

Why a Reasonable Right of Publicity Should Survive Death: A Rebuttal

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I. Introduction

Elvis Presley.¹ Tiger Woods.² Babe Ruth.³ Princess Diana.⁴ Johnny Carson.⁵ These names immediately conjure up an image, a personality—a persona that shares many characteristics with what marketing professionals loosely call a *brand*. These individuals have become symbols representing, in some instances, well-known traits or characteristics, e.g., Marilyn Monroe: glamour mixed with tragedy, Babe Ruth: athletic accomplishment accompanied by boastful self-confidence. Other personas are associated with causes or historical events—think FDR and the end of the Depression or Princess Diana and the fight against the paparazzi.

The value associated with these individuals' names does not disappear when they die. Indeed, in some instances, it was the person's death that created the mystique that transformed them from merely famous to iconic: Janis Joplin and Jimmy Hendrix come to mind. While there may, of course, be exceptions, from a policy perspective, a post-mortem right of publicity is fully consistent with what Justice Frankfurter described years ago as the "law's recognition of the psychological function of symbols. [Trademarks are used to convince consumers of] the desirability of the commodity on which it appears. . . . If another poaches on the commercial magnetism of the symbol he has created he can obtain legal redress."⁶

This article is a rebuttal to the thoughtful and provocative argument advanced by Christopher Serbagi and David Marcus in "The Death of Celebrity Art: Why the Right of Publicity Should Not Survive Death ("The Death of Celebrity Art"), which appeared in the Spring 2008 issue of *Bright Ideas*,⁷ wherein they argued that a post-mortem right of publicity should not be recognized.

Underlying "The Death of Celebrity Art" is the following vexing question: If I take a photograph of a famous person, I clearly own the copyright in the photograph. Does that copyright ownership alone confer the rights necessary to sell copies of the photograph? Can I display the photograph? Can I license the photograph for use on a tee-shirt, coffee mug, or a portable toilet?

Messrs. Serbagi and Marcus are involved in a heated litigation against the Marilyn Monroe estate, which is perhaps the leading advocate in the United States for expansive publicity rights. It is also worth noting that the position of the Monroe legal team, if not in this case then in the past, has often been that while the sale of original copyrighted photographs may not implicate Monroe's right of publicity, the public display of the photographs

in an exhibition on her life in a department store may do so.⁸

It is understandable, given this backdrop, that Serbagi and Marcus argue so stridently against any recognition of post-mortem publicity rights. I respectfully submit, however, that there is room for a post-mortem right that does not compromise the legitimate First Amendment or copyright rights. I also submit that public policy weighs strongly in favor of recognizing such a right.

Society as a whole can benefit from a reasonably circumscribed post-mortem right of publicity, which will protect not only the heirs or assignees of the deceased right of publicity owner, but also all others who have licensed or otherwise associated themselves with the right of publicity with the authorization of its owner. Reasonable legislation delineating the duration of a post-mortem right of publicity and the manner in which it can be conveyed will not impede copyright owners or trample the First Amendment; rather, it will bring certainty to all involved and enable the publicity rights owner to reward his or her heirs with the benefits associated with the valuable asset associated with his or her name, likeness, and persona, and also to protect the commercial relationships established by the rights owner before he or she died. This decision should not be determined based upon whether the heirs had anything to do with creating the assets; rather, it is a decision that should be placed in the hands of the rights owner, and thereafter reasonably regulated after the rights owner dies.

Marilyn Monroe was more than a '50s/early '60s sex goddess; she personified Hollywood glamour with her beauty and alluring aura. The world fell in love with her apparent vulnerability, innocence, and innate sensuality. Even though Marilyn died in 1962 at the age of thirty-six, her fame did not die with her. Today, the name "Marilyn Monroe" still represents beauty, sensuality, and glamour.⁹ With her popularity and commercial appeal as strong as it was in the 1950s, Marilyn is still a valuable commercial asset. It is hard to dispute that this commercial value is, at least in some significant part, the product of the brand stewardship of those who manage the Monroe estate and that without such tight control over the use of Monroe's image, Monroe today would stand for something altogether different, if anything at all. Isn't this what Justice Frankfurter described as the creation of commercial magnetism which cannot be poached without legal redress?

If Marilyn had the right to control her right of publicity while alive, her heirs, and arguably all those with whom she may have contracted, should be able to control

and benefit from that right after her death. Many courts have acknowledged this concept, even in New York, where there currently is no statutory post-mortem right of publicity.¹⁰ Without a post-mortem right of publicity, Monroe's name or likeness could show up on portable toilets. Such offensive, unauthorized uses of Monroe's persona are a real possibility absent reasonable legislation that would permit the heirs and/or other authorized entities to regulate use of the publicity right after death.

II. The Public Benefits from a Post-Mortem Right of Publicity

Serbagi and Marcus take the position that there is no reason to extend the right of publicity beyond the life of its original owner.¹¹ But there are public policies and legal justifications that do support recognizing a post-mortem right of publicity. Several courts, for example, have noted that celebrity fame, which in most cases is derived from hard work, is an intangible property right that should be descendible.¹² Legislation recognizing such a right for a reasonable period of time after death upholds the principle against unjust enrichment, prevents deceptive advertising, and serves to maintain confidence in contracts.¹³

Although a celebrity's fame can be amplified or deflated by the media, a celebrity's fame is ultimately the result of the celebrity's hard work, talent, and investment.

[E]very person is entitled to the fruit of his labors unless there are important countervailing public policy considerations. Yet, because of the inadequacy of traditional legal theories . . . persons who have long and laboriously nurtured the fruit of publicity values may be deprived of them, unless judicial recognition is given to what is here referred to as the right of publicity—that is, the right of each person to control and profit from the publicity values which he has created or purchased.¹⁴

To develop a celebrity's prominence in a particular field usually takes substantial money, time, and energy.¹⁵ Tiger Woods is a perfect example. Today, Tiger Woods is considered the world's best and most famous golfer.¹⁶ He achieved this fame not only with his god-given talent, but also with hard work and family support. When he won the Masters Tournament in Augusta, Georgia in 1997 by a record 12-stroke margin, he was the youngest player ever to win the tournament.¹⁷ If Tiger had an accident and died, do you think Nike or Buick, which have paid handsomely for Tiger's endorsement, would have done so if their competitors could suddenly use his name and likeness to endorse their competing products

immediately after Tiger's death? Would it be fair to allow a person who took photos of Tiger Woods to suddenly license the images in those photos for use in connection with tee-shirts, coffee mugs, or other trinkets? Why should Tiger Woods's wife and child not be permitted to continue to benefit from his name and image and protect it from unauthorized and dilutive commercial uses?

When an individual reaches celebrity status, ostensibly it is his or her name and likeness that is recognized and protected from unauthorized commercial use in most states by common law or by statute.¹⁸ Some courts, including the United States District Court for the District of New Jersey, have characterized this right as a property right because the celebrity's name and likeness are things of value.¹⁹ Courts in other states have done the same.²⁰ The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.²¹ If a celebrity's right of publicity is treated as an intangible property right in life, courts have held that it also must be treated as such after death and, accordingly, may descend upon death.²² Since the celebrity has created a valuable capital asset, it is consistent with the celebrity's expectation that this asset will benefit his heirs and assigns after his death.²³ Absent a post-mortem right of publicity, the public effectively receives a windfall by dint of being able to use the deceased celebrity's name or likeness without limitation. This is unjust enrichment.²⁴

Moreover, recognizing a post-mortem right of publicity safeguards consumers from deceptive sponsorship, approval, or certification of goods and services.²⁵ Indeed, it likely would be confusing if, after Tiger Woods's death, Adidas were to come out with a Tiger Woods golf clothing line that would compete with clothing made by Tiger Woods's chosen apparel company, Nike. Tiger Woods and Nike chose to create their relationship, and Nike invested millions based on the exclusivity of that relationship. If, after Tiger Woods died, Adidas suddenly could use the Tiger Woods name for a competing clothing line, not only would the public believe that Tiger Woods was now endorsing Adidas, but it also would diminish Nike's desire to create an exclusive relationship with Tiger Woods and invest in that relationship while Tiger Woods is alive.

A post-mortem right of publicity maintains the value of the sponsorships, relationships, and other contractual rights entered into by the right of publicity owner during his or her lifetime as well as the value of such rights to the licensees who invested millions of dollars not only to acquire the right to use a celebrity's name and likeness, but to promote and market the name as their own.²⁶ The commercial appeal in using a celebrity's fame stems from its duration and exclusivity.²⁷ If a celebrity's name and likeness were to enter the public domain instantly upon death, the value of endorsement contracts entered into while the celebrity was alive would be greatly diminished.²⁸

In sum, there is great societal benefit from permitting a post-mortem right of publicity. But how broad should such a right be?

III. Post-Mortem Publicity Rights Will Not Chill More Expression Than Do Pre-Mortem Publicity Rights

Serbagi and Marcus contend that a broad post-mortem right of publicity will stifle expression and create fear of portraying historical figures and celebrities.²⁹ But if this is true, it is equally true while the celebrity is alive. The celebrity's death will not suddenly result in an expansion of publicity rights that will endanger more protected expression. The First Amendment has held its own against the right of publicity.³⁰ There is no basis for the assertion that a post-mortem right of publicity necessarily will stifle creativity or artistic expression.

The First Amendment protects speech expressed in a variety of media, from written or spoken words to music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures.³¹ Even speech carried out for profit is protected, including that of publishers distributing artists' expressive works.³² Commercial speech is entitled to First Amendment protection, albeit somewhat less than noncommercial speech.³³ Indeed, the First Amendment dictates that celebrities can be the subject of comment, parody, lampoon, and any other noncommercial form of expression without any right to compensation.³⁴ The right of publicity is merely another economic right that can prevent others from misappropriating the economic value generated by the celebrity's fame.³⁵

One test courts have formulated to help clarify the distinctions between, and balance, the right of publicity and the First Amendment to ensure that artistic expression is protected is the "transformative use" test.³⁶ The test inquires whether the transformative elements of the artist's work are so great that the celebrity's name and likeness are only the raw materials from which the original work was synthesized.³⁷ If the artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, without adding significant original artistic expression, then it trespasses on the right of publicity.³⁸ But if the work contains significant transformative elements, then it is entitled to First Amendment protection.³⁹

Illustrating this balance and demonstrating that the right of publicity will not stifle creative and artistic expression is *ETW Corp. v. Jireh Publ'g*.⁴⁰ ETW Corporation is the exclusive licensing agent for Tiger Woods's publicity rights. Jireh Publishing, Inc. publishes works of art created by Rick Rush, who is well known for creating paintings of famous figures in sports and famous sporting events. In 1998, Rush created a painting entitled "The Masters of Augusta," which celebrated Woods's 1997

Masters victory. The painting consists of three views of Woods in different poses in the foreground and includes Rush's signature. Next to Woods are his caddy, Mike "Fluff" Cowan, and his final round partner's caddy. Behind these three figures is the Augusta National Clubhouse. The likenesses of Arnold Palmer, Sam Snead, Ben Hogan, and Jack Nicklaus are depicted looking down on Woods in the blue background behind the clubhouse. Limited-edition reproductions of the painting came with a narrative description of the painting, which also used the name Tiger Woods.

ETW sued Jireh alleging, *inter alia*, infringement of Woods's right of publicity. Jireh argued that Rush's use of Woods's image and name in Rush's painting and narrative were protected by the First Amendment. The Sixth Circuit agreed with Jireh and found that Rush's work was more than a mere likeness of Woods, i.e., it met the transformative use test's requirement for original expression, not merely imitating the celebrity's image for commercial gain. The court explained that Rush's limited edition painting included a combination of images in addition to that of Woods. This represented an artistic effort to capture a historic sports event on canvas, not necessarily capitalize on the celebrity image. The court held that Woods's right of publicity must yield to the First Amendment's protection of Rush's original and artistic expression, especially in view of the limited-edition distribution of the work.

Copyright law also permits the artist to sell his copyrighted work and, in tandem with the First Amendment, should shield the artist from any right of publicity attacks, provided the copyright owner has sole ownership of the work and does not overly extend the commercialization of the work.⁴¹ The copyrighted work that includes a celebrity image should be able to be auctioned or otherwise sold, provided it is not mass marketed for commercial consumption such as by licensing a third party to use the work in connection with selling portable toilets.

IV. The Marilyn Monroe Cases

Serbagi and Marcus are to be commended for their efforts to defend their client's right to sell its copyrighted photographs of Marilyn Monroe. But their efforts to defeat an assertion of post-mortem publicity rights should not come at the expense of all right of publicity owners and their heirs.

The states that have laws governing the right of publicity and the post-mortem right of publicity appear to have adopted a reasonable approach to protecting the societal benefits associated with protecting the right of publicity in life and death. But, regardless of whether there is a statutory post-mortem right of publicity in California, New York, Indiana, or anywhere else, copyright owners should be able to freely sell or display their works, e.g., the Marilyn Monroe photographs, including

in a gallery if they so choose. Such commercialization has been, and continues to be, protected by copyright law and by the First Amendment. Although the Monroe estate may claim the right to license some of these activities, I agree with Serbagi and Marcus that a post-mortem right of publicity should not cover all such activities. The only activities a post-mortem right of publicity statute should regulate in a reasonable manner are those in which the works are commercialized, i.e., transformed in order to sell something other than merely their original expression, such as by being licensed for use on t-shirts, mugs, or portable toilets or for endorsements for products or services.

IV. Conclusion

I do not opine on the merits of the Marilyn Monroe cases. But I do believe that a properly balanced post-mortem right of publicity is a reasonably fair way to ensure that the commercially valuable name and likeness of a person is protected after death from unauthorized or unflattering uses for commercial gain.

Endnotes

1. See *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).
2. See *ETW Corp. v. Jireh Publ'g Inc.*, 332 F.3d 915 (6th Cir. 2003).
3. See *Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990).
4. See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002).
5. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 810 F.2d 104 (6th Cir. 1987).
6. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).
7. See NYSBA *Bright Ideas*, Vol. 17, No. 1, 11 (Spring/Summer 2008).
8. The author's partner negotiated such an agreement with the Monroe Estate several years ago.
9. See Marilyn Monroe's Biography, Marilyn Monroe c/o CMG, Worldwide <http://www.marilynmonroe.com/about/bio.html>.
10. *Pirone*, 894 F.2d at 585-86 (2d Cir. 1990) (stating there is no independent common-law right of publicity and right is not descendible); see *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174 (1984).
11. *Death of Celebrity Art* at 15.
12. See Ind. Code §§ 32-26-1-1 to -20 (Indiana's Right of Publicity Act allowing statutory post-mortem right of publicity); *Comedy III, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001) (maintaining that a celebrity's fame is the result of hard work and the celebrity's heirs and assigns have a legitimate protectable interest in exploiting the celebrity's commercial value); *Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89, 96 (Tenn. Ct. App. 1987) (indicating that a right of publicity is an intangible personal property and therefore descendible); *Estate of Presley v. Russen*, 513 F. Supp. at 1335 (indicating that right of publicity should be descendible).
13. *Elvis Presley Int'l Mem'l Found.*, 733 S.W.2d at 98.
14. Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 216 (1954).
15. *Comedy III v. Saderup*, 21 P.3d at 804.
16. *ETW Corp.*, 332 F.3d at 918.
17. *Id.*
18. *Winter v. DC Comics*, 69 P.3d 473, 476 (Ca. 2003).
19. *Estate of Presley*, 513 F. Supp. at 1354.
20. *Id.* at 1355; *Elvis Presley Int'l Mem'l*, 733 S.W.2d at 97; *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978); *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 282 (S.D.N.Y. 1977); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975).
21. *Comedy III*, 21 P.3d at 804.
22. *Elvis Presley Int'l Mem'l Found.*, 733 S.W.2d at 97-8; *Estate of Presley*, 513 F. Supp. at 1355; *Price*, 400 F. Supp. at 844.
23. *Elvis Presley Int'l Mem'l Found.*, 733 S.W.2d at 98.
24. *Id.*
25. *Id.* at 99.
26. *Id.* at 98.
27. *Id.*
28. *Id.*
29. *Death of Celebrity Art* at 15-16.
30. See *ETW Corp.*, 332 F.3d 915; see also *Winter*, 69 P.3d 473; see also *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001); see also *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959 (10th Cir. 1996).
31. *ETW Co.*, 332 F.3d at 924.
32. *Id.* at 924-5.
33. *Id.* at 925.
34. *Comedy III*, 21 P.3d at 807.
35. *Id.* at 806.
36. *Id.*
37. *Winter*, 69 P.3d at 477.
38. *Id.* at 808.
39. *Id.*
40. 332 F.3d 915.
41. *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1141 (9th Cir. 2006) (stating that "although California law recognizes an assertable interest in the publicity associated with one's voice, we think it is clear that federal copyright law preempts a claim alleging misappropriation of one's voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium"); *Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1448 (11th Cir. 1998) (indicating that "Copyright law, for example, does not exist merely to protect the tangible items, such as books and paintings, in which the underlying expressive material is embodied; rather, it protects as well the author's or artist's particular expression that is included in the tangible item"); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 839-40 ("right to publicity may be subject to federal preemption where it conflicts with the provisions of the Copyright Act of 1976").