one the right to the enjoyment of his life, it gives to him something more than the mere right to breathe and exist.”²²⁵

The first amendment to the United States Constitution, freedom of speech, was mentioned as an important right which should be accorded the highest degree of protection in U.S. jurisprudence.²²⁶ However, for purposes of the appropriation of name and likeness rights the Constitution does not forgive or sanction such unauthorized taking of one’s name or likeness if accomplished for private commercial gain.²²⁷ “There is in the publication of one’s picture for advertising purposes not the

217. *Id.*

218. *Id.* at 69.

219. *Id.*

220. *Id.*

221. *Id.*

222. *Id.* at 70.

223. *Id.* at 69.

224. *Id.*

225. *Id.* at 70.

226. *Id.* at 74.

227. *Id.*

slightest semblance of an expression of an idea, a thought, or an opinion, within the meaning of the constitutional provision which guarantees to a person the right to publish his sentiments on any subject."²²⁸ For this reason the court was able to concentrate on the legal wrong committed by the defendant in using the plaintiff's photograph to promote the sale of life insurance.²²⁹

Judge Cobb, in formulating his opinion, made reference to the *Roberson* case, and the argument advanced in that case, that to allow recovery for an invasion of the right of privacy would open the floodgates of litigation.²³⁰ Cobb found that this concern was not a sufficient reason for denying legal redress to aggrieved plaintiffs.²³¹ Thus, the right of privacy was afforded the same right to enforcement as traditional claims brought, for example, under the contract theory.²³² Cobb ascribed the reluctance of judges to accept a right of privacy to the belief that, because the cases before them were unique factually, the right was perceived not to exist.²³³ Cobb's reasoning, as applied in the *Pavesich* case, stands in marked opposition to the *Roberson* holding. Referring to the photographs in the advertisement, Judge Cobb stated: "The defendant insurance company and its agent had no more authority to display them in public for the purpose of advertising the business in which they were engaged than they would have had to compel the plaintiff to place himself upon exhibition for this purpose."²³⁴

The factual similarity of the *Roberson* and *Pavesich* cases makes it clear that the holding which provided recovery in the latter instance could have easily been granted to the *Roberson* plaintiff. In the three years between these two cases, the law had undergone a metamorphosis in which precedent was discarded to accommodate the need for recognition of this important right. The development of the privacy right from its genesis in the article by Samuel D. Warren and Louis D. Brandeis to its final

228. *Id.* at 80.

229. *Id.*

230. *Id.* at 77.

231. *Id.*

232. *Id.* at 80.

233. *Id.* at 77.

234. *Id.* at 79.

expression by Judge Cobb spanned sixteen years. This cause of action has exerted a strong impact in American jurisprudence, as evidenced by the vast number of cases currently litigated under this right. It is almost unthinkable that plaintiffs were ever denied the ability to advocate their commercial appropriation claims. This surprise is expressed in the language used by Judge Cobb when giving judgment for the plaintiff:

So thoroughly satisfied are we that the law recognizes, within proper limits, as a legal right, the right of privacy, and that the publication of one's picture without his consent by another as an advertisement, for the mere purpose of increasing the profits and gains of the advertiser, is an invasion of this right, that we venture to predict that the day will come that the American bar will marvel that a contrary view was ever entertained by judges of eminence and ability, just as in the present day we stand amazed that . . . Lord Hale, with perfect composure of manner and complete satisfaction of soul, imposed the death penalty for witchcraft upon ignorant and harmless women.²³⁵

Having denounced the decision in *Roberson*, the court established the right of privacy as a firmly rooted legal principle.²³⁶ Historically, *Pavesich* is cited as the leading case.²³⁷ However, once the right of privacy was recognized in the United States, the new tort required further definition and polish. Dean Prosser, former dean of the University of California at Berkeley, School of Law (Boalt Hall), writing in 1960,²³⁸ elaborated on the then comparatively novel tort, and found that it comprised not one but rather four distinct interests.²³⁹ In spite of the fact that each interest shares the title "privacy," the rights which flow to a plaintiff are independent under each type of invasion.²⁴⁰ The privacy right is divided into four separate torts.²⁴¹ Dean Prosser described those torts as follows:

235. *Id.* at 80-81.

236. *Id.* at 81.

237. Prosser, *supra* note 3, at 386; Nizer, *supra* note 203, at 535; Nimmer, *The Right Of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

238. Prosser, *supra* note 3, at 383.

239. *Id.* at 389.

240. *Id.*

241. *Id.*

1. Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness.²⁴²

This classification provides a variety of causes of action. While an acknowledgment of each tort is important to a discussion of the development of the right of privacy, the final category, involving appropriation, is the focus of this inquiry. The issues to follow will be limited to the appropriation concerns.

IV. THE RIGHT TO PUBLICITY

To establish an appropriation, a plaintiff must prove that his name or likeness has been taken by a defendant for the defendant's commercial advantage.²⁴³ With respect to the taking of an individual's name, Prosser has distinguished economic gain from harmless use: "Unless there is some tortious use made of it, anyone can be given or assume any name he likes. The Kabotznicks may call themselves Cabots, and the Lovelskies become the Lowells, and the ancient proper Bostonian houses can do nothing about it but grieve."²⁴⁴ Once it is established that a name or likeness was taken for its value as a commodity, the next step is to prove that exploitation occurred for the benefit of a Defendant.²⁴⁵ In most instances, the benefit is a monetary gain, or the furthering of a business or commercial interest. This aspect separates appropriation from the other three privacy torts, for the interest sought to be protected is not freedom from personal affronts but freedom from a proprietary taking.²⁴⁶ Indeed, while a plaintiff might feel that his dignity or pride has been wounded, this injury is secondary to the loss of capital.²⁴⁷ For example, celebrities frequently object to the taking of what

242. *Id.*

243. *Id.*

244. *Id.* at 403.

245. *Id.* at 405.

246. *Id.* at 406.

247. Rader, *supra* note 1, at 232.

is termed their "right of publicity."²⁴⁸ Although the *Pavesich* case guaranteed that a right to privacy would be judicially protected, the doctrine of appropriation required expansion to meet the needs of a technologically advanced society.²⁴⁹ While private individuals had the ability to prevent invasion, relief was needed for those in the public eye who sought to exclude others from gratuitously taking their notoriety.²⁵⁰ The right to publicity was therefore a logical development from the right to privacy.²⁵¹ The recognition of a right of privacy provided a solid foundation for recognition of the right of publicity.²⁵² The influence of Warren and Justice Brandeis was important to development of a right of publicity.²⁵³ Mention of this fact was made by Bloustein, Professor of Law at New York University School of Law, when he advances the proposition that publicity rights are the beneficiaries of the advances made by the tort doctrine of privacy:

[T]he very characterization of these cases as involving a "right to publicity" disguises the important fact that name and likeness can only begin to command a commercial price in a society which recognizes that there is a right to privacy, a right to control the conditions under which name and likeness may be used.²⁵⁴

This suggests that the need for commercial protection is distinct from the need for privacy.²⁵⁵ In economic terms, licenses which grant the use of a likeness for publicity purposes negate the tort of privacy altogether.²⁵⁶ Put another way, the right of publicity is the legal status which allows the right of privacy to be made into a commodity and sold.²⁵⁷ The difference between these interests has been aptly described by the renowned legal commentator Rader:

248. Nimmer, *supra* note 237, at 203.

249. *Id.*

250. Berkman, *The Right of Publicity - Protection For Public Figures and Celebrities*, 42 BROOKLYN L. REV. 527, 533 (1976).

251. Rader, *supra* note 1, at 228.

252. *Id.* at 229.

253. Prosser, *supra* note 3, at 383.

254. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 989 (1964).

255. *Id.*

256. *Id.*

257. *Id.*

For 'right of privacy' actions, the injured party attempts to stop the publication of the damaging material whereas a 'right of publicity' plaintiff may not object to the commercial use of his name or likeness so long as it is or becomes authorized and he is paid for the use A private individual, not a celebrity, fails to create a tangible and saleable product by associating his name or likeness with the product because his name or likeness does not ordinarily have commercial value.²⁵⁸

The development of the entertainment industry creates a capacity to produce revenue which could not have been anticipated when the tort of privacy was first envisioned.²⁵⁹ As a result of the rapid progress in communications, the effectiveness of the privacy right has decreased.²⁶⁰

Those who have carefully nurtured a career dependent upon public popularity should be entitled to preserve financial gains accruing from publicity.²⁶¹ Public interest is a vital ingredient to sustaining popularity, whether one is a recording artist or a prominent athletic figure.²⁶² Like a lawyer who receives remuneration in exchange for legal advice, the labor invested by a celebrity should be rewarded by safeguarding the profits which flow from advertising and other exploitation of his or her person for economic gain.²⁶³

The right to publicity was discussed in the case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*²⁶⁴ The case involved two competing manufacturers of chewing gum.²⁶⁵ The plaintiff promoted his product by entering into exclusive contracts with famous baseball players which enabled him to market their photographs in association with the sale of his gum.²⁶⁶

258. Rader, *supra* note 1, at 232-33.

259. Nimmer, *supra* note 237, at 204.

260. *Id.*

261. *Id.* at 216.

262. *Id.* at 217.

263. *Id.*

264. 202 F.2d 866 (2d Cir. 1953).

265. *Id.* at 867.

266. *Id.*

In America, it is extremely popular for children to collect baseball cards. These cards include, on one side, a photograph of a player in uniform, and on the back information relating to the individual player's career. Such cards are sold in packets which contain chewing gum and provide a strong incentive to purchase a particular brand. Through an assignment, the defendant in *Haelan* received the right to use the baseball players' photographs in connection with the sale of his competing brand.²⁶⁷ At trial, counsel for the defendant maintained that the plaintiff was not entitled to recovery under the right of privacy, because, as a personal right, it was non-assignable.²⁶⁸ The defendant further suggested that the plaintiff's contract amounted only to a release which for the term of the contract precluded the player from suing the plaintiff for invasion.²⁶⁹ The court conceded that the right of privacy vested exclusively in the baseball player but nevertheless recognized the right to publicity:

We think that, in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, *i.e.*, the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," *i.e.*, without an accompanying transfer of a business or of anything else. Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolizes the fact that courts enforce a claim which has pecuniary worth. This right might be called a "right of publicity" [and] [t]his right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.²⁷⁰

The *Haelan* court distinguished the right of publicity from the right to privacy.²⁷¹ Judge Frank noted for example that publicity rights are assignable.²⁷² It is that which makes it possible for a celebrity to control the profitability of his name and like-

267. *Id.* at 869.

268. *Id.* at 867.

269. *Id.*

270. *Id.* at 868.

271. *Id.*

272. *Id.* at 869.

ness in the competitive marketplace of merchandising and endorsements.²⁷³ With the often abrupt changes in public trends and the relatively short careers of athletes and celebrities it is vital, in the absence of career security, to provide such individuals with the bargaining power necessary to the granting of licenses.²⁷⁴

The advertising industry is an important secondary market for public figures.²⁷⁵ The substantial income generated in the area is an important consideration for those involved in the entertainment and sports industries.²⁷⁶ As one legal writer noted, "the notion that, absent some compelling public interest, people are entitled to the benefits of their efforts was an important justification for the expansion of the initial privacy model of the tort."²⁷⁷

Additionally, an increased control on the standard of advertising content would result if public figures were provided with the ability to bargain for the use of their names and likenesses.²⁷⁸ The commercial industry has capitalized on the appeal of endorsements, which often result in increased consumption.²⁷⁹

Many individuals decide to buy a product simply by the virtue of the fact that a film star or athlete has appeared with it.²⁸⁰ The reasons for the success of a product may be as varied as the items themselves.²⁸¹ One explanation for this psychological phenomenon may be a subconscious desire to associate with the celebrity, using the most instantly available method at hand: i.e., select the product enjoyed by that star.²⁸² Another more negative incentive may be a public belief that the promotion is a warranty.²⁸³ This is most likely to occur when the product adver-

273. *Id.* at 868.

274. Berkman, *supra* note 250, at 537.

275. *Id.*

276. *Id.* at 533.

277. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 75 TRADEMARK REP. 41, 65 (1984).

278. Trecce, *Commercial Exploitation of Names, Likenesses and Personal Histories*, 51 TEX. L. REV. 637, 647 (1973).

279. *Id.* at 644.

280. *Id.* at 645.

281. *Id.* at 646.

282. *Id.* at 645.

283. *Id.*

tised is within the same area in which the celebrity achieved distinction.²⁸⁴ Consumers may therefore be misled into purchasing inferior products simply because such items are used by figures who command respect. The potential for this type of abuse provides an additional incentive to celebrities who, by withholding permission, may prevent their names or likenesses from being misused for promotional purposes.²⁸⁵ This view was elucidated in a law review article:

If society chooses to allow uses of names and likeness in advertising, it might prefer that consumers not be misled about the willingness of a celebrity to associate himself with a product or service. Similarly, society might decide that the "emulating" behavior of consumers would channel itself more acceptably if the persons emulated had some control over the decision to link their names and likenesses with particular products.²⁸⁶

Consumers as well as public figures would be benefitted by such control, for it would provide celebrities with a stronger position when negotiating with those wishing to use their fame for commercial purposes. Additionally, if the product to be sold is in conflict with the aims or beliefs of the celebrity, or is unfit for sale, the use of name and likeness could be denied altogether.²⁸⁷ The recognition of a right of publicity as a property right was imperative if worthwhile controls were to be placed on the advertising and merchandising industries.²⁸⁸

The conflict and uncertainty exhibited by American courts who grappled with the fundamental distinction between a celebrity's right of privacy and the right to publicity is expressed in the cases to follow. Although the *Haelan* decision is important insofar as it designated publicity as a separate property right, much confusion reigned in subsequent cases. Complications in judicial reasoning could have been avoided if *Haelan* had been strictly followed. Yet, as Professor Nimmer points out "by the very nature of our judicial process, a new principle of

284. *Id.*

285. *Id.* at 647.

286. *Id.*

287. *Id.* at 642-43.

288. *Id.* at 647.

law can never be completely embodied in any one decision."²⁸⁹ The right of publicity is frequently raised when the courts are presented with public figure plaintiffs.²⁹⁰ This right is extremely useful: it encompasses not merely a claim for remuneration for unauthorized use of name and likeness, but recompense for the affront to personal dignity.²⁹¹

Often a celebrity's image will be inconsistent with the product for which his likeness is used. For this reason "[t]he economic injury, resulting from an appropriation of a celebrity's identity should not obscure the concurrent harm to personal integrity and autonomy."²⁹² The distinction between a celebrity's identity and the product for which his likeness was used, formed the basis of the plaintiff's claim in *O'Brien v. Pabst Sales Co.*²⁹³

The parties were characterized in a unique manner by Judge Hutcheson: "Plaintiff, in physique as in prowess as a hurler, a modern David, is a famous football player. Defendant, in bulk, if not in brass and vulnerability, a modern Goliath, is a distributor of Pabst beer."²⁹⁴ In 1939, Davy O'Brien was selected to pose as the most popular football player of the year for publicity pictures to be taken by his university.²⁹⁵ The defendant, in an effort to increase sales, produced a football calendar in which the plaintiff's photograph appeared accompanied by the words "Pabst [f]amous [b]lue [r]ibbon [b]eer."²⁹⁶

As a member of an organization called "[T]he Allied Youth of America," O'Brien used his fame to promote the organization's theme, which discouraged the consumption of alcoholic beverages.²⁹⁷ The plaintiff had been approached on several occasions with offers to endorse various alcoholic drinks, but he consistently refused.²⁹⁸ After learning of the association of his pho-

289. Nimmer, *supra* note 237, at 222.

290. Hefter & Besha, *Character Merchandising in the USA: A Search for Definable Remedies and a Warning of Potential Liability*, INDUS. PROP. L. 592 (1978).

291. Denicola, *supra* note 277, at 66.

292. *Id.*

293. 124 F.2d 167 (5th Cir. 1942).

294. *Id.* at 168.

295. *Id.*

296. *Id.*

297. *Id.*

298. *Id.* at 169.

tograph with a nationwide advertisement for beer, he brought a claim for invasion of privacy against the defendant.²⁹⁹ The holding, rendered in favor of the defendant, relied upon the proposition that as the most publicized player, O'Brien had impliedly waived any right of privacy.³⁰⁰ The court determined this by the fact that over 800 photographs of the plaintiff were provided to magazines without his objection.³⁰¹ O'Brien's contention that the calendar would suggest to the public that the players listed were sanctioning the consumption of beer was found by the court to be lacking in merit.³⁰²

In a dissenting opinion, Justice Holmes found that the defendant was in fact liable for appropriating the plaintiff's property right by using his photograph for the purpose of advertising.³⁰³ Relying upon the standard practices engaged in by advertising companies, who frequently offered substantial monetary incentives for the use of famous players likenesses, Holmes decried the plight of those like the plaintiff who were left without legal redress:³⁰⁴ "The decision of the majority leaves the appellant without remedy for any non-libelous use made of his picture by advertisers of beer, wine, whisky, patent medicines, or other non-contraband goods, wares, and merchandise. It also places every other famous stage, screen and athletic star in the same situation."³⁰⁵ This may seem late when one notes that the first mention of the need for privacy occurred in what may only be described as a landmark article, *The Right To Privacy*,³⁰⁶ published in 1890. This article was motivated by the newspaper practice of engaging in gossip which exposed the personal idiosyncrasies and habits of the wealthy.³⁰⁷

In particular, the newspapers of Boston chose to write in glaring detail about the parties given by Mrs. Samuel D. Warren.³⁰⁸ William Prosser described the events which inspired War-

299. *Id.* at 168.

300. *Id.* at 169.

301. *Id.*

302. *Id.*

303. *Id.* at 171.

304. *Id.*

305. *Id.*

306. Warren & Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

307. *Id.* at 196.

308. Prosser, *supra* note 3, at 383.

ren and Brandeis to advocate so vigorously the need for a recognized right of privacy:

It was the era of "Yellow Journalism," when the press had begun to resort to excesses in the way of prying that have become more or less commonplace today; and Boston was perhaps, of all the cities in the country, the one in which a lady and a gentleman kept their names and their personal affairs out of the papers. The matter came to a head when the newspapers had a field day on the occasion of the wedding of a daughter, and Mr. Warren became annoyed. It was an annoyance for which the press, the advertisers and the entertainment industry were to pay dearly over the next 70 years.³⁰⁹

The article, produced by two of America's most famous attorneys, Warren and Brandeis, launched a fervent attack on the press for failing to be an impartial observer in the recording of events.³¹⁰ Their article generated the spirit needed to protect individuals from unwanted injection into the public forum:

The press is overstepping in every direction the obvious bounds of propriety and of decency. Gossip is no longer the resource of the idle and of the vicious, but has become a trade, which is pursued with industry as well as effrontery No enthusiasm can flourish, no generous impulse can survive under its blighting influence.³¹¹

In formulating the argument in favor of creating a privacy right, Warren and Brandeis looked at two English cases, the first of which is *Prince Albert v. Strange*.³¹² The facts of this 1849 case involved a request by the Prince that the defendant be enjoined from placing on exhibition and offering for sale a catalog containing etchings made by the Queen and Prince for their own amusement.³¹³ The defendant allegedly came into possession of the prints when an employee of the royal printer made impres-

309. *Id.*

310. Warren & Brandeis, *supra* note 306, at 196.

311. *Id.*

312. 41 Eng. Rep. 1171 (1849).

313. *Id.*

sions of the etchings.³¹⁴ Although the defendant denied that his possession of the works occurred through surreptitious means, the court enjoined the exhibition, but did not disturb the publication of the catalog.³¹⁵ In spite of defendant's willingness to return all the etchings in his possession and, "as a loyal and dutiful subject, in every respect comply with the wishes of the Queen,"³¹⁶ he insisted upon the right to reproduce the catalog.³¹⁷ On behalf of the Prince, the solicitor general argued: "The interference of the [c]ourt is not asked for in this case on the ground of decorum or good taste, but on the general principle that this [c]ourt will protect every person in the free and innocent use of his own property."³¹⁸ Warren and Brandeis, in their enthusiasm to find initial stirrings of the privacy doctrine in the English courts, appear to have grasped the reasoning in the *Prince Albert* case too tightly. The opinion addresses the propriety of maintaining protection for property rights with some ancillary discussion of the breach of confidence in the printer's workmen.³¹⁹ Indeed, while privacy may have been what Prince Albert sought to protect via the injunction, the means by which he achieved it remain within the context of a property right.³²⁰ A similar view was taken in measuring the relative importance accorded to the case: "Warren and Brandeis discerned in this decision 'merely an instance of the enforcement of the more general right of the individual to be left alone' but . . . the decision is based mainly on the right of property which the plaintiff had in the prints."³²¹

The next English case the American courts relied on to support the proposition that privacy was an interest worthy of protection was *Pollard v. Photographic Co.*³²² This action, tried in 1888, was brought against the Photographic Company for the unauthorized use of the plaintiff's photograph in an advertisement.³²³ The plaintiff, Mrs. Pollard, entered defendant's store

314. *Id.* at 1172.

315. *Id.* at 1173.

316. *Id.* at 1174.

317. *Id.*

318. *Id.* at 1175.

319. *Id.*

320. *Id.* at 1176.

321. *R. Wacks, supra* note 106, at 5.

322. 60 L.T.R. 418 (1888).

323. *Id.* at 419.

with the intention of having several photographs taken of herself.³²⁴ Without her authorization, the plaintiff's portrait was displayed in the defendant's store window.³²⁵ At trial, the defendant's argument that a photographic negative is the property of the photographer and available for his use in the absence of illegal acts such as libel or slander failed.³²⁶ Judge North, in delivering his opinion, analogized the relationship between customer and photographer to that of attorney and client.³²⁷ He claimed that an element of confidentiality existed in both relationships.³²⁸ By reproducing for his own use photographs taken from the plaintiff's portrait, the defendant was, in the judge's opinion, liable for breach of faith.³²⁹ Additionally, the opinion illustrated the belief that, absent an express agreement between the photographer and his subjects, prints taken without consent amounted to a breach of contract.³³⁰ The description of the relationship between the plaintiff and the defendant in this case would appear to designate the abuse as existing exclusively within the realm of either contract or trust. However, the reading of the *Pollard* case by Warren and Brandeis would suggest that the legal terms "trust" and "contract" were used to denote a privacy interest. Failing to ascertain any evidence of the privacy doctrine in English law, Warren and Brandeis, discussing *Pollard* remarked, "since the latest advances in photographic art have rendered it possible to take pictures surreptitiously, the doctrines of contract and of trust are inadequate to support the required protection and the law of tort must be resorted to."³³¹

The lack of precedent in England did not inhibit Warren and Brandeis, who argued that a new approach was needed if American jurisprudence were to provide an effective method of protection against invasions of privacy.³³² But, a reluctance to depart from the status quo was clear in the first few cases which tested the theory of a privacy right. One of the most famous of

324. *Id.*

325. *Id.*

326. *Id.*

327. *Id.*

328. *Id.*

329. *Id.* at 420.

330. *Id.*

331. Warren & Brandeis, *supra* note 306, at 211.

332. *Id.*

these cases was *Roberson v. Rochester Folding Box Co.*³³³ tried in 1902. The case involved an ordinary individual, Abigail M. Roberson, who sued the defendant for using her photograph without permission in an advertisement for his product, baking flour.³³⁴ The Franklin Mills Co. reproduced the plaintiff's photograph on cartons of flour with a caption which read "[f]lour of the [f]amily."³³⁵ Below this caption, in smaller print, appeared the name of the second defendant: "Rochester Folding Box Co, Rochester, N Y."³³⁶

The use of Miss Roberson's likeness produced an immediate physical reaction in the plaintiff, subsequently diagnosed as nervous shock.³³⁷ Due to the overt display of the defendant's product in stores, markets and other areas to which the public was admitted, the photograph was recognized by friends and acquaintances of the plaintiff.³³⁸ It was later discovered that her photograph appeared on at least 25,000 cartons marketed throughout America and internationally.³³⁹ The plaintiff requested a permanent injunction as well as \$15,000 damages.³⁴⁰ The court recognized that the plaintiff's complaint was predicated on a new, as yet unrecognized right.³⁴¹ The judge held in favor of the plaintiff, notwithstanding the lack of precedent for his decision.³⁴² The court found that the defendant's use of her likeness for economic advantage in furthering its own business interests constituted an invasion of her privacy right, which the court characterized as "the right to be let alone."³⁴³

On appeal, Justice Parker reversed the lower court's holding on the theory that it was the province of the legislature to enact such a novel principle and not that of the court which must abide by previous decisions.³⁴⁴ Mention was also made of the early English cases, which do not themselves provide a recogni-

333. 171 N.Y. 538, 64 N.E. 442 (N.Y. 1902).

334. *Id.*

335. *Id.*

336. *Id.*

337. *Id.*

338. *Id.*

339. *Id.* at 448.

340. *Id.* at 442.

341. *Id.* at 443.

342. *Id.*

343. *Id.*

344. *Id.*

tion of the right of privacy. Fearful that the floodgates would be open to a plethora of claims if a ruling for the plaintiff were granted, the court refused to recognize a right of privacy.³⁴⁵ Louis Nizer, a U.S. attorney best known for his legal writing, astutely commented on the rationale behind Justice Parker's holding: "The reason for the court's ruling was its fear that the recognition of the right of privacy would result in a deluge of litigation which would make it impossible to prevent the doctrine from being extended step by step until it embraced all sorts of absurdities."³⁴⁶ Justice Parker attempted to mitigate the harshness of his decision by directing counsel to the penal code section 242, which contains sanctions for malicious publication.³⁴⁷ This may provide a civil remedy at common law or allow the instigation of criminal proceedings for cases involving the publication of a photograph if the plaintiff is able to prove that the material constituted a libel.³⁴⁸ This attempt to soften his judgment was meaningless, for it was asserted at trial that the plaintiff was not libeled by the photograph.³⁴⁹ Indeed, due to the quality of the likeness the plaintiff's friends were able to identify Miss Roberson as the face in the advertisement.³⁵⁰

The case contains an aggressive dissent by Justice Grey who argued that the plaintiff had suffered a serious wrong which should be remedied if not at law then in equity.³⁵¹ Courts of equity were created for instances such as this, where one seeking redress was unable to formulate a claim recognizable at law.³⁵² Justice Grey found it unthinkable that protection could be afforded in *Prince Albert* and *Pollard* on the basis of a property claim, while it was denied in the present action.³⁵³ He noted that, in *Roberson*, the defendant's acts were just as reprehensible as if they had taken for their own monetary gain a writing or etching created by the plaintiff.³⁵⁴ As to the inability of the common law to provide redress for actions such as those of the de-

345. *Id.*

346. Nizer, *supra* note 203, at 532.

347. *Roberson*, 171 N.Y. 538, 64 N.E. 442 (N.Y. 1902).

348. *Id.*

349. *Id.* at 442.

350. *Id.*

351. *Id.* at 449.

352. *Id.*

353. *Id.* at 451.

354. *Id.* at 450.

pendant, Justice Grey stated:

It would be a reproach to equitable jurisprudence if equity were powerless to extend the application of the principles of common law or of natural justice in remedying a wrong, which, in the progress of civilization, has been made possible as the result of new social or commercial conditions.³⁵⁵

After *Roberson* a strong sentiment developed that it was unconscionable for the law to turn its back on a plaintiff who, like Abigail Roberson, suffered embarrassment and illness due to the wrongful taking of her likeness.³⁵⁶ The time was ripe to develop new legal remedies. The effect of the decision had almost instantaneous impact.³⁵⁷

Public figures litigating claims based on the right of privacy were to encounter substantial difficulty because of the courts holding that notoriety constituted an implied waiver.³⁵⁸ This twist in judicial reasoning proved daunting to those who, like Davey O'Brien having developed a public image, were to be denied the opportunity to litigate on the issue of privacy. Justice Holmes, in his dissenting opinion theorized that, in renouncing his right of privacy, the plaintiff received in exchange a right to publicity.³⁵⁹

Since publicity is, after *Haelan*, considered to be a property right, a celebrity's control over the use of his likeness would remain inviolate from defenses raised by defendants such as Pabst.

Turning from the athletic sphere to that of the motion picture industry, the case of *Paramount Pictures v. Leader Press*³⁶⁰ illustrates that film stars are also without legal protection in litigating under the guise of privacy. This case was brought by Paramount Studios to enjoin the defendant from manufacturing

355. *Id.* at 449.

356. Yang, *Privacy: A Comparative Study of English and American Law*, 15 INT'L & COMP. L.Q. 175, 181 (1966).

357. *Id.*

358. Nimmer, *supra* note 237, at 204.

359. *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1942).

360. 106 F.2d 229 (10th Cir. 1939).

and offering for sale items which related to films produced by them.³⁶¹ Counsel for the plaintiff urged that advertising is an important tool which, if correctly executed, communicates to the public information which is calculated to ensure star status to their actors.³⁶² The products sold by Leader Press were described by the plaintiff as follows: "[T]hey, [defendants] incorporate therein pictures, cartoons, and caricatures of the stars and featured players . . . in an inartistic, grotesque and inferior manner."³⁶³ In particular, the plaintiff objected to a picture of Claudette Colbert, which the defendant produced following her performance as Cleopatra.³⁶⁴ Due to poor workmanship, Miss Colbert's head appeared to be that of a negress.³⁶⁵ In granting judgment for Paramount, the court found that the defendant's sale of items to film theaters had induced a breach of the contract between the plaintiff and its exhibitors.³⁶⁶ By entering the public forum as a famous actress, Miss Colbert's only claim could have been based on the right of publicity, for like Davey O'Brien, notoriety would have precluded recovery on an action to preserve her privacy.³⁶⁷

The decisions continued to represent a growing judicial uncertainty regarding application of the right of privacy in the context of a celebrity.³⁶⁸ The distinction between the right to be left alone as advanced by Justices Warren and Brandeis, and the prevention of appropriation through the right of publicity remained unclear.³⁶⁹ In cases where a public figure was granted judgment, the courts appeared to arbitrarily select one of the two rights.³⁷⁰ The case brought by Muhammad Ali against Playgirl magazine appealed for recognition of both of these rights.³⁷¹

Muhammad Ali, until his defeat by Leon Spinks, was the

361. *Id.* at 230.

362. *Id.*

363. *Id.*

364. *Id.* at 231.

365. *Id.*

366. *Id.* at 232.

367. Nimmer, *supra* note 237, at 205.

368. Nimmer, *supra* note 237, at 204.

369. Berkman, *supra* note 250, at 527.

370. *Id.*

371. Ali v. Playgirl Inc., 447 F. Supp. 723 (S.D.N.Y. 1978).

heavyweight boxing champion of the world.³⁷² He sued Playgirl magazine for using a portrait in its February 1978 issue which depicted a black man sitting in the corner of a boxing ring wearing nothing but tape on his hands.³⁷³ Although the portrait was an illustration not a photograph, the physical resemblance to Ali was undisputed.³⁷⁴ The caption underneath read "Mystery Man,"³⁷⁵ and was followed by a line which referred to the figure as "The Greatest."³⁷⁶ The court took judicial notice of Ali's successful efforts to characterize himself in the media as "the greatest" by referring to the cover of *Time* magazine, issued after the Ali-Spinks fight, which read "'The Greatest' is [g]one."³⁷⁷

Muhammad Ali alleged that the defendant was liable for invading both his statutory right of privacy as well as his common law right to publicity.³⁷⁸ Following the issuance of a preliminary injunction, counsel for the defense moved that, despite cessation of distribution of the issue in the domestic market, sales of the magazine be allowed to continue in England.³⁷⁹ In support of its motion, the defendant claimed that the right of privacy was inapplicable to the plaintiff who as a public figure was not entitled to invoke the protection offered under the privacy statute.³⁸⁰

Judge Gagliardi resolved the issue by holding that Ali's status as a celebrity did not prevent him from asserting a right to privacy under New York statutory law.³⁸¹ "That [plaintiff] may have voluntarily on occasion surrendered [his] privacy, for a price or gratuitously, does not forever forfeit for anyone's commercial profit so much of [his] privacy as [he] has not relinquished."³⁸² This decision clearly acknowledged that if one ventures into the public view, there is still a concurrent right to keep private certain aspects of one's personal life which, if made available for comment, would result in an abuse of personal dig-

372. *Id.* at 725 n.1.

373. *Id.* at 725-26.

374. *Id.* at 726.

375. *Id.* at 726-27.

376. *Id.* at 727.

377. *Id.* at 727 n.8.

378. *Id.* at 726.

379. *Id.* at 730.

380. *Id.* at 727.

381. *Id.* at 728.

382. *Id.* at 727 (citing *Booth v. Curtis Publishing Co.*, 15 A.D. 2d 343, 351-52, 223 N.Y.S. 2d 737, 745 (1962)).

nity.³⁸³ Thus, public celebrities are, under the *Ali* decision, able to claim the same right to privacy as any other private individual.

In addressing the plaintiff's second claim, that the publication of his likeness was a violation of his right to publicity, Judge Gagliardi noted that most New York courts do not distinguish the property right of publicity from privacy claims.³⁸⁴ The right to publicity was described as analogous to the concept of goodwill developed by a company.³⁸⁵ In granting the plaintiff's right to protect this interest, Gagliardi reflected that his judgment was "the straightforward one of preventing unjust enrichment by the theft of good will [sic]."³⁸⁶ The holding in this case accommodated a finding that the portrait amounted to the unlawful appropriation of Muhammad Ali's likeness³⁸⁷ as well as an invasion of his separate and distinct right to privacy.³⁸⁸

Not all courts have recognized the theory that publicity and privacy rights may be mutually exclusive for purposes of adjudication.³⁸⁹ The lack of independent analysis accorded to each interest does not always result in a disadvantage to plaintiffs who are seeking to vindicate their claims for legal protection.³⁹⁰

In *Palmer v. Schonhorn Enterprises Inc.*,³⁹¹ four well-known professional golfers brought an action for injunction against the defendant who, in marketing a board game, used the plaintiffs' names in association with an advertisement.³⁹² The game consisted of "profiles and playing charts" which specified biographical information about *inter alia*, the four plaintiffs.³⁹³ In spite of the fact that the information used by Schonhorn Enterprises was accurate, the defendant did not obtain consent

383. *Id.* at 728.

384. *Id.*

385. *Id.*

386. *Id.* at 728-29 (citing Kalven, *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

387. *Id.* at 729.

388. *Id.* at 728.

389. *Palmer v. Schonhorn Enter. Inc.*, 96 N.J. Super. 72, 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967).

390. *Id.* at 462.

391. *Id.* at 458.

392. *Id.* at 459.

393. *Id.*

prior to production and distribution of the game.³⁹⁴ The defendant's failure to comply with a request by the plaintiffs that they be disassociated with the product resulted in litigation.³⁹⁵ At trial, it was conceded by the defendants that the use of the golfers' names increased the sales potential of the game.³⁹⁶ For their part, the plaintiffs urged that the unwarranted taking of their names not only reduced their potential to receive remuneration from other manufacturers, but also infringed their right to privacy.³⁹⁷ Predictably, defense counsel argued that the plaintiffs were not entitled to a right of privacy since their entry into a professional sport operated as a waiver.³⁹⁸ Schonhorn also maintained that the information used by them in the game was "public data and available to all, it should not be denied the privilege of reproducing that which is set forth in newspapers, magazine articles and other periodicals."³⁹⁹

In his opinion, Judge Horn recognized that the act of republishing biographical information regarding a celebrity was within the protection afforded by the first amendment of the United States Constitution, and was not a violation of privacy in a strict sense.⁴⁰⁰ The plaintiffs' complaint, however, alleged that the defendant's use of the information was to further its own pecuniary advantage in a commercial market.⁴⁰¹

Schonhorn's appropriation was thus viewed as an impediment to the free enjoyment of profit which should flow to the plaintiffs as a result of effort expended in the golfing profession.⁴⁰² Judge Horn's view in granting judgment for the plaintiffs was that a contrary ruling would prove fundamentally unfair.⁴⁰³ As noted by one legal writer: "Fortunately, the court did not commit the further error of proclaiming that public figures sacrifice, or waive, their rights of publicity as to their names or biog-

394. *Id.*

395. *Id.*

396. *Id.*

397. *Id.*

398. *Id.* at 460.

399. *Id.*

400. *Id.* at 462.

401. *Id.* at 459.

402. *Id.* at 462.

403. *Id.*

raphies, thereby precluding any relief."⁴⁰⁴ By permitting the plaintiffs to recover in spite of their standing as celebrities, the privacy doctrine was, in this instance, expanded to include the right to publicity.⁴⁰⁵ Here, a monetary interest was protected not as a property right, but under the belief that public figures do not sacrifice their privacy even in a commercial context.⁴⁰⁶ Although as far as the plaintiffs were concerned, the ends justified the means, the court neglected to seize the chance to distinguish between a property, as opposed to a personal, right. Three years later, a strikingly similar fact situation arose.

In *Uhlaender v. Henricksen*,⁴⁰⁷ the plaintiff sued on behalf of all major league baseball players to enjoin the defendant from using their names in the production of two board games called "Big League Manager Baseball"⁴⁰⁸ and "Negamco's Major League Baseball."⁴⁰⁹ These games used information concerning 500-700 baseball players from the major leagues.⁴¹⁰ The action was formally brought by an association which represented the collective interests of over 850 players, and was responsible for negotiating, licensing and marketing contracts as well as group endorsements.⁴¹¹ At the time of the action over 27 licensing agreements were in force, four or five of which were with distributors of products similar to those manufactured by the defendant.⁴¹² These agreements produced revenue for the players; the evidence established that in the previous year alone the total income realized from such ventures exceeded \$400,000.⁴¹³

After informing Henricksen that his products constituted an appropriation of a property right, the association offered to enter into a standard licensing contract.⁴¹⁴ The action arose out of the defendant's unwillingness to either withdraw the games from the consumer market or to be party to a recognized agree-

404. Berkman, *supra* note 250, at 537.

405. *Palmer*, 232 A.2d at 462.

406. *Id.* at 461.

407. 316 F. Supp. 1277 (D. Minn. 1970).

408. *Id.* at 1278.

409. *Id.*

410. *Id.*

411. *Id.* at 1278-79.

412. *Id.* at 1279.

413. *Id.*

414. *Id.*

ment.⁴¹⁵ The defendant claimed that, as public figures, the plaintiffs were not entitled to invoke the right of privacy, and that by charging a licensing fee of \$2,500 the plaintiff was attempting "to keep little people out of the business."⁴¹⁶ Henricksen's effort to escape liability on the basis that the privacy tort was unavailable to professional sportsmen failed.⁴¹⁷ This defense was ineffective because the ground upon which relief was sought by the plaintiff was "misappropriation and use for commercial profit of the names of professional major league baseball players without the payment of royalties."⁴¹⁸ The court distinguished rights involving privacy from those relating to a proprietary interest.⁴¹⁹ The contention that a celebrity is precluded from objecting to the use of his name had merit only in an action for the invasion of privacy which, as Judge Neville stated, was separate from the right in contention.⁴²⁰ The time and effort invested by baseball players in achieving fame was to be rewarded by the income generated from agreements such as those negotiated by the association.⁴²¹

The *Uhlaender* ruling safeguards the principle that name and likeness rights constitute a viable property interest.⁴²² The *Palmer* and *Uhlaender* holdings have been summarized as follows: "In addition to the just result rendered in *Uhlaender*, its value lies in the fact that the court, in contrast to the *Palmer* court, analyzed the right in question and acknowledged the essential differences between the right of privacy and the right to publicity."⁴²³

The case which conclusively established the right of publicity as a property right was *Zacchini v. Scripps - Howard Broadcasting Co.*⁴²⁴ Appearing in virtually every American tort textbook to illustrate the limitations of the first amendment right of free speech, the case is helpful in the context of publicity rights.

415. *Id.*

416. *Id.*

417. *Id.* at 1288-89.

418. *Id.* at 1279.

419. *Id.* at 1280.

420. *Id.* at 1283.

421. *Id.* at 1282.

422. *Id.* at 1283.

423. Berkman, *supra* note 250, at 539.

424. 47 Ohio St. 2d 224, 351 N.E.2d 454 (Ohio 1976).

354 GOLDEN GATE UNIVERSITY LAW REVIEW [Vol. 18:301

The facts involve Zacchini who, in spite of his express refusal, had the tape of his entire 15-second performance as a "human cannonball" broadcast by the defendant's television station.⁴²⁵ The plaintiff argued before the Ohio State Supreme Court that his right to publicity had been infringed by the television station.⁴²⁶ In response, the defendant invoked its first amendment rights to report on "newsworthy events."⁴²⁷ After a ruling in favor of the defendant, the case was appealed to the United States Supreme Court.⁴²⁸ The lower court's holding was reversed, the Supreme Court finding that the plaintiff's performance was compensable as a property right thereby rendering ineffective the constitutional defense.⁴²⁹ The Court reasoned that Zacchini had developed an unusual act which the defendant's broadcast had minimized the likelihood that the public would pay to see, the performance of which had been provided for free to those viewing at home.⁴³⁰

The Supreme Court concluded that a valuable property interest was affected because "the telecast had gone beyond the bounds of First Amendment protection by appropriating Zacchini's 'entire act.'"⁴³¹ Publicity, as a means from which income is derived, is viewed at the highest level of the federal judiciary as an important right of property.⁴³² The courts will protect individuals such as Zacchini from appropriations which seek to remove the monetary gain derived from commercial endeavors in the public sphere.⁴³³

The American cases unequivocally established that a right to publicity was entitled to protection either independently of or in coexistence with the right to privacy.⁴³⁴ The application of these rights to celebrities by the American courts developed logically from the early cases, and such courts now regard the com-

425. *Zacchini*, 351 N.E.2d 454.

426. *Id.* at 460.

427. *Id.* at 460-61.

428. 433 U.S. 562 (1979).

429. *Id.* at 576.

430. *Id.*

431. Felcher & Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1590-91 (1979) (citing *Zacchini*, 433 U.S. at 579 & n.1 (Powell, J., dissenting)).

432. *Zacchini*, 433 U.S. at 570.

433. *Id.*

434. Rader, *supra* note 1, at 243.

mercial exploitation of name and likeness to be an important attribute of a public figure's career.⁴³⁵ The benefit to celebrities which may arise from merchandising, licensing contracts and endorsements can potentially yield an income far greater and longer lasting than the primary field in which notoriety and public recognition was achieved.⁴³⁶ Legal protection of such income will enable film stars, recording artists, athletes, and local public performers to enjoy the "fruit of their labor."⁴³⁷

Once the courts had characterized publicity as a property right, they were, as the cases to follow illustrate, faced with a deluge of litigation regarding standing to bring a claim for misappropriation.⁴³⁸ Certainly the celebrity is entitled to ask for judicial recognition of the right to publicity.⁴³⁹ But the issue of whether the heirs of a public figure could claim protection on their own behalf still required adjudication.⁴⁴⁰ The inheritability of name and likeness rights was also unsettled.⁴⁴¹ The attempt of the courts to cope with the issue of divisibility has been summarized as follows:

When first presented with this theory, courts found it sufficiently disconcerting to reject it outright. However, after two decades of agreement that the right of publicity is a property right, the idea became more palatable, and several courts held that the right could be inherited . . . other cases have proposed different rationales and came to different conclusions about the circumstances under which inheritance may occur.⁴⁴²

*Price v. Hal Roach Studios Inc.*⁴⁴³ established that a right of publicity did not terminate upon the death of the celebrity whose likeness was the subject of revenue.⁴⁴⁴ The parties to this action were the respective widows of Oliver Hardy and Stanley Laurel, who were the designated beneficiaries of the estates be-

435. Denicola, *supra* note 277, at 62-63.

436. Hefter & Besha, *supra* note 290, at 593.

437. Nimmer, *supra* note 237, at 216.

438. Felcher & Rubin, *supra* note 431, at 1593.

439. *Id.* at 1589.

440. *Id.* at 1593.

441. *Id.*

442. *Id.* at 1595.

443. 400 F. Supp. 836 (S.D.N.Y. 1975).

444. *Id.* at 844.

longing to the two famous comic actors.⁴⁴⁵

As plaintiffs, the widows brought a claim against Roach Studios, for their use of the names and likenesses of Laurel and Hardy.⁴⁴⁶ The defendant, which had entered into several service contracts with the actors for the years 1923 through 1939, claimed that any rights to which the actors had been entitled had been waived, or, in the alternative, that such rights were in the public domain.⁴⁴⁷ Since the plaintiffs did not contest Roach's right to market the films and still photographs taken while the actors were under contract with the studio, the court focused only on the request that the defendant be restrained from merchandising the names or likenesses of Laurel and Hardy after the expiration of the contract term.⁴⁴⁸ Counsel for the defendant attempted to establish that a clause which granted "to Roach the exclusive rights to photograph, copyright, and reproduce all the 'acts, poses, plays and appearances' of Laurel and Hardy for the contract term and 'perpetually'"⁴⁴⁹ was the equivalent of a non-revocable license.⁴⁵⁰ The court, however, construed the clause to relate only to the films and photographs taken while the actors were employees of the studio, and not to mean that Roach was entitled to exploit their personalities in any other context.⁴⁵¹

Both the actors had continued to pursue their careers after the expiration of their studio contracts, which indicated that a perpetual right accorded to Roach "was neither contemplated by the parties nor specifically provided for in the contracts."⁴⁵² This conclusion was further supported by the fact that Stanley Laurel had specifically insisted that he be free to appear on the radio for the purpose of endorsing various products.⁴⁵³ The court placed great emphasis on the fact that, after both actors had left the employment of Roach Studios, their subsequent work was

445. *Id.* at 838.

446. *Id.* at 839.

447. *Id.*

448. *Id.* at 840.

449. *Id.*

450. *Id.* at 840-42.

451. *Id.* at 841.

452. *Id.*

453. *Id.*

left undisturbed.⁴⁵⁴

After finding that the contract produced at trial by the defendant was insufficient to support a claim that Roach owned the exclusive rights claimed by the plaintiffs, the court then considered the issue of waiver.⁴⁵⁵ The defendant theorized that, due to the actors' failure to use their names and likenesses for the years 1940 to 1954, their right to publicity was abandoned.⁴⁵⁶ Judge Stewart described this argument as "nonsensical,"⁴⁵⁷ and cited the New York privacy statute which provides that a celebrity may elect to leave unused his public profile.⁴⁵⁸

Judge Stewart's opinion provides an important supplement to the statutory law on the issue of devisability, for he concluded that "[t]here cannot, therefore, be any necessity to exercise the right of publicity during one's life in order to protect it from use by others or to preserve any potential right of one's heirs".⁴⁵⁹ His holding illustrates the flaw in the arguments presented by the defendant, for by claiming that the right to publicity exists only for the duration of a celebrity's life, counsel mistook publicity for privacy.⁴⁶⁰

The right of privacy has been defined as a personal right to protect against harm to individual feelings.⁴⁶¹ It follows that this right will perish with the individual who may have found the necessity to invoke its protection.⁴⁶² For this reason, the right of privacy cannot be assigned or inherited as it is essentially a personal right protecting individual integrity.⁴⁶³ In reference to the right of publicity, the *Price* court concluded: "There appears to be no logical reason to terminate this right upon death of the person protected. It is for this reason, presumably, that this publicity right has been deemed a 'property right.'"⁴⁶⁴ It is im-

454. *Id.*

455. *Id.* at 846.

456. *Id.*

457. *Id.*

458. *Id.*

459. *Id.*

460. *Id.*

461. Berkman, *supra* note 250, at 527.

462. Felcher & Rubin, *supra* note 431, at 1593.

463. *Id.*

464. *Price*, 400 F. Supp. at 844.

portant to note that, while the court maintained the plaintiffs' right to control the names and likenesses of "Stan and Olly," such rights were enforceable by designated heirs as distinguished from "mere descendants."⁴⁶⁵

In *Lugosi v. Universal Pictures*,⁴⁶⁶ the plaintiff was ultimately not as successful as the widows of Laurel and Hardy.⁴⁶⁷ The defendant, Universal Studios, was the original producer of the film "Dracula," which starred the actor Bela Lugosi.⁴⁶⁸ A claim was brought against Universal for invasion of the right to publicity following the execution of licensing agreements between the studio and producers of merchandised items which depicted Lugosi in his role as Dracula.⁴⁶⁹ The trial court, in accordance with *Haelan and Uhlaender*, found that the right to publicity had in fact been appropriated.⁴⁷⁰ The court also determined that Lugosi's right to publicity could be inherited by the beneficiaries to his will.⁴⁷¹

This happy ending was not the final ending, for Universal appealed the case to the Court of Appeal of California,⁴⁷² which determined that there was no policy basis to support the survival of a right of publicity surviving the death of the individual concerned.⁴⁷³ Thus, Lugosi's heirs were not entitled to the exclusive right to market Lugosi as Dracula.⁴⁷⁴

The court noted that Lugosi himself had failed to exploit the marketing potential of his name and likeness during his lifetime.⁴⁷⁵ Lugosi's nonuse for the entire duration of his career resulted in a forfeiture of the right to publicity.⁴⁷⁶ Had any aspect of the Dracula personality been used for commercial purposes during the actor's life, the court might have provided a ruling

465. *Id.* at 844 n.8.

466. *Lugosi v. Universal Pictures*, 139 Cal. Rptr. 35 (1977).

467. *Id.* at 40.

468. *Id.* at 36.

469. *Id.*

470. *Id.* at 37.

471. *Id.*

472. *Lugosi v. Universal Pictures*, 139 Cal. Rptr. 35 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

473. *Id.* at 40.

474. *Id.*

475. *Id.* at 37.

476. *Id.* at 38.

similar to the decision in *Price*.

The question of whether a celebrity must market the right to publicity during his lifetime was again raised in *Groucho Marx Productions v. Day and Night Co.*⁴⁷⁷ This action involved the assignees of the Marx Brothers rights to publicity.⁴⁷⁸ The defendant, Day and Night, produced a play entitled "A Day In Hollywood/A Night In the Ukraine,"⁴⁷⁹ which allegedly infringed upon the characterization of the Marx Brothers.⁴⁸⁰ Although the names Groucho, Chico and Harpo were never mentioned, the script involved a depiction of Anton Chekov's novel, *The Bear*, as performed by three actors utilizing the style of acting made famous by the Marx Brothers.⁴⁸¹ The plaintiff claimed damages "in the nature of a license fee."⁴⁸²

The United States District Court of New York granted a partial summary judgment in favor of the plaintiff.⁴⁸³ Judge Connor found that the appropriate substantive law to govern the action was that of New York which, unlike California, recognized an inheritable right to publicity.⁴⁸⁴ Also, since under New York law a celebrity was required to exploit his name and likeness rights during his lifetime, Connor found that a commercial use was inherent in the actors' performance itself.⁴⁸⁵ Thus every performance, act, or public appearance by the Marx Brothers "was sufficient exploitation without the need for them to 'endorse dance studios, candy bars or tee shirts.'"⁴⁸⁶

Like the ruling in *Lugosi*, this judgment in favor of the assignees was also short-lived.⁴⁸⁷ On appeal, Judge Newman determined that the appropriate choice of law was that of California.⁴⁸⁸ In accordance with the rules of that state, he found that the right to publicity and the right of privacy terminated upon a

477. *Groucho Marx Prod. v. Day and Night Co.*, 689 F.2d 317 (2d Cir. 1982).

478. *Id.* at 318.

479. *Id.*

480. *Id.*

481. *Id.* at 319.

482. *Id.*

483. *Id.*

484. *Id.*

485. *Id.*

486. *Id.*

487. *Id.* at 322.

488. *Id.*

celebrity's death.⁴⁸⁹ The New York judgment was vacated.⁴⁹⁰ Judge Connor's contention that mere performance by the celebrity was a sufficient ground on which his heirs could recover was therefore overruled.⁴⁹¹ The appellate court had construed more narrowly the criteria for determining whether exploitation of name and likeness had occurred.⁴⁹² In stating the rationale behind judgment for the defendant, the court mentioned that the original play produced by Day and Night was distinct from the products endorsed by the Marx Brothers.⁴⁹³ Thus, while the original three actors had advertised items "ranging from Plymouth Automobiles to Smirnoff Vodka,"⁴⁹⁴ the defendant, by using the likenesses of the Marx Brothers for an unrelated project, was free from liability.⁴⁹⁵

In order for the plaintiff's claim to succeed, the court required evidence proving that the use complained of was similar to a prior exploitation.⁴⁹⁶ Judge Newman's holding could be interpreted as leaving the plaintiff without a remedy unless the defendant sued exploited an area the Marx Brothers had promoted, such as Plymouth or Smirnoff.

Judge Newman was not the first to hold that the right to publicity must be subordinated to the public interest, which allows for the production of fictional accounts based upon a particular celebrity's life or work. In *Guglielmi v. Spelling-Goldberg Productions*,⁴⁹⁷ a claim was brought to enjoin a television production concerning the life of Rudolpho Guglielmi, better known by his stage name Rudolph Valentino.

The plaintiff, Valentino's nephew and legal heir, objected to a network program entitled "Legend of Valentino: A Romantic Fiction."⁴⁹⁸ The use of Valentino's name and likeness without prior consent was construed by the plaintiff to be a violation of

489. *Id.* at 323.

490. *Id.*

491. *Id.* at 322.

492. *Id.*

493. *Id.* at 323.

494. *Id.*

495. *Id.*

496. *Id.*

497. 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979).

498. *Id.* at 862, 603 P.2d at 455, 160 Cal. Rptr. at 353.

the right to publicity, which the nephew, as heir to the estate, sought to protect.⁴⁹⁹ Chief Justice Bird, on hearing the complaint, seized upon the "context and nature of the use,"⁵⁰⁰ citing these as the factors which would control the disposition of the case.⁵⁰¹ The defendant admitted that Valentino was the central character in the program, but maintained that the use was related to the actor's own medium and did not promote products which were distinct from the actor as an individual.⁵⁰² The plaintiff claimed that the fictional nature of the work was a serious threat to future publicity rights.⁵⁰³ Chief Justice Bird dismissed this argument, reasoning that the defendant's production was just as likely to inspire curiosity, which would in turn create a market for authorized biographies, as it was to adversely affect future plans for merchandising.⁵⁰⁴ The court felt that fictional dramatization was incapable of endangering later factual accounts involving the legendary Valentino.⁵⁰⁵

The resolution of the case depended on which interest was to be given the greater protection: the creative thought invested by the defendant or the property interest claimed by the plaintiff.⁵⁰⁶ In rendering judgment for the defendant, Chief Justice Bird argued that free speech was not to be compromised by an aggrieved individual's proprietary claim.⁵⁰⁷ "No author should be forced into creating mythological words or characters wholly divorced from reality. The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comments."⁵⁰⁸

Chief Justice Bird was not merely protecting the right of an author to draw upon people and events which may be used as a source of material and inspiration. Her statements outline the important distinction between the creative use of a celebrity for

499. *Id.*

500. *Id.* at 864, 603 P.2d at 457, 160 Cal. Rptr. at 355.

501. *Id.*

502. *Id.*

503. *Id.* at 870, 603 P.2d at 460, 160 Cal. Rptr. at 358.

504. *Id.* at 870, 603 P.2d at 461, 160 Cal. Rptr. at 359.

505. *Id.*

506. *Id.*

507. *Id.* at 869, 603 P.2d at 460, 160 Cal. Rptr. at 358.

508. *Id.*

the purpose of disseminating ideas and the less valued appropriation which is expressed in the merchandising of unrelated products.⁵⁰⁹

This judgment leaves undisturbed cases which involve appropriations committed for the purpose of ancillary exploitation in markets unrelated to the celebrity, or where the information presented is of limited social utility. It was this distinction which precluded Valentino's nephew from claiming the royalties generated by the defendant's production.⁵¹⁰

The court in *Estate of Presley v. Russen*⁵¹¹ was faced with similar competing interests when the heirs of Elvis Presley sought to enjoin the defendant from producing a live show which imitated the late star.⁵¹² The theatrical performance in question was called "The Big El Show" (a tribute to Elvis Presley),⁵¹³ in which a Mr. Larry Seth appeared in the traditional "Elvis" costume, which incorporated a jumpsuit, jewelry and scarves which were handed out to the audience.⁵¹⁴ Songs performed by Seth were those made famous by Presley, and Presley's poses and choreography were imitated.⁵¹⁵ Performances were given throughout the United States and Canada without authority in the form of a contract or license from the estate.⁵¹⁶ As successors, Presley's heirs claimed that their right to publicity was infringed by the Big El Show.⁵¹⁷ Judge Brotman applied the same test as that used by Chief Justice Bird to determine whether the performance served any social utility by providing "a substantial value to society."⁵¹⁸ The production, in spite of its popularity, involved imitation as opposed to creative or biographical interpretation.⁵¹⁹ Audiences watching the performance were at best informed about a singer who shaped the development of the music and entertainment industry.⁵²⁰ Imitation was, in the estima-

509. *Id.* at 874, 603 P.2d at 463, 160 Cal. Rptr. at 361.

510. *Id.* at 875, 603 P.2d at 464, 160 Cal. Rptr. at 362.

511. 513 F. Supp. 1339 (D.N.J. 1981).

512. *Id.* at 1344.

513. *Id.* at 1349.

514. *Id.* at 1348.

515. *Id.*

516. *Id.* at 1349.

517. *Id.* at 1354.

518. *Id.* at 1359.

519. *Id.*

520. *Id.* at 1360.

tion of the court, lacking in creativity and without social merit.⁵²¹ For this reason, judgment was granted for the plaintiff, since the primary function of the defendant's production was to "appropriate the commercial value of the likeness of Elvis Presley."⁵²²

The court also asked whether the right to publicity could be subject to inheritance.⁵²³ The judgment of the New Jersey court found that the heirs to the Presley estate were, by inheritance, entitled to enjoy the benefits achieved by Presley.⁵²⁴ The right to publicity itself had, in previous decisions, been recognized and was, in the court's view, capable of being the subject of a lease or assignment.⁵²⁵ Since the plaintiffs were designated beneficiaries under Presley's will, they had standing to challenge the defendant's appropriation.⁵²⁶ Unfortunately, the action requested an interim, as opposed to a final, injunction regarding the defendant's production.⁵²⁷ In this action, the plaintiff failed to demonstrate injury and neglected to request a permanent injunction which could have resulted in a holding in their favor.⁵²⁸ The case is nevertheless important since it established that publicity rights may become the property of a designated beneficiary under a valid will.⁵²⁹

The litigation brought by those seeking financial advantage from the royalties accruing to the Presley estate was considerable.⁵³⁰ In *Factors Etc., Inc. v. Pro Arts, Inc.*,⁵³¹ the holder of an exclusive license to exploit commercially the name and likeness of Elvis Presley requested an injunction and damages against defendant Pro Arts.⁵³² Factors had obtained its license two days after Presley's death for the sum of \$100,000, and began preparing merchandised items almost immediately.⁵³³ Also seeking to

521. *Id.* at 1359.

522. *Id.* at 1360.

523. *Id.* at 1354.

524. *Id.* at 1361.

525. *Id.* at 1335.

526. *Id.* at 1361.

527. *Id.* at 1344.

528. *Id.* at 1379.

529. *Id.* at 1361.

530. *Id.* at 1339; *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978).

531. *Factors*, 579 F.2d at 215.

532. *Id.* at 216.

533. *Id.* at 217.

benefit from the income that Elvis memorabilia could render, Pro Arts purchased the copyright to a photograph of Presley taken by a journalist.⁵³⁴ Three days after Presley's death, the defendant produced for sale a poster size blowup of the photograph which read "In Memory - 1935-1977."⁵³⁵

On learning of the defendant's activities, Factors requested that the item be removed from the market.⁵³⁶ In support of its refusal to comply with the plaintiff's demand, Pro Arts claimed that the right of publicity was extinguished at Presley's death, or alternatively, that the poster was merely a reminder of an event which could be classified as newsworthy.⁵³⁷ The court rejected the second contention, ruling that the product, being neither creative nor newsworthy, was not entitled to protection under the first amendment.⁵³⁸

In ruling on the case, Judge Ingraham held that the right to publicity, unlike the right of privacy, was capable of surviving the death of a celebrity.⁵³⁹ Factors, as a bona fide licensee, was properly asserting its own contractual right to claim the royalties and entitlement to exploit the name and likeness of Elvis Presley.⁵⁴⁰ This conclusion embraced the theory of unjust enrichment, for a contrary ruling would have provided a gain to those engaged in the unconsented to exploitation of a deceased public figure.⁵⁴¹ Judge Ingraham added: "[A]t the same time, the exclusive right purchased by Factors and the financial benefits accruing to the celebrity's heirs would be rendered virtually worthless."⁵⁴² This interpretation of the aim toward which the law should strive in defining the relationship and concurrent rights of parties such as those in the instant case was not upheld on appeal.⁵⁴³ Although the issue of whether a celebrity must himself exploit publicity rights was, due to Presley's own com-

534. *Id.*

535. *Id.*

536. *Id.*

537. *Id.* at 219.

538. *Id.* at 222.

539. *Id.* at 221.

540. *Id.*

541. *Id.*

542. *Id.*

543. 579 F.2d 215 (2d Cir. 1978), *aff'g* 444 F. Supp. 288 (S.D.N.Y. 1977), *cert. denied*, 440 U.S. 908 (1979).

mercial ventures, not resolved, this requirement further narrowed the publicity doctrine.⁵⁴⁴

If the heirs of a public figure are to be successful in claiming for their own benefit, publicity rights, there must be evidence "that the celebrity 'acted in such a way as to evidence his or her own recognition of the extrinsic commercial value of his or her name or likeness', and manifested that recognition in some overt manner, e.g. making an inter vivos transfer in the rights of the name."⁵⁴⁵

Judge Ingraham's view would provide celebrities with the ability to designate, after death, those individuals to whom financial benefits are to flow. This would accord with the premise upon which private property and the entire area comprising the law of wills and trusts had been established. The right to publicity, having achieved status as a property right, must be subject to alienation by the celebrity who created the interest. Although this provides a benefit to designated beneficiaries at the expense of more commercially enterprising individuals, the law of inheritance sanctions unconditional donations. Just as private individuals are free to decide matters affecting the distribution of their property, those who work in professions which invite public notoriety should be accorded the same opportunity and freedom of decision.

V. ADVERTISING PRACTICE

Turning from judicial sources of relief for the instances of appropriation, the advertising industry in Britain developed standards to guide those wishing to use the name and likeness of a celebrity for promotional purposes. These rules are codified in The British Code of Advertising Practice⁵⁴⁶ [hereafter "British Code"] and The IBA Code of Advertising Standards and Practice⁵⁴⁷ [hereafter "IBA Code"]. The British Code is concerned with non-broadcast advertisements, and applies to promotions

544. *Factors*, 579 F.2d at 216.

545. Rader, *supra* note 1, at 235.

546. THE BRITISH CODE OF ADVERTISING PRACTICE (Cap committee 7th ed. Oct. 1985) [hereinafter "BRITISH CODE"].

547. THE INDEPENDENT BROADCASTING AUTHORITY CODE OF ADVERTISING STANDARDS AND PRACTICE, (IBA July 1986) [hereinafter "IBA CODE"].

appearing in “newspapers, magazines, printed publications, posters, cinema and video-cassette commercials, viewdata services, as well as leaflets and brochures wherever they appear.”⁵⁴⁸ In an attempt to go beyond the standard that previously required advertisements to be “legal, decent, honest and truthful,”⁵⁴⁹ the British Code places particular emphasis on the extent to which an individual may be exploited in an advertisement.⁵⁵⁰ Section 17.1 states that “advertisements should not portray or refer to any living persons, in whatever form or by whatever means, unless their express prior permission has been obtained.”⁵⁵¹ This protection, although apparently comprehensive, is diminished by an exception which allows exploitation if the product is not “inconsistent with the celebrity’s position,”⁵⁵² and does not interfere with the individual’s “right to enjoy a reasonable degree of privacy.”⁵⁵³ Ostensibly, this provides recognition of a right of privacy by requiring that this right be free from commercial invasion.⁵⁵⁴ But a celebrity whose name and likeness was used in a marketing strategy consistent with his public character may be without a remedy.⁵⁵⁵ This is best illustrated by advertisements which utilize a double entendre for promotion. For example, an alcohol distributor published a headline which read “vodka without Russchian is like Lenin without McCartney.”⁵⁵⁶ It is reasonable to assume from the appearance of the advertisement that some members of the public would construe this as an endorsement.

Although David Frost was able to stop the owners of a new hotel from using his photograph in conjunction with a caption which read “no matter who you are we can make you feel at home,”⁵⁵⁷ it was only due to the threat of a libel action that the proprietors agreed to withdraw the advertisement.⁵⁵⁸ Even this type of claim will not always be effective in preventing unautho-

548. BRITISH CODE, *supra* note 546, at 19.

549. *Id.* at 8.

550. *Id.* at 31.

551. *Id.* at 31, §17.1.

552. *Id.* at 31, §17.2.

553. *Id.*

554. *Id.* at 31.

555. Frazer, *supra* note 2, at 282 n.6.

556. *Id.* at 282.

557. R. WACKS, THE PROTECTION OF PRIVACY 167 (1980).

558. *Id.*

alized use, for the plaintiff must prove that the advertisement contains a defamatory implication in order to sustain a libel action.⁵⁵⁹ Thus, a public figure's name, when isolated from the context of an overt or defamatory endorsement, may still be exploited by advertisers.⁵⁶⁰

Additionally, the requirement that "living" persons must first give their express consent would make available to advertisers the names and likenesses of celebrities now deceased.⁵⁶¹ The British Code does not state whether permission from heirs is required for exploitation of a public figure,⁵⁶² and as such is not useful in an attempt to prohibit appropriation of public figures no longer alive.⁵⁶³

The IBA Code is concerned exclusively with advertisements broadcasted on television and radio.⁵⁶⁴ This code aspires to a higher quality of advertising because it is thought that those listening to radio or television programs in the home or car are a captive audience.⁵⁶⁵ Provision 13 of the IBA Code contains the limits within which celebrities and all other individuals may be exploited for promotional purposes.⁵⁶⁶ This provision reads: "Individual living persons should not normally be portrayed or referred to in an advertisement without their permission."⁵⁶⁷ The IBA Code provisions are basically a set of guiding rules created for the advertising industry.⁵⁶⁸ But the drafting is too weak to provide any significant protection, whether an individual is a celebrity or not, since the code is not legally enforceable.⁵⁶⁹ The use of the word "normally" indicates that there might be exceptions which would justify unauthorized use of name or likeness.⁵⁷⁰ It is still possible for one who provides an unusual reason which would justify appropriation to abuse a celebrity's

559. *Id.* at 167-68.

560. *Id.* at 168.

561. BRITISH CODE, *supra* note 546, at 31, §17.1.

562. *Id.*

563. *Id.*

564. IBA CODE, *supra* note 547, at 3.

565. *Id.*

566. *Id.* at 4.

567. *Id.*

568. *Id.* at 3.

569. *Id.* at 2.

570. *Id.* at 4.

right to publicity.⁵⁷¹ Perhaps the most helpful provision in the IBA Code is the rule which requires all advertisers broadcasting on television and radio to comply with both statutory and common law.⁵⁷² The IBA Code is enforced through self-regulation within the advertising industry, but stronger legislation is required to safeguard the individual.

The British and IBA Codes, while providing guidelines and theoretical principles, are not enforceable and do not fill the gap created by the British courts' dilatory action in providing judicial remedies for appropriation. There is a great need for reform in the common law. Legislation should be provided to control the taking without compensation of a celebrity's right to publicity. In the absence of change, abuses of this property right in the form of lost income, merchandising opportunities, and personal dignity will flourish.

VI. CONCLUSION - FUTURE LEGISLATION

The American common law has developed to accommodate a right of privacy and to ensure that the right to publicity constitutes a viable source of income for celebrities. The ability of famous individuals to capitalize on the endorsement of products can provide large sums of revenue. Not only is this avenue for realizing income important to a public figure, it may also serve as the only means by which the heirs of a mismanaged celebrity can benefit.

English law regarding the appropriation of name and likeness rights lags behind the relatively recent strides made in America. Due to the fact that actions for passing off still require a common field of activity between the plaintiff and defendant, this tort is of limited value to a celebrity whose name or likeness has been the subject of appropriation. Additionally, English courts are reluctant to interfere with free competition, which frequently results in the judicial giveaway of merchandising opportunities to those engaged in the exploitation of a public figure's personality. But neither country has successfully developed a coherent system which can afford adequate protection. The

571. *Id.*

572. *Id.* at 3, prov. 2.

characterization of publicity as a property right rather than a transient personal interest is important. More vital still is the need to provide a means by which this property, like any other, may descend to chosen beneficiaries. In the world of constantly advancing technology and swifter modes of communication, those who wish to appropriate names and likenesses are furnished with a variety of methods to do so. It is from the courts that celebrities should be able to obtain redress. The law should provide safeguards which will enable individuals to benefit from their own labor. Future legislation may provide protection for celebrities by implementing the proposals contained in the following model.

- (1) Legislative recognition of a statutory right of publicity, i.e. the right vested in each [celebrity: one with "fame, renown, wide recognition"]⁵⁷³ of the sole right to 'exploit' commercially his own name and likeness, or to refrain therefrom.
- (2) No person shall take for commercial purposes the name or likeness of a celebrity without first having obtained a license, from that celebrity or his agent.
- (3) "Commercial purposes" shall include, but not be limited to, (a) endorsements; (b) merchandized items; (c) creative or fictional works not containing a newsworthy character; (d) any product offered for sale to the public, utilizing name or likeness.
- (4) A celebrity will be entitled to exercise his right to publicity at any time and will not be precluded from entering into agreements with a party contracting to exploit the same.
- (5) In the event that the celebrity is no longer living, the legatees of his estate will be vested with the right to negotiate publicity rights and licenses on their own behalf.
- (6) The fee for licensing agreements will be calculated with reference to the nature and extent of the use made.
- (7) In the event that name or likeness rights are exploited in the absence of license, the party owning the right to publicity will be entitled to enforce a license effective immediately upon the dis-

573. WEBSTER'S NEW WORLD DICTIONARY 235. (World Publishing Co. 1966).

covery of the use, and damages will be added to the fee designated.

(8) Publicity rights will be the property of a celebrity or his heirs for a term not exceeding the life of the celebrity plus fifty years, and, upon expiration, his name and reputation will be within the public domain.

(9) A private organization will be established to provide enforcement and redress to those owning the right of publicity, and will include affiliated bodies to provide reciprocal protection on an international basis.

The establishment of a private organization to provide a system of registration and licensing for publicity rights is advisable. Appropriations which occur on an international basis must be traced by a body similar in structure and function to a Performing Rights Society.⁵⁷⁴ But the scope of any such future organization must be enlarged to include affiliates in countries where publicity rights are employed for advertising purposes. The use of name and likeness would be monitored within each specified geographical area, and enforced by contractual agreement. Associated bodies are therefore necessary to provide protection since the law has not kept pace with rapidly developing media technology, which in its most advanced form is represented by satellite broadcasting throughout the world. In the absence of clear legislative and judicial rules, and in the presence of the ineffective self-regulating measures taken by the advertising industry, a society charged with the aim of enforcing protection of name and likeness rights may be the only effective means by which protection against appropriation can occur.

574. The Performing Rights Society, an organization composed of writers and publishers of music, the function of which is to enforce copyright throughout many European countries.