

TONEY V. L'OREAL USA, INC.: PERSONA AND THE UNFETTERED RIGHT OF PUBLICITY

By Farbod Moridani

When L'Oreal used pictures of June Toney to market its hair products after its contract with her had expired, it should have expected a lawsuit for breach of contract. But Toney did not file a breach of contract claim; she filed a right of publicity action, alleging that L'Oreal had misappropriated the commercial value of her image.¹ In response, L'Oreal claimed that Toney's right of publicity claim under state law was preempted by the Copyright Act under 17 U.S.C. § 301.² In the ensuing litigation, both the District Court for the Northern District of Illinois and the Seventh Circuit struggled to determine when § 301 preempts a right of publicity claim.³

Due to its inherently amorphous nature, the scope of the right of publicity and its relationship to copyright law has been a subject of debate ever since Congress passed the Copyright Act of 1976. The right of publicity, if never preempted, can interfere with rights traditionally exercised under copyright law such as distribution and performance.⁴ Such a conflict would occur when, for example, an individual purchases an exclusive-use license from a copyright holder to use material from a television show, but is prevented from using the material because the actors who appear in it claim a right to the commercial value of their persona as portrayed in the show.⁵ A copyright license would be of little value if anyone whose likeness appeared in the work could preclude its use. Congress's decision to delete language from the final version of § 301 that specifically enumerated which kinds of state claims federal copyright preempts forced the

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1. *Toney v. L'Oreal USA, Inc.*, No. 02 C 3002, 2002 U.S. Dist. LEXIS 21229 (N.D. Ill. Oct. 30, 2002) [hereinafter *Toney I*].

2. *See id.*; 17 U.S.C. § 301 (2000).

3. *Toney I*, 2002 U.S. Dist. LEXIS 21229; *Toney v. L'Oreal USA, Inc.*, 384 F.3d 486 (7th Cir. 2004) [hereinafter *Toney II*]; *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005) (rehearing) [hereinafter *Toney III*].

4. 17 U.S.C. § 106 (2000).

5. *See, e.g., Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997).

courts to decide whether § 301 preempted the right of publicity.⁶ This lack of definition has led to disparate interpretations across the circuit courts, and some confusion as to where the preemption line should lie for right of publicity claims.

Some commentators argue that § 301 should always preempt right of publicity claims, if only because the right is already protected in other ways.⁷ Others advocate merely a narrowing of the right of publicity rather than total preemption.⁸ An essential question underlies these critiques: what does the right of publicity accomplish, and can its protections remain robust without contradicting the goals of copyright law? The Supremacy Clause⁹ might provide some assistance by preempting the right of publicity where it conflicts with federal copyright law,¹⁰ yet courts have tended not to adopt this reading of the Supremacy Clause. As a result, the question remains: where should the law draw the line in preempting the right of publicity? The answer necessarily lies in balancing the goals of copyright against the underlying premise of the right of publicity.

This Note explores the implications of the Seventh Circuit's holding in *Toney III* that § 301 does not preempt right of publicity claims arising out of the unauthorized use of an individual's persona.¹¹ Part I explores the origins of the right of publicity under state law, and the assumptions on which the right is based. It then recounts the development of copyright preemption as it has applied to right of publicity claims, and discusses the different approaches scholars have taken in limiting or preserving the right of publicity. Part II presents the factual background of *Toney*, including a comparison of the logical rationales of each of the reviewing courts, up through the case's rehearing in the Seventh Circuit. Examining each of these courts' rationales illuminates the difficult task of balancing copyright concerns with publicity interests. Part III discusses the implications of *Toney III*, and the questions that remain regarding its effect on creative expression and the scope of § 106 rights. Finally, Part IV concludes that the *Toney III* court may have fashioned an unreasonably narrow preempt-

6. H.R. REP. NO. 94-1476, at 24 (1976).

7. See, e.g., Lee Goldman, *Elvis is Alive, But He Shouldn't Be: The Right of Publicity Revisited*, 1992 BYU L. REV. 597, 601-02 (1992).

8. See David W. Melville & Harvey S. Perlman, *Protection for Works of Authorship Through the Law Of Unfair Competition: Right of Publicity and Common Law Copyright Reconsidered*, 42 ST. LOUIS U. L.J. 363 (1998).

9. U.S. CONST. art. VI, cl. 2.

10. See Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 236-44 (2002) (advocating use of the Supremacy Clause as a test for when federal copyright law should preempt copyright claims).

11. *Toney III*, 406 F.3d 905, 910 (7th Cir. 2005).

tion rule and suggests that future cases must preempt a broader class of right of publicity claims in order to best effectuate traditional copyright principles.

I. BACKGROUND

A. The Evolution of Copyright Preemption

Prior to Congress's passage of the Copyright Act of 1976, copyright was a creature of both state and federal law.¹² Federal copyright protected published works, and state common law provided quasi-copyright¹³ protection for unpublished works.¹⁴ This dual system of copyright resulted in a lack of uniformity since state law provided perpetual protection for unpublished works,¹⁵ while federal protection was subject to a finite term of years.¹⁶ Further, the moment a work was published, state protection vanished,¹⁷ and the work either gained federal protection¹⁸ or fell into the public domain. The Copyright Act of 1976 sought to resolve this lack of uniformity by, among other things, expressly preempting all state laws that provide protections for copyrightable subject matter that are "equivalent to any of the exclusive rights within the general scope of copyright" as provided in the Copyright Act.¹⁹ However, Congress specifically excluded from the scope of preemption laws with respect to:

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

12. H.R. REP. NO. 94-1476, at 129-33 (1976).

13. State protection of copyright works is often mistakenly referred to as "common law copyright." This is in fact incorrect, given that common law protection did not prevent copying of a work after publication. *See* *Batjac Prods. Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223, 1225 n.1 (9th Cir. 1998). Further, state protection was not always by means of common law; it was often provided for by statute. *See, e.g.*, CAL. CIV. CODE § 980(a) (Supp. 2006).

14. *See* *Goldstein v. California*, 412 U.S. 546 (1973); *Wheaton v. Peters*, 33 U.S. 591 (1834).

15. *See* An Act to Amend and Consolidate the Acts Respecting Copyright, Act of March 4, 1909, ch. 320, § 2, 35 Stat. 1075, 1076 (codified at 17 U.S.C. §§ 1-62 (2000)).

16. 17 U.S.C. § 106A(b) (2000); *see* U.S. CONST. art 1, § 8, cl. 8.

17. *See* *Magnuson v. Video Yesteryear*, 85 F.3d 1424, 1428 (9th Cir. 1996) ("Under the 1909 Act, common law copyright terminated when a work was published, at which point the work became eligible for federal statutory copyright.").

18. *See* 17 U.S.C. §§ 102-106 (2000).

19. 17 U.S.C. § 301(a).

- (2) any cause of action arising from undertakings commenced before January 1, 1978;
- (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106; or
- (4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8).²⁰

Courts have struggled to determine when protection afforded by a particular state law is “equivalent to any of the exclusive rights within the general scope of copyright”²¹ such that it should be preempted by federal copyright law under § 301(a). This struggle has been particularly pronounced with respect to right of publicity claims.

B. The Right of Publicity

The right of publicity, though implemented through statute,²² arises from two principles embedded in the common law: the right of privacy and the commercial exploitation of property. The typical right of publicity statute protects individuals’ “marketable identities from commercial misappropriation by recognizing their right to control and profit from the use of their names and nicknames, likenesses, portraits, performances (under

20. 17 U.S.C. § 301(b). Section 102 enumerates the following works as copyrightable subject matter:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

17 U.S.C. § 102 (2000). Section 103 extends copyrightable subject matter to include compilations and derivative works. 17 U.S.C. § 103 (2000).

21. 17 U.S.C. § 301. Exclusive rights afforded by the Copyright Act include the rights of reproduction, creation of derivative works, distribution, public performance, and public display. *See* 17 U.S.C. § 106 (2000).

22. *See* CAL. CIV. CODE § 3344 (West 1997); FLA. STAT. § 540-08 (West 2002); 765 ILL. COMP. STAT. 1075/10 (West 2001); NEV. REV. STAT. § 597.790 (2004); OHIO REV. CODE ANN. §§ 2741.01-.02 (Supp. 2005); OKLA. STAT. tit. 12, § 1449 (1993); 42 PA. CONS. STAT. § 8316 (Supp. 2004); TENN. CODE ANN. § 47-25-1105 (Supp. 2001).

certain circumstances), biographical facts, symbolic representations, or anything else that evokes [their] marketable identity.”²³

The right of privacy is based on the principles embodied in Samuel Warren and Louis Brandeis’s seminal law review article of 1890, in which the authors called for a “right to be let alone” in an age where technological advancements made the dissemination of private facts increasingly onerous.²⁴ The first case to apply this “right to be let alone” in a way that resembles the modern right of publicity, *Pavesich v. New England Life Insurance Co.*, involved a newspaper published in Atlanta, Georgia that printed an advertisement for the New England Mutual Life Insurance Company (“N.E. Mutual”).²⁵ The newspaper used a picture of Paolo Pavesich in the advertisement along with a caption underneath the picture which read: “In my healthy and productive period of life I bought insurance in the New England Mutual Life Insurance Co., of Boston, Mass., and to-day my family is protected and I am drawing an annual dividend on my paid-up policies.”²⁶ N.E. Mutual acquired and used Pavesich’s picture without his consent.²⁷ Pavesich filed suit, and the Supreme Court of Georgia held that “the publication of one’s picture without his consent by another as an advertisement, for the mere purpose of increasing the profits and gains of the advertiser, is an invasion of [the] right” to privacy.²⁸ As a result, Pavesich had a valid claim for damages.²⁹

In *Pavesich*, the prohibition against using an individual’s likeness for profit without consent was intended merely to protect a private individual from “wounded feelings.”³⁰ However, over the next fifty years, with the rise of movies, television shows, sports, and the celebrities that came along with them, courts became wary of “wounded feelings” claims arising every time the media covered celebrity news.³¹ In response, courts began limiting celebrities’ right to preclude unauthorized use of their like-

23. Pamela Edwards, *What's the Score?: Does the Right of Publicity Protect Professional Sports Leagues?*, 62 ALB. L. REV. 579, 581 (1998); see, e.g., CAL. CIV. CODE § 3344 (West 1997).

24. Samuel D. Warren & Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

25. 50 S.E. 68 (Ga. 1905).

26. *Id.* at 68-89.

27. *Id.*

28. *Id.* at 81.

29. *Id.*

30. *Id.* at 73.

31. See Goldman, *supra* note 7, at 603-07.

nesses, holding that celebrities and other public figures had by virtue of their celebrity consented to use of their likeness.³²

In an effort to recoup their newly-limited ability to control the use of their images, celebrities began claiming a property interest in the commercial value of their likenesses. The first court to recognize such an interest was the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*³³ Haelan Laboratories ("Haelan") had a contract with several Major League Baseball players, acquiring exclusive permission to use their photographs on chewing gum wrapping.³⁴ A competing chewing gum company thereafter used the same photographs on its own wrapping without Haelan's permission,³⁵ and Haelan sued, claiming an exclusive right to the commercial value of the baseball players' likenesses in the photographs.³⁶ The Second Circuit held that individuals have the right to control the commercial use of their likenesses and to assign that right to others through contract.³⁷ The court rejected the contention, made by other courts at the time,³⁸ that a "right of publicity" claim was merely an attempt to prevent hurt feelings resulting from unauthorized publication of one's picture.³⁹ Rather, the court reasoned that individuals whose identities carried economic value should not be deprived of "money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."⁴⁰ The court likened the right to

32. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204-06 (1954).

33. 202 F.2d 866 (2d Cir. 1953).

34. *Id.* at 867.

35. *Id.*

36. *Id.*

37. *Id.* at 868.

38. The district court for the Eastern District of New York had held earlier that: The rights and remedies of the persons aggrieved are purely personal and not assignable. Rights for outraged feelings are no more assignable than would be a claim arising from a libelous utterance. The alleged agreements made between the actresses in question and the plaintiff, under which the plaintiff was given the exclusive right to publish the portraits, may have conferred rights which the plaintiff might have protected by copyright, but none in favor of the plaintiff against the defendants under the Civil Rights Law of Privacy.

Bowman Gum, Inc. v. Topps Chewing Gum, Inc., 103 F. Supp. 944, 951 (E.D.N.Y. 1952).

39. *Haelan Labs*, 202 F.2d at 868.

40. *Id.*

control one's identity to a property interest that can be negotiated, licensed, and assigned.⁴¹

The principles underlying *Pavesich* and *Haelan Laboratories* together formed the modern right of publicity. Courts since have consistently protected individuals' right to preclude the use of their likeness, especially when that likeness has inherent economic value.⁴² However, the scope of this right has come into question because it primarily benefits celebrities and, in its broadest application, conflicts with fundamental principles underlying copyright law.

C. Balancing the Right of Publicity with Copyright

Commentators disagree about the general validity and proper scope of the right of publicity.⁴³ A broad interpretation of the right of publicity can result in interference with, or even abrogation of, copyrights. For example, if any person whose face appears in a film could prevent distribution of the movie through a right of publicity claim, the movie industry would be brought to its knees. Conversely, a very narrow construction of the right of publicity leaves private individuals vulnerable to exploitation of their likenesses for the profit of others. This Section provides a brief overview of scholarly attempts to deal with these issues, and to balance the right of publicity with copyright. These attempts include suggesting complete elimination of the right of publicity, limiting the scope of the right, and limiting it so far as it conflicts with federal law.

1. *Eliminating the Right of Publicity*

Professor Lee Goldman advocates abandoning the right of publicity altogether.⁴⁴ Goldman argues that neither an incentive rationale, a personal autonomy rationale, nor an unjust enrichment rationale for the right of publicity justifies giving people, in the end mostly celebrities, a property

41. *See id.*

42. An individual does not need to be a celebrity in order to state a right of publicity claim. Neither must the individual's likeness have significant inherent economic value. *See, e.g., CAL. CIV. CODE* § 3344 (2000). But those bringing right of publicity claims today overwhelmingly tend to be celebrities seeking to protect the value of their likenesses. *See Goldman, supra* note 7, at 604-07. This marks a departure from the origins of the right of publicity. What originally protected a private individual's right "to be let alone," now primarily protects the economic interests of those who profit most from not being private individuals. *Compare Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (1905), with *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

43. *See generally Goldman, supra* note 7; Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn From Trademark Law*, *STAN. L. REV.* (forthcoming); Melville & Perlman, *supra* note 8.

44. Goldman, *supra* note 7, at 598.

interest in the use of their likenesses.⁴⁵ Regarding the incentive rationale, Goldman argues that any analogy to patent and copyright incentives is incorrect.⁴⁶ Copyright and patent protections provide an economic incentive for people to produce creative works and novel inventions which will ultimately benefit the public.⁴⁷ The right of publicity, on the other hand, results in no benefit to the public.⁴⁸ Rather, Goldman argues, it simply provides added economic benefit to people who have already succeeded in creating economic value in their image: “[I]t is the Madonnas and Michael Jordans who reap the greatest rewards from the right of publicity, not the struggling actor or author.”⁴⁹ Since the right of publicity rewards individuals who have already succeeded in attaining money and fame, the right simply allows for, and legally sanctions, excess. It does not provide an incentive to do anything other than economically to exploit the use of one’s likeness.

Goldman also rejects the personal autonomy rationale for a broad right of publicity.⁵⁰ Given that the people commonly filing right of publicity claims are celebrities, “the notion that the individual should have absolute control over the use of his or her identity is quaint, but naïve.”⁵¹ According to Goldman, this rationale should be limited to private, non-celebrity individuals.⁵² It should not be available to celebrities because they “arguably have waived certain rights to privacy, are routinely subject to media scrutiny . . . and often can effectively respond to public misrepresentations.”⁵³ The same is not true for the Pavesiches of the world.⁵⁴

Goldman rebuffs the unjust enrichment rationale for the right of publicity as well.⁵⁵ He denies the notion that people are entitled to the “fruits of their labor,” arguing that “our culture permits many forms of free-riding.”⁵⁶ In fact, many celebrities benefit from free-riding because of the increased publicity and, even if they do not benefit, they do not suffer ei-

45. Goldman, *supra* note 7, at 604-13. Professor Goldman is not the only one to question the theoretical justification for a right of publicity. *See generally* Dogan & Lemley, *supra* note 43.

46. Goldman, *supra* note 7, at 605.

47. Goldman, *supra* note 7, at 605.

48. Goldman, *supra* note 7, at 605.

49. Goldman, *supra* note 7, at 604.

50. Goldman, *supra* note 7, at 606-07.

51. Goldman, *supra* note 7, at 606.

52. Goldman, *supra* note 7, at 608.

53. Goldman, *supra* note 7, at 608.

54. *See Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (1905).

55. Goldman, *supra* note 7, at 608-09.

56. Goldman, *supra* note 7, at 609.

ther: "Madonna's and Michael Jackson's media coverage is exhaustive (and exhausting); the marketplace is filled with their memorabilia. Nevertheless, their concerts always sell out."⁵⁷ Further, profiting through the use of another's likeness does not necessarily "place[] the originator at a competitive disadvantage" because the misappropriator usually "does not compete in the celebrity's primary market."⁵⁸ In effect, Goldman argues that because celebrities do not suffer when their likeness is misappropriated, and because historically the United States has not recognized a natural right to the fruits of one's labor, the unjust enrichment theory is simply incorrect.⁵⁹ Since none of the proffered justifications is sufficient, Goldman suggests eliminating the right of publicity.

2. *Limiting the Scope of the Right of Publicity*

Most scholars do not advocate abandoning the right of publicity altogether. However, some have suggested limiting its scope. Professors Melville and Perlman, for example, argue that the right of publicity should only operate "when the indicia of identity appropriated by the defendant are within the direct, personal sphere of the plaintiff, and the indicia are appropriated for use in commercial advertising or merchandise."⁶⁰

According to Melville and Perlman, the right of publicity has gone astray and must return to its roots.⁶¹ Specifically, the closer the particular use of a likeness is to the "personal sphere" of the individual whose likeness is appropriated, and the more commercial that use, the more justified a right of publicity claim becomes.⁶² N.E. Mutual's use of Pavesich's picture⁶³ would fall within this category. Conversely, when the use of a likeness is not personal, and is informative or parodic, a right of publicity claim is less justified.⁶⁴ This rationale not only protects private individuals from commercial exploitation of their image, but also avoids the curtailment of expression, particularly where the expression involves celebrity personas.⁶⁵

The right of publicity has steadily expanded since *Haelan Laboratories* both in "the subject matter protected and the nature of the use thought

57. Goldman, *supra* note 7, at 610-13.

58. Goldman, *supra* note 7, at 610.

59. Goldman, *supra* note 7, at 610-13.

60. Melville & Perlman, *supra* note 8, at 408.

61. See Melville & Perlman, *supra* note 8, at 408.

62. Melville & Perlman, *supra* note 8, at 394-95, 397-98.

63. See *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (1905).

64. Melville & Perlman, *supra* note 8, at 393.

65. Melville & Perlman, *supra* note 8, at 396-97.

to be infringed upon.”⁶⁶ In fact, the right of publicity has been expanded so far beyond its original bounds that some courts have held that the mere evocation of a celebrity’s image in the mind of an individual viewing a particular work is sufficient to violate the right of publicity.⁶⁷

While Melville and Perlman’s approach certainly would curtail the type of right of publicity claim to which Goldman is so averse, it still would require courts to determine when a particular use is personal or commercial enough to be the subject of a right of publicity claim, and when a use is impersonal or imitative enough to be exempted. A commercial use may be entirely imitative, or very creative. Similarly, a particular use may be very personal, but also informative or analytical. As a result, there is a gray area such that wherever a court might draw the line, that line likely would be somewhat arbitrary and ad hoc. So far, courts have not adopted this analysis.

3. *Limiting the Right of Publicity Through the Supremacy Clause*

The question that lies at the heart of balancing the right of publicity with copyright is whether and how the right of publicity can remain robust without interfering with, or conflicting with, copyright law. Whereas copyright protection is specifically sanctioned in the United States Constitution,⁶⁸ the right of publicity is a matter of state statute.⁶⁹ The Supremacy Clause, at a basic level, preempts any state law that conflicts with a federal law, or with the Constitution.⁷⁰ Jennifer Rothman argues that the Supremacy Clause “provides the best avenue for remedying the conflict between the right of publicity and copyright law.”⁷¹ According to Rothman, the Supremacy Clause should preempt the right of publicity whenever it interferes with the purposes of copyright law. To that end, the right of publicity should be preempted when:

- (1) the right of publicity claim is based solely on appropriation of a “persona” rather than a likeness, image, voice, or name; or
- (2) the right of publicity holder consented to the original work in which his or her performance is captured – and the use is either

66. Melville & Perlman, *supra* note 8, at 392.

67. See *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

68. See U.S. CONST. art I, § 8, cl. 8.

69. See CAL. CIV. CODE § 3344 (West 1997); FLA. STAT. § 540-08 (West 2002); 765 ILL. COMP. STAT. 1075/10 (West 2001); NEV. REV. STAT. § 597.790 (2004); OHIO REV. CODE ANN. §§ 2741.01-.02 (Supp. 2005); OKLA. STAT. tit. 12, § 1449 (1993); 42 PA. CONS. STAT. § 8316 (Supp. 2004); TENN. CODE ANN. § 47-25-1105 (Supp. 2001).

70. U.S. CONST. art. VI, cl. 2.

71. Rothman, *supra* note 10, at 236.

by the copyright holder or a licensee; or (3) the right of publicity holder consented to the original copyright work and the work is used by the public in a way that is explicitly allowed by the Copyright Act.⁷²

Rothman argues that any right of publicity claim arising out of the use of an individual's persona should be preempted because a persona is an idea, and "[t]he Copyright Act explicitly leaves ideas in the public domain."⁷³ Specifically, a right of publicity claim, where the only use is of a persona, attempts to protect ideas, which is specifically prohibited by the United States Constitution.⁷⁴ However, many courts have held that where the misappropriated likeness is the persona of the claimant, the right of publicity is not preempted specifically because ideas do not fall within the ambit of copyright protection.⁷⁵ Because a persona is not copyrightable subject matter and cannot be fixed, many courts have held that protecting the persona inherent in a particular work would not be affording protection to otherwise copyrightable subject matter. As a result, such a claim is exactly the type excluded from copyright preemption. Therefore, most courts have found right of publicity claims based on use of a persona to not be preempted for the very reason that Rothman believes they should be.

Rothman also suggests that right of publicity claims should be preempted when the likeness in question is fixed with the claimant's permission.⁷⁶ Under current law, consent to a particular use of a likeness is a defense to a right of publicity claim,⁷⁷ but does not extend to use of the likeness in unauthorized derivative works.⁷⁸ As a result, an individual may be liable for appropriating another's likeness without permission in a derivative work, even though he holds the copyright to the original work which includes the same likeness.⁷⁹ Rothman therefore suggests that the consent

72. Rothman, *supra* note 10, at 252.

73. Rothman, *supra* note 10, at 252.

74. Rothman, *supra* note 10, at 252.

75. See *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-04 (9th Cir. 2001); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623 (6th Cir. 2000); *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000).

76. Rothman, *supra* note 10, at 254.

77. See CAL. CIV. CODE § 3344 (West 1997); FLA. STAT. § 540-08 (West 2002); 765 ILL. COMP. STAT. 1075/10 (West 2001); NEV. REV. STAT. § 597.790 (2004); OHIO REV. CODE ANN. §§ 2741.01-.02 (Supp. 2005); OKLA. STAT. tit. 12, § 1449 (1993); 42 PA. CONS. STAT. § 8316 (Supp. 2004); TENN. CODE ANN. § 47-25-1105 (Supp. 2001); Rothman, *supra* note 10, at 231; 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY 3.1[B], 11.58 (2d ed. 2000).

78. Rothman, *supra* note 10, at 254.

79. Rothman, *supra* note 10, at 254.

defense be extended to apply not only to the use of another's likeness in an original work, but also in derivative works.⁸⁰ However, it may be difficult for contracting parties to anticipate the derivative works in which a likeness might later appear, when deciding whether to give permission for a likeness to be fixed in the original medium. Though this test would avoid conflict with the purposes of copyright protection if it were easy to implement, it may be too unwieldy for practical implementation by the average individual.

Each of these commentators has attempted to provide a solution to the right of publicity's interference with copyright. No circuit has attempted to remove the right of publicity completely, nor have they explicitly balanced the beneficial aspects of the right of publicity with the purposes behind robust and unfettered copyright protection.

II. *TONEY V. L'OREAL USA, INC.*

A. Facts and Procedural Posture

June Toney, a print, commercial, and runway model, entered into an agreement with Johnson Products Company ("Johnson"), allowing Johnson to use Toney's likeness on national advertisements until November 1996, and on its hair product packaging until November 2000.⁸¹ Thereafter, L'Oreal USA, Inc. ("L'Oreal") acquired the line of products on which Toney's likeness appeared, and continued to distribute the products through December 2000, beyond the contract period.⁸² Toney filed suit against L'Oreal in the Northern District of Illinois, alleging that L'Oreal had used her likeness on its products past the period authorized by the contract. She alleged, among other things, that L'Oreal had violated her right of publicity under the Illinois Right of Publicity Act ("IRPA").⁸³ L'Oreal filed a motion to dismiss on the grounds that the IRPA was preempted by § 301.⁸⁴

80. Rothman, *supra* note 10, at 254.

81. *Toney III*, 406 F.3d 905 (7th Cir. 2005).

82. *Id.*

83. 764 ILL. COMP. STAT. 1076/1-60 (West 2001). The IRPA empowers individuals "to control and to choose whether and how to use an individual's identity for commercial purposes."

84. *Toney III*, 406 F.3d at 905.

B. The District Court's Analysis

The district court agreed with L'Oreal that the right of publicity claim was preempted, and dismissed the claim.⁸⁵ The court interpreted § 301 as requiring that: "(1) the work in which the right is asserted . . . be fixed in tangible form and come within the subject matter of copyright as specified in § 102 of the Copyright Act"; and "(2) The right . . . be equivalent to one of the rights specified in § 106."⁸⁶ Relying on *Baltimore Orioles, Inc. v. Major League Baseball Players Assoc.*,⁸⁷ where the Seventh Circuit had previously concluded that right of publicity claims are always preempted when the likeness in question is fixed in a tangible medium of expression, the district court concluded that Toney's likeness was indeed fixed.⁸⁸ Further, the court reasoned that because her right of publicity claim would, if she were to prevail, result in preventing the defendant from distributing those pictures, Toney was attempting to exploit a right exclusively granted under § 106 to copyright holders.⁸⁹ Based on this characterization, the district court found Toney's right of publicity claim preempted.⁹⁰

C. The Court of Appeals's Analysis

The Court of Appeals for the Seventh Circuit affirmed,⁹¹ finding it relevant that "Toney's likeness in photographic form is an original work and fixed in tangible form."⁹² The court held that *Baltimore Orioles* forbids the conclusion that an individual's likeness, when portrayed in a tangible medium, can escape preemption.⁹³ It reasoned that after *Baltimore Orioles*, the right of publicity is itself "within the subject matter of copyright."⁹⁴ Since any right of publicity claim seeks to enjoin the reproduction, distribution, performance, display, or adaptation of the work in which the "persona" inheres,⁹⁵ the court found that the right of publicity is "qualitatively indistinguishable from the rights enumerated in § 106 of the

85. See *Toney I*, No. 02 C 3002, 2002 U.S. Dist. LEXIS 21229, at *3 (N.D. Ill. Oct. 30, 2002).

86. *Id.* at *4.

87. 805 F.2d 663 (7th Cir. 1986).

88. *Toney I*, 2002 U.S. Dist. LEXIS 21229, at *6.

89. See 17 U.S.C. § 106.

90. *Toney I*, 2002 U.S. Dist. LEXIS 21229, at *7.

91. See *Toney II*, 384 F.3d at 492.

92. *Id.* at 489.

93. *Id.* at 490.

94. *Id.* at 489.

95. See *id.* at 492.

Copyright Act”⁹⁶ and is therefore categorically preempted. Toney filed a petition for rehearing, which the Seventh Circuit granted.⁹⁷

D. The Court of Appeals’s Analysis on Rehearing

Rehearing the issue, the Seventh Circuit departed from the prior panel’s ruling, holding that Toney’s right of publicity claim was *not* preempted by § 301.⁹⁸ In stark contrast to the prior panel, the court concluded that Toney’s likeness was not a work of authorship fixed in a tangible medium of expression within the subject matter of copyright.⁹⁹ Although her picture was indeed “fixed” in physical form on the hair-product packaging and in the national advertisements,¹⁰⁰ and though a “pictorial work” does fall within the subject matter of copyright,¹⁰¹ the court separated Toney’s *persona*—the use in commerce of which Toney had a right to prohibit under the IRPA—from Toney’s *picture*, which was copyrightable subject matter, but which was not the subject of this litigation.¹⁰²

Whereas § 301 might preempt a state law providing copyright protection for a picture, the court held, a *persona* “is not authored and it is not fixed,” and therefore does not fall within the subject matter of copyright.¹⁰³ Hence, the rights afforded by the IRPA were not equivalent to those provided by the Copyright Act, since copyright cannot protect a *persona*,¹⁰⁴ and Toney’s right of publicity claim was not preempted.¹⁰⁵ The court also noted in passing that establishing a right of publicity claim under the IRPA requires proof of “commercial purpose,” an extra element that is neither necessary nor relevant to a claim under the Copyright Act.¹⁰⁶

According to the court, whether the “defendants owned the copyright to the photograph that was used, is irrelevant to the [right of publicity] claim.”¹⁰⁷ If Toney were to prevail on her right of publicity claim, it effec-

96. *Id.*

97. *See Toney III*, 406 F.3d at 905.

98. *Id.*

99. *Id.* at 910.

100. *Id.* at 908.

101. *See* 17 U.S.C. § 102 (a)(5).

102. *Toney III*, 406 F.3d at 910.

103. *Id.*

104. *See id.* The court took the unusual of step of melding two questions together, assuming that if the first requirement of copyright preemption is not satisfied, neither can the other be. *Id.*

105. *Id.*

106. *Id.*

107. *Id.*

tively did not matter that L'Oreal would ultimately be enjoined from exercising its right to distribute the photographs of Toney, for which it held the copyright.¹⁰⁸ The relevant question, rather, was “the message—whether the plaintiff endorses, or appears to endorse the product in question. One can imagine many scenarios where the use of a photograph without consent, in apparent endorsement of any number of products, could cause great harm to the person photographed.”¹⁰⁹ In other words, § 301 does not preempt an individual’s attempt to prevent the exercise of copyrights if the reproduction, distribution, performance, or display¹¹⁰ would send a message that the person depicted in that work endorses the product.

In concluding that § 301 does not preempt Toney’s right of publicity claim, the court narrowed its decision in *Baltimore Orioles*, where it had found that § 301 preempts any right of publicity claim where the subject matter of the claim is fixed in a tangible medium of expression.¹¹¹ Many commentators and other courts had criticized *Baltimore Orioles* as abrogating entirely any state law protecting individuals’ right to control the use of their own likeness in commerce.¹¹² In marginalizing that case, the court stated that *Baltimore Orioles* stood only for the proposition that “laws that intrude on the domain of copyright are preempted even if the particular expression is neither copyrighted nor copyrightable.”¹¹³ In so holding, the Seventh Circuit joined the majority of other circuits in protecting the right of publicity from § 301 preemption.

108. *Id.*

109. *Id.* at 910.

110. These are some of the rights afforded under 17 U.S.C. § 106.

111. *Baltimore Orioles, Inc. v. Major League Baseball Players Assoc.*, 805 F.2d 663, 674-76 (7th Cir. 1986).

112. See, e.g., MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 2.09[F] (2005); Shelley R. Saxer, Note, *Baltimore Orioles, Inc. v. Major League Baseball Players Association: The Right of Publicity in Game Performances and Federal Copyright Preemption*, 36 UCLA L. REV. 861 (1989).

113. *Toney III*, 406 F.3d at 911. It is difficult to follow the court’s reasoning without ultimately concluding that Toney’s right of publicity claim intrudes on the domain of copyright, in a manner similar to *Baltimore Orioles*, by affording to Toney the ability to prevent L'Oreal from distributing its photographs. It is therefore difficult to distinguish *Baltimore Orioles* from *Toney* in the manner that the court suggests while upholding preemption of the *Baltimore Orioles* claims and not doing the same for Toney’s. This is likely the court’s best effort to marginalize *Baltimore Orioles*, given that only an en banc court can overrule the decision of a Seventh Circuit panel.

III. DISCUSSION

The differences in the various courts' analyses in the *Toney* case delineates two fundamental issues with which the Seventh Circuit struggled in adjudicating *Toney's* claim. First, for § 102 analysis, is the relevant "work" the medium in which the persona appears,¹¹⁴ or the persona itself?¹¹⁵ Second, for § 106 analysis, is a party precluded from bringing a right of publicity claim simply because prevailing on that claim will result in the defendant being unable to exercise an exclusive copyright? This Part discusses the likely result of *Toney III* for preemption of right of publicity claims, presents the state of the law in other circuits, and analyzes implications for the future.

A. Under *Toney III*, § 301 Never Preempts Right of Publicity Claims

For § 301 to preempt a right of publicity claim, the *object* of the claim must be a work of authorship fixed in a tangible medium of expression.¹¹⁶ Whereas the *Toney II* court held that a likeness is fixed for purposes of § 301 preemption when it is embodied in a tangible medium of expression,¹¹⁷ the *Toney III* court held that a persona can never be fixed because a persona is not itself copyrightable.¹¹⁸ Whether or not a particular right of publicity claim satisfies the test is entirely dependent on which test a court adopts. If a court adopts the *Toney II* interpretation, right of publicity claims are always preempted because a likeness has to appear in some kind of medium before its use can violate the right of publicity.¹¹⁹ Since the persona is fixed in a tangible medium of expression, it falls directly within the scope of copyright, and is therefore preempted. Conversely, the *Toney III* court's interpretation results in right of publicity claims never being preempted because the substance of a right of publicity claim, a persona, is not copyrightable subject matter.¹²⁰ As a result, the § 102 test is

114. See, e.g., *Brode v. Tax Mgmt., Inc.*, 14 U.S.P.Q.2d 1195, 1203 (N.D. Ill. 1990); *Ippolito v. Ono-Lennon*, 526 N.Y.S.2d 877, 881-82 (Sup. Ct. 1998) (finding that the relevant work is the matter in which the persona inheres).

115. See, e.g., *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003-05 (9th Cir. 2001) (finding that the relevant work is the persona); *Brown v. Ames*, 201 F.3d 654, 658-59 (5th Cir. 2000).

116. 17 U.S.C. § 301.

117. *Toney II*, 384 F.3d 486, 489 (7th Cir. 2004).

118. *Toney III*, 406 F.3d at 908-09.

119. See *Rothman*, *supra* note 10, at 233-34.

120. *Rothman*, *supra* note 10, at 233 (noting that one interpretation always results in preemption while the other never does).

not satisfied, and the claim is not preempted.¹²¹ Applying the *Toney III* test to cases where courts have found the right of publicity claim to be preempted will demonstrate that under *Toney III*, § 301 will never preempt a right of publicity claim.

In *Ahn v. Midway Manufacturing Co.*,¹²² three plaintiffs brought a right of publicity action against videogame distributors and publishers.¹²³ The plaintiffs had modeled for the *Mortal Kombat* series of video games and were told that they would receive bonuses if the games were successful.¹²⁴ The *Mortal Kombat* series proved to be very successful and, as a result, the video game companies decided to release home console and handheld versions of the arcade originals.¹²⁵ The companies asked the plaintiffs to sign a new agreement for use of their images, and the plaintiffs refused.¹²⁶ After the games entered the market, the plaintiffs filed suit, alleging that the use of their images in the handheld and home console versions without their permission violated their publicity rights. The *Ahn* court interpreted § 102 exactly as the *Toney II* court did, looking to the medium in which the appropriated likeness appeared.¹²⁷ The court found that the plaintiffs' likenesses were "fixed" because they were videotaped with the plaintiffs' consent.¹²⁸ Since their performances on the videotape were choreographic, and choreographic works were copyrightable, the work in question fell within the subject matter of copyright.¹²⁹ As a result, the plaintiffs' right of publicity claims fell under the first requirement for § 301 preemption.¹³⁰

If the plaintiffs brought their right of publicity claims in the Seventh Circuit today, their claims likely would not be preempted. The court determining preemption would not ask whether the home console and handheld versions of the *Mortal Kombat* games, in which the plaintiffs' likenesses appeared, are copyrightable. Rather, the court would note that the games incorporated the plaintiffs' personas. Since personas cannot be fixed and are not within the subject matter of copyright, the plaintiffs'

121. Note that neither the preemption rule of *Toney II* nor the preemption rule of *Toney III* go to the merits of a preemption claim or the defenses that can defeat a right of publicity suit.

122. 965 F. Supp. 1134 (N.D. Ill. 1997).

123. *Id.* at 1135.

124. *Id.* at 1136.

125. *Id.*

126. *Id.*

127. *See id.* at 1138; *Toney II*, 384 F.3d at 489-90.

128. *Ahn*, 965 F. Supp. at 1138.

129. *Id.*

130. *Id.*

claim would not satisfy the first requirement of § 301 preemption, and therefore would not be preempted.

The California Court of Appeal addressed a similar question in *Fleet v. CBS, Inc.*,¹³¹ where a group of actors attempted to use right of publicity claims to enjoin the distribution of a film because the distributor had not compensated them for their performance.¹³² The distributor countered that it held a copyright in the film,¹³³ and should be able to make use of the exclusive right of distribution that copyright protection affords.¹³⁴

The court found that § 301 preempted the actors' right of publicity claims. In its § 102 analysis, the court reasoned that the actors' portrayal in the film was copyrightable. Once the studio fixed their performances on film, "the performances came within the scope or subject matter of copyright law protection."¹³⁵ Finding further that the actors were only trying to prevent the distributor from exercising its exclusive right to exhibit a copyrighted work,¹³⁶ the court dismissed the actors' claims as preempted.¹³⁷ Upholding the plaintiffs' claim would have had a devastating effect on the use of § 106 rights because the claimants had no copyright in the matter in question and merely sought to prevent the true copyright owner from using those rights. This would hardly be in accord with Congress's desire "[t]o 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."¹³⁸

But if the actors had brought their claims in the Seventh Circuit today, the court inevitably would have to conclude that the "work" in question is not the film itself, or the actors' performances, but rather their personas. Since these cannot be "fixed," the "work" in question cannot come within the subject matter of copyright. As a result, § 301 would not preempt the actors' right of publicity claims.¹³⁹ Assuming the plaintiffs eventually prevailed on their claims, the distributor would be enjoined from exhibiting the film. This would be a disservice both to the unfortunate distributor whose copyright in the film would be curtailed, and to the public who

131. 50 Cal. App. 4th 1911 (Ct. App. 1996).

132. *Id.* at 1914-15.

133. *Id.* at 1916.

134. *See id.*

135. *Id.* at 19-20.

136. *See* 17 U.S.C. § 106.

137. *Fleet*, 50 Cal. App. 4th at 19-20.

138. U.S. CONST. art. I, § 8, cl. 8.

139. Note that the consent defense might still prevent the plaintiffs from prevailing on their claim. However, it is troubling that the plaintiffs would get past preemption for reasons discussed *infra* at Section III.C.

would not have the benefit of experiencing the film, and would ultimately run up against copyright's constitutional mandate.

This particular scenario highlights the implications of the *Toney III* court's § 102 analysis. Any person has a valid claim to enjoin the exercise of copyrights if she simply alleges that the misappropriated object within the particular work contains her persona.¹⁴⁰ If Jennifer Aniston sues a bar owner for violating her right of publicity by playing a *Friends* episode, the Seventh Circuit would not find § 301 to preempt her claim because the right she claims is the ability to control the use of her persona.¹⁴¹ If Arnold Schwarzenegger walks into a Hard Rock Café and sees a poster of the *Terminator* with his face on it, his subsequent right of publicity claim likely would survive preemption in the Seventh Circuit because his claim arises out of the restaurant's use of his persona, not the copyrightable expression inherent in the poster itself.¹⁴² If the purpose of § 301 preemption is to prevent state claims from interfering with copyrights, *Toney III*'s interpretation of § 102 analysis ironically allows exactly that.¹⁴³

B. The Ever-Expanding Right of Publicity

While *Toney III* conflicts with *Ahn* and *Fleet*, it follows a judicial trend of fashioning a way for right of publicity claims to survive preemption. Many circuits have allowed publicity claims to survive even when they clearly conflict with copyrights. In *Midler v. Ford Motor Co.*,¹⁴⁴ for example, the Ninth Circuit allowed Bette Midler's right of publicity claim to escape preemption where Ford hired an imitator to sing a song for its

140. There is, of course, a difference between preemption and prevailing on the merits. But if every claim of this type survives preemption, then merely the cost of defending against these kinds of lawsuits could have a devastating effect on the entertainment industry.

141. This is a response to hypotheticals posed by Rothman in testing her own theory. Applying the Seventh Circuit's test to Rothman's hypotheticals is illuminating because it highlights the inevitable problems that result from the *Toney III* test. See Rothman, *supra* note 10, at 262 (setting out the example of broadcasting the television show *Friends* in a bar, only to be confronted with a right of publicity claim when an actor in the show witnesses the broadcast).

142. See Rothman, *supra* note 10, at 264.

143. Note that performers may contract away their right of publicity, or may agree to waive all publicity rights in the promotional materials flowing from their performances. Though this is a common practice, it only further proves the notion that the right of publicity overwhelmingly favors celebrities. While a celebrity may waive her right of publicity through contract negotiation with a studio or distributor, an independent, non-celebrity artist would have to waive her right of publicity or sacrifice a performance opportunity.

144. 849 F.2d 460 (9th Cir. 1988).

commercials in a manner that sounded very similar to Midler's voice.¹⁴⁵ Midler did not own the copyright in the musical composition, and Ford had purchased a license from the individual who did hold the copyright, in order to avoid potential liability.¹⁴⁶ When the commercial aired, Midler filed suit, alleging that Ford's use of her persona, by hiring a singer to imitate her, violated her right of publicity.¹⁴⁷ The Ninth Circuit held that her claim survived preemption.¹⁴⁸ Midler effectively prevented a licensed use of copyrighted material merely because the voice of the woman in the commercial sounded like hers.

In *White v. Samsung Electronics America, Inc.*,¹⁴⁹ Vanna White of "Wheel of Fortune" fame brought a right of publicity action against Samsung Electronics because of an advertisement it ran "starr[ing] a robot dressed in a wig, gown and jewelry reminiscent of Vanna White's hair and dress; the robot was posed next to a Wheel-of-Fortune-like game board."¹⁵⁰ The Ninth Circuit found in favor of White because the advertisement usurped White's persona to the commercial benefit of Samsung.¹⁵¹ Similarly, in *Hirsch v. S.C. Johnson & Son, Inc.*,¹⁵² an athlete commonly known as "Crazylegs" brought a right of publicity claim against a company that had offered for sale women's personal products under the same name.¹⁵³ The Supreme Court of Wisconsin held that the athlete's claim should withstand preemption because "Crazylegs" evoked his persona.¹⁵⁴

In *Landham v. Lewis Galoob Toys, Inc.*,¹⁵⁵ the Sixth Circuit found that Sonny Landham's right of publicity claim was not preempted, even though his claim arose out of the defendant's merchandising of toys based on Landham's character in the movie *Predator*.¹⁵⁶ Citing the Ninth Circuit's logic in *Midler*, the court allowed Landham to proceed with this right of publicity claim even though he had no copyright in the character

145. *Id.* at 462-64.

146. *Id.* at 462.

147. *Id.*

148. *Id.* at 464.

149. 971 F.2d 1395 (9th Cir. 1992).

150. *Id.* at 1514 (Kozinski, J., dissenting).

151. *Id.* at 1399.

152. 280 N.W.2d 129 (Wis. 1979).

153. *Id.* at 130.

154. *Id.* at 138.

155. 227 F.3d 619 (6th Cir. 2000).

156. *Id.* at 621, 623.

he played in the movie, and no particular right in merchandising for the *Predator* films.¹⁵⁷

The Fifth Circuit also followed suit in *Brown v. Ames*.¹⁵⁸ The court found that the plaintiffs' right of publicity claims, arising out of the defendants' unauthorized use of their likenesses to market the plaintiffs' own musical performances on CD's and cassettes, did not fall within § 301 preemption.¹⁵⁹ Noting that the right of publicity protects an individual's right to control the use of his persona, as opposed to controlling the use of a work of authorship, the court held that the substance of a right of publicity claim differed from the content of a copyright infringement claim.¹⁶⁰ As a result, the claims were not preempted.

There is one key similarity between the Seventh Circuit's analysis of § 301 preemption in *Toney III* and these other courts: they view the content of a right of publicity claim as the right to control the use of one's persona. Since personas are not fixable in a tangible medium of expression, it is unlikely that any of these courts will ever find a right of publicity claim to be preempted under § 301, no matter how detrimental that might be to the rights of a copyright holder and the public. As a result, all of these decisions have expanded publicity rights and, in the process, have limited the scope of copyright.

C. Going Forward: The Implications for Copyright

This trend, which the Seventh Circuit embraced in *Toney III*, will likely have significant consequences for copyright. The Copyright Act seeks to provide an incentive for individuals to create and innovate, giving them an economic monopoly on their creations for a limited time.¹⁶¹ This monopoly benefits not only the private actor but, more importantly, the public through the dissemination of creative and expressive works.¹⁶² The Seventh Circuit's interpretation of the right of publicity may upset this delicate balance since a single plaintiff may stop the distribution, repro-

157. *Id.* at 624.

158. 201 F.3d 654 (5th Cir. 2000).

159. *Id.* at 656.

160. *Id.* at 658.

161. *Twentieth Century Music Corp v. Aiken*, 422 U.S. 151, 156 (1975) ("Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts."); *see generally* ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 325 (2003).

162. *Twentieth Century Music Corp.*, 422 U.S. at 156 ("The immediate effect of our copyright law is to secure a fair return to an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.")

duction, display, or performance¹⁶³ of these creative works simply by alleging that the work appropriates her persona without authorization. This could have a chilling effect on creation and innovation, even if a claimant ultimately does not prevail on his right of publicity claim. If an author risks liability for violating the right of publicity merely by exploiting § 106 rights, then there is a strong disincentive to ever exploit those rights. Works that would greatly benefit the public through dissemination may remain dormant, or simply fall by the wayside because it is not worth the risk of having to defend against a right of publicity suit.

Toney III likely will have detrimental effects in all creative forums. Artists will have to take care to ensure that their sculptures or paintings do not evoke the persona of a celebrity when viewed by an audience. Musicians will need to be careful not to play their instruments in a style that is commonly associated with another musician with more fame. Songwriters will be forced to avoid using chord progressions that were previously used by famous bands simply because hearing a particular progression would remind the listener of the persona of another. Advertisers will have to make certain that their use of voice-overs does not sound like the voice of a celebrity. Biographers will have to seek permission from the individuals about whose lives they wish to write. Comedians will no longer be able to satirize the conduct of celebrities for fear that their use of a celebrity's name or persona in their act will give rise to a right of publicity claim. These are of course extreme examples, some of which might not succeed on the merits. But the threat of a suit is powerful, as is the fear that arises from it. The *Toney III* rule ultimately hurts most severely those individuals who need unfettered copyright protection more than any other, and are least served by the right of publicity: independent, unsophisticated creators and performers.

Although a creator can license the needed publicity rights, the average creator has neither the legal nor financial capability of seeking such rights every time his work might evoke or use the persona of a celebrity. Nor does the average creator have the capability to defend against suit after suit, even if she will eventually prevail on the merits. While movie studios and record companies could require individuals whose personas appear within their works to waive their right of publicity both in the original work and in later licenses in order to avoid the potential pitfalls of a right of publicity suit, this avenue likely is unavailable to independent creators. Similarly, independent performers who are in need of performance opportunities will have little bargaining power to resist waiving their right of

163. See *supra* note 20.

publicity, lest they quickly be replaced by another performer who is more willing. The end result is that all independent performers will be forced to waive their publicity rights, all independent creators will have to incur the significant costs of licensing the use of a persona, and sophisticated parties like movie studios and celebrities are free to negotiate as they wish. As a result, only the most sophisticated of parties will be protected by the *Toney III* rule either because they can afford to negotiate more favorable licenses and contract terms, or because they can file suit after suit to stop distribution of any work of which they do not approve.

It would be inconsistent to assume that Congress, in providing creators a monopoly over the use of their creative works, intended at the same time to allow the expression of those works to be curtailed the moment a celebrity whose persona appears in a particular work disapproves. The secondary result that only celebrities will retain their publicity rights because of their ability to negotiate more freely than independent performers is also inconsistent with the privacy theory on which the right of publicity is based. That the public interest that is served by the flow of creative expression from artist to audience, and by the right "to be let alone," can so summarily be defeated seems to disserve the constitutional mandate, and is unfortunately the likely result of the *Toney III* rationale. This outcome works directly against Congress's, and the public's, interest in fostering the creation and dissemination of creative works.

IV. CONCLUSION

An unfettered right of publicity, as seen in *Toney III*, is counterproductive because it can conflict with copyright principles, and abrogate copyright protections. This consequence is exactly what Congress sought to prevent by enacting § 301 preemption. Eliminating the right of publicity entirely¹⁶⁴ is likely not the answer because there are legitimate privacy interests that the right protects, especially for non-celebrities. However, there are circumstances in which the right of publicity must give way in order to ensure that copyright, and the utilitarian principles behind it, are effective. Viewing the content of a right of publicity claim as protection of a persona and considering copyright ownership of the medium in which the persona appears to be irrelevant have negative consequences. This approach creates pitfalls within the copyright system, weakening the position of independent artists who do not have the ability to avoid contracting out of their right of publicity, and diluting the position of independent creators

164. See Goldman, *supra* note 7.

who likely cannot afford to seek licenses from celebrities for use of their personas.