

## THE RIGHT OF PUBLICITY: RESURGENCE OF LEGAL FORMALISM AND JUDICIAL DISREGARD OF POLICY ISSUES



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The right of publicity, so called, is a relatively recent development in the common law. It protects the commercial value in a person's name, likeness, and (to some degree) performance from unauthorized exploitation. Of particular use to celebrities who capitalize on their identities through advertising, endorsements, or merchandising, it gives them a remedy, either damages or an injunction, against anyone who uses their names or likenesses without permission, subject to a First Amendment privilege.

The term "right of publicity" was coined in 1953 by Judge Jerome Frank in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,<sup>1</sup> but the law had afforded protection to publicity values under various doctrinal mantels since before the turn of the century. The historical roots

of the right of publicity go back to the right of privacy and the famous 1890 Harvard Law Review article by Warren and Brandeis that conceived it,<sup>2</sup> as well as to the law of tradenames and unfair competition.

Since *Haelan*, commentators have written at length about the right of publicity and its proper scope. Prosser wrote of it as a branch of the right of privacy;<sup>3</sup> Nimmer advocated treatment as a property right;<sup>4</sup> and others have written about it from nearly every perspective, from its application to styles of performance to its conflict with the freedom of the press.<sup>5</sup>

Courts in many states have now recognized the right of publicity, but its contours are not yet fixed. The most intense current controversy concerns descendibility: whether an heir or assignee can main-

<sup>1</sup>202 F.2d 866 (2d Cir. 1953), cert. den. 346 U.S. 816.

<sup>2</sup>Warren & Brandeis, *The Right to Privacy*, 4 Harv.L.Rev. 193 (1890).

<sup>3</sup>Prosser, *Privacy*, 40 Calif. L. Rev. 383 (1960).

<sup>4</sup>Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203 (1954).

<sup>5</sup>E.g., note, *Intellectual Property — Performer's Style — A Quest for Ascertainment, Recognition, and Protection*, 52 Den.L.J. 561 (1975); note, *First Amendment Theory Applied to the Right of Publicity*, 19 B.C.L.Rev. 277 (1978); Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 Yale L.J. 1577 (1979).

tain a publicity action against an unauthorized user of the name or likeness of a deceased person. Courts are divided on the issue, and commentators are having a field day.

The right of publicity was born and developed in a period of American jurisprudence characterized by growing positivism and realism; increasing recognition by scholars and judges that judges do not passively discover the law from a fixed set of broad, abstract, principles, but actively make and shape the law with their decisions; and a corresponding waning of faith in the mechanical application of legal logic and the purity of legal concepts and categories. Indeed, Judge Frank, who gave the right of publicity its name, was a leading exponent of legal realism who asserted that the "certainty" of legal reasoning was a mere illusion that served our unconscious need for security and authority, and that legal rules and principles were largely rationalizations for conclusions otherwise reached.<sup>6</sup> Some recent commentators have argued that traditional legal concepts are now impotent and positivism is now the norm.<sup>7</sup>

In this paper I will examine the historical development of the right of publicity, with particular focus on the descendibility issue. The analysis will proceed on both the level of the relevant doctrines and the level of the conceptual structure that frames these doctrines. My contention is that the substantive development and current scope of the right have been shaped more by the formal legal concepts judges have used in thinking about it than by meaningful judicial analysis of and response to the policy considerations implicated. To the extent that this is true, recent claims that conceptualism is dead and that all law is positivized are overstated and need to be reevaluated.

#### Historical Foundations

In the famous 1890 article "The Right to Privacy,"<sup>8</sup> Samuel Warren and Louis Brandeis argued for the recognition of a

broad "right to be left alone." They urged that the common law's age-old principle of protecting person and property be extended to protect one's feelings with respect to the privacy of his name, portrait, and facts about his personal life.

They contended that the common law had long been groping toward protection of these interests with such doctrines as libel, which prohibited the publication of false defamatory statements that tended to harm one's reputation; common law copyright, which gave authors the exclusive right to publish their works; literary property in letters, which gave senders some rights in the contents of their letters notwithstanding the recipients' rights in the physical objects; and implied contracts and trust relationships, which sometimes served to restrain photographers from publishing photographs against the wishes of the subjects, and employees from divulging trade secrets of their employers.

Though these doctrines evinced the law's concern with privacy, Warren and Brandeis argued, they were inadequate to deal with the whole problem. Libel law looked to the damage done to the plaintiff's reputation, "his external relations to the community,"<sup>9</sup> rather than to his own feelings. Common law copyright in unpublished works protected merely "the right to take the profits arising from publication" and not "the peace of mind or the relief afforded by the ability to prevent any publication at all."<sup>10</sup> Senders' property in letters could prevent publication of the letters themselves but not — without torturing the concept<sup>11</sup> — descriptions of their contents. And the method of implying contracts, or terms therein, or trust relationships could not protect against harms by strangers.

The trouble with all these notions was that they were concerned with earthbound, material values. Property conceptions were simply too narrow effectively to protect the fundamentally spiritual and emotional interests with which Warren and Brandeis were concerned:

<sup>6</sup>J. Frank, *Law and the Modern Mind* (1930).

<sup>7</sup>See notes 134-137, *infra*.

<sup>8</sup>4 Harv. L. Rev. 193.

<sup>9</sup>*Id.* at 200.

<sup>11</sup>For an example of such contortion, see *Prince Albert v. Strange*, 41 Eng. Rep. 1171 (Ch. 1841).

We must therefore conclude that the rights, so protected, whatever their exact nature, are not rights arising from contract or from special trust, but are rights against the world; and . . . the principle which has been applied to protect these rights *is in reality not the principle of private property*, unless that word be used in an extended and unusual sense. The principle which protects personal writings and any other productions of the intellect or of the emotions, is the *right to privacy*, and the law has no new principle to formulate when it extends this protection to the personal appearance, sayings, acts, and to personal relations, domestic or otherwise.<sup>12</sup>

The underlying principle had always been present in the common law. Courts needed only to apply that principle free of the inadequate notions of property and contract. Legal protection of emotional interests was no great leap, because for Warren and Brandeis, the history of the common law had been one of increasing recognition of "man's spiritual nature."<sup>13</sup> This gradual process had expanded protection from physical harm (battery) to protection from fear of that harm (assault), and had spawned the law of nuisance to protect man against "offensive noises and odors," etc.,<sup>14</sup> and the law of alienation of affections to protect his family relations.

This development of the law was inevitable. The intense intellectual and emotional life, and the heightening of sensations which came with the advance of civilization, made it clear to men that only part of the pain, pleasure, and profit of life lay in physical things. Thoughts, emotions, and sensations demanded legal recognition, and the beautiful capacity for growth which characterizes the common law enabled the judges to afford the requisite protection, without the interposition of the legislature.<sup>15</sup>

The authors went on to outline the scope of their proposed right. They reasoned that it should not cover publication of matters of public interest,<sup>16</sup> that it should have only limited application to public figures, who "have renounced the right to live their lives screened from public observation,"<sup>17</sup> and that it should cease "upon the publication of the facts by the individual, or with his consent."<sup>18</sup> Damages should be awarded for "injury of feelings."<sup>19</sup>

Thus Warren and Brandeis were proposing an alternative conception of interests in the elements of personal identity. Courts had been using traditional property and contract conceptions that dealt with commercial values, markets, and profits. These amounted to a right not to be exploited, not to be robbed. Wrongs to these rights were understood as stealing, appropriation, unjust enrichment. The right of privacy, on the other hand, was a personal right; its province was the emotions, spirit, peace of mind. A wrong to it was conceived as a violation, an invasion, an intrusion.

Courts in fact took up the personal right conception of privacy. In 1902 in *Roberson v. Rochester Folding Box Co.*,<sup>20</sup> the New York Court of Appeals refused to recognize the right at common law, leaving it to the legislature to protect, and the legislature soon did protect it, with a sweeping privacy statute.<sup>21</sup> Then in 1905 the Supreme Court of Georgia in *Pavesich v. New England Life Insurance Co.*<sup>22</sup> found the right of privacy inherent in natural law, and many courts have since developed a common law right of privacy.

*Roberson* and *Pavesich*, now the landmark common law privacy decisions, illustrate how the interests in one's identity can straddle the realms of the spirit and the market. In *Roberson*, a young woman sued for invasion of her privacy over the use of her photograph on advertisements for Franklin Mills Flour under the caption,

<sup>12</sup>4 Harv. L. Rev. at 213 (emphasis added).

<sup>13</sup>*Id.* at 193.

<sup>14</sup>*Id.* at 194.

<sup>15</sup>*Id.* at 195.

<sup>16</sup>*Id.* at 214.

<sup>17</sup>*Id.* at 215.

<sup>18</sup>*Id.* at 218.

<sup>19</sup>*Id.* at 219.

<sup>20</sup>171 N.Y. 538, 64 N.E. 442 (1902).

<sup>21</sup>New York Civil Rights Law, Sections 50, 51.

<sup>22</sup>122 Ga. 190, 50 S.E. 68 (1905).

"The Flour of the Family." She alleged that the defendant had "conspicuously posted and displayed in stores, warehouses, saloons, and other public places" 25,000 copies of the ad.<sup>23</sup> Obviously the defendant had seen value in the plaintiff's likeness and exploited it, but her claim was for injury to her feelings: she complained that the poster had caused her "great distress and suffering [and] severe nervous shock."<sup>24</sup> The plaintiff in *Pavesich* complained of emotional harm from the unauthorized use of his photograph in defendant's advertising as the happy, successful, and secure owner of a life insurance policy, juxtaposed to an "ill-dressed and sickly" man who had none.<sup>25</sup> "Plaintiff is an artist by profession and the publication is peculiarly offensive to him."<sup>26</sup> He was awarded damages. Thus privacy, in protecting emotional interest, could function to redress commercial exploitation.

#### Identity as a Personal Right

Though Warren and Brandeis made much of the difference between privacy's concern with the plaintiff's own feelings and libel's concern with his relations with others, the two doctrines are closely linked: they really amount to variations on the personal right theme, each with its own idiosyncratic features. Especially in the early privacy cases, libel tended to buttress and complement privacy claims. In *Roberson*, where the right of privacy was held not to exist at common law, the advertisement was also found not libellous. *Pavesich*, conversely, granted relief on both privacy and libel grounds.

The alliance proved durable. In *Munden v. Harris*<sup>27</sup> the defendant used without permission a photograph of five-year-old Onel Munden over a caption reading:

Papa is going to buy mama an Elgin watch for a present, and some one (I mustn't tell who) is going to buy my big sister a diamond ring. So don't you

think you ought to buy me something? The payments are so easy, you'll never miss the money if you get it of Harris-Goar Co. . . .<sup>28</sup>

Plaintiff sued in privacy and libel. Defendant demurred, and the trial court sustained the demurrer. The Missouri Court of Appeals, however, held that plaintiff had stated a cause of action for invasion of privacy. The privacy holding followed *Pavesich* and rejected *Roberson*. The court also held the advertisement libellous because it "was necessarily bound to cause [plaintiff] to undergo the vexation and humiliation of ridicule," given the "teasing propensities of his fellows."<sup>29</sup>

In the early days of the privacy cause of action, plaintiffs sometimes used libel instead of a privacy claim. In *Foster-Millburn Co. v. Chinn*,<sup>30</sup> J. P. Chinn sued the publishers of Doan's Directory of patent medicines, circulation 8,000,000, for publishing his picture next to a testimonial letter praising Doan's Kidney Pills which he never wrote. Chinn asserted that because it was well known that Doan's routinely paid for such endorsements, he was libelled by being made to appear as having sold his signature, and put on evidence that he had been laughed at by his friends. The Kentucky Court of Appeals found error in the libel judgment for Chinn, but held that defendant had violated his right of privacy, thereby relieving Chinn of the burden of proving special damages.

In *Lahr v. Adell Chemical Co.*,<sup>31</sup> however, a libel cause of action lay where one in privacy did not. Cowardly Lion Bert Lahr sued under the New York privacy statute and in libel for a Lestoil commercial that used an imitation of his voice. Though the privacy action failed because the court would not construe the statute's "name, portrait, or picture" to cover vocal imitations, it held that the possibility that audiences would infer from the commercial that Lahr had "stooped to perform below his class" was actionable as libel.<sup>32</sup>

<sup>23</sup>64 N.E. 442.

<sup>24</sup>*Id.*

<sup>25</sup>50 S.E. at 68-69.

<sup>26</sup>*Id.* at 69.

<sup>27</sup>153 Mo.App. 652, 134 S.W. 1076 (1911).

<sup>28</sup>134 S.W. at 1076.

<sup>29</sup>134 S.W. at 1079-80.

<sup>30</sup>134 Ky. 424, 120 S.W. 364 (1909).

<sup>31</sup>300 F.2d 256 (1st Cir. 1962).

<sup>32</sup>*Id.* at 258.



One of the traditional features of the personal right conception is that death extinguishes all of one's personal causes of action. Libel claims, personal injury claims, etc., all die with the person injured. This has meant that heirs cannot use privacy to protect their interests in the identity of a deceased person. In *Schuyler v. Curtis*,<sup>33</sup> relatives of the late Mary Hamilton Schuyler, socially prominent philanthropist and granddaughter of Alexander Hamilton, sued to enjoin the erection of a bust of Mrs. Schuyler for display near one of Susan B. Anthony in an 1893 exposition. Defendants had not sought the relatives' permission to erect the statue. Plaintiffs complained that since Mrs. Schuyler had eschewed publicity and had "not sympathized"<sup>34</sup> with Susan B. Anthony's feminist views, display of the statue would violate Mrs. Schuyler's right of privacy, which, they asserted, "descend[ed] unimpaired to her immediate relatives."<sup>35</sup> Assuming without deciding that a right of privacy existed — this case preceded *Roberson* — Judge Peckham for the New York Court of Appeals reversed a judgment for plaintiff:

Whatever the rights of a relative may be, they are not, in such case as this, rights which once belonged to the deceased, and which a relative can enforce in her behalf and in a mere representative capacity; as, for instance, an executor or administrator, in regard to the assets of a deceased. It is not a question of what right of privacy Mrs. Schuyler had in her lifetime. The plaintiff does not represent that right. Whatever right of privacy Mrs. Schuyler had died with her. Death deprives us of all rights, in the legal sense of that term; and when Mrs. Schuyler died, her own individual right of privacy, whatever it may have been, expired at the same time.<sup>36</sup>

Judge Gray, dissenting, argued from the other conception. The right of privacy

should be a property right which survives its owner:

The theory of the case, which calls for equitable relief, is not that of a mere protection to wounded feelings, but the protection of a right which those who represent the deceased have to her name and memory, as a family heritage, and which had not become the public property.<sup>37</sup>

With respect to claims based on injured feelings, the Peckham personal right conception has carried the day. When the widow of Jesse James, Jr., sued for invasion of her right of privacy because of a film about her late husband, she was denied relief because she was not depicted in it:<sup>38</sup>

The authorities appear to be uniform that the right of privacy cannot be asserted by anyone other than him whose privacy is invaded. The gravamen of the tort is ordinarily the unwarranted publication by defendant of intimate details of *plaintiff's* private life.<sup>39</sup>

Plaintiff also pleaded a property claim, which the California District Court of Appeals ignored in its opinion. Similarly, when Mrs. Al Capone sued the producers of "The Untouchables" for unauthorized depiction of her late husband, her privacy claim was dismissed because Capone was dead, and her property claim was dismissed as parasitic to the one in privacy.<sup>40</sup>

In their initial formulation of the right of privacy, Warren and Brandeis viewed public figures as having "renounced the right to live their lives screened from public observation"<sup>41</sup> and thus meriting less privacy protection. This waiver notion functions somewhat like a reasonable-plaintiff standard in the area of intentional infliction of emotional harm: it amounts to saying that we would not find credible the claim that someone who has voluntarily sought renown suffered emotional harm from the nonlibellous publication of his name and likeness. He may have suf-

<sup>33</sup>147 N.Y. 434, 42 N.E. 22 (1895).

<sup>34</sup>42 N.E. at 25.

<sup>35</sup>*Id.*

<sup>36</sup>*Id.*

<sup>37</sup>*Id.* at 28 (Gray, J., dissenting).

<sup>38</sup>*James v. Screen Gems*, 344 P.2d 799 (1959).

<sup>39</sup>*Id.* at 801 (citations omitted and emphasis added).

<sup>40</sup>*Maritote v. Desilu Productions*, 345 F.2d 418 (7th Cir. 1965), *cert. den.* 382 U.S. 883.

<sup>41</sup>4 Harv.L.Rev. at 215.

ferred some kind of harm, but not to his emotions. Personal rights protect the personality — body, reputation, emotions. If a plaintiff cannot credibly allege harm to one of these, then a personal right is no use to him. This aspect of the personal right conception has had a powerful impact on privacy protection.

In *O'Brien v. Pabst Sales Co.*,<sup>42</sup> a well-known college football player who sued for the unconsented use of his photograph on defendant's promotional calendar was held to have waived his right of privacy. Since the use was also held nonlibellous, the plaintiff had nothing emotional to complain of; if he had any claim, it lay in some property notion. The majority refused to grant relief on any unpleaded quantum meruit claim,<sup>43</sup> and Judge Holmes in a famous dissent argued for relief on property grounds notwithstanding the plaintiff's reliance on a privacy theory.<sup>44</sup>

Judicial construction has worked to limit even statutory rights of privacy in the same way. In *Gautier v. Pro-Football*,<sup>45</sup> an animal trainer agreed to perform before the stadium audience during half-time of a professional football game. He sued under the New York privacy statute for damages when his performance was broadcast on television without his consent. The court dismissed his complaint, holding that the privacy statute "provided primarily for injury to the person, not to his property or business.

The recovery is grounded on the mental strain and distress, on the humiliation, on the disturbance of the peace of mind suffered by the individual affected . . . Section 51 of the Civil Rights Law was not enacted to fill gaps in our copyright statute, or to supplement causes of action based on contracts express or implied or to extend the law relating to unfair competition or to the appropriation of another's business or enterprise.<sup>46</sup>

Section 51 states that plaintiff "may sue

and recover damages for any injuries sustained by reason of" the unconsented use.<sup>47</sup> Like *O'Brien*, *Gautier* specifically did not reach the unpleaded property claim.<sup>48</sup> And like the *Capone* case, it held that property damages might be recoverable in a privacy action if parasitic to a feelings-based wrong.

It may be helpful to schematize the relationship that emerges from these cases. There are uses of the elements of A's identity which hurt A's feelings, and there are uses of A's identity which enrich B. Privacy claims work only where A's feelings are hurt. In other cases some variant of the property conception is required. In the range in which the two fields overlap are situations like those in *Pavesich*, *Munden*, and *Chinn*. Outside the pain field are cases like *O'Brien*, *Gautier*, *Maritote*, and *James*, where the plaintiffs, either by admission of judicial construction, are not complaining of emotional harm.

#### Identity as Property

The property conception of interests in names and likenesses, in response to which Brandeis and Warren proposed the right of privacy, and which *Haelan* crystallized in the right of publicity, has had a long history in the law of tradenames and unfair competition and in a wide variety of contractual disputes.

Plaintiffs have long used the law of tradenames and unfair competition to protect publicity values against exploitation by others. Before 1918, two requirements of the unfair competition cause of action, however, posed difficulties for these plaintiffs: to succeed, they had to prove that (1) the defendant was an actual competitor of the plaintiff (the competition requirement) and (2) the defendant intended to mislead the public into believing that the plaintiff was connected with the defendant's project or product (the palming-off requirement).

In *Edison v. Edison Polyform Manufacturing Co.*,<sup>49</sup> Thomas Edison sued to

<sup>42</sup>124 F.2d 167 (5th Cir. 1941).

<sup>43</sup>*Id.* at 170.

<sup>44</sup>*Id.*

<sup>45</sup>378 A.D. 31, 106 N.Y.S.2d 553 (1st Dep't

<sup>46</sup>106 N.Y.S.2d at 560.

<sup>47</sup>New York Civil Rights Law Section 51.

<sup>48</sup>106 N.Y.S.2d at 560.

<sup>49</sup>73 N.J. Eq. 136, 67 Atl. 392 (1907).

restrain the defendant from using his name and likeness on an over-the-counter pain-killer. Edison had in fact invented the formula for the medicine and licensed it to defendant's assignor. The original license did not mention the use of Edison's name or picture. Defendant's product was labelled Edison's Polyform and bore a picture of Edison and the following statement:

I certify that this preparation is compounded according to the formula devised and used by myself. Thos. A. Edison.<sup>50</sup>

The court held that fair trade law did not apply because Edison, an inventor, was not a competitor of the patent medicine manufacturer.<sup>51</sup>

In *Brown Chemical Co. v. Meyer*,<sup>52</sup> the manufacturer of Brown's Iron Bitters sued the manufacturer of Brown's Iron tonic for unfair competition. Defendant was a firm one of whose members was named Brown. Though the two products were in competition, plaintiff's cause failed because

A man's name is his property, and he has the same right to its use and enjoyment as he has to that of any other species of property. If such use be a reasonable, honest, and fair exercise of such right, he is no more liable for the incidental damages he may do a rival in trade than he would be for injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon his own land. These and similar instances are *damnum absque injuria*.<sup>53</sup>

Defendant was found not to be palming off his product as plaintiff's; indeed, defendant's advertising strategy had been to point out the differences between the two. Therefore the use was "reasonable, hon-

est, and fair," and plaintiff had no legal remedy.

In 1918, the Supreme Court extended the formal reach of the unfair competition cause of action in *International News Service v. Associated Press*,<sup>54</sup> holding that palming off was not required where defendant misappropriated plaintiff's property. The court defined a property right as "any civil right of a pecuniary nature."<sup>55</sup> After this decision a plaintiff could establish a cause of action for unfair competition by alleging either violation of a property right or intent to mislead the public.<sup>56</sup> Where he could establish a protectable property right, he had to show an intent to mislead the public (or, in later cases, a likelihood of public confusion).<sup>57</sup>

The law of unfair competition was thus expanding to subsume a broader class of injuries. This expansion was achieved by shifting the focus of the doctrine from the culpability of defendant's intent to the nature of the interest plaintiff was seeking to protect. To a large extent, the unfair competition question collapses into the question, "What will courts protect as property?"

*Feldman v. Amos and Andy*<sup>58</sup> illustrates the effect of the *International News* definition of property on the protection of names: Feldman, for four years a marketer of "Amos 'n' Andy" workshirts, attempted to register "Amos 'n' Andy" as a trademark. Charles J. Correll and Freeman Gosden, "Amos and Andy" of radio fame, opposed the registration, pursuant to section 6 of the trademark statute,<sup>59</sup> which provided for opposition by "any person who believes he would be damaged by the registration." They claimed that "Amos and Andy" was the name of their firm, a partnership formed by oral agreement. They introduced evidence to show they had been using the name "Amos and

<sup>50</sup>67 Atl. at 392.

<sup>51</sup>*Id.* at 393.

<sup>52</sup>139 U.S. 540 (1891).

<sup>53</sup>*Id.* at 544.

<sup>54</sup>248 U.S. 215 (1918).

<sup>55</sup>*Id.* at 236.

<sup>56</sup>See, e.g., *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 A.D. 459, 7 N.Y.S.2d 145 (1st Dep't 1938); *infra*, note 61; *Metropolitan Opera Association v. Wagner-Nichols*, 199 Misc. 786, 101 N.Y.S.2d 453 (N.Y. Co. 1050), *infra*, note 63; *Ettore v. Philco Television Broadcasting Co.*, 229 F.2d 481 (3d Cir. 1956), *cert. den.* 351 U.S. 926 (1956), *infra*, note 77.

<sup>57</sup>See, e.g., *Miller v. Universal Pictures*, 11 A.D.2d 47, 201 N.Y.S.2d 632 (1st Dep't 1960), *infra*, note 73; and *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962), *supra*, note 31.

<sup>58</sup>67 F.2d 746 (C.C.P.A. 1934).

<sup>59</sup>15 U.S.C.A. Sections 65-66, 425



Andy" for six years on engraved stationery, the door of their office in Chicago, phonograph albums, and in correspondence, booking agreements, and advertisements. Section 5 of the trademark statute prohibited the registration of "an individual, firm, corporation, or association" name not expressed in a "distinctive manner." Feldman argued that (1) "Amos and Andy" was not the name of a firm but a mere advertisement of dramatic performances, (2) his use of elision in "Amos 'n' Andy" was "distinctive," and (3) his product was not similar to any sold by the opposers and thus registration could not cause them damage.

Associate Judge Bland found that "Amos and Andy" was a firm name and that applicant's "Amos 'n' Andy" was not "distinctive." He quoted the passage from *Brown Chemical* that "a man's name is his own property" and said that opposers need not prove damage, because damage would be inferred from the applicant's invasion of that property.<sup>60</sup> Bland used the *Brown Chemical* quotation to support the protection of a name from registration as a trademark without a showing of damage — presumably likelihood of public confusion, or palming off — despite the fact that *Brown Chemical* stood for the proposition that names were not protectable absent palming off.

The *International News* property-as-value notion was expressly used to protect names in *Madison Square Garden Corp. v. Universal Pictures Co.*,<sup>61</sup> which enjoined the defendant from distributing a film that used the name of Madison Square Garden and the Rangers hockey team owned by it. There the plaintiff was held to have a property right in its name and reputation because it "had built up a valuable business licensing the use of genuine photographs taken in the Garden in feature moving pictures, and from that business had derived substantial revenue."<sup>62</sup>

In *Metropolitan Opera Association v.*

*Wagner-Nichols Recorder Corp.*,<sup>63</sup> the opera company brought an unfair competition action against a firm that was recording its weekly radio broadcasts and selling phonograph records of them. Plaintiff had a recording contract with Columbia Records. The court held that neither actual competition between plaintiff and defendant nor palming off need be alleged to state a cause of action for unfair competition. Equity would protect plaintiff's "property rights" from any form of commercial immorality.<sup>64</sup>

The law of contracts has figured large in the cases involving publicity values. The contracts are typically exploitation, endorsement, or broadcast agreements. Disputes in these cases fall generally into two categories: (1) disputes between the parties to a contract over its scope and interpretation, which raise the question, "What *did* A grant to B?" and (2) disputes between a party to a contract and an outsider in which the grantee of certain contractual rights complains of harm to those rights by the outsider, which raise the question, "What *could* A grant to B?" Though contract nominally involves the voluntary exchange of in personam obligations, in rem property questions suffuse the contractual discussions. Here, as in unfair competition, much of the inquiry reduces to, "What is property?"

Cases involving disputes between the parties to an exploitation contract illustrate a rather subtle way in which background property notions inform, and sometimes determine, outcomes of contract cases. Adjudication in these cases means interpreting the scope of contractual grants where the contract is silent or ambiguous. Exactly what rights and privileges did A grant to B? B did X. Was X within A's grant? The answer to this question in the cases seems to turn on whether the right question in the cases seems to turn on whether the right to do X is a property right. What emerges is an implicit rule of construction: if X is A's prop-

<sup>60</sup>68 F.2d at 748.

<sup>61</sup>255 A.D. 459, 7 N.Y.S.2d 845 (1st Dep't 1938).

<sup>62</sup>7 N.Y.S.2d at 850.

<sup>63</sup>199 Misc. 786, 101 N.Y.S.2d 483 (N.Y.Co.

1950), *aff'd*, 279 A.D. 632, 107 N.Y.S.2d 795 (1st Dep't).

<sup>64</sup>101 N.Y.S.2d at 492.



erty, then B only gets it if A expressly grants it to him in the contract. But if X is not property, then there need be no express grant: in fact, A may have to expressly reserve X to protect it. A few cases should help make this clear.

In *Pollard v. Photographic Co.*,<sup>65</sup> a woman sought to restrain a photographer from selling copies of a photograph of her which she had hired him to take. The question was whether the defendant had an implied obligation not to make and sell additional copies of the photograph. North, J., granted the injunction:

The customer who sits for the negative thus puts the power of reproducing the object in the hands of the photographer; and in my opinion the photographer who uses the negative to produce copies for his own use, without authority, is abusing the power confidentially placed in his hands merely for the purpose of supplying the customer; and further, I hold that the bargain between the customer and the photographer includes, by implication, an agreement that the prints taken from the negative are to be appropriated to the use of the customer only.<sup>66</sup>

In justifying this holding, he invoked the copyright law of the day, which provided that copyright in a photograph made for hire remained with the customer unless expressly granted in writing to the photographer. If the plaintiff had registered her copyright, equity would have restrained the defendant on that ground. Instead, North implied the obligation:

But, although the protection against the world in general conferred by the act cannot be enforced until after registration, this does not deprive the plaintiffs of their common-law right of action against the defendants for his breach of contract and breach of faith.<sup>67</sup>

The potential for the property protection of copyright seemed to determine the question.

In *Miller v. Universal Pictures Co.*,<sup>68</sup>

plaintiff, widow and executrix of famous bandleader Glenn Miller, had sold to Universal the right to make a film based on Miller's life. The contract gave Universal the right to portray Miller and his family and to "use or simulate the style . . . of Glenn Miller and/or his orchestra" in the film and in all "media of advertising and publicity including, but not limited to, commercial tie-ups."<sup>69</sup> Plaintiff agreed to provide Miller's arrangements, orchestrations, and compositions for use in the making of the film. The rights granted to defendant in the contract were to be exercised "only in connection with and for the purpose of advertising and exploitation"<sup>70</sup> of the film. The contract made no specific reference to the sale of phonograph records made from the sound track.

RCA had the exclusive phonograph record rights to the Glenn Miller orchestra recordings. Aware of this, Universal meticulously imitated the sound and style of the Glenn Miller orchestra for the soundtrack of the film by hiring a conductor to analyze and recreate Miller's renditions of his hit songs and employing former members of the original Miller orchestra. Miller's widow sued when Universal, through its parent company and co-defendant, Decca Records, issued a soundtrack album featuring Miller's biggest hits as performed by the synthetic orchestra. Plaintiff received no royalties from the sale of this Album, which was enormously successful.

The trial judge awarded plaintiff damages calculated as if she had received the royalties in her RCA contract on the sale of the Decca release. RCA was for some reason not a party to the action. He found that the soundtrack album was not intended to advertise or exploit the film but to take a valuable product from RCA. He found an implied obligation "inherent in the limited license contract" and an implied covenant of good faith not to harm plaintiff by using its grant to lessen her income from other sources.<sup>71</sup>

<sup>65</sup>40 Ch.Div. 345 (1888).

<sup>66</sup>*Id.* at 349.

<sup>67</sup>*Id.* at 352.

<sup>68</sup>18 Misc.2d 626, 188 N.Y.S.2d 386 (S.Ct.

1959).

<sup>69</sup>188 N.Y.S.2d at 391.

<sup>70</sup>*Id.*

<sup>71</sup>*Id.* at 393.

That this contract interpretation was informed by property notions is made plain by the judge's invocation of the proposition that "it is the unique quality of the performance and plaintiff's primary property in that performance which constitute the basis for the action."<sup>72</sup>

The Appellate Division, First Department, reversed.<sup>73</sup> It held that because plaintiff had no control over the copyrights to Miller's songs (which were presumably subject to compulsory licenses) and because she had no "property interests in the Glenn Miller 'sound,'" <sup>74</sup> no negative covenant would be implied.

The RCA license agreement was in existence and known to all parties at the time the contract between plaintiff and Universal Pictures was made, and if plaintiff wished to restrict Universal Pictures in the use of its sound track, she should have expressly so provided in the agreement. Hence, under the theory of the complaint, there is no occasion to consider whether, within the meaning of the contract, the recordings were merely in exploitation of the motion picture as urged by defendants.<sup>75</sup>

Thus the property question seems to shift the burden of drafting and thereby determine the interpretation question: if the plaintiff has no property right in the Glenn Miller sound, then she has to bargain for an express covenant to protect it from duplication. But in the trial court, where the plaintiff was seen to be asserting a property right — perhaps in the style, perhaps in the performance, it is not clear — the silence in the contract with respect to the soundtrack album was "wholly understandable,"<sup>76</sup> and the obligation not to compete was implied.

In *Ettore v. Philco Television Broadcasting Co.*,<sup>77</sup> a professional boxer had in 1936 sold the film rights in his upcoming bout with Joe Louis for \$500. (Louis knocked him out.) Thirteen years later,

defendants broadcast on television a truncated version of the film.<sup>78</sup> Ettore sued for damages, claiming he had not authorized the telecast. Defendants claimed that Ettore's film deal should be construed to authorize any use of the film whatsoever. That original film contract was silent as to use of the film beyond general theatrical distribution. In evaluating the claim, the court looked to the law of the states in which Ettore alleged injury, and found that

Where a professional performer is involved, there seems to be a recognition of a kind of property right in the performer to the product of his services.<sup>79</sup>

Then the court had to reach the question of the scope of Ettore's film rights grant:

Commercial television . . . was not in existence at the time of the Ettore-Louis contest. Fairness would seem to require that a court treat the absence of the new or unknown media, television in the instant case, as about the equivalent of a reservation against the use of the work product of the artist or performer by a known medium . . .<sup>80</sup>

Property issues interact with contract issues in a more fundamental way in suits against outsiders. In cases involving "exclusive" exploitation contracts, in rem property protection is sine qua non. You can contractually grant the exclusive right to X only if the law gives you the power to exclude others from X — if, that is, the law protects X as property. It is meaningless, for example, to sell the "exclusive" rights to market T-shirts with your name and picture on them if you are powerless to prevent others from doing so.

This issue arises typically in suits by a party to an exploitation contract for alleged interference with its contractual rights by an outsider. In *Liebig's Extract of Meat Co. v. Liebig Extract Co.*,<sup>81</sup> a Baron Liebig had developed and pub-

<sup>72</sup>*Id.*

<sup>73</sup>11 A.D.2d 47, 201 N.Y.S.2d 632 (1st Dep't 1960).

<sup>74</sup>201 N.Y.S.2d at 634.

<sup>75</sup>*Id.* at 635.

<sup>76</sup>188 N.Y.S.2d at 391.

<sup>77</sup>229 F.2d 481 (3d Cir. 1956), cert. den. 351

U.S. 926 (1956).

<sup>78</sup>This version omitted the third round, which Ettore claimed was his best. *Id.* at 483.

<sup>79</sup>*Id.* at 487.

<sup>80</sup>*Id.* at 491.

<sup>81</sup>180 F. 688 (2d Cir. 1910).

lished a formula for meat extract. He had granted plaintiff the exclusive right to use his name in connection with the sale of meat extract. Defendant sold a similar product, also using the Liebig name, and plaintiff was granted an injunction:

The formula having been published, anybody was free to use it in 1863; but no one was free to use Baron Liebig's name in connection with the product, except by his express permission to be implied from the fact of the process becoming generally known as his.<sup>82</sup>

Plaintiff had Liebig's express permission, and defendant for reasons not clear from the opinion refused to disclose the process used in making its product and thus could not be said to have the "implied" permission. Underlying this decision is the unspoken notion that a person can prevent others from using his name.

Two cases involving the exploitation of news of sporting events will illustrate the importance of in rem considerations in contract discussions. In *National Exhibition Co. v. Teleflash, Inc.*,<sup>83</sup> the owner of a baseball team and stadium sought injunctive relief on unfair competition grounds from defendant's alleged "dissemination over telephone wires to groups of listeners, gathered at various distances from the scene of the game, of description, play by play, of the plays as they occur during the progress of the game."<sup>84</sup> Plaintiff claimed that the defendant's practice hurt ticket sales and caused Western Union to stop paying plaintiff for "the privilege of announcing the results of innings."<sup>85</sup> The court denied relief: "What plaintiff owned was the game.

It is not sufficient to constitute unfair competition that the plaintiff merely had title to the game. In addition, it must have title to an exclusive right to describe it, play by play, while in progress. The very problem we are trying to solve is whether the plaintiff has any such right. Plainly, as I see it, there was no competition, much less unfair com-

petition, between the game itself and the words concerning it used by the defendants. Unless the plaintiff had exclusive right of description, I fail to see any wrong done to it by the defendants in giving their own description of what they had seen.<sup>86</sup>

By Judge Caffey's analysis, plaintiff had rights only against (1) trespassers to the park and (2) licensees (ticket holders). Plaintiff alleged no trespass to the stadium (it didn't know how defendant was getting its information), so its only other source of exclusive rights was the contract of the admissions ticket. Since the complaint did not allege that tickets contained a condition that the licensee would not communicate news of the game during its progress, the action had to be dismissed.

Contract was incapable of protecting plaintiff because the court refused to recognize an exclusive right of exploitation similar to that recognized in *International News*. The admissions contract could have bound only paying spectators, and plaintiff could grant no exclusive rights to Western Union because it had none itself. Two years later in Pennsylvania, on strikingly similar facts, the owner of the Pittsburgh Pirates sued to enjoin unauthorized radio broadcasts of its games in *Pittsburgh Athletic Co. v. KQV Broadcasting Co.*<sup>87</sup> Plaintiff had sold General Mills the "exclusive" right to broadcast Pirates home games. Admissions tickets did in fact contain the proviso missing in the *Teleflash* case. Defendant's reporters were "stationed at vantage points outside Forbes Field" from which they could "see over the enclosure of that field and observe the plays as they are made."<sup>88</sup> The injunction issued:

It is perfectly clear that the exclusive right to broadcast play-by-play descriptions of games played by the "Pirates" at their home field rests in the plaintiffs. . . . That is a property right of the plaintiffs with which defendant is interfering.<sup>89</sup>

<sup>82</sup>*Id.* at 690.

<sup>83</sup>24 F.Supp. 488 (S.D.N.Y. 1936).

<sup>84</sup>*Id.* at 488.

<sup>85</sup>*Id.* at 489.

<sup>86</sup>*Id.*

<sup>87</sup>24 F.Supp. 490 (W.D.Pa. 1938).

<sup>88</sup>*Id.* at 492.

<sup>89</sup>*Id.*



The court's reasoning followed that of *International News* in protecting plaintiff's labor and investment:

The defendant wrongfully deprives the plaintiffs and each of them of the just benefits of their labors and expenditures in respect of the baseball games and the publication of the news thereof . . . .<sup>90</sup>

Though plaintiff's labor and investment were the central factors in the decision, the court was also influenced by the plaintiff's exclusive broadcast contract and the ticket proviso: the opinion cited plaintiff's "creation of the game, its control of the park, and its restriction of the dissemination of news therefrom"<sup>91</sup> as the reasons for the property protection.

The baseball cases exemplify two possible solutions to the property-contract puzzle. In *Teleflash*, plaintiff's exploitation contract could not grant the exclusive right to announce news of the game because the court would not protect the plaintiff in the exercise of such a right. In *KQV*, the court recognized an exclusive right of exploitation partly because of plaintiff's "exclusive" contracts.

In the *Metropolitan Opera* case, the plaintiff was held to have stated a cause of action for unjustifiable interference with its contractual rights in addition to its unfair competition claim because of its recording contract with Columbia, even without alleging that defendant induced any breach. In reaching the conclusion that the plaintiff had a property right in its performances, the court considered both the labor expended on the performances and the investment of licensee Columbia.<sup>92</sup>

A strain of self-help, of bootstrapping, thus begins to emerge in counterpoint to the general theme of contracts being subordinate to property. While in some cases the effectiveness of contracts hinges on the in rem protection the law will afford, in others the courts step in to protect values that people have been exchanging in "exclusive" contracts all along without

judicial intervention. The relationship between contract and property is circular. Sometimes commerce depends on protection; sometimes protection depends on commercial custom. It is this latter, law-as-protector-of-going-enterprises theme that Judge Holmes sounded in his dissent in *O'Brien v. Pabst Sales Co.*,<sup>93</sup> where a football player was denied damages against the beer company that had put his picture on its sales calendar:

No one can doubt that commercial advertisers customarily pay for the right to use the name and likeness of a person who has become famous . . . . The decision of the majority . . . . is contrary to usage and custom among advertisers in the marts of trade. They are undoubtedly in the habit of buying the right to use one's name or picture to create demand and goodwill for their merchandise. It is the peculiar excellence of the common law that, by general usage, it is shaped and moulded into new and useful forms.<sup>94</sup>

The explicit recognition in *Haelan Laboratories v. Topps Chewing Gum, Inc.*<sup>95</sup> of a right of publicity did much to shift the balance toward this latter tendency. *Haelan* involved a dispute between two grantees of the "exclusive" right to use the photographs of certain professional baseball players on bubble gum cards. The players had first signed with plaintiff for a specified term, and then during that term signed also with defendant, who knew of the earlier contract. Plaintiff sued the later grantee for invasion of its exclusive rights. Defendant argued that plaintiff's contract with the players amounted to no more than a release from liability under the New York privacy statute (in Hohfeldian terms, a privilege); since the right of privacy is personal and therefore not assignable, plaintiff's contract could invest plaintiff with no property, so in inducing the players to authorize it to use their photographs, defendant violated no right with the plaintiff. The trial judge dismissed plain-

<sup>90</sup>*Id.* at 494.

<sup>91</sup>*Id.*

<sup>92</sup>101 N.Y.S.2d 483, at 497-98.

<sup>93</sup>124 F.2d 167 (5th Cir. 1941), discussed *supra*.

<sup>94</sup>*Id.* at 170-171 (Holmes, J., dissenting).

<sup>95</sup>202 F.2d 866 (2d Cir. 1953), *cert. den.* 346 U.S. 816.

tiff's complaint, but the Second Circuit reversed:

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), 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.<sup>96</sup>

This settled the contract issue: defendant had violated plaintiff's exclusive rights. The opinion crystallized and gave a name to an interest which contract and unfair trade law had theretofore afforded only inchoate and rather groping protection and which privacy law had almost completely forsaken.

This right might be called a 'right of publicity.' For it is common knowledge that many prominent persons (especially actors and ball players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, and subways. This right of publicity would yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.<sup>97</sup>

#### Concepts in Conflict

The early discussions of the right of privacy insisted that it was logically deducible from the principles of the common law,<sup>98</sup> or "derived from the natural law."<sup>99</sup> Such was the dominant mode of legal thought at the turn of the century. Judges and commentators were unabashed about

declaring results in in-the-nature-of-things terms.

The right of publicity was crystallized more than sixty years later, in much more positivist times. By then, Holmes's admonition that "[t]he life of the law has not been logic: it has been experience"<sup>100</sup> was a commonplace.<sup>101</sup> Early publicity decisions denied the importance of calling publicity a "property" right, and recognized that protection was more a result of judicial discretion than an inexorable corollary of the "nature of things." In *Haelan* the label was "immaterial" because "the tag 'property' simply symbolizes that courts enforce a claim which has pecuniary worth."<sup>102</sup> *Metropolitan Opera* defined property rights as "rights which are recognized and protected by the courts by excluding others therefrom" and said that "[t]he designation is therefore more in the nature of a legal conclusion than a description."<sup>103</sup>

Commentators have echoed these positivist sentiments. Discussing publicity as one of four interests protected under the law of privacy, Prosser wrote:

It seems quite pointless to dispute over whether such a right is to be classified as 'property.' If it is not, it is at least, once it is protected by law, a right of value upon which the plaintiff can capitalize by selling licenses.<sup>104</sup>

A recent note<sup>105</sup> on the descendibility issue reiterated: "The property label itself is without independent substance; it merely indicates that courts recognize a pecuniary right of publicity."<sup>106</sup>

Yet despite these disavowals, the fact that publicity was labelled a property right has had a powerful substantive effect on the scope of the right. Far from a mere "conclusion" or "tag," "property" in this context has had independent signifi-

<sup>96</sup>*Id.* at 868.

<sup>97</sup>*Id.*

<sup>98</sup>*E.g.*, Warren and Brandeis, *supra*, note 2.

<sup>99</sup>*E.g.*, Pavesich v. New England Life Insurance Co., *supra*, note 22, at 70.

<sup>100</sup>O. W. Holmes, *The Common Law* 1 (1881).

<sup>101</sup>Similar notions were put forth in 5 R. Pound, *Jurisprudence* (1959) at 28 ("A particular body of law is a system of practical adjustments and compromises proved by experience, not a body of uni-

versal, logical deductions."); and Hart & Sacks, *The Legal Process: Basic Problems in the Making and Application of the Law* (1958).

<sup>102</sup>202 F.2d at 868.

<sup>103</sup>101 N.Y.S.2d at 493.

<sup>104</sup>W. Prosser, *supra*, note 3.

<sup>105</sup>Note, *Lugosi v. Universal Pictures: Descent of the Right of Publicity*, 29 *Hast.L.J.* 751 (1978).

<sup>106</sup>*Id.* at 758.

cance; it has given content to the right of publicity far beyond that which these positivist definitions indicated it possessed.

The vitality of the property label has had a dramatic impact in the recent controversy over the inheritability of the right of publicity. Two cases involving Elvis Presley highlight the issue. In *Factors, Etc., Inc. v. Creative Card Co.*,<sup>107</sup> plaintiff, the licensee of rights to exploit the name and likeness of the late Elvis Presley, sought to enjoin the manufacture and sale of an unauthorized Elvis Presley poster. In granting the injunction, Judge Tenney wrote:

It appears that a recognized property right, the 'right of publicity,' inhered in and was exercised by Elvis Presley in his lifetime, that it was assignable by him and was so assigned, that it survived his death and was capable of further assignment.<sup>108</sup>

Having made the right assignable, courts are almost forced to protect it after the death of the celebrity. An assignable right that dies with its subject violates our traditional understanding of property; it is a bundle of rights we are unaccustomed to and uncomfortable with.

The other Presley case further demonstrates the force at work here. Another unauthorized distributor of Elvis Presley posters appealed the grant of a preliminary injunction to the Second Circuit.<sup>109</sup> For Judge Ingraham, descendibility was almost *fait accompli*:

There can be no doubt that Elvis Presley assigned to Boxcar [Presley's management corporation] a valid property right, the exclusive authority to print, publish, and distribute his name and likeness. In doing so, he carved out a separate intangible property right for himself, the right to a certain percentage of the royalties that would be realized by Boxcar upon exploitation of Presley's likeness and name. *The identification of this exclusive right belonging to Boxcar as a transferable property right compels the conclusion that the*

*right survives Presley's death.* The death of Presley should not itself extinguish Boxcar's property right. Instead, the income interest, continually produced from Boxcar's exclusive right of commercial exploitation, should inure to property right. To hold that the right did not survive Presley's death would be to grant a windfall in the form of profits from the use of Presley's name and likeness. At the same time, the exclusive right purchased by Factors and the financial benefits accruing to the celebrity's heirs would be rendered virtually worthless.<sup>110</sup>

A logically distinct question concerning the degree of protection to afford the right of publicity is whether the right is inheritable even if it was not "frozen" by assignment, i.e., when an heir, and not an assignee, is seeking to protect it. Can it survive because it was *capable* of assignment?

In New York it can. In *Price v. Hal Roach Studios, Inc.*<sup>111</sup> the widows of Stanley Laurel and Oliver Hardy sued for misappropriation of their rights in their late husbands' names and likenesses. Defendants were the studio that had produced the Laurel and Hardy films, and the persons to whom it had granted "world-wide exclusive merchandising rights" to the actors' names and likenesses. After holding that neither the studio's employment and publicity contracts with the actors nor its copyrights in the films gave it the rights claimed to have, Stewart, District Judge, discussed the right of publicity. He began by stressing the difference between privacy, a feeling-based right, and publicity, a commercial one. Privacy rights are not assignable during life and terminate upon death.

When determining the scope of the right of publicity, however, one must take into account the purely commercial nature of the protected right. Courts and commentators have done just that in recognizing the right of publicity as assignable. There appears to be no log-

<sup>107</sup>444 F.Supp. 279 (S.D.N.Y. 1977).

<sup>108</sup>*Id.* at 282.

<sup>109</sup>*Factors, Etc., Inc. v. Proarts, Inc.*, 579 F.2d

215 (2d Cir. 1978).

<sup>110</sup>*Id.* at 221 (emphasis added).

<sup>111</sup>400 F.Supp. 836 (S.D.N.Y. 1975).



ical reason to terminate this right upon death of the person protected.<sup>112</sup> While the "no logical reason" language might be read as an independent (if highly attenuated), positivist consideration of the descendibility issue, the idea of "property" has undeniable determinative power here. Likening publicity to other commercial rights and making it assignable seems almost to dispose of the inheritability issue, despite the fact that Laurel and Hardy had not assigned the rights asserted during their lifetimes. Nonexploitation of the right during one's lifetime is no bar to inheritability, Stewart reasoned, because during non-exploitation, one's interests in his name and likeness are protected by the law of privacy.<sup>113</sup>

As authority for the proposition that the right of publicity is protectable even absent exploitation, Stewart cited *Grant v. Esquire, Inc.*<sup>114</sup> That case involved an article on current men's fashions in which *Esquire* magazine ran a 1946 photo of Cary Grant, altered to give the appearance that Grant was wearing a 1973 Orlon double-knit cardigan sweater. Grant had the good taste to sue and was awarded damages on publicity grounds. Judge Knapp's formulation of the case set the tone: "The question presented is whether *Esquire* had the right to compel Mr. Grant to contribute his face for free."<sup>115</sup> In holding the First Amendment no bar to the action, he wrote: "[T]he First Amendment does not absolve [publishers] from the obligation of paying their help. . . . [D]efendant is entitled to report (either with or without pictures) almost any activity in which Mr. Grant might engage. It is not entitled to appropriate his services as a professional model."<sup>116</sup> The relevant passage in the opinion demonstrates the operative, reifying power of the property label. In justifying property protection of Grant's right of publicity despite Grant's

desire not to exploit it, Judge Knapp wrote: *If the owner of Blackacre decides for reasons of his own not to use his land but to keep it in reserve he is not precluded from prosecuting trespassers.*<sup>117</sup>

Under California law, commercial value in a name or likeness is inheritable only if exploited during the lifetime of the celebrity. The case that settled the descendibility question in California is *Lugosi v. Universal Pictures*.<sup>118</sup> The widow and son of Bela Lugosi, the actor who played Count Dracula in the 1930 film, sued Universal for licensing the use of Lugosi's likeness for Dracula T-shirts and the like. Like Laurel and Hardy, Lugosi in his employment contracts with the studio had granted the right to exploit his name and likeness in connection with his films; and like Hal Roach Studios, Universal had made a lucrative business out of exploiting the actors' face independent of the films. The trial court awarded Lugosi's heirs damages and an injunction on an analysis similar to that in the Laurel and Hardy case.<sup>119</sup> The California Supreme Court reversed, holding that the right of publicity was a personal one that died with Lugosi, leaving his heirs with no protectable interests in his name or likeness. Unlike Cary Grant's remarkably reified right of publicity, Lugosi's survives him only if frozen in an exploitation contract or defended against appropriation during his lifetime.

The court reached its result by rejecting the line of cases that give publicity "property" protection: it categorized it instead as strictly "personal." To this end, it relied heavily on Prosser's discussion of publicity as one of four interests protected by the law of privacy,<sup>120</sup> and concluded that "[t]he protection of name and likeness from unwarranted intrusion or exploitation is the heart of the law of privacy."<sup>121</sup> The court's use of Prosser as

<sup>112</sup>*Id.* at 844.

<sup>113</sup>*Id.*

<sup>114</sup>367 F.Supp. 876 (S.D.N.Y. 1973).

<sup>115</sup>*Id.* at 878.

<sup>116</sup>*Id.* at 884.

<sup>117</sup>*Id.* at 880. A recent decision in the Southern District followed *Price* and *Proarts* in holding the publicity rights of the Marx Brothers descendible.

*Groucho Marx Productions, Inc. v. Day and Night Co.*, No. 80 Civ. 2310 (S.D.N.Y. Oct. 2, 1981).

<sup>118</sup>603 P.2d 425, 25 Cal.3d 813, 160 Cal.Rptr. 323.

<sup>119</sup>172 U.S.P.Q. 541 (1972).

<sup>120</sup>Prosser, *Privacy*, 48 Cal.L.Rev. 383, 401-407.

<sup>121</sup>160 Cal.Rptr. at 329.

"authority" is interesting for its selectivity. It cited Prosser in its determination that publicity ought to be treated as merely one aspect of the "right to be let alone"; in its refusal to regard publicity as property it quotes Prosser as calling the dispute over the label "pointless."<sup>122</sup> In fact, the article merely reports the fact that actions for "appropriation" of value in one's identity have been brought in the name of privacy. Prosser actually stresses the difference between publicity and the three privacy-related wrongs that protect emotional interests — intrusion, disclosure, and false light. He regards the controversy over the property label as "pointless" but emphasizes the "proprietary nature" of the right and praises *Haelan's* protection of it.<sup>123</sup> The opinion goes on to quote a passage from Prosser's torts treatise:<sup>124</sup>

"There has . . . been a good deal of consistency in the rules that have been applied to the four disparate torts under the common name. As to any of the four, it is agreed that the plaintiff's right is a personal one, which does not extend to members of his family, unless, as is obviously possible, their own privacy is invaded along with his. The right is not assignable, and while the cause of action may or may not survive after his death, according to the survival rules of the particular state, *there is no common law right of action for a publication concerning one who is already dead.*"<sup>125</sup>

Only part of this "authority" supports the court's conclusion, and the court takes its choice: "Although, as we discuss hereafter, the right to exploit one's name and likeness may be assignable [in fact the court explicitly so states,<sup>126</sup> as does Prosser, elsewhere]<sup>127</sup> a number of decisions support the italicized conclusion."<sup>128</sup>

It cited and rejected in a footnote *Price's* holding that there is "no logical reason to terminate [the right of publicity] upon the death of the person protected".<sup>129</sup>

"To the contrary, as we have explained, a rule of non-descendibility is justified by the personal nature of the right, coupled with the difficulty in judicially selecting an appropriate durational limitation were it held descendible to one's heirs."<sup>130</sup>

Likening the right of publicity to personal, feeling-based interests, then, commands the conclusion that the right died with *Lugosi*. California resisted the pull of the property label by taking refuge in the personal right category.

After drawing its conclusion from the "nature of the right" the court briefly discussed some of the actual policy considerations at issue:

If rights to the exploitation of artistic or intellectual property never exercised during the lifetime of their creditors were to survive their death, neither society's interest in the free dissemination of ideas nor the artist's rights to the fruits of his own labor would be served. Authority, as noted, supports the strong policy considerations which underlie the conclusion that the right is personal.<sup>131</sup>

Though the *Lugosi* opinion does some violence to the purity of the personal right conception by forcing it around an assignable interest, the conception is far from impotent. Its application is less dogmatic than that of property in New York, but the very fact that the court wrestled with the conception so vigorously and with such ingenuity is testament to some kind of conceptual vitality. The holding was reasoned, justified, and stated in *con-*

<sup>122</sup>*Id.* at 326.

<sup>123</sup>48 Cal.L.Rev. 401-407.

<sup>124</sup>W. Prosser, *Law of Torts* 814-815 (4th ed. 1971).

<sup>125</sup>160 Cal.Rptr. at 327.

<sup>126</sup>*Id.* at 326.

<sup>127</sup>See note 3, *supra*.

<sup>128</sup>160 Cal.Rptr. at 327. In an even more startling bow to Prosser as authority for subsuming publicity

into the privacy category, *Carson v. National Bank of Commerce Trust & Savings*, 356 F.Supp 811 (D.Neb. 1974), *aff'd* 501 F.2d 1082 (8th Cir. 1974), held, citing Prosser, that because under Nebraska law there is no common law or statutory right of privacy, there is no right of publicity, either.

<sup>129</sup>See note 113, *supra*.

<sup>130</sup>160 Cal.Rptr. at 329, fn. 8.

<sup>131</sup>*Id.*

ceptual terms, with only a passing, almost makeweight, consideration of policy.<sup>132</sup>

### CONCLUSIONS

Some writers on contemporary jurisprudence claim that the adoption of open-ended definitions of property such as that embraced in the publicity area heralded the demise of conceptualism and formalistic reasoning. Kenneth Vandavelde<sup>133</sup> has traced the development of the concept of property from (1) Blackstone's eighteenth century notion of absolute dominion over things, exemplified in the fee simple; through (2) the nineteenth century acceptance of limited and intangible forms of property, either by the imposition of limitations on formerly absolute rights, as in the case of tradenames and oil and gas removal rights, or by the creation of property limited from the outset, as in the case of trade secrets; to (3) the twentieth century Hohfeldian conception of property as bundles of rights, privileges, powers, and immunities, the composition of which varies with the demands of the situation. Vandavelde argued that this development, this shattering of the absolute property right, and the subsequent adoption of the nebulous and toothless definition of property epitomized in *International News*, robbed the property concept of its usefulness as a characterization of legal relations and hence of its power to decide cases:

Thus, by 1925, it was abundantly clear that the definition and application of the concept of property could not be done through logical deduction. The courts avoided paralysis by deciding cases according to public policy. Property was completely positivized. . . . But this solution to the problem came at the price of the courts' legitimacy. . . . The creation of the new property was,

in microcosm, the destruction of the rule of law.<sup>134</sup>

A recent note in the *Harvard Law Review*<sup>135</sup> describes much the same evolution in the doctrine of tortious interference with contractual relations. Once the law began to treat all contract rights as property, the inevitable clashes with other values became apparent, and formerly absolute rights and privileges were limited. Ultimately judges were forced into ad hoc interest balancing. The author viewed this transformation as "an illustration of the changing juristic conception of property, tort, and contract. . . . The ultimate abandonment of formalistic reasoning implies that judicial decisions cannot be deduced from abstract doctrines such as property and competition."<sup>136</sup>

And, surely, in many areas of the law, the application of formal concepts is subordinated to practical considerations. The incantation that formalism is dead and all law is positivized cannot, however, account for the current judicial reliance on traditional, often absolute conceptions of property and personal rights in deciding the scope of a right so recently crystallized as the right of publicity. What can account for it? There are two dimensions of the role of conceptions in the decisions that need explaining: (1) the degree to which discussions of conceptions dominate the opinions and displace or overshadow considerations of policy and fairness; and (2) the degree of rigidity and absoluteness with which the conceptions, once invoked, are applied.

One possible hypothesis is that the conceptions have no real power over the decisions judges make, but judges use them as labels to give their decisions legitimacy, to mask the discretion inherent in adjudication with an artificial coating of

<sup>132</sup>For a somewhat different mix of policy and categorization, see *Memphis Development Foundation v. Factors, Etc., Inc.*, 616 F.2d 956 (6th Cir. 1980), which discussed policy arguments on both sides and, after analogizing the right of publicity to defamation, found the asserted advantages of inheritability insufficient to justify "changing the traditional common law rule against allowing heirs the exclusive control of the commercial use of their ancestor's name." *Id.* at 959.

<sup>133</sup>Vandavelde, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 *Buff.L.Rev.* 325 (1980).

<sup>134</sup>*Id.* at 366-7.

<sup>135</sup>Note, *Tortious Interference with Contractual Relations in the Nineteenth Century: The Transformation of Property, Contract, and Tort*, 93 *Harv.L.Rev.* 1510 (1980).

<sup>136</sup>*Id.* at 1539.



inevitability and determinacy. Holmes put forth such a proposition almost a century ago:

Perhaps one of the reasons why judges do not like to discuss questions of policy, or to put a decision in terms upon their views as law-makers, is that the moment you leave the path of merely logical deduction you lose the illusion of certainty which makes legal reasoning seem like mathematics. But the certainty is an illusion, nonetheless.<sup>137</sup>

Thus when the implications of the traditional, fee simple understanding of property coincide with a judge's reaction to a case, he uses the property label as justification for the result. If the traditional personal conception will buttress his conclusion, he uses that. This model would explain the judges' observed concept-laden discourse, but alone it cannot account for the predictive power the concepts have had the rigor which their implications have been played out in the cases.

A second model posits the genuine importance of these concepts in the cognitive processes of judges and lawyers, or what Duncan Kennedy has called "legal consciousness."<sup>138</sup> The concepts are intellectual operations, shared ideas around which lawyers organize legal issues. Pound wrote of similar notions, the "legal conception," a "legally defined category into which cases may be fitted,"<sup>139</sup> and "mental habits governing judicial and juristic craftsmanship."<sup>140</sup> Under this model, concepts are operative, *i.e.*, have a substantive impact on the shape of the law, because "when certain situations of fact come within a category a series of rules and principles become applicable."<sup>141</sup> Concepts "impose limits, suggest directions . . . but do not uniquely determine outcomes"<sup>142</sup>; they *mediate* and *interact* with social and economic forces and the visceral reactions and personal biases of judges to have an independent influence

on the development of legal doctrines. This model goes some distance toward explaining the cases, especially many of the property cases, in which the judges appear sincerely to feel bounded by the traditional attributes of the old-time property right.

Another version of the cognitive explanation involves a notion of the life cycle of a legally protected interest. This model would translate Vandeveld's developmental view from fixed historical periods into phases in the maturation of legal rights in general. Thus when an interest is newly protected, we appeal to the defining strength of our traditional legal concepts for a sense of order, of limits. Eventually it becomes clear that this sense of order entails the sacrifice of other values, and judges temper and limit the pure application of the concept to accommodate them. Ultimately, perhaps, the concept loses most of its power, and judges are free to improvise, balance interests, and respond to experience unfettered by formalistic constraints. By this view, publicity is still in its infancy: judges are applying the old concepts in their pure form. Property implies assignability and descendibility. Privacy, sixty years older, may be in the second phase: there is at least ritual power left in the personal right concept, but *Lugosi* shaped it to accommodate assignability, a characteristic antithetical to the pure personal right model. There are other similarities in the development of privacy and publicity that recommend this trans-historical hypothesis. Each developed as a response to the perceived inadequacies of its predecessor. Brandeis and Warren proffered privacy as a solution to the unsatisfactory results of the various property/material doctrines that preceded it. The right of publicity was crystallized and synthesized largely in response to the wrongs that privacy and contract had left unredressed. For each, the first stage of responsive development was

<sup>137</sup>Holmes, *Privilege, Malice, and Intent*, 8 Harv. L. Rev. 1, at 7 (1894).

<sup>138</sup>Kennedy, *Toward an Historical Understanding of Legal Consciousness*, 3 Research in Law & Soc. 3 (1980).

<sup>139</sup>2 R. Pound *Jurisprudence* 127 (1959).

<sup>140</sup>*Id.* at 111.

<sup>141</sup>*Id.* at 127.

<sup>142</sup>Kennedy, *supra*, note 139, at 8.

recognition as a parasitic claim. Before privacy was developed, emotional harm was compensable only if a wrong to a property interest was shown. Privacy cases sometimes allowed property damages where a wrong to plaintiff's feelings had occurred.<sup>143</sup>

Perhaps positivism simply operates at the level of categorization — whether to call X a property right, a personal right, or anything at all — but once applied and accepted, the concepts have determinative power of their own, and they serve as a limit on the number of substantive choices open to a judge in deciding a case. *International News* and *Metropolitan Opera* used broad, loose criteria for categorizing something as property, but we have seen that once a thing is in the category, traditional implications of that category take hold. Under this model, there is room for the tendency illustrated in *KQV* to protect as property those values that parties have been exchanging as property. The emphatically opposite results in the *Miller* trial and appellate decisions are likewise intelligible: the courts differed on the initial categorization — whether plaintiff's interest in her late husband's performance or style was a property right; each categorization dictated a disposition of the case.

However we explain it, the effect of this phenomenon has been the virtual neglect of important issues of fairness; economic incentives to celebrity, performance, and merchandising; and freedom of expression. Many of these issues are probably best resolved by legislative action, but adjudication in the publicity field has served to obfuscate rather than highlight this need.

Operative legal concepts are functioning as limits on positivism and realism in the publicity field. Eulogies for conceptualism are premature. The history of the legal protection of commercial interests in the elements of personal identity is more than anything else the history of the application and interplay of two fundamental conceptions of legal rights, each manifesting itself in various legal doctrines. Privacy and defamation embody the personal right conception. Property was imported to lend definition and determinacy to the rules of decision of both unfair competition and contract law, and was eventually precipitated in the right of publicity. Though perhaps it was created in the spirit of positivism, the development of the right of publicity has been largely conceptual in both form and substance. Jerome Frank would be surprised at what *Haelan* has wrought.