

## COMEDY III PRODUCTIONS, INC. V. NEW LINE CINEMA

By Jennifer A. Lee

Popular and artistic culture does not exist in a vacuum. Music, film, books, and art all build upon what has preceded them. As Judge Alex Kozinski wrote, “Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the work of those who came before.”<sup>1</sup> Aside from this inevitable dependence, creators of artistic works often deliberately choose to incorporate portions of earlier works in reference, tribute, or parody.

Artists and authors are not free to use previous works with impunity, however. Copyright law protects artistic works by granting the creator a monopoly, limited in both duration and scope. The law strikes a bargain between the creator and the public; the creator can control his work for a certain period of time, after which the public is granted free access to it.<sup>2</sup> This temporary monopoly is often extremely lucrative to the party who owns it. It is, therefore, no surprise that many attempt to claim or extend it by replacing an expired copyright with some other form of intellectual property protection. One common tactic is to claim a trademark right in the work itself. Another is to assert a right of publicity as an heir or assignee of the artist who created the work.

The plaintiff in *Comedy III Productions, Inc. v. New Line Cinema*<sup>3</sup> attempted both when the defendant, a motion picture production company, incorporated a Three Stooges film clip into the background of a scene in a new movie.<sup>4</sup> The Ninth Circuit rejected Comedy III’s trademark infringement claim<sup>5</sup> and refused to acknowledge Comedy III’s right of publicity

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1. White v. Samsung Elecs. of Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting).

2. See Merriam v. Holloway Publ’g Co., 43 F. 450, 451 (E.D. Mo. 1890) (“The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book.”).

3. 200 F.3d 593 (9th Cir. 2000).

4. Appellant Comedy III Productions, Inc.’s Opening Brief at 5, Comedy III Prods., Inc. v. New Line Cinema, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301).

5. *Comedy III*, 200 F.3d at 596.

claim simply by failing to discuss it.<sup>6</sup> Unfortunately, the court's brief and conclusory opinion both misstates a key point of trademark law and fails to sufficiently explain the legal rationale for its decision. As such, both the finality of the decision and its strength as precedent are questionable. This Note fills in the gaps left by the court's analysis by exploring, in more detail and clarity than presented by the court, some of the theories by which its decision may be upheld.

## I. BACKGROUND

This section begins with an overview and comparison of copyrights and trademarks, the two areas of law which form the major foundation of the Ninth Circuit's opinion in *Comedy III*. The section then turns to a brief introduction to the right of publicity, which, although absent from the court's opinion, forms a major component of the parties' arguments.<sup>7</sup> It concludes with a discussion of the potential conflicts that may arise between trademarks or rights of publicity and First Amendment free speech rights.

### A. The Rationale and Limits of Copyright Law

Copyright law is rooted in the United States Constitution, which authorizes Congress to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries."<sup>8</sup> This directive sets out both the purpose and the means of copyright protection and hints at its underlying tensions. The government seeks to give artists and authors sufficient incentive to create their works by granting them copyrights which enable them to profit from those works.<sup>9</sup> However, these private interests clash with the public's free access to creative works. The Copyright Act<sup>10</sup> attempts to balance these conflicting interests, in part by providing for the expiration of copyrights after 70 years.<sup>11</sup>

The balance between the author's interest in protecting her work and the public's interest in using that work freely is therefore not static. In-

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6. See *id.* at 593-96.

7. See *infra* notes 108-109 and accompanying text.

8. U.S. CONST. art. I, § 8, cl. 8.

9. 1 NIMMER ON COPYRIGHT § 1.10[B][1] (release no. 51, May 2000).

10. 17 U.S.C. §§ 101-1101 (1994).

11. The 1976 Copyright Act created a term of 50 years after the death of the author. 17 U.S.C. § 302(a) (1994). The 1998 Sonny Bono Copyright Term Extension Act added an additional 20 years to the basic term. Act of Oct. 27, 1998, Pub. L. 105-298, Title I, 112 Stat. 2827 (codified at 17 U.S.C.A. § 302 (1994 & West Supp. 1999)).

stead, it shifts dynamically as time progresses. During the author's lifetime, and for some time after, the law favors the author's rights to control her work. However, as time goes by, this interest diminishes until, at last, the copyright expires. From that point on, the public's interest prevails.

## B. Trademark Law and the Focus on Consumer Perceptions

Trademarks serve as shortcuts in consumer culture by allowing consumers to make assumptions about the quality or source of goods and services represented by familiar marks. Trademark law protects consumers from fraud.<sup>12</sup> If a seller uses a mark identical or similar to another, consumers may mistakenly purchase the wrong product.<sup>13</sup> Trademark law also protects sellers and manufacturers from losing profits by preventing competitors from unfairly capitalizing on their consumer goodwill and brand-name recognition.<sup>14</sup>

Classic trademark infringement involves "palming off," in which one seller intentionally tries to divert the customers and profits of another by selling a similar product under a similar trademark.<sup>15</sup> Federal law guards against palming off through section 43(a) of the Lanham Act.<sup>16</sup> Standard trademark infringement analysis consists of two prongs: ownership of a valid mark and infringement.<sup>17</sup> Whether the plaintiff owns a valid mark depends in part on the mark's level of "distinctiveness." The level of distinctiveness, in turn, determines both what proof is necessary to show the mark deserves legal protection and the breadth of that protection.<sup>18</sup> To

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12. Joseph P. Bauer, *A Federal Law of Unfair Competition: What Should Be the Reach of Section 43(a) of the Lanham Act?*, 31 UCLA L. REV. 671, 705 (1984).

13. *Id.* at 705.

14. 1 MCCARTHY ON TRADEMARKS § 2:31 (4th ed. 1998).

15. See 4 MCCARTHY § 25:1.

16. Lanham Trade-Mark Act (Trade-Mark Act of 1946) § 43(a), 15 U.S.C. § 1125(a) (1994). Section 43(a) focuses solely on defendants engaged in commercial activities. For example, section 43(a)(1)(A) is limited to those who use a mark in commerce. *Id.* § 1125(a)(1)(A). Likewise, section 43(a)(1)(B) concerns only false sponsorship or endorsement "in commercial advertising or promotion." *Id.* § 1125(a)(1)(B). This emphasis reflects the commercial nature of both trademarks themselves and the reasons for protecting them. The Ninth Circuit has interpreted section 43(a) as extending to the right of publicity. *See White v. Samsung Elecs. of Am., Inc.*, 971 F.2d 1395, 1399-1400 (9th Cir. 1992). The right of publicity is discussed in more detail in Parts I.C. and III.B, *infra*.

17. 2 MCCARTHY, *supra* note 14, § 15:1.

18. *See id.* Mark distinctiveness is arrayed along a spectrum comprised of four categories. In order of least to most distinctive, these categories are: (1) generic marks, (2) descriptive marks, (3) suggestive marks, and (4) arbitrary or fanciful marks. *Id.* § 11:2. Arbitrary or fanciful marks are considered inherently distinctive, for they lack natural association with any product. *Id.* Some examples of well-known arbitrary or fanciful

prove the second prong of trademark analysis, infringement, the plaintiff must show a likelihood of consumer confusion.<sup>19</sup>

### C. The Right of Publicity: A New Form of Personal Property

The right of publicity is the “inherent right of every human being to control the commercial use of his or her identity.”<sup>20</sup> The origins of the right of publicity lie within the older right of privacy.<sup>21</sup> However, while the right of privacy protects an individual’s dignity and self-esteem, the right of publicity concerns an individual’s property right in her own identity or persona.<sup>22</sup> The concept of a right of publicity as a free-standing form of intellectual property is relatively new. Judge Frank of the Second Circuit first coined the term “right of publicity” in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>23</sup> Currently, fifteen states have

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marks are “Tide” (laundry detergent), “Tiffany & Co.” (jewelry), and “Tupperware” (food containers). They carry the highest degree of protection and the lowest standard of proof—a party may claim rights in an arbitrary or fanciful mark simply by proving it was the first to use the mark. See ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 578 (2d ed. 2000). By contrast, a descriptive mark, which describes some characteristic of a product, could theoretically apply to any product with a similar property. Therefore, a person cannot acquire rights in a descriptive mark unless it possesses sufficient secondary meaning such that consumers recognize the product sold under that mark as originating from a single source. *Id.* Examples of descriptive marks that are valid trademarks include “Softsoap” and “Holiday Inn.”

19. See 2 MCCARTHY, *supra* note 14, § 15:1. Proof of actual consumer confusion is not required. This distinction both lessens the plaintiff’s burden of proof and eliminates frivolous claims against clearly ridiculous or exaggerated appropriations of marks. See Alison P. Howard, *A Fistful of Lawsuits: The Press, the First Amendment, and Section 43(a) of the Lanham Act*, 88 CALIF. L. REV. 127, 135-36 (2000). The Ninth Circuit advanced the now-standard test for likelihood in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

20. 4 MCCARTHY, *supra* note 14, § 28:1.

21. *Id.* § 28:5. The legal concept known as the right of privacy was created in a landmark law review article. See Charles Warren & Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

22. 4 MCCARTHY, *supra* note 14, § 28:6. For a more detailed discussion of the background and history behind the right of publicity, see Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control*, 45 U. KAN. L. REV. 329 (1997).

23. 202 F.2d 866, 868 (2d Cir. 1953). Melville B. Nimmer followed up shortly after with the first in-depth analysis of this new right. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

right of publicity statutes.<sup>24</sup> Seventeen recognize a common law right of publicity.<sup>25</sup>

A right of publicity claim is specific to the plaintiff asserting it, or to that person's assignee.<sup>26</sup> To prevail, the plaintiff must show that the defendant, without permission, used the plaintiff's identity in a manner likely to damage its commercial value.<sup>27</sup> For example, actor Paul Newman markets and sells a line of food products under the name "Newman's Own." Each Newman's Own product bears a picture or likeness of Newman on its label. Since Paul Newman's identity is a key marketing tool for Newman's Own products, Newman could assert that an unauthorized use of his likeness damages his ability to use his identity in a commercial fashion. This proof requirement resembles trademark's likelihood of confusion standard.<sup>28</sup> Right of publicity also draws the same commercial/noncommercial distinction as trademark:<sup>29</sup> only commercial uses constitute violations of the right.<sup>30</sup>

#### D. Comparison of Trademark and Copyright Law

The contrasting policy goals of copyright and trademark law create several doctrinal differences. The most obvious is duration: copyright protection lasts for a certain term of years, whereas trademark protection is potentially infinite.<sup>31</sup> Another difference lies in the required showing for infringement. Trademark infringement occurs only when it is likely that

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24. California, Florida, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Texas, Virginia, Washington, and Wisconsin.

4 MCCARTHY, *supra* note 14, § 28:17 n.1.

25. Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin. *Id.* § 28:16. California's statutory right of publicity is contained in California Civil Code sections 3344 and 3344.1. CAL. CIV. CODE §§ 3344, 3344.1 (West 2000).

26. 4 MCCARTHY, *supra* note 14, § 28:7. *See, e.g.*, CAL. CIV. CODE § 3344.1(a)(1) (West 2000) (imposing liability on any person who uses another's identity "without such person's prior consent"); *id.* § 3344.1(b) (allowing for the free transfer of publicity rights); *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (referring to damages under a common law right of publicity claim for unauthorized appropriations of a *plaintiff's* identity).

27. 4 MCCARTHY, *supra* note 14, § 28:7.

28. *See supra* Part I.B.

29. *See supra* note 16.

30. *See Langvardt, supra* note 22, at 343. For example, California Civil Code section 3344 applies only to use of another's persona "for advertising or selling or soliciting purposes." CAL. CIV. CODE § 3344(a) (West 2000). Similarly, California Civil Code section 3344.1 only pertains to uses "on or in products, merchandise, or goods, or for purposes of advertising or selling." CAL. CIV. CODE § 3344.1(a)(1) (West 2000).

31. *See 1 MCCARTHY, supra* note 14, § 6:31.

consumers will be confused about the sponsorship or origin of a product.<sup>32</sup> Copyright infringement, however, occurs whenever a party violates any one of the exclusive rights set out in 17 U.S.C. § 106.<sup>33</sup> Therefore, simply copying a work may infringe a copyright; however, simply copying a trademark is not *per se* infringement of that mark.<sup>34</sup>

These differences do not, however, make copyright and trademark mutually exclusive. A single work may meet the separate requirements of each. For example, a picture of an individual falls within section 102 of the Copyright Act;<sup>35</sup> however, it may also serve as a mark identifying a good or a service.<sup>36</sup> This dual nature makes it possible, in a single act, to simultaneously violate both the copyright and trademark rights that adhere to a single object.<sup>37</sup>

## E. The Tension between Intellectual Property Rights and the First Amendment

Copyright, trademark, and publicity rights exist in constant tension with the First Amendment right to free speech.<sup>38</sup> The monopolies granted by these intellectual property rights greatly restrain the public's ability to use artistic works or marks freely. Accordingly, many intellectual property statutes incorporate trade-offs that attempt to balance these conflicting interests. For example, copyright expires in time, and trademarks are restricted to commercial use.<sup>39</sup>

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32. See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) ("A trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his.").

33. 17 U.S.C. § 106 (1994). The copyright owner has the exclusive right to reproduce, distribute, perform, display and prepare derivative works based upon the copyrighted work. *Id.*

34. See *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 218 (D. Md. 1988) ("Unlike a copyright, mere reproduction of a trademark is not an infringement.").

35. 17 U.S.C. § 102(a)(5) (1994).

36. 1 MCCARTHY, *supra* note 14, § 6:14. For example, each illustration of Paul Newman's face on a Newman's Own product is copyrightable as an original creative work. However, these illustrations are also the marks that identify Newman's Own products.

37. See *Nintendo of Am., Inc. v. Dragon Pac. Int'l*, 40 F.3d 1007 (9th Cir. 1994) (awarding plaintiff both copyright and trademark statutory damages for defendant's unauthorized marketing and sale of video game cartridges). For example, one could violate both copyright and trademark rights by affixing a picture of Paul Newman to a generic jar of spaghetti sauce.

38. See 2 SMOLLA AND NIMMER ON FREEDOM OF SPEECH § 21:2 (3d ed. 1996) ("[C]opyright and the First Amendment, held 'side by side,' may, in fact, be contradictory.").

39. See *supra* Part I.A-B.

The First Amendment also protects some uses of intellectual property that might otherwise infringe.<sup>40</sup> For example, trademarks may be used without permission from the owner if the use is merely nominative—that is, where consumer confusion is unlikely because a mark is only used to denote the *plaintiff's* goods or services.<sup>41</sup> In *New Kids on the Block v. News America Publishing, Inc.*, the Ninth Circuit found no trademark infringement where two national newspapers conducted telephone polls asking readers to name their favorite member of a popular singing group.<sup>42</sup> In refusing to hold the newspapers liable, the court concluded that since the defendants had not implied that the New Kids had sponsored or endorsed their polls, they were entitled to a fair use defense.<sup>43</sup> Moreover, the court noted that “it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark.”<sup>44</sup>

An even stronger free speech flavor underlies the protection of trademark parodies. In *L.L. Bean v. Drake Publishers*, the defendant published a short magazine humor article that parodied the plaintiff's well-known mail-order catalog.<sup>45</sup> In defending the magazine article as a form of expression protected by the First Amendment, the court cast free speech protection in generous terms to include even parodies that conveyed relatively trivial messages such as the reminder “that we are free to laugh at the images and associations linked with the mark.”<sup>46</sup>

The Supreme Court has considered the conflict between the right of publicity and the First Amendment only once. In *Zacchini v. Scripps-Howard Broadcasting Co.*,<sup>47</sup> a human cannonball performer sued a news station for filming and broadcasting his circus act in violation of publicity rights. The Supreme Court denied the defendant's First Amendment defense and held that the plaintiff possessed a valid right of publicity.<sup>48</sup>

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40. For example, certain uses of trademarks, even though they may impose on the mark owner's rights to some extent, are allowed by the First Amendment in the interest of having an informed public. 2 SMOLLA AND NIMMER, *supra* note 38, § 21:5.

41. See 2 MCCARTHY, *supra* note 14, § 15:1.

42. 971 F.2d 302, 309 (9th Cir. 1992).

43. *Id.* at 309. The trademark fair use defense is superficially similar but conceptually distinct from the copyright fair use defense.

44. *Id.* at 306.

45. 811 F.2d 26, 27 (1st Cir. 1987).

46. *Id.* at 34.

47. 433 U.S. 562, 564 (1977).

48. See *id.* In noting that “[p]etitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it,” the Supreme Court emphasized the personal property nature of publicity rights. *Id.* at 578.

Free speech/intellectual property inquiries often turn on whether the use at issue is commercial.<sup>49</sup> For example, trademark uses may be considered either “commercial” or “expressive.”<sup>50</sup> Commercial uses promote or otherwise imply sponsorship of a product; expressive uses, on the other hand, merely convey information or opinion.<sup>51</sup> The two categories are not mutually exclusive. Newspapers, for example, contain elements of both: the articles disseminate information to the public, but they also entice consumers to buy the newspaper.<sup>52</sup> Generally, the more expressive the use is, the more likely it will be found worthy of First Amendment protection.<sup>53</sup> In cases where a use is primarily expressive, it is usually said that the interest in having an informed and enlightened public outweighs the intellectual property rights of an individual.<sup>54</sup>

## II. CASE SUMMARY

### A. Facts and Procedural History

New Line Cinema released the motion picture *The Long Kiss Goodnight* in 1996. In one scene, the heroine of the film, played by Geena Davis, talks to her former boss on the telephone. While they are speaking, a television in the background plays a short clip of The Three Stooges movie *Disorder in the Court*.<sup>55</sup>

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49. *L.L. Bean*, 811 F.2d at 32. For example, in copyright cases, whether a use was commercial is often of paramount importance to an assertion of fair use. *See, e.g.*, Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985) (“The fact that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use.”). Unlike copyrights, patents do not give rise to free speech issues. *See* 1 NIMMER, *supra* note 9, § 1.10[C][2].

50. *See* 2 SMOLLA AND NIMMER, *supra* note 38, § 21:5. Where publicity rights are concerned, this distinction is recast as “commercial” versus “communicative” uses. *See* 4 McCARTHY, *supra* note 14, § 28:41.

51. *See* 2 SMOLLA AND NIMMER, *supra* note 38, § 21:5.

52. *See* 4 McCARTHY, *supra* note 14, § 28:41.

53. *See id.*; cf. S.F. Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522, 536 (1987) (upholding the United States Olympic Committee’s congressionally-granted monopoly over the use of the word “Olympic,” in part because it did not prohibit expressive uses by other parties). *But see* New Kids on the Block v. News Am. Publ’g, 971 F.2d 302, 309 (9th Cir. 1992) (“Where, as here, the use does not imply sponsorship or endorsement, the fact that it is carried on for profit and in competition with the trademark holder’s business is beside the point.”).

54. *See, e.g.*, 4 McCARTHY, *supra* note 14, § 28:41.

55. Comedy III Prods., Inc. v. New Line Cinema, 46 U.S.P.Q.2d 1930, 1935 n.3 (C.D. Cal. 1998); *see also* THE LONG KISS GOODNIGHT (New Line Productions 1996).

Comedy III Productions claims to be the exclusive owner of all "rights, title, and interest" in *The Three Stooges*.<sup>56</sup> Shortly after the release of *The Long Kiss Goodnight*, Comedy III filed a complaint against New Line in California state court for violations of Lanham Act section 43(a)<sup>57</sup> and state unfair competition law.<sup>58</sup> New Line removed the suit to federal court<sup>59</sup> and filed a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6).<sup>60</sup> Following oral argument, the district court granted New Line's motion, giving Comedy III leave to amend. Comedy III amended its complaint to add two new claims: (1) damages for unfair competition—passing off, and (2) damages for unfair competition—misappropriation.<sup>61</sup> New Line again filed a Rule 12(b)(6) motion to dismiss. After issuing a request for Comedy III to articulate how it owned a valid trademark that would allow the relief it sought, the court dismissed Comedy III's complaint with prejudice.

## B. The Ninth Circuit's Decision

The Ninth Circuit affirmed the district court's dismissal of Comedy III's claim. In applying the standard two-prong trademark infringement analysis,<sup>62</sup> the court emphasized that the central issue was whether Comedy III could claim a valid trademark right in *The Three Stooges*' clip.<sup>63</sup> Comedy III insisted that it claimed a right, not in the clip of *Disorder in the Court* itself, but in the name, likeness, and overall act of The Three Stooges.<sup>64</sup> The court refused to accept this distinction, concluding that Comedy III's claim could not be separated from a claim in the film footage itself, which falls within the scope of the federal Copyright Act, not

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56. *Id.* at 1931. Comedy III Productions was formed in 1959 by Moe Howard, Larry Fine, and Curly Joe DeRita, three of the six actors who played The Three Stooges over the decades. Appellant Comedy III Productions, Inc.'s Opening Brief at 3, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301); *The Three Stooges Official Website*, at <http://www.threestooges.com/bios/curlyjoe.htm> (last visited Jan. 30, 2001).

57. Lanham Trade-Mark Act (Trade-Mark Act of 1946) § 43(a), 15 U.S.C. § 1125(a) (1994).

58. *Comedy III*, 46 U.S.P.Q.2d at 1930.

59. 15 U.S.C. § 1121(a) grants original jurisdiction to federal district courts over all actions arising under the Lanham Act. 15 U.S.C. § 1121(a) (1994).

60. Rule 12(b)(6) allows a defendant to assert that the plaintiff has failed to state a claim upon which relief can be granted. FED. R. CIV. P. 12(b)(6).

61. *Comedy III*, 46 U.S.P.Q.2d at 1930.

62. See *supra* Part I.B.

63. *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 594-95 (9th Cir. 2000).

64. *Id.* at 595.

the Lanham Act.<sup>65</sup> Since it had failed to find a valid trademark, the court did not reach the issue of infringement.<sup>66</sup>

The court did not explicitly address Comedy III's common law right of publicity claim, but it did distinguish numerous cases cited by Comedy III in support of its Lanham Act misappropriation claim. In *White v. Samsung Electronics America, Inc.*, the Ninth Circuit construed the Lanham Act to protect against the use of a celebrity's likeness in a television advertisement for electronic products.<sup>67</sup> Similarly, in *Wendt v. Host International, Inc.*, the Ninth Circuit held that the unauthorized replication of a celebrity's likeness in animatronic robots violated the Lanham Act.<sup>68</sup> In addition, *Waits v. Frito-Lay, Inc.* interpreted the Lanham Act as guarding against the unauthorized simulation of an individual's distinctive voice.<sup>69</sup> The court distinguished New Line's use of the *Disorder in the Court* clip from these cases by concluding that it was neither a simulation of an aspect of The Three Stooges, nor a use whose purpose was to sell a product.<sup>70</sup>

Only one case cited by Comedy III, *In re Florida Cypress Gardens, Inc.*, addressed Lanham Act protection of an act performed by a character.<sup>71</sup> However, that case involved use of the act's name, not the act itself. The court distinguished *Florida Cypress* because New Line had not used The Three Stooges' name in its film or marketing.<sup>72</sup>

The Ninth Circuit concluded that Comedy III's "fanciful argument" would unjustifiably extend Lanham Act protection to an entirely new context.<sup>73</sup> While it noted that Comedy III's claim would have been stronger were it seeking to enjoin the sale of The Three Stooges' likenesses on T-

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65. A copyright claim to the clip itself is clearly moot since the copyright to *Disorder in the Court* has long since expired. *See id.*

66. The court rejected Comedy III's argument that New Line's failure to pay Comedy III a fee, coupled with the fact that others had done so, provided evidence of trademark infringement. *See id.* Persons or companies may issue licenses to public domain works, not because they own any intellectual property rights, but because they own a work, or a copy of a work, which is rare or difficult to obtain. It is common practice in the movie industry to purchase licenses for such works simply for the sake of convenience.

67. 971 F.2d 1395, 1396, 1401 (9th Cir. 1992).

68. 125 F.3d 806, 808-09 (9th Cir. 1997).

69. 978 F.2d 1093, 1096 (9th Cir. 1992).

70. *See Comedy III*, 200 F.3d at 596.

71. 208 U.S.P.Q. 288 (1980).

72. *Comedy III*, 200 F.3d at 596.

73. *Id.* at 595-96.

shirts,<sup>74</sup> the court refused to “entertain this expedition of trademark protection squarely into the dominion of copyright law.”<sup>75</sup>

### III. DISCUSSION

*Comedy III Productions, Inc. v. New Line Cinema* significantly limits the scope of trademark law. Of particular note is the Ninth Circuit’s decision to uphold the dismissal of Comedy III’s claim on the pleadings under Rule 12(b)(6).<sup>76</sup> Rule 12(b)(6) is a tool of enormous potential for civil defendants, for it can halt a suit at the earliest stage, saving the parties from costly and time-consuming discovery as well as the need to conduct a trial.<sup>77</sup> Because of this rule’s power and finality, the hurdle it sets is very low and is generally easy for plaintiffs to overcome.<sup>78</sup> Courts give plaintiffs every benefit of the doubt when considering a motion for dismissal by reading the material allegations of a complaint as favorably to them as possible, within reasonable limits.<sup>79</sup> As a result, only the weakest and most poorly drafted claims fail to clear the Rule 12(b)(6) bar.<sup>80</sup> By failing to fully explain its reasoning, the *Comedy III* court missed an opportunity to make a strong statement against similarly “fanciful” claims.<sup>81</sup>

The following discussion attempts to fill in the gaps left by the court’s abbreviated opinion by presenting a cohesive view of why the law does not allow claims such as Comedy III’s. Section A explains how, even

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74. *Id.* at 595. The court was likely making an oblique reference to *Comedy III Productions, Inc. v. Saderup, Inc.*, a case in which Comedy III sued an artist who made charcoal sketches of The Three Stooges and sold them on T-shirts. The case was accepted for review by the California Supreme Court. *Comedy III Prods., Inc. v. Saderup, Inc.*, 83 Cal. Rptr. 2d 533 (Cal. 1999) (unpublished opinion).

75. *Comedy III*, 200 F.3d at 596.

76. *Id.*

77. See Constance M. Boland & Lesley Szanto Friedman, *Motions to Dismiss Under FRCP 12(b): Strategy and Tactics*, 633 PLI/LIT 17, 19 (2000). Federal Rule of Civil Procedure 12(b)(6) allows for dismissal if the plaintiff fails to state a claim upon which relief can be granted. FED. R. CIV. P. 12(b)(6).

78. See *Duncan v. AT&T Communications, Inc.*, 668 F. Supp. 232, 234 (S.D.N.Y. 1987) (giving examples of claims which may be dismissed under Rule 12(b)(6), such as those “so poorly composed as to be functionally illegible” or “baldly conclusory”). Federal Rule of Civil Procedure 8(a) sets the standard for sufficient claims, requiring only a short and plain statement of the claim showing that the pleader is entitled to relief. FED. R. CIV. P. 8(a).

79. See *Russell v. Landrieu*, 621 F.2d 1037, 1039 (9th Cir. 1980).

80. See *Comedy III Prods., Inc. v. New Line Cinema*, 46 U.S.P.Q.2d 1930, 1933 (C.D. Cal. 1998) (“[I]t is only under extraordinary circumstances that dismissal is proper under Rule 12(b)(6).”).

81. See *Comedy III*, 200 F.3d at 595.

though the Ninth Circuit's conclusions regarding the validity of Comedy III's trademark claim were correct, the court's reasoning was flawed. Section B briefly explores the Ninth Circuit's reasons for not discussing Comedy III's right of publicity claim before turning to an analysis of the merits of that claim.

### A. Comedy III's Trademark Claim

#### 1. *The Three Stooges Clip Is Not an Enforceable Trademark*

The Ninth Circuit correctly refused to accept Comedy III's assertion that it merely claimed the acts and likenesses of The Three Stooges, and not the movie clip depicting those acts and likenesses.<sup>82</sup> Despite the superficial limits of its legal claim, Comedy III's true goal was to enjoin the use of the clip itself, a work that clearly falls under 17 U.S.C. § 102(a)(6).<sup>83</sup> The court therefore properly barred Comedy III from reviving a copyright<sup>84</sup> by dressing it in trademark's clothing.

#### 2. *The Ninth Circuit's Opinion Misstates the Relationship between Copyright and Trademark*

Although the court's analysis of Comedy III's trademark claim began accurately, the court veered into dangerous waters when it declared that "the Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity."<sup>85</sup> The court's sole support was *Smith v. Chanel, Inc.*,<sup>86</sup> a case involving trademarks in perfume advertising.<sup>87</sup> Nowhere does *Smith* discuss the boundaries between copyright and trademark—it is purely a trademark case.<sup>88</sup> Since *Smith* does not actually apply to the instant case, the court is left with an unsupported, conclusory, and ultimately incorrect assertion.

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82. *Id.*

83. 17 U.S.C. § 102(a)(6) (1994).

84. A copyright of which it was not even the original owner or assignee. Appellant Comedy III Productions, Inc.'s Opening Brief at 6, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301).

85. *Comedy III*, 200 F.3d at 595.

86. 402 F.2d 562 (9th Cir. 1968).

87. *Comedy III*, 200 F.3d at 595.

88. *Smith* only mentions the word "copyright" once in the entire opinion. That one instance clearly has nothing to do with the overlap, or lack thereof, between copyright and trademark law. See *Smith*, 402 F.2d at 567 ("Consumer allegiances built over the years with intensive advertising, trademarks, trade names, copyrights and so forth extend substantial protection to firms already in the market.").

Viewed in one light, the court's statement may be read as asserting that copyright and trademark protection are mutually exclusive. Ample case law holds to the contrary.<sup>89</sup> The two forms of intellectual property are analytically distinct and may co-exist within the same protected work.<sup>90</sup> The Seventh Circuit has observed that "courts have consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property."<sup>91</sup>

Alternatively, one may read the opinion as declaring that public domain material cannot be covered by the Lanham Act, and hence formerly-copyrighted works cannot be trademarks. Case law is divided on this point. In *G. & C. Merriam Co. v. Syndicate Publishing Co.*, the Supreme Court refused to prohibit the use of the name "Webster" by a company that competed with the publisher of the original Webster Dictionary.<sup>92</sup> However, in *Warne & Co. v. Book Sales, Inc.*,<sup>93</sup> a federal district court came to a different conclusion. Plaintiff Warne was the original publisher of Beatrix Potter's well-known Peter Rabbit children's books, seven of which were in the public domain.<sup>94</sup> The court held as a matter of law that Warne was not barred from claiming trademark rights in the cover illustrations for these books.<sup>95</sup>

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89. See, e.g., *Nintendo of Am., Inc. v. Dragon Pac. Int'l*, 40 F.3d 1007, 1011 (9th Cir. 1994) (allowing statutory damages under both Copyright Act and Lanham Act for the same act of infringement); *Museum Boutique Intercontinental, Ltd. v. Picasso*, 880 F. Supp. 153, 166-67 (S.D.N.Y. 1995) (noting that dual protection under copyright and trademark laws is not uncommon); *Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979) ("Dual protection under copyright and trademark laws is particularly appropriate for graphic representations of characters.").

90. See Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 474 (1986).

91. *Titan Sports, Inc. v. Hellwig*, No. 3:98-CV-467(EBB), 1999 U.S. Dist. LEXIS 10523 (D. Conn. Apr. 26, 1999) (quoting *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638 (7th Cir. 1993)).

92. *G. & C. Merriam Co. v. Syndicate Publ'g Co.*, 237 U.S. 618, 622 (1915) ("After the expiration of [the copyright to the original Webster Dictionary], it is well settled that [the Webster name] cannot be acquired by registration as a trademark; for the name has become public property, and is not subject to such appropriation.").

93. 481 F. Supp. 1191 (S.D.N.Y. 1979).

94. The copyright in some of these books had expired, while the other books had never been copyrighted in the United States. *Id.* at 1193.

95. See *id.* at 1196 ("The fact that a copyrightable character or design has fallen in the public domain should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods."); see also *Tempo Communications, Inc. v. Columbian Art Works, Inc.*, 223 U.S.P.Q. 721, 721 (N.D. Ill. 1983) ("[T]he expiration of a

The divergent outcomes of these cases may stem in large part from the fact that different aspects of the formerly copyrighted works and different public perceptions of those characteristics were at issue. *Warne* involved creative illustrations, one of which had been used by the plaintiff on a variety of other products and had come to symbolize the plaintiff's company.<sup>96</sup> *Merriam*, on the other hand, involved the name of the product itself, a name which the Court felt had become a generic term for dictionaries and was thus invalid as a trademark.<sup>97</sup> However, commentators and courts still debate where to draw the line between copyright and trademark.<sup>98</sup> Given the conflicting case law and commentary, it is clear that the *Comedy III* court's blanket statement that public domain works are untouched by trademark goes too far.

It is difficult to determine exactly what rule for delineating the boundary between copyright and trademark the Ninth Circuit was trying to articulate in *Comedy III*. Although it is possible to read the decision as the court stating what it believed to be an established point of law, the above discussion proves the inaccuracy of this view. If, on the other hand, the court wished to announce a rule that stood apart from those in other jurisdictions, it also failed to make its point clear.

### 3. *Regardless of the Validity of Comedy III's Alleged Mark, New Line's Use Does Not Infringe*

Although the court did not reach the infringement prong of its trademark analysis, New Line would not have been guilty of infringement even if Comedy III had owned a valid trademark in the clip. A trademark infringement claim depends on a showing that consumers are likely to be confused about the source of a product.<sup>99</sup> In *Rogers v. Grimaldi*,<sup>100</sup> Ginger

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copyright or a patent does not bar an action under the Lanham Act for trademark infringement."); cf. 1 MCCARTHY, *supra* note 14, § 1:31 ("The fact that a company does not own one form of intellectual property does not mean that it lacks ownership of another form of valid intellectual property in the same article, creation or trade symbol.").

96. *Warne*, 481 F. Supp. at 1194 n.2.

97. See *Merriam*, 237 U.S. at 622.

98. For opposing viewpoints on how trademark law should treat formerly copyrighted fictional characters, compare Kurtz, *supra* note 90 (arguing that restricting the use of formerly copyrighted characters through trademark undermines copyright policy) with Michael Todd Helfand, *When Mickey Mouse Is As Strong As Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623 (1992) (advocating the use of trademark to protect characters which have fallen into the public domain).

99. See *Maljack Prods., Inc. v. Goodtimes Home Video Corp.*, 81 F.3d 881 (9th Cir. 1996) (holding that others may copy a motion picture whose copyright has expired and use its title, so long as their actions do not cause source confusion).

Rogers, the famed dancer and actress, sought damages and injunctive relief for the defendant's distribution of a film entitled *Ginger and Fred*.<sup>101</sup> The Second Circuit upheld the district court's summary judgment in favor of the defendant, holding that "a title with at least some artistic relevance to the work" is not false advertising under the Lanham Act where it is not "explicitly misleading as to the content of the work."<sup>102</sup> Under the *Rogers* standard, it seems doubtful that courts would find that a feature far less integral to a film than its title, such as New Line's use of an unnamed clip, gives rise to a likelihood of confusion.

Comedy III also failed to allege that New Line altered the clip itself in any way or used it in other than its original form.<sup>103</sup> It is well established that mere copying of a public domain work does not constitute trademark infringement if it does not lead to consumer confusion.<sup>104</sup> Leslie Kurtz explains this principle as follows:

When a public domain work is copied, along with its title, there is little likelihood of confusion even when the most minimal steps are taken to distinguish the publisher of the original from that of the copy. The public is receiving just what it believes it is receiving—the work with which the title has become associated. The public is not only unharmed, it is unconfused.<sup>105</sup>

Even if Comedy III could have convinced the court that it owned a valid trademark in the *Disorder in the Court* clip, it could not have prevailed in its trademark infringement claim against New Line. It is highly unlikely that viewers of *The Long Kiss Goodnight*, were they even to notice the *Disorder in the Court* clip, would leap to conclude that The Three

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100. 875 F.2d 994, 997 (2d Cir. 1989).

101. *Ginger and Fred* was the work of two Italian film legends: director Federico Fellini and actor Marcello Mastroianni.

102. *Rogers*, 875 F.2d at 1000.

103. Comedy III Prods., Inc. v. New Line Cinema, 46 U.S.P.Q.2d 1930, 1935 (C.D. Cal. 1998).

104. See 1 McCARTHY, *supra* note 14, § 6:31; see also Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 1197 (S.D.N.Y. 1979). The district court in *Comedy III* discussed this point in detail. See *Comedy III*, 46 U.S.P.Q.2d at 1935. However, the Ninth Circuit did not comment upon it, despite Comedy III's allegation in its appellate brief that by "commingling [sic] . . . the images, voices, and sounds" from the clip with those of New Line's new film, New Line had created a new transformative work that derived from The Three Stooges clip. Appellant Comedy III Productions, Inc.'s Opening Brief at 28, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301).

105. Leslie A. Kurtz, *Protection for Titles of Literary Works in the Public Domain*, 37 RUTGERS L. REV. 53, 77 (1984).

Stooges or their heirs had somehow produced or sponsored New Line's film. Without this likelihood of confusion, there is simply no infringement. In addition, absent consumer confusion, freedom of expression concerns tend to favor allowing New Line to use the clip in its creative film.<sup>106</sup>

### B. Comedy III's Right of Publicity Claim

Comedy III's second major claim asserted that, in using the *Disorder in the Court* clip, New Line violated the common law right of publicity belonging to the actors who portrayed The Three Stooges.<sup>107</sup> Despite both Comedy III and New Line's extensive treatment of the publicity right issue, neither the district court nor the Ninth Circuit addressed it.<sup>108</sup> Perhaps the Ninth Circuit's neglect of this issue stems from the fact that California does not recognize a common law right of publicity for deceased celebrities<sup>109</sup> and that, even though California has established such a right

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106. See *supra* Part I.E.

107. Comedy III did not explicitly assert a right of publicity claim before the district court; rather, it alleged unfair competition in the forms of passing off and misappropriation. *See Comedy III Prods., Inc. v. New Line Cinema*, 46 U.S.P.Q.2d 1930, 1930 (C.D. Cal. 1998). However, in its appellate brief, Comedy III recast its unfair competition allegations as a common law right of publicity claim. *See Appellant Comedy III Productions, Inc.'s Opening Brief at 2*, 43-47, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301).

108. *See generally Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000); *Comedy III*, 46 U.S.P.Q.2d at 1930-36; *Appellant Comedy III Productions, Inc.'s Opening Brief at 2*, 43-47, *Comedy III Prods. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301); *Defendant-Appellee New Line Cinema Corporation's Answering Brief at 35-39*, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301). The district court did allude to publicity rights briefly when distinguishing various cases cited by Comedy III. *Comedy III*, 46 U.S.P.Q.2d at 1935 ("In addition, the Plaintiff relies on Wendt, as 'particularly relevant . . . in that it addresses both of the primary sources of Comedy III's right in the present case: the common law right of publicity and section 43(a) of the Lanham Act.'") (quoting Plaintiff's Letter to the Court, September 24, 1997).

109. Since right of publicity claims are personal, they are generally brought by someone who is still living. *See Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 808-09 (9th Cir. 1997); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096 (9th Cir. 1992); *Rogers v. Grimaldi*, 875 F.2d 994, 996-97 (2d Cir. 1989). Some jurisdictions do allow heirs and assignees to assert a common law right of publicity claim for a deceased person. *See, e.g., McFarland v. Miller*, 14 F.3d 912, 918 (3d Cir. 1994) (holding that right of publicity is descendible under New Jersey common law); *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Prods., Inc.*, 694 F.2d 674 (11th Cir. 1983) (same under Georgia common law). California, however, does not. California's rule was established by the companion cases of *Lugosi v. Universal Pictures*, 25 Cal. 3d 813 (1979) and *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860 (1979). *Lugosi* involved a claim by the widow and son of renowned horror actor Bela Lugosi against Universal Pictures, alleging

through statutes,<sup>110</sup> Comedy III's claim falls squarely within an express exemption to the law.<sup>111</sup> The court may also have been swayed by New Line's argument that Comedy III's right of publicity claim was procedurally improper.<sup>112</sup> Regardless, the right of publicity, although similar to trademark, is a separate, free-standing legal concept that provides an alternative route to relief for many would-be trademark claims.<sup>113</sup> Without a discussion of this important counterpart to trademark, the Ninth Circuit's analysis of Comedy III's case is incomplete.

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unauthorized use of Lugosi's likeness as he appears in one of his most famous roles, Count Dracula. *Lugosi*, 25 Cal. 3d at 816-17. In denying the plaintiffs' claim, the court held that "the right to exploit name and likeness is personal to the artist and must be exercised, if at all, by him during his lifetime." *Id.* at 824. *Lugosi* did leave plaintiffs a way around its rule by hinting that an exception might be made if the original artist had exploited his right of publicity during his lifetime. *See id.* at 822-23. However, the court shut even this small door in *Guglielmi* by issuing a curt, two-paragraph opinion which stated the *Lugosi* rule as barring a postmortem right of publicity, without qualification. *Guglielmi*, 25 Cal. 3d at 861.

110. In the wake of *Lugosi* and *Guglielmi*, California revived the postmortem right of publicity through statutory means. California Civil Code section 3344.1 provides that "[a]ny person who uses a deceased personality's [identity in a commercial manner]... shall be liable for any damages sustained by the person or persons injured as a result thereof." CAL. CIV. CODE § 3344.1(a)(1) (West 2000) (formerly Cal. Civ. Code § 990). The right granted by this statute only lasts for 70 years following the artist's death. *Id.* § 3344.1(g). The specific purpose of the statute was to legislatively overrule *Lugosi*. 4 MCCARTHY, *supra* note 14, § 28:27. In the aftermath of *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997), a right of publicity suit brought by Fred Astaire's widow, California Civil Code section 990 was amended, renumbered as California Civil Code section 3344.1, and renamed the Astaire Celebrity Image Protection Act. *See Scott L. Whiteleather, Still Dancing: An Article on Astaire v. Best Video and its Lasting Repercussions*, 7 UCLA ENT. L. REV. 267, 286 (2000).

111. California Civil Code section 3344.1 includes several exemptions to the statutory right of publicity. In particular, section 3344.1(a)(2) states that audiovisual entertainment works—a category that clearly includes motion pictures—does not fall within the scope of the statute. CAL. CIV. CODE § 3344.1(a)(2) (West 2000).

112. New Line asserted that Comedy III's appellate brief claim for right of publicity represented an impermissible attempt to raise a new legal issue on appeal, not merely a change in nomenclature. Defendant-Appellee New Line Cinema Corporation's Answering Brief at 27-30, *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (No. 98-55301). It is unclear whether the Ninth Circuit's failure to directly address the right of publicity was a tacit acceptance of New Line's argument.

113. Courts have held that Lanham Act section 43(a) encompasses some right of publicity claims. *See, e.g.*, *White v. Samsung Elecs. of Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

### 1. Comedy III May Assert a Right of Publicity in Fictional Characters

One unusual issue raised by Comedy III's claim is whether a party can claim a right of publicity in a fictional character. Typically, people assert claims over the publicity rights of real persons.<sup>114</sup> Comedy III, however, claimed a right of publicity in The Three Stooges, not in the actors who played them.<sup>115</sup>

The Third Circuit has given qualified approval to publicity rights claims in fictional characters. In *McFarland v. Miller*,<sup>116</sup> the plaintiff, George McFarland, had become famous in his youth for portraying the character Spanky in the *Our Gang* and *Little Rascals* films. Miller operated a restaurant called "Spanky McFarland" that featured numerous images of McFarland's *Little Rascals* character as part of the interior decor.<sup>117</sup> McFarland sued Miller for violation of his common law right of publicity, and the Third Circuit ultimately held that an actor may validly claim a right of publicity in a character he played if the character and the actor are, in effect, equivalent.<sup>118</sup>

The Ninth Circuit has also addressed this question. In *Wendt v. Host International, Inc.*,<sup>119</sup> Host International created animatronic robots resembling the characters Norm and Cliff from the television show *Cheers* and placed them in airport bars modeled after the *Cheers* set.<sup>120</sup> George Wendt and John Ratzenberger, who played Norm and Cliff, sued Host International for violating their common law rights of publicity.<sup>121</sup> In reversing the lower court's summary judgment against the plaintiffs, the Ninth Circuit held that the right of publicity attached to the actors' physical like-

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114. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977); *White*, 971 F.2d at 1395.

115. See *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000).

116. 14 F.3d 912, 914 (3d Cir. 1994).

117. *Id.* at 916.

118. See *id.* at 920 ("Where an actor's screen persona becomes so associated with him that it becomes inseparable from the actor's own public image, the actor obtains an interest in the image which gives him standing to prevent mere interlopers from using it without authority."); see also *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975) (allowing a common law right of publicity in the on-screen images of Stan Laurel and Oliver Hardy). For an in-depth analysis of the *McFarland* standard, see Langvardt, *supra* note 22, at 391-99.

119. 125 F.3d 806 (9th Cir. 1997).

120. *Id.* at 809.

121. *Id.*

nesses rather than their characters, and that therefore, the key issue was the degree to which the robots resembled the actors themselves.<sup>122</sup>

Both *McFarland* and *Wendt* reached the same conclusion, but by very different paths. *McFarland* implied that the right of publicity may be tied to the fictional character, not the actor, and that the actor earns the right of publicity by proving a certain degree and exclusivity of association with that character.<sup>123</sup> *Wendt*, by contrast, viewed the right of publicity as personal to the actor himself; thus, whether the public recognizes the actor because of his association with a popular character is unimportant.<sup>124</sup>

Comedy III's claim would most likely satisfy the *McFarland* standard. Moe, Larry, and Curly all did other entertainment work, but in the public mind they are "Moe, Larry, and Curly—The Three Stooges." The dividing line between screen image and public persona blurs even further where, as in *McFarland*, the actor and the character he portrays use the same name.<sup>125</sup> "Moe Howard," "Larry Fine," and "Curly Howard" are stage names, but they are the names by which the public identified those actors as real individuals as well as The Three Stooges characters. Comedy III's claim would also easily pass the bar set by *Wendt*, for New Line's use involved film footage of the actors, which by definition replicated their exact likenesses. Thus, the mere fact that The Three Stooges are fictional characters does not bar Comedy III from asserting a right of publicity in them.

## 2. *Comedy III's Right of Publicity Claim Undermines the First Amendment*

Like trademark rights, an unrestrained right of publicity possesses the potential to restrict the First Amendment's guarantee of free speech. Although it lacks precedential authority, Judge Kozinski's dissent to the Ninth Circuit's refusal to rehear *White v. Samsung Electronics America, Inc.*<sup>126</sup> en banc highlights some important free speech conflicts that could

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122. See *id.* at 811-12.

123. See *McFarland*, 14 F.3d at 920.

124. See *Wendt*, 125 F.3d at 811 ("While it is true that appellants' fame arose in large part through their participation in *Cheers*, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.").

125. See also *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 838-39 (S.D.N.Y. 1975) (involving a right of publicity suit by Lucille Hardy Price and Ida K. Laurel, the widows of the famous comedy duo Laurel and Hardy).

126. 971 F.2d 1395, 1397-99 (9th Cir. 1992) (holding in favor of publicity rights).

arise if *White* were followed too generously.<sup>127</sup> Chief among these is the crippling effect an expansive right of publicity would have on artists' freedom to utilize portions of pre-existing public domain works in new creative works.<sup>128</sup> In addition, Judge Kozinski noted that even commercial speech is entitled to some level of First Amendment protection, albeit less than that given to noncommercial speech.<sup>129</sup>

If allowed, Comedy III's right of publicity claim would restrict New Line's First Amendment rights in two significant ways. First, it would renege upon the bargain struck by copyright law between the intellectual

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127. 989 F.2d 1512 (1993) (Kozinski, J., dissenting). Numerous commentators have echoed Judge Kozinski's cautionary words. See, e.g., Roberta Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994); Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183 (1998); Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. 283 (2001). These criticisms apply mainly to common law publicity rights, for right of publicity statutes do a better job of balancing the competing interests. For example, California Civil Code section 3344.1(2) specifically exempts not only plays, books, newspapers, and audiovisual works, but also advertisements or commercial announcements for any of those works from the publicity rights granted by the section. CAL. CIV. CODE § 3344.1(2) (West 2000); see also id. § 3344(f) (exempting the owners or employees of any medium used for advertising from liability under the section if they were not aware the use was unauthorized). These statutory exemptions mirror the common law's greater deference to noncommercial speech. See *supra* Part I.E.

128. Judge Kozinski illustrated his point by citing numerous examples of well-known books, songs, and movies that utilize well-known trademarks, all of which presumably would not have enriched our culture without the protective shield of free speech. *White*, 989 F.2d at 1514. He also noted that an unfettered right of publicity could place excessive liability on those who parody or otherwise comment on public figures. *Id.* at 1519 ("Parody, humor, irreverence are all vital components of the marketplace of ideas. . . . [T]he last thing the First Amendment will tolerate . . . is a law that lets public figures keep people from mocking them. . . .").

129. *Id.* The Supreme Court laid to rest the notion that commercial speech was exempt from the First Amendment in *Virginia State Board. of Pharmacy v. Virginia Citizens Consumers Council, Inc.*:

It is clear . . . that speech does not lose its First Amendment protection because money is spent to project it, as in a paid advertisement of one form or another. . . . Speech likewise is protected even though it is carried in a form that is "sold" for profit . . . and even though it may involve a solicitation to purchase or otherwise pay or contribute money.

425 U.S. 748, 761 (1976). This view is now reflected in state statutes. See, e.g., CAL. CIV. CODE § 3344(e) (West 2000) (stating that commercial use of another's identity does not violate the statute "solely because the material containing such use is commercially sponsored or contains paid advertising").

property rights of the individual and the free access rights of the public.<sup>130</sup> The copyright in The Three Stooges' *Disorder in the Court* has expired.<sup>131</sup> Comedy III, however, wanted to snatch the film out of the public domain and back into private hands. Claims like Comedy III's could, therefore, potentially confer copyright-like rights on a party that neither created a work nor owned any rights in it as an assignee. Second, Comedy III's claim would intrude upon the freedom of expression given to those who produce artistic works. Opening such artists to liability for drawing upon any number of "public domain" works would have a serious chilling effect upon the creative process. If allowed, claims such as Comedy III's would therefore represent a significant threat to the freedoms of speech and expression granted to the public by the First Amendment.

#### IV. CONCLUSION

The Ninth Circuit correctly declined to entertain Comedy III's Lanham Act and unfair competition claims. However, rather than hand down a strong rule that clearly delineates one of the boundaries between copyright and trademark law, the court issued a conclusory and unsupported holding that may endanger the finality of its decision and calls into question the strength with which this case may serve as precedent. In addition, the court has missed an opportunity to reaffirm its right of publicity rules. This lost chance is all the more disappointing given the Ninth Circuit's usual role as a leading jurisdiction in the shaping of publicity rights law.

Furthermore, it is conceivable that, contrary to the Ninth Circuit's rule, an exact reproduction of an artist's performance could, in fact, become a trademark after the copyright in the performance expires. It has become increasingly common for advertisements on television, radio, and the Internet to incorporate portions of the original recordings of classic songs.<sup>132</sup> For example, Philips Electronics has recently adopted The Beatles' "Getting Better" as a musical counterpart to its slogan, "Let's Make Things Better."<sup>133</sup> The chorus of the song appears along with the

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130. See *supra* Part I.A.

131. See *supra* note 65.

132. Some classic songs recently used in television commercials include Jimi Hendrix's "Are You Experienced?" (Reebok DMX running shoes), Queen's "Another One Bites the Dust" (Aiwa stereo systems), and The Knack's "My Sharona" (Taco Bell "Chalupas").

133. Philips chose "Getting Better" specifically to provide "a strong musical button so that Philips' TV spots are recognized instantly." *Philips Profile: Building the brand with flagship products*, at <http://www.news.philips.com/profile/brand/brand1.html> (last visited Feb. 4, 2001).

Philips logo at the end of each Philips television commercial. Presumably, Philips currently licenses the song from The Beatles. However, if Philips were to continue using "Getting Better" as part of its commercial signature, one could envision a point in the distant future, after The Beatles' copyright in the song has expired, when Philips could lay claim to the song as a trademark, assuming that it has remained the sole electronics company to use it. It is, therefore, advisable not to view the Ninth Circuit's rule in *Comedy III Productions, Inc. v. New Line Cinema* as setting an outer limit on trademark law.