



Right of Publicity

in 17 jurisdictions worldwide

2012

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Global Overview

Jonathan D Reichman*

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The right of publicity is the right of an individual to control the use of his or her name, likeness or other personal attribute (voice, signature, etc) for commercial purposes, such as for use on merchandise or in advertisements. The right is often considered to be a form of, or related to, the right of privacy, which is the right of an individual to control the use of his or her personal attributes for any public purpose. In recent years, however, the right of publicity has been recognised as a unique form of property governed by its own rules and principles.

The expansive growth of publicity rights, from being almost non-existent 50 years ago to widely accepted today, reflects increased concern that, without protection, an individual's identity can be used and abused by third parties in connection with advertising, promotions, products and other commercial activities. As the following chapters make clear, however, critical issues in the field, such as what forms of identity should be protected, how long protection should last and how protection should be applied in various commercial contexts are addressed differently in different jurisdictions. These questions are thorny because of the inherent tension between publicity rights and the ability of businesses and other entities to freely engage in advertising, entertainment and other forms of commercial expression. In many jurisdictions, including those surveyed in this book, the right to freedom of speech and expression – even for purely commercial purposes – is highly valued. Therefore, countries have understandably been reluctant to limit free speech through the creation of a new personal right.

The complexity of these issues is compounded by developments in both technology and popular culture. The global information revolution – as reflected in phenomena such as the internet, social networking, reality television and viral advertising – creates a world that crowns more individuals than ever before as 'celebrities' (even if only for Andy Warhol's proverbial 15 minutes of fame), yet at the same time gives companies more media avenues than ever before to engage in unauthorised exploitation. But despite these global challenges, and the potential for an individual in country A to have his or her identity misappropriated halfway around the world in country B, no unifying body of international law exists on the right of publicity. Unlike other intellectual property fields such as copyright, trademark and patent law, there are no international treaties or conventions. As a result, a wide spectrum of protection is offered by the various jurisdictions around the world. In the United States, a wide spectrum of differences even exists between individual states.

These significant differences arise between countries because there are, at the core, different philosophies behind protecting the right of publicity. Some countries, such as the US, view the right as a commercial property interest to be exploited and traded at will; others, such as Italy, view it as a fundamental personal right that cannot be severed from the individual. Still others, such as Spain and Portugal, adopt both approaches. (These different philosophies are also reflected, to a significant extent, in historically different approaches to copyright law.) In practical terms, those jurisdictions viewing

publicity rights as property often give greater freedoms to individuals who want to monetise their identities, whereas those viewing the right as personal usually reduce these freedoms while nevertheless affording individuals the ability to protect themselves and reassert their authority if a user or licensee acts contrary to their vision.

Of the 17 jurisdictions surveyed, eight recognise the right of publicity as a distinct per se right, independent of other rights; eight jurisdictions offer analogous protections but regard the right as cobbled together from other laws; and one, the United Kingdom, offers no express recognition at all. However, even beyond these three categories distinctions predominate. This publication attempts to help the reader understand those distinctions while highlighting areas of similarity where they exist.

Probably no aspect of publicity rights is more varied than the scope of protection offered. All jurisdictions that recognise the right protect an individual's name and likeness, but that is where the similarity ends. For example, Japan protects an individual's signature; France protects an individual's title of nobility, family motto and heraldic signs; and Portugal expressly protects an individual's family name.

Some jurisdictions have protections that are somewhat vague and open-ended. For example, in Israel, any characteristic that 'belongs to a person uniquely' is protected, although the paucity of court decisions leaves this phrase vague. In Brazil, any 'physical, psychological, or moral characteristic' is protected. Other countries, including Argentina, Austria, Greece, India and Spain, as well as certain US states, grant protection for any element of a persona that serves to identify a person in the minds of the public. But such undefined parameters of protection can often lead to controversies in court.

Another major area of distinction is whether the right can be licensed and sold. Some jurisdictions, such as Greece, India, Japan and the US, allow the right to be both freely licensed and transferred in accordance with the laws of private property. Some, such as France and Mexico, allow the right to be licensed but not transferred. Other jurisdictions, such as Austria, allow neither (except through trademark rights). Still other jurisdictions (such as Italy, Germany, and Russia) do not allow the transfer or license of the right of publicity, but do permit individuals to give 'permission' for the use of the right. Thus, in these latter jurisdictions, an individual can never truly part with the rights to his or her identity. Spain, which adopts both the property and personal approaches, allows an individual to sell the 'commercial' rights to his or her identity but not the 'constitutional' rights.

A further area of distinction among jurisdictions is the length of protection for the right. While virtually all surveyed countries grant protection throughout the life of the individual, several jurisdictions, including Argentina, Brazil, France, Germany, Mexico, Spain and Russia, as well as some US states, allow the right to continue after death and to be controlled by the individual's heirs (subject to some qualifications, such as in Russia, where the right only continues after death if the person is survived by an heir). This is known as

post-mortem protection. In Germany, some aspects of the right (ie, those considered to be linked to an individual's right of privacy) end at death, while the more commercial aspects subsist for 10 years after death. In Mexico, the right subsists 50 years after death. In the US, the availability of post-mortem protection varies among the states and is one of the most contested aspects of American right of publicity law. New York, a commercially prominent state that is home to many celebrities, does not recognise any post-mortem protection, while California (the other 'celebrity capital' of America) grants protection for 70 years after death. In some countries, such as Greece, Canada, Israel and Japan, the term of protection is unknown because the laws have never been tested.

Finally, several jurisdictions that treat the right of publicity as personal (rather than as property) grant a decedent's close relatives an additional right, which is akin to post-mortem protection, namely protection from statements or publications that would dishonour the decedent's family. These relatives may only enforce the right if they can prove that their own interests were also directly affected. The right subsists for the lifetime of any qualifying relative.

In litigation for the infringement of publicity rights, the remedies available to a plaintiff vary in accordance with local civil practice. Virtually every jurisdiction awards the plaintiff injunctive relief and monetary damages if infringement has been proven. However, certain jurisdictions, such as Austria, France, Greece, Mexico and Spain, also provide for publication of the judgment, while other jurisdictions, such as India and the US, allow for punitive damages.

In some areas of right of publicity law, the similarities among jurisdictions outweigh the differences. For example, virtually all the surveyed jurisdictions exempt use of an individual's identity for the purposes of news reporting and public affairs. Such exemptions reflect the common belief that, while an individual's persona has value, protection must sometimes yield to the freedom of expression. For example, in Germany the Constitution protects the freedom of the arts and the press, and publicity rights must defer to them. Austria applies an express balancing test, asking whether the public's interest in use of an individual's identity (for example, in a magazine picture) outweighs the individual's interest in controlling it. In Spain, the image of an individual can be used if such individual is a public official at a public event or if the image is 'accessorial' to a news story. In France, humour, and facts in the public domain and of newsworthy expression, are exempt from right of publicity protection, although the public domain/newsworthy exemption is limited if the material is indecent and violates the individual's dignity. In the US, the Federal Constitution protects freedom of expression. However, some American courts have held that commercial speech (such as advertising) is not protected as strongly as non-commercial speech (such as newspaper articles), and therefore the use of an individual's identity in an advertisement, for example, would not be entitled to this constitutional protection.

Unfortunately, the dividing line between exempted versus non-exempted speech is often blurry, as reflected in each jurisdiction's efforts to draw the line in its own way. In Japan, for example, the 'reasonable' use of pictures is allowed, but there is limited guidance as to the meaning of this term. In Spain, the use of an individual's persona in an image is allowed if the use meets 'social norms at the time' – another ambiguous phrase. And in the US, courts have

struggled when attempting to determine whether expression is 'commercial' or 'non-commercial'.

Another similarity among the surveyed jurisdictions is that most do not require an individual to register his or her publicity right as a prerequisite to enforcing it. (In Russia, however, an individual's name must be registered at birth in order to receive protection, and a few jurisdictions do require registration for post-mortem rights.) This policy reflects the fact that, as with copyright law (but in contrast to, for example, patent law), most jurisdictions reject formalities as a condition to right of publicity protection. Thus, it is a right that automatically belongs to all individuals as a matter of law. Furthermore, virtually all jurisdictions grant the right to any individual without any requirement that the individual actively commercialise his or her identity. There are some exceptions, and a few jurisdictions treat the right of publicity differently for a celebrity than for the average person. In Israel, for example, the Supreme Court has held that a plaintiff must show that his or her identity possesses economic value. Therefore, while every Israeli citizen technically has a right of publicity, protection is more limited for those individuals unable to prove such value. In Japan, the right applies only to 'persons of distinction' – in other words, celebrities and other people widely known by society.

A few jurisdictions expand protection beyond individuals. For example, in Austria and Russia, a corporation can rely on the right of publicity to take action against certain infringements of its name, while in several US states, musical groups have been held by courts to possess a right of publicity. Some jurisdictions deny the right to non-citizens. Hence, in India, foreign individuals are not entitled to the constitutional protections governing the rights of privacy and publicity, although they still receive certain statutory rights. In the US, courts are divided over whether foreign individuals possess the right, particularly if the individuals reside in countries that do not recognise the right.

All of the surveyed jurisdictions are similar in that they allow other forms of intellectual property protection (ie, beyond the right of publicity itself) to be invoked against identical or similar acts of infringement. For example, an individual can secure copyright protection for a photograph or drawing of his or her likeness. Furthermore, famous individuals can often register their names or images as trademarks. Such trademark protection has certain unique advantages over right of publicity law. For example, trademark protection can potentially last indefinitely, in contrast to right of publicity protection, which lasts for the individual's lifetime or, at most, a fixed number of years thereafter.

Relative to other forms of intellectual property protection, the right of publicity is still in its infancy. While the laws of the surveyed jurisdictions provide different levels and types of protection, all reflect the growing view that an individual's identity, and the unique elements that comprise it, possess intrinsic commercial value that the individual should be allowed to control. We hope that this international survey will assist legal practitioners and legislatures as they grapple with this fascinating and burgeoning field.

* *The author wishes to acknowledge the contribution of Kenyon & Kenyon LLP associate Aaron Johnson for his assistance in the preparation of this overview.*

United States

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Sources of law

1 Is the right of publicity recognised?

There is no federal right of publicity. Instead, the right of publicity is a matter of state law. The right is recognised by 31 states; the remaining 19 states (specifically, their courts and legislatures) have not yet considered the issue. Only two states' courts have considered and expressly rejected the right, but in both cases the states' legislatures subsequently enacted right of publicity statutes.

A chart listing those states that recognise the right of publicity appears at the end of this chapter.

As individual state laws have developed independently from one another, there are often significant differences in the various states' implementation of the right. The key states for the right of publicity are New York and California, as these states are the domiciles of most American celebrities, and consequently their laws receive the greatest attention and scrutiny. This chapter focuses on the laws of these two states, while pointing out important areas in which other states' laws differ.

2 What are the principal legal sources for the right of publicity?

The right of publicity is established through civil statutes enacted by the state legislatures or common law created by the courts. A few states have both: after their courts created a common law right, their legislatures enacted statutes in order to broaden or narrow the common law right. In those states that established the right by statute, the right has been subject to interpretation by the courts in the context of infringement litigation. The chart at the end of this chapter shows the principal legal source or sources for each state's right of publicity.

Three states (Arizona, Louisiana and Oklahoma) also have criminal right of publicity statutes, making it a misdemeanour to infringe the right of publicity of current or former members of the armed services.

Additionally, two federal statutes grant forms of protection that are somewhat related to the right of publicity. Section 2(c) of the Lanham Act (15 USC section 1052(c)) prohibits the registration as a federal trademark of a living individual's name, portrait or signature without such individual's consent. 15 USC section 8131 (part of the 1999 Anticybersquatting Consumer Protection Act) provides that when a living individual's name has been registered as an internet domain name by another party without his or her consent, such individual can sue to cancel the domain name, or to have it transferred to his or her possession.

3 How is the right enforced? Which courts have jurisdiction?

The right of publicity is generally enforced through civil lawsuits in state courts, or in United States federal courts if the parties meet the jurisdictional requirements of such courts (see question 28).

4 Is the right recognised per se, or by reference to other laws?

In those states that recognise the right of publicity, it is a unique proprietary right distinct from other personal and proprietary rights. However, a celebrity – who is in the business of commercially exploiting his or her name and likeness – may conceivably assert that his or her name or likeness also constitutes a trademark. The celebrity may even seek to register his or her name or a standard image of his or her likeness as trademarks in the United States Patent and Trademark Office. If a celebrity is genuinely using his or her name or likeness as a trademark for products or services, then the unauthorised use of such name or likeness may constitute both an infringement of the right of publicity and an infringement of such trademark.

Existence of right

5 Who has or is entitled to the right of publicity?

Of those states that recognise the right, the vast majority hold that only natural, human persons possess it (ie, non-human persons such as corporations and other institutions are excluded). For example, New York's statute limits the right to 'any living person' and California's statute defines infringement as 'any person who uses another's [ie, another person's] name, voice, signature, photograph, or likeness'. A small minority of cases have expanded the right of publicity to include musical groups. Additionally, as noted in question 2, several states (ie, Arizona, Louisiana and Oklahoma) give members of the armed services additional protection through criminal penalties against the unauthorised use of their identities.

6 Do individuals need to commercialise their identity to have a protectable right of publicity?

Of those states that recognise the right, the vast majority do not require commercialisation as a prerequisite to a protectable right of publicity. This means that non-celebrities (individuals who have never marketed their names, likenesses, etc, for profit) possess an enforceable right of publicity. Neither New York nor California require the commercialisation of identity for an individual to possess a protectable right of publicity; as the California Court of Appeals has observed, 'California's appropriation statute is not limited to celebrity plaintiffs.' In the case of the post-mortem right of publicity (see question 15), Utah requires the deceased individual's name or likeness to be 'of commercial value' at the time of death for protection to exist, and Tennessee requires continuous exploitation of the right for protection to be maintained (after an initial 10-year post-mortem period, during which exploitation is not required).

7 Can a foreign citizen have a protectable right of publicity?

American courts are divided on whether a foreign resident can take advantage of a state's right of publicity laws. No state

statute expressly refuses to protect a foreign domiciliary, and a few statutes, such as those in Indiana and Washington, expressly apply to any individual regardless of domicile. However, the Washington statute's broad application was recently held by a court to be unconstitutional (see question 10). This issue has arisen at least twice with respect to residents of the United Kingdom, which does not expressly recognise a right of publicity. In one case a federal appellate court, applying Massachusetts law, held that the British resident possessed an enforceable right of publicity through ordinary conflict of laws principles. The court held that even though the United Kingdom did not formally recognise the right, protection in this instance would be limited to the US and would therefore not interfere with British public policy goals. However, in another case, a Californian court held that Princess Diana, who died a domiciliary of Great Britain, did not pass along the right to her estate upon death. The court stated that, because the United Kingdom did not provide a post-mortem right, there was nothing for her to pass on, and hence her successors could not enforce the right against third parties in the US.

8 What is protected under the right of publicity?

There is a broad range of protection among the laws of the different states. However, every state that recognises the right of publicity protects at least an individual's name and either his or her 'likeness' or 'picture'. The New York statute protects 'name, portrait, picture, or voice'; the California statute protects 'name, voice, signature, photograph, or likeness'; and California common law protects any aspect or combination of aspects of an individual's persona that serves to identify him or her. While broad, this protection is not limitless – a California court recently rejected house owners' publicity claim over the unauthorised use of pictures of their house, because they were unable to show that it was 'part of their identity', even though the design of the house was distinctive and unique. In a famous case the US Supreme Court held that an aerial performer's act, when broadcast in full, can be protected by the right. The state with the broadest statutory coverage is Indiana, whose statute protects 'name; voice; signature; photograph; image; likeness; distinctive appearance; gestures; or mannerisms'.

9 Is registration required for protection of the right? If so, what is the procedure and what are the fees for registration?

No state requires a living individual to register his or her right of publicity in order to obtain or maintain protection for it. A few states (California, Oklahoma, Texas and Nevada) require registration in order for the owners of a post-mortem right (typically the decedent's heirs) to fully exercise and enforce it.

Registration usually involves filing a form with the state's secretary of state and paying a nominal filing fee (eg, \$10 in California). Nevada's statute requires the successor-in-interest of a decedent's post-mortem right of publicity to register his or her ownership claim within six months of reasonably becoming aware of an unauthorised use of such right. California's and Oklahoma's statutes require the successor-in-interest to register his or her ownership claim in order to obtain monetary damages against an infringer, and such damages are not recoverable for any violation that occurs before registration (registration is not required, however, as a prerequisite to injunctive relief). Texas's statute only requires registration if the owner of the right elects to exercise it in the first year following the individual's death. Without such registration, the executor of the estate can exercise the right – notwithstanding the decedent's intent to have passed the right on to another party – and the true owner must wait until a year after death.

10 Does the existence, or the extent, of the right depend on where the individual lives or has lived?

For infringement claims based on the publicity rights of a living person, it is an open question as to which state's substantive law applies. The court may apply the law of its own state, or the law of the state where the alleged infringement occurred (if infringement occurred outside of the forum state), or the law of the rights owner's domicile (if different from the forum state and the 'infringement state'). The court's choice will depend upon the forum state's conflict of laws rules and a determination of which state has the most significant relationship to the lawsuit.

There is more consensus among the states in cases deciding whether a post-mortem right of publicity exists; most courts apply the law of the state in which the individual was domiciled at the time of death. However, two states (Indiana and Washington) have statutes recognising a right of publicity for a deceased individual regardless of where he or she was domiciled at the time of death. But these provisions have recently come under attack. In February 2011, a federal court in Washington state held that Washington's choice of law clause was unconstitutional because it applied Washington law when another state might have a greater interest in, or relationship to, the dispute. For this reason, the court ruled that the clause was 'arbitrary and unfair' and violated the US Constitution. The court expressed concern that the statute would lead to forum shopping, turning Washington into a national centre for right of publicity lawsuits regardless of an individual's connection to the state. While Indiana's statute was not at issue in the lawsuit, it could face the same challenge, and the Washington court's ruling could be cited as precedent. However, at this time, it is unclear how influential the Washington decision will be.

Ownership of right

11 Can the right be transferred? In what circumstances?

The right of publicity is a form of property that is freely alienable and can be assigned in gross. It is recommended that all assignments be memorialised in writing. The right is fully divisible, meaning that an assignment can be limited to specific components of the right. For example, an individual could theoretically assign the publicity right in his or her name to one party, and the publicity right in his or her likeness to another party.

In a similar vein, an individual could theoretically assign his or her entire publicity right to one party for exploitation in one state, and to another party for exploitation in another state. However, assigning the right of publicity to different parties on a geographic basis may be inconsistent with commercial realities, in that many commercial uses of the right involve exploitation on a nationwide basis. Moreover, to the extent that an individual considers his or her name, likeness and so forth to constitute trademarks, such multiple assignments may violate the 'single source' rule of trademark law.

12 Can the right be licensed? In what circumstances?

As with assignments, ownership of the right may be freely licensed, either exclusively or non-exclusively, and under any circumstances or commercial conditions that the parties agree upon. It is recommended that all licences be put in writing. Licensing different aspects of the right to different parties on a geographic basis raises the same issues as noted above with respect to assignments.

13 If the right is sold or licensed, who may sue for infringement?

Only the owner of the right, or an exclusive licensee, has standing to sue for infringement. The exclusive licensee only has standing to sue for an infringement of a right that is within the scope of its licence.

14 How long does protection of the right last?

Of those states that recognise the right of publicity, all provide that the right lasts at least throughout a person's lifetime. Many also recognise that the right exists after death (post-mortem rights). For a more detailed discussion on the post-mortem right of publicity, please see question 15.

15 Is the right protected after the individual's death? For how long? Must the right have been exercised while the individual was alive?

There is a split among the states on extending the right of publicity past death, although the clear trend is for recognition of a post-mortem right. The majority of states recognise a post-mortem right of publicity, although a few of those states have extra requirements. For example, Utah courts currently require the right to have been exercised during an individual's lifetime as a prerequisite to post-mortem protection. Tennessee's statute requires continuous exploitation of the post-mortem right for it to subsist beyond an initial 10-year term after an individual's death; two years of non-use results in a waiver of the right. This is akin to the 'abandonment' principle of trademark law.

The length of time for post-mortem protection varies widely, from 20 years under Virginia's statute to 100 years under the statutes of Indiana and Oklahoma, while Nebraska's statute states that the right 'survive[s] the death of the subject' but does not specify for how long. Tennessee's statute provides that the right continues indefinitely, provided (as noted above) there is continual exploitation after an initial 10-year term. California's statute provides for 70 years of post-mortem protection. Several states (Connecticut, Georgia, Michigan, New Jersey and Utah) recognise the post-mortem right through common law (ie, case law) without specifying a duration. New York is one of the few states that expressly rejects a post-mortem right of publicity. In 2010, legislation was introduced into the New York Senate, which would have recognised a 70-year post-mortem term. But this legislation was not enacted into law, and is no longer pending.

16 If post-mortem rights are recognised, who inherits the rights upon the individual's death? How is this determined?

Every state that recognises a post-mortem right allows the right to be transferred by contract, will or other testamentary instrument. For individuals who die intestate, each state has its own rules, although the majority of states apply their standard intestate succession rules, which vary but typically put the surviving spouse and children first in line. In California, the right of publicity statute establishes a specific order of succession. The surviving spouse or surviving issue (children or grandchildren) receives the entire right if either no spouse or no issue are alive, otherwise each receives one half of the right. Rights to the surviving issue are divided per stripes, in accordance with California estate law (this means that the surviving grandchildren of a deceased child split equally the share that the deceased child would have received). If there is no surviving spouse or issue, the deceased's right of publicity ceases to exist. There has been recent case law focusing on whether the right of publicity exists for an individual who died prior to enactment of his or her state of domicile's post-mortem statute, and if so, to whom the right passes. In response, California recently amended its statute to make clear that the right applies to such decedents and falls under the 'residuary rights' clause of a decedent's will. According to the amended statute, 'a provision in the testamentary instrument that provides for the disposition of the residue of the deceased personality's assets shall be effective to transfer the rights recognised under this section in accordance with the terms of that provision'.

17 Can the right be lost through the action or inaction of its owner?

The right cannot be lost while an individual is alive because no state currently requires that an individual's identity be commercialised. In other words, the right of publicity is not treated like a trademark, which, without commercialisation, can be lost through abandonment. Previously, courts in Ohio and Utah held that commercialisation (or at least a proven intrinsic value in an individual's persona) was a prerequisite to protection, but both states have since enacted statutes without this requirement. As described above, Utah's courts require exploitation before death for a post-mortem right to exist. Additionally, in Tennessee an individual's post-mortem right is lost if the individual's successor fails to exploit the right for two consecutive years (after an initial 10-year term of 'free', guaranteed protection).

18 What steps can right owners take to ensure their right is fully protected?

While an individual is alive, his or her right does not need protection beyond vigilance with respect to infringers, although residing in a state with broad publicity protection could help maximise enforcement power in the event a court chooses to apply substantive law from the individual's domiciliary state (see question 10). There is more that an individual can do to maximise his or her post-mortem rights for the benefit of his or her heirs. For example, an individual can reside in a state with a favourable post-mortem right of publicity, such as California or Indiana, which are recognised by commentators as having some of the broadest and most robust protections; and expressly address the right in his or her will. Additionally, the successor-in-interest to a post-mortem right of publicity can maximise protection by immediately registering his or her claim to the right, if the decedent resided in a state that requires such registration (see question 9).

Infringement**19** What constitutes infringement of the right?

The right of publicity is infringed when (i) an individual has a valid, enforceable right; (ii) one of the protected aspects of his or her persona is used, without the individual's permission, in a commercial context; and (iii) the individual suffers injury as a result. Some states also require proof that the unauthorised use of the identity or persona is likely to cause damage to its value. Infringement can occur even where the infringer does not use the individual's actual persona. Courts have found the use of 'sound-alikes' and 'look-alikes' in advertisements to be infringing where the fake persona identifies the individual. For example, in 1988, a federal court held that singer/actress Bette Midler's common law right of publicity was infringed when a car commercial used a sound-alike to mimic her singing voice on the soundtrack. In 1992, this same federal court held that television personality Vanna White's common law right of publicity was infringed when an electronics company's advertisement used the image of a robot bearing White's distinctive attributes. (This decision was subsequently criticised by commentators as an overly expansive interpretation of the right of publicity's scope.)

20 Is an intent to violate the right necessary for a finding of infringement?

No. However, knowledge by the infringer that his or her actions will identify the individual is often required for an award of punitive or exemplary damages.

21 Does secondary liability exist for the right? What actions incur such liability?

Only California case law has expressly recognised secondary liability for a violation of the right of publicity. No other state court has accepted or rejected it, and no state statute expressly recognises it. In

California, a court relied upon the Restatement (Second) of Torts to find a company secondarily liable for giving ‘substantial assistance’ to a direct violator of the right of publicity. In this case, the defendant controlled user accounts for a network of websites owned and run by third parties; maintained a code of conduct for the sites; and split user fees with the website owners. Some of the third-party sites used pictures of individuals who had assigned their rights of publicity to the plaintiff, and the plaintiff sued the defendant for secondary right of publicity liability.

Analogising to secondary liability under trademark and copyright law (ie, the defendant directly benefited financially from the infringement, and had the ability to control the content of the websites), the court preliminarily held that the plaintiff was likely to prevail. Passive distributors are protected by some state statutes and courts, such as in California, where by statute ‘the owners or employees of any medium used for advertising’ are not liable if an advertisement violates an individual’s right of publicity, unless they had ‘knowledge of the unauthorised use’ of the persona.

22 What defences exist to an infringement claim?

There are several common defences for infringement of the right of publicity:

Exempted behaviour

Most states with right of publicity statutes provide exemptions from liability for certain activities. For example, California’s statute has express exceptions for the unauthorised use of an individual’s name, likeness and so forth in connection with news, public affairs, sports broadcasts or accounts and political campaigns. New York’s statute does not contain express exceptions, but the statute only prohibits unauthorised uses for ‘advertising purposes or for the purposes of trade’, and therefore all other uses are exempted. ‘Purposes of trade’ can be a grey area; for example, it is generally accepted that the use of an individual’s name or likeness in a newspaper article is exempt, even though the newspaper publisher seeks to sell copies of the paper at a profit. Tennessee’s statute is even more limited, prohibiting only uses in advertisements or solicitations. A Tennessee federal court recently held that use of an individual’s image on a tabloid website did not constitute use in an advertisement or solicitation, even though the content was used to drive additional advertisement sales. And Wisconsin’s statute only prohibits the ‘unreasonable’ use of an individual’s identity. A recent Wisconsin case found that use of an individual’s name as a keyword for search engine advertising was not unreasonable. Several states expressly exempt use in ‘literary works’, a broad category that has been found by courts to encompass diverse works including video games. The California post-mortem statute expressly exempts the use of a deceased personality’s name, likeness and so forth in such First Amendment-protected works as plays, books, musical compositions, motion pictures and television programmes. To illustrate, under this exemption a movie studio could produce a new, fictional motion picture featuring such well-known deceased actors as James Dean, Marilyn Monroe or Humphrey Bogart (appearing through the use of look-alike performers or digital technology) and their estates would be powerless to stop it (at least with respect to exploitation of the motion picture in California). By contrast, California’s statute for living persons does not contain this exemption, indicating that the California legislature intended broader freedom for the unauthorised use of a deceased person’s publicity right than a living person’s.

First Amendment

Underlying many of the above statutory exemptions is the goal of balancing the interests of publicity right owners with the freedom of speech protected under the First Amendment of the US Constitution. But even independent of specific exemptions, the First Amendment is often asserted as a defence in right of publicity infringement

litigation. The defence is typically raised in cases where the individual’s identity is used, without permission, in such works as movies, television programmes, plays and books. In these cases, the defence is often successful, and the courts find the unauthorised use permissible. The courts apply a variety of tests to reach this result. One test (borrowed from copyright law) looks to whether the unauthorised use is ‘transformative’, in other words, that it results in new, significant, and independent creative elements beyond the individual’s identity. To illustrate, in 2003 a California court held that a comic book’s use of mutant characters who displayed several distinctive attributes of two blues musicians (brothers Johnny and Edgar Winter) was protected by the First Amendment because the comic books were expressive, transformative works. By contrast, in 2001 the same California court held that a t-shirt design that was simply a hand-drawn image of the movie comedy team ‘The Three Stooges’ was ‘little more than the appropriation of the celebrat[ies]’ economic value’, in other words, not transformative, and therefore a violation of the deceased comedians’ publicity rights. Another test (borrowed from trademark law) looks to whether the individual’s identity is relevant to the work in which it appears, and, if relevant, whether it nevertheless misleads consumers into thinking that the individual endorsed the work or was involved in its creation.

Federal copyright pre-emption

Due to the US Constitution’s supremacy clause, state laws that conflict with federal laws are pre-empted. In the right of publicity context, many defendants have claimed that various states’ right of publicity laws were pre-empted by federal intellectual property legislation, most notably the Copyright Act. The defence has occasionally been successful. For example, a California court held that where the right of publicity claim was based solely on an individual’s performance within a film, the claim was identical to one for copyright infringement, and therefore pre-empted by federal law. However, courts have generally not been sympathetic to this defence, either because the right of publicity is seen as containing an ‘extra element’ missing from copyright law (exploitation of an identifiable persona for advertising or trade purposes) or as not covering the same subject matter as copyright law (a person’s likeness versus a work of authorship). Therefore, while copyright ownership of a motion picture or sound recording allows the owner to exploit an artist’s performance in such film or sound recording, it does not give the owner the right to exploit the artist’s image or voice in advertising or trade.

Consent

If an individual has given express or implied consent to the commercial use of his or her identity, there can be no infringement. While this might seem obvious, several disputes have arisen on this question. For example, courts have recently dealt with several disputes involving social networks. Many social networks have broad terms of service that purport to allow them to exploit any content that an individual posts on the service. The owners of these social networks take the position that these service terms allow them to use aspects of members’ identities in advertisements for the social networks. Several members have challenged such usage in court, but no court has reached a final decision on this issue. In another case, a California court held that when an actress posed for pictures at a celebrity event, knowing that the photographers intended to sell the pictures, she implicitly gave her consent for thumbnail versions of the images to be advertised.

Delay

Right of publicity infringement claims are subject to the same standard defences as generally apply in American civil litigation, such as expiry of the statute of limitations or estoppel by laches, waiver or acquiescence. The length of the statute of limitations varies from state to state; in California it is two years, and in New York it is one year.

Remedies

23 What remedies are available to an owner of the right of publicity against an infringer? Are monetary damages available?

The plaintiff in a right of publicity case may seek compensatory damages, punitive or exemplary damages and injunctive relief (both preliminary and permanent). Some states (Indiana, Ohio, Tennessee and Washington) also allow the plaintiff to seek the destruction of infringing materials. Many, but not all, state courts have imposed injunctions that are nationwide in scope, even covering those jurisdictions that do not expressly recognise the right of publicity.

24 Is there a time limit for seeking remedies?

Yes, a claim for infringement of the right of publicity must be brought in a court within the applicable statute of limitations period. The defence of estoppel by laches (ie, delay that prejudices the defendant) may also apply (see question 22).

25 Are attorneys' fees and costs available? In what circumstances?

Some states allow attorneys' fees to be recovered, but it varies by state. In California, the statute specifies: 'The prevailing party or parties in any action under this section shall also be entitled to attorneys' fees and costs.' New York State law generally does not allow courts to award attorneys' fees. Thus, absent express recognition by statute, the general 'American Rule' applies (ie, each party, including the prevailing party, must pay its own attorneys' fees).

26 Are punitive damages available? If so, under what conditions?

Yes, most states allow for punitive damages in egregious cases such as when the defendant's actions were done with knowledge that such actions were infringing or in reckless disregard of the individual's publicity rights. The egregiousness may be found through, for example, fraud, premeditation, 'conscious disregard' of the owner's rights or failure to check whether the plaintiff had expressly authorised any use of his or her image. It may also include continuation of the infringing actions after receiving a cease-and-desist letter from the owner of the publicity right. In New York, punitive damages are available when the defendant 'knowingly used' the plaintiff's identity. California's statute merely states that courts 'may' award punitive damages; according to the California Civil Code, such an award requires a finding of 'oppression, fraud or malice'.

27 What significant judgments have recently been awarded for infringement of the right?

When determining compensatory damages awards, courts often try to determine the fair market value of the identity or persona that was appropriated. Sample judgments include the following:

- in 1986, the Beatles were awarded US\$5.6 million in damages from a company that had produced three years of near-constant live stage shows imitating the Beatles' likenesses and sound. The court applied a 12.5 per cent royalty rate to the show's gross income to arrive at the damages amount;
- as noted in question 19, in 1988 singer/actress Bette Midler was awarded US\$400,000 in damages after an automobile company used a singer who imitated her voice in a television commercial;
- in 1992, singer Tom Waits was awarded US\$375,000 in compensatory damages and US\$2 million in punitive damages after a radio commercial for potato chips featured a singer who imitated his voice;
- in 1998, a court awarded US\$40,000 in compensatory and exemplary damages to Dr K J Yesudas, a famous singer from India, for the distribution of pirated and low-quality audio tapes that displayed his name and picture on the tape packaging; and

- in 2006, a professional model was awarded US\$25,000 in damages after her photos were used in advertising despite the photographer having signed an agreement that expressly forbade their use for commercial purposes.

Litigation

28 In what forum are right of publicity infringement proceedings held?

Right of publicity infringement proceedings are held in American civil courts. The plaintiff chooses the state in whose court the lawsuit is brought. The case will remain there unless it is dismissed or transferred for a procedural reason (eg, lack of personal jurisdiction over the defendant). As described in more detail in question 10, which state's substantive law will apply to an infringement litigation is a complex question with no settled answer.

Because right of publicity claims are state law claims, they are typically brought in state courts. However, such claims may instead be brought in federal court if certain jurisdictional requirements are met, such as the presence of other (ie, federal) claims in the action or, alternatively, if 'diversity jurisdiction' is met (this requires the parties to be citizens of different states or non-US citizens, and the controversy to involve more than US\$75,000). In infringement lawsuits involving celebrities' rights of publicity, it is common for the celebrity (or, if such celebrity is deceased, his or her estate or heirs) to also assert that the unauthorised use constitutes unfair competition, false advertising, trademark infringement or a combination thereof. Because federal courts have jurisdiction over these latter claims, such additional allegations give the federal court jurisdiction over the entire case, including the right of publicity claim. Plaintiffs generally tend to prefer litigating in the federal courts if jurisdiction is available.

29 Are disputed issues decided by a judge or a jury?

A case is decided by a judge unless either party elects to have it decided by a jury. If such an election is made, the jury will decide all questions of fact, while questions of law shall still be decided by the judge. Individuals (as opposed to corporations) typically elect to have their cases heard by a jury, especially when the adverse party is a large corporation, because parties tend to view juries as being more sympathetic to individuals.

30 To what extent are courts willing to consider, or bound by, the opinions of other national or foreign courts that have handed down decisions in similar cases?

A court follows its own prior decisions under the doctrine of 'precedent'. A court is only bound by the rulings of a higher court in whose jurisdiction it sits. The final arbiter of state laws (such as right of publicity laws) is the state's highest court, not the US Supreme Court, which is a federal court. If the parties are litigating a right of publicity infringement case in federal court due to the existence of federal jurisdiction (see question 28), the federal court will look to state court decisions for guidance in interpreting a state right of publicity statute. If there is no state court decision on point, it can ask the state's highest court for assistance in addressing the question. This procedure is called 'certifying' the question to the state's highest court. Both state and federal courts will look to court decisions of other jurisdictions for guidance if there is no relevant decision in their own jurisdiction on the question at issue. However, the courts are not bound by these out-of-jurisdiction decisions. Recently, a few American courts have looked to the court decisions of other countries for guidance, although this practice is controversial.

31 Is preliminary relief available? If so, what preliminary measures are available and under what conditions?

Yes, a court may grant a preliminary injunction. While the standards for preliminary injunctions may vary from state to state, generally a court will grant relief based upon an evaluation of such factors as:

- whether the plaintiff will suffer irreparable injury if the injunctive relief is not granted;
- the plaintiff's likelihood of success on the merits;
- whether the plaintiff could be compensated through other remedies, such as monetary damages;
- a balance of the hardships between the parties if the preliminary injunction is granted versus if it is denied; and
- how the preliminary injunction will affect the public interest.

If the plaintiff obtains a preliminary injunction, he or she will likely be required to post a bond that may be forfeited to the defendant if the court later finds (following trial) that the preliminary injunction was wrongly granted.

32 What avenues of appeal are available in main proceedings or preliminary injunction proceedings? Under what conditions?

The losing party may appeal a trial court's decision, either after the final judgment or after a preliminary injunction ruling, through the standard appeal procedures of the court system in which the case was heard. In the various states, this typically consists of one intermediate appellate court and a final court of highest jurisdiction. The federal system follows this same structure and the court of highest jurisdiction is the US Supreme Court. Generally, the court of highest jurisdiction is not obligated to consider an appeal (ie, it has the discretion to decline to hear the case). Generally, appellate courts at any level will only overturn a trial court's factual findings when such findings were 'clearly erroneous', while findings of law are reviewed on a de novo basis.

33 What is the average cost and time frame for a first instance decision, for a preliminary injunction, and for appeal proceedings?

It varies greatly, but a right of publicity proceeding can cost at least several hundred thousand dollars and take more than a year, if pursued through trial. A substantial portion of the total is likely to consist of discovery costs, given the expansive discovery permitted under the American court system. A preliminary injunction proceeding might cost US\$100,000, especially if the court allows expedited discovery and hears live witness testimony, which in effect converts the proceeding into a 'mini-trial'. A preliminary injunction hearing can take place within a few weeks or a few months after the case is filed and typically lasts a few days. An appeal proceeding might cost US\$50,000 to US\$100,000, and might take up to a year following the trial court's decision.

These estimates are very rough approximations because the actual costs and time frames are highly contingent on the facts and issues involved in the case and on the courts' schedules.

Chart of states that recognise the right of publicity†

State	Principal legal source	Post-mortem protection
Alabama	Common law	
Arizona	Common law	
California	Common law; additional state statute	70 years after death
Connecticut	Common law	Yes, but of uncertain duration
Florida	Common law; additional state statute	40 years after death
Georgia	Common law	Yes, but of uncertain duration
Hawaii	Common law	
Illinois	Common law; additional state statute	50 years after death
Indiana	State statute	100 years after death
Kentucky	Common law; additional state statute	50 years after death
Louisiana	No civil law, but criminal statute prohibits violation of a soldier's right of publicity	Uncertain duration
Massachusetts	State statute	
Michigan	Common law	Yes, but of uncertain duration
Minnesota	Common law	
Missouri	Common law	
Nebraska	State statute (common law rejected)	Yes, but of uncertain duration
Nevada	State statute	50 years after death
New Hampshire	Common law	
New Jersey	Common law	Yes, but of uncertain duration
New York	State statute (common law rejected)	None

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Ohio	Common law; additional state statute	60 years after death
Oklahoma	State statute	100 years after death
Pennsylvania	Common law; additional state statute	30 years after death
Rhode Island	State statute	
Tennessee	State statute	10 years as a right; indefinite with continual exploitation
Texas	Common law; additional state statute	50 years after death
Utah	Common law; additional state statute	Yes, but of uncertain duration
Virginia	State statute	20 years after death
Washington	State statute	10 years if identity has no 'commercial value'; 75 years if it does
West Virginia	Common law	
Wisconsin	Common law; additional state statute	None
<p>The following states have yet to consider the right of publicity: Alaska; Arkansas; Colorado; Delaware; Idaho; Iowa; Kansas; Maine; Maryland; Mississippi; Montana; New Mexico; North Carolina; North Dakota; Oregon; South Carolina; South Dakota; Vermont, Wyoming.</p>		

† *Gaps in the chart indicate where neither state laws nor court opinions have addressed the issue.*

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