

# Right of Publicity

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**[Return to publication table of contents](#)**

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## Table of Contents

Right of Publicity in The New Age: A Warholian Nightmare.....	205
The Genesis of the Right of Publicity Claim .....	205
Right of Publicity in California .....	209
Proper Plaintiffs.....	211
Attacking Damages .....	213
Conclusion .....	215



## Right of Publicity

### **Right of Publicity in The New Age: A Warholian Nightmare**

In February 2005, a California jury handed down a verdict in a right of publicity suit which astonished the legal community. *Christoff v. Nestle, S.A. et al.*, No. EC036163 (Los Angeles County Super. Ct. Jan. 27, 2005). It awarded Russell Christoff, a kindergarten teacher from Concord, California, \$15.6 million for the unauthorized use of his likeness on Taster's Choice packages from 1997 through 2003.

Christoff had posed for the familiar photo of a smiling man's face hovering over a steaming cup of coffee in 1986, and was paid \$250 for the photo shoot. The contract required Nestle to pay him \$2,000 if the photo was used. Nestle failed to pay that money, but used the image for six years. Christoff's lawyer argued that in those years, his image had become as integral to the brand as the coffee itself. The jury agreed, and under California's right of publicity statute, awarded Christoff five percent of Nestle's worldwide profits for the time his image was used, in addition to \$330,000 for the use of the photo.

While Nestle has learned a harsh lesson regarding making sure it obtains photo releases, the Christoff case presents an opportunity for the defense bar to learn valuable lessons in defending right of publicity cases. How did it happen that Christoff, an unknown former model, was awarded the type of verdict one would expect to be handed to a well-known celebrity, or famous model? Is "celebrity" relevant to right of publicity claims, or is there such a thing as a "celebrity" anymore, in this day and age of reality television and instant digital media? Or, has Warhol's proposition that "in the future everyone will be famous for fifteen minutes" finally come true, with devastating consequences?

### **The Genesis of the Right of Publicity Claim**

The right of publicity finds its genesis in the right of privacy, and in some states is still referred to as an "invasion of privacy" claim. The genesis of the rights of a person to exploit their value as a persona under the concept of the "right of privacy." As one California court stated,

[i]n the commercial arena, celebrity endorsements are often considered a valuable marketing tool. What may have originated as a concern for the right to be left alone has become a tool to control the commercial use and, thus, protect the economic value of one's name, voice, signature, photograph, or likeness.

*KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 367 (Cal. App. 2 Dist. 2000).

In those states that still recognize the tort of right of publicity as closely intertwined with that of "invasion of privacy," there is the recognition that stems from two interrelated theories; first, every person has the right to be left alone, and this would include the right for their image to not be publicly displayed without their approval, for commercial gain. *Agency for Health Care Admin. v. Associated Indus. of Fla., Inc.*, 678 So. 2d 1239, 1252 n.20 (Fla. 1996).

Second, the law recognizes that people have a property right vested in their image. The value of property right is most obvious in the case of celebrities, or those who trade on their image, such as models. When others make use of that property without authorization, they are depriving that person of the right to profit from that image themselves. In some states, the measure of damages is the money which would have been paid to the plaintiff, such as Maine (see, e.g., *Fitch v. Stanley*, 2005 Me. Super. LEXIS 190 (2005), while in others, such as Georgia, the measure of damages is essentially unjust enrichment of the defendant. *Whisper Wear, Inc. v. Morgan*, 277 Ga. App. 607, 627 S.E.2d 178 (Ga. Ct. App. 2006).

The first explicit "right of publicity" case was *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953). In what is now widely accepted right of publicity doctrine, the *Haelan* court found that a baseball player had a property right to his photograph, as it was used on trading cards. As now recognized, the common law cause of action for right of publicity generally requires that the plaintiff prove (1) defendant's use of the plaintiff's identity, (2) the appropriation of the plaintiff's name or likeness to the defendant's advantage, commercially or otherwise, (3) lack of consent, and (4) resulting injury. *Butler v. Target Corp.*, 323 F. Supp. 2d 1052 (C.D. Cal. 2004).

Today, the evolution of the concept of right of publicity has come to include the right not only to one's own image, but even to synthesized

images (*White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992)); not only to the use of one's own voice, but to "sound-alike's." (*Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992)). The right of publicity concept now encompasses broader intellectual property rights, including quasi-trademark rights under the Lanham Act.

Actions under the Lanham Act have included a suit by Muhammed Ali for the use of the phrase "the Greatest" (*Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978)), by Johnny Carson for "here's Johnny" (*Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983), and (unsuccessfully) by an author when her name was used in relation to the promotion of a book with which she asserted she did not wish to be associated. (*Flynn v. AK Peters, Ltd.*, 377 F.3d 13 (1st Cir. 2004).

Under the Lanham Act, individuals who can demonstrate that their name has obtained a "secondary meaning" may establish a cause of action under Section 43(a) of the Lanham Act, which creates civil liability for:

Any person who, on or in connection with any goods or services, . . . uses in commerce any . . . false designation of origin [which] is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person[.]

The plaintiff can meet this evidentiary burden through the use of direct evidence, such as consumer surveys or testimony from consumers, or through the use of circumstantial evidence. A plaintiff may establish secondary meaning for a name by presenting circumstantial evidence regarding: "(1) the length and manner of its use, (2) the nature and extent of advertising and promotion of the mark and (3) the efforts made in the direction of promoting a conscious connection, in the public's mind, between the name or mark and a particular product or venture." *Boston Beer Co. Ltd. P'ship v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 182 (1st Cir. 1993); see also, *815 Tonawanda St. Corp. v. Fay's Drug Co., Inc.*, 842 F.2d 643, 648 (2d Cir. 1988) (including among the factors that may be considered to prove secondary meaning "advertising expen-

ditures, consumer surveys, media coverage, attempts to copy the mark, and length and exclusivity of use”).

In the cases of Ali and Carson, it was established that the phrases in question had become so closely associated with the plaintiffs that they had acquired a secondary meaning directly related to the plaintiffs, and that confusion could result by the use of the phrase, suggesting a tie to the plaintiff. In the case of the author, despite the fact that it was her own name which was used, the plaintiff could not establish that *her own name* had acquired a secondary meaning in the market, so as to create any connection between her name and the book.

It would seem, then, that in order to prove secondary meaning under the Lanham Act, a plaintiff must actually establish that he or she *themselves* is a “celebrity”, or person of such significance in any given field that their name, or some nickname or phrase associated with them, has so permeated the public consciousness, that the public understands and relates that phrase to them.

This raises the pop-philosophical question, what is the nature of fame and celebrity in the 21st century and digital age, and how does one defend such claims? Tila Tequila, a Myspace phenom, has, at last count, over 1,250,000 “friends,” and yet is virtually unknown outside the 18–35 demographic. What is the nature of Ms. Tequila’s so-called fame, and does it have any value in the broader context of a lawsuit?

Digital media permit an instant saturation of the market with images, personalities, and information. This information is nearly instantaneously updated and replaced by new images, personalities, and information, making what was new, hip, cool and hot a moment ago entirely passé. The nature of the world in which we live demands constant updating. This creates an army of both instant celebrities and instant has-beens.

In analyzing claims in this new media driven age, it is helpful to go back to the standards which guided the courts in the past in analyzing claims, while always thinking out of the box concerning fresh approaches which can be taken to attack claims, given the myriad of new claims being brought. The first line of attack should be determining whether there is any value or meaning which has attached to the plaintiff’s image, as this impacts, for various purposes, both whether they

have a claim, and damages. For example, a secondary meaning is established, in the words of the *Boston Beer Co.* court, first by “the length... of its use.” *Boston Beer Co.*, at 182. If a plaintiff is a “flash in the pan,” it would seem that a feasible argument could be made that no secondary meaning attaches to the plaintiff (or their name, likeness, etc.), regardless of how “famous” the plaintiff claims to be for the moment.

Second, a plaintiff who is only widely known in one particular forum, such as the internet, would have a hard time demonstrating secondary meaning, as the second prong. Therefore, such a plaintiff would neither have standing to make a claim, nor damages.

### **Right of Publicity in California**

The *Christoff* case was based on California law. In California, the right of publicity is both a common law right as well as a statutory right.

California Civil Code §3344 forms the statutory basis for right of publicity actions and, similar to common law, authorizes recovery of damages by any living person whose name, photograph, or likeness is used for commercial purposes without his or her consent.<sup>1</sup> By definition, §3344 does not limit recovery to so-called “celebrity” plaintiffs, by any person whose “name, photograph, or likeness is used for commercial purposes without his or her consent.” The issue with non-celebrity plaintiffs is the damages they can prove from the use. A celebrity plaintiff may be able to prove through expert testimony actual damages from the use, for example, by demonstrating that they were deprived of an opportunity to potentially “market” a product, or that their value in the marketplace has been diminished as a result of an unauthorized use. Examples of these types of theories are celebrities claiming that the profits or the value of their endorsements went down after an unauthorized use, either due to over-saturation, or because of an unauthorized use in a specific market.

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<sup>1</sup> California Civil Code §3344.1, the “Astaire Celebrity Image Protection Act” provides protection for the use of a deceased personality’s name, voice, signature, photograph, or likeness for up to 70 years after the death of the personality.

However, a non-celebrity “endorsement” seemingly has no intrinsic “value,” as the face on the billboard or package is anonymous. No one is clamoring for the endorsement of the ubiquitous man on the street. “Regular people” cannot claim that their non-existent market for endorsement has now become “oversaturated” because of an unauthorized advertisement. It ought to be noted that while these are arguments to make *vis à vis* actual damages awards, a finding of an unauthorized use subjects the defendant to possible punitive damages, as well as, in many jurisdictions, other disgorgement damages, such as profits in California. Thus Russell Christoff, an anonymous kindergarten teacher, received a verdict which included five percent of Nestle’s profits, or \$15.3 million attributable to the use, as well as \$330,000 for “lost licensing” for the use of the photo. *Christoff v. Nestle, S.A. et al.*, No. EC036163 (Los Angeles County Super. Ct. Jan. 27, 2005).

Christoff, of course, sued under Section 3344 of the California Civil Code. Under Section 3344, a plaintiff must prove all the elements of the common law cause of action, a “knowing” use by the defendant, as well as a direct connection between the alleged use and the commercial purpose. While these hurdles are high, if the plaintiff proves these elements, the plaintiff is entitled to any damages sustained by the plaintiff, any “actual damages” suffered by the plaintiff (or \$750), “and any profits from the unauthorized use *that are attributable to the use.*” (Emphasis added). Here, however, the burden shifts back to the defendant, as the plaintiff only need show the gross revenue attributable “to the use,” and then the defendant is “required to prove... deductible expenses.” Punitive damages may also be awarded, and attorney’s fees and costs are awarded to the prevailing party.

The question is, what is profit “attributable to the use” of the plaintiff’s person? In the *Christoff* case the jury found that only five percent of Taster’s Choice sales during the six years Christoff’s photograph was used was attributable to the photograph itself (albeit worldwide, when the photograph was not used worldwide).

It seems obvious that the defense must consistently and strenuously attack such claims of attribution as speculative. However, it must be noted that juries do typically find some attribution to the use, on the basis that basic marketing principles—the public chose one product

over another for some reason, and one of the reasons was probably the smiling face in advertisements. In *Andreas v. Volkswagen of America, Inc.*, 336 F.3d 789, 798–99 (8th Cir. 2003), a jury attributed 10 percent of Audi’s profits from the sale of a car model to an infringing phrase used in a television commercial used in advertisements.

Broadly speaking, in a case like *Christoff*, one would expect that the defense would heavily attack the concept that its use was “knowing.” However, the weakness with this argument is that it is not the lack of consent that needs to be “knowing,” but rather, the use itself. The distressing aspect of the verdict in this case is the award of \$330,000 for “licensing” of the photograph, when information available suggests that the contract signed by Christoff in 1986 stated that he would get \$2,000 if it was used. As such, it would seem that Christoff’s actual damages were \$2,000, and that the market fixed the value of his image at \$2,000—not \$330,000.

Did the jury come to look at Christoff circa 2006, the smiling figure on the Taster’s Choice containers as a quasi-celebrity, and therefore worth more, in 2005, than the piddling \$2,000 Nestle offered him in 1986? Whether or not it did, a valuable conclusion we may reach is that some jurors are mesmerized even by the suggestion of celebrity and fame, and consider its worth to be far more than the market will actually bear.

## Proper Plaintiffs

The common law right of publicity or commercial misappropriation causes of action do not require, *per se*, that the plaintiff prove that they are a “celebrity.” However, there must be a showing by the plaintiff that they were “injured” by the misappropriation. The question is, if an individual is not a celebrity, what value is there in their image or likeness, such that the commercial use would cause “injury” to them?

A quick study in contrasts may be made between two authors, one well known, and one not particularly well known: Stephen King and Flynn. Both filed suits related to right of publicity, both “reverse attribution” cases. In one, Stephen King, the famous fiction author, sued because his name was used with respect to a movie with which he did not wish to be associated, “*Stephen King’s The Lawnmower Man*.” King prevailed, in part, with the court noting that his good name as an author

would be tarnished by a possessory credit. *Stephen King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992). The court did allow a “based upon” credit.

Flynn, an expert on artificial intelligence (robots), sued on a similar theory. She had co-authored one edition of a book on mobile robots, and found that she was listed as a co-author on the next edition, with which she calls “a disaster.” Inflamed, she sued for reverse attribution under the Lanham Act. The court, in essence, told Ms. Flynn that she was a not enough of a celebrity to make a claim, even if she was well known in her field. *Flynn v. AK Peters, Ltd.*, 377 F.3d 13 (1st Cir. 2004).

Thus, it is clear that a plaintiff has certain hurdles in a Lanham Act case, such as celebrity. However, in a recent case a contrary argument was made by plaintiffs—that their very *lack* of celebrity gave value to their images. In *KNB Enterprises*, the plaintiffs held the copyright to a number of erotic photographs, which were copied from one website to another, without authorization. *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362 (2000). The plaintiffs not only admitted that the models in question were non-celebrities, but claimed that their value in that particular industry was being “new.” The defendants argued that because the plaintiffs were non-celebrities, there was no value in their Section 3344 claim, and therefore, the only claim was a copyright claim. The court disagreed, stating that “[u]nder California law, the statutory right of publicity exists for celebrity and noncelebrity plaintiffs alike.” *KNB Enters.*, 78 Cal. App. 4th at 374.

A number of states and statutes require either that the plaintiff show “pecuniary injury,” or that the in some other manner establish that they are, in essence, a celebrity. As noted earlier, the Lanham Act requires that the plaintiff’s name or likeness have a “secondary meaning” in order to substantiate the claim of confusion. In order to show a “secondary meaning,” the plaintiff must show that his or her name or likeness is so well known that there is a likeliness of confusion; in other words, they must show that they are celebrities.

States or statutes which require a showing of pecuniary injury put the onus on the plaintiffs to establish that in some manner the defendant’s use of their likeness caused them to lose money, or an opportunity to make money. It is difficult to imagine a scenario under which a plaintiff could

make such a showing unless the plaintiff was well-known, or uniquely positioned like a model, to make money from his or her likeness.

## Attacking Damages

The *Christoff* case clearly illustrates the dangers of large damages in a right of publicity case. Christoff was awarded \$330,000 for the photograph which was used without his permission, despite the fact that the contract originally called for him to be paid \$2,000. In addition to that, Christoff was awarded \$15.3 million for five percent of the profits Nestle made, worldwide, during the time frame his photo was used on the coffee packages.

While such a verdict may seem distressingly large, it must be seen in the context of other verdicts obtained by bona fide celebrities, as well as well publicized events such as the over \$10 million paid (by two separate publications) for the rights to publish the first photographs of the infant of Brad Pitt and Angelina Jolie. It is likely that juries seem infatuated with the idea that celebrities, and those on their way to being celebrities, simply get, or would get, whatever they ask for in the endorsement marketplace, and that if a defendant takes without asking, it will pay for it in spades in trial.

In one recent case, *Los Angeles Times Magazine* used an altered photograph of Dustin Hoffman in his famous role of “Tootsie,” without Hoffman’s permission. The photograph was altered from wearing the red sequined dress, to a beige satin gown, for a fashion issue. Hoffman sued, and was awarded \$1.5 million in compensatory damages, and another \$1.5 in punitive damages. The judge found that \$1.5 million was a figure “which represents the fair market value of the right to utilize Mr. Hoffman’s name and likeness in the manner in which it was used by Los Angeles Magazine.” Hoffman was one of a number of persons whose images appeared in the issue. *Hoffman v. Capitol Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (C.D. Cal. 1999), *rev’d*, 255 F.3d 1180 (Cal. Ct. Appl. 2001).

In a verdict in Missouri, a jury found in favor of a former NHL hockey player whose name was used in the comic book series *Spawn* for a mob enforcer, “Tony Twist,” and awarded the plaintiff \$24.5 million in compensatory damages. After the judge reduced the award, Twist appealed, and the reduced verdict was reversed and remanded with new instruc-

tions. The appellate court noted that Twist met his burden of demonstrating that the comic character's name was based on him, as shown by the marketing of the series, and that there was actual confusion in the minds of consumers that he endorsed the product. *John Doe, a/k/a Tony Twist, Appellant v. TCI Cablevision, et al.*, 110 S.W.3d 363 (Mo. 2003).

Two cases which are strikingly similar are *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992). In each of these cases the defendants utilized a "sound alike" to imitate the plaintiffs. In *Midler*, the sound alike sang a song which was popularized by her, in a television advertisement for a car. Midler was awarded \$400,000 in compensatory damages. In *Waits*, the defendant used a sound alike to imitate his distinctive gravelly voice in a Doritos chip advertisement. Waits, an indie rock icon, but essentially unknown in the mainstream, was awarded only \$100,000 in compensatory damages. However, when punitive damages and attorneys' fees were included, the total award to Waits was \$2.5 million.

Several themes appear to run through these awards. First, the more well known a particular plaintiff, the higher the compensatory award will likely be, as it will be assumed that in order to have a well known celebrity endorse a product, as opposed to an "unknown," will be more expensive. Second, there is the "Garbo effect": if the celebrity never endorses anything, an endorsement may also be worth more money than an endorsement by a personality who frequently appears in endorsements. Finally, there is the unseemly or salacious element. If the celebrity would never be associated with that particular product (Johnny Carson with portable toilets, for example), it is more likely that a jury will give a greater award, because in the event that there *is* confusion, the public will draw unsavory conclusions about the celebrity—perhaps that they are desperate for money or work.

There are countervailing arguments for the defense. Given that consumer confusion and commercial attribution is an element of the tort, this defense can be used both with regards to the second and third points, depending upon the facts. In other words, if a celebrity never endorses anything, and the defendant utilized some component of their likeness, an easier argument can be made that consumers will *not* assume that the celebrity now suddenly has endorsed, or is tied to this

product, but rather that it is a parody, homage, or simply entirely independent of the celebrity. The same argument can be made if the product is so far removed from the normal realm of the celebrity's public life, so as to border on satire. It is hard to believe that anyone really thought that Johnny Carson endorsed the "Here's Johnny" portable toilets, any more than anyone really thought that Hustler's infamous 1983 Cam-pari advertisement featuring an interview with Jerry Falwell was "real." (*Hustler Magazine v. Falwell*, 485 US 46 (1988)).

Finally, with respect to commercial use, a recent filing raises several interesting issues: may a religious organization use a famous figure, who is not a member, to proselytize? Jews for Jesus thinks so, and has used the images of a number of people it stereotypically believes are Jews to pitch its religion. Jackie Mason, who relies on his Jewish "schtick," as he calls it, was not amused, and recently filed a \$2 million action, and is seeking injunctive relief to bar Jews for Jesus from distributing pamphlets bearing his likeness. The *Mason v. Jews for Jesus* case, which was not brought under the Lanham Act, raises a number of issues—does Jews for Jesus have a First Amendment defense, as a religious organization, to proselytize as it sees fit? If their use is not a "commercial use," as Jews for Jesus is a not for profit, does Mason have a right of publicity claim at all? Can Mason establish a claim by proving that *he* has lost value in the marketplace by being associated with Jews for Jesus, when his comedic act heavily depended on being Jewish? *Mason v. Jews for Jesus*, No. 06-6V-6433 (N.Y. Sup. Ct. 2006).

Jews for Jesus, for their part, are claiming that the pamphlet is not meant seriously, and "shame on [Mason]" for taking it so seriously.

## Conclusion

As the public's insatiable desire for celebrity and all things associated with celebrity grows, the repercussions for right of publicity claims can be felt in terms of increasing dollar values. Defense of these claims depends upon taking new and creative approaches, and out-of-the-box thinking. With awards for even non-celebrities reaching tens of millions of dollars, each case must be handled with a unique approach.

**[Return to publication table of contents](#)**

