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# PUBLICITY DILUTION: A PROPOSAL FOR PROTECTING PUBLICITY RIGHTS

Sarah M. Konsky†

## I. INTRODUCTION

The right of publicity prohibits commercial use of a person's name or likeness without the person's consent.<sup>1</sup> The right is grounded in property rationales and is supposed to safeguard the economic value of a person's name or likeness against commercial exploitation,<sup>2</sup> however, the current right of publicity goes much farther. Courts have read the protection of a use of a name or likeness broadly, allowing recovery for everything from the use of a robotic depiction of a celebrity to the use of a comedian's catchphrase.<sup>3</sup> A nonfamous person can recover under the right even though her persona does not have an inherent economic value.<sup>4</sup> In some cases, a person can recover without showing actual economic injury to her persona.<sup>5</sup> The result is an extremely broad right of publicity, in which a person can recover for commercial uses of almost anything associated with her identity.

The right of publicity has become too unwieldy and overbroad, and it goes beyond its purpose of protecting the underlying economic

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1. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

2. See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977); *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). For a discussion of the different property rationales, see *infra* Part II.A.

3. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992) (holding the use of robot dressed to look like Vanna White and depicted on game show set violated White's right of publicity); *Carson v. Here's Johnny Portable Toilets, Inc.* 698 F.2d 831 (6th Cir. 1983) (holding the use of Carson's catchphrase "Here's Johnny" as the name of a business violated Carson's right of publicity).

4. See Alicia M. Hunt, Comment, *Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 NW. U. L. REV. 1605, 1621-23 (2001).

5. See generally 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:1 (4th ed. 1997) (stating that a likelihood of some harm is sufficient).

value in a person's name or likeness.<sup>6</sup> Further, the expansive right chills valuable speech that would otherwise be protected under the First Amendment. The current right of publicity curbs society's entitlements under the First Amendment to invoke the names and likenesses of cultural icons.<sup>7</sup> Many appropriations contain both commercial and noncommercial speech, and therefore do not automatically warrant the lower level of protection given to purely commercial speech under the First Amendment.<sup>8</sup>

This paper proposes a new standard of right of publicity dilution based on trademark dilution law. The Federal Trademark Dilution Act ("FTDA") prohibits commercial use of a famous mark that dilutes the mark's economic value.<sup>9</sup> The FTDA strikes an optimal balance by preventing use of a mark that harms property interests, while allowing more benign use of the mark. The FTDA's three key requirements of a famous mark, a commercial use, and actual dilution<sup>10</sup> should be applied in publicity cases. The FTDA standard would strike an optimal balance between protecting a celebrity's economic value and protecting the public's interest in speaking about its cultural icons.

Part II explains the origins and current status of the right of publicity. Part III provides a general summary of trademark law and a detailed analysis of the FTDA. Part IV proposes a new right of publicity dilution modeled on trademark dilution law. The argument for a new right of publicity dilution law proceeds in several parts. First, the current right of publicity is overprotective and inconsistent with the rationales behind the right. Second, a right of publicity dilution modeled after trademark dilution law would provide an optimal balance between preventing uses that cause economic harm and allowing free dialogue about cultural icons. The key requirements of this right of publicity dilution are a famous mark, a use in commerce, and actual dilution. Finally, an application of the right of publicity dilution to past cases illustrates that the proposed right provides an ideal level of publicity protection.

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6. See generally Vincent M. de Grandpré, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73 (2001).

7. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 65-68 (1994).

8. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

9. 15 U.S.C. § 1125(c) (2000).

10. *Id.*

## II. RIGHT OF PUBLICITY

The right of publicity is a relatively new right that was first adopted by a court in 1953.<sup>11</sup> Currently, the right of publicity prohibits unauthorized commercial use of a person's name or likeness.<sup>12</sup> To critically evaluate the right of publicity, it is necessary to understand the origins and justifications for publicity protection, the relevant statutory and common law bases of the right, and the current application of the right in case law.

### *A. Origins and Theoretical Background*

Early foundations for the right of publicity were based in the right of privacy.<sup>13</sup> Prosser listed appropriation, which protects against the use of another's name or likeness for the benefit of the user, as one of the four privacy torts.<sup>14</sup> The privacy rationale suggests that unauthorized uses of a person's name or likeness will offend the person's dignity by exploiting her identity.<sup>15</sup> For example, a person who unexpectedly finds herself depicted in an advertisement may suffer harms traditionally associated with an invasion of privacy—from a violation of her right to be left alone to an invasion of her inviolate personality.<sup>16</sup>

However, most courts and commentators now ground the right of publicity in property rationales. In the first case to adopt the right of publicity, the Second Circuit stated that "it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."<sup>17</sup> Several strands of the property-rights rationale have emerged. One common argument is that the right is grounded in an

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11. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

12. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

13. *See* J. Thomas McCarthy, *Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 UCLA L. REV. 1703, 1704-07 (1987).

14. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960). Prosser identified the four privacy torts as public disclosure of private facts, intrusion upon seclusion, false light, and appropriation of name or likeness. *Id.*

15. *See* DANIEL J. SOLOVE & MARC ROTENBERG, *INFORMATION PRIVACY LAW* 162 (Aspen 2003).

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

17. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

incentive to produce; in essence, a Lockean labor theory.<sup>18</sup> Protection of a person's name and likeness against commercial use gives the person an incentive to develop a public and famous persona. As the Supreme Court stated, "the State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment."<sup>19</sup> A second argument is that the right of publicity prevents a congestion externality.<sup>20</sup> Unrestricted use of a person's name or likeness makes that name or likeness less scarce and thus, less valuable.<sup>21</sup> Similarly, it can create consumer confusion about which uses are authorized by the person.<sup>22</sup> A third argument for the right of publicity is unjust enrichment.<sup>23</sup> A commercial user should not be able to benefit from a person's investment in developing a public and famous persona.<sup>24</sup> Finally, an alternative argument is that the right of publicity should be an inherent right.<sup>25</sup> Under this view, the right of publicity should be "viewed as a property right grounded in human autonomy" that should extend to all people regardless of fame.<sup>26</sup>

### *B. Right of Publicity Law*

Today, more than half of the states recognize a right of publicity, either as a matter of statutory or common law.<sup>27</sup> The Restatement (Third) of the Law of Unfair Competition has also adopted a right of publicity.<sup>28</sup> Under the Restatement, a violation of the right occurs when one "appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade."<sup>29</sup> A comment to the Restatement states that the right "allows a person to prevent harmful or excessive

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18. See Kwall, *supra* note 7, at 79–80.

19. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

20. See Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621, 634 (2003).

21. See *Id.*

22. See Kwall, *supra* note 7, at 75–79.

23. See *Zacchini*, 433 U.S. at 576; Kwall, *supra* note 7, at 80.

24. See *Zacchini*, 433 U.S. at 576.

25. See Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 385–86 (1999).

26. See *id.* at 385.

27. 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 6:3 (2d ed. 2000).

28. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

29. *Id.*

commercial use that may dilute the value of the identity.”<sup>30</sup> This comment suggests that dilution is a concern motivating the right of publicity. A plaintiff’s remedies for infringement of the right of publicity include injunctions, actual damages, and punitive damages.<sup>31</sup>

A state right of publicity was recognized one time by the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>32</sup> The case involved a human cannonball, whose fifteen-second performance consisted of him being shot into a net two hundred feet away.<sup>33</sup> A television reporter filmed the performance, and the reporter’s station aired it in its entirety.<sup>34</sup> The Court affirmed that the use of the human cannonball’s performance violated his right of publicity under state law.<sup>35</sup> However, this holding is quite limited and does little to delineate the scope of the right of publicity. The Court was concerned that the broadcast of the entire act would threaten the economic value of the performance;<sup>36</sup> it might not have reached the same conclusion if less than the entire act were appropriated.

Despite the lack of Supreme Court precedent, the right of publicity has been adopted by a myriad of lower courts. A paradigm violation of the right of publicity occurs when a company uses the name or likeness of a celebrity to make its product more attractive to the public. For example, a professional hockey player could recover under the right of publicity if a comic book author named a character after the player without the player’s authorization.<sup>37</sup> Similarly, fashion model Christie Brinkley could recover under the right of publicity if a publisher made and distributed posters of her image without her consent.<sup>38</sup> These clear-cut cases easily meet the requirements of the right of publicity tort: a person’s name or likeness was used in commerce without the person’s authorization.<sup>39</sup>

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30. *Id.* § 46 cmt. c.

31. *Id.* at §§ 48–49; see also Matthew Savare, Comment, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 149–59 (2004) (discussing the different state law remedies for infringement of the right of publicity).

32. 433 U.S. 562 (1977).

33. *Id.* at 562–63.

34. *Id.* at 564, 569.

35. *Id.* at 578.

36. *Id.* at 575–76.

37. *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (en banc).

38. See *Brinkley v. Casablanca*, 438 N.Y.S.2d 1004 (N.Y. App. Div. 1981).

39. See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

The lower courts have attempted to define the contours of the right of publicity in more difficult cases. Two aspects of the tort have led to much litigation. First, courts have had to decide what constitutes the use of a person's identity for purposes of the statute. Right of publicity statutes or common law rights typically prohibit the use of a person's name or likeness.<sup>40</sup> However, courts have taken an expansive view of what constitutes an appropriation of identity and have allowed right of publicity causes of action for use of a person's nickname,<sup>41</sup> use of a caricature or robot portraying a person,<sup>42</sup> use of an inanimate object closely associated with a person,<sup>43</sup> use of the name of a fictional character closely associated with a person,<sup>44</sup> and use of a person's famous catchphrase.<sup>45</sup> Second, courts have struggled to determine what constitutes a commercial use or a use for purposes of trade.<sup>46</sup> Courts have developed several tests for determining when expressive works, such as artwork or songs, naming or depicting a celebrity, should be entitled to protection.<sup>47</sup> Arguably, these line-drawing difficulties are inherent in a right protecting a person's name or likeness.

The right of publicity has grown immensely since its first adoption by courts fifty years ago. Courts have struggled to determine the outer limits of protection under the right of publicity. Scholars

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40. See, e.g., *id.* (protecting name, likeness and indicia of identity); see also CAL. CIV. CODE § 3344 (Deering Supp. 2004) (protecting name, photograph or likeness); N.Y. CIV. RIGHTS LAW § 51 (McKinney Supp. 2004) (protecting name, portrait, picture or voice).

41. See *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979) (holding a cause of action for appropriation where famous football player Elroy Hirsch's nickname "Crazylegs" was used on shaving gel products).

42. See *White v. Samsung Elecs. Am., Inc.* 971 F.2d 1395 (9th Cir. 1992) (holding the use of robot dressed to look like Vanna White and depicted on game show set violated White's right of publicity).

43. See *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (holding the use of distinctive racing car associated with a famous driver constituted a use of the driver's name or likeness).

44. See *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1993) (holding the use of the name of character "Spanky McFarland" could violate the right of publicity of the actor who played that character).

45. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (holding the use of Carson's catchphrase "Here's Johnny" as the name of a business violated Carson's right of publicity).

46. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (holding painting of Tiger Woods was protected by the First Amendment); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (holding that song entitled "Rosa Parks" was not protected by the First Amendment); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (holding that parody of a movie still was protected by the First Amendment).

47. For a discussion of the different tests, see *ETW Corp.*, 332 F.3d at 931-36.

argue the right is unwieldy and overprotective.<sup>48</sup> Nevertheless, the judicial and legislative trend is toward recognizing a publicity right of some sort. This paper proposes a shift to a more limited publicity right that protects the economic value of a person's name and likeness.

### III. TRADEMARK DILUTION

The primary purpose of trademark law is to "reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods."<sup>49</sup> A trademark is an identifying marker a manufacturer puts on a product—for example, COCA-COLA soft drinks or VOLKSWAGEN cars. Trademark law addresses attempts by secondary users to capitalize on the goodwill associated with a trademark. An overview of trademark law must include a brief explanation of the two types of trademark protection, trademark infringement law and trademark dilution law. The proposed right of publicity is based on the Federal Trademark Dilution Act ("FTDA"). Therefore, it is necessary to examine the requirements of the FTDA in detail.

#### *A. Trademark Protection: Infringement and Dilution*

The traditional means for protecting a trademark is a trademark infringement action under the Lanham Act.<sup>50</sup> Infringement law is motivated by a concern about consumer fraud, and therefore requires a showing of consumer confusion.<sup>51</sup> A paradigm case of trademark infringement occurs when a secondary user tries to pass her goods off as being associated with a primary user by appropriating the primary user's trademark. For example, a company might sell HERSHEY potato chips, hoping that consumers will think their product is made by the HERSHEY candy company. Trademark law thus protects the symbols that indicate the source of a good or service.<sup>52</sup>

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48. For a discussion of these criticisms, see e.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993); Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART. & ENT. L. 227 (1999).

49. Ty, Inc. v. Perryman, 306 F.3d 509, 510 (7th Cir. 2002) (Posner, J.).

50. 15 U.S.C. § 1125(a) (2000).

51. *Id.*

52. Kathleen B. McCabe, *Dilution-by-Blurring: A Theory Caught in the Shadow of Trademark Infringement*, 68 FORDHAM L. REV. 1827, 1836 (2000).

In 1996, Congress changed the landscape of trademark protection by passing the FTDA.<sup>53</sup> Unlike a trademark infringement action, a trademark dilution action can be brought in the absence of consumer confusion about the goods.<sup>54</sup> Trademark dilution law is concerned with protecting a trademark owner against uses that “whittle away” the value of the mark, diminishing its uniqueness.<sup>55</sup> As the House Report to the FTDA stated, dilution “applies when the unauthorized use of a famous mark reduces the public’s perception that the mark signifies something unique, singular, or particular.”<sup>56</sup> Thus, dilution is substantially broader than infringement; it only requires harm to the value of the trademark.

Generally, trademark dilution occurs when marks are blurred or tarnished.<sup>57</sup> Blurring occurs when a mark is associated with an unrelated product, regardless of consumer confusion.<sup>58</sup> For example, the House Report to the FTDA stated that “the use of DUPONT shoes, BUICK aspirin, and KODAK pianos” would be prohibited under the FTDA.<sup>59</sup> A key harm of blurring is that consumer search costs increase when a trademark is associated with a number of unrelated products.<sup>60</sup> Tarnishment occurs when a mark is associated with something unsavory.<sup>61</sup> A tarnishing use dilutes a trademark by causing consumers to associate negative connotations with the mark.

### *B. Federal Trademark Dilution Act*

The FTDA states that “the owner of a famous mark shall be entitled . . . to an injunction against another person’s commercial use in commerce of a mark or trade name, if such use begins after the

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53. 15 U.S.C. § 1125(c) (2000).

54. *See id.*

55. *See* Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927). Schechter’s article is the seminal article of the dilution movement.

56. H.R. REP. NO. 104-374, at 3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1030.

57. *See* Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 431 (2003) (citing H.R. REP. NO. 104-374, at 3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1030).

58. *See id.*; *see also* Ty, Inc. v. Perryman, 306 F.3d 509, 511–12 (7th Cir. 2002) (Posner, J.).

59. H.R. REP. NO. 104-374, at 3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1030.

60. Ty, Inc., 306 F.3d at 511 (Posner, J.). Judge Posner discusses the problem with a restaurant called Tiffany’s:

[W]hen consumers next see the name “Tiffany” they may think about both the restaurant and the jewelry store, and if so the efficacy of the name as an identifier of the store will be diminished. Consumers will have to think harder—incur as it were a higher imagination cost—to recognize the name as the name of the store.

*Id.*

61. *See infra* Part III.B.3.

mark has become famous and causes dilution of the distinctive quality of the mark.”<sup>62</sup> Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”<sup>63</sup> The FTDA exempts fair use in comparative commercial advertising,<sup>64</sup> noncommercial use,<sup>65</sup> and use in news reporting and news commentary.<sup>66</sup>

### 1. Distinctive and Famous Mark Requirements

To qualify for protection under the FTDA, a mark must be distinctive and famous.<sup>67</sup> The distinctiveness requirement ensures that generic terms simply naming the product they represent are not protected because such protection would strip competitors of the right to refer to their products by name.<sup>68</sup> Courts differentiate several levels of distinctiveness and ultimately grant the most protection to arbitrary or fanciful marks having no logical relationship to the product they identify.<sup>69</sup>

Legislative history suggests that Congress intended to single out the most famous marks for protection.<sup>70</sup> Indeed, courts have stated that they should be “discriminating and selective” in deciding which marks are famous.<sup>71</sup> The FTDA lists eight factors that a court may consider in declaring a mark famous, including the distinctiveness of the mark, the duration of the use of the mark, the degree of recognition of the mark, and the existence of other similar marks.<sup>72</sup>

62. 15 U.S.C. § 1125(c)(1) (2000).

63. *Id.* § 1127.

64. *Id.* § 1125(c)(4)(A).

65. *Id.* § 1125(c)(4)(B).

66. *Id.* § 1125(c)(4)(C).

67. *Id.* § 1125(c).

68. *See, e.g.,* Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 215 (2d Cir. 1999).

69. *Id.* at 216.

70. *See* DAVID S. WELKOWITZ, TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW 176 (BNA Books 2001).

71. I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 46 (1st Cir. 1998).

72. 15 U.S.C. § 1125(c)(1) (2000).

In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to—(A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographic extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition

The FTDA requires that the mark be famous at the time of the alleged diluting use.<sup>73</sup>

A more difficult inquiry is whether a mark can meet the fame requirement if it is famous in a limited geographic market or in a niche market. Citing the legislative history of the FTDA, courts have agreed that fame cannot be local.<sup>74</sup> Courts have split on whether marks famous in niche markets meet the fame requirement.<sup>75</sup> The Seventh Circuit has opined that the outcome of these cases turns on whether the plaintiff and defendant are using the mark in the same niche market; if so, the mark meets the fame requirement.<sup>76</sup> Thus, in some cases a plaintiff might be able to meet the fame requirement by showing fame in a niche market.

## 2. Use in Commerce Requirement.

The FTDA's prohibition of trademark dilution could potentially bar a good deal of speech otherwise protected by the First Amendment. To minimize First Amendment concerns, the FTDA is limited to commercial use<sup>77</sup> and explicitly exempts noncommercial use of a trademark.<sup>78</sup> Thus, the FTDA only reaches commercial speech, which the Supreme Court has held is entitled to a low level of protection under the First Amendment.<sup>79</sup>

In many cases, the noncommercial use exemption will be straightforward. An example of a clearly commercial use is the appropriation of the famous TIFFANY mark for the name of a

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of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered . . . .

*Id.*

73. *Id.*

74. *See, e.g.,* *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 640-41 (7th Cir. 1999). "The legislative history of the statute makes clear that Congress intended that, in order to be 'famous,' a mark must be used in a substantial segment of the United States." *Id.* at 641 n.7.

75. *Compare id.* at 641 (concluding that the fame in a niche market could satisfy the fame requirement when both the defendant and the plaintiff used the mark in the same niche market) *with* *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 99 (2d Cir. 2001) (concluding it is unlikely Congress intended to protect marks famous only in niche markets).

76. *Syndicate Sales*, 192 F.3d at 640.

77. *See* 15 U.S.C. § 1125(c)(1) (2000).

78. *Id.* §§ 1125(c), 1125(c)(4)(B).

79. *See, e.g.,* *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 562-63 (1980).

business unrelated to the famous jewelry store.<sup>80</sup> In contrast, an example of a clearly noncommercial use is the use of the famous TIFFANY mark in a history textbook's discussion about famous jewelry stores. Other cases are more difficult. For example, courts disagree about whether mixed speech with both commercial and noncommercial elements should fall within the FTDA's noncommercial use exemption.<sup>81</sup>

### 3. Actual Dilution Requirement

The FTDA requires that the use "causes dilution of the distinctive quality of the mark."<sup>82</sup> The Supreme Court recently held that a plaintiff must show actual dilution of the mark, rather than a mere likelihood of dilution.<sup>83</sup> However, the Court did not define actual dilution. At one extreme, it is not enough that the use of the junior mark conjures up mental associations of the famous mark.<sup>84</sup> At the other extreme, it is not required that the user of the senior mark prove the consequences of dilution, such as lost profits.<sup>85</sup> The Court left open the possibility that circumstantial evidence of actual dilution could be sufficient in cases where it would be reliable, notably in cases where the senior mark and junior mark are identical.<sup>86</sup> Commentators have speculated that the actual dilution requirement may deter plaintiffs from suing under the FTDA, as the requirement raises the plaintiff's burden of proof.<sup>87</sup>

Courts recognize two main types of dilution: blurring and tarnishment. Blurring is described as the whittling away of a well-

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80. *Tiffany & Co. v. Tiffany Prod., Inc.*, 264 N.Y.S. 459 (N.Y. Sup. Ct. 1932).

81. *Compare* *Planned Parenthood Fed. of Am. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. 1997) (concluding that commercial speech is speech containing a commercial element) *with* *Mattel, Inc., v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002) (concluding that commercial speech is speech that "does no more than propose a commercial transaction"). For a discussion of this split, see Patrick D. Curran, Comment, *Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077 (2004).

82. 15 U.S.C. § 1125(c) (2000).

83. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433–34 (2003).

84. *See id.*

85. *Id.*

86. *Id.*

87. Brian A. Jacobs, Note, *Trademark Dilution on the Constitutional Edge*, 104 COLUM. L. REV. 161, 183–84 (2004) (noting that the actual dilution standard will require FTDA plaintiffs to incur the expense of obtaining consumer surveys, circumstantial evidence, or other proof of actual dilution). *But see* *Moseley*, 537 U.S. at 434 ("Whatever difficulties of proof may be entailed, they are not an acceptable reason for dispensing with proof of an essential element of a statutory violation.").

known mark's distinctiveness.<sup>88</sup> A significant harm of blurring is that the consumer incurs higher search costs; even if the consumer is not confused by the multiple sources of the mark, the consumer must still ask to which source the use of the mark refers.<sup>89</sup> Courts have adopted a wide variety of multi-factor tests to measure blurring.<sup>90</sup> Some courts have adopted the test proposed by Judge Sweet in his *Mead Data Central, Inc., v. Toyota Motor Sales, U.S.A., Inc.*<sup>91</sup> concurrence that examines the similarity of the marks, the similarity of the products, sophistication of the consumers, predatory intent, renown of the senior mark, and renown of the junior mark.<sup>92</sup> In contrast, the Second Circuit declines to set forth a definitive set of factors, instead providing a nonexhaustive list of relevant factors to consider, including "actual confusion and likelihood of confusion, shared consumers and geographic isolation, the adjectival quality of the junior use, and the interrelated factors of duration of the junior use, harm to the junior user, and delay by the senior in bringing the action."<sup>93</sup> The Seventh Circuit examines only two factors, the renown of the senior mark and the similarity of the marks.<sup>94</sup> Thus, there is little agreement between courts about the ideal test for trademark dilution. Ultimately, blurring cases appear to turn on the fame of the senior mark, the similarity of the marks, and consumer confusion. In some ways, the dilution inquiry resembles the confusion inquiry in trademark infringement law.<sup>95</sup> If confusion exists, then dilution likely exists, because "[c]onsumer confusion would undoubtedly dilute the distinctive selling power of [the] trademark."<sup>96</sup> Thus under the FTDA, confusion can be seen as a sufficient, but not as a necessary condition for a finding of dilution.<sup>97</sup>

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88. See *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1028–29, 1031 (2d Cir. 1989).

89. See *Ty, Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) (Posner, J.).

90. For a discussion of the competing approaches, see Gerard N. Magliocca, *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949, 984–86 (2001).

91. 875 F.2d 1026 (2d Cir. 1989).

92. *Id.* at 1035 (Sweet, J., concurring). For a discussion of the test and a list of the courts adopting the test, see WELKOWITZ, *supra* note 70, at 247–48.

93. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 227–28 (2d Cir. 1999). For a discussion of the test and a list of the courts adopting the test, see WELKOWITZ, *supra* note 70, at 248–50.

94. *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 468 (7th Cir. 2000).

95. See WELKOWITZ, *supra* note 70, at 256.

96. *Nabisco, Inc.*, 191 F.3d at 219.

97. See *id.*

A subset of blurring is tarnishment: degrading a mark's positive associations by linking the mark with unsavory products or ideas.<sup>98</sup> Tarnishment often occurs when the senior mark is associated with something unwholesome and can occur when the senior mark is associated with poor quality goods.<sup>99</sup> For example, tarnishment of the Budweiser mark occurred when a junior user sold BUTTWISER merchandise.<sup>100</sup>

Trademark dilution law has been the subject of criticism.<sup>101</sup> As the preceding discussion suggests, courts have struggled to read specific requirements into the rather vague language of the FTDA. Courts have not settled on tests for noncommercial use or dilution. However, these shortcomings do not mean that trademark dilution law is flawed in concept. Rather, the shortcomings could simply indicate that Congress or the Supreme Court needs to clarify the boundaries of this new area of the law.

#### IV. PUBLICITY DILUTION PROPOSAL

The current right of publicity should be replaced with a right of publicity dilution, similar to trademark dilution law. A right of publicity dilution would prohibit the most harmful uses of a person's name or likeness without chilling valuable commentary. This argument proceeds in several parts. First, criticism of the current right of publicity illustrates the need to amend the right of publicity. Second, a publicity dilution right modeled after trademark dilution law would create an ideal standard. Third, it is necessary to set out the precise contours of the publicity dilution right. It is also useful to examine the difficult cases that could arise under the proposed standard and to propose alternative avenues of recourse for people who cannot recover under the standard. Finally, an application of the proposed right of publicity dilution to different cases illustrates that the publicity dilution right provides an optimal level of protection.

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98. There is debate about whether tarnishment should be part of the dilution analysis. While tarnishment was part of many state antidilution statutes and was mentioned in the legislative history to the FTDA, a tarnishment action might not be supported by the text of the FTDA. For a discussion, see *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003).

99. See WELKOWITZ, *supra* note 70, at 265.

100. *Anheuser-Busch, Inc. v. Andy's Sportswear, Inc.*, 40 U.S.P.Q.2d (BNA) 1542 (N.D. Cal. 1996).

101. See, e.g., Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789 (1997); Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 460 (1994).

### *A. Criticism of the Right of Publicity*

The right of publicity has been subject to much criticism.<sup>102</sup> First, differing state right of publicity standards create undesirable inconsistencies in the law. Commentators argue a uniform federal standard is needed.<sup>103</sup> Without a uniform standard, a person wanting to use another's name or likeness must undertake a time-consuming examination of the publicity laws of the different states.<sup>104</sup> Similarly, a person's ability to recover for an unauthorized use of her likeness varies depending on the state in which she sues.<sup>105</sup> Inconsistent state law may also encourage forum shopping, in which litigants seek the forum with the most sympathetic laws to their positions.<sup>106</sup> Thus, differences among state right of publicity statutes may cause practical problems for both potential users of a person's name or likeness and people attempting to vindicate their publicity rights.

Courts have recognized that the right of publicity carries a risk of infringing on First Amendment rights.<sup>107</sup> Much commentary on the right of publicity addresses the proper balance between the right and the First Amendment.<sup>108</sup> Commentators argue that the right of publicity can be too broad, prohibiting expression that should be protected under the First Amendment.<sup>109</sup> This problem is alleviated in part by the fact that the right only regulates commercial use of a person's name or likeness. Commercial speech is afforded a low level of protection under the First Amendment, and therefore can be subject to regulations that political speech cannot.<sup>110</sup> However, many appropriations contain both commercial and noncommercial elements and thus, do not automatically warrant a low level of First

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102. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of petition for rehearing en banc and arguing that the right of publicity is overprotective of celebrities' images); Madow, *supra* note 48 (arguing that the rationales for the right of publicity are not compelling).

103. See, e.g., Goodman, *supra* note 48.

104. *Id.* at 228.

105. *Id.*

106. *Id.* at 244. Forum shopping may also make it difficult for parties to inform themselves *ex ante* about publicity rights. To make informed decisions, parties must know about the laws of all of the states. *Id.*

107. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003).

108. See, e.g., Kwall, *supra* note 7; Madow, *supra* note 48, at 134-46.

109. See Kwall, *supra* note 7.

110. See *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557 (1980) (holding that truthful advertising could be regulated if regulation furthers a substantial government interest and is not overbroad).

Amendment protection.<sup>111</sup> Further, the current right of publicity curbs society's entitlements under the First Amendment to invoke the names and likenesses of cultural icons.<sup>112</sup> Thus, the right of publicity can chill valuable speech.

Further, critics of the right of publicity argue that the right is overprotective.<sup>113</sup> The right of publicity is intended to protect a person's proprietary and financial interests in her identity.<sup>114</sup> However, the right goes far beyond the goal of protecting proprietary and financial interests. First, a majority of courts hold that the right of publicity protects the names and likenesses of all people, regardless of fame.<sup>115</sup> Nonfamous people may not have significant proprietary or financial interests in their names or likenesses. Rather, their objections to the use of their names or likenesses may be grounded only in privacy rationales, such as injury to their mental and emotional well-being.<sup>116</sup> Further, a plaintiff alleging a right of publicity violation is not required to show actual damages; a likelihood of some damage is sufficient.<sup>117</sup> In the absence of an identifiable loss, a showing of unjust enrichment may be enough for recovery.<sup>118</sup> The right of publicity, thus, is overinclusive, going beyond its goal of protecting the economic value of a person's name or likeness.

Similarly, some critics question the utility of a broad right of publicity.<sup>119</sup> A comment to the Restatement (Third) of Unfair Competition lays out many of the criticisms:

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111. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

112. See *Kwall*, *supra* note 7, at 65–68 (“Society’s entitlement to invoke the personas of our cultural icons is substantially diminished in the context of patently commercial appropriations.”).

113. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of petition for rehearing en banc); de Grandpré, *supra* note 6.

114. Kenneth E. Spahn, *The Right of Publicity: A Matter of Privacy, Property, or Public Domain?*, 19 NOVA L. REV. 1013, 1014 (1995).

115. See *Hunt*, *supra* note 4, at 1621–23. Under this view, the plaintiff’s fame goes to the amount of damages, but not to the existence of the right. *Id.* at 1621.

116. See *Spahn*, *supra* note 114, at 1025. For a discussion of the interests of non-famous persons, see *infra* Part IV.C.2. See, e.g., *Hunt*, *supra* note 4; *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824–25 n.11 (9th Cir. 1974).

117. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:1 (4th ed. 1997).

118. See 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 11.8[B]–[C] (West 1999).

119. See generally *Madow*, *supra* note 48, at 134–46.

The rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets. The commercial value of a person's identity often results from success in endeavors such as entertainment or sports that offer their own substantial rewards. Any additional incentive attributable to the right of publicity may have only marginal significance. In other cases the commercial value acquired by a person's identity is largely fortuitous or otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection . . . . Thus, courts may be properly reluctant to adopt a broad construction of the publicity right.<sup>120</sup>

This criticism suggests that the right of publicity may not be adequately tailored to meet its end goal of protecting the economic value of a person's name or likeness.

#### *B. Trademark Dilution Law Provides the Correct Level of Protection*

A dilution standard provides ample protection against uses that cause economic damage, but does not silence other valuable speech. The current right of publicity should be replaced by a publicity dilution right similar to trademark dilution law. This right could develop in three different ways. First, Congress could amend the FTDA to include personas. Under this standard, a person's name or likeness would be entitled to the same protection as a trademark. Alternatively, Congress could pass a separate publicity dilution statute modeled on the FTDA. This scheme is preferable, because it gives Congress more latitude to consider unique situations that may arise in the publicity context, but not in the trademark context. Congress should have the power to enact such regulations under the Commerce Clause of the United States Constitution.<sup>121</sup> Finally, judges could simply begin to apply the FTDA or dilution standards in publicity cases. However, legislative history suggests that Congress did not intend for the FTDA to cover names, likenesses, or

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120. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995).

121. U.S. CONST. art. I, § 8, cl. 3 (giving Congress the power "[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes"). Congress has the authority to regulate trademarks under the Commerce Clause. It follows that Congress should have the authority to regulate similar uses of personas. For a discussion of Congressional authority to enact a federal right of publicity, see Goodman, *supra* note 48, at 240.

identities.<sup>122</sup> Therefore, Congressional action probably is preferable to judicial action in this case.

The publicity dilution standard would be a significant departure from the current state of trademark law. Celebrities have some recourse under trademark law when their names or likenesses rise to the level of a trademark.<sup>123</sup> However, courts have taken a narrow view of what constitutes a celebrity's trademark, typically limiting trademark protection to a celebrity's name and most famous depictions.<sup>124</sup> As it stands, trademark law is not equipped to subsume the right of publicity.<sup>125</sup> The limited protection afforded to celebrities under trademark law is insufficient to protect a celebrity's persona from economic harm.

Therefore, Congress should expand upon existing trademark dilution law to create a new right of publicity dilution, either by amending the FTDA or passing a new statute. First, Congress should recognize the similarities between trademark protection and publicity protection. Commentators have noted the similarities between the right of publicity and trademark dilution law<sup>126</sup> and have proposed using aspects of trademark law in right of publicity cases.<sup>127</sup> Trademarks are symbols that represent the source of goods or services. Trademark dilution law ensures that secondary uses of these symbols do not dilute the power of the symbol to represent the source

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122. See WELKOWITZ, *supra* note 70, at 215.

123. See *Parks v. LaFace Records*, 329 F.3d 437, 445–47 (6th Cir. 2003) (compiling trademark infringement cases involving the use of celebrity's name or likeness). For a discussion of what constitutes a trademark, see *infra* Part IV.C.1.

124. See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003) (holding that “as a general rule, a person's image or likeness cannot function as a trademark”); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990) (holding 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”). *But see ETW Corp.*, 332 F.3d at 941–42 (Clay, J., dissenting) (arguing that “the jurisprudence clearly indicates that a person's image or likeness can function as a trademark as long as there is evidence demonstrating that the likeness or image was used as a trademark”).

125. See, e.g., Haemmerli, *supra* note 25, at 393–401 (illustrating that trademark law would not provide an adequate remedy for a right of publicity violation).

126. See Kristine Boylan, *The Corporate Right of Publicity in Federal Trademark Dilution Legislation*, 88 TRADEMARK REP. 349 (1998) (arguing that the FTDA in effect creates a right of publicity for corporations); Malte Farnaes, “Trademark Law” Caught in Love Triangle with “Right of Publicity”: *Eastwood v. Superior Court*, 12 J. CONTEMP. LEGAL ISSUES 568 (2001) (briefly noting that right of publicity claims often resemble dilution claims).

127. For the argument that trademark infringement should be amended to cover right of publicity claims, see Haemmerli, *supra* note 25. For the argument that the right of publicity should be extended to cover instances of tarnishment, see Edgar Sargent, *Right of Publicity Tarnishment and the First Amendment*, 73 WASH. L. REV. 223 (1998).

of the good. Similarly, a person's name or likeness serves as a powerful symbol representing the underlying product of the persona or the person's endorsement.<sup>128</sup> The law should protect against any secondary use of a person's name or likeness that dilutes the value of the underlying persona or the person's endorsement. When a person's name or likeness is associated with a number of products or services, it ceases to be unique and valuable.

Protection of publicity should be centered around its theoretical underpinnings—protection of the economic value of a persona.<sup>129</sup> For illustrative purposes, the right of publicity dilution can be contrasted with privacy protection. The right of publicity concerns itself with injuries to the pocketbook while the right of privacy concerns itself with injuries to the psyche.<sup>130</sup> Therefore, a publicity right should be focused on economic injury. A right of publicity dilution based on FTDA standards would be more consistent with the property rationales underlying publicity protection than the current right of publicity. Under the current right of publicity, a plaintiff may recover without showing actual harm to the economic value of her persona.<sup>131</sup> A plaintiff may also be able to recover without showing that her persona is famous and inherently valuable.<sup>132</sup> However, under the proposed publicity dilution standard, a plaintiff will have to show actual dilution to a valuable persona. Thus, the proposed new cause of action for publicity dilution is significantly more restrictive than the current right of publicity. For that reason, the proposed publicity dilution should preempt the current right of publicity.<sup>133</sup> Thus, the FTDA standards should be adopted in lieu of the current publicity test. The specific requirements of the FTDA standards will be explored in the following section.

128. At first glance, a person's name or likeness may seem too inextricably intertwined with a person to function as a trademark. One could argue that a person's name or likeness are not symbols representing a person, but rather part and parcel with the person. But in the commercial realm, product names and likenesses conjure up equally powerful associations with the underlying product. Arguably, the strength of association between a popular trademark and its underlying product is no weaker than the association between a name of a celebrity and the celebrity.

129. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

130. 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:61 (2d ed. 2000).

131. See discussion *supra* Part IV.A; see, e.g., 4 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 28:1 (4th ed. 1997); 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11.8[B]–[C] (West 1999).

132. See discussion *supra* Part IV.A; see, e.g., Hunt, *supra* note 4.

133. Some people who would have protection under the current right of publicity will be without protection under the proposed right of publicity dilution. See discussion *infra* Part IV.C.

### *C. Requirements of the Proposed Right of Publicity*

To recover under the right of publicity dilution, a person must meet three requirements: a person must prove that her mark was famous, that it was used in commerce without her authorization, and that the use actually diluted her mark. This section examines these requirements in detail. Specifically, it sets out the relevant standards, discusses difficult cases that may arise and proposes alternate remedies for persons who cannot recover under the relevant standards.

#### 1. Use of a Mark Requirement

Currently, a right of publicity action requires the use of a person's name or likeness.<sup>134</sup> Courts have adopted a broad reading of likeness.<sup>135</sup> The FTDA requires "commercial use in commerce of a mark."<sup>136</sup> This raises the question of what should be considered a mark for purposes of the proposed publicity dilution standard.

The law should adopt trademark standards, with necessary modifications to deal with differences between personas and trademarks. A symbol becomes a trademark either through registration with the Patent and Trademark Office or through sufficient active use of the mark.<sup>137</sup> If Congress amends the FTDA to include personas as trademarks, then famous persons could register their personas. Similarly, if Congress creates a separate cause of action for publicity dilution, it could create a registry of protected personas. However, even in the absence of a registry system, a celebrity persona could become protected through active use of the persona.

A person's name and likeness should constitute a mark, as they are the easiest identifiers of the underlying persona. More difficult cases include whether protection should extend to a person's voice, a caricature of a person, or a symbol associated with a person. Courts should read the mark requirement broadly in the publicity dilution context. The mark inquiry is intrinsically intertwined with the dilution inquiry, which asks whether the person's image was blurred or

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134. *E.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); CAL. CIV. CODE § 3344 (Deering Supp. 2004); *see* discussion *supra* Part II.B.

135. *See* discussion *supra* Part II.B; *see, e.g.*, *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

136. 15 U.S.C. § 1125(c) (2000).

137. *See, e.g.*, *Zazú Designs v. L'Oréal, S.A.*, 979 F.2d 499, 502-03 (7th Cir. 1992).

tarnished. That is, an attenuated mark that does not clearly and specifically identify a person will not blur or tarnish a person's image. An apt example is an advertisement with a caricature that loosely resembles a celebrity.<sup>138</sup> This vague caricature arguably should be considered a use of the celebrity's mark. The attenuated nature of the use will be addressed by a blurring inquiry: If the caricature is not sufficiently similar to the celebrity's image, then the public will not associate the celebrity with the advertisement. Therefore, attenuated use of a person's name or likeness will not blur the person's identity. A broad definition of mark avoids unnecessary duplication of the dilution inquiry.

The mark requirement of the publicity dilution test will be an easy hurdle for a national celebrity to overcome. Virtually any use of a plaintiff's image will constitute a use of a "mark." However, a person who is not nationally known may not be able to meet the fame requirement. The fame requirement is examined in detail in the following section.

## 2. Distinctive and Famous Mark Requirements.

The majority of courts hold that the right of publicity applies to all persons, regardless of fame.<sup>139</sup> To recover under the proposed publicity dilution standard, the mark must be distinct and famous at the time of the alleged infringing use.

### *a. Standard*

First, a court must find that the mark is distinct. Courts have set a high bar for distinctiveness in the trademark context.<sup>140</sup> However, courts must read distinctiveness more broadly in the publicity dilution context. A celebrity's name and likeness are unique to that celebrity and distinguish that celebrity from other people. Therefore, they should be seen as distinct for purposes of publicity dilution. Furthermore, a finding that only the most famous images of a

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138. This example is drawn from the facts of *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726–27, 729 (S.D.N.Y. 1978), which granted a preliminary injunction because plaintiff Mohammed Ali proved he was likely to prevail on the claim that his right of publicity had been violated when Playgirl published a caricature of a nude African-American man in a boxing ring and identified the man in the caricature as "The Greatest."

139. See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); Hunt, *supra* note 4, at 1621–23.

140. See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922–23 (6th Cir. 2003); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 582–85 (2d Cir. 1990); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1363–64 (D.N.J. 1981).

celebrity are protected would lead to absurd results. A famous image of Julia Roberts could not be used in an automobile advertisement, but a nonfamous image of Julia Roberts could be used in the same advertisement. Both cases involve the same exploitation of the distinctiveness of Julia Roberts' image. The distinctiveness requirement should not be difficult to meet in publicity dilution cases. A person's name or likeness will have the requisite distinctiveness to satisfy the requirement.

Publicity dilution law should apply many of the FTDA standards for fame. Concededly, fame is difficult to quantify in any circumstance. However, celebrity lends itself to the famous/nonfamous distinction as well as corporate trademarks do. The eight-factor test for fame set out in the FTDA<sup>141</sup> translates into a useful test for determining the fame of a persona. Specifically, a court examining fame under publicity dilution law should look to: (1) the duration and extent that a person has used her name or likeness in commercial settings;<sup>142</sup> (2) the duration and extent of advertising and publicity of the name or likeness;<sup>143</sup> (3) the geographic area in which the name or likeness is used;<sup>144</sup> (4) the scope of the use of the person's name or likeness;<sup>145</sup> and (5) the degree of recognition of the person's name or likeness.<sup>146</sup> A court should not require that the person be famous on a national level, as is required under trademark dilution law.<sup>147</sup> People are more likely to achieve significant fame locally, but not nationally. For example, local newscasters and politicians are likely to be extremely famous in their communities. Publicity dilution law therefore should protect both locally and nationally famous persons. Further, fame in a niche market may be enough to meet the fame standard in some limited circumstances.<sup>148</sup>

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141. 15 U.S.C. § 1125(c)(1) (2000). For the list of factors, see *supra* note 72.

142. See *id.* § 1125(c)(1)(B) (stating "the duration and extent of the use of the mark in connection with goods or services with which the mark is used").

143. *Id.* § 1125(c)(1)(C) (stating "the duration and extent of the advertising and publicity of the mark").

144. *Id.* § 1125(c)(1)(D) (stating "the geographic extent of the trading area in which the mark is used").

145. *Id.* § 1125(c)(1)(E) (stating "the channels of trade for the goods or services with which the mark is used").

146. *Id.* § 1125(c)(1)(F) (stating "the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought").

147. See, e.g., *supra* Part III.B.1; 15 U.S.C. § 1125(c); *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633 (7th Cir. 1999).

148. See, e.g., *supra* Part III.B.1; *Syndicate Sales*, 192 F.3d at 640-41; *TCPIP Holding Co. v. Harr Communications, Inc.*, 244 F.3d 88, 99 (2d Cir. 2001).

As in the trademark dilution context, courts should set a high bar for famousness. The proposed publicity dilution law should address uses that harm the economic value of a person's name or likeness. Famousness can be used as a screening mechanism to ensure the underlying persona is sufficiently valuable to warrant recovery under the statute.

### *b. Difficult Cases*

In the trademark context, it is safe to assume that the owner of a famous mark wanted the mark to become famous and took concrete steps to make the mark famous. After all, the primary purpose of a trademark is to provide source identification for goods and services.<sup>149</sup> Therefore, the only inquiry in a trademark dilution case is whether the trademark achieved sufficient fame to meet the requirements of the FTDA. Cases involving personal fame are more complicated.

The first difficult case is that of someone who is launched into fame involuntarily and whose image is subsequently diluted by commercial use. It is not safe to assume that a person wanted his name or likeness to become famous. For example, Chicago Cubs fan Steve Bartman became the subject of international fame after he reached out for a foul ball that might otherwise have been caught by Cubs left fielder Moises Alou for a key out in a playoff game.<sup>150</sup> Trademark dilution law does not provide guidance about whether Bartman has the requisite fame to recover for the subsequent use of his name or likeness on apparel or other merchandise.

A person who is involuntarily launched into the spotlight should be considered famous for publicity dilution purposes. The person acquired real fame. The person's persona meets some of the FTDA's eight factors for determining famousness; most significantly, the mark is recognizable on a national basis.<sup>151</sup> Ex post, the person's name or likeness may have the same commercial value as the name or likeness of someone who undertook efforts to become famous. If the right of publicity dilution is about protecting a person's property right in a valuable name or likeness, it should not matter how the persona became famous. As the Ninth Circuit stated in a right of publicity

149. *Ty, Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) (Posner, J.).

150. *Annie Sweeney, et. al., Diehard Cubs Fan Meant No Harm Touching Foul, Supporters Say*, CHI. SUN-TIMES, Oct. 15, 2003, at 2. A Lexis search for "Steve Bartman" yields 1,760 news stories with his name (as of Oct. 29, 2004).

151. *See* 15 U.S.C. § 1125(c)(1) (2000). In addition, the mark may be used to a large extent, the mark may be used in a wide geographic area, and the mark may be used in different channels. *See id.* § 1125(c)(1)(B)-(E).

case, "The law protects a celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof."<sup>152</sup> Similarly, the law provides legal protection for trademarks that have become famous, even if the fame was acquired through chance or through no affirmative act by the trademark holder. The main argument to the contrary is that the person did not invest sufficient resources into developing her name or likeness. Indeed, the requirements for fame set out in the FTDA appear to contemplate some degree of effort toward making the trademark famous.<sup>153</sup> Regardless, finding the requisite fame in this case is consistent with the property rationales behind the right of publicity dilution. Once the person was launched into fame, her name and likeness became valuable property.

The second difficult case is that of someone who becomes famous because of the very use of her name in commerce. The Ninth Circuit recognized this possibility, stating that "the appropriation of the identity of a relatively unknown person may result in economic injury or may itself create economic value in what was previously valueless."<sup>154</sup> For example, a young woman at Mardi Gras was caught on camera flashing her breasts. The image later was used on the "Girls Gone Wild" video, the video's packaging, and other promotional materials.<sup>155</sup> After this use by "Girls Gone Wild," the young woman arguably was famous.

A person cannot recover for publicity dilution when the alleged diluting use launches her into fame. The FTDA requires that the diluting use "begins after the mark has become famous."<sup>156</sup> The FTDA does not take potential for future fame into account. The only relevant inquiry is whether the mark has achieved fame at the time of the commercial use.<sup>157</sup> Admittedly, this temporal requirement can be harsh in its application. Returning to the "Girls Gone Wild" example, the first appropriator of the woman's likeness would not be liable, but

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

153. See 15 U.S.C. § 1125(c)(i) (2000). For example, the FTDA examines the duration and extent of use of the mark in connection with the goods or services with which the mark is used, the duration and extent of the advertising and publicity of the mark, the geographic extent of the trading area in which the mark is used, and the channels of trade for the goods or services with which the mark is used.

154. *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824–25 n.11 (9th Cir. 1974).

155. See *Gritzke v. M.R.A. Holding, LLC*, No. 4:01cv495-RH, 2003 U.S. Dist. LEXIS 9307 (N.D. Fla. Mar. 16, 2003).

156. 15 U.S.C. § 1125(c)(1) (2000).

157. *Id.*

a subsequent appropriator may be liable if the first appropriator sufficiently launched the woman into fame. However, judging fame from an ex post perspective greatly diminishes the fame requirement. The fame requirement would become an empty qualification that would simply turn on the successfulness or popularity of the alleged infringing use. The law arguably should defer to Congress's decision that fame be evaluated at the time of the alleged diluting use.<sup>158</sup>

The third difficult case is that of someone who used to be famous. For example, a former child prodigy might decide to become a recluse in his adulthood, taking great lengths to avoid public attention.<sup>159</sup> There are competing ways to approach whether someone who has abandoned fame should have recourse under the proposed publicity dilution statute. First, the court could make the same inquiry into whether the person was famous at the time of the alleged diluting use. If the person was not famous at that time, he could not recover. However, this approach may have problematic results: A person who was famous and seeks to leave the limelight might never be able to erase her fame.<sup>160</sup> Therefore, courts should adopt the standard for trademark abandonment. Under the Lanham Act, a mark is deemed to be abandoned "when its use has been discontinued with intent not to resume such use."<sup>161</sup> Similarly, a person taking sufficient measures to return to the private life should be seen as having abandoned fame. A person who has abandoned fame would not be able to recover under the publicity dilution standard.<sup>162</sup> Simply put, a person not capitalizing on the economic value of her former fame cannot recover for dilution to that economic value.

158. See *id.* § 1125(c).

159. See *Sidis v. F-R Pub. Corp.*, 113 F.2d 806 (2d Cir. 1940).

160. While this result might be intuitively troubling, it is consistent with a famous right of privacy case. In *Sidis*, the court held that a famous person who became a recluse later in life remained a public figure. *Id.* at 809. Therefore, he did not have recourse under privacy torts for the publication of an unauthorized story about his life. *Id.* at 809–10.

161. 15 U.S.C. § 1127 (2000). Under this section, three years of nonuse of a registered mark is prima facie evidence of abandonment. However, the presumption is frequently rebutted by a registrant's convincing demonstration that she intended to resume use. See BEVERLY W. PATTISHALL, ET AL., TRADEMARKS AND UNFAIR COMPETITION § 4.03 (Lexis Nexis 5th ed. 2002).

162. Note that this solution is not practical unless the law of privacy also recognizes abandonment of fame. Otherwise, a person who had abandoned his fame may have no recourse for invading uses of his image. He could not recover under the new right of publicity dilution because he would not meet the fame requirement. Additionally, he could not recover under the right of privacy because he would not be a private figure. Therefore, both publicity dilution law and privacy law must move together for sensible results.

*c. Recourse for the Nonfamous*

The publicity dilution standard requires that a person be famous at the time of the alleged dilution. Because publicity dilution protects a person's economic worth, the right should not extend to individuals who have not commercially exploited their economic worth.<sup>163</sup> A criticism of this approach is that weaker marks will suffer more from diluting uses. "Having only weakly established their identity in the marketplace, the entrance of other products using the same mark would inhibit their ability to gain a strong foothold in the public's mind as a unique source of the goods."<sup>164</sup> This criticism extends to the use of names or likenesses of people who have only weakly established their identities in the marketplace.<sup>165</sup>

However, nonfamous persons have recourse under other rights, such as the right of privacy. Privacy law is best suited to address use of the names or likenesses of nonfamous persons. While the right of publicity deals with economic injury, the right of privacy deals with injury to the psyche.<sup>166</sup> Thus, privacy law is intended to deal with use of a person's name or likeness that causes emotional harms or offends the expectation of solitude—the very injuries suffered by nonfamous people.<sup>167</sup> Two different privacy torts may protect the rights of nonfamous persons. The tort of intrusion upon seclusion provides a remedy when a person "intentionally intrudes, physically or otherwise, upon the solitude or seclusion of another or his private affairs or concerns" in a way that would be "highly offensive to a reasonable person."<sup>168</sup> The tort of publicity given to private life makes it illegal to "give[] publicity to a matter concerning the private life of

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163. Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1613–16 (1979); see also Hunt, *supra* note 4, (arguing that extending the right of publicity to non-celebrities is inconsistent with the First Amendment).

164. David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531, 540 (1991).

165. For example, the Ninth Circuit has stated that:

Generally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered. However, it is quite possible that the appropriation of the identity of a celebrity may induce humiliation, embarrassment and mental distress, while the appropriation of the identity of a relatively unknown person may result in economic injury or may itself create economic value in what was previously valueless.

*Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824–25 n.11 (9th Cir. 1974).

166. 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:61 (2d ed. 2000).

167. See Hunt, *supra* note 4.

168. RESTATEMENT (SECOND) OF TORTS § 652B (1977).

another" that would be highly offensive to a reasonable person and is not of legitimate concern to the public.<sup>169</sup>

However, this approach might produce a gap in the law. There may be cases in which a nonfamous person's name or likeness is used in commerce, but that person does not have an avenue of recourse under privacy law. An example can be drawn from the facts of *Ainsworth v. Century Supply Co.*<sup>170</sup> A tile layer consented to be filmed by a tile company for an instructional video.<sup>171</sup> The tile company subsequently used his image without consent in an advertisement.<sup>172</sup> The tile layer would not have the requisite fame to recover under the proposed publicity dilution standard. However, the tile layer may also be unable to recover under privacy law. A court may determine that the tile layer does not have a valid tort claim for intrusion upon seclusion or public disclosure of private life because he consented to the initial filming of his image. Thus, the tile layer may be a loser under the proposed new regime.

This gap in the law does not mean that the proposed standard for publicity dilution is flawed. The harm in this case is to the tile layer's solitude and desire for a private life and not to the value of his commercial persona. Therefore, privacy law should be the source of his remedy.<sup>173</sup> Perhaps the tile layer case illustrates a need to expand the current privacy law to cover this type of harm to a person's solitude. Regardless, a nonfamous person should not be allowed to recover for the dilution of his persona, since his persona was not of economic value prior to the use.

### 3. Use in Commerce Requirement

The current right of publicity and trademark dilution law both require that the use be in commerce.<sup>174</sup> Therefore, the commercial use requirement does not constitute a significant change in the law. This requirement is intended to exempt speech that receives heightened protection under the First Amendment from the purview of the

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169. *Id.* § 652D.

170. 693 N.E.2d 510 (Ill. App. Ct. 1998).

171. *Id.* at 511-12.

172. *Id.* at 512.

173. For a discussion of possible remedies for the non-famous, see Hunt, *supra* note 4, at 1653-58.

174. See discussion *supra* Parts II.B, III.B; see, e.g., 15 U.S.C. § 1125(c) (2000); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

statutes.<sup>175</sup> However, this requirement is not always easy to apply. The difficult cases under the FTDA are cases of mixed speech with both commercial and noncommercial elements. Courts have split on how to characterize mixed speech.<sup>176</sup> Courts often consider parody or artwork to be sufficiently noncommercial and outside the scope of trademark dilution law, even if the parody or social commentary is sold for profit.<sup>177</sup> However, other courts have taken a more stringent view of the noncommercial use defense, prohibiting the defense when the speech is sold for profit.<sup>178</sup>

Resolving the ongoing debate about the proper classification of mixed speech under the FTDA is beyond the scope of this paper. Rather, it is sufficient to note that this conundrum in many ways mirrors a similar debate in the right of publicity context.<sup>179</sup> Thus, the shift from a right of publicity to a dilution regime would not make this area of the law any more complicated. If anything, the fame and actual dilution requirements of the proposed publicity dilution action might minimize the number of close cases by imposing a higher bar for recovery.

A person whose image is diluted by a noncommercial use (such as artwork or commentary) must seek recovery in other areas of the law. Possibilities include privacy law and defamation law. However, these actions may be difficult for a plaintiff to win. The plaintiff may hit some of the same hurdles in the privacy context, as some privacy causes of action exempt newsworthy information from privacy protection.<sup>180</sup> Furthermore, defamation cases are difficult for public figures to win. Public figures must show actual malice or reckless disregard for the truth.<sup>181</sup> Therefore, a person who is injured by a noncommercial use of her name or likeness may be without recourse.

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175. See, e.g., 141 CONG. REC. S19312 (Dec. 29, 1995) (statement of Senator Leahy) ("I continue to believe, as our House colleagues also affirm, that parody, satire, editorial, and other forms of expression will remain unaffected by this legislation.").

176. For a discussion of this split, see Curran, *supra* note 81.

177. See, e.g., *Mattel, Inc., v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (holding the popular song "Barbie Girl" was protected by the First Amendment).

178. See, e.g., *Am. Dairy Queen Corp. v. New Line Prod., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998) (holding movie entitled "Dairy Queens" satirizing beauty contestants was not protected by the First Amendment).

179. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (discussing the different tests used by courts to determine what constitutes a commercial use of a person's likeness under the right of publicity).

180. See, e.g., RESTATEMENT (SECOND) OF TORTS § 625D (1977) (prohibiting giving publicity to the private life of another if the matter publicized "is not of legitimate concern to the public").

181. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 334 (1974).

This is not a troubling result because a person should not have control over uses of her name or likeness that are entitled to full First Amendment protection.

#### 4. Actual Dilution Requirement

Currently, a right of publicity plaintiff may be able to recover without showing actual damage to the commercial value of her persona.<sup>182</sup> To recover under the proposed publicity dilution standard, a person must show actual dilution of her name or likeness.<sup>183</sup>

##### *a. Standard*

Under the FTDA, a plaintiff must show dilution of the distinctive quality of a mark.<sup>184</sup> A plaintiff must show actual dilution of a mark.<sup>185</sup> The fact that the junior mark conjures up mental associations of a famous mark is not enough to show blurring or tarnishment, but circumstantial evidence of actual dilution may be sufficient in some cases.<sup>186</sup> The same requirement of actual dilution should apply in publicity dilution cases.

Courts have not settled on a single test to measure blurring under the FTDA.<sup>187</sup> In the end, the blurring analysis may be a case-by-case inquiry that examines relevant factors as the court sees fit. Because a goal of dilution law is to prevent uses that whittle away the distinctiveness of a mark, courts should at least look at the fame of the senior mark, the similarity of the marks, and consumer confusion. Thus, courts should ask whether a use blurs the distinctiveness of a celebrity's persona by associating it with unrelated goods. The standard for tarnishment is more straightforward. Tarnishment occurs when a mark's goodwill is degraded by association with unsavory products or ideas.<sup>188</sup> Thus, the tarnishment inquiry simply asks whether the use associates the mark with unwholesome conduct—such as drugs, sex, or violence—or with goods of poor quality.<sup>189</sup> The

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182. See 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11.8[B]–[C] (West 1999); 4 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* 28:1 (4th ed. 1997).

183. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433–34 (2003).

184. 15 U.S.C. § 1125(c) (2000).

185. *Moseley*, 537 U.S. at 434.

186. *Id.*

187. For a thorough discussion of the possible tests, see *supra* Part III.B. See, e.g., Magliocca, *supra* note 90, at 984–86.

188. See discussion *supra* Part III.B; see, e.g., WELKOWITZ, *supra* note 70, at 176, 265.

189. See, e.g., *Deere & Co. v. MTD Prod., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994).

trademark tarnishment inquiry translates seamlessly into a persona tarnishment inquiry.

*b. Difficult Cases*

In addition to the problems in defining a blurring test, several hard cases emerge. One such case is that of gradual blurring. For example, a single small use of Tom Cruise's image in an advertisement may not cause any actual dilution of his image. However, many similar, aggregated uses may blur his image by overexposing him and ultimately reducing his commercial value. The Supreme Court recently held that a likelihood of dilution is not enough; the use at issue must rise to the level of actual dilution.<sup>190</sup> The case explicitly rejected the possibility that likelihood of future dilution could be sufficient.<sup>191</sup> Therefore, Cruise could only recover for a use of his image that actually blurs his persona.<sup>192</sup> In reality, though, it is likely that Cruise will be able to show that each small use whittles away the distinctiveness of his persona by associating him with unrelated products.

Another difficult case is that of an infamous person whose name and likeness have negative connotations. Trademark law traditionally protects the goodwill that a company invests in its identifying mark.<sup>193</sup> Therefore, trademark law is not well-equipped to deal with the negative connotations of a mark, which one commentator aptly calls "badwill."<sup>194</sup> The fungible nature of trademarks means that once a mark develops badwill, the company can simply change the mark.<sup>195</sup> However, if a person develops badwill, the person cannot as easily shed her name, likeness, or persona. Further, a company does not benefit from badwill in a

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190. *Moseley*, 537 U.S. at 433–34.

191. *Id.*

192. Note that the Supreme Court did reserve the possibility that in some cases, blurring can be inferred from circumstantial evidence. *Id.* at 434. Thus, if the uses mirror Cruise's image closely enough, a court may be willing to infer dilution.

193. See generally 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:15 (4th ed. 1997).

194. See *Badwill*, Note, 116 HARV. L. REV. 1845, 1845–52 (2003). "Importantly, badwill is not merely the absence of goodwill. . . . In contrast, a consumer harboring badwill toward a producer would rather buy a product from an unknown source than from the disfavored producer." *Id.* at 1850.

195. *Id.* at 1846. The author provides an example: "[I]f the producer of Fig Newtons notices that consumers harbor badwill toward the Fig Newtons mark, she might continue to produce the same product but market it under a different trademark, shedding the badwill that consumers associate with Fig Newtons." *Id.*

trademark, as negative connotations likely correlate with a lack of sales. In contrast, a notorious persona may have market value.<sup>196</sup> A person may be able to market notoriousness into book or movie deals or advertisements.<sup>197</sup>

Trademark dilution law does not provide a clear-cut rule for the treatment of an infamous person with a bad reputation. Publicity dilution law should not provide a remedy for tarnishment of a person's badwill. The market value of the persona comes from the development of a notorious reputation. A person marketing her infamy should not be able to argue that someone impermissibly tarnished the (nonexistent) goodwill associated with her name or likeness. Whether publicity dilution should provide a remedy for blurring of badwill is a more difficult question. On one hand, badwill can translate into a positive market value that could be diluted by blurring. It also is difficult to determine when a person is capitalizing on goodwill and when a person is capitalizing on badwill.<sup>198</sup> On the other hand, allowing a remedy could give a person an incentive to develop badwill. Nevertheless, a person should be able to recover for the blurring of her badwill. The right of publicity dilution is grounded in the property rationale of protecting a person's economic value.<sup>199</sup> Its protection should extend to all uses that dilute actual economic value.

### *c. Remedies for Nondiluting Uses*

If a use does not rise to the level of blurring or tarnishing, then it does not diminish the economic value of a person's name or likeness. Therefore, the person should not be able to recover under the publicity dilution standard. For example, an advertisement for a movie theater might celebrate the best movie stars of all time. It is unlikely that this use would blur the stars' images, because consumers would not associate the stars with the movie theater. Therefore, the stars should not be able to recover for the whittling away of their images. In all likelihood, the stars would be without recourse in other

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196. Adam Tschorn, *Hollywood's Walk of Shame; From Sex to Drugs to Freakish Fashions, The Frequency of Well-Timed Celebrity Scandals Proves There's No Such Thing as Bad Publicity*, WOMEN'S WEAR DAILY 34S (Feb. 24, 2004).

197. See generally *id.*

198. For example, actor Charlie Sheen is both a talented actor and a notorious figure. See *Sheen, Charlie*, Biography.com, at <http://www.biography.com/search/article.jsp?aid=9481297&page=1&search=> (last visited Oct. 29, 2004).

199. See discussion *supra* Part IV.B.

areas of the law. This is not a troubling result. If the use does not constitute actual dilution of a celebrity's persona, then the celebrity does not suffer sufficient economic harm.

#### *D. Revisiting Right of Publicity Cases*

The proposed publicity dilution standard reaches an optimal balance between protecting a celebrity's valuable image and ensuring vibrant free speech. Application of the proposed publicity dilution standard to right of publicity cases illustrates that the proposed standard prevents use of a celebrity's name or likeness that causes economic harm.

Many cases will come out the same under this standard. Notably, many right of publicity cases have been suits by celebrities seeking recourse for dilution of their names or likenesses. For example, *Wendt v. Host International Corp.*<sup>200</sup> involved famous characters from the television show *Cheers*. The defendants designed airport bars that resembled the set of *Cheers*, complete with animatronic figures resembling *Cheers* actors George Wendt (who played "Norm") and John Ratzenberger (who played "Cliff").<sup>201</sup> The Ninth Circuit held that the actors have a triable claim that the use of their likenesses constituted a violation of the right of publicity.<sup>202</sup> Similarly, the use of the *Cheers* characters in a bar could constitute dilution by blurring. The publicity dilution inquiry would turn on the degree to which bar patrons would come to associate the robots with the actors. If there is a high degree of similarity between the robots and the actors, people may come to associate the actors with the bar. This would diminish the actors' ability to market their characters to other establishments or advertisers in the future. Consumers would have higher search costs because they would have to ask to which location or product endorsed by the actors a particular use refers.<sup>203</sup>

Similarly, in *Carson v. Here's Johnny Portable Toilets, Inc.*,<sup>204</sup> late-night television host Johnny Carson sued a portable toilet business calling itself Here's Johnny Portable Toilets, Inc.<sup>205</sup> Carson argued that the use of his catchphrase in the company's name violated

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200. 125 F.3d 806 (9th Cir. 1997).

201. *Id.* at 809.

202. *Id.* at 811-12.

203. See *Ty, Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) (Posner, J.); Posner, *supra* note 20, at 634.

204. 698 F.2d 831 (6th Cir. 1983).

205. *Id.* at 832-33. The founder of the company paired the company name with a second phrase, "The World's Foremost Comedian." *Id.* at 833.

his right of publicity. The Court held that the commercial value of Carson's identity was exploited in violation of the right of publicity, even though his name and likeness were not used.<sup>206</sup> Under the proposed publicity dilution standard, Carson can show blurring. If he attempts to market his catchphrase for use on another product, consumers would have to try to differentiate to which one of the products the catchphrase is referring. This confusion would constitute the requisite whittling away of Carson's persona. Carson may have a claim that the use constitutes tarnishment by associating his persona with an unseemly product. However, a court should conclude that a portable toilet is not inherently unwholesome for tarnishment purposes.

The proposed fame requirement means that some persons who could recover under the old right of publicity standard cannot recover under the publicity dilution standard. As discussed in the previous section, an apt example is *Ainsworth v. Century Supply Co.*<sup>207</sup> A tile layer consented to be filmed by a tile company for an instructional video, but the tile company used his image without consent in an advertisement.<sup>208</sup> The court concluded that the tile layer sufficiently pleaded a claim of appropriation of his image.<sup>209</sup> However, the tile layer was not famous at the time of the use. Because his persona did not have economic value, he could not seek recourse under a statute protecting the economic value of a persona. Rather, the tile layer might have a claim under privacy law.<sup>210</sup>

Finally, the proposed actual dilution requirement means that some persons who would have a cause of action under the old right of publicity standard would not be able to make a claim of publicity dilution. One example is *White v. Samsung Electronics America, Inc.*,<sup>211</sup> a suit by *Wheel of Fortune* hostess Vanna White. A series of humorous advertisements for Samsung products depicted futuristic scenes with current Samsung products to convey the message that the Samsung products would still be in use in the future.<sup>212</sup> One of the ads for a Samsung VCR pictured a robot dressed in a blonde wig and a dress similar to White's, standing next to a game board similar to the

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206. *Id.* at 836-37.

207. 693 N.E.2d 510 (Ill. App. Ct. 1998).

208. *Id.* at 511-12.

209. *Id.* at 513.

210. See discussion *supra* Part IV.C.2; see, e.g., Hunt, *supra* note 4.

211. 971 F.2d 1395 (9th Cir. 1992).

212. *Id.* at 1396.

*Wheel of Fortune* game show set.<sup>213</sup> The caption to the ad read: "Longest-running game show. 2012 A.D."<sup>214</sup> The court held that this use violated White's common law right of publicity. However, this use probably would not violate the proposed new publicity dilution standard. The ad sets out a farcical and humorous prediction about the future. Any similarity between White and the robot probably is not significant enough to cause consumers to associate White with the Samsung product. Therefore, the use does not whittle away the distinctiveness of White's persona, nor hurt White's chances of getting real-life product endorsements. Thus, White cannot recover under the publicity dilution standard.

Another case that may come out differently under the actual dilution requirement is *Hoffman v. Capital Cities/ABC Inc.*,<sup>215</sup> involving actor Dustin Hoffman. A *Los Angeles Magazine* article titled "Grand Illusions" altered famous film stills to make it look like the actors were wearing current fashions.<sup>216</sup> The final still was a famous shot of Dustin Hoffman in the movie *Tootsie*, in which Hoffman is standing in front of an American flag wearing a red sequined dress. The American flag and Hoffman's head were not altered, but his body and the red sequined dress were replaced with the body of a male model wearing a cream-colored evening dress and high-heeled sandals.<sup>217</sup> The court decided the case on First Amendment grounds.<sup>218</sup> Hoffman could not recover under the proposed new publicity standard. First, a court could conclude that this was an exempted noncommercial use.<sup>219</sup> Even if a court did find this use to be commercial, it probably would not find sufficient dilution. The altered photographs are not tarnishing because the spread merely plays off of Hoffman's role in the movie *Tootsie*. Taken in context, the spread does not suggest that Hoffman cross-dresses.<sup>220</sup> Further, the altered photographs of Hoffman probably

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213. *Id.*

214. *Id.*

215. 255 F.3d 1180 (9th Cir. 2001)

216. *Id.* at 1183.

217. *Id.* The text accompanying the ad identified the still as from the movie *Tootsie* and read, "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels." *Id.*

218. *Id.* at 1189.

219. See 15 U.S.C. § 1125(c)(4)(B) (2000).

220. There might be a colorable claim for tarnishment in other, less benign contexts. For example, one can imagine an advertisement for a cross-dressing club that depicts Hoffman dressed in drag. Such a use presents a greater chance that consumers would associate Hoffman

would not constitute blurring; Hoffman's ability to market his image should not be damaged by what essentially is a parody of his movie role.

## V. CONCLUSION

The current right of publicity prohibits the unauthorized commercial use of a person's name or likeness. However, the right does not provide the optimal level of protection for a person's name or likeness. The current right of publicity is overbroad. A plaintiff may recover without showing actual harm to the economic value of her persona.<sup>221</sup> A plaintiff may also recover without showing that her persona is famous and inherently valuable.<sup>222</sup> This broad right of publicity is inconsistent with the right's purpose of protecting the underlying economic value in a person's name or likeness.<sup>223</sup>

Therefore, the right should be replaced by a right of publicity dilution that is modeled after federal trademark dilution law. The right of publicity dilution would be more consistent with the theoretical underpinnings behind publicity protection.<sup>224</sup> To recover under the proposed right of publicity dilution, a potential plaintiff would have to meet several requirements. First, the plaintiff must be famous. Fame serves as a useful indicator of economic value in a persona. Second, the use of the plaintiff's image must be in commerce. This requirement ensures that high-value, noncommercial speech is not regulated in violation of the First Amendment. Finally, the plaintiff must show that the use actually diluted her image, either by blurring or tarnishment. The blurring inquiry prevents uses that whittle away the distinctiveness of a plaintiff's name or likeness by associating it with unrelated goods or services.<sup>225</sup> The tarnishment inquiry prevents those especially offensive uses of a plaintiff's name or likeness that associate the plaintiff with unsavory ideas or poor quality goods.<sup>226</sup> The actual dilution requirement allows a plaintiff to recover when she

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with the cross-dressing club. Therefore, that use might tarnish the commercial value of Hoffman's persona.

221. See discussion *supra* Part IV.A; see, e.g., 4 MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:1(4th ed. 1997).

222. See discussion *supra* Part IV.A; see, e.g., Hunt, *supra* note 4, at 1621-23.

223. See, e.g., Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 570-74 (1977).

224. See discussion *supra* Part IV.B; see, e.g., Haemmerli, *supra* note 25.

225. See discussion *supra* Part III.B; see, e.g., Mead Data Cent. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026, 1028-29, 1031 (2d Cir. 1989).

226. See discussion *supra* Part III.B; see, e.g., Anheuser-Busch, Inc. v. Andy's Sportswear, Inc., 40 U.S.P.Q.2d (BNA) 1542 (N.D. Cal. 1996).

suffers real economic harm. Admittedly, the proposed publicity dilution regime may create more difficult cases and raise administration costs.

The overarching interest in striking the correct balance between property rights and the right of free speech outweighs any costs that may be incurred by the proposed standard. A right of publicity dilution would prevent any commercial use of a valuable persona that diminishes the economic value of the persona. Other harms could be addressed under other areas of the law, such as privacy or defamation. The narrower right of publicity dilution would ensure that speech that would otherwise be protected by the First Amendment is not over-regulated. Thus, the proposed right of publicity dilution would strike the optimal balance between protecting a celebrity's economic value and protecting the public's interest in speaking about its cultural icons.

