

You Can Take My Picture, But Not My Right Of Publicity

by Jeffrey Albright

A mother in the United States took a picture of her family and posted it on Facebook®. Shortly thereafter, her friend traveling in Europe discovered a Belgian restaurant using the image in its marketing campaign. Does the mother have rights in the image or can the restaurant use the picture without getting permission from the family?

Recently, Woody Allen filed a federal lawsuit against a clothing manufacturer who used an image of him from the 1977 movie *Annie Hall* on billboards without permission. Allen asserted the ads violated his longstanding policy of not making commercial endorsements and damaged his longstanding reputation. American Apparel argued that the use of Allen's image in a satirical or social context was protected under the First Amendment of the *Constitution*. In May of 2009, Allen accepted a settlement of \$5 million from American Apparel prior to the case going to a jury trial.¹

The area of law involving these situations is not well understood and differs significantly depending on the jurisdiction. The issue of the "right of publicity" pits the private rights of individuals against First Amendment free speech and free press rights. For New Mexico, with its burgeoning film industry and a number of high-profile celebrities living here, this area of law is relevant to our state, even if our case law and statutes are not yet well-defined.

The right of publicity protects every person's ability to control the commercial use of his or her identity.² The right makes it illegal for one person to use another's identity as a means of attracting attention to an advertisement or product without first obtaining a license.³ The right protects celebrities, athletes, and public figures from commercial exploitation of a person's name, picture, or likeness or to prevent others from unfairly appropriating that value for commercial benefit. Any trait that uniquely identifies celebrities or implicates their marketable identities deserves protection under the right. However, a person's name or picture may still be used in news reporting, in an unauthorized biography, or in entertainment parody, such as *Saturday Night Live*.⁴

To make a *prima facie* showing of a right-of-publicity claim, the claimant must prove (1) that the claimant owns an enforceable right in the identity of a human being; (2) that the defendant, without permission, has used some aspect of the identity or person in such a way that plaintiff is identifiable from the defendant's use; and (3) defendant's use is likely to cause damage to the commercial value of that persona.



Woody Allen in American Apparel's Billboard. Source: <http://frillr.com>

The first element, that of valid ownership, is much like the concept of standing to sue. Either the plaintiff's *own* identity is at issue, or the plaintiff is an assignee or exclusive licensee of someone else's right of publicity. Sometimes this right can reside with an heir, but some states do not recognize commercial rights in human identity. This is particularly true if the right of publicity is claimed in something other than a human being—such as a corporation, partnership, institution or animal.

The second element requires a showing that the alleged infringer used some aspect of the plaintiff's

identity or persona that makes the plaintiff clearly identifiable.⁵ These might include facial expressions or body characteristics, association with certain products or, in the case of Vanna White of *Wheel of Fortune Fame*, a robot posed next to a game board and dressed in a wig, gown and jewelry. Samsung used just such an image in conjunction with an advertising campaign that so closely resembled White's dress and mannerisms that the court determined Samsung had violated White's right of publicity.⁶ The court determined that the common law right of publicity is based on the use of any indicia by which the plaintiff is identifiable.

The final element requires a plaintiff to prove that the defendant used the plaintiff's identity or persona in a way that is likely to cause damage to the commercial value of that entity or persona. Absent damage, a plaintiff will not prevail.

The two main defenses are consent and First Amendment protection. If a defendant had permission to use a likeness, image or persona, then there can be no violation. The outcome from a First Amendment protection argument often depends on the facts of each case. Freedom of speech and freedom of the press can limit the application of the right of publicity, but even those First Amendment rights have bounds. The U.S. Supreme Court case of *Zacchini v. Scripps* addressed these limitations.⁷

Hugo Zacchini was a human cannonball whose act of being shot from a cannon lasted about 15 seconds. A reporter videotaped the entire performance over Zacchini's objections. That night, the entire



Hugh Zacchini and his cannonball act. Source: <http://www.edward-samuels.com>.

performance was aired on local television, although the reporter admonished the audience that people needed to see the live performance to appreciate it. The Supreme Court stated that while reporting of Zacchini's act would not have violated Zacchini's right of publicity, the broadcast of the entire act posed a substantial threat to the economic value of the entire performance. The Court said much of the economic value "lies in the right of exclusive control over the publicity given to his performance; if the public can see the act free on television, it will be less willing to pay to see it . . . and goes to the heart of petitioner's ability to earn a living as an entertainer."⁸ While recognizing the right to report on the act, the Court's ultimate decision weighed in favor of the right of publicity and the individual's livelihood.



Vanna White and Samsung's Robot. Source: <http://web.hamline.edu/>

Parody can also play a role in courts' decisions related to their First Amendment analyses. The Vanna White case also raised the issue of parody. Samsung attempted to argue that the use of the robot, even if it mimicked White, was really a parody and should prevail over any claim of the right of publicity. The court determined otherwise, deciding the ad's spoof of White and *Wheel of Fortune* was subservient to and only tangentially-related to the ad's primary message: buy Samsung VCRs. The court reasoned that the difference between a "parody" and a "knock-off" was the difference between fun and profit. However, there is no bright line, and whether a particular use is commercial or communicative is very subjective and fact-specific.

We can now reach some conclusions about the Facebook photo and Woody Allen billboard. It is difficult to imagine that the use

of the family Facebook photo by the restaurant caused commercial harm to the subjects. That is not to say that the restaurant might not profit from using the photo, but it might be difficult to show that the family was damaged. Woody Allen, however, seems to fit all of the criteria—hence the reason that American Apparel settled for \$5M just prior to trial.

About the Author:

Jeffrey Albright is a partner with the law firm of Lewis and Roca LLP. His intellectual property practice emphasizes trademarks, copyrights, trade secrets, work for hire, and IP licensing and assignments. He has litigated cases in federal court involving trademark infringement, fraud before the U.S. Patent and Trademark Office and has appeared in proceedings before the Trademark Trial and Appeals Board.

Endnotes

- ¹ See "American Apparel Settles Lawsuit with Woody Allen," by C. J. Hughes and Sewell Chan (New York Times, May 18, 2009).
- ² J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition, §28:1, at 28-3.
- ³ J. Thomas McCarthy, The Human Person as Commercial Property: The Right of Publicity, 10 Colum. VLA J.L. & Arts 129, 1334.
- ⁴ McCarthy, The Human Person as Commercial Property; The Right of Publicity, at 131.
- ⁵ Roy S. Kaufman, Ed., Art Law Handbook, § 307E, at 222.
- ⁶ White v. Samsung Electronics America, Inc., 971 F.2d 1395, 1401 (9th Cir. 1992).
- ⁷ See Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977).
- ⁸ Id. at 575, 576.

Interview with Lisa Strout *continued from page 5*

Could you address some of the issues that have arisen around the film industry in New Mexico—Judge Campbell's recent ruling with respect to the denial of the Los Ranchos home occupancy permit; Las Vegas residents' concerns; and general residential concerns about noise, location, etc., in their communities?

As New Mexico's film industry has expanded, there have been some expected growing pains along the way, such as the situations in Los Ranchos and Las Vegas. A permit that is workable for all has been designed in Las Vegas and production continues in that community. We stand ready to assist local communities as they work to create rules that make sense for their residents while embracing appropriate opportunities. The truth is, the vast majority of New Mexicans support the film industry and are clamoring for more, not less.

What are the top three things that you think a lawyer wanting to work in the film industry in New Mexico should know?

Know the industry and its lingo, be prepared for "interesting" personality types and, of course, specialize in entertainment law.

What kinds of legal issues do you see coming through the Film Office?

Disputes over location contracts are the usual complaints. A film company scratched a wall and the homeowner is claiming \$5,000 to repair it while the film company's insurance adjuster argues that it's only \$2,000. Things along that nature.... I think our most unusual complaint was from an animal owner who demanded to be compensated for the trauma inflicted upon her dog from the loud noises of the film company trucks. Her dog needed therapy and claimed the film company should foot the bill.

Is there any message you would like to get out to the legal community or anything else you would like to say to the legal community?

Simply, that we send our gratitude for your support of the film industry in New Mexico.

About the Author:

Tony Couture practice with the Couture Law Firm in Albuquerque.