

# THE SUBJECT STRIKES BACK: INTELLECTUAL PROPERTY LAW, VISUAL PLEASURE, AND RESISTANCE IN THE ARTS

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*In which we discuss self-infringement, monkey selfies, wildlife, Oscar Wilde, (Richard) Prince, Prince (Rogers Nelson), kissing sailors, the metaphor of the hunt, fatwās, the Masters, the male gaze, revenge porn, peeping Toms, surveillance art, nudes at the Met, Rastafarians, celebutantes, Andy Warhol, Jeff Koons, Rockwellian tranquility, and the Three Stooges*

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#### INTRODUCTION: CAPTURING THE SUBJECT

*Load. Aim. Shoot.* Photography's fraught phraseology unabashedly employs the metaphor of vengery, exhorting us to the hunt with the subject as prey. As Susan Sontag once argued:

To photograph people is to violate them, by seeing them as they never see themselves, by having knowledge of them they can never have; it turns people into objects that can be symbolically possessed. Just as the camera is a sublimation of the gun, to photograph someone is a sublimated murder—a soft murder, appropriate to a sad, frightened time.<sup>1</sup>

Caught by the camera's eye, image subjects have remained relatively powerless in the photographer's (often white and/or male) gaze. Once captured, subjects tend to recede from any legal calculus as their

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1. SUSAN SONTAG, ON PHOTOGRAPHY 10 (1973).

likeness is reproduced, distributed, and publicly displayed in perpetuity. As the government-granted monopoly that superintends the use of creative works, copyright typically vests in the individual behind the camera. Thus, the further exploitation of the images comes under the exclusive control of the depicter, not the depicted. In the process, therefore, copyright law weaponizes “the camera as phallus,”<sup>2</sup> enabling the full realization of photography’s hunting metaphor with the imprimatur of the state.

But, in recent years, the subjects have struck back. From hip-hop artist/businessman Jay-Z and model/actress Emily Ratajkowski, to pop star Taylor Swift and viral sensation Naruto, the crested macaque, subjects are pushing for greater control over the exploitation of their images and personae. Notwithstanding some recent, limited success, however, subjects continue to face an uphill battle. This Article assesses the legal landscape related to subject rights, with a particular emphasis on intellectual property law. In the process, the analysis seeks to shed light on the stakes at issue, the concerns with the existing legal regime, the obstacles presented by the extant jurisprudence, and the prospects and potential avenues for change.

This Article begins with an examination of modern artist Richard Prince’s notorious *New Portraits* series. An appropriationist commentary on digital identity, *New Portraits* featured unauthorized, supersized copies of a number of provocative Instagram posts.<sup>3</sup> Prince generated headlines for his brazen commercial misappropriation of these third-party images and raised important questions regarding subject rights.<sup>4</sup> This case study pays particular attention to the trenchant objections raised by two of the works’ unwitting subjects—Zoë Ligon, who responded with a poignant protest against the series’s exhibition after it caused her to relive a painful history of sexual trauma, and Emily Ratajkowski, who parried Prince’s act of image imperialism with a meta-capitalistic piece of performance art that reclaimed her image and out-earned Prince in the process. Ligon and Ratajkowski’s travails highlight the dignitary and economic harms that can result from the unauthorized exploitation of someone’s image and the limited options that subjects have at their disposal to oppose such activities. Indeed, legal doctrine has long frustrated efforts at

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2. *Id.*

3. See Amy Adler, *Why Art Does Not Need Copyright*, 86 GEO. WASH. L. REV. 313, 315 (2018) (explaining how Prince created the *New Portrait* series).

4. *Id.*

resistance by victims of unwanted artistic misappropriation (such as the surveilled subjects of Arne Svenson's voyeuristic series, *The Neighbors*, and Juliana Huxtable, the subject of Frank Benson's acclaimed *Juliana* sculpture) by leaving them without rights to control the representation of their bodies in the public sphere. This Article explores both how and why by providing a systematic assessment and critical reading of the legal theories upon which subjects might rest potential claims.

Subject rights have found limited recognition through three primary vehicles: the federal Copyright Act;<sup>5</sup> state and common law right of publicity protections; and the federal Lanham Act<sup>6</sup> and analogous unfair competition provisions at state and common law. The next three Parts of the Article examine each regime in turn. At first blush, copyright law would seem to hold promise as a candidate for recognition of subject rights. After all, assuming there are no contracts circumventing default rules, first principles of authorship generally support rewarding creative efforts with vested rights. But, as it turns out, the creative contributions to copyrighted works made by those in front of the camera have rarely translated into recognized interests. The reason for this peculiar state of affairs resides in the authorship-as-fixation doctrine. With its accidental origins in *Burrow-Giles Lithographic Co. v. Sarony*<sup>7</sup>—the Supreme Court's seminal decision affirming the copyrightability of photography—the doctrine has achieved more forceful expression in recent years in cases such as *Garcia v. Google, Inc.*<sup>8</sup> and has served to effectively preclude the likes of Ligon, Ratajkowski, Huxtable, or the subjects of *The Neighbors* from raising copyright claims against those who profiteer from their representations. But despite some understandable public policy justifications for the juridical conflation of authorship with fixation, there are good reasons to question the unadulterated embrace of the doctrine. As a careful analysis reveals, authorship-as-fixation lacks support in the text of the Copyright Act, betrays the utilitarian origins and theoretical grounding of our copyright regime, and—as the case of Naruto the macaque and other claims involving celebrity 'self-infringement' demonstrate—creates outcomes that can fly in the face of common sense and result in troubling consequences. However, so long as it remains the reigning law of the land, authorship-as-fixation will

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5. 17 U.S.C. §§ 101–1401.

6. Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified at 15 U.S.C. §§ 1051–1127).

7. 111 U.S. 53 (1884).

8. 786 F.3d 733 (9th Cir. 2015) (en banc).

preclude recognition of subject rights, no matter how warranted reexamination of the doctrine might be.

With copyright claims roadblocked, subjects have turned their attention to two alternative intellectual property regimes to seek relief against the unauthorized exploitation of their likenesses and personae. However, a detailed inquiry into the application of right of publicity and trademark law to subject rights suggests that both regimes present significant obstacles to achieving protection and would raise critical concerns in the process. Reliance on right of publicity law to vindicate subject rights, particularly as they pertain to the use of photographs or films embodying a subject's likeness, provokes thorny issues of preemption that courts have not sufficiently addressed. In addition, the extant jurisprudence has failed to draw a satisfactory line between actionable advertising/merchandising uses of a likeness and non-actionable artistic uses—a distinction that carries significant implications for expressive freedoms. Finally, the chaotic, patchwork nature of right of publicity protections afforded by various states has spurred forum shopping, as the vastly different scopes of protection, scienter requirements, anti-SLAPP safeguards, and First Amendment-related defenses have resulted in gamesmanship and strategic maneuvering that threaten to undermine creative commerce in the national marketplace.

Meanwhile, although some subjects have enjoyed success through the Lanham Act and related theories of unfair competition, the relevant jurisprudence governing the threshold issues of trademarkability and likelihood of confusion has suffered from incongruity and unpredictability. While courts have generally rejected infringement allegations related to the use of a pure likeness or “signature vocal performance,” they have, without sufficient justification, received claims related to non-vocal actions and voices more favorably. The prevalence of judicial skepticism over trademark claims seeking to protect unauthorized use of a subject's likeness or persona is understandable in light of the public policy concerns animating federal trademark law. With the Lanham Act's ultimate focus centered on consumer confusion, rather than on the protection of dignitary or economic harms to subjects whose valuable personality rights have been usurped, the propriety of relying on the statute for the vindication of subject rights remains questionable. These concerns are further buttressed by how recognition of subject rights through the Lanham Act could undermine the copyright regime by undercutting the exclusive rights secured by those deemed authors.

All told, while this Article remains sympathetic to the cause of subject rights, it critiques the ways that courts have approached the issue through the prism of three intellectual property regimes. It also argues that the prospects for vindication of subject rights may be best served by eschewing right of publicity and trademark law and relying, instead, on copyright law to acknowledge and reward the significant creative labors of those in front of the camera. This, of course, would require a wholesale reexamination of the authorship-as-fixation doctrine, which is ripe for reconsideration. To illustrate this point, this Article concludes by grafting the extant law of subject rights onto the Second Circuit's holding in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*,<sup>9</sup> for which the Supreme Court recently granted certiorari.<sup>10</sup> The profound implications of *Warhol* reverberated through both the legal and art worlds alike when the Second Circuit found that Andy Warhol's famous prints of pop star Prince, which were based on Lynn Goldsmith's photograph of Prince, were not excused from infringement liability under the fair use doctrine.<sup>11</sup> But an analysis of the creative and value contributions to the ultimate Warhol artwork calls into question the hierarchy of rights embraced by the court, wherein Goldsmith now expressly controls Warhol's artistic production while Prince, the originator (or, dare one say, author) of his distinctive style and persona, has no legal say. As the holding in *Warhol* illustrates, our intellectual property laws still have significant work to do in properly aligning creative contributions with the reward of rights, in recognizing the economic value and dignitary interests of subjects, and in balancing the rights of fixers and users with the rights of subjects. This Article aims to provide a small, but important, step in that direction and to encourage further discourse and interventions on the topic.

#### I. THE *BLURRED LINES* OF SUBJECT RIGHTS: RICHARD PRINCE'S NEW PORTRAITS

This examination of subject rights begins with the most recent controversy involving Richard Prince, the copyright *bête noir* of the art world. In 2013, Prince won a seismic victory in a copyright infringement lawsuit brought by photographer Patrick Cariou, whose

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9. 11 F.4th 26 (2d Cir. 2021), *cert. granted by* \_\_ S. Ct. \_\_, 2022 WL 892102 (Mar. 28, 2022).

10. *Id.*

11. *Id.* at 124–25.

Rastafarian images Prince had taken, altered (including by painting “lozenges” over the faces of the subjects), and combined with other appropriated art to form pastiche compositions.<sup>12</sup> In the case, *Cariou v. Prince*,<sup>13</sup> the United States Court of Appeals for the Second Circuit reversed the lower court and deemed Prince’s works largely transformative and, as such, fair use immunized him from infringement liability.<sup>14</sup>

Following his triumph in *Cariou*, a newly emboldened Prince released his *New Portraits* series, which examined questions of self-representation in the world of social media by making unauthorized use of a set of provocative (and often sexual) images that users had posted of themselves on Instagram. Each work in the series contained a reproduction of one such Instagram post/image, blown up to “absurd proportion,” with a single footer below containing Prince’s own cryptic reactions to the post/image.<sup>15</sup> These squib notes by Prince, which were attributed to his own Instagram account, @richardprince4, were hardly the stuff of erudite commentary; indeed, one litigant characterized them as “gobbledygook nonsens[e].”<sup>16</sup> Following a successful exhibition at the Gagosian Gallery, works in the *New Portraits* series sold for as much as \$100,000 each.<sup>17</sup>

Not surprisingly, the *New Portraits* series generated a new round of controversy over Prince’s work, and allegations of tortious misconduct quickly followed. The photographers who had captured the images featured in the series bristled at his wholesale and unauthorized exploitation of their work, and, despite Prince’s victory in *Cariou*, they

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12. Brian Boucher, *Richard Prince Wins Major Victory in Landmark Copyright Suit*, ARTNEWS (Apr. 25, 2013, 12:24 PM), <https://www.artnews.com/art-in-america/features/richard-prince-wins-major-victory-in-landmark-copyright-suit-59404> [<https://perma.cc/X72A-A2HJ>].

13. 714 F.3d 694 (2013).

14. *Id.* at 712.

15. Josh Russell, *Proof Is in the Pixels for Appropriation Artist Richard Prince*, COURTHOUSE NEWS SERV. (July 28, 2020), <https://www.courthousenews.com/proof-is-in-the-pixels-for-appropriation-artist-richard-prince> [<https://web.archive.org/web/20220221181529/https://www.courthousenews.com/proof-is-in-the-pixels-for-appropriation-artist-richard-prince>].

16. *Id.* (quoting Eric McNatt’s attorney, Caitlin Fitzpatrick).

17. Lizzie Plaugic, *The Story of Richard Prince and His \$100,000 Instagram Art*, VERGE (May 30, 2015, 11:28 AM), <https://www.theverge.com/2015/5/30/8691257/richard-prince-instagram-photos-copyright-law-fair-use> [<https://web.archive.org/web/20220221182101/https://www.theverge.com/2015/5/30/8691257/richard-prince-instagram-photos-copyright-law-fair-use>].

pursued formal claims of copyright infringement against him.<sup>18</sup> After all, Prince had handsomely profited from the series, which seemed to have only minimal ‘transformative’ elements that might have otherwise excused Prince’s unlicensed use of the photographers’ images.<sup>19</sup>

Just as significantly, a very different constituency—the subjects featured in the images—sounded serious opposition to Prince’s project by trumpeting the rights of the objectified. For example, a snapshot of Zoë Ligon, a sex educator and boutique owner, served as the focus of one of Prince’s *New Portraits*. Ligon had posted the image, which featured her donning a red bra, on her Instagram account, and she was particularly horrified at Prince’s repurposive use of the photograph because of her personal history as a victim of sexual abuse.<sup>20</sup> In response, Ligon bravely shared her survival story and vocally lobbied museums and galleries against the public exhibition of the Prince series.<sup>21</sup> Ligon explained that she had used sexualized photographs of herself as a mechanism to reclaim control over her body and its representation.<sup>22</sup> Prince’s unauthorized usurpation and exhibition of Ligon’s image (at the Museum of Contemporary Art Detroit (MOCAD) in Ligon’s own hometown, no less) forced Ligon to relive her sexual trauma.<sup>23</sup> “My being harmed only contributes to the ‘art’ of it all, and this resembles revenge porn and harassment more than anything else,”<sup>24</sup> she explained.

Ultimately, MOCAD offered to remove Ligon’s portrait from the show but declined to cancel the exhibition altogether.<sup>25</sup> Ligon refused the gesture, decrying the spectacle as “expropriation—the seizure of property for an intended public benefit, except it is the wealthy

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18. See, e.g., *Graham v. Prince*, Case No. 1:15-cv-10160-SAS (S.D.N.Y. Dec. 30, 2015); *McNatt v. Prince*, Case No. 1:16-cv-08896 (S.D.N.Y. Nov. 16, 2016).

19. Plaugic, *supra* note 17.

20. Ryan Patrick Hooper & LaToya Cross, *Meet Zoe Ligon, the Sex Educator Calling out MOCAD’s Controversial “New Portraits” Exhibit*, WDET (Nov. 6, 2019), <https://wdet.org/posts/2019/11/06/88857-meet-zoe-ligon-the-sex-educator-calling-out-mocads-controversial-new-portraits-exhibit> [<https://perma.cc/DDN7-EK8W>].

21. *Id.*

22. *Id.* (quoting Zoë Ligon as explaining that “part of the reason I take ‘sexy selfies’ is because I am reclaiming my own sexual[] image”).

23. *Id.*

24. Naomi Rea, *Appropriation Art or Revenge Porn? The Subject of a Richard Prince Instagram Portrait Slams the Artist’s Use of Her Image*, ARTNET (Nov. 5, 2019), <https://news.artnet.com/art-world/richard-prince-appropriation-instagram-1696413> [<https://perma.cc/VZF9-G7JC>].

25. *Id.*

one-percenter art world which benefits in this case . . . not the public.”<sup>26</sup> Meanwhile, the director of MOCAD, Elysia Borowy-Reeder, defended the show by highlighting its role in promoting discourse around the provocative questions about ownership that Ligon’s concerns raised.<sup>27</sup>

Capitalistic resistance drove the response from another subject featured in Prince’s *New Portraits* series. In her poignant essay, *Buying Myself Back: When Does a Model Own Her Own Image?*,<sup>28</sup> model/actress Emily Ratajkowski detailed her travails in the fashion industry and the ways in which systematic male exploitation and profiteering from her image had provoked a pervasive sense of powerlessness within her.<sup>29</sup> In the piece, Ratajkowski recounted the sexual assault she suffered during an unpaid 2012 shoot at the hands of an abusive photographer, Jonathan Leder, and the pain and anger she endured as he published three books featuring the naked Polaroids he took of her that day.<sup>30</sup> While Ratajkowski did not specifically cite either Susan Sontag’s theories or the metaphor of photographic predation, those concepts permeated her narrative, and she vowed to resist future efforts to exploit her representation, stating publicly that she would “own[] the high-art Emily,” and “carve out control where she can find it.”<sup>31</sup> She made good on this promise only months later.

In a shrewd riposte to Prince, Ratajkowski got the last laugh when she auctioned off a digital-only non-fungible token (“NFT”) version of a photograph of her posing in front of the very *New Portrait* in which Prince had featured a bikini shot of her.<sup>32</sup> In the process, Ratajkowski served up a stinging meta-response to Prince’s unwanted misappropriation of her likeness: she profited from an image of

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26. *Id.*

27. As MOCAD’s director, Elysia Borowy-Reeder, posited, the exhibit provoked such inquiries as, “[i]s social media empowering people or co-opting artistic production? Where do our expectations and perceptions around privacy and consent lead us when using social media? What are you consenting to when posting? Is all photography exploitative?” *Id.*

28. Emily Ratajkowski, *Buying Myself Back: When Does a Model Own Her Own Image?*, CUT (Sept. 15, 2020), <https://www.thecut.com/article/emily-ratajkowski-owning-my-image-essay.html> [<https://perma.cc/8EUS-THDX>].

29. *Id.*

30. *Id.*

31. *Id.*

32. To view the NFT, see Kate Dwyer, *Emily Ratajkowski Is Selling an NFT at Christie’s*, N.Y. TIMES (Nov. 8, 2021) <https://www.nytimes.com/2021/04/23/style/emily-ratajkowski-nft-christies.html> [<https://perma.cc/KU6D-RAT8>].

herself, posing before an image of Prince's work in which she had unwittingly starred. She dubbed her work (and, for that matter, her resistive act of performance art) *Buying Myself Back: A Model for Redistribution*.<sup>33</sup> She auctioned her NFT through Christie's for a whopping \$140,000—almost twice the cost of Prince's *New Portrait* featuring her, which had sold for \$81,000—to none other than Ratajkowski herself.<sup>34</sup>

Unfortunately, not everyone can harness the power of the marketplace to resist the unauthorized exploitation of one's likeness.<sup>35</sup> Considering that few people possess the immense economic or social capital of Ratajkowski, others may struggle to level the playing field in a similar way. Moreover, if, in fact, greater recognition for subject rights were a desirable goal, it would hardly seem ideal or equitable to leave the preservation of such dignitary interests to the marketplace's invisible hand.

Of course, the various subjects of Prince's *New Portraits* are not alone in finding themselves unwittingly objectified by the art world. Rather, such objection is, unfortunately, a tradition as old as art itself. In recent years, numerous such controversies have garnered headlines. For example, contemporary artist Frank Benson came under fire for *Juliana*, a nude sculpture he featured at the 2015 New Museum

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33. *Id.*

34. Michael Ordoña, *This Picture of Emily Ratajkowski Is Free to Look at. But Its NFT Sold for \$140,000*, L.A. TIMES (May 17, 2021, 3:17 PM), <https://www.latimes.com/entertainment-arts/story/2021-05-17/emily-ratajkowski-nft-sells-for-140000> [<https://web.archive.org/web/20220221191419/https://www.latimes.com/entertainment-arts/story/2021-05-17/emily-ratajkowski-nft-sells-for-140000>]. While Ratajkowski owns the Prince *New Portrait* print in which she starred, her purchase would not have typically included the copyright to that work. That copyright would remain with the artist—Richard Prince. And, ironically, if Prince were to be litigious, he could plausibly claim that the unauthorized NFT, which reproduced his work without permission, was an act of infringement. But such a step might be myopic, as the legality of Prince's own actions in creating the *New Portraits* themselves is very much in question. As such, it would take a galling level of chutzpah (and poor judgment) for Prince to threaten legal action against Ratajkowski, a fact that she likely banked on when she elected to proceed with the NFT.

35. While Ratajkowski may not have hundreds of millions of dollars, she enjoys both some wealth and tremendous social media influence—a form of cultural cachet that she can convert into power and money in a manner that has enabled her to buy herself back (albeit not without significant sacrifices and financial stress). Ratajkowski, *supra* note 28.

Triennial.<sup>36</sup> Created from a 3-D scan of artist Juliana Huxtable's body, the work initially earned praise from critics for its celebration of trans bodies.<sup>37</sup> But the subject, Huxtable, notably objected, publicly decrying the sculpture as "A LITERAL EMBODIMENT OF EXPLOITATION I HAVE COME TO HATE."<sup>38</sup>

Meanwhile, an ambitious project in surveillance art called *The Neighbors* by photographer Arne Svenson has also raised concerns about the rights of those who unwittingly find themselves on celluloid or canvas.<sup>39</sup> From the comfort of his TriBeCa loft, Svenson utilized high-powered telephoto lenses intended for bird watching to surreptitiously snap candid photographs of his well-heeled neighbors as they napped, cleaned, and engaged in other mundane activities in their nearby luxury apartments.<sup>40</sup> The provocative results formed the basis of a noted exhibition, commanded significant prices on the art market, and received acclaim on artistic, though not ethical, grounds.<sup>41</sup> Some of the neighbors unknowingly captured during these unguarded moments objected to Svenson's project and sued him for invasion of privacy.<sup>42</sup> But when a trial court held that he was no ordinary peeping

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36. *Juliana Huxtable Blowing up the System*, 52 *INSIGHTS* (Jan. 5, 2017), <https://www.52-insights.com/juliana-huxtable-art-blowing-up-the-system-transgendered-interview> [<https://perma.cc/8W55-CMHP>].

37. Rosanna McLaughlin, *Emily Ratajkowski's 'The Cut' Essay and Why We Can't Buy Our Way out of Today's Toxic Image Economy*, *FRIEZE.COM* (Sept. 28, 2020), <https://www.frieze.com/article/some-thoughts-emily-ratajkowskis-cut-essay> [<https://perma.cc/Q3S5-BUTE>].

38. Juliana Huxtable (@huxtablejuliana), *TWITTER* (Aug. 6, 2020, 2:09 PM), <https://mobile.twitter.com/huxtablejuliana/status/1291436151509852162> [<https://perma.cc/T6EW-VGHL>].

39. John Tehranian, *Copyright's Male Gaze: Authorship and Inequality in a Panoptic World*, 41 *HARVARD J.L. & GENDER* 343, 355–57 (2018).

40. *New Yorkers Threaten to Sue Artist Who Secretly Photographed Them in Their OWN Apartments and Is Selling Prints for \$7,500*, *DAILY MAIL* (May 16, 2013), <http://www.dailymail.co.uk/news/article-2325757/New-Yorkers-threaten-sue-artist-secretly-photographed-OWN-apartments-selling-prints-7-500-dollars.html> [<https://perma.cc/63S6-CB6D>].

41. See, e.g., Catherine Wagley, *Arne Svenson: The Neighbors*, *PHOTOGRAPH MAG.* (Feb. 1, 2013), <https://photographmag.com/articles/arne-svenson-the-neighbors> [<https://perma.cc/793K-P2XY>] (referring to the collection of photographs as "lyrical" and positing that "[t]hey look the way a Milan Kundera novel sounds—removed and hazy, melancholically preoccupied with small moments").

42. See *Foster v. Svenson*, Case No. 651826/2013 (N.Y. Sup. Ct. 2013), *aff'd*, 7 N.Y.S.3d 96 (N.Y. App. Div. 2015) ("Plaintiffs move by Order to Show Cause for a preliminary injunction seeking to prevent dissemination and display of certain photographs.").

Tom, Svenson's artistic purpose ultimately gave him a First Amendment defense to liability.<sup>43</sup>

Notably, the plaintiffs in the case against Svenson did not raise any intellectual property claims. After all, as well shall see, the copyrights to the works indisputably belonged to Svenson *qua* voyeur. The plight of these disgruntled subjects begs the question as to what the law, especially in the arena of intellectual property rights, has to say about the control and dissemination of such works.

As the intellectual property regime that most directly regulates the exploitation of creative works, copyright law serves as the starting point of our analysis. To an observer unfamiliar with modern copyright jurisprudence, it might seem curious that the subjects of the *New Portraits* had to fight Prince extralegally, both in the court of public opinion and in the marketplace, given that the photographers of the images used by Prince could actually pursue legal action. This curious dichotomy results from copyright's almost complete foreclosure of the ability of subjects to obtain relief against such misappropriations. An examination of copyright's first principles of authorship helps explain this state of affairs.

## II. THE SUBJECT IN COPYRIGHT/THE COPYRIGHT IN SUBJECTS

Despite the innumerable creative contributions that subjects make to finished works of art in which they are featured, courts have traditionally rejected efforts to grant subjects any kind of authorial rights. As the wellspring of American authorship jurisprudence, *Burrow-Giles Lithographic Co. v. Sarony* laid the foundation for the historical exclusion of subjects from the copyright conversation by reading copyright's authorship doctrine in a manner that fetishizes both singularity and the control of fixation.<sup>44</sup> The resulting authorship-as-fixation doctrine may have served us well by promoting the alienability of (intellectual) property rights and market efficiency. But it has come at an expense—both in fealty to copyright's utilitarian goals and to equitable concerns regarding the consumption of visual pleasure and the right to control representations of the human form. As an exegesis of the *Sarony* decision and its progeny highlights, the problematic conflation of authorship with fixation has precluded protection for subject rights and, in the process, impoverished our copyright regime.

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43. *See id.* at 6.

44. 111 U.S. 53, 61 (1884).

A. *Oscar Wilde, the Law of the Camera, & the Rights of the Subject*

In 1865, Congress amended the Copyright Act to extend protection to the output of a recent invention: the camera.<sup>45</sup> However, it was unclear whether Congress had the authority to do so, as the text of the Constitution only authorizes the grant of copyright protection to “authors” for their “writings.”<sup>46</sup> So, the actual protectability of photographs remained up in the air until 1884 when the Supreme Court finally confronted the issue by considering whether a posed shot of Oscar Wilde taken by Napoleon Sarony involved sufficient human originality to constitute a work of authorship.<sup>47</sup> In short, the Court had to ascertain whether photography was more science or art—i.e., whether it merely represented an act of mechanical reproduction facilitated by a scientific process involving the transmission of light or whether it constituted the product of a series of deliberate creative decisions made by a human being.<sup>48</sup> In the pivotal *Sarony* decision, the Court concluded the latter and, in the process, blessed the extension of copyright protection to the then-new technology of photography.<sup>49</sup>

Besides deciding the issue of whether photography constituted a work of authorship, *Sarony* did something else altogether: it vested the copyright to the particular image in question in the photographer—the individual *behind* the camera.<sup>50</sup> In 1884, such a conclusion was by no means foregone, and the Court could have come to a different conclusion by identifying the significant creative contributions that a variety of other individuals had provided to the image in question. For example, authorship could just as easily have vested in the person *in front of* the camera. As a “self-proclaimed aesthete,” Oscar Wilde added key expressive elements to the image in question with his carefully constructed persona, expression, and “trademark look with his head resting on his hand.”<sup>51</sup> In addition, there were other individuals behind the scenes who possessed viable claims to authorship of the particular

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45. Copyright Act of 1865, ch. 126, 13 Stat. 540 (Act of March 3, 1865).

46. U.S. CONST. art. I, § 8, cl. 8.

47. *Sarony*, 111 U.S. at 56.

48. Or, as Christine Haight Farley has put it, the Court had to ask: “Was it a scientific process involving the mere transmission of light, or did the resulting product reflect the genius of a Romantic author?” Christine Haight Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 409 (2004).

49. *Id.* at 386 (noting that “it is a well-known case in copyright law frequently cited for propositions about the originality standard”); *Sarony*, 111 U.S. at 55–56.

50. *Sarony*, 111 U.S. at 59.

51. Farley, *supra* note 48, at 433.

image in question. Benjamin Richard, Sarony's long-time cameraman and collaborator, actually snapped the shot and, in the process, contributed "creative choices in the precise timing to click the shutter, the angle of the shot, the frame, the focus, the distance from the subject, [and] the centering of the subject."<sup>52</sup> And it is entirely possible that an unknown makeup artist and costumer helped set out the distinctive compositional elements of the scene, which featured tapestries, fur, and a carefully mounded rug on which Wilde rested his foot.<sup>53</sup>

Yet the Court gave no consideration to these alternative sources of authorship. As Christine Haight Farley points out, it is "reasonable to question why the Court had chosen not to locate authorship in other practices" besides the directorial activities of the photographer.<sup>54</sup> The answer, at least in part, may come from a key fact set out at the beginning of the opinion: Wilde and Sarony had expressly contracted away the issue (at least *vis-à-vis* each other) and entered into an agreement that specifically deemed Sarony, and not Wilde, the "author, inventor, designer, and proprietor of the photograph."<sup>55</sup> Long overlooked by readers of the case, the existence of this contract is critical to understanding the *Sarony* decision for at least two reasons.

First, the contract precluded consideration of Wilde's authorial role. So, while subsequent observers and courts have frequently read *Sarony* as vesting authorship in the person behind the camera, the decision actually says nothing of the sort. Instead, the court simply addressed whether photographs constituted works of authorship under the Constitution's Copyright Clause.<sup>56</sup> Second, Sarony and Wilde's *ex ante* contract on the matter of authorship suggests the uncertainty surrounding that question, as various parties, including the photographer and the subject, could have made viable claims to authorship.<sup>57</sup> After all, works in the visual and performing arts, where

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52. *Id.* at 434.

53. To view the famous photograph and read more about the backstory leading to this controversy, see Mitch Tuchman, *Supremely Wilde*, SMITHSONIAN MAG. (May 2004), <https://www.smithsonianmag.com/arts-culture/supremely-wilde-99998178> [<https://perma.cc/76YT-3QBG>].

54. Farley, *supra* note 48, at 433.

55. *Sarony*, 111 U.S. at 54.

56. *Id.* at 58.

57. *Id.* at 54.

creation and fixation might diverge, were entirely new additions to copyrightable subject matter.<sup>58</sup>

That said, *Sarony* provided influential guidance to future courts on the concept of authorship by shaping the concept in manifestly unitary terms that encouraged the vesting of rights in a single master mind: “*he* to whom anything owes its origin; originator; maker; *one* to who completes a work of science or literature.”<sup>59</sup> *Sarony*’s “master mind” heuristic<sup>60</sup> reflects a romantic conception of authorship—where “solitary authors” birth original works “*ex nihilo* through their intellectual labors”<sup>61</sup>—that has pervaded our jurisprudence<sup>62</sup> and has, in turn, led courts to bestow rights automatically in the person who fixes the work in a tangible medium. While many individuals can appear before the camera or assist in wardrobe, scene-setting, and makeup behind the scenes, the fixer is usually singular—only one person literally clicks the button on the camera.<sup>63</sup> Since both the development processes of yore and the instant production process of today usually leave images in the possession of their fixers, an authorship-as-fixation regime renders identification of authorship more facile.<sup>64</sup> Crediting norms also favor fixers as their identities are

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58. See *Copyright Timeline: A History of Copyright in the United States*, ASS’N RSCH. LIBRS., <https://www.arl.org/copyright-timeline> [<https://perma.cc/K9Z3-MLZ6>] (discussing the history of copyrights).

59. *Sarony*, 111 U.S. at 57–58 (emphasis added).

60. As various commentators have noted, the idea of the “master mind” is a key concept in the romantic conception of authorship, which conceptualizes authors as solitary geniuses whose mythic individual efforts result in the creation of original works *ex nihilo*. See JAMES BOYLE, SHAMANS, SOFTWARE AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY 51–60 (1996); James D.A. Boyle, *The Search for an Author: Shakespeare and the Framers*, 37 AM. U. L. REV. 625, 629 (1988); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship,”* 1991 DUKE L.J. 455, 455–63 (1991).

61. Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early America*, 118 YALE L.J. 186, 188 (2008).

62. *Id.* (noting that this romantic conception of authorship “lies at the normative heart of our vision of copyright”). For example, the concept is central to the reigning joint authorship standard, which makes the possibility of joint authorship exceedingly difficult to achieve. For a more extensive discussion detailing the high bar for joint authorship imposed by courts, see Tehranian, *supra* note 39, at 371. The reluctance to recognize co-authorship appears to betray the realities of the artistic process and the multiplicity of important, original, and creative contributions in the development of works protected under the Copyright Act. *Id.*

63. John Tehranian, *Sex, Drones & Videotape: Rethinking Copyright’s Authorship-Fixation Conflation in the Age of Performance*, 68 HASTINGS L.J. 1319, 1368 (2017).

64. *Id.* at 1368–69.

usually memorialized.<sup>65</sup> So, although a contract precluded the *Sarony* Court from considering the subject of the photograph as the author, it should perhaps come as no surprise that we have (over)read *Sarony* as announcing a default standard vesting copyright in the person behind the camera—a move that triggered a century-long move towards the conflation of authorship and fixation.<sup>66</sup>

*B. The Authorship-as-Fixation Conflation: Silicon Valley, Hollywood, & the Fight Against Subject Copyright*

The authorship-as-fixation doctrine reached its apotheosis in *Garcia v. Google, Inc.*<sup>67</sup> In the 2015 decision, the Ninth Circuit flatly rejected the possibility that those solely in front of the camera could ever possess a copyright interest in a final work. The case was not without significant controversy and procedural twists and turns, however. Indeed, for a dangerous and tantalizing moment, the largest circuit court in the country briefly accepted the idea that, absent contracting away of rights, a subject could enjoy copyright interests—property rights that would grant them control over the usage of their images in works of art.<sup>68</sup>

In the suit, actress Cindy Lee Garcia sued Google in an attempt to enjoin it from continuing to make the movie *Innocence of Muslims* available on YouTube.<sup>69</sup> Garcia had a small role in the movie, which producers had pitched to her as a swashbuckling Arabian adventure under the inoffensive working title *Desert Warrior*. In fact, *Innocence of Muslims* was an unabashed polemic indicting Islam,<sup>70</sup> and, to add insult to injury, the movie's director took Garcia's performance—solicited under false pretenses—and overdubbed it so that she appeared to be

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65. *Id.*

66. *Id.*

67. *Garcia v. Google, Inc.* (*Garcia I*), 743 F.3d 1258 (9th Cir. 2014), *amended and superseded by* 766 F.3d 929 (9th Cir. 2014), *rev'd and remanded by* *Garcia v. Google, Inc.* (*Garcia II*) 786 F.3d 733, 747 (9th Cir. 2015) (en banc).

68. In particular, the disconnect between the aim of the copyright regime—the encouragement of creativity—and its vesting rules, which seem to deny authorial rights to a wide range of creators including those in front of the camera, raises serious questions.

69. The Digital Millennium Copyright Act (DMCA) safe harbor was not at issue since Garcia sought an injunction and the DMCA safe harbor does not apply to equitable relief. *See* 17 U.S.C. § 512(a)–(d), (j) (limiting the DMCA safe harbor to monetary relief).

70. *Garcia II*, 786 F.3d at 737.

making such inquiries as “[i]s your Mohammed a child molester?”<sup>71</sup> Garcia grew understandably concerned about the grave threats to her life she began to receive when the movie’s thirteen-minute trailer was distributed on YouTube and a fatwā issued against her. She therefore turned to copyright law to make her condemnation of the movie known and to try to limit its distribution.<sup>72</sup>

For a time, Garcia’s gambit succeeded. Sympathetic to her plight, the initial 2014 opinion (“*Garcia I*”) by Judge Alex Kozinski recognized Garcia’s authorial interests in her performance.<sup>73</sup> After all, reasoned Judge Kozinski, as a creative work of authorship fixed in a tangible medium, her performance indisputably met the threshold requirements for copyright protection.<sup>74</sup> Since Garcia had not granted the filmmakers a license to use her performance in the manner embodied in the final cut,<sup>75</sup> Kozinski concluded that *Innocence of Muslims* infringed Garcia’s copyright interests, and she had the right to enjoin further distribution of any version of the movie that featured her.<sup>76</sup>

The unadulterated disgust that *Garcia I* seemed to provoke on all sides of the copyright spectrum would be difficult to overstate. The opinion was roundly condemned as “truly awful,” “butcher[ing] copyright law,”<sup>77</sup> “wrong on the law, terrible for Hollywood, even worse for the Internet, and doesn’t even make things right for the poor

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71. *Id.*

72. *Garcia I*, 743 F.3d at 1268 (“Garcia has shown that removing the film from YouTube will help disassociate her from the film’s anti-Islamic message and that such disassociation will keep her from suffering future threats and physical harm.”).

73. *Id.* at 1265.

74. *Garcia II*, 786 F.3d at 749 (Kozinski, J., dissenting).

75. *Garcia I*, 743 F.3d at 1266–67.

76. See Ord. Denying Appellee’s Second Emergency Stay Motion, *Garcia v. Google, Inc.*, No. 12-57302 (9th Cir. Feb. 28, 2014) (specifying that “[t]his order does not preclude the posting or display of any version of ‘Innocence of Muslims’ that does not include Cindy Lee Garcia’s performance”).

77. See Eric Goldman, *Internet Law Professors File Amicus Brief in ‘Innocence of Muslims’ Case—Garcia v. Google*, TECH. & MKTG. L. BLOG (Apr. 16, 2014), <http://blog.ericgoldman.org/archives/2014/04/internet-law-professors-file-amicus-brief-in-innocence-of-muslims-case-garcia-v-google.htm> [<https://perma.cc/4TUM-KEV3>].

actress,”<sup>78</sup> and “incredibly troubling.”<sup>79</sup> Critics went so far as to suggest that, if the decision were left standing, it would doom our entire copyright system.

The overwhelming denunciation of *Garcia I* precipitated the unthinkable: an unholy alliance of two of the Ninth Circuit’s most powerful lieges, Hollywood and Silicon Valley. Though they have remained at diametric odds over copyright law for much of the past two decades, the likes of Adobe, Kickstarter, Tumblr, Twitter, and Pinterest joined forces with major broadcasters, news organizations, and other media companies in a push to overturn the decision.<sup>80</sup> No fewer than twenty-three amicus briefs were ultimately filed.<sup>81</sup> And, in the end, an en banc panel resoundingly reversed *Garcia I*, with a near unanimous opinion (“*Garcia II*”) that contained only a single dissenting vote—Judge Kozinski’s.<sup>82</sup> *Garcia II* expressed understandable reservations about a potential future dominated by “‘copyright cherry picking,’ which would enable any contributor from a costume designer down to an extra or best boy to claim copyright in random bits and pieces of a unitary motion picture.”<sup>83</sup> As even Judge Kozinski admitted, recognition of Garcia’s independent copyright interest in (parts of) the final cut raised the concern that rights to any creative enterprise with multiple contributors could “quickly become entangled in an impenetrable thicket of copyright.”<sup>84</sup>

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78. James Grimmelman (@grimmelm), TWITTER (Feb. 26, 2014, 2:01 PM), <https://twitter.com/grimmelm/status/438796071113097216>.

79. Mike Masnick, *Horrific Appeals Court Ruling Says Actress Has Copyright Interest in Innocence of Muslims, Orders YouTube to Delete Every Copy*, TECHDIRT (Feb. 26, 2014, 12:29 PM), <https://www.techdirt.com/articles/20140226/12103626359/horrific-appeals-court-ruling-says-actress-has-copyright-interest-innocence-muslims-orders-youtube-to-delete-every-copy.shtml> [<https://perma.cc/QJM4-66W8>].

80. Brief for Adobe Sys. Inc. et al. as Amici Curiae in Support of Google and YouTube’s Petition for Rehearing En Banc, *Garcia v. Google Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

81. Matthew Sag, *Garcia v. Google Amicus Briefs with Very Brief Summaries*, MATHEW SAG (April 18, 2014), <https://matthewsag.com/garcia-v-google-amicus-briefs-with-very-brief-summaries> [<https://perma.cc/PZ9G-T4AA>].

82. *Garcia v. Google, Inc. (Garcia II)*, 786 F.3d 733, 736, 747, 749 (9th Cir. 2015) (en banc) (Kozinski, J., dissenting).

83. *Id.* at 737.

84. *Garcia v. Google, Inc. (Garcia I)*, 743 F.3d 1258, 1265 (9th Cir. 2014). Despite this acknowledgement, Judge Kozinski ultimately dismissed these concerns by noting the prevalent use of contracts in industry and by encouraging a wide reading of implied licenses to preclude any such balkanization of rights in the vast majority of cases. *See id.*

Despite its flaws, however, the *Garcia I* opinion was not without its merits. Specifically, it raised fundamental questions about copyright's problematic treatment of authorship—serious queries entirely ignored by the en banc panel and long-absent from the copyright discourse. This fact was entirely lost in the frenzy to condemn the decision wholesale.

Indeed, as Judge Kozinski argued, *Garcia II*'s conception of authorship and its derogation of subject copyrights “artificially shrinks authorial rights by holding that a performer must personally record his creative expression in order to retain any copyright interest in it.”<sup>85</sup> The idea of authorship-as-fixation—long hinted at in claims brought by performers including actors, interviewees, pornography stars, photographic subjects, and musicians—had now become the official law of a circuit for the first time. With *Garcia II* in place, absent contracting, authors had to fix their own creative output (or, at the very least, play a substantial role in the act of fixing) to earn copyright interests.<sup>86</sup> But *Garcia II*'s conflation of copyright's fixation requirement<sup>87</sup> with its authorship doctrine imposes an entirely new

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85. *Garcia II*, 786 F.3d at 753 (Kozinski, J., dissenting).

86. In rejecting Garcia's copyright claim, *Garcia II* posited that, “she never fixed her acting performance in a tangible medium;” that is, the performance was fixed by someone other than her—writer-director Mark Basseley Youssef and his crew. *Garcia II*, 786 F.3d at 737, 743. As the court concluded, “however one might characterize Garcia's performance, she played no role in fixation.” *Id.* at 744.

87. The fixation requirement, which purportedly derives from the Constitution's reference to “writings” as the subject matter of federal copyright protection, U.S. CONST. art. I, § 8, cl. 8, dictates that a copyright cannot vest in an expression of an idea that does not have a tangible embodiment. See 17 U.S.C. § 102(a). Thus, a speech, dance performance, parade or sporting event has no copyright protection unless it is fixed in a tangible medium. There are debates as to whether fixation is constitutionally required. See, e.g., Megan Carpenter & Steven Hetcher, *Function over Form: Bringing the Fixation Requirement into the Modern Era*, 82 FORDHAM L. REV. 2221, 2236 (2014) (noting that, although “numerous courts and commentators have seen fixation as a constitutional requirement . . . fixation de jure did not exist prior to the 1976 Act . . . [and] the U.S. copyright system functioned without the fixation requirement for nearly the first two centuries of its existence”). It is, however, an express part of the 1976 Copyright Act, and it is said to serve a variety of purposes, including advancing evidentiary interests. See, e.g., Russ VerSteeg, *Jurimetric Copyright: Future Shock for the Visual Arts*, 13 CARDOZO ARTS & ENT. L.J. 125, 132 (1994) (noting fixation's critical role in ensuring that “a copyright claimant will be able to provide a court documentary evidence of the copyrightable subject matter”); Gregory S. Donat, *Fixing Fixation: A Copyright with Teeth for Improvisational Performers*, 97 COLUM. L. REV. 1363, 1400 (noting that, without the fixation requirement, “copyright law would forever be mired in

condition for the vesting of rights—one wholly absent from the Copyright Act—that mandates the author do the fixing.<sup>88</sup> If we want the goals of our copyright regime to actually align with the Constitution’s stated utilitarian purpose of rewarding creative activity,<sup>89</sup> then a rule that precludes the vesting of copyright interests in anyone (including the subject) other than the fixer does not make sense. Meanwhile, the requirement that the author of a work and its recorder must necessarily be one and the same elevates form over function and threatens to allow minute, and seemingly irrelevant, procedural differences to trigger wildly different outcomes in

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disputes over the definition and boundaries of the works claiming copyright protection”), that, among other things, help define the “metes and bounds” of a copyrighted work. Carpenter & Hetcher, *supra*, at 2240 (“[F]ixation helps to define the metes and bounds of a copyrighted work.”). But it is worth nothing that, by virtue of ensuring that written documentation of a work’s creation exists, the fixation requirement fulfills its evidentiary interests regardless of whether it is the author who does the actual fixing or not.

88. This purported condition of protection has never been expressly dictated by the Constitution or the Copyright Act. Admittedly, the Constitution does suggest that authors receive copyright in “their” writings. U.S. CONST. art. I, § 8, cl. 8. Depending on the interpretation of “their,” one could make a plausible argument that the fixation does, in fact, need to be done by the author, but it appears that no court has expressly grappled with that issue. Indeed, the relevant section of the U.S. Code that embodies the fixation requirement, § 102(a), merely dictates that a work of authorship must be fixed to earn copyright protection; notably, *it does not say by whom*. See 17 U.S.C. § 102(a) (extending the subject matter of federal copyright protection to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated”). Meanwhile, § 101 defines “fixed” to include embodiment in a tangible medium either “by or under the authority of the author.” 17 U.S.C. § 101. The *Garcia II* court waived away the “under authority” portion of the statute by stating that “Garcia claims that she never agreed to the film’s ultimate rendition or how she was portrayed in *Innocence of Muslims*, so she can hardly argue that the film or her cameo in it was fixed ‘by or under [her] authority.’” 786 F.3d at 744. But such a position confuses the film’s “ultimate rendition” with its actual fixation, which first occurred with its recording on the set. The latter was arguably done under Ms. Garcia’s authority, as she gave a performance knowing full well that she was going to be recorded on film. See, e.g., MELVILLE & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.03 (noting that “[t]o the extent that a band member voluntarily participates in a recording session, or an actor voluntarily participates in a film shoot, the resulting product may be considered pursuant to the requisite authority”). Of course, this does raise the issue as to whether there should be a difference in copyrightability between performances where the performer is aware that he or she is being recorded (i.e., as in *Garcia II*) or not (e.g., a surreptitiously recorded sex tape).

89. U.S. CONST. art. I, § 8, cl. 8 (mandating that copyright protection “promote the progress of . . . useful arts”).

numerous situations. Consider, for example, what would have happened if Garcia had incidentally recorded herself on a smartphone while practicing for her shoot. She would have a copyright in that particular performance, since it was fixed by her in a tangible medium.<sup>90</sup> She could then use that copyrighted work to at least advance a colorable argument that the makers of *Innocence of Muslim* infringed her copyright interest in her performance when they created an unauthorized derivative version thereof in their final cut.<sup>91</sup>

C. *Ain't No Monkey Business: Naruto on Art, Artifice, & Authority*

Strict application of the authorship-as-fixation rule therefore does more than merely elevate form over function in copyright's authorship doctrine and ignores the significant creative contributions of subjects to artistic imagery; it can also lead to strange, if not absurd, results in the arts. Consider the case of wildlife photographer David John Slater and Naruto, the Celebes crested macaque living on the Indonesian island of Sulawesi.<sup>92</sup> In 2014, Slater engineered a series of evocative "selfie" shots of Naruto playfully posing for the camera.<sup>93</sup> When images of Naruto went viral, Slater sought to enforce copyrights to the works through his representatives.<sup>94</sup> But, to Slater's surprise, Naruto struck back.

As Next Friends, the non-profit group People for the Ethical Treatment of Animals (PETA) and primatologist Dr. Antje Engelhardt sued Slater on Naruto's behalf, claiming that Naruto, and not Slater,

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90. See 17 U.S.C. § 101 ("A work is 'fixed' in a tangible medium . . . when [it is] . . . sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.").

91. See 17 U.S.C. § 106(2) (securing the exclusive right for copyright holders to prepare derivative versions of their protected works); *id.* § 101 (defining "derivative work" quite broadly as any "work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted"). Of course, the producers could claim that they made no actual use of her actual performance embodied in this hypothetical rehearsal recording and that, therefore, the movie could not infringe Garcia's rehearsal recording.

92. *Naruto v. Slater*, 888 F.3d. 418, 420 (9th Cir. 2018).

93. *Id.*

94. *Id.*

authored the selfies and owned the copyrights to the images.<sup>95</sup> As a result, they claimed that Slater's unauthorized commercial exploitation of the images constituted copyright infringement.<sup>96</sup> The lawsuit rested on the logic of authorship-as-fixation to make its claim. After all, Naruto had fulfilled all the criteria needed for a human being to earn copyright protection in the selfies, as he had literally fixed the creative work in a tangible medium by clicking the shutter of the camera.<sup>97</sup>

Ultimately, however, Naruto lost. Deferring to the view of the Copyright Office, which had expressly rejected the possibility of non-human authorship in its official Compendium,<sup>98</sup> a federal district court dismissed the case,<sup>99</sup> and the Ninth Circuit affirmed.<sup>100</sup> But the incident garnered widespread media coverage and triggered an important conversation about both the rights of animals and of subjects.<sup>101</sup> After all, the images of Naruto were particularly remarkable because he seemed profoundly aware and cognizant of his audience.<sup>102</sup> And, if one puts aside Naruto's place in the animal kingdom, the authorship-as-fixation regime would have vested the image copyrights in Naruto for snapping the shots himself. But such a result seems to

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95. The Next Friends claimed that Naruto (a male macaque) was the macaque featured in the selfies. *See* *Naruto v. Slater*, Complaint, Case No. 15-cv-04324, 2015 WL 5576925, at ¶ 1 (N.D. Cal. Sept. 21, 2015), *aff'd*, *Naruto v. Slater*, 2016 WL 362231 (Jan. 28, 2016). But Blurb, Inc.'s Motion to Dismiss challenges this claim and states that the macaque in the selfies was a different macaque—one that was female. *See* Defendant Blurb, Inc.'s Notice of Motion and Motion to Dismiss the Complaint for Copyright Infringement, 2015 WL 9392536, at \*3–4 (N.D. Cal. Nov. 6, 2015). For the purposes of this Article, we will assume that it was, in fact, Naruto in the photographs.

96. *Naruto*, 888 F.3d at 420, 424.

97. As Naruto (through Next Friends) stated in his Complaint, had the selfies "been made by a human using Slater's unattended camera, that human would be declared the photographs' author and copyright owner." *Naruto*, 2015 WL 5576925, at ¶ 5.

98. *See* COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 313.2 (3d ed.) ("To qualify as a work of 'authorship' a work must be created by a human being. Works that do not satisfy this requirement are not copyrightable.") (citations omitted).

99. *Naruto v. Slater*, Order Granting Motions to Dismiss, 2016 WL 362231 (N.D. Cal. Jan. 28, 2016).

100. *Naruto v. Slater*, 888 F.3d 418 (9th Cir. 2018).

101. Sophie Duffy & Dori Ann Hanswirth, *Monkey See, Monkey Do . . . Monkey Own? The Curious Case of Naruto v. Slater*, HOGAN LOVELLS (Sept. 20, 2017), <https://www.engage.hoganlovells.com/knowledgeservices/news/monkey-see-monkey-do-monkey-own-the-curious-case-of-naruto-v-slater> [<https://perma.cc/44SH-PAW6>].

102. *Naruto*, 888 F.3d at 420.

betray Slater's vital creative contributions to the final works, which were the product of careful design and fulfilled Slater's vision to communicate the agency, acuity, and sentience of macaques in a striking visual.<sup>103</sup> Since he perceived himself as the "master mind" of the works, Slater had no compunction about claiming ownership of the image copyrights.<sup>104</sup> Drawing on his applied knowledge from long periods working with the macaques, he had engineered the shots<sup>105</sup> and made innumerable artistic choices pertaining to "camera lens width, positions and settings (e.g., predictive autofocus, motor wind, and flashgun)."<sup>106</sup> These elements—from luring the subject to controlling the lighting, shading, and positioning—directly echo the very creative contributions upon which the *Sarony* decision rested authorship.<sup>107</sup>

Thus, even though Slater did not depress the shutter button, he provided critical creative contributions to the final images. But, absent reconsideration of the authorship-as-fixation doctrine, we are left with

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103. *Naruto*, 2015 WL 5576925, at ¶ 5 ("My experience of these monkeys [crested macaques] suggested that they were not just highly intelligent but were also aware of themselves . . . . It was only a matter of time before one pressed the shutter resulting in a photo of herself [sic]. She [sic] stared at herself with a new found appreciation, and made funny faces—in silence—just as we do when looking in a mirror." (quoting DAVID J. SLATER, *WILDLIFE PERSONALITIES* 11 (2014) (defendant Slater's book that included pictures of Naruto) (alterations in original))).

104. Tehranian, *supra* note 63, at 1357.

105. See Brief of Defendant-Appellees David John Slater and Wildlife Personalities, Ltd., at \*3-4, No. 16-15469 (9th Cir. Aug. 25, 2016) ("Slater, an award-winning nature photographer, set up what became the Monkey Selfie in the course of several grueling days in an Indonesian jungle. Developing a keen understanding of their subjects is a critical skill for any professional photographer, and that was vital here for Slater as he slowly built a trustful, friendly relationship with a group of crested macaque monkeys."); Hayden Smith, *Can Monkey Who Took Grinning Self-Portrait Claim Copyright?* METRO (July 14, 2014, 10:38 PM), <http://metro.co.uk/2011/07/14/can-monkey-who-took-grinning-self-portrait-claim-copyright-77773> [<https://web.archive.org/web/20220216100136/https://metro.co.uk/2011/07/14/can-monkey-who-took-grinning-self-portrait-claim-copyright-77773>] (quoting Slater as explaining, "It was my artistry and idea to leave [the macaques] to play with the camera and it was all in my eyesight. I knew the monkeys were very likely to do this and I predicted it. I knew there was a chance of a photo being taken.").

106. *Brief of Defendant-Appellees*, *supra* note 105, at \*4.

107. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54 (1884). Ironically, although *Sarony* gave rise to modern authorship-as-fixation jurisprudence, the decision itself put no value on who actually clicked the camera shutter. In fact, in that case, the individual who snapped the shot was Benjamin Richard, not Napoleon Sarony—the putative "photographer" in whom the Court vested authorship.

the particularly remarkable result that the selfies—indisputably creative works fixed in a tangible medium—may have no copyright owner at all. Naruto apparently cannot enjoy any copyright interest since he does not belong to the correct species, and Slater cannot enjoy any copyright interest since he did not click the magic button.

*D. Infringing Oneself: Image & Ownership*

The authorship-as-fixation doctrine has also led to troubling results in a recent wave of cases where individuals have faced liability for infringing photographs of themselves. In recent years, federal courts have been inundated with lawsuits brought by the paparazzi against various celebrities, including Justin Bieber, Ariana Grande, Gigi Hadid, Khloe Kardashian, Nicki Minaj, Emily Ratajkowski, and Jessica Simpson, for posting photos of themselves on social media.<sup>108</sup> Once again, another controversy involving Emily Ratajkowski can shed light on the dynamics at play. In 2019, after she published an Instagram post containing an image of herself, the paparazzo who captured the shot sued her for copyright infringement.<sup>109</sup>

There is no doubt that celebrities who post images of themselves taken by others on social media have technically infringed copyright law. After all, they have engaged in the unauthorized reproduction, distribution, and public display of a copyrighted work without permission from the rightsholder. But these incidents raise the question of whether such uses *should* constitute fair use and whether pursuit of such claims is ultimately in the long-term interest of rightsholders themselves. The vindication of such claims in the federal courts could prove myopic for rightsholders; while they might generate some short-term profits from the settlement value of such claims, they simultaneously run the very real risk of having case law issued that enervates the scope of photographers' rights by bringing sympathetic instances of unauthorized use before judges and juries.

The peril that rightsholders may face if such cases reach a jury trial seems particularly grave. To understand why, a personal anecdote and some admittedly inductive logic may help. Each year, I take an informal, highly unscientific, and thoroughly inadmissible poll of my

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108. *As the Number of Paparazzi v. Celebrity Copyright Cases Grows, How Big of a Problem Is This Really*, FASHION L. (July 15, 2019), <https://www.thefashionlaw.com/as-the-number-of-paparazzi-v-celebrity-copyright-cases-continues-to-grow-how-big-of-a-problem-is-this-really> [<https://perma.cc/YE4U-KD3F>].

109. *O'Neil v. Ratajkowski*, No. 1:19-cv-09769 (S.D.N.Y. filed Oct. 23, 2019).

copyright students to gauge their immediate reaction upon listening to the subject matter of two canonical music infringement cases: *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*<sup>110</sup> and *Fogerty v. Fantasy, Inc.*<sup>111</sup> In the former suit, George Harrison famously faced allegations of unconsciously infringing a doo-wop hit (The Chiffons's *He's So Fine*) that he likely heard on the radio during his youth.<sup>112</sup> In the latter dispute, John Fogerty stood accused (by his former record label) of infringing *Run to the Jungle*, a song which he had written, recorded, and provided vocals to with his former band, Creedence Clearwater Revival.<sup>113</sup> After having my students listen to the relevant songs, I ask them to cast two votes. The first vote asks whether, in their view, George Harrison's *My Sweet Lord* is substantially similar to The Chiffons's *He's So Fine*. The second vote queries whether John Fogerty's *The Old Man Down the Road* is substantially similar to Creedence Clearwater Revival's *Run to the Jungle*. Almost without fail, more students view Fogerty, rather than Harrison, as an infringer. Putting aside any sophisticated analysis of music, understanding of the universe of pop music melodies and compositions, and placements of the respective songs in a context that ferrets out common tropes and chord sequences from truly unique and hallmark sounds, it is unsurprising that students find more similarity in Fogerty's work than in Harrison's. *The Old Man Down the Road* sounds more obviously like *Run to the Jungle* than *My Sweet Lord* sounds like *He's So Fine*, where the resemblance is more nuanced. Of course, in the real world, the results came out the exact opposite way: Harrison suffered more than a million dollars in liability while a jury resoundingly rejected infringement claims against Fogerty.<sup>114</sup>

While it is impossible to know what went through the minds of the jurors who rendered the actual verdicts in these cases as compared to my law students, one cannot help but speculate that one contributing factor to the disparate results might be that those trained in the law might view the idea of infringing oneself as more palatable than those who are not. After all, law students are steeped in the technical niceties

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110. 420 F. Supp. 177 (S.D.N.Y. 1976), *aff'd sub nom.* ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983).

111. 510 U.S. 517 (1994).

112. *Bright Tunes*, 420 F. Supp. at 178.

113. *Fogerty*, 510 U.S. at 519–20.

114. See *ABKCO Music, Ltd.*, 722 F.2d at 993, 999 (affirming—with a few modifications—a damage award of almost \$1.6 million); *Fogerty*, 510 U.S. at 520 (“The copyright infringement claim went to trial and a jury returned a verdict in favor of Fogerty.”).

of the law. They inhabit a professional world where, for example, a policy can simultaneously constitute a tax and not a tax in the same holding<sup>115</sup> or where ownership of a tangible object is divorced from ownership of creative content contained in that tangible object.<sup>116</sup> By contrast, the idea of infringing oneself—no matter how possible under the law of intellectual property and perfectly logical to technician-lawyers—may well fly in the face of a jury’s application of common sense.

Regardless of the long-term wisdom in litigating such claims, rightsholders are filing such suits with increasing regularity.<sup>117</sup> The availability of statutory damages to savvy rightsholders who systematically register their copyrights has fueled these claims.<sup>118</sup> After all, the Copyright Act provides statutory damages of up to \$150,000 per willful act of infringement<sup>119</sup> and the possibility of recovering reasonable attorneys’ fees<sup>120</sup> to rightsholders who have endured the unauthorized reproduction, distribution, public display, public performance, or derivatization<sup>121</sup> of their timely registered works,<sup>122</sup> even in the absence of any proof of actual damages. But despite facing

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115. See, e.g., *Nat’l Fed’n of Ind. Bus. v. Sebelius*, 567 U.S. 519, 546, 574 (2012) (finding that the Affordable Care Act’s individual mandate was, simultaneously, a tax for the purposes of the Tax and Spending Clause of the Constitution but not a tax for the purposes of the Anti-Injunction Act).

116. See, e.g., 17 U.S.C. § 202 (“Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.”).

117. Cf. John Tehranian, *Infringement Nation: Copyright Reform and the Law/Norm Gap*, 2007 UTAH L. REV. 537, 550 (2007) (positing that “[o]ne can readily imagine a future dystopian world where the record labels, long since irrelevant to the development and distribution of new music, become nothing more than copyright trolls, drawing their revenue entirely from collections (or litigation) of this kind”).

118. See Mitch Stoltz, *Collateral Damages: Why Congress Needs to Fix Copyright Law’s Civil Penalties*, ELEC. FRONTIER FOUND. (July 24, 2014), <https://www.eff.org/wp/collateral-damages-why-congress-needs-fix-copyright-laws-civil-penalties> [<https://perma.cc/G3VT-2DJC>] (articulating two major problems with copyright law’s statutory damage scheme: excessive penalties and unpredictability).

119. 17 U.S.C. § 504(c)(2).

120. See *id.* § 505 (providing that courts may award costs and reasonable attorneys’ fees to a prevailing party under the Copyright Act).

121. See *id.* § 106 (vesting exclusive right to reproduce, distribute, publicly display, publicly perform and derivatize a work in copyright holders).

122. See *id.* § 412 (restricting awards of statutory damages and fees to prevailing plaintiffs who have registered their work prior to the defendant’s commencement of the infringing conduct unless plaintiffs work was registered within three months of first publication).

the threat of six-figure liability for her single act of arguable infringement,<sup>123</sup> Ratajkowski fought the allegations, and the case remains pending.<sup>124</sup>

Taken on a public sidewalk, the shot at issue in the suit featured Ratajkowski strolling through the streets of New York City with a large vase of flowers covering her face so that she could protect herself from unwanted intrusion by the paparazzi.<sup>125</sup> In short, the photograph itself reflected and commented upon Ratajkowski's strident objection to those who might try to capture her likeness without her consent. Echoing an intuitive sense of fair play, Ratajkowski responded to the unauthorized use of her likeness by reproducing the image without consent on her own social media to make a point.<sup>126</sup> As Ratajkowski explained, with her use of the "bouquet as a shield[,] . . . [she] liked what it said about [her] relationship with the paparazzi."<sup>127</sup> The idea that Ratajkowski's actions could expose her to up to \$150,000 in statutory damages liability (not to mention costs and fees) seems to fly in the face of reason. By giving rise to potentially unfair results, cases such as Ratajkowski's raise equitable concerns—particularly in situations where there is not even an inkling of consent—about authorship-as-fixation and the way the doctrine unilaterally vests copyrights to works featuring human subjects in fixers. At the very least, such instances seem to call for capacious readings of the fair use and implied-license doctrines. As a result, it is not difficult to imagine a court finding that Ratajkowski actions were non-commercial, transformative, and did no real harm to the market for the photograph and, as a result, constituted fair use. Alternatively, a court feeling a bit more ambitious might even draw the conclusion that an individual filmed in public without their consent (something allowed under the First Amendment) should enjoy parallel rights, perhaps through an

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123. This is the statutory maximum allowed for a single willful act of infringement under the Copyright Act. *See id.* § 504(c)(2).

124. On September 28, 2021, the Southern District of New York ruled that, among other things, significant factual disputes rendered Ratajkowski's fair use defense inappropriate for summary judgment, and, instead, necessitated resolution at trial. *See O'Neil v. Ratajkowski*, No. 19-cv-09769, 2021 WL 4443259, at \*6, \*11 (S.D.N.Y. Sept. 28, 2021). Meanwhile, Ratajkowski has apparently not changed her approach to social media posting and, in 2021, another photographer sued her for infringing two other paparazzi shots in which she starred. *See* Complaint at 1–2, 4, *Mateo v. Ratajkowski*, No. 2:21-cv-05684-MCS-AFM (C.D. Cal. July 14, 2021).

125. To view the photograph, see Ratajkowski, *supra* note 28.

126. *Id.*

127. *Id.*

implied license, to also make use of any such footage.<sup>128</sup> More broadly, cases such as these can threaten to bring the authorship-as-fixation doctrine to the breaking point if courts entertain the idea that a key part of the creativity in the shot (including the very decision to place the flowers in front of Ratajkowski's face) came from Ratajkowski herself and could give rise to a copyright interest in the photograph, authorship-as-fixation be damned. In the meantime, as Ratajkowski has reluctantly concluded, "I have learned that my image, my reflection, is not my own."<sup>129</sup>

The convolutions of such cases go beyond the idea of facing massive liability for the use of one's own image. Indeed, some cases where litigants have found potential ways around such liability raise only further doctrinal questions. When a paparazzi agency, Splash News, sued noted Italian fashion house Moschino, Moschino's creative director (Jeremy Scott), and singer Cardi B for publishing an image—taken by one of the agency's photographers—on their respective social media sites of Cardi B wearing a Moschino/Scott dress on the streets of New York City,<sup>130</sup> the defendants, through their counsel of record (which included the author of this Article), fought back. Even though Cardi B was the subject matter of the image, she could not claim a copyright interest in the photograph.<sup>131</sup> But someone else—or, rather, something else—could: Moschino/Scott's dress.

The particular frock in question was no ordinary vestment. Entitled *When Spring Is in Bloom*, it was an original Jeremy Scott design that featured a whimsical arrangement of stylized flowers affixed to the outer garment.<sup>132</sup> As such, its sculptural elements enjoyed copyright protection as a work of applied art pursuant to the Supreme Court's decision in *Star Athletica, LLC v. Varsity Brands, Inc.*,<sup>133</sup> which widened

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128. For a discussion on the intersection of copyright law and the First Amendment, see generally Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970).

129. *Id.*

130. Complaint at 1, 3–4, *Splash News & Picture Agency, LLC v. Moschino, S.P.A.*, No. 2:19-cv-09220 (C.D. Cal. Oct. 26, 2019).

131. See *supra* Section II.A (explaining the authorship-as-fixation doctrine and in whom copyright protection vests).

132. *Moschino Responds to Paparazzi Photo Lawsuit: You Infringed Our Copyright in the Jacket*, FASHION L. (Jan. 27, 2020), <https://www.thefashionlaw.com/1394oschino-responds-to-paparazzi-photo-lawsuit-you-infringed-our-copyright-in-the-jacket> [<https://perma.cc/ZF4C-DD5R>] [hereinafter *Moschino Responds*].

133. 137 S. Ct. 1002 (2017).

the ability of creators to obtain copyrights for clothing designs.<sup>134</sup> So Moschino and Scott registered the work's copyright with the Copyright Office and then promptly filed a counterclaim against the agency and the photographer, claiming that the image of Cardi B donning the outfit constituted an unauthorized derivative work that reproduced an image of the garment without permission of the copyright holder.<sup>135</sup> Since unauthorized derivative works enjoy no copyright protection, no matter how much additional creativity they may contain,<sup>136</sup> such a finding would doom the paparazzi agency's lawsuit, preclude its ability to make infringement claims against the rest of the world and even subject it (and the underlying paparazzo) to potential infringement liability. Not surprisingly, the claims against Moschino, Scott, and Cardi B were dismissed with prejudice shortly thereafter.<sup>137</sup>

If anything, the machinations in the Moschino/Scott lawsuit revealed some uncomfortable, if not bizarre, results dictated by the authorship-as-fixation doctrine. To wit, an individual who is photographed without permission simply cannot sue the photographer if the photographer posts that image on social media.

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134. *Id.* at 1014. *But see Moschino Responds*, *supra* note 132 (describing the “murkier” nature of a copyright claim for the photographing of a design contained on a useful article such as clothing).

135. Answer & Counterclaim at 23, *Moschino, S.P.A.*, No. 2:19-cv-09220.

136. *See* 17 U.S.C. § 103(a) (“[P]rotection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.”); *see also* *Pickett v. Prince*, 207 F.3d 402, 407 (7th Cir. 2000) (denying copyright protection to any portion of an unauthorized derivative work); *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 34 n.6 (2d Cir. 1982), *superseded by rule*, FED. R. CIV. P. 52(a), *as recognized in* *Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd.*, 726 F.3d 62 (2d Cir. 2013) (“[I]f Eden did not have Paddington’s consent to produce a derivative work based on Paddington’s copyrighted illustrations, its derivative copyrights would be invalid . . . .”); *Gracen v. Bradford Exch.*, 698 F.2d 300, 302 (7th Cir. 1983) (“[E]ven if Miss Gracen’s painting and drawings had enough originality to be copyrightable as derivative works *she* could not copyright them unless she had authority to use copyrighted materials from the movie.”); *Sobhani v. @Radical.Media, Inc.*, 257 F. Supp. 2d 1234, 1239–40 (C.D. Cal. 2003) (denying copyright protection to unauthorized derivative work); *Anderson v. Stallone*, No. 87-0592, 1989 WL 206431, at \*10 (C.D. Cal. Apr. 25, 1989) (“[N]o part of an infringing derivative work should be granted copyright protection.”). The legislative history behind the 1976 Copyright Act supports this position. As the House of Representatives noted, “the bill prevents an infringer from benefiting, through copyright protection, from committing an unlawful act.” H.R. Rep. No. 94-1476, at 57 (1976).

137. Stipulation to Dismiss Case at 2, *Splash News & Picture Agency, LLC v. Moschino, S.P.A.*, (2:19-cv-09220) (C.D. Cal. Mar. 27, 2020).

But the owner of certain inanimate objects (those with copyrightable portions) can. If such an inanimate object is photographed without permission, the photographer can face claims of liability for infringement and can even lose a right to enforce the image's own copyright. *Some inanimate objects, it would seem, may have greater rights to control their representation than human subjects.*

*E. Copyright & the Weaponization of the White Male Gaze in Art & Visual Pleasure*

Perhaps most pointedly, the authorship-as-fixation doctrine also raises significant concerns about the trafficking of visual pleasure through its weaponization of the white male gaze. In her celebrated psychoanalysis of film, *Visual Pleasure and Narrative Cinema*, Laura Mulvey, a British film theorist, critiqued the way that popular culture—through the visual arts—depicts the world, and women in particular, through a male gaze. “In a world ordered by sexual imbalance,” Mulvey argued, “pleasure in looking has been split between active/male and passive/female. The determining male gaze projects its phantasy onto the female figure which is styled accordingly.”<sup>138</sup> The male gaze, or masculine point of view, replicates the patriarchal hierarchy of traditional society, thereby normalizing a world of subordination where women are deprived of agency.<sup>139</sup> In the shadow of the male gaze, a woman in front of the camera exists solely for visual pleasure—a passive erotic object only significant for how she “plays to and signifies male desire.”<sup>140</sup>

The authorship-as-fixation doctrine propertizes the male gaze by extinguishing the agency of the subject at the moment of fixation and imbuing the (typically white male) gazer/fixer, through copyright ownership, with the unilateral authority to control representations of female (and, often, non-white) bodies and to suppress countervailing narratives of resistance, with resulting adverse consequences for dignitary interests and gender equality.<sup>141</sup> After all, as the Guerilla

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138. Laura Mulvey, *Visual Pleasure and Narrative Cinema*, SCREEN, Autumn 1975, at 6, reprinted in FILM THEORY AND CRITICISM: INTRODUCTORY READINGS 833, 837 (Leo Braudy & Marshall Cohen eds., 5th ed., 1999).

139. Thomas F. Ryan, *Vision and Spirituality in Post-Katrina New Orleans*, 7 SEATTLE J. SOC. JUST. 101, 106 (2008).

140. Mulvey, *supra* note 138, at 837–38. In this rubric, the female serves as a spectacle to the male role, which is “the active one [] forwarding the story, making things happen.” *Id.*

141. Tehranian, *supra* note 39, at 354.

Girls, a feminist art group, once famously wondered, “[d]o women have to be naked to get into the Met Museum?”<sup>142</sup> Their query was no mere rhetorical question. At the time, it certainly seemed as if the answer was a resounding “yes,” as 85% of the nude photographs and paintings, but fewer than 5% of the exhibited artists, at the Met were female.<sup>143</sup> By vesting property rights in the interloper, the penetrator, or the watcher/voyeur, the doctrine echoes traditional binaries of passivity and activity grafted on notions of femininity and masculinity, casting the woman in front of the camera in the role of the captured subject-spectacle and the man behind the trigger as the doer, the “master mind,” the author and, above all, the rightsholder.<sup>144</sup> One particularly pernicious example of copyright’s male gaze comes from the wave of revenge porn cases in recent years where victim-subjects (usually women) have found themselves legally powerless because the copyrights to the leaked photographs or movies vested in their former partners (usually men) who created the materials.<sup>145</sup>

Despite its empowerment of the male gaze, betrayal of the utilitarian logic of our copyright regime, absence in the text of the Copyright Act, and promotion of troubling results in a variety of situations, authorship-as-fixation has triumphed, at least in the Ninth Circuit.<sup>146</sup> Admittedly, not every circuit has adopted such a hardline view, and there are still pockets of authority to support claims that non-fixers should also enjoy copyright interests for their creative contributions.<sup>147</sup>

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142. Jeffrey Toobin, *Girls Behaving Badly*, NEW YORKER (May 22, 2005), <https://www.newyorker.com/magazine/2005/05/30/girls-behaving-badly> [https://perma.cc/JS3W-JP6Z].

143. *Id.*

144. Tehranian, *supra* note 39, at 354–55.

145. To some extent, the rise of “sexting,” where individuals (often female) create their own sexual images and recordings, could change this dynamic since the subject and recorder are one and the same. Pamela Paul, *He Sexts, She Sexts More, Report Says*, N.Y. TIMES (July 15, 2011), <https://www.nytimes.com/2011/07/17/fashion/women-are-more-likely-to-sext-than-men-study-says-studied.html> [https://perma.cc/8RDV-BFES].

146. See Tehranian, *supra* note 39, at 373 (noting the Ninth Circuit’s historical discomfort with recognition of multiple authorship).

147. See *Lindsay v. Wrecked & Abandoned Vessel R.M.S. Titanic*, No. 97-civ-9248, 1999 WL 816163, at \*5 (S.D.N.Y. Oct. 13, 1999) (“[W]here a plaintiff alleges that he exercised such a high degree of control over a film operation—including the type and amount of lighting used, the specific camera angles to be employed, and other detail-intensive artistic elements of a film—such that the final product duplicates his

Nevertheless, vindication of subject rights through the prism of copyright remains an uphill battle, at best. But, copyright law does not provide the only hope for the protection of subject rights. As we shall see, subjects also enjoy potential relief grounded in legal theories in neighboring fields of intellectual property.

### III. THE TREACHERY OF IMAGES: PUBLICITY RIGHTS & THE BATTLE FOR SUBJECT CONTROL

In a case that could have widespread implications for both the artists who create celebrity images and the purveyors and viewers of those images, hip-hop artist/businessman Jay-Z recently challenged the broad, unilateral dominion that copyright holders believe they can exercise over subject images by suing photographer Jonathan Mannion.<sup>148</sup> Mannion captured a series of candid shots of Jay-Z during his early days in the music business, and Mannion later licensed these images for prints and merchandise, apparently without Jay-Z's blessing.<sup>149</sup> So, in 2021, Jay-Z sued—not for copyright infringement—but for misappropriation of his publicity rights.<sup>150</sup>

If successful, Jay-Z's suit could fundamentally challenge (and diminish) the rights of photographers to dispose of their work as art, while vindicating the ability of subjects to exert control over the use of their images after the moment of fixation. The case could also impact portraiture artists of all stripes and force individuals and entities making use of such imagery to secure another set of licenses—not just from the copyright holder but from the subject as well.

Jay-Z's suit, like other right of publicity claims involving copyrightable subject matter, raises at least three different questions about the scope of right of publicity protections and how courts might

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conceptions and visions of what the film should look like, the plaintiff may be said to be an 'author' within the meaning of the Copyright Act.”). Notably, however, the *Lindsay* court did caution that the non-fixers should have a close relationship with the fixation. *Id.*

148. Blake Brittain, *Jay-Z's Right-of-Publicity Claims Survive Photographer's Motion to Dismiss*, REUTERS (Sept. 10, 2021, 4:50 PM), <https://www.reuters.com/legal/transactional/jay-zs-right-of-publicity-claims-survive-photographers-motion-dismiss-2021-09-10> [<https://web.archive.org/web/20220222215654/https://www.reuters.com/legal/transactional/jay-zs-right-of-publicity-claims-survive-photographers-motion-dismiss-2021-09-10>].

149. *Id.*

150. *Id.* Such a claim would seemingly be precluded by the binding precedent of *Garcia v. Google, Inc.*, 786 F.3d 733, 741–42 (9th Cir. 2015).

interpret and understand (1) the commercial misappropriation element of most publicity rights statutes and common law actions; (2) the relationship between right of publicity claims—which are exclusively grounded in state or common law—and copyright protections—which are exclusively grounded in federal law—and the degree to which, and circumstances in which, the latter might preempt the former; and (3) the First Amendment limitations on the right of publicity. These three hermeneutical queries are intricately interrelated. After all, the development of a judicial test to protect expressive rights in the face of claims seeking to propertize an individual’s name, voice, or likeness can speak to how one might draw the line between commercial and non-commercial misappropriations (i.e., what is an act of exploitative merchandising versus protected artistic or journalistic expression). Moreover, a finding of preemption—whether express preemption through the operation of § 301 of the Copyright Act<sup>151</sup> or implied “field” or “conflict” preemption through the operation of the Constitution’s Supremacy Clause<sup>152</sup>—can reflect concerns about protecting certain expressive rights secured under the First Amendment (i.e., what the Copyright Act, within the scope of its subject matter, expressly or implicitly deems to the public domain for the use of all).

Of course, Jay-Z is not the first high-profile litigant to attempt such a maneuver with respect to art featuring a celebrity’s likeness. For example, several years ago, Tiger Woods sued to prevent the sale of limited-edition reproductions of Rick Rush’s *The Masters of Augusta*.<sup>153</sup>

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151. 17 U.S.C. § 301.

152. See *Gade v. Nat’l Solid Wastes Mgmt. Ass’n*, 505 U.S. 88, 98 (1992) (recognizing “field pre-emption” as occurring when “the scheme of federal regulation is ‘so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it,’” and “conflict pre-emption” as occurring when “compliance with both federal and state regulations is a physical impossibility” or when a state law “stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress”) (first quoting *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947); then quoting *Fla. Lime & Avocado Growers, Inc. v. Paul*, 373 U.S. 132, 142–43 (1963); and then quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)). As the Supreme Court has noted, the existence of an express preemption statute in a body of law (such as copyright) does not preclude separate analysis of implied preemption. See, e.g., *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 881–83 (2000) (finding that, while a federal automobile safety statute’s express preemption language did not negate the viability of separate common law claims related to car safety, implied preemption principles rendered such claims unavailing).

153. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918–19 (6th Cir. 2003).

Inspired by Woods's first Masters win, Rush's work portrayed Woods in three different poses at the Augusta National Golf Club, the tournament site, with the likenesses of several golf legends in the background.<sup>154</sup> Among other things, Woods claimed that sale of the prints violated his publicity rights under Ohio law.<sup>155</sup> But both a district and appellate court disagreed, finding that Rush's artistic interpretation of Woods, which placed Woods in a historical context, rendered the work "transformative" and particularly worthy of First Amendment protection.<sup>156</sup> Mannion's use of Jay-Z's actual image would seem less transformative than Rush's, thereby seemingly giving Jay-Z a better chance at prevailing than Woods. However, Jay-Z's claims implicate significant copyright preemption issues not present in the Woods suit since Jay-Z's actual image is embodied in copyrighted works owned by someone else (i.e., the photographer).<sup>157</sup> These preemption issues play a significant role in the ability to vindicate subject rights through the right of publicity and bear further scrutiny. Indeed, a closer examination of the features of publicity rights claims suggests that courts have not fully appreciated the extent to which they might raise issues under the statutory preemption requirements of § 301 of the Copyright Act or the field and conflict preemption principles emanating from the Constitution's Supremacy Clause.

A. *Publicity Rights & the Problem of Preemption*

Courts have long assumed that there is "no categorical preemption of the general right of publicity"<sup>158</sup> since, as David Nimmer puts it, "a *persona* can hardly be said to constitute a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution. *A fortiori*, it is not a 'work of authorship' under the [Copyright] Act."<sup>159</sup> Section 301

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154. *Id.* at 918.

155. *Id.* at 919.

156. *See id.* at 938 ("Rush's work consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement in that event. Because Rush's work has substantial transformative elements, it is entitled to the full protection of the First Amendment.")

157. *See* Brittain, *supra* notes 148–50 and accompanying text.

158. NIMMER & NIMMER, *supra* note 88, § 1.17; (footnote omitted); *see also* J. THOMAS MCCARTHY & ROGER E. SCHECHTER, 2 THE RIGHTS OF PUBLICITY AND PRIVACY § 11:50 (2d ed) (2021) ("The majority of courts presented with the issue of possible federal preemption of the right of publicity, including the U.S. Supreme Court, have held, for various reasons, that there is no such preemption.") (footnote omitted).

159. NIMMER & NIMMER, *supra* note 88, § 1.17 (footnotes omitted).

of the Copyright Act expressly provides for preemption for all state or common law claims.<sup>160</sup> Determinations of § 301 preemption generally comprise a two-part test, which requires that: (1) “the content of the protected right must fall within the subject matter of copyright”; and (2) “the right asserted under state law must be the equivalent to the exclusive rights contained in section 106 of the Copyright Act.”<sup>161</sup> In applying this test to claims under the right of publicity, courts have repeatedly held that names, voices, and likenesses fall outside of the subject matter of copyright. For example, in response to claims that Abercrombie & Fitch (“Abercrombie”) violated the publicity rights of several surfers featured in a vintage photograph from the 1965 Makaha International when it reproduced the image in its sales catalog and used the image to sell t-shirts identical to those worn by the surfers, the retailer asserted that the claims were preempted under the Copyright Act.<sup>162</sup> According to Abercrombie, it acted well within its rights since it purchased the copyrights to the image from its author, legendary surf photographer, LeRoy Grannis.<sup>163</sup> The Ninth Circuit disagreed, noting, among other things, that Abercrombie’s preemption defense was unavailing.<sup>164</sup> As the court reasoned, Abercrombie could not even meet the first element of the § 301 standard.<sup>165</sup> Citing Nimmer’s treatise, the court found that the publicity claim was not within the subject matter of copyright protection since “[a] person’s name or likeness is not a work of authorship within the meaning 17 U.S.C. § 102.”<sup>166</sup> Similarly, when model June Toney, who appeared in a series of photographs used in hair care products and advertisements, sued for the misappropriation of her likeness under the Illinois Right of Publicity Act,<sup>167</sup> defendant L’Oreal raised a copyright preemption defense.<sup>168</sup> The Seventh Circuit, in its decision upon rehearing, demurred, noting:

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160. See 17 U.S.C. § 301(a) (“[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”).

161. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003 (9th Cir. 2001) (citing *Del Madera Props. v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 976 (9th Cir. 1987), *overruled on other grounds by Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994)).

162. *Id.*

163. *Id.* at 1000.

164. *Id.* at 1005.

165. *Id.* at 1003–04.

166. *Id.* at 1004.

167. 765 ILL. COMP. STAT. 1075/1–1075/60 (1999).

168. *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 907 (7th Cir. 2005).

Toney's identity is not fixed in a tangible medium of expression. There is no "work of authorship" at issue in Toney's right of publicity claim. A person's likeness—her persona—is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this.<sup>169</sup>

Based on the assumption that a persona is neither authored nor fixed, courts and commentators have consistently concluded that the right of publicity falls outside of the subject matter of the Copyright Act and cannot be preempted under Section 301.<sup>170</sup> But such a position—advanced as a virtual truism<sup>171</sup>—typically comes without explanation or support, as if it were a simple reality, like the blue color of the sky. In fact, when scrutinized, this concept of identity rests on far weaker grounds than it might appear at first blush.

Though oft-repeated, it is simply not true that "[o]ne's persona, in all its varying aspects, is incapable of reduction to tangible form."<sup>172</sup> Indeed, the constituent elements of a right of publicity—name, voice, and likeness—are far more amenable to characterization as works of authorship than courts and commentators have previously allowed.<sup>173</sup> After all, while some part of a celebrity's look may be the product of nature and birth, a great deal is the product of deliberate, authorial agency—carefully constructed, manipulated, and manicured with the exercise of myriad creative decisions that are fixed in and on the tangible medium of the human body. This is especially true in the modern era, where the mythmaking and publicity machines of Hollywood work in overdrive, as stars draw on various technologies, including new surgeries and techniques, to customize their likenesses. For all intents and purposes, therefore, a celebrity is a type of

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169. *Id.* at 910.

170. *See id.* at 910–11.

171. One commentator has described any position to the contrary as "ridiculous." *See* David E. Shipley, *Three Strikes and They're out at the Old Ball Game: Preemption of Performers' Rights of Publicity Under the Copyright Act of 1976*, 20 ARIZ. ST. L.J. 369, 387 (1988) (positing that "it is ridiculous to regard the people who might be pictured in a photograph or painting as authors").

172. Michael J. McLane, *The Right of Publicity: Dispelling Survivability, Preemption and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W.L. REV. 415, 423 (1983).

173. *See, e.g., infra* text accompanying notes 174–77 (comparing celebrity personae to copyrightable characters).

character.<sup>174</sup> For example, the protectible persona of the 1970's version of the band Kiss was very much grounded in a particular combination of graphical art (makeup fixed in the tangible medium of the skin), sculptural work (heavily manipulated "big" hair stylized in a particular fashion), and one very long tongue.<sup>175</sup> Michael Jackson's ever-evolving look was the direct product of numerous intricately curated facial alterations created by plastic surgeon-artists (perhaps even as works made for hire).<sup>176</sup> And one would be hard-pressed to know the difference amongst the amalgamation of characters Woody Allen has played in his movies, his celebrity persona, and even his "real" self.<sup>177</sup>

The largely unscrutinized assumption that celebrity personae uniformly lie outside of the subject matter of copyright is even more unusual given the forms of copyright protection that courts have recognized in related areas. For example, courts have shown no compunction about granting copyright protection to characters so long as they are sufficiently delineated and/or constitute the story being told.<sup>178</sup> Celebrity personae are often akin to inhabited characters that, like the animated characters protected in *Walt Disney Productions v. Air Pirates*,<sup>179</sup> are replete with both "physical as well as conceptual

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174. See Rebecca Dancer, *Plastic Surgery Trends Continue to Be Influenced by Social Media, According to New Report*, ALLURE (Feb. 19, 2020), <https://www.allure.com/story/plastic-surgery-trends-aafprs-annual-report-2019> [https://perma.cc/3K2E-ZXSW] (discussing how celebrity plastic surgery trends influence others to get surgeries).

175. Deb Taylor, *The Truth About Gene Simmons' Cow Tongue*, SUGGEST (June 17, 2021, 10:06 AM), <https://www.suggest.com/gene-simmons-cow-tongue/447> [https://perma.cc/88F8-ZCJV].

176. See Jon Meyersohn, Cynthia McFadden, & Tom McCarthy, *Why Did Michael Jackson Go so Far to Alter His Appearance?*, ABC NEWS (July 1, 2009, 6:56 PM), <https://abcnews.go.com/2020/MichaelJackson/story?id=7982236&page=1> [https://perma.cc/6PX7-56FG] (describing the potential surgeries that Michael Jackson may have undergone despite his denials of multiple surgeries).

177. Cf. Kenneth Turan, *Woody Allen's Familiar Screen Persona Isn't Aging Well*, L.A. TIMES (May 3, 2002, 12:00 AM), <https://www.latimes.com/archives/la-xpm-2002-may-03-et-kenny3-story.html> [https://perma.cc/UG4V-NVD2] (noting that, despite the growing age discrepancy between him and the female lead actresses cast in his films, Allen long played "the same nebbishy Manhattan-loving neurotic[]" characters who "invariably end up with their youthful, attractive co-stars").

178. See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (recognizing the protectability of characters so long as they are sufficiently delineated); *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys.*, 216 F.2d 945, 950 (9th Cir. 1954) (protecting characters only if they "constitute[]" the story being told").

179. 581 F.2d 751 (9th Cir. 1978).

qualities . . . [that] contain some unique elements of expression.”<sup>180</sup> Meanwhile, courts have also had no problem considering alterations to the flesh, such as tattoos, within the scope of copyright protection. For example, in one of the odder suits in the annals of copyright jurisprudence, artist S. Victor Whitmill sued Warner Bros over the tattoo featured on actor Ed Helm’s face in the film *The Hangover Part II*, claiming it was an almost identical, unlicensed copy of the famous tattoo he created for boxer, Mike Tyson.<sup>181</sup> Although Whitmill lost his motion for a preliminary injunction to enjoin distribution of the movie, he managed to wrest a settlement from Warner Bros.<sup>182</sup> In the court’s consideration of Whitmill’s request for a preliminary injunction, the court had no problem acknowledging that Whitmill had a valid copyright (a position with which the Copyright Office, having granted him a registration on the tattoo, agreed) and was likely to prevail on the merits of his claim, to boot.<sup>183</sup> If a tattoo whose sole fixation exists on skin can earn copyright protection, it is only fair to ask why faces, originally constructed by nature but then morphed over time through a series of creative decisions captured in, and literally written onto the flesh, cannot. Despite the old metaphor of the body as canvas, courts seem to have instinctively forgotten the adage when assessing the copyrightability of the identity traits that compose a persona.<sup>184</sup>

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180. *Id.* at 755.

181. Complaint at 1, *Whitmill v. Warner Bros. Ent., Inc.* No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011).

182. Matthew Belloni, *Warner Bros. Settles ‘Hangover II’ Tattoo Lawsuit*, HOLLYWOOD REPORTER (June 20, 2011), <https://www.hollywoodreporter.com/business/business-news/warner-bros-settles-hangover-ii-203377> [<https://perma.cc/36DU-32SG>].

183. See Transcript of Hearing on Motion for Preliminary Injunction at 3, *Whitmill*, No. 4:11-cv-752 CDP, 2011 WL 11819138 (“If I look at the likelihood of success on the merits, I think plaintiff has a strong likelihood of prevailing on the merits for copyright infringement. Most of the defendant’s arguments against this are just silly. Of course tattoos can be copyrighted. I don’t think there is any reasonable dispute about that. They are not copyrighting Mr. Tyson’s face, or restricting Mr. Tyson’s use of his own face, as the defendant argues, or saying that someone who has a tattoo can’t remove the tattoo or change it, but the tattoo itself and the design itself can be copyrighted, and I think it’s entirely consistent with the copyright law . . .”).

184. Meanwhile, one might object that some aspects of a right of publicity (such as a voice or a particular stylized tick that becomes part of one’s persona) are not really fixed unless and until captured in another type of copyrighted work (such as a sound recording or a film). But we have clear examples of other types of copyrighted works that enjoy protection even though their expression in a tangible medium typically

All told, despite blind assumptions to the contrary, numerous aspects of a celebrity persona that now come under the scope of likeness rights are, at least arguably, authored and fixed in a tangible medium. The issue of whether likeness rights are authored or fixed is more complicated than commentators or courts have historically asserted.

Of course, even if elements of a right of publicity claim come under the scope of the Copyright Act (the first part of the § 301 preemption query), state law misappropriation claims are not preempted unless they also vindicate rights equivalent to the exclusive rights protected under federal copyright law (the second part of the § 301 preemption query).<sup>185</sup> On this latter question, courts typically apply the “extra elements” test,<sup>186</sup> which asks whether the state law claim contains an “extra element . . . [that] changes the nature of the action so that it is *qualitatively* different from a copyright infringement claim.”<sup>187</sup> Although a few outlier courts have held otherwise, the commercial misappropriation elements to right of publicity claims are not usually

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comes only by way of being captured in another copyright work. One example is musical compositions, which, although sometimes written out prior to existing, often do not have an independent existence until they are actually captured in a (separately copyrightable) sound recording. Many modern artists simply play music and sing lyrics aloud (in a non-fixed form) until they create a musical composition. Then they capture that musical composition on tape rather than engaging in the act of scribbling the musical notes and lyrics. Nevertheless, courts do not demand that the musical composition exist in a tangible form by itself (that is, in formal musical notation) to receive protection. Instead, musical compositions have received protection as copyrightable works since at least 1909 (far longer than sound recordings, at least at federal law). *Historically Significant U.S. Copyright Legislation*, MUSIC LIBR. ASS'N, [https://www.musiclibraryassoc.org/mpage/copyright\\_hsl#:~:text=The%20third%20major%20revision%20to,maximum%20term%20of%2056%20years](https://www.musiclibraryassoc.org/mpage/copyright_hsl#:~:text=The%20third%20major%20revision%20to,maximum%20term%20of%2056%20years) [https://perma.cc/G7YS-68G2].

185. *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005).

186. Virtually every circuit has adopted this “extra element” heuristic. *See, e.g.*, *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716–17 (2d Cir. 1992); *Rosciszewski v. Arete Assocs., Inc.*, 1 F.3d 225, 229–30 (4th Cir. 1993), *superseded by statute*, VA. CODE ANN. § 18.2-152.3 (2020); *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995); *Allied Artists Picture Corp. v. Rhodes*, 679 F.2d 656, 659 (6th Cir. 1982); *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 679 (7th Cir. 1986); *Nat'l Car Rental Sys., Inc. v. Comput. Assocs. Int'l, Inc.*, 991 F.2d 426, 431 (8th Cir. 1993); *Del Madera Props. v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 977 (9th Cir. 1987), *overruled on other grounds by* *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994); *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 847–48 (10th Cir. 1993); *Crow v. Wainwright*, 720 F.2d 1224, 1226 (11th Cir. 1983).

187. *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985).

sufficient extra elements to render them substantively distinguishable from copyright infringement claims except for the subject matter to which they pertain.<sup>188</sup> As a result, the non-preemption of right of publicity claims largely rests on the courts' belief that personae lie outside the scope of the Copyright Act—a position potentially subject to greater scrutiny in future cases.

Meanwhile, even if celebrity personae do not fall under the protection of the Copyright Act, that does not mean that they do not come under its scope. Specifically, in deciding what might enjoy copyright protection, the copyright regime also elects to deed certain things (like ideas and facts) to the public domain. If that is the case, a state law that propertizes certain aspects of personae and takes them out of the commons could interfere with the functioning of the copyright regime. For example, it is an axiomatic principle that ideas cannot enjoy copyright protection.<sup>189</sup> But that does not mean that states can grant exclusive rights to prevent all commercial misappropriations of an idea, as such a grant could upset Congress's careful balancing act between copyright and the commons to achieve maximal progress in the arts.<sup>190</sup> For example, the Fifth Circuit recently found that the Copyright Act preempted an application of Texas misappropriation law to protect a valve design that the Copyright Act expressly chose not to protect.<sup>191</sup> Noting that “[s]cope and protection are not synonyms,”<sup>192</sup> the court held that “state claims based on ideas

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188. See, e.g., *Motown Rec. Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240 (C.D. Cal. 1987) (“The fact that [California’s statutory right of publicity] requires that the unauthorized use must be in connection with the advertising of a product, unlike copyright, is not a *qualitative* extra element which changes the nature of the action.”), *rev’d sub nom.* *Motown Rec. Corp. v. Wilson*, 849 F.2d 1746 (9th Cir. 1988) (per curium).

189. *What Does Copyright Protect?*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/help/faq/faq-protect.html#:~:text=Copyright%20does%20not%20protect%20ideas,your%20written%20or%20artistic%20work> [https://perma.cc/ADY7-Z3MR].

190. Section 102(b) of the Copyright Act makes explicit that copyright protection does not “extend to any idea.” 17 U.S.C. § 102(b).

191. *Ultraflo Corp. v. Pelican Tank Parts, Inc.*, 845 F.3d 652, 653 (5th Cir. 2017). Plaintiff conceded, and the Court agreed, that the valve design was not protected under the Copyright Act as it was “either a useful article or an idea.” *Id.* at 656 (footnote omitted).

192. *Id.* (quoting *United States ex rel. Berge v. Bd. of Trs.*, 104 F.3d 1453, 1463 (4th Cir. 1997); see also *Endemol Ent. B.V. v. Twentieth Television Inc.*, No. CV 98-0608 ABC (BQR), 1998 WL 785300, at \*3 (C.D. Cal. Sept. 29, 1998) (“Even though the ideas

fixed in a tangible medium of expression fall within the subject matter of copyright even though copyright law does not protect the mere ideas.”<sup>193</sup> As a result, the court concluded that “[a]llowing state law to protect such works would undermine the ‘deliberate exclusion’ of such subject matter from the federal copyright scheme.”<sup>194</sup>

With the sympathetic issues often at play in right of publicity cases (where an individual’s notoriety is, without authorization, exploited by a third party for express commercial gain), the valuable rights at stake, and the absence of clear congressional intent<sup>195</sup> on the preemption issue,<sup>196</sup> it is not entirely surprising that courts have eschewed preemption of such claims. But if celebrity personae are not protected under copyright law, it is fair to ask why they should receive copyright-like protections under state law that are not afforded to other ideas, facts,

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embodied in a work covered by the Copyright Act fall outside copyright *protection*, this does not mean that they fall outside the Act’s *scope* regarding its subject matter . . .”).

193. *Ultraflo Corp.*, 845 F.3d at 657 (citing *Spear Mktg., Inc. v. BancorpSouth Bank*, 791 F.3d 586, 597 (5th Cir. 2015)).

194. *Id.* (quoting *Spear Mktg.*, 791 F.3d at 596). Although the court grounded much of its preemption analysis in § 301 of the Copyright Act, it ultimately employed the broader notion of conflict preemption in concluding that, “[t]o allow state law protection in this area that Congress excluded from the ambit of copyright thus would run afoul of the ‘familiar doctrine’ that the federal policy ‘may not be set at naught, or its benefits denied’ by the state law.” *Id.* at 659 (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964)).

195. It is worth noting that right of publicity claims themselves were far less common at the time of the 1976 Copyright Act’s passage than they are today, meaning that the real issues at play may not have been before Congress at the time.

196. Some courts have interpreted the House Report that accompanied the 1976 Copyright as resolving the issue firmly against preemption. *See, e.g.*, *Ippolito v. Ono-Lennon*, 526 N.Y.S.2d 877, 882 (Sup. Ct. N.Y. Cnty. 1988) (holding, without explanation, that “it is clear from the cited House Report that plaintiff’s first cause [for a right of publicity violation] . . . would not be preempted as [it] involve[s] something more than rights equivalent to those under the Federal Copyright Act.”). However, the actual language of the House Report is vague, stating only a conditional truism—“common law rights of ‘privacy,’ ‘publicity,’ and trade secrets, . . . would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.” H.R. Rep. No. 94-1476, at 132 (1976). Thus, the House Report makes no express statement about the non-preemption of publicity rights claims. Indeed, even some who oppose preemption admit the lack of clarity in the legislative history. *See, e.g.*, MCCARTHY & SCHECHTER, *supra* note 158, § 11:50 (admitting that “this legislative history is cast in some doubt because it referred to the ‘missing illustrative list’ [originally slated for codification in 17 U.S.C. § 301(a) and detailing state law claims that would not be preempted under the Copyright Act] deleted at the last moment in the House of Representatives”).

or methods of operation that lie outside of the scope of federal copyright protection and remain in the public domain for all to use. After all, as the Fifth Circuit succinctly put it, “copyright preemption prohibits state interference with Congress’s decision not to grant copyright protection just as much as it protects a decision to provide protection.”<sup>197</sup>

Meanwhile, even if the publicity rights fall outside the subject matter of copyright and, therefore, do not suffer complete preemption under § 301, thorny issues still plague the enforcement of the right of publicity under field and conflict preemption principles emanating from the Constitution’s Supremacy Clause.<sup>198</sup> Specifically, when read broadly, the right of publicity can undermine the very protections and rights that federal copyright law secures exclusively for authors. For example, as the undisputed author to certain photographs of Jay-Z, Mannion alone enjoys the exclusive right to reproduce, distribute, and publicly display the images.<sup>199</sup> Although merchandising uses of the works might implicate Jay-Z’s publicity rights by involving an extra element—commercial misappropriation—copyright preemption would seem to preclude claims against pure use of the prints as fine art.<sup>200</sup> Any other result would significantly dilute, if not render meaningless, the ability of copyright holders, such as Mannion, to exercise their § 106 rights, thereby potentially violating federalism principles.

Indeed, as David Nimmer has pointed out, “[a]part from . . . odd exceptions, both federal- and state-court decisions routinely follow” the logic of *Fleet v. CBS, Inc.*,<sup>201</sup> a California case that held that copyright law preempts right of publicity claims stemming from basic exploitation of the copyrighted work in which the subject appeared.<sup>202</sup> The Ninth Circuit has adopted and expanded on the rationale of *Fleet*,

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197. *Ultraflo Corp.*, 845 F.3d at 653.

198. U.S. CONST. art. VI, § 2 (deeming federal law “the supreme Law of the Land”). As the Supreme Court has noted, the Supremacy Clause is invoked if a state law “actually conflicts with a valid federal statute” or “stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.” *Edgar v. MITE Corp.*, 457 U.S. 624, 631 (1982) (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

199. 17 U.S.C. § 106 (granting copyright holders the exclusive right to, among other things, reproduce, distribute and public display their works).

200. See Brittain, *supra* notes 148–50 and accompanying text.

201. 58 Cal. Rptr. 2d 645 (1996).

202. NIMMER & NIMMER, *supra* note 88, § 1.17.

seemly precluding the viability of Jay-Z's position in a matter brought by athletes challenging unauthorized exploitation of their images in sports journalism photographs.<sup>203</sup> As the court held, all right of publicity claims related to copyrighted images are preempted except "when [the claim] targets non-consensual *use* of one's name or likeness *on merchandise or in advertising*."<sup>204</sup> Such a rule, reasoned the court,

strikes the right balance by permitting athletes to control the use of their names or likenesses on merchandise or in advertising, while permitting photographers, the visual content licensing industry, art print services, the media, and the public, to use these culturally important images for expressive purposes. Plaintiffs' position, by contrast, would give the subject of every photograph a de facto veto over the artist's rights under the Copyright Act, and destroy the *exclusivity* of rights that Congress sought to protect by enacting the Copyright Act.<sup>205</sup>

#### *B. Merchandise Versus Art*

That said, the line between merchandising, which is characterized as a commercial exploitation for purposes of trade that typically triggers a right of publicity violation, and mere use as artwork, which is typically characterized as a form of noncommercial expression that is insulated from liability, is often unclear. For example, in 2004, when Arnold Schwarzenegger sued a company creating unauthorized bobbleheads featuring his visage, there were legitimate questions as to whether the bobbleheads were merchandise or art and whether they were transformative in any way.<sup>206</sup> Complicating the query was the timing of

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203. See *Maloney v. T3Media, Inc.*, 853 F.3d 1004, 1011 (9th Cir. 2017).

204. *Id.* (emphasis added). As the Ninth Circuit reasoned in a prior case:

Since [the challenged] use of plaintiffs' likenesses did not extend beyond the use of the copyrighted material it held, there was no right of publicity at issue, aside from the actors' performances. Had the court held otherwise, each actor could claim that any showing of the film violated his right to control his image and persona.

*Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1143 (9th Cir. 2006).

205. *Maloney*, 853 F.3d at 1019.

206. *Oak Prods., Inc. v. Ohio Disc. Merch., Inc.*, No. SC081563 (L.A. Super. Ct. filed Apr. 30, 2004). The parties settled shortly thereafter in an agreement that allowed the bobblehead maker to proceed with sales, but only so long as it did not depict Schwarzenegger brandishing an assault rifle (as it originally had). See John M. Broder, *Bobblehead Is Stilled*, N.Y. TIMES (Aug. 3, 2004), <https://www.nytimes.com/2004/08/03/us/national-briefing-west-california-bobblehead-is-stilled.html> [<https://perma.cc/8B5A-C57V>].

the release, which occurred in the midst of Schwarzenegger's gubernatorial years.<sup>207</sup> As a result, the creation and distribution of the bobbleheads seemed to constitute an act of political speech (along with artistic expression) that would seemingly lie at the heart of the type of expression sheltered from liability under the First Amendment.<sup>208</sup> Additionally, now that the Supreme Court has recognized video games as works of art entitled to full free speech rights,<sup>209</sup> it is fair to wonder whether the unauthorized use of celebrity likenesses in games (or even in virtual "merchandise" sold as part of the game) is protected under the First Amendment and other limitations to the right of publicity.<sup>210</sup> One may legitimately ask why an artistic rendition of the Three Stooges featured on a wearable canvas (a t-shirt) would fall on the unprotected merchandise side of the equation and result in a right of publicity violation<sup>211</sup> while an artistic rendition of a golfer featured on a hanging canvas<sup>212</sup> and an actual photograph of a quarterback on a commemorative poster<sup>213</sup> would evade liability as protected art.<sup>214</sup>

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207. See Broder, *supra* note 206.

208. See generally David S. Welkowitz & Tyler T. Ochoa, *The Terminator as Eraser: How Arnold Schwarzenegger Used the Right of Publicity to Terminate Non-Defamatory Political Speech*, 45 SANTA CLARA L. REV. 651, 652–53 (2005) (pointing out that politicians and other public figures face a higher standard in defamation suits).

209. See *Brown v. Ent. Merchs. Ass'n*, 564 U.S. 786, 790 (2011) (noting that video games communicate ideas through familiar literary devices and features distinctive to the medium in ways that suffice to confer First Amendment protection).

210. William K. Ford, *So Are Games Coffee Mugs or What? Games and the Right of Publicity Revisited*, 19 UIC REV. INTELL. PROP. L. 178, 178–82 (2020).

211. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799–801 (Cal. 2001) (finding liability for a charcoal rendition of the Three Stooges featured on t-shirts).

212. See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (finding no liability for a painting of Tiger Woods taking his place amongst the Masters champions of the past).

213. See *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995) (holding that commemorative posters sold to honor quarterback Joe Montana were protected from right of publicity liability under the First Amendment as they were newsworthy and had previously appeared on the front page of a newspaper).

214. As one observer has wryly suggested about the seeming incoherence of right of publicity jurisprudence, "[p]erhaps this simply confirms that right of publicity issues are heavily fact-dependent and require careful analysis. Or perhaps Curly had it right all along: 'This is gettin' on my noives!'" D. John Hendrickson, *From the Three Stooges to T3Media: Is the Right of Publicity a Comedy of Errors?* MANHATTAN ADVERT. & MEDIA L. BLOG (Dec. 2, 2019), <https://www.admedialaw.com/blog/2019/12/02/from-the-three->

Given the divergent jurisprudence, it should come as no surprise that there are prior cases that could conceivably support Jay-Z's position in his suit against Mannion. For example, a federal court held that a veteran who claimed to be the sailor kissing a woman in Alfred Eisenstadt's famous image, *VJ Day in Times Square*, had stated a valid claim under Rhode Island law for the sale of limited editions of the photograph (at \$1,600 each).<sup>215</sup> As the court reasoned, while the First Amendment may have once protected licensing of the image for its newsworthiness, its sale in limited editions so many decades later made the use "for purposes of trade" akin to merchandising, so as to fulfill the *prima facie* requirements for a misappropriation-of-likeness claim.<sup>216</sup> Thus, the sale of the limited editions was more akin to commercial exploitation (merchandise) than protected speech (art/journalism). Or, as another federal court put it more bluntly in a case addressing the King's publicity rights, "[t]here is no constitutional protection for selling posters of Elvis Presley as Elvis Presley."<sup>217</sup>

C. *Deconstructing the Vindication of Subject Rights Through the Right of Publicity: A Case Study in Litigation, Substance, & Procedure*

While these may be outlier cases, they raise another important point about the right of publicity: to date, no federal right of publicity law exists. Instead, publicity rights remain a pastiche of protections from the various states, each different in its own way.<sup>218</sup> This reality, combined with the inherently nationwide/interstate distribution of creative works, creates a perfect storm for forum shopping, as potential plaintiffs can choose amongst dozens of different regimes for the law and jurisdiction most favorable to their claims.<sup>219</sup>

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stooges-to-t3media-is-the-right-of-publicity-a-comedy-of-errors  
[<https://perma.cc/5XHM-8WQ3>].

215. *Mendonso v. Time Inc.*, 678 F. Supp. 967, 968, 972 (D.R.I. 1988). Time Inc. was the owner of Life Magazine, where the photograph initially appeared. *Id.* at 968.

216. *Id.*

217. *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 284–85 (S.D.N.Y. 1977), *aff'd, sub nom. Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978).

218. *Statutes & Interactive Map*, RIGHT OF PUBLICITY, <https://rightofpublicity.com/statutes> [<https://perma.cc/8L5W-CZE8>] (providing an overview of all state laws on rights of publicity).

219. See Brittany Lee-Richardson, *Multiple Identities: Why the Right of Publicity Should Be a Federal Law*, 20 UCLA ENT. L. REV. 189, 222–23 (2013) (arguing that a federal right of publicity statute would prevent plaintiffs from forum shopping).

A deep dive into use of the right of publicity to vindicate the rights of subjects—as embodied in a real case—illustrates the complex machinations at play, the hurdles to such claims, and the strategic choices involved in the choice of jurisdiction and venue. In 2019, the Estate of Dean Potter, through its counsel of record (which included the author of this Article), sued LG Electronics.<sup>220</sup> Dean Potter was a legendary rock climber, BASE jumper, and highliner.<sup>221</sup> After his untimely and tragic death from a wingsuit flying accident at Yosemite National Park in 2015, the proprietary rights to his name, image, and likeness<sup>222</sup> were devised to his surviving siblings.<sup>223</sup> In 2018, his family started receiving surprising reports that Potter was making posthumous appearances in a multi-million-dollar national advertising campaign for LG Electronics' new line of OLED televisions.<sup>224</sup> The commercials depicted Potter traversing a highline tied to Cathedral Peak in Yosemite National Park as a dilated full moon dramatically rose in the background horizon.<sup>225</sup> LG obtained rights to the footage, captured in the short film, *Moonwalk*, from the movie's putative copyright holder.<sup>226</sup> However, LG had not sought permission from Potter's Estate to depict Potter.<sup>227</sup> Besides the economic harm that the Estate suffered from LG's unlicensed appropriation of Potter's commercially-valuable publicity rights, the Estate also suffered from Potter's post-mortem association with a brand antithetical to Potter's lifestyle and beliefs and from the pain of seeing a deceased brother, who passed away during a similar daredevil stunt, unwittingly resurrected as a commercial skill for consumer electronics.<sup>228</sup> After efforts to resolve the matter short of litigation failed, the Potter Estate filed suit in Indiana claiming, among other things, violation of Indiana's right of publicity statute.<sup>229</sup>

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220. Complaint at 1, *Dean Potter LLC v. LG Elecs. USA, Inc.*, No. 1:19-cv-04085-JPH-TAB (S.D. Ind. Oct. 1, 2019).

221. *Id.* at 4.

222. These rights endure posthumously under Indiana Code. *See* IND. CODE ANN. § 32-36-1-1 (West 2021).

223. Complaint, *supra* note 220, at 4.

224. *Id.* at 8.

225. *Id.*

226. *Id.* at 15.

227. *Id.* at 13.

228. *Id.* at 13–15.

229. *Id.* at 1.

1. *State-to-state differences in the substantive scope of protections*

The choice of Indiana as the operative forum and law for the case might seem curious at first blush. After all, Potter was a California resident when he died, and his estate was administered under California law. But the laws of Indiana—where the commercials had played, and the advertised product had been sold—provided significant advantages to putative rightsholders—advantages particularly relevant in the Potter suit and in the Estate’s attempt to vindicate Potter’s subject rights.

First, Indiana’s right of publicity statute protects a far more fulsome concept of identity/persona than similar provisions in other states, including California. Under the Indiana Code, “[a] person may not use an aspect of a personality’s right of publicity for a commercial purpose during the personality’s lifetime or for one hundred (100) years after the date of the personality’s death without having obtained previous written consent from a person” vested with control of the personality’s publicity rights.<sup>230</sup> Most importantly for Potter’s purposes, Indiana’s relevant statute defines a person’s publicity right as including: “(1) name; (2) voice; (3) signature; (4) photograph; (5) image; (6) likeness; (7) distinctive appearance; (8) gestures; or (9) mannerisms.”<sup>231</sup>

Second, Indiana’s statutory language has no express scienter requirement for the imposition of liability.<sup>232</sup> By contrast, California’s Civil Code Section 3344 prohibits only any “*knowing*[ ] use[ ] [of] another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent.”<sup>233</sup> All told, Indiana’s statutory right of publicity is simultaneously both more expansive (it covers images, distinctive appearances, gestures, or mannerisms) and less demanding (it requires no showing of knowledge) than California’s.

Both of these differences would play a salient role in assessing the Potter claim. LG claimed no violation of the right of publicity because, among other things, Potter’s name was not used and his facial features

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230. IND. CODE § 32-36-1-8(a) (2021).

231. *Id.* § 32-36-1-7.

232. *See id.* § 32-36-1-8.

233. CAL. CIV. CODE § 3344(a) (West 2022) (emphasis added).

were not shown, thereby allegedly rendering him unidentifiable.<sup>234</sup> Indeed, since the operative footage of Potter only showed his silhouette while he conducted his famous line-walk to Cathedral Peak, the fact that Indiana's statute encompasses "distinctive appearance," "gestures," and "mannerisms" made the claim that the advertisement implicated Potter's right of publicity stronger<sup>235</sup> in Indiana than in California.<sup>236</sup> In fact, the California statute further requires that, in any case involving photographs, a plaintiff must be "readily identifiable" in the work, which the statute defines as occurring "when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use."<sup>237</sup> Assuming this language would apply to audiovisual works like film, it could have served as a serious impediment to Potter's claim under California law. Additionally, since the advertisement for LG was created by a third party—an advertising agency operating out of Korea over whom jurisdiction in the United States might have been difficult to obtain—it would be easier for Potter to prevail against LG without an express showing that LG had the proper mental state for liability.<sup>238</sup>

Thus, one's ability to protect subject rights through the right of publicity varies dramatically by state. Consider the fact that the *Svenson*

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234. Defendant's Statement of Defenses It Will Prove at Trial at 2, Dean Potter LLC v. LG Elecs. USA, Inc., No. 1: 19-cv-04085-RLM-TAB (S.D. Ind. July 27, 2020).

235. IND. CODE § 32-36-1-7. *But see* Newcombe v. Adolf Coors Co., 157 F.3d 686, 692 (9th Cir. 1998) (finding a right of publicity claim to be stated under California law for an unauthorized replication of silhouette showing a major league pitcher's distinctive wind-up and stance, despite a lack of facial visibility or specific bodily features, in a beer advertisement).

236. Of course, in California, plaintiffs can also seek relief under California's common law right of publicity, which co-exists alongside the statutory right and has sometimes been defined more broadly. *See, e.g.*, White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1397–98 (9th Cir. 1992) (noting that California's common law right of publicity is more expansive than the statutory right in that the former covers imitations of a celebrity, such as a robot dressed as Vanna White). But, for a deceased celebrity, only the provisions of California's statutory protections apply since the California Supreme Court has held that, at common law, there are no post-mortem publicity rights. *See* Lugosi v. Universal Pictures, 603 P.2d 425, 430–31 (Cal. 1979) (en banc) (holding that California common law recognized no posthumous right of publicity). In response to the *Lugosi* ruling, the California legislature passed the California Celebrities Rights Act of 1986, which granted post-mortem publicity rights protection via statute. *See* CAL. CIV. CODE § 3344.1 (effective Jan. 1, 2012).

237. CAL. CIV. CODE § 3344(b)(1).

238. *See supra* notes 231–33 and accompanying text.

plaintiffs sued Arne Svenson for intrusion on their privacy, not a violation of their right of publicity.<sup>239</sup> The decision not to bring the latter claim likely reflects the limitations of the scope of the right of publicity statute in New York, where the offending conduct took place. In part, this could be because Svenson was selling (at least to date) the works only as art.<sup>240</sup> But even if Svenson had licensed the photographs for use in advertisements for home cleaning products, the plaintiffs would still have had difficulty obtaining any relief under a misappropriation theory. By showing only bodies and silhouettes, the images featured in *The Neighbors* specifically eschewed depiction of the subjects' faces. Since the language of New York's right of publicity prohibits only the unauthorized use of someone's "name, portrait, picture or voice" for "advertising purposes or for the purposes of trade,"<sup>241</sup> the subject portraits captured in *The Neighbors* may not have made sufficient use of a propriety personality right protected under New York law to be actionable. Although not relevant to the *Svenson* plaintiffs, other significant jurisdictional variances—such as differences in remedies,<sup>242</sup> the availability of posthumous application,<sup>243</sup> the term of protection,<sup>244</sup> and even registration requirements<sup>245</sup>—can also create complications for subject-plaintiffs seeking right of publicity relief and can impact decisions related to forum.

## 2. *Anti-SLAPP concerns*

Right of publicity claimants face significant landmines in states such as California, which have a broad statute in place to deal with so-called "strategic lawsuits against public participation" (SLAPP). As such, the applicability of anti-SLAPP relief to right of publicity claims plays a significant role in determining whether the pursuit of such claims makes sense in a particular jurisdiction. California Code of Civil

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239. See *supra* notes 39–43 and accompanying text.

240. See *supra* text accompanying notes 40–43.

241. N.Y. CIV. RTS. LAW § 51 (McKinney 2022).

242. RIGHT OF PUBLICITY COMM., INT'L TRADEMARK ASS'N, RIGHT OF PUBLICITY STATE OF THE LAW SURVEY 2-5 (2019).

243. In New York, for example, no post-mortem right of publicity existed until the legislature amended New York Civil Right Law to extend such protections in 2021. See N.Y. CIV. RTS. LAW § 50-f(2) (effective May 29, 2021).

244. Protection can endure for just a lifetime or, in the case of a state like Indiana, for 100 years after death. See IND. CODE ANN. § 32-36-1-8(a) (2021).

245. For example, Nevada requires formal registration of personality rights before allowing any posthumous enforcement thereof. See NEV. REV. STAT. § 597.800 (2021).

Procedure section 425.16, commonly referred to as the “anti-SLAPP” statute, seeks to deter the “disturbing increase in lawsuits brought primarily to chill the valid exercise of the constitutional rights of freedom of speech and petition for the redress of grievances” by providing an early mechanism for courts to dispense with such actions.<sup>246</sup> The anti-SLAPP statute allows a defendant to bring a motion to strike/dismiss within sixty days of service<sup>247</sup> of a complaint against any eligible state or common law claims on which the plaintiff cannot establish a probability of prevailing.<sup>248</sup> Prevailing defendants not only earn immediate dismissal of the claim(s) but also an automatic reimbursement of their attorneys’ fees and costs to defend the suit.<sup>249</sup> Notably, the anti-SLAPP statute’s fee provisions run only one-way. Plaintiffs who fend off an anti-SLAPP motion never receive fees unless the defendant’s motion is “frivolous or . . . solely intended to cause unnecessary delay.”<sup>250</sup> To make matters even worse from a plaintiff’s perspective, even when defendants lose an anti-SLAPP motion, they still benefit from an automatic stay on discovery that occurs pending resolution of the motion and the immediate (interlocutory) right to appeal any denial of such a motion—a move that often pauses a case for several years while it works itself through the appellate court system.<sup>251</sup>

Courts adjudicate California anti-SLAPP motions using a two-part test. The defendant must first show that the claim being “SLAPPED” arises from, “any act . . . in furtherance of [a] person’s right of petition or free speech under the United States Constitution or the California

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246. CAL. CIV. PROC. CODE § 425.16(a) (West 2022).

247. *Id.* § 425.16(f).

248. There is no federal anti-SLAPP statute and, as a result, the anti-SLAPP statute does not apply to federal claims, although federal courts will entertain anti-SLAPP statutes that pertain to state or common law claims. *See, e.g.*, *United States ex rel. Newsham v. Lockheed Missiles & Space Co.* 190 F.3d 963, 973 (9th Cir. 1999) (upholding the application of the anti-SLAPP statute in federal court to state and common law claims since, *inter alia*, “the twin purposes of the *Erie* rule—discouragement of forum-shopping and avoidance of inequitable administration of the law”—favor application of California’s Anti-SLAPP statute in federal cases” (quoting *Hanna v. Plumer*, 380 U.S. 460, 468 (1965))).

249. CAL. CIV. PROC. CODE § 425.16(c)(1).

250. *Id.*

251. *Id.* § 425.16(g).

Constitution in connection with a public issue.”<sup>252</sup> If the defendant meets this burden, the court must dismiss the claim unless the plaintiff can establish a probability of prevailing on the merits.<sup>253</sup> At first blush, right of publicity claims relating to the commercial misappropriation of celebrity likenesses might appear far afield from the original intent of an anti-SLAPP statute, which seeks to prevent individuals and entities from using the legal process as a way to chill legitimate speech and petitioning activity on important matters of public concern.<sup>254</sup> However, the way in which California courts have construed the anti-SLAPP statute has, in effect, brought most right of publicity suits within its purview.

Drawing from the statute’s explicit dictate that the anti-SLAPP be “construed broadly” in order to “encourage continued participation in matters of public significance,”<sup>255</sup> courts have interpreted eligibility for anti-SLAPP treatment quite generously. As the Ninth Circuit noted, while

[t]he California Supreme Court has not drawn the outer limits of activity that furthers the exercise of free speech rights . . . [i]t seems to suffice . . . that the defendant’s activity is communicative . . . . Thus, the courts of California have interpreted this piece of the defendant’s threshold showing rather loosely.<sup>256</sup>

Courts have consequently held that actions are in furtherance of a right to petition or free speech in connection with a “public issue” if “the subject of the . . . activity underlying the claim (1) was a person or entity in the public eye; (2) could affect large numbers of people beyond the direct participants; or (3) involved a topic of widespread, public interest.”<sup>257</sup> Construing this “public issue/public interest” requirement pliantly,<sup>258</sup> courts have held that conduct is made “in connection with a public issue or an issue of public interest,” as required by California Code of Civil Procedure Section 425.16(e)(4),

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252. *Id.* § 425.16(b)(1). To prevail on an anti-SLAPP motion, a defendant need not prove that the plaintiff intended to chill the defendant’s exercise of constitutional rights. *See Equilon Enters., LLC v. Consumer Cause, Inc.*, 52 P.3d 685, 688 (Cal. 2002) (stating that “the defendant has no such burden”).

253. *Civ. PROC.* § 425.16(b)(1).

254. *Id.* § 425.16(a).

255. *Id.*

256. *Hilton v. Hallmark Cards*, 599 F.3d 894, 903–04 (9th Cir. 2009).

257. *D.C. v. R.R.*, 106 Cal. Rptr. 3d 399, 426 (Ct. App. 2010) (citing *Jewett v. Capital One Bank*, 6 Cal. Rptr. 3d 675, 681 (Ct. App. 2003)).

258. *Gilbert v. Sykes*, 53 Cal. Rptr. 3d 752, 760–61 (Ct. App. 2007).

“if the . . . conduct concerns a topic of widespread public interest and contributes in some manner to a public discussion of the topic.”<sup>259</sup> Indeed, as one court has succinctly put it, an issue of public interest is “*any issue in which the public is interested.*”<sup>260</sup> Given this guidance and the very nature of celebrity, almost any defendant accused of misappropriating a celebrity’s likeness can credibly argue that the use pertains to an issue of public interest.

Unsurprisingly, therefore, courts in California have subjected all manner of state law claims related to the creation and dissemination of creative content, such as television shows or comic books, to the provisions of the anti-SLAPP statute.<sup>261</sup> Most significantly for our purposes, courts have not hesitated to apply the California anti-SLAPP statute to right of publicity claims. So, for example, when Paris Hilton sued Hallmark for selling a greeting card that featured her image and her erstwhile tagline (“That’s hot.”), the Ninth Circuit had no problem finding that Hilton’s right of publicity claim was subject to anti-SLAPP consideration.<sup>262</sup> As the court reasoned, Hallmark’s creation and dissemination of the card constituted an expressive act (the *greeting* card, after all, conveyed a particular message),<sup>263</sup> and it related to a matter of public interest (since there was “no dispute that Hilton is a person ‘in the public eye’ and ‘a topic of widespread, public interest’”).<sup>264</sup> With all of this in mind, almost any celebrity claim for a right of publicity violation in California can invoke a credible anti-SLAPP threat which, even if unsuccessful, can freeze a case in its tracks for multiple years. In short, litigating a right of publicity claim in California is a perilous endeavor.

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259. *Stewart v. Rolling Stone LLC*, 105 Cal. Rptr. 3d 98, 109 4th (Ct. App. 2010).

260. *Nygaard, Inc. v. Uusi-Kerttula*, 72 Cal. Rptr. 3d 210, 220 (Ct. App. 2008).

261. *See, e.g., Tamkin v. CBS Broad., Inc.*, 122 Cal. Rptr. 3d 264, 271 (Ct. App. 2011) (holding that “[t]he creation of a television show is an exercise of free speech” subject to the anti-SLAPP statute as the “defendants’ acts helped to advance or assist in the creation, casting, and broadcasting of an episode of a popular television show”); *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 404 (Ct. App. 2011) (holding that videogames are “considered ‘expressive works’ subject to First Amendment protections” and that “Activision’s use of No Doubt’s likenesses in *Band Hero* is a matter of public interest because of the widespread fame No Doubt has achieved”).

262. *Hilton v. Hallmark Cards*, 599 F.3d 894, 899, 903–04 (9th Cir. 2009).

263. *Id.* at 904 (“Thus, Hallmark’s card qualifies as speech and falls comfortably within the universe of types of communication that California courts have considered ‘conduct in furtherance of’ the exercise of free speech rights upon which to base anti-SLAPP motions to strike.”).

264. *Id.* at 907.

By sharp contrast, although Indiana has an anti-SLAPP statute that similarly provides for early dismissal of cases implicating the exercise of free speech rights on issues of public interest and granting an automatic award of attorneys' fees to prevailing defendants,<sup>265</sup> it is nowhere near as defendant-friendly as California's statute and would not apply to garden-variety right-of-publicity claims. First, under Indiana's statute, the burden of proof on the issue of a probability of success is the reverse of California's. Specifically, the defendant, not the plaintiff, must show, "by a preponderance of the evidence, that the act upon which the claim is based is a lawful act in furtherance of the person's right of petition or free speech."<sup>266</sup>

Secondly, and perhaps most importantly, although the language of the Indiana anti-SLAPP statute mimics California's by granting protection to any "act in furtherance of a person's right of petition or free speech under the Constitution of the United States or Constitution of the State of Indiana in connection with a public issue or an issue of public interest,"<sup>267</sup> the Indiana courts have interpreted the scope of the statute far more narrowly on the issue of what constitutes free speech in the public interest.<sup>268</sup> While California courts have effectively deemed celebrity lives as inherently of "public interest," Indiana courts have demurred.<sup>269</sup> The Indiana Supreme Court, for example, has emphasized that the anti-SLAPP's protection of free speech activities relates to the "unfettered interchange of ideas for the bringing about of political and social changes desired by the people."<sup>270</sup> In doing so, the court has defined "public issue" as "'any matter of political, social, or other concern to the community,' as determined by its content, form, and context,"<sup>271</sup> and has cautioned expressly *against* any broad reading of the concept.<sup>272</sup> Most saliently, it

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265. IND. CODE. § 34-7-7-1 to 10 (2021).

266. *Id.* § 34-7-7-9(d).

267. *Id.* § 34-7-7-1(a).

268. *Gresk v. Demetris*, 96 N.E.3d 564, 571 n.10 (Ind. 2018).

269. *Compare* *Seeling v. Infinity Broad. Corp.*, 119 Cal. Rptr. 2d 108, 115 (Ct. App. 2002) ("The offending comments [about a television show participant] arose in the context of an on-air discussion between the talk-radio cohosts and their on-air producer about a television show of significant interest to the public and the media.") *with* *Gresk*, 96 N.E.3d at 571 n.10 (declining to adopt California's broad Anti-SLAPP "public issue" categories).

270. *Gresk*, 96 N.E.3d at 570 (quoting *Lach v. Lake Cty.*, 621 N.E.2d 357, 358 (App. 1993)).

271. *Id.* at 571 (quoting *Love v. Rehfus*, 946 N.E.2d 1, 9 n.6 (Ind. 2011)).

272. *Id.*

exhorted lower courts to “avoid[] a sweeping view of what is ‘public.’”<sup>273</sup> In the process, the Indiana Supreme Court resoundingly rejected adoption of California’s far more capacious views on public interest.<sup>274</sup>

If the rightsholder in the Potter suit had brought the claim in California, it would have likely faced an immediate anti-SLAPP motion, which, given the extant precedent, may well have qualified as raising claims related to the exercise of free speech rights on an issue of public interest. As a result, Potter would have needed to demonstrate a probability of prevailing on the merits or face dismissal and an automatic assessment of costs and fees against it. In sharp contrast, the plaintiff faced no real risk of being immediately put on the defensive with exposure to anti-SLAPP relief in Indiana. These strategic considerations can make all the difference when assessing a case’s viability.

### 3. *Differing First Amendment limitations on the right of publicity*

Anti-SLAPP statutes are, of course, grounded in First Amendment concerns. But, in addition to differing scopes in the applicability of anti-SLAPP motions to right of publicity claims, jurisdictions have also adopted varying substantive defenses to the right of publicity in order to protect free speech.<sup>275</sup> Thus, besides the myriad publicity rights statutes and common-law protections from which they can select, plaintiffs can also cherry-pick from an array of judicial approaches to balancing right of publicity protections with expressive freedoms.<sup>276</sup> The differences amongst various jurisdictions in the scope and availability of First Amendment limitations on the right of publicity would also impact the Potter suit.<sup>277</sup>

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273. *Id.*

274. *Id.* at n.10 (“We decline to adopt the ‘public interest’ or ‘public issue’ categories identified in *Cross v. Cooper*, 197 Cal. App. 4th at 912–14, 128 Cal. Rptr. 3d 595, which were derived from California’s anti-SLAPP statute and their legislature’s directive to ‘construe[the statute] broadly.’ CAL. CIV. PROC. CODE § 425.16 (West 2018). Our General Assembly has not provided a similar legislative command.”).

275. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 152–58 (3rd Cir. 2013).

276. *See, e.g.*, *Price v. Stossel*, No. 07 Cv. 11364 (SWK), 2008 WL 2434137, at \*7 (S.D.N.Y. Jun. 4, 2008) (describing how plaintiff “apparently decided to refile his action, which was initially brought in California, in order to avoid the immediate-appeal provision of California’s anti-SLAPP statute”).

277. *See infra* note 292 (observing that no case law has yet determined the test for application of First Amendment protections to Indiana’s right of publicity statute).

Although courts routinely limit right of publicity claims under the First Amendment, the precise test for doing so remains unclear. In the only Supreme Court decision involving the right of publicity, the High Court rejected a news-reporting/First Amendment defense to a claim brought by Hugo Zacchini, the Human Cannonball, against an Ohio news broadcaster that had aired a fifteen-second segment compromising the entirety of his act.<sup>278</sup> While the Court acknowledged the tension between free speech and publicity rights, it declined to elaborate further.<sup>279</sup>

The High Court's silence since *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>280</sup> left state courts to individually determine where to draw the proverbial "line" between free expression and actionable misappropriation. In the name of protecting robust free-speech rights for those who use celebrity images as the raw materials for their creative expression, the California Supreme Court developed a particularly rigorous First Amendment check that has significantly curtailed the ability of subjects to limit the use of their likenesses in copyrighted materials. First announced in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,<sup>281</sup> this test asks "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question."<sup>282</sup> Uses characterized as the latter, rather than the former, are deemed transformative and, as such, are wholly immunized from right of publicity liability.<sup>283</sup> California's transformative-use test focuses on "whether a product containing a

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278. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1977) (reasoning that "[t]he Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner").

279. *See id.* at 574–75 ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent.").

280. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

281. 21 P.3d 797 (Cal. 2001).

282. *Id.* at 809.

283. *Ross v. Roberts*, 166 Cal. Rptr. 3d 359, 368 (Ct. App. 2013) ("[T]he validity of defendants' First Amendment defense here is quite obvious. . . . Roberts's work—his music and persona as a rap musician—relies to some extent on plaintiff's name and persona. . . . These were 'raw materials' from which Roberts's music career was synthesized. But these are not the 'very sum and substance' of Roberts's work.").

celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."<sup>284</sup> This test has provided generous protection to defendants facing liability under the right of publicity. Indeed, most courts have generally hewed to its broad construction of transformation, reading the concept more widely than in copyright law:

[T]ransformative elements or creative contributions that require First Amendment protection are not confined to parody [which has received particularly strong protection in copyright law] and can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism.<sup>285</sup>

For example, when Kierin Kirby, the lead singer of the band Deee-Lite, sued Sega for creating a videogame featuring a main character who seemed to share many of her traits, the California Court of Appeals rejected her right of publicity claims on First Amendment grounds.<sup>286</sup> Applying *Comedy III*, the court determined that Sega had "add[ed] something new, with a further purpose or different character, altering the first with new expression, meaning, or message"<sup>287</sup> and, as such, enjoyed protection from liability under the First Amendment, even though the video game character's facial features, clothing, hairstyle, and use of certain catchphrases bore a striking resemblance to Kirby.<sup>288</sup>

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284. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001). As the court further clarified, "when we use the word 'expression,' we mean expression of something other than the likeness of the celebrity." *Id.*

285. *Id.* (citations omitted).

286. *See Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 614 (2006) (agreeing with the respondents who contend "that their right of free expression under the First Amendment . . . provide[s] a complete defense to Kirby's claims").

287. *Id.* at 58 (quoting *Comedy III*, 21 P.3d at 808).

288. *Id.* at 55-56.

Other jurisdictions draw on different heuristics, including the predominant-use test<sup>289</sup> and an *ad hoc* balancing of interests,<sup>290</sup> that tend to be less defendant-friendly.<sup>291</sup> To date, the Indiana courts have not provided clear guidance on which First Amendment test they will utilize,<sup>292</sup> but they certainly have not adopted California's transformative-use test. As a result, there is a world of difference in the risks facing a right of publicity plaintiff in California compared to Indiana. With respect to Potter, application of the transformative-use test could have jeopardized the entire suit—particularly when considered in conjunction with an anti-SLAPP motion that would have

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289. The predominant use test, first applied in *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (en banc), posits that

[i]f a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.

*Id.* at 374 (quoting Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003)).

290. See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 152–58 (3d Cir. 2013) (detailing the various tests used by courts to balance the right of publicity with the First Amendment and assessing the advantages and shortcomings of each approach).

291. A few courts have also drawn on the artistic relevance/*Rogers* test. Originating in the Second Circuit's trademark decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the *Rogers* test immunizes use of a celebrity image in any creative work from liability so long as the use is artistically relevant and does not "explicitly mislead[] as to the source or content of the work." *Id.* at 999. Although the artistic relevance test is the one standard that is arguably more defendant-friendly than the transformative-use test, courts have largely relegated its use to a limited number of suits involving both Lanham Act and right of publicity claims. See, e.g., *id.* at 1005 (applying the artistic relevance test to both Ginger Rogers's Lanham Act and right of publicity claims); *Parks v. LaFace Records*, 329 F.3d 437, 443, 451–52 (6th Cir. 2003) (applying the artistic relevance test to both the Lanham Act and right of publicity claims brought by Rosa Parks against OutKast for his unauthorized use of her name in the song *Rosa Parks*); see also *Hart*, 717 F.3d at 157 (criticizing use of the artistic relevance test for right of publicity claims since it was developed in the trademark context and more property fits Lanham Act claims).

292. See Jennifer Rothman, *Indiana*, ROTHMAN'S ROADMAP TO THE RIGHT OF PUBLICITY, <https://www.rightofpublicityroadmap.com/law/indiana> [https://perma.cc/6L39-ANEU] (noting that "[t]here is no case law discussing First Amendment protections in connection with the Indiana Rights of Publicity Statute").

required the plaintiff to make a prima facie showing of a probability of success on the merits right out of the gate.

So, even putting aside substantive differences in the elements and scope of publicity rights statutes in California versus Indiana, procedural differences (such as the availability of anti-SLAPP relief) and the development of common law defenses (such as transformative use) can dramatically impact the ability of a plaintiff, like Potter, to seek vindication of subject rights in litigation. In the end, a state where virtually no A-list celebrities reside (John Mellencamp excepted, of course) appears to offer substantially broader publicity rights protections than California and New York, the two states most closely associated with celebrity culture and where so many of those featured in front of the camera make their homes.<sup>293</sup> In part, this seemingly anomalous state of affairs might be explained by the other significant power players in California and New York: the world's largest media companies.<sup>294</sup> While celebrities typically embrace a vigorous right of publicity, the Hollywood studios, broadcasters, newspapers, and other media conglomerates are far less keen on the idea, as it can curtail the right to exploit their copyrighted content as they deem fit.<sup>295</sup> Meanwhile, the Hoosier State's embrace of publicity rights is no coincidence and emanates from one man in particular—James Dean.<sup>296</sup> Over the years, the public fascination with Hollywood icon James Dean has proven enduring, despite (or, perhaps, because of) his

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293. Compare IND. CODE § 32-36-1-1 (2021) with CAL. CIV. CODE § 3344 (West 2022).

294. Soumya Karlamangla, *California Is Doubling Efforts to Preserve Film and TV Production*, N.Y. TIMES (Jan. 13, 2022), <https://www.nytimes.com/2022/01/13/us/film-production-tax-credits.html> [<https://perma.cc/NBJ4-2PT4>] (explaining how the film industry is so important to California that Governor Gavin Newsome is distributing an additional \$330 million in tax credits towards media production in 2022 and 2023 on top of the \$330 million already budgeted yearly through 2025).

295. See, e.g., *Lawsuits over Paparazzi Images on Instagram Raise Celebrity Questions over Right of Publicity*, FASHION L. (Oct. 19, 2018), <https://www.thefashionlaw.com/lawsuits-over-instagram-images-raise-celebrity-questions-over-right-of-publicity> [<https://perma.cc/2B5P-9EJY>] (detailing supermodel Gigi Hadid's stated interest in improving celebrities' rights of publicity after "being 'legally pursued'" over her since-deleted posting on her personal Instagram of a paparazzo's photograph for which she had posed).

296. Eriq Gardner, *Indiana Moves to Grant Broad New Legal Rights to Dead Celebrities*, HOLLYWOOD REP. (Feb. 9, 2012, 12:09 AM), <https://www.hollywoodreporter.com/business/business-news/indiana-dead-celebrities-legal-rights-james-dean-law-288124> [<https://perma.cc/NQ7A-5YGA>].

untimely death in 1955 at just the age of twenty-four.<sup>297</sup> As a result, Dean's Estate remains one of the most profitable amongst the world of dead celebrities.<sup>298</sup> As it turns out, James Dean had close ties to the State of Indiana (where he was born) and, over time, his family members (many of whom still lived in Indiana) collaborated with Mark Roesler (the founder of CMG Worldwide, a key innovator in the publicity rights and celebrity estate management space) to successfully lobby the Indiana legislature to pass a statute that arguably provides the broadest and most extensive right of publicity protections in the United States.<sup>299</sup>

States and their courts possess broad leeway in defining the protections and limitations of publicity rights statutes. As a result, it is not far-fetched to wonder whether one or more states might entertain the possibility of granting subjects greater rights over the exploitation of their likenesses in works of art—particularly where such works have significant commercial motivations or applications. Thus, like the Potter Estate, future Jay-Zs could turn to jurisdictions which take a broader view of publicity rights. If subjects hope to strike back with publicity rights theories, strategic selection of the fora for adjudicating such disputes will likely play a key role in the process. But, many challenges—including preemption challenges and First Amendment limitations—will remain.

#### IV. THE SUBJECT AS DESIGNATION OF ORIGIN: TRADEMARK & THE VINDICATION OF SUBJECT RIGHTS

Even if the right of publicity is unavailable, trademark law offers subjects the potential to exert some control over the exploitation of their images. The machinations of the Marilyn Monroe Estate in recent

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297. *Id.* (describing how, after an unpopular court decision that held the opposite, Indiana implemented “James Dean Laws” which posthumously protected rights of celebrities).

298. Danielle & Andy Mayoras, *Celebrity Legacies: James Dean Estate Has a Cause*, DANIELLE & ANDY (Aug. 7, 2015), <https://danielleandandy.com/celebrity-legacies-james-dean-estate-has-a-cause> [<https://perma.cc/62TH-R5HG>] (reporting that Dean's Estate earned five million dollars in 2012).

299. *See, e.g.*, Nancy Hass, ‘*I Seek Dead People*’, N.Y. TIMES MAG. (Oct. 12, 2003), <https://www.nytimes.com/2003/10/12/magazine/i-seek-dead-people.html> [<https://perma.cc/9PQB-PJSC>] (profiling the work of Mark Roesler and CMG and noting, among other things, that “Indiana is especially celebrity-friendly—the right to publicity extends 100 years there, and because of a 1995 law that Roesler virtually wrote, celebrities and their heirs don't even have to live in the state to sue”).

years illustrate this point. In 2012, after almost a decade of litigation on the issue, the Monroe Estate effectively lost the ability to make a credible right of publicity claim<sup>300</sup> when the California Supreme Court applied principles of judicial estoppel to find that Monroe was a New York, not a California, resident when she died.<sup>301</sup> New York law therefore determined her publicity rights and, at the relevant time,<sup>302</sup> provided no post-mortem protection.<sup>303</sup> As such, the Estate could not draw upon Monroe's right of publicity to enjoin unauthorized uses of her likeness in advertising and photograph sales.<sup>304</sup>

This significant defeat did not end the Estate's efforts to wrest control over Monroe's image, however. In *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe, LLC*,<sup>305</sup> none other than a New York federal court noted its "annual tradition . . . [of] resolv[ing] the latest claims in the long-running battle among multiple parties asserting multiple claims to the intellectual property rights of Marilyn Monroe"<sup>306</sup> and found

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300. Potential plaintiffs such as the Monroe Estate still enjoy some wiggle room to claim continuing protection under the right of publicity since some states, such as Washington, Indiana, and Hawaii, have "all comers" right of publicity statutes that offer an estate protection within its jurisdiction, regardless of the decedent's domicile at the time of death. Christian B. Ronald, Note, *Burdens of the Dead: Postmortem Right of Publicity and the Dormant Commerce Clause*, 42 COLUM. J.L. & ARTS 123, 125 (2018). Courts and commentators have nevertheless questioned the constitutionality of such laws. *See, e.g.*, *Experience Hendrix, L.L.C. v. HendrixLicensing.com, Ltd.*, 766 F. Supp. 2d 1122, 1127, 1133 (W.D. Wash. 2011), *rev'd*, 762 F.3d 829, 833 (9th Cir. 2014) (holding that the Washington Personality Rights Act, which retroactively recognized a right of publicity for Jimi Hendrix even though he was domiciled in New York when he died, was unconstitutional under various constitutional clauses, including the Commerce Clause, the Due Process Clause, and the Full Faith and Credit Clause); Ronald, *supra*, at 125–26 (arguing that "[t]he current patchwork of state postmortem right of publicity statutes violates the dormant Commerce Clause").

301. *Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, 692 F.3d 983, 1000 (9th Cir. 2012).

302. On May 29, 2021, New York extended its right of publicity post-mortem. *See* N.Y. CIV. RTS. LAW §§ 50-f (McKinney 2022) (granting a cause of action to "deceased personalit[ies]" for commercial misappropriation of their "name[s], voice[s], signature[s], photograph[s], or likeness[es]" for a period of forty years after their death). This right, though, only extends to individuals who died after May 29, 2021, so it does not resurrect Monroe's lapsed right of publicity. *See id.*

303. *See* *Milton H. Greene Archives, Inc.*, 692 F.3d at 1000 (holding that Monroe LLC did not inherit the right to enforce Marilyn Monroe's posthumous right of publicity and could not enforce it against Milton Greene because she died a citizen of New York, where no such right existed).

304. *Id.* at 991.

305. 364 F. Supp. 3d 291 (S.D.N.Y. 2019).

306. *Id.* at 299.

that, while the Monroe Estate no longer enjoyed any right of publicity, it could seek relief through the operation of the Lanham Act and its prohibition of false endorsement.<sup>307</sup> By rejecting summary judgment motions against the Estate's false endorsement claim, the court allowed the Estate to go to trial against a number of defendants charged with licensing images of Monroe in connection with merchandise but, notably, not pure sales or licenses of the art itself.<sup>308</sup>

As the *A.V.E.L.A.* case suggests, in the quest to protect against the unauthorized commercial exploitation of a subject's image, the Lanham Act can serve as a potential alternative to the right of publicity. Indeed, even when—unlike in *A.V.E.L.A.*—a right of publicity claim is potentially viable, subjects will often still raise a Lanham Act or related state law cause of action (usually grounded in unfair competition) as a secondary, or even tertiary, claim.<sup>309</sup> Although courts in such cases have frequently ruled in tandem on these right of publicity and trademark/false endorsement claims, both jurists and scholars have given insufficient independent analysis to the particularities of the latter.<sup>310</sup> This is especially troubling because trademark/false endorsement claims serve distinct purposes,<sup>311</sup> require distinct elements,<sup>312</sup> and enjoy

307. As the court held, false endorsement constituted a distinct claim from the right of publicity and, as a result, the Estate's lack of any publicity rights did not preclude potential relief under the Lanham Act for false endorsement. *Id.* at 307–08.

308. *Id.* at 322–23.

309. See 15 U.S.C. § 1125; S. REP. NO. 79-1333 (1946), as reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (stating that “[t]here is no essential difference between trademark infringement and what is loosely called unfair competition”).

310. See, e.g., Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1164–65 (2006) (analyzing trademark law only alongside, and in the context of, right of publicity claims, and not on its own).

311. See *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 563 (5th Cir. 2001) (citing S. REP. NO. 79-1333 (1946)), *abrogated by* *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014) (noting that the purpose of the Lanham Act is to “secur[e] to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not”); *Conte Bros. Auto., Inc. v. Quaker State-Slick 50, Inc.*, 165 F.3d 221, 229 (3rd Cir. 1998) (“[T]he focus of [the Lanham Act] is on anti-competitive conduct in a commercial context.”), *abrogated by* *Lexmark Int'l*, 572 U.S. at 118; *Thompson Med. Co., v. Pfizer Inc.*, 753 F.2d 208, 215 n.13 (2d Cir. 1985) (“The central purpose of the trademark bill . . . was to ‘make possible a choice between competing articles by enabling the buyer to distinguish one from the other.’” (citing S. REP. NO. 79-1333, at 4 (1946))).

312. See, e.g., 15 U.S.C. § 1125(a)(1)(A) (interdicting, inter alia, false designations of origin likely to cause consumer confusion in connection with any goods or services in interstate commerce).

distinct defenses.<sup>313</sup> From the perspective of substantive elements, doctrinal consistency, and public policy, resorting to the Lanham Act to support subject rights is fraught with peril. Inconsistencies as to what constitutes a protectable “subject” mark and whether a likelihood of confusion occurs from the use of said mark have plagued the case law, resulting in a series of decisions that take seemingly paradoxical and troubling positions.<sup>314</sup> Meanwhile, use of the Lanham Act to protect subject rights threatens to interfere with the functioning of the marketplace for creative works and burdens the copyright regime as a whole, thereby destabilizing commercial expectations in the licensing arena. And perhaps most alarmingly of all, the recognition of subject rights through the Lanham Act and related state law has potentially adverse consequences for the public domain and expressive freedoms.

#### A. *Protectability & Confusion*

To begin with, Lanham Act claims face significant hurdles that do not exist in publicity rights actions. In the latter, a plaintiff typically prevails by simply showing any unauthorized commercial misappropriation of a celebrity’s name, voice, or likeness.<sup>315</sup> By sharp contrast, in the former, besides showing misappropriation of the likeness, a plaintiff must show that: (1) the likeness amounts to a protectible trademark;<sup>316</sup> and (2) the misappropriation of said mark created a likelihood of consumer confusion as to sponsorship,

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313. See, e.g., Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1 (2013) (discussing the competing approaches of courts to First Amendment defenses for, inter alia, right of publicity and trademark cases).

314. See *infra* Section IV.A.1.

315. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 445–46 (6th Cir. 2003) (describing how, to prevail on a Lanham Act false advertising claim, a celebrity “must show that the use of [their] name is likely to cause confusion among consumers as to the ‘affiliation, connection, or association’ between the celebrity and the defendant’s goods or services or as to the celebrity’s participation in the ‘origin, sponsorship, or approval’ of the defendant’s goods or services”).

316. *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1215 (10th Cir. 2004); *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 638 (7th Cir. 2001).

affiliation, or endorsement<sup>317</sup> under a multi-part balancing test.<sup>318</sup> Perhaps because of the imperfect fit between the Lanham Act and subject rights, the relevant jurisprudence on issues of trademarkability and likelihood of confusion has suffered from incongruity and unpredictability.

1. *The Challenge of Establishing Trademark Usage & Rights*

In evaluating whether a subject owns the needed protectable, source-identifying mark, to prevail in a claim of false endorsement,<sup>319</sup> courts have had to wrestle with the issue of what qualifies as a protectable mark.<sup>320</sup> Many courts have viewed claims of trademark-like protection in a celebrity's image or likeness with skepticism, going so far as to question whether one's likeness can *ever* serve a legitimate trademark function of indicating source or origin of a product or even endorsement thereof. For example, in *ETW Corporation v. Jireh Publishing, Inc.*,<sup>321</sup> when the Sixth Circuit rejected Tiger Woods's

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317. Claims for false endorsement can be grounded in either 15 U.S.C. § 1125(a)(1)(A), which generally provides a claim against false designations that are likely to cause consumer confusion as to the source or origin of goods or services, including as to their sponsorship, affiliation, connection, association or approval, and section 1125(a)(1)(B), which generally forbids false advertising. Typically, courts have analyzed them as the former, thereby requiring a likelihood of consumer confusion. *See* *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997); *Donchez*, 392 F.3d at 1215; *Packman*, 267 F.3d at 638.

318. The precise test for finding a likelihood of confusion varies by circuit, but the multi-factor balancing tests used are largely similar. In the Second Circuit, for example, courts apply the eight *Polaroid* factors, which look to:

- (1) the strength of plaintiff's mark; (2) the similarity of the parties' marks;
- (3) the proximity of the parties' products in the marketplace; (4) the likelihood that the plaintiff will "bridge the gap" between the products; (5) actual consumer confusion between the two marks; (6) the defendant's intent in adopting its mark; (7) the quality of the defendant's product; and
- (8) the sophistication of the relevant consumer group.

*Playtex Prods., Inc. v. Georgia-Pac. Corp.* 390 F.3d 158, 162 (2d Cir. 2004) (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)).

319. *See, e.g.,* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106 (9th Cir. 1992) ("[C]ourts have recognized false endorsement claims brought by plaintiffs, including celebrities, for the unauthorized imitation of their distinctive attributes, where those attributes amount to an unregistered commercial 'trademark.'" (citation omitted)).

320. *See, e.g.,* *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61–63 (2d Cir. 2001) (deciding whether an artist had trademark rights in a recording of her own signature performance).

321. 332 F.3d 915 (6th Cir. 2003).

attempt to argue that Rush's art violated his trademark rights, it held that "[n]o reasonable person could believe that merely because . . . photographs or paintings contain [a celebrity's] likeness or image, they all originated with [that celebrity]," and that, therefore, "as a general rule, a person's image or likeness cannot function as a trademark."<sup>322</sup> The Second Circuit has also questioned the ability of the subject matter of an art work to serve in a trademark capacity, reasoning that "a photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently 'distinctive' in the trademark sense of tending to indicate origin."<sup>323</sup>

Besides questioning the ability of a subject's likeness to receive trademark protection, courts have held that subjects' "signature performances" are not protectable.<sup>324</sup> Accordingly, in *Oliveria v. Frito-Lay, Inc.*,<sup>325</sup> the court held that Astrud Gilberto could not seek Lanham Act relief for the unauthorized use of her signature performance of *The Girl from Ipanema* in an advertisement for Baked Lay's potato chips.<sup>326</sup> Significantly, the Second Circuit noted that "[Gilberto] has not cited a single precedent throughout the history of trademark supporting the notion that a performing artist acquires a trademark or service mark signifying herself in a recording of her own famous performance."<sup>327</sup> Similarly, Don Henley could not seek

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322. *Id.* at 922.

323. *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990). As such, the Second Circuit concluded that "an ordinarily prudent purchaser would have no difficulty discerning that these photos are merely the subject matter of the [work] and do not in any way indicate sponsorship. No reasonable jury could find likelihood of confusion." *Id.* at 585.

324. *Oliveira*, 251 F.3d at 62.

325. 251 F.3d 56 (2d Cir. 2001).

326. *Id.* at 57–58. The court did caution that "[w]e cannot say it would be unthinkable for the trademark law to accord to a performing artist a trademark or service mark in her signature performance[.]" but suggested that this was a matter best left to Congress, if it so chose to amend the Lanham Act, not for the courts. *Id.* at 62–63.

327. *Id.* at 62. It should be noted that the Second Circuit did vacate the dismissal of Gilberto's state law claim for unfair competition. *Id.* at 64. However, it did so because the district court had incorrectly read the Complaint to admit that Gilberto had placed her recording of the song in the public domain. *Id.* at 63–64. The Second Circuit also vacated the dismissal of Gilberto's state law claim for a right of publicity violation on the same basis. *Id.* As such, there was no independent analysis given to the state law unfair competition claim as compared to the right of publicity claim (or the Lanham Act claim).

Lanham Act relief for the unauthorized use of the music and lyrics from his songs by a political candidate.<sup>328</sup>

On the other hand, courts have shown far greater receptiveness to recognizing trademark rights in other aspects of subject personae. While courts have not protected signature performances (no matter how distinctive or famous), they have recognized rights to certain non-vocal stylings, such as a blonde donning a gown and jewels while turning large game-show letters<sup>329</sup> or burly middle-aged gentlemen drinking beer at the end of bar.<sup>330</sup> Thus, in defining Vanna White's mark as her letter flipper "persona,"<sup>331</sup> the Ninth Circuit famously allowed the game show hostess to proceed to trial on a trademark claim,<sup>332</sup> which she brought against Samsung for a satirical advertisement featuring a futuristic world where a blonde-wigged robot turned illuminated alphabetic cubes in her stead.<sup>333</sup> And in defining the relevant mark as composed of their "unique physical characteristics" (while seated at the end of a bar, presumably),<sup>334</sup> the Ninth Circuit allowed actors George Wendt and John Ratzenberger to move forward to a jury with a false endorsement claim for the use of animatronic robotic figures based on their Norm and Cliff characters in a series of bars modeled after the set from the television show *Cheers*.<sup>335</sup> Interestingly, the majority opinions failed to explain what was so distinctive about a blonde woman turning letters or a burly middle-aged man sitting at the end of a bar drinking a beer and declined to contemplate the consequences on expressive freedoms and the public domain from privatizing such tropes.<sup>336</sup>

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328. *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1147, 1169 (C.D. Cal. 2010).

329. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399, 1401 (9th Cir. 1992).

330. *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1285–86 (9th Cir. 1999) (per curiam) (Kozinski, J., dissenting).

331. *White*, 971 F.2d at 1400.

332. *Id.* at 1401. She also brought, and was allowed to proceed on, a common law right of publicity claim. *Id.* at 1399.

333. *Id.* at 1396, 1399, 1401.

334. *See Wendt*, 125 F.3d at 812 (discussing appellants' claim that "by using an imitation of their unique physical characteristics, Host misrepresented their association with and endorsement of the Cheers bars concept").

335. *Id.* at 809, 814. They also sued for violation of their statutory and common law rights of publicity. *Id.* at 809. The Ninth Circuit reversed the district court's grant of summary judgment to the defendants on the false endorsement claim. *Id.* at 809, 814.

336. In addition, neither holding fully addressed why, even if there were valid marks in the cases, those marks should belong to Vanna White, George Wendt, and John Ratzenberger and not the rightsholders of their respective television programs.

Meanwhile, voices, but not signature performances, have sometimes received protection so long as they are sufficiently famous and distinctive.<sup>337</sup> As a result, Tom Waits could recover damages under the Lanham Act when Doritos used a sound-alike (a singer with a similarly gruff and raspy masculine voice) in one of its advertisements,<sup>338</sup> and Bette Midler could recover (albeit under California tort law) for similar conduct by Ford Motors.<sup>339</sup> Such decisions are particularly unusual since voices are largely functional, and granting a limited trademark monopoly in them potentially threatens a range of expressive behavior. The use of an especially gravelly singing voice in a commercial, for example, becomes all the more dangerous in the wake of the *Waits v. Frito Lay, Inc.*<sup>340</sup> ruling,<sup>341</sup> which Jennifer Rothman, a leading scholar of celebrity persona rights, has criticized for effectively giving Waits “ownership of a masculine[,] raspy singing style.”<sup>342</sup> Moreover, it is strange to consider that, while Astrud Gilberto could not bring a Lanham Act claim for the *actual* use of her voice,<sup>343</sup> Bette Midler and Tom Waits could bring similar claims for *imitations*.<sup>344</sup> Yet, even on the imitation front, the case law is inconsistent. In *Sinatra v. Goodyear Tire & Rubber Co.*,<sup>345</sup> the Ninth Circuit held that Nancy

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337. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098–1100 (9th Cir. 1992) (explaining how the *Midler* decision “held that ‘when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California’” (quoting *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988)); *Midler*, 849 F.2d at 463–64 (determining that plaintiff had defeated summary judgment by making a showing sufficient that the defendants appropriated her identity to sell products for profit). *Waits* and *Midler* set up the requirement that such protection only extends to voices that are sufficiently “distinctive” and “widely known.” See *Waits*, 978 F.2d at 1100–02 (upholding jury instructions on this point).

338. *Waits*, 978 F.2d at 1096, 1112 (noting both that the jury could award damages under the Lanham Act and that they were “duplicative of damages awarded for voice misappropriation”).

339. *Midler*, 849 F.2d at 463–64.

340. 978 F.2d 1093 (9th Cir. 1992).

341. *Id.* at 1096.

342. Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 221 (2002).

343. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62–63 (2d Cir. 2001).

344. Zachary Vaughan discussed this paradox with respect to right of publicity decisions seeking to vindicate performers’ rights. See Zachary M. Vaughan, *The Paradox that Wasn’t: Federal Preemption of State-law Voice Misappropriation Claims*, 11 J. MARSHALL REV. INTELL. PROP. L. 694, 695, 710–15 (2012) (arguing that “this apparent paradox is actually no conflict at all”).

345. 435 F.2d 711 (9th Cir. 1970).

Sinatra could not seek relief for the unauthorized imitation of her performance and vocal styling in *These Boots Are Made for Walkin'* used in a Goodyear advertisement.<sup>346</sup> The same court, however, had no problem granting such relief to Bette Midler and Tom Waits,<sup>347</sup> all while failing to overrule or fully distinguish the *Sinatra* decision.<sup>348</sup> The decisions on subject/performance trademark protection are muddled, to the say the least. While some courts have generally rejected the potential to trademark a celebrity likeness or “signature vocal performances,” they have sometimes recognized extending such protections to non-vocal actions and voices.

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346. See *id.* at 712–13 (affirming summary judgment against Nancy Sinatra on her state law “passing-off” claim where defendants used an imitation of her song).

347. *Midler v. Ford Motor Co.*, 849 F.2d 460, 463–64 (9th Cir. 1988); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096, 1112 (9th Cir. 1992). Of course, *Waits* granted such relief on Lanham Act grounds as well as California common law, 978 F.2d at 1098, 1100, 1112, while *Midler* granted relief on the former but never considered the latter since the plaintiff was denied the opportunity to amend her complaint to include a Lanham Act claim. See *id.* at 1110 n.10 (describing the procedural history of *Midler*).

348. The *Waits* court does discuss the *Sinatra* case briefly in the context of a string cite and claims in the parenthetical that the *Sinatra* court found that “[Sinatra’s] voice was not sufficiently unique to be protectable.” *Waits*, 978 F.2d at 1106–07. Yet, it does not appear that the *Sinatra* court made any such finding. In fact, the *Sinatra* decision notes that: “In this case[,] appellant’s complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics[,] and arrangement, which made her the subject of popular identification, ought to be protected.” 435 F.2d at 716. Furthermore, it is worth noting that, at the time of their respective lawsuits, Nancy Sinatra and her works were every bit as famous as (perhaps more than) Tom Waits and his works. See *About, NANCY SINATRA*, <http://nancysinatra.com/about.html> [<https://perma.cc/CVT7-US3Z>] (describing how Sinatra’s most famous song, *These Boots are Made for Walkin'*, “earned three Grammy® nominations and sold over a million copies”). Furthermore, the *Waits* court never clarified just what is needed to make vocal styling sufficiently distinctive to be given protection and why Sinatra’s performance did not rise to that level of sufficient distinctiveness. *Waits*, 978 F.2d at 1099–1100. The *Midler* court, by contrast, distinguishes *Sinatra* on the grounds that Sinatra sought to protect the particular song and arrangement—creatures of copyright protection—whereas Midler sought to protect just her voice—something outside of the scope of authorship and beyond the subject matter of copyright. *Midler*, 849 F.2d at 462. However, this does not explain why the *Sinatra* court did not recognize Sinatra’s voice, by itself, as sufficiently distinctive and widely known to qualify for protection. It is also worth noting that, in the *Sinatra* case, the court explicitly wrestled with the issue of whether recognition of a false endorsement claim would effectively impinge on the functioning of the federal copyright regime. *Sinatra*, 435 F.2d at 717–18. It concluded that it would. *Id.* Neither the *Waits* nor *Midler* decisions gave any weight to such an argument.

## 2. *Reconciling the Extant Jurisprudence on Likelihood of Confusion*

The courts' analyses in likelihood-of-confusion determinations—a standard that applies to Lanham Act and related state law claims of unfair competition<sup>349</sup>—have been similarly difficult to decipher. Courts have allowed the likes of Vanna White, George Wendt, and Tom Waits to prevail on false endorsement claims for the unauthorized use of their personae or vocal stylings but have rejected the viability of such relief in other cases.<sup>350</sup> Courts have reasoned that, even if a plaintiff's performance establishes a protectable mark, they must deny relief because there is no reasonable basis to conclude a likelihood of consumer confusion.<sup>351</sup> Again, a principled basis to distinguish differing case outcomes is not readily forthcoming. For example, in *Storball v. Twentieth Century Fox Film Corp.*,<sup>352</sup> Fox used The Capitols' ditty, *Cool Jerk*, in two movies—*Home Alone 2* and *Night and the City*—and their related advertising.<sup>353</sup> Fox presumably obtained the appropriate copyright licenses for the uses, so the plaintiffs were left only with a suit for false endorsement, claiming that Fox's use created a “misrepresentation of The Capitol[s'] affiliation with and endorsement of defendant's goods.”<sup>354</sup> The court summarily rejected the claim, stating in broad terms that the “[m]ere use of a sound recording in a motion picture or audio/visual presentation, with truthful attribution of the performance to the performers in the credits, does not constitute a representation that the performers in the

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349. See, e.g., *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166, 173 (D.D.C. 1992), *aff'd*, 15 F.3d 1159, 1994 WL 26339, at \*1 (D.C. Cir. 1994) (per curiam) (“Under . . . the Lanham Act and the common law of unfair competition, the ‘ultimate test’ is whether consumers are likely to be confused as to origin or endorsement.” (quoting *New West Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1201 (9th Cir. 1979))).

350. *Storball v. Twentieth Century Fox Film Corp.*, No. CV 93-2745 RMT (Tx), 1993 WL 734117 (C.D. Cal. Nov. 8, 1993), *aff'd*, 57 F.3d 1078, 1995 WL 358617, at \*1 (9th Cir. 1995).

351. See, e.g., *Brown*, 799 F. Supp. at 173 (applying the reasonable jury standard in granting defendant's motion for summary judgment); *Storball*, 1993 WL 734117, at \*1 (“[N]o reasonable jury could find such use of the sound recording to be sufficient to support the finding of confusion or likelihood of confusion. As a result, defendant Fox is entitled to summary judgment on the Lanham Act claims.”).

352. No. CV 93-2745 RMT (Tx), 1993 WL 734117, at \*1 (C.D. Cal. Nov. 8, 1993), *aff'd*, 57 F.3d 1078, 1995 WL 358617, at \*1 (9th Cir. 1995).

353. *Id.* at \*1.

354. *Id.* at \*2 n.3.

sound recording approve, sponsor[,] or endorse the motion picture.”<sup>355</sup>

In *Brown v. Twentieth Century Fox Film Corp.*,<sup>356</sup> musician James Brown also lost a similar suit against Twentieth Century Fox when the movie *The Commitments* featured his famous performance of the song *Please, Please, Please* from *T.A.M.I. Show* in 1965.<sup>357</sup> In a key scene in the motion picture, Jimmy, the leader of the eponymous band, tries to inspire his mates towards more dynamic musicianship by showing them the clip of Brown.<sup>358</sup> The defendants obtained licenses from the copyright holders of *T.A.M.I. Show*<sup>359</sup> and the copyright holders of the music composition and lyrics featured in the footage.<sup>360</sup> Nevertheless, Brown argued that the filmmakers also needed his permission for the use of the footage, especially for its exploitation in the marketing of the film, and he sued for false endorsement under the Lanham Act.<sup>361</sup> The court dispensed with the Lanham Act claim on summary judgment with a single line: “[T]here is no evidence whatsoever that any viewers of ‘The Commitments’ believed that plaintiff had endorsed the film or personally approved the use of the clip, nor could any reasonable jury reach that conclusion from watching the film.”<sup>362</sup> Thus, it would seem, demonstrating a likelihood of consumer confusion can be particularly difficult when a defendant is simply using a celebrity’s likeness, rather than a traditional trademark, and when the exploited image or performance is not in association with another product (other than a work of art itself).

Yet, courts in the *Wendt v. Host International, Inc.*,<sup>363</sup> *White v. Samsung Electrics American, Inc.*,<sup>364</sup> and *Waits v. Frito-Lay, Inc.*, cases had no problem finding that a likelihood of confusion could have resulted

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355. *Id.* at \*2 n.7; *see also, e.g.*, *Phila. Orchestra Ass’n v. Walt Disney Co.*, 821 F. Supp. 341, 350–51 (E.D. Pa. 1993) (finding that plaintiff failed to establish “that Disney represented that [plaintiff] endorsed the home video” and “failed to prove that Disney violated the Lanham Act by releasing home videos which correctly credited the [plaintiff] for the performance”).

356. 799 F. Supp. 166, 173 (D.D.C. 1992), *aff’d*, 15 F.3d 1159, 1994 WL 26339, at \*1 (D.C. Cir. 1994) (per curiam).

357. *Id.* at 168, 173.

358. *Id.* at 168.

359. *Id.* at 169.

360. *Id.*

361. *Id.* at 173.

362. *Id.*

363. 125 F.3d 806 (9th Cir. 1997).

364. 971 F.2d 1395 (9th Cir. 1992).

from satirical (in the case of *White*)<sup>365</sup> or imitative (in the cases of *Wendt* and *Waits*)<sup>366</sup> uses of performance personae. If anything, the logic might go the other way. Presumably, an ordinary person is far less likely to view a commercial's satirical use of a blonde, letter-turning robot as having *White's* sponsorship, approval, or endorsement than actual footage of *White* in the same advertisement. As for imitations, at least they are just that; the better the imitation, one would think, the closer it comes to being as bad as a use of the original without permission. But it is difficult to imagine how use of an imitation without permission is actually *worse* than use of the original itself, especially from the likelihood-of-confusion perspective. One could attempt to reconcile these various holdings by arguing the imitation cases involved the use of physical characteristics (*Wendt*) or vocal stylings (*Waits*) that, because of their un-authored or unfixed natures, respectively, fall outside of the subject matter of copyright.<sup>367</sup> By contrast, the actual voices or performances used in the *Brown* and *Storball* cases were fixed in a tangible medium and therefore already within the scope of copyright.<sup>368</sup> But such a consideration makes more sense for an analysis of a state-based right (like the right of publicity), which is subject to

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365. See *id.* at 1401 (“Looking at the series of advertisements as a whole, a jury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers that celebrity Vanna White . . . was endorsing Samsung products.”).

366. See *Wendt*, 125 F.3d at 813–14 (concluding that “[a] reasonable jury could conclude that . . . Host’s alleged conduct creates at least the likelihood of consumer confusion,” and that “[s]ufficient evidence exists by which a reasonable jury might infer actual consumer confusion”); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (holding that the unauthorized use of well-known singer’s voice to promote a product constitutes misappropriation under California law, as “[a] singer manifests herself in the song [and to] impersonate her voice is to pirate her identity”); *Waits*, 978 F.2d at 1111 (stating that at trial the jury listened to recordings, heard evidence relevant to the likelihood of confusion and evidence of actual consumer confusion and that “[t]his evidence was sufficient to support the jury’s finding that consumers were likely to be misled by the commercial into believing that Waits endorsed SalsaRio Doritos”).

367. See 17 U.S.C. § 102(a) (limiting copyright protection to “original works of authorship fixed in any tangible medium of expression”).

368. *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166, 173 (D.D.C. 1992), *aff’d*, 15 F.3d 1159, 1994 WL 26339, at \*1 (D.C. Cir. 1994) (per curiam); *Storball v. Twentieth Century Fox Film Corp.*, No. CV 93-2745 RMT (Tx), 1993 WL 734117, at \*8 (C.D. Cal. Nov. 8, 1993), *aff’d*, 57 F.3d 1078, 1995 WL 358617, at \*1 (9th Cir. 1995).

express federal preemption defenses.<sup>369</sup> And while recognition of such performer rights raises legitimate concerns about interfering with the flow of commerce and the licensing of copyrighted works, the same concerns are present when dealing with unauthorized imitations of a “mark” as opposed to unauthorized uses of the actual “mark.”

At the end of the day, the differing outcomes in these cases may be, at least partly, guided by whether unauthorized use of the subject persona was in a work of art (*e.g.*, *Brown*, *ETW*, and *Storball*, where the courts found no Lanham Act violations) or in a piece of advertising or merchandise (*e.g.*, *White*, *Wendt*, and *Waits*, where the courts found potential Lanham Act violations). Still, the art (non-commercial) versus advertising/merchandising (commercial) distinction does not explain all of the holdings, including the judgments in *Oliveira* and *Sinatra*. Furthermore, as we have documented, although this binary makes all the difference in right of publicity claims, such considerations are nowhere to be found in the specific elements of courts’ Lanham Act analysis, particularly as to whether the plaintiffs possessed a protectible mark or could show a likelihood of confusion. As such, even if the rulings in these trademark cases ultimately comported with existing right of publicity norms, they made a mess of Lanham Act jurisprudence in the process.

*B. Lanham Act Claims & Subject Rights: Square Peg Meets Round Hole*

When viewed from a public policy perspective, the hurdles that courts have (sometimes and inconsistently) applied to subject rights cases actually make a great deal of sense, as they help to ensure that efforts to vindicate subject rights do not contort the Lanham Act away from its fundamental purpose: protection against consumer confusion. As the text of the Act makes clear, the Lanham Act’s goal is to “mak[e] actionable the deceptive and misleading use of marks in . . . commerce” and “to protect persons engaged in such commerce against unfair competition.”<sup>370</sup> To this end, § 43(a) of the Lanham Act provides a federal remedy against anyone engaged in “[a] false designation of origin” or any “false or misleading description . . . or false or misleading representation of fact” in connection with “any goods or services” in a manner likely to cause consumer confusion.<sup>371</sup>

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369. See 17 U.S.C. § 301; *see also* *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134, 1137 (N.D. Ill. 1997); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649–50 (Ct. App. 1996).

370. 15 U.S.C. § 1127.

371. *Id.* § 1125(a).

Although courts have interpreted the Act broadly,<sup>372</sup> the Supreme Court has cautioned that it not be read as a general law of unfair competition with boundless application.<sup>373</sup> In attempting to raise a viable § 43(a) action to vindicate their subject and performance-related rights, plaintiffs typically claim that their case is about false endorsement and that consumers would mistakenly think that the advertised product originates from, is associated with, or is endorsed by the plaintiff.<sup>374</sup> In reality, however, many of these suits represent (understandable, but nevertheless problematic) attempts to fit a proverbial square peg into a round hole. The injury in these subjects-rights suits is not the confusion of consumers; rather, it is an associational and semiotic harm. As a result, the propriety and viability of using the Lanham Act and related state unfair competition laws as a vehicle for relief in such cases remain in doubt.

In addition, recognition of Lanham Act relief for cases involving subject rights raises significant questions about the degree to which such victories might undermine exclusive rights secured for copyright holders. Courts have therefore bristled at recognizing such protection for “performance rights” under the Lanham Act because such an overture would necessarily interfere with the functioning of the market for copyrighted works and burden—if not actively undermine—the federal copyright regime as a whole.<sup>375</sup> As the Second Circuit noted in the *Oliveira* case involving *The Girl from Ipanema*, if courts acknowledged such a right,

[n]umerous artists who could assert claims similar to Gilberto’s would bring suit against entities that had paid bona fide license fees to all known holders of rights. Indeed, artists who had licensed users under their copyrights and had received fees for the copyright license could bring suits claiming additional compensation for

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372. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776–85 (1992) (Stevens, J., concurring) (tracking lower courts’ increasingly expansive interpretation of the scope of § 43(a) of the Lanham Act and Congress’s codification of that consensus).

373. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29 (2003) (Scalia, J., dissenting) (stating that § 43(a) “appl[ies] only to certain unfair trade practices prohibited by its text”).

374. See 15 U.S.C. § 1125(a).

375. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 63 (2d Cir. 2001) (“[F]or a court now to ‘recognize’ the previously unknown existence of such a right would be profoundly disruptive to commerce.”).

infringement of trademark rights. Immense unforeseen liabilities might accrue, upsetting reasonable commercial expectations.<sup>376</sup>

The court in *Henley v. DeVore*<sup>377</sup> also adopted the same logic, claiming that a contrary ruling, which necessarily would create a new species of trademark rights, “would be profoundly disruptive to commerce.”<sup>378</sup> And the *Sinatra* court discredited the plaintiff’s unfair competition claim because, among other things, “the defendants had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements.”<sup>379</sup>

In contrast to the *Oliveira*, *Henley*, *Sinatra*, and *Brown* suits, however, many courts have had no problem granting Lanham Act relief to subjects. For example, concerns about undermining the copyright regime and licensing markets did not alarm the courts in the disputes involving Bette Midler and George Wendt.<sup>380</sup> In the former case, Ford and its advertising agency, Young & Rubicam, secured the rights for Bette Midler’s *Do You Want to Dance?* from the musical composition’s copyright holder for use in their “Yuppie Campaign” for the Lincoln Mercury.<sup>381</sup> And in the latter case, Host International had secured the rights to use *Cheers*’s intellectual property for its airport restaurants.<sup>382</sup>

All told, attempts to protect subject rights through trademark law face several key obstacles, including the difficulty in showing that the subject alone can serve a trademark function and that the use of a subject creates a likelihood of consumer confusion. Moreover, such claims also raise significant issues involving potential interference with the functioning of the copyright regime and with commerce and licensing markets. In the end, the Lanham Act can sometimes (albeit haphazardly) provide relief to subjects in sympathetic factual scenarios, but it often does so in a way that raises more problems than it solves.

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376. *Id.*

377. 733 F. Supp. 2d 1144 (C.D. Cal. 2010).

378. *Id.* at 1168 (C.D. Cal. 2010) (citing *Oliveira*, 251 F.3d at 63).

379. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717 (9th Cir. 1970).

380. *Midler v. Ford Motor Co.*, 849 F.2d 460, 462–63 (9th Cir. 1988); *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997).

381. *Midler*, 849 F.2d at 461–62 (“Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler’s voice.”).

382. *See Wendt*, 125 F.3d at 811 (noting an argument by Host International and the owner of the *Cheers* copyright, Paramount Pictures, that the figures in question “appropriate only the identities of the characters” owned by Paramount and not the actors themselves, who have no ownership rights to the characters).

## V. LEVERAGING SUBJECT RIGHTS THROUGH CONTRACT

Finally, in a brief (but related) digression from the world of intellectual property, it is worth noting that protections for subjects are—at least in theory—available through contracting. Indeed, some such notable protections, from the economic (the residual payment regime that the collective bargaining agreement (“CBA”) of SAG-AFTRA with the major studios has secured for member-actors<sup>383</sup>) to the dignitary (the strict provisions regarding nudity and simulated sex under the SAG-AFTRA CBA<sup>384</sup>), exist. However, such successes are few and far between and, in most cases, the vast gulf in bargaining power between subjects and fixer-producers means contracting for enhanced subject rights is not an option.<sup>385</sup>

That said, some subjects—particularly those who have developed significant bargaining power—have resorted to contract law to undo the default operation of copyright law and to obtain rights to control the use of their likeness in images without having to resort to the difficulty of making right of publicity or Lanham Act claims. But the cautionary tale of singer Taylor Swift’s efforts with photographers is a blunt reminder that even those artists with significant bargaining power sometimes cannot achieve the protections they desire via contract.<sup>386</sup> For a time, Swift—a vociferous advocate for artists’ rights (at least when her artistic rights are involved)—required all photographers attending her concerts to execute agreements

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383. See, e.g., Producer – SAG-AFTRA Codified Basic Agreement of 2014, § 5 (June 4, 2017), [https://www.sagaftra.org/files/2014\\_sag-aftra\\_cba\\_1.pdf](https://www.sagaftra.org/files/2014_sag-aftra_cba_1.pdf) [<https://perma.cc/T383-V4WT>] (requiring producers to pay actors a certain percentage of the gross receipts for a movie released for television broadcasting).

384. See 2020 Memorandum of Agreement Between the Screen Actors Guild-American Federation of Television and Radio Artists and the Alliance of Motion Picture and Television Producers, at ¶ 18 (July 22, 2020), <https://www.sagaftra.org/files/2020%20SAG-AFTRA%20MOA%207-22-20%20%2800223283xBE9D7%29-signed.pdf> [<https://perma.cc/E5DZ-TW8F>] (specifying requirements for producers and rights for performers, such as prior notification and the prohibition of sex acts during auditions).

385. See, e.g., Noam Cohen, *Use My Photo? Not Without Permission*, N.Y. TIMES (Oct. 1, 2007), <https://www.nytimes.com/2007/10/01/technology/01link.html> [<https://perma.cc/CTN2-XBSA>] (describing the struggles of a fifteen-year-old girl in her suit against Virgin Mobile over its use of a photograph of her that the photographer posted on Flickr).

386. See, e.g., Michael Zhang, *Taylor Swift Photo Contract: Break Our Rules, and We Can Break Your Gear*, PETAPIXEL (June 23, 2015), <https://petapixel.com/2015/06/23/taylor-swift-photo-contract-break-our-rules-and-we-can-break-your-gear> [<https://perma.cc/7K65-YEEE>] (detailing contracts that Taylor Swift required photographers to sign in order to have permission to take snapshots at her events).

permanently limiting their ability to use the photographs they might take during the show and granting Swift a perpetual, royalty-free license to use the images for publicity and promotional purposes.<sup>387</sup> At first, the photographers generally acceded to the terms, recognizing that they were individually powerless to fight the conditioning of access on wholesale waiver of many of the rights they would normally enjoy under copyright law. But they ultimately collaborated together to use the engine of public shaming—a favorite tactic of Swift’s in her disputes with Apple over digital streaming rights and with her prior record label in her high profile struggle over the rights to her master recordings—to force Swift to reverse the policy.<sup>388</sup> Since she had made the rights of artists a signature cause in her public identity, Swift was particularly vulnerable to charges of hypocrisy on the issue.<sup>389</sup> After all, her agreements dictated that photographers give up significant rights to images they had taken of her when she had decried the very same asymmetrical power dynamic for harming creators and forcing artists like her to lose the rights to their sound recordings to record labels.<sup>390</sup>

Since the use of contracts to overturn default rules in intellectual property demands leverage, if Swift could not ultimately succeed in turning the tables on traditional copyright holders by vesting rights in the subject, those with far less bargaining power (i.e., virtually all others) face even more perilous odds. In addition, contracting

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387. *Id.* One iteration of the contracts even granted Swift’s team the unilateral authority “confiscate and/or destroy” any technology or equipment of any photographers who violated any terms of the agreement. *Id.*

388. In response to Swift’s open letter to Apple decrying its music streaming service’s inequitable exploitation of recording artists, photographer Jason Sheldon penned a mordant missive that highlighted Swift’s hypocrisy in limiting the rights of photographers wishing to shoot at her shows. Jason Sheldon, *An Open Response to Taylor Swift’s Rant Against Apple*, PETAPIXEL (June 22, 2015), <https://petapixel.com/2015/06/22/an-open-response-to-taylor-swifts-rant-against-apple> [<https://perma.cc/APB3-MGFT>]. After Sheldon’s polemic went viral, Swift quickly backed down and altered the terms of her agreement. See Michael Zhang, *Taylor Swift’s Concert Photo Contract Changed to Be More Photographer-Friendly*, PETAPIXEL (July 22, 2015), <https://petapixel.com/2015/07/22/taylor-swifts-concert-photo-contract-changed-to-be-more-photographer-friendly> [<https://perma.cc/TC72-2KCG>] (reporting that the new contract allows photographers to publish photos more than once and permits Swift to request that photos be deleted, rather than allowing for confiscation or destruction of photographers’ equipment, if photographers violate the terms of the agreement).

389. Brianna Tracy, *Taylor Swift Knows She’s ‘Loud’ About Artists’ Rights: ‘It’s Because Someone Has to Be*, PEOPLE (Dec. 11, 2019, 6:05 PM), <https://people.com/music/taylor-swift-loud-artists-rights> [<https://perma.cc/T8RY-KSK3>].

390. Zhang, *supra* note 386.

requires privity, which is often lacking in the unauthorized use of someone's image. So, while contracting may make sense in the context of a stadium show where photographers are granted privileged access to a musician in return for agreeing to certain terms and conditions (which might include an intellectual property assignment or license), it is not practicable in other scenarios, such as paparazzi photography.

CONCLUSION: WHITHER THE SUBJECT? GOLDSMITH, WARHOL, & PRINCE

Shortly after Prince's death in 2016, photographer Lynn Goldsmith's attorneys fired off a cease-and-desist letter to the Estate of Andy Warhol. In the correspondence, Goldsmith claimed that Warhol's famous 1984 silkscreen prints and pencil illustrations of the singer constituted an infringing, derivative version of her 1981 photograph of Prince, upon which they were indisputably based.<sup>391</sup> After discussions failed to resolve the issue, the Estate turned the tables on Goldsmith, suing her for declaratory relief of non-infringement, claiming that Warhol's transformative portraits were protected under the fair use doctrine and that Goldsmith, in waiting more than three decades, had taken too long to raise her claims.<sup>392</sup> Four years later, the Second Circuit issued its decision in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*<sup>393</sup> and stunned the art and legal worlds by finding that Warhol's portraits were not entitled to a fair use defense and did, in fact, infringe Goldsmith's photograph.<sup>394</sup> The case is now pending before the Supreme Court.<sup>395</sup>

The Second Circuit's *Goldsmith* holding has resulted in much consternation, as critics charged the decision with threatening vital freedoms of expression in the art world and backtracking on, if not outright defying, the broad rights granted to artists only a few years

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391. Ashley Cullins, *Andy Warhol Estate Sues over Image of Prince*, HOLLYWOOD REPORTER (Apr. 7, 2017, 4:44 PM), <https://www.hollywoodreporter.com/business/business-news/andy-warhol-estate-sues-image-prince-992212> [<https://perma.cc/4BRK-2P9E>].

392. Complaint at 2, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, No. 1:17-cv-02532, 2017 WL 1330503 (S.D.N.Y. Apr. 7, 2017), ECF No. 1.

393. 992 F.3d 99 (2d Cir. 2021), *rev'd in part and vacated in part*, 11 F.4th 26 (2d Cir. 2021), *cert. granted by* 596 U.S. \_\_\_, 2022 WL 892102 (Mar. 28, 2022).

394. *Id.* at 124.

395. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 596 U.S. \_\_\_, 2022 WL 892102 (Mar. 28, 2022) (granting the Warhol Foundation's petition for writ of certiorari).

earlier by the very same court in *Cariou v. Prince*.<sup>396</sup> The *Goldsmith* decision was surprising in a number of ways, particularly its elision of the purported binding precedent in *Cariou*, which, despite its logical deficiencies and wildly inappropriate aesthetic judgments,<sup>397</sup> remains the law of the Circuit. While the *Goldsmith* court admitted to being “bound by *Cariou*, and hav[ing] no occasion or desire to question its correctness on its own facts,” it certainly did not act like it in reasoning that “our review of the decision below persuades us that some clarification is in order.”<sup>398</sup> Without compunction, *Goldsmith* breezily dismissed *Cariou* as merely a “high water-mark of our court’s recognition of transformative works,”<sup>399</sup> arguing that, while “literal construction of certain passages of *Cariou* may support th[e] proposition [that Warhol’s work was transformative], such a reading stretches that decision too far.”<sup>400</sup> Such a statement—that a court should not be guided by a literal construction of passages in binding precedent—is remarkable and made even more so when accompanied by a failure to provide any other alternative basis (would they prefer a non-literal interpretation?) upon which to read authority. Furthermore, while the court conceded that Warhol had imbued the original photograph “with ‘new expression, meaning, or message’”<sup>401</sup> through the use of new aesthetics—“the *sine qua non*”<sup>402</sup> of transformation—it nevertheless opined that this was merely a

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396. 714 F.3d 694, 698–99 (2d. Cir. 2013); Barry Werbin & Jessica Wessel, *United States: The ‘Transformation’ of Fair Use After Prince v. Cariou*, MONDAQ (Feb. 14, 2014), <https://www.mondaq.com/unitedstates/copyright/292912/the-39transformation39-of-fair-use-after-prince-v-cariou> [<https://perma.cc/Z27J-Z3SH>] (“The Second Circuit’s decision has created panic in those circles traditionally protective of copyright, but also has instilled a greater sense of freedom to create by appropriation in artists and creators who build on others’ content without fear of liability . . .”).

397. See John Tehranian, *Dangerous Undertakings: Sacred Texts and Copyright’s Myth of Aesthetic Neutrality*, in SAGE HANDBOOK INTELL. PROP. 418, 425–27 (Matthew David & Debora Halbert eds., 2014) (critiquing the aesthetic judgments made in the *Cariou* decision).

398. *Goldsmith*, 992 F.3d at 110.

399. *Id.* (quoting TCA Television Corp. v. McCollum, 839 F.3d 168, 181 (2d Cir. 2016)).

400. *Id.* at 111.

401. *Id.* (quoting *Cariou*, 714 F.3d at 706 (quoting *Campbell v. Acuff-Rise*, 510 U.S. 569, 579 (1994))).

402. *Id.*

necessary, but insufficient, condition for a finding of transformation.<sup>403</sup> Such a rationale inevitably begs the question as to what *more* is necessary for a transformation determination—something the court does not sufficiently explain. In short, both *Goldsmith's* brazen dismissal of binding precedent and its reasoning leave much to be desired.

The vertiginous leaps of logic from *Cariou* to *Goldsmith* are cause for significant concern. But, unfortunately, inexplicable vacillations and inconsistent rulings in the world of art and fair use are all too common. Just ask Jeff Koons. In recent decades, the Second Circuit adjudicated two infringement suits against him for his unauthorized use of source materials in his work. In the first case, Koons found inspiration in a cheap postcard that he saw in a tourist shop which featured a photograph of a couple and several puppies, posing in Rockwellian tranquility.<sup>404</sup> Koons appropriated the depiction of the couple and the puppies (*Puppies* by Art Rogers) and accentuated various elements of the photograph to create a work that served as a satire of suburban American aesthetic sensibilities.<sup>405</sup> Yet, the court denied his fair use defense, finding him liable for damages and even ordering him to pay the attorneys' fees of the plaintiff.<sup>406</sup> Undeterred, Koons continued to take his legal chances with work that drew from pre-existing materials. Only a few years later, he once again found himself accused of copyright infringement in *Blanch v. Koons*.<sup>407</sup> In that case, the plaintiff owned the copyright to a photograph entitled *Silk Sandals by Gucci*—a commercial work used in advertising.<sup>408</sup> Koons reproduced a portion

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403. See *id.* (holding that “[i]t does not follow, however, that any secondary work that adds a new aesthetic or new expression to its source material is necessarily transformative”).

404. *Rogers v. Koons*, 960 F.2d 301, 304–05 (2d. Cir. 1992).

405. As Koons's attorney, Martin Garbus, explained:

[Koons] saw sentimentality, inanity[,] and kitsch. When he blew up the image to larger than life size, stuck daisies in the hair of the sickly sweet smiling couple (the flowers were not in the photograph)[,] and painted the finished ceramic, the sculpture acquired a horrific quality quite distinct from the original.

Martin Garbus, *Lolita and the Lawyers*, N.Y. TIMES BOOK REV., Sept. 26, 1999, <https://archive.nytimes.com/www.nytimes.com/books/99/09/26/bookend/bookend.html> [<https://perma.cc/Z2UB-U6DV>].

406. *Rogers*, 960 F.2d at 310, 313.

407. 396 F. Supp. 2d 476, 478 (S.D.N.Y. 2005), *aff'd*, 467 F.3d 244, 246 (2d Cir. 2006).

408. *Id.*

of the image for his painting *Niagara*.<sup>409</sup> This time, however, the Court found that the fair use doctrine protected Koons's activities as a form of transformative appropriation.<sup>410</sup> Unpredictability in fair use decisions creates a significant chilling effect on expressive freedoms, causing artists, their galleries, and other exhibitors and distributors to fear the risk of multi-million dollar liability lest they get too close to the blurry line.

But, perhaps just as importantly, the *Goldsmith* holding raises another threshold issue: if the underlying rightsholder to the photograph can come after Warhol nearly three decades after the creation of allegedly infringing work, what about Prince's Estate? Of course, the *Goldsmith* decision does not address this issue, but the equitable argument for recognizing Prince's rights is seemingly just as plausible as recognizing Goldsmith's.<sup>411</sup> Putting the extant law aside, from a purely creative perspective, Prince's carefully cultivated look—the deliberate, studied, and the result of numerous stylistic decisions by the man himself—interplayed synergistically with his music, inextricably weaving together the image and sound. Goldsmith's artistry was no doubt essential to capturing the indelible expression in the underlying photograph, but so was Prince's. From an economic and cultural perspective, the commercial magnetism and semiotic value of Warhol's work owes as much, if not more, to Prince than Goldsmith. That said, in the seminal case establishing the transformative-use test used in California to balance First Amendment rights with that state's right of publicity, the California Supreme Court took pains to emphasize that “the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms . . . [including] subtle social criticism.”<sup>412</sup> It then directly cited to Warhol's celebrity portraits as a quintessential example of the type of works that should not give rise to publicity rights liability.<sup>413</sup>

The California Supreme Court's dicta related to Warhol's celebrity portraits, combined with our analysis of First Amendment defenses and distinctions between merchandising/advertising and art,<sup>414</sup>

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409. *Id.* at 479.

410. *Id.* at 480–82.

411. Of course, this fact illustrates the dangerous slippery slope of the *Goldsmith* decision.

412. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

413. *Id.*

414. *See supra* Part III.

suggests that a right of publicity claim brought by Prince's Estate against Warhol's Estate would have difficulty succeeding in any jurisdiction. Moreover, our assessment of Lanham Act jurisprudence pertaining to subject rights<sup>415</sup> indicates that a trademark claim would also face long odds. After all, even if a court were to recognize a trademark interest in Prince's (altered) image, the idea that the average art consumer would view the use of Prince's visage as akin to his endorsement of Warhol's work seems difficult to support. So, in the end, we are left with reliance on copyright law, which would recognize and reward creative labors. But, of course, authorship of fixation tells us that Prince did not fix his image and, therefore, has no rights in the creative works—whether the photograph by Goldsmith or the serigraph by Warhol—that embody versions of it.

But if the use of Prince's likeness in Warhol's painting is transformative and protected under the First Amendment (as the California Supreme Court has claimed), it is only fair to ask why the use of Goldsmith's image (which stylistically captures Prince's visage at a particular moment in time) should not also be deemed so. Or, alternatively and more to the point, why should the Warhol Estate be immune from litigation from Prince's Estate but face liability from Goldsmith? In a sense, such a state of affairs prioritizes the rights of a second-order creative party (Goldsmith) over both a first-order creative party (Prince) and third-order creative party (Warhol). The upshot is that Goldsmith enjoys a panoply of rights over the use her photograph, which is almost entirely based on Prince's image, including control over Warhol's dynamic recasting of her work. Meanwhile, Prince has no control over the use of his image by either Goldsmith or Warhol. Although Goldsmith is a deeply talented artist deserving of intellectual property protection in her work, so are both Andy Warhol and Prince Rogers Nelson. For the former, the creative freedom to contend with and comment on the world of popular culture remains at stake. For the latter, it is the ability to maintain some say "over the circulation, commodification and meaning of their visual likeness."<sup>416</sup> While the Supreme Court might revisit the ramifications of the Second Circuit's opinion in *Goldsmith* on the

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415. See *supra* Part IV.

416. Rosanna McLaughlin, *Emily Ratajkowski's 'The Cut' Essay and Why We Can't Buy Our Way out of Today's Toxic Image Economy*, FRIEZE (Sept. 28, 2020), <https://www.frieze.com/article/some-thoughts-emily-ratajkowskis-cut-essay> [<https://perma.cc/Z6NF-SDM2>].

former issue, it is unlikely to address the latter issue. That day will soon come, however. When it does, we will have to grapple with a wholesale reassessment of the way in which our intellectual property regime balances expressive freedoms with the rights of fixers, the rights of users, and—although long treated as tertiary—the rights of subjects.