Featuring People in Ads (2014 Edition)

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CHAPTER 13: FEATURING PEOPLE IN ADS

Advertisements routinely depict people—their image, name, voice and other aspects of their personality. This chapter looks at the special legal issues that arise from depicting people in ads.

1. Overview of Publicity Rights

Publicity rights generally protect the use of people’s names, images, voices or other personality attributes from unconsented commercialization. Publicity rights initially were part of a person’s privacy rights.

In the United States, privacy rights generally trace back to the immensely influential privacy article by Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). Both Warren and Brandeis were lawyers at the time; Brandeis went on to become a celebrated U.S. Supreme Court justice.

The authors were reacting to improvements in camera technology. Initially, camera shutter speeds were so slow that people had to pose (i.e., stand still) for photographs. However, technological evolutions reduced shutter speeds, which allowed photographers to take photos of people without their consent. Warren and Brandeis argued that “the existing law affords a principle from which may be invoked to protect the privacy of the individual from invasion either by the too enterprising press, the photographer, or the possessor of any other modern device for rewording or reproducing scenes or sounds.”

Recapping privacy law in the early 1960s, Dean William Prosser classified privacy legal claims over the intervening seventy years into
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four categories. See William L. Prosser, Privacy, 48 CAL. L. REV. 383 (1960) and RESTATEMENT (SECOND) OF TORTS (for which Prosser was the reporter). Prosser’s four categories included “[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness,” which has evolved into the modern “publicity right.”

Although the publicity rights doctrine is well-recognized, its legal implementation is a little chaotic. There is no federal publicity right. Currently, about half the states statutorily codify publicity rights, and some statutes explicitly provide that publicity rights survive beyond a person’s death. See, e.g., Cal. Civil Code § 3344.1 (surviving rights for seventy years post-mortem); Indiana Code 32–36 (surviving rights for 100 years post-mortem). In some states, publicity rights are protected by common law doctrines. In a few states, publicity rights are concurrently protected both by statute and the common law.

Because many celebrities reside there, California and New York play particularly important roles in the development of publicity rights laws. However, publicity rights are not limited to celebrities, and they usually equally protect both well-known and unknown individuals.

Publicity rights generally govern two discrete activities: first, the “merchandizing” of a person by selling an item that incorporates some identifiable part of the person, such as the incorporation of a celebrity’s image on a t-shirt or a videogame containing a character that has similarities with an actual person, and second, the depiction of a person in ad copy. Given the book’s emphasis, this chapter focuses almost exclusively on the ad copy cases. Typically, the ad copy cases are doctrinally easier than the merchandizing cases, but both types of cases can create difficult line-drawing situations. In addition, the publicity rights doctrines have an uneasy fit with the First Amendment, especially in the merchandizing context.
Publicity rights only apply to individuals; companies or other business organizations rely on trademark law and related doctrines. If a person’s name develops secondary meaning in association with commercial offerings, people can develop trademark rights in their name or other attributes to complement their publicity rights (which exist automatically). When enforcing those rights, trademark law requires that the usage creates a likelihood of consumer confusion. In contrast, consumer confusion is irrelevant to a publicity rights claim.

2. Publicity Rights and Ad Copy

As a baseline proposition with only limited exceptions, depicting a person in ad copy requires the person’s consent. Even with this fairly clear rule, plenty of ambiguity remains. This part looks at the depiction of various personality attributes to explore the boundaries of the publicity rights doctrine.

A. A Person’s Name

In reading this opinion, it may be helpful to know that a “Henley shirt” is a collarless polo shirt. It is named after Henley-on-Thames, England, whose rowers wore uniforms in this style.


. . . FACTS . . .

Plaintiff Donald Hugh Henley (“Henley” or “Plaintiff”), is a popular and critically acclaimed rock and roll musician. He began his music career in the 1970s as the founder and member of the band The Eagles. In the 1980s and 1990s, Henley maintained a successful solo career by continuing to produce platinum albums and perform on tour in concerts around the world.
On September 3 and 4, 1997, Defendant Dillard Department Stores ("Dillard" or "Defendant") ran a newspaper advertisement for a shirt known as a "henley." The ad features a photograph of a man wearing a henley shirt with the words, “This is Don” in large print, beside the picture, and an arrow pointing toward the man’s head from the words. Underneath the words is the statement, “This is Don’s henley” in the same size print, with a second arrow pointing to the shirt. The advertisement also included the name of the retailer, “Dillard’s”, general information about the sale price of the shirts, the name of the shirt’s manufacturer, the available sizes and the following: “Sometimes Don tucks it in; other times he wears it loose—it looks great either way. Don loves his henley; you will too.” The ad ran in newspapers throughout Texas and in Mexico.
B. Right to Publicity

The right of publicity is often described as the “inherent right of every human being to control the commercial use of his or her identity.” The right to publicity is considered an intellectual property right. It is a more expansive right than any common law or statutory trademark infringement right because it does not require a showing of likelihood of confusion.

The tort of misappropriation of one’s name or likeness is generally referred to as the “Right of Publicity” and is based on section 652C of the Restatement of Torts which reads, “One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy.” The Fifth Circuit has specifically identified three elements a plaintiff must prove to recover for the tort of misappropriation of name and likeness in Texas: (1) the defendant appropriated the plaintiff’s name or likeness for the value associated with it, and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) there was some advantage or benefit to the defendant.

The right of publicity is designed to protect the commercial interests of celebrities in their identities. It is intended to protect the value of a celebrity’s notoriety or skill. Because a celebrity’s identity can be valuable in the promotion of products, “the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.” Such celebrities have an exclusive legal right to control and profit from the commercial use of their name, personality and identity. “If the celebrity’s identity is commercially exploited, there has been an invasion of his right whether or not his ‘name or
likeness’ is used.” The tort does not protect the use of the celebrity’s name per se, but rather the value associated with that name. . . .

1. Did Defendant Appropriate the Plaintiff’s Name or Likeness for the Value Associated with it, and not in an Incidental Manner or for a Newsworthy Purpose?

The threshold issue to determine in analyzing this element is whether Defendant actually appropriated Defendant’s name or likeness. . . .

While use of the expression “Don’s henley” is arguably the use of Plaintiff’s name, a genuine issue of fact exists as to whether that expression is, indeed, Plaintiff’s name. However, Courts have recognized that a defendant may be held liable for using a phrase or image that clearly identifies the celebrity, in addition to finding liability for using a plaintiff’s precise name. Because the use of the expression “Don’s henley” is so clearly recognizable as a likeness of Plaintiff, the Court finds that no reasonable juror could conclude that the phrase “Don’s henley” does not clearly identify the Plaintiff, Don Henley. . . .

The second issue the Court must resolve is whether Defendant appropriated Plaintiff’s name or likeness for the value associated with it, and not in an incidental manner. Defendant argues that “there has been no evidence presented that Dillard chose to use the wording ‘Don’s henley’ in order to capitalize on the alleged value of the name Don Henley.” The Court disagrees, and in fact, finds that Defendant has presented no reasonable evidence to defeat Plaintiff’s summary judgment motion. Plaintiff presents uncontroverted deposition testimony from Lisa M. Robertson, the creator of the print advertisement, admitting that use of Don Henley’s ‘name’ was intended to make the ad more interesting. She . . . intended to use the expression as a “play on words” and intended consumers to
recognize this advertisement as a “wordplay” on the name “Don Henley.” In other words, Defendant admitted that she did not intend potential consumers to perceive the ad as depicting an anonymous man named “Don.” She intended for them to associate the expression “Don’s henley” with the Plaintiff Don Henley. Furthermore, Debra L. Green, the ad’s designer, admitted that she believed the expression “Don’s henley” would catch the consumers’ eye because of its similarity to the name “Don Henley.” Therefore, Defendant admits Dillard used the play on words, “Don’s henley” to attract consumers as they associated the expression and the ad with Plaintiff Don Henley. In other words, they used the value associated

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2 Q: Well, what prompted you to come up with the idea “This is Don. This is Don’s Henley”?
A: Well, I was trying to find a play on words to use for the ad.
Q: And there’s no doubt that when you were using the words “This is Don. This is Don’s henley,” the Don Henley wordplay meant Don Henley the recording artist, not some other person named Don Henley?
A: Well, obviously the name—yes, I mean I knew it was Don Henley; that was where it came from. But it wasn’t, you know, to imply that he was a part of it.
Q: I think you said earlier that by using the word—by using the headline “This is Don. This is Don’s henley,” you intended a wordplay, correct?
A: Yes.
Q: And so it was your intention for consumers to recognize this advertisement as a wordplay.
A: Yes.
Q: And for the wordplay to work, the consumer had to recognize the name Don Henley, right?
A: Well, you’d have to know who he was to get it, yes.
Q: So for it to work or for them to get it, they must recognize the similarity between the words “This is Don. This is Don’s henley” and the name of the recording artist Don Henley, correct?
A: Yes.

3 Q: Do you think that the words “Don’s,” apostrophe “s,” “henley” would catch a consumer’s eye?
A: I think the sound of them reading it would repeat the sound of—I think that that would in some way associate with Don.
Q: Well, my question is would it have caught your average consumer’s eye, the use of the words “Don’s henley”?
A: I think so.
with Don Henley’s identity and personality in order to attract consumers’ attention.

Defendant presents testimony from Dillard’s Vice President of Sales Promotion, William B. Warner, suggesting that the use of the words “Don’s henley” adds no value to the advertisement. Warner testified that he believes there is no value associated with the expression “Don’s henley,” and that the singular and sole purpose of choosing and printing that phrase was “fun.” In fact, Defendant argues, the use of the expression, “Don’s henley” was incidental to the primary focus of the advertisement. The portions of the ad that were of “chief importance” were the “handwritten text and arrows . . . the visual presentation of information.”

. . . The Court finds it unreasonable to draw the inference Defendant requests. Defendant’s evidence could not lead a reasonable jury to conclude that the use of the words “Don’s henley” was for any purpose other than to attract the attention of consumers.

Defendant also insists that its use of the phrase “Don’s henley” was incidental to the handwritten style of the text and arrows. “[O]ne of the primary purposes of advertising is to motivate a decision to purchase a particular product or service. The first step toward selling a product or service is to attract the consumers’ attention.” Defendant’s use of the message “This is Don. This is Don’s henley.” in large letters, centered in the print ad was clearly and admittedly intended to attract the consumers’ attention. The Court is hard

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4 Q: Did the words—in your opinion, do the words “Don” and “Don’s henley” help make the ad more effective?  
A: I think not. I think they make it fun, but not necessarily in any way that would actually make it more effective from the standpoint of achieving what a good ad is intended to achieve.  
Q: Was it you [sic] opinion that the words “Don” and “Don’s henley” add no value at all to the ad?  
A: That’s my basic opinion.
pressed to believe that a reasonable jury could conclude that the size and style of the letters, rather than the message created with those letters, are the focus of the ad. No reasonable jury could conclude that the use of the word play was merely incidental to the advertisement.

2. Can the Plaintiff be Identified from the Publication?

The second element Plaintiff must satisfy to prove an infringement of the Right of Publicity, is that “plaintiff as a human being must be ‘identifiable’ from the total context of the defendant’s use.” While there are many ways a plaintiff can be identified in a defendant’s use, the most obvious is use of a name that distinguishes the plaintiff. “Identifiability of plaintiff will probably not be a disputable issue in the majority of meritorious Right of Publicity cases.” This is due to the fact that defendants will usually make the plaintiff’s identity as identifiable as possible so as to draw the maximum amount of attention to the defendant’s product. “The intent, state of mind and degree of knowledge of a defendant may shed light on the identifiability issue.” “To establish liability, plaintiff need prove no more than that he or she is reasonably identifiable in defendant’s use to more than a de [minimis] number of persons.” . . .

The Court finds that the issue of identifiability is indisputable in this case because Defendant has offered no evidence to suggest that Plaintiff is not identifiable from the ad. Plaintiff’s survey evidence indicates that sixty-five percent of survey respondents believed there was a spokesperson or endorser in the ad. Of those who said there was a spokesperson or endorser, twenty-three percent said the spokesperson or endorser was Don Henley.\(^8\) In other words, fifteen

\(^8\) It is arguable that, had the respondents been shown Defendant’s ad and been asked “Who do you think is identified in this ad?” a different result would have occurred. In order to name Don Henley as the spokesperson or endorser of the ad (as the question was asked by the surveyor), the surveyees
percent of those asked believed Don Henley was a spokesman for or endorser of the ad, and thus, necessarily identified him from the ad. The results of this survey clearly prove that Don Henley was reasonably identifiable in Defendant's ad to more than a de [minimis] number of persons.

Further, in evaluating the intent and state of mind of Defendant, the evidence is undisputed that Defendant intended to appropriate Don Henley’s identity and intended that consumers associate the ad with Don Henley. First, as stated supra, the creators of the ad admitted they intended consumers to associate Don Henley with the ad. Second, the Defendant intended to appropriate the image of performing artist Don Henley, not some other, anonymous person by that same name. This is proven by Plaintiff’s evidence that the ad creators drafted an earlier version of the ad that added quotes or paraphrases from eight Don Henley song titles to the ad at issue.9 The Court concludes that there is no fact issue from which a reasonable jury could conclude that Plaintiff was not identifiable from the ad.

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9 The ad, in draft form read, “If all you want to do is dance / pick up your witchy woman / take it to the limit in our cotton henley. We promise, you’ve spent your last worthless evening! Give her the best of your love, and when the party’s over, toss our machine washable henley right in the dirty laundry. In the long run, you’ll love the great colors and the super-sturdy construction. But hurry in, they may be already gone.” [Editor’s note: we underlined the song titles, which are a mixture of Eagles songs and Don Henley solo songs.]
3. Was there an Advantage or Benefit to Defendant?

Defendant insists that Plaintiff cannot prove a benefit inured to Dillard because the sales generated by the ad were not sufficient to cover the costs of running the ad. Plaintiff argues that the Court need consider no more than the fact that the ad was created with the belief that the use of the words “Don’s henley” would help sell its product.

. . . Comment d [of the Restatement (Second) of Torts § 652C] reads: “It is only when the publicity is given for the purpose of appropriating to the defendant’s benefit the commercial or other values associated with the name or likeness that the right of privacy is invaded.” Comment d further suggests that the notion that a benefit must inure to the defendant is intertwined with the factor requiring that the plaintiff prove the defendant appropriated the plaintiff’s name or likeness for its value and not for an incidental use. The “benefit” element requires Plaintiff to prove that Defendant derived some commercial benefit from the use of plaintiff’s name or likeness as opposed to deriving no commercial benefit due to the fact that the use was incidental. . . .

The plaintiff in a right to publicity action is not required to show that the defendant made money off the commercial use of the name or likeness, as Defendant suggests. It is immaterial that Defendant made little profit after the ad ran, only ran the advertisement once, and received no feedback on the ad. What Plaintiff must prove is that Defendant received a commercial benefit from use of Plaintiff’s name or likeness that, without Plaintiff’s image, he would not otherwise have received. Defendant’s sophisticated and experienced ad creators described the benefit they received as being able to catch the eye of the consumer and make the ad more interesting. By appropriating Plaintiff’s name or likeness, Defendant received the benefit of a celebrity endorsement without asking permission or paying a fee.
To reiterate an earlier point, the Right of Publicity cause of action exists to protect a celebrity’s identity, which can be valuable in the promotion of products. Such celebrities have an exclusive legal right to control and profit from the commercial use of their name, personality and identity. . . . The Court, thus, refuses to require a plaintiff to prove that a defendant made a profit or secured a tangible benefit from use of the plaintiff’s name or likeness.

. . . Defendant should not be shielded from liability because “the product promoted is undesirable, the ad [is] clumsy or somehow ineffective, or sales slump[ed] during the relevant time period.” Rather, Dillard should be held liable because it received a benefit by getting to use a celebrity’s name for free in its advertising. Whether or not the advertising worked for Dillard is wholly irrelevant. The Court concludes that there is no fact issue from which a reasonable jury could conclude that Defendant did not receive a benefit from its use of Plaintiff’s likeness. . . .

NOTES AND QUESTIONS

Celebrities v. Ordinary People. This case emphasizes Don Henley’s celebrity status. However, as cases such as the Cohen case discussed later illustrate, celebrity status is not required for a valid publicity rights claim.

Variations. Would the result have changed if Dillard had referenced “Donald’s henley”? “Dawn’s henley”? “Don Juan’s henley”? Once the court believed that Dillard was intentionally trying to evoke Don Henley, was Dillard liable no matter what variation of “Don Henley” they used? The ad derives value from the pun on Henley’s name, but the court doesn’t seem interested in the fact that it required extra mental effort for consumers to decode the pun.
**Consumer Survey.** The case says “fifteen percent of those asked believed Don Henley was a spokesman for or endorser of the ad.” Does the result change if all of the other 85% clearly understood that the ad was a joke? Does this case suggest that the perceptions of a small minority of consumers can veto advertising that the majority understand as a joke?

Consumer surveys are common in trademark and false advertising cases, but they are relatively rare in publicity rights cases.

*Celebrities on a First-name Basis.* During the 2010 Super Bowl, the online brokerage E*Trade ran one of its “talking baby” commercials. In the commercial, the protagonist is explaining to his “girlfriend” (a baby girl) that he didn’t call because he was taking advantage of E*Trade. The girlfriend accusatorily asks, “And that milkaholic Lindsay wasn’t over?” After an awkward pause, the protagonist then replies “Lindsay?” in an unsure voice while a previously unseen baby girl in the protagonist’s room—presumably, the “Lindsay” both babies are referencing—reveals herself to the camera and says “Milk-a-what?”
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This ad prompted a $50 million lawsuit from Lindsay Lohan, a successful teen actress who battled highly publicized substance-addiction issues. Lohan v. E*Trade Securities LLC, No. 10-004579 (N.Y. Sup. Ct. complaint filed March 8, 2010). Lohan claimed that the ad’s “Lindsay” references were meant to be her. Among other things, she claimed that her first name is so well-known that ad viewers would have assumed it was her.

If you represented Lohan, what evidence would you try to introduce to show that “Lindsay” referenced your client?

Lohan was born in 1986. In the 1980s, “Lindsay” was the 44th most popular girl name according to the Baby NameVoyager (and the sound-alike “Lindsey” was the 42nd most popular). In 2008, “Lindsay” was the 380th most popular girl’s name. Is either fact relevant?

Would it matter if the first draft of the commercial referred to the Lindsay character as “Deborah”? Or does every first name have the possibility of some celebrity with the same name claiming the ad refers to him or her?

Lohan and E*Trade subsequently settled the lawsuit on confidential terms.*

Does the following billboard, promoting tourism with the slogan “MORE RUSH THAN YOU GET FROM TALK RADIO,” misappropriate anyone’s personality rights? Does the capitalization matter?

* Lindsay Lohan may have an unusually expansive view of her publicity rights, including a pending lawsuit against Grand Theft Auto V for containing an actress character and a failed lawsuit against the singer Pitbull for using her name in rap lyrics.
What about a New Orleans billboard for local favorite Zatarain’s Fish-Fri with the tagline “AS SEEN ON OKRA”?

How about the following ad and product name? Elroy Hirsch was a University of Wisconsin athlete who went on to become a successful and well-known pro football player. Hirsch got the nickname “Crazylegs” as described in *Hirsch v. S.C. Johnson & Son. Inc.*, 280 N.W.2d 129 (Wis. 1979):

In the fourth game of his first season of play at Wisconsin, he acquired the name, “Crazylegs.” In that game, Hirsch ran 62 yards for a touchdown, wobbling down the sideline looking as though he might step out of bounds at any moment. Hirsch’s unique running style, which looked something like a whirling eggbeater, drew the attention of a sportswriter for the Chicago Daily News who tagged Hirsch with the nickname, “Crazylegs.” It is undisputed that the name stuck, and Hirsch has been known as “Crazylegs” ever since.
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GEL
Crazylegs works in a crazy way. It starts as a smooth pink gel.

TO FOAM
Slip it over your skin and it turns into a rich foam. But a thin layer of the gel’s emollients remains to moisturize your legs. It helps prevent the dryness shaving can cause. And also helps protect against nicks and cuts.

TO MOISTURIZER
Even after you’ve shaved, the moisturizers in Crazylegs stay. To continue softening and conditioning your legs. Crazylegs gives you a closer, more feminine shave. A great shave. And, more important, great skin.

Not just for a great shave. For great skin.
The court upheld Hirsch’s claim against the product name. Are you surprised by that result? Why or why not?

Is there any situation where a depiction of a celebrity wouldn’t qualify as a benefit to the advertiser? Courts have been very celebrity-favorable in this context. In Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir. 1996), for example, the former basketball star Kareem Abdul-Jabbar alleged that GMC violated the Lanham Act and California’s statutory and common law right of publicity by using his former name, Lew Alcindor, without his consent, in a television ad aired during the 1993 NCAA men’s basketball tournament. The court of appeals agreed that a jury could find GMC liable.

The ad involved a voiceover that asked, “Who holds the record for being voted the most outstanding player of this tournament?” The screen then displayed, “Lew Alcindor, UCLA, ‘67, ‘68, ‘69.” The voiceover then asked, “Has any car made the ‘Consumer Digest’s Best Buy’ list more than once? [and responds:] The Oldsmobile Eighty-Eight has.” The ad also called the car “A Definite First Round Pick.” Abdul-Jabbar adopted his present name in 1971, and hadn’t used “Lew Alcindor” for commercial purposes in over ten years at the time of decision. The court of appeals reasoned that, under California common law, the key issue was whether his “identity” had been appropriated; California statutory law protected “name, voice, signature, photograph, or likeness.” Using the former name could constitute use of his “identity,” and the statute wasn’t limited to presently used names. “To the extent GMC’s use of the plaintiff’s birth name attracted television viewers’ attention, GMC gained a commercial advantage.” Whether the name Lew Alcindor “equalled” Kareem Abdul-Jabbar in consumers’ minds was a question for the jury.
In addition, Abdul-Jabbar provided sufficient evidence for a jury to find that he was injured “economically because the ad will make it difficult for him to endorse other automobiles, and emotionally because people may be led to believe he has abandoned his current name and assume he has renounced his religion.” (Abdul-Jabbar changed his name as a result of his religious conversion to Islam.)

NOTES AND QUESTIONS

*Abandonment via Name-change.* This case addresses a celebrity name-change when the “abandoned” name was also well-known, a relatively unusual circumstance. A more likely scenario is the celebrity’s adoption of a new stage name that becomes more well-known than his or her birth name. For example, the real name of 50 Cent is Curtis Jackson. If ad copy referenced Curtis Jackson, would that violate his publicity rights if few consumers would realize that is the same person as 50 Cent? In the case of post-mortem publicity rights, some statutes require the individual to have commercialized his or her name before death as a precondition of descendibility.

*References to Celebrities in Ad Copy.* Why isn’t it okay that GM merely recited a true fact that Alcindor was the NCAA tournament MVP three times? What changes, if any, could GM make to its ad copy to reference Lew Alcindor and not violate his publicity rights? Does this case imply that no changes would have satisfied the court, i.e., that merely mentioning Alcindor in the ad copy is a per se publicity rights violation?

In the discussion about GM’s liability for false endorsement under the Lanham Act and the possibility of a nominative use defense, the court says:

Had GMC limited itself to the “trivia” portion of its ad, GMC could likely defend the reference to Lew Alcindor as a
nominative fair use. But by using Alcindor’s record to make a claim for its car—like the basketball star, the Olds 88 won an “award” three years in a row, and like the star, the car is a “champ” and a “first round pick”—GMC has arguably attempted to “appropriate the cachet of one product for another,” if not also to “capitalize on consumer confusion.” We therefore hold that there is a question of fact as to whether GMC is entitled to a fair use defense.

This seems to suggest that GMC could have referenced Alcindor if it did not try to connect Alcindor’s accomplishments to its product claims. But if GMC doesn’t make that cognitive connection for the viewer, why would GMC invoke Alcindor’s accomplishments? Worse, it might be even more suspicious if GMC invoked Alcindor’s accomplishments without tying them to product claims; otherwise, it might look even more like an implied endorsement from Alcindor/Abdul-Jabbar. Given that GMC faces trouble either way, does this support the inference that GMC could not revamp the ad copy to reference Alcindor?

*Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509 (7th Cir. 2014), held that an ad congratulating Jordan in a special issue of *Sports Illustrated* celebrating Michael Jordan’s career was commercial speech, and that therefore Jordan’s Lanham Act and right of publicity claims could proceed. What sort of commercial advantage could Jewel have been seeking from running this ad?
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Tweeting about Celebrities. A paparazzi photographed actress Katherine Heigl exiting a Duane Reade drugstore carrying two Duane Reade shopping bags. Duane Reade then tweeted the photo
with the text “Love a quick #DuaneReade run? Even @KatieHeigl can’t resist shopping #NYC’s favorite drugstore.”

Assume that everything about the tweet is true, and assume Duane Reade properly procured the necessary copyright license to the photo. Does Katherine Heigl have a valid right of publicity claim against Duane Reade? See Heigl v. Duane Reade, Inc., 14 CV 2502 (S.D.N.Y. complaint filed Apr. 9, 2014). If you think Duane Reade went too far, what (if anything) could they do to share this photo with their audiences without Heigl’s permission?

Test Yourself: In July 2014, NBA basketball player LeBron James, often nicknamed “King James,” announced that he was re-signing
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with the Cleveland Cavaliers. This announcement sparked a flurry of tweets on Twitter. Which of the following do you think are legally problematic?
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1. DiGiorno Pizza
   - Tweet: "lot of pizza getting eaten in Cleveland m #WelcomeHomeLebron "
   - Time: 9:38 AM - 11 Jul 2014
   - Retweets: 40
   - Favorites: 65

2. Applebee's
   - Tweet: "We are melting in anticipation @KingJames!! #TheKingIsBack"
   - Time: 10:29 AM - 11 Jul 2014
   - Retweets: 26
   - Favorites: 52

3. Denny's
   - Tweet: "if only you would have signed with *us*, king james, if only. we coulda been a contender, we coulda been somebody..."
   - Time: 9:45 AM - 11 Jul 2014
   - Retweets: 198
   - Favorites: 297
Press Releases. Recall *Yeager v. Cingular Wireless LLC* from Chapter 2, which held that a Cingular press release touting its disaster preparedness equipment called MACH 1 and MACH 2 and invoking legendary pilot Chuck Yeager’s accomplishment of flying at Mach 1 speed could violate Yeager’s publicity rights.

*Ad Agency Liability.* The court treated the advertiser (GM) and its ad agency (Leo Burnett) as equally liable for the publicity rights violation. For more on this, see Chapter 16, Sec. 1.

*Personality Trademarks and Publicity Rights Compared.* In some cases, individuals may have protectable trademarks in addition to their publicity rights. Recall that getting a trademark requires making a “use in commerce” of the term, such as by affixing a person’s name or likeness on goods or services available in the marketplace. Furthermore, to get a trademark in a personal name,
the individual has to show that their name has achieved secondary meaning, i.e., that when consumers see the name, they think of a single source of marketplace goods or services. Think, for example, of the many celebrities who launch lines of clothing under their name, such as the Kardashian Kollection for Sears.

As a result of the use in commerce and secondary meaning requirements, non-celebrities rarely will have trademark rights protecting some aspect of their personality. For that matter, most celebrities will not have protectable trademark rights, either because they have not merchandized their personality or have not achieved the requisite secondary meaning.

Even when celebrities have trademark rights in their personalities, publicity rights claims are usually easier to win (unless they are in a jurisdiction which has not clearly recognized publicity rights at all) because publicity rights do not require showing a likelihood of consumer confusion about product source. Also, as the Henley and Abdul-Jabbar cases indicate, courts will often apply publicity rights doctrines broadly, while they may be reluctant to expand trademark doctrine so freely.

Nevertheless, if they are eligible for trademark protection, celebrities may find value in securing federal trademark registration to complement their publicity rights. For example, federal trademark registration ensures access to federal courts (rather than state courts) and consistent minimum protectable rights across all jurisdictions. Also, trademark registrations can improve standing for certain types of actions, such as counterfeiting claims or domain-name enforcement actions.

**Keyword Advertising on Names.** Assume that an advertiser purchases a person’s name as the trigger for its keyword advertising, i.e., when searchers use the search query “Joe Smith,” the
advertisement displays. Assume the plaintiff does not have any trademark rights in his or her name. Does the purchase of the keyword advertising trigger violate the person’s publicity or privacy rights? Does it matter if the ad copy references the name? See Habush v. Cannon, 346 Wis. 2d 709 (Wis. App. Ct. 2013) (dismissing a Wisconsin publicity rights claim for one lawyer purchasing keyword ads on another lawyer’s name).

In 2010, Google used to say, “Don’t use proper names as keywords. Sites that promote people-finder services, detective agencies, or other similar services are not permitted to use proper names in ad text or as keywords.” As of 2014, it says “We do not monitor the use of proper names in AdWords ads or keywords.”

B. A Person’s Voice

California’s publicity rights statute expressly protects the use of a person’s voice in ad copy. However, does that prevent an advertiser from using a “sound-alike”?

Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988)

This case centers on the protectibility [sic] of the voice of a celebrated chanteuse from commercial exploitation without her consent. Ford Motor Company and its advertising agency, Young & Rubicam, Inc., in 1985 advertised the Ford Lincoln Mercury with a series of nineteen 30 or 60 second television commercials in what the agency called “The Yuppie Campaign.” The aim was to make an emotional connection with Yuppies,* bringing back memories of when they were in college. Different popular songs of the seventies were sung on each commercial. The agency tried to get “the original people,” that is, the singers who had popularized the songs, to sing them. Failing in that

* [Editor’s note: “Yuppie” is an acronym for “Young Urban Professional,” an affluent segment of the Baby Boomers.]
endeavor in ten cases the agency had the songs sung by “sound-alikes.” Bette Midler, the plaintiff and appellant here, was done by a sound-alike.

Midler is a nationally known actress and singer. She won a Grammy as early as 1973 as the Best New Artist of that year. Records made by her since then have gone Platinum and Gold. She was nominated in 1979 for an Academy award for Best Female Actress in *The Rose*, in which she portrayed a pop singer. Newsweek in its June 30, 1986 issue described her as an “outrageously original singer/comedian.” Time hailed her in its March 2, 1987 issue as “a legend” and “the most dynamic and poignant singer-actress of her time.”

When Young & Rubicam was preparing the Yuppie Campaign it presented the commercial to its client by playing an edited version of Midler singing “Do You Want To Dance,” taken from the 1973 Midler album, “The Divine Miss M.” After the client accepted the idea and form of the commercial, the agency contacted Midler’s manager, Jerry Edelstein. The conversation went as follows: “Hello, I am Craig Hazen from Young and Rubicam. I am calling you to find out if Bette Midler would be interested in doing . . . ?” Edelstein: “Is it a commercial?” “Yes.” “We are not interested.”

Undeterred, Young & Rubicam sought out Ula Hedwig whom it knew to have been one of “the Harlettes,” a backup singer for Midler for ten years. Hedwig was told by Young & Rubicam that “they wanted someone who could sound like Bette Midler’s recording of [Do You Want To Dance].” She was asked to make a “demo” tape of the song if she was interested. She made an a capella demo and got the job.

At the direction of Young & Rubicam, Hedwig then made a record for the commercial. The Midler record of “Do You Want To Dance” was first played to her. She was told to “sound as much as possible like
the Bette Midler record,” leaving out only a few “aahs” unsuitable for the commercial. Hedwig imitated Midler to the best of her ability.

After the commercial was aired Midler was told by “a number of people” that it “sounded exactly” like her record of “Do You Want To Dance.” Hedwig was told by “many personal friends” that they thought it was Midler singing the commercial. Ken Fritz, a personal manager in the entertainment business not associated with Midler, declares by affidavit that he heard the commercial on more than one occasion and thought Midler was doing the singing.

Neither the name nor the picture of Midler was used in the commercial; Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler’s voice. The district court described the defendants’ conduct as that “of the average thief.” They decided, “If we can’t buy it, we’ll take it.” The court nonetheless believed there was no legal principle preventing imitation of Midler’s voice and so gave summary judgment for the defendants. Midler appeals. . . .

California Civil Code section 3344 is also of no aid to Midler. The statute affords damages to a person injured by another who uses the person’s “name, voice, signature, photograph or likeness, in any manner.” The defendants did not use Midler’s name or anything else whose use is prohibited by the statute. The voice they used was Hedwig’s, not hers. The term “likeness” refers to a visual image not a vocal imitation. The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law; the statute itself implies that such common law causes of action do exist because it says its remedies are merely “cumulative.”

The companion statute protecting the use of a deceased person’s name, voice, signature, photograph or likeness states that the rights it recognizes are “property rights.” By analogy the common law
rights are also property rights. Appropriation of such common law rights is a tort in California. . . .

Why did the defendants ask Midler to sing if her voice was not of value to them? Why did they studiously acquire the services of a sound-alike and instruct her to imitate Midler if Midler’s voice was not of value to them? What they sought was an attribute of Midler’s identity. Its value was what the market would have paid for Midler to have sung the commercial in person.

. . . A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, “the other stands before me.” A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California. Midler has made a showing, sufficient to defeat summary judgment, that the defendants here for their own profit in selling their product did appropriate part of her identity.

NOTES AND QUESTIONS

Why Copyright Wasn’t an Issue. Bobby Freeman wrote the song “Do You Wanna Dance?” and recorded it in 1958. A 1965 cover version by the Beach Boys is perhaps the best known version. Midler herself covered the song, with a jazzier and much slower arrangement, under
the title “Do You Want To Dance?” in 1973. Therefore, Midler did not own the copyright to the song, and her permission was not required for Ford to perform the copyrighted song in the advertisement. Because Ford did not use Midler’s 1973 recording either, it did not need a copyright license for that recording.

**Damages.** On remand, a jury awarded Midler $400,000 from Ford’s ad agency Young & Rubicam (Ford had already exited the case). Midler had asked for damages of $10 million. How should damages be computed in a sound-alike case?

*Waits v. Frito Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), a sound-alike case involving raspy-voiced singer Tom Waits and a radio advertisement for “SalsaRio Doritos,” explores that question. The jury awarded $2.6 million in compensatory and punitive damages and attorneys’ fees against the manufacturer Frito-Lay and its advertising agency Tracy-Locke. The defendants appealed to the Ninth Circuit. That court upheld the award in its entirety, ruling that damages were not limited to economic injury (though the economic value of the use to the advertiser is important for liability). Injury to Waits’ peace, happiness and feelings was also compensable.

He was particularly embarrassed by the ad because it seemed to contradict his anti-commercial stance: “because of his outspoken public stance against doing commercial endorsements, the Doritos commercial humiliated Waits by making him an apparent hypocrite.”

In addition, the jury could award him damages for injury to goodwill (his artistic reputation and reputation for refusing to endorse products). Further, the court upheld an award based on lost future publicity value. If Waits did do a commercial in the future, his asking price would be lowered because of the Doritos ad.
Moreover, the court upheld the punitive damages award, holding that the jury could have found the defendants’ conduct “despicable because they knowingly impugned Waits’ integrity in the public eye,” and that defendants acted in conscious disregard of Waits’s right of publicity.

**Asking Permission.** Businesspeople frequently believe that “it’s better to ask for forgiveness than permission.” Are the *Midler* and *Waits* cases consistent with this maxim? When you are a practicing lawyer, will you prospectively ask IP rightsholders for their consent in ambiguous situations, or do these opinions make you a little gun-shy?

**Singers Closely Identified with Famous Songs.** Assume that ad copy includes a performance of a properly licensed song sung by a non-sound-alike. On publicity rights grounds, can a singer of that song nevertheless object to use of that song because the song is so closely identified with him or her? The answer appears to be no.

*Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) involved Goodyear’s radio and television ads promoting its “wide boots” tires. The ad copy included portions of the song “These Boots Are Made For Walkin’,” a 1966 #1 hit for Nancy Sinatra (the daughter of Frank Sinatra). The ad agency properly secured licenses to the song’s copyrights, owned by Criterion Music (not Sinatra). Sinatra alleged, among other things, “that the song has been so popularized by the plaintiff that her name is identified with it; [and] that she is best known by her connection with the song.” Nevertheless, the Ninth Circuit concluded that her lawsuit was preempted by copyright law.

*Oliveria v. Frito-Lay, Inc.*, 251 F.3d 56 (2nd Cir. 2001), addresses a slightly different situation. Oliveria, who performs under the name “Astrud Gilberto,” sang the well-known 1964 recording of the song “The Girl from Ipanema.” Frito-Lay obtained the proper copyright
licenses to use that recording in a television ad for its baked potato chips. Nevertheless, Oliveria claimed she had become known as the Girl from Ipanema due to the recording’s success and her many subsequent performances of the song. The court rejected Oliveria’s trademark claim because she did not cite “a single precedent throughout the history of trademark supporting the notion that a performing artist acquires a trademark or service mark signifying herself in a recording of her own famous performance.” The court said that Oliveria’s state law claims could be refiled in state court, but Oliveria never did so.

C. A Person’s Image

Visually depicting a person in ad copy is usually squarely covered by the person’s publicity/privacy rights. It might also constitute an endorsement or testimonial, which is discussed later in this chapter. California’s statute also protects against the use of “likenesses,” which probably refers to drawings of people instead of photos or videos of them.

To get around this general rule, some advertisers have hired look-alike actors to portray famous celebrities. As with the sound-alike cases, courts generally have rejected this work-around.

For example, Allen v. National Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985), involved an ad depicting a look-alike of the famous director and actor Woody Allen:

The present action arises from an advertisement, placed by National to promote its nationally franchised video rental chain, containing a photograph of defendant Boroff taken on September 2, 1983. The photograph portrays a customer in a National Video store, an individual in his forties, with a high forehead, tousled hair, and heavy black glasses. The
customer’s elbow is on the counter, and his face, bearing an expression at once quizzical and somewhat smug, is leaning on his hand. It is not disputed that, in general, the physical features and pose are characteristic of plaintiff.

The staging of the photograph also evokes associations with plaintiff. Sitting on the counter are videotape cassettes of “Annie Hall” and “Bananas,” two of plaintiff’s best known films, as well as “Casablanca” and “The Maltese Falcon.” The latter two are Humphrey Bogart films of the 1940’s associated with plaintiff primarily because of his play and film “Play It Again, Sam,” in which the spirit of Bogart appears to the character played by Allen and offers him romantic advice. In addition, the title “Play It Again, Sam” is a famous, although inaccurate, quotation from “Casablanca.”

The individual in the advertisement is holding up a National Video V.I.P. Card, which apparently entitles the bearer to favorable terms on movie rentals. The woman behind the counter is smiling at the customer and appears to be gasping in exaggerated excitement at the presence of a celebrity.
The photograph was used in an advertisement which appeared in the March 1984 issue of “Video Review,” a magazine published in New York and distributed in the Southern District, and in the April 1984 issue of “Take One,” an in-house publication which National distributes to its franchisees across the country. The headline on the advertisement reads “Become a V.I.P. at National Video. We’ll Make You Feel Like a Star.” The copy goes on to explain that holders of the V.I.P. card receive “hassle-free movie renting” and “special savings” and concludes that “you don’t need a famous face to be treated to some pretty famous service.”

The same photograph and headline were also used on countercards distributed to National’s franchisees. Although the advertisement that ran in “Video Review” contained a disclaimer in small print reading “Celebrity double provided by Ron Smith’s Celebrity Look-Alike’s, Los Angeles, Calif.,” no such disclaimer appeared in the other versions of the advertisement.

The defendants explained the look-alike’s appearance in the ad copy this way:

Although defendants concede that they sought to evoke by reference plaintiff’s general persona, they strenuously deny that they intended to imply that the person in the photograph was actually plaintiff or that plaintiff endorsed National. Defendants offer their own interpretation of the advertisement to support their assertion that the photograph does not depict plaintiff. According to defendants, the idea of the advertisement is that even people who are not stars are treated like stars at National Video. They insist that the advertisement depicts a “Woody Allen fan,” so dedicated that
he has adopted his idol’s appearance and mannerisms, who is able to live out his fantasy by receiving star treatment at National Video. The knowing viewer is supposed to be amused that the counter person actually believes that the customer is Woody Allen.

Do you find that explanation credible?

Allen ultimately succeeded on his trademark claim of likely confusion over endorsement, and the court did not definitively resolve his publicity/privacy rights claims because the New York statute covered only a portrait or picture, and the court was unsure that a look-alike could count as a portrait or picture. However, the court’s discussion of those claims is nevertheless useful:


Arrington reaffirms the rule first established in Roberson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442 (1902). The New York Court of Appeals therein rejected an argument, based on the Warren and Brandeis article, that New York should recognize the branch of privacy law which has come to be known as misappropriation of another’s name or likeness. Plaintiff Roberson sought to recover for the humiliation she felt when she discovered that some 25,000 copies of her portrait had been distributed throughout the country without her consent as part of an advertisement for
flour. The court held that no precedent supported plaintiff’s argument, that recognition of such a common law right would result in endless litigation, and that only the legislature could create this new right.

In response to public outcry over the outcome of Roberson, the New York legislature passed sections 50 and 51 of the Civil Rights Law in 1903. In its present form the statute provides that

A person, firm or corporation that uses for advertising purposes, or for purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, is guilty of a misdemeanor.

Section 51 provides in addition that

Any person whose name, portrait or picture is used within the state for advertising purposes or for purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if defendant shall have knowingly used such person’s name, portrait or picture in such a manner as is forbidden or declared to be unlawful by the last section, the jury, in its discretion, may award exemplary damages. . . .
The right to privacy recognized by the Civil Rights law has been strictly construed, both because it is in derogation of New York common law and because of potential conflict with the First Amendment, particularly where public figures are involved. To make out a violation, a plaintiff must satisfy three distinct elements: 1) use of his or her name, portrait, or picture, 2) for commercial or trade purposes, 3) without written permission. Merely suggesting certain characteristics of the plaintiff, without literally using his or her name, portrait, or picture, is not actionable under the statute. Plaintiff here must therefore demonstrate, inter alia, that the advertisement in question appropriates his “portrait or picture.”

In addition to the statutory right to privacy, plaintiff in this case argues that defendants have violated his “right of publicity,” an analogous right recognized in the common law of many jurisdictions. Indeed, until recently, some federal courts assumed that the New York courts would recognize such a common law right independent of that protected by the Civil Rights Law. The elements of the cause of action were deemed to be essentially the same as those provided in the privacy statute, with the additional requirement that the plaintiff have developed a property interest with a monetary value in his or her name or face. Unlike the Civil Rights Law provision, which is primarily designed to compensate for the hurt feelings of private people who find their identities usurped for another’s commercial gain, the right of publicity protects this property interest of the celebrity in his or her public identity. It is primarily this interest which Woody Allen seeks to vindicate in the case at bar.

The New York Court of Appeals, however, recently has held that no separate common law cause of action to vindicate the
right of publicity exists in New York. Stephano v. News Group Publications, Inc., 64 N.Y.2d 174 (1984). The court held, in essence, that the “right of publicity” was merely a misnomer for the privacy interest protected by the Civil Rights Law, as applied to public figures.

By its terms, the statute applies to any use of a person’s picture or portrait for advertising or trade purposes whenever the defendant has not obtained the person’s written consent to do so. . . . Since the “right of publicity” is encompassed under the Civil Rights Law as an aspect of the right of privacy, which, as noted, is exclusively statutory in this state, the plaintiff cannot claim an independent common law right of publicity. . . .

. . . In examining the undisputed facts of this case with reference to plaintiff’s summary judgment motion, it is immediately clear that two of the three prongs of the Civil Rights Law are satisfied. First, there is no question that the photograph said to be of plaintiff was used for commercial purposes, since it appeared in a magazine advertisement soliciting business for National Video franchisees. Second, defendants do not dispute that plaintiff never gave his consent to the use of the photograph, either orally or in writing. It therefore appears that the only element of plaintiff’s case over which there is any serious dispute is whether the photograph is a “portrait or picture” of plaintiff.

Plaintiff argues that Boroff’s physical resemblance to him, when viewed in conjunction with the undeniable attempt to evoke plaintiff’s image through the selection of props and poses, makes the photograph in question a “portrait or picture” of plaintiff as a matter of law. Plaintiff notes that it
is not necessary that all persons seeing the photograph actually identify him, only that he be identifiable from the photograph. Plaintiff contends that it is beyond cavil that some people will recognize him in this photograph. The cited cases, however, involved photographs which were not disputed to be of the plaintiffs; the only question was whether the pictures were too old or too obscure to be recognizable. They do not help us answer the more basic question of whether the photograph in the case at bar is, in fact, a “picture” or “portrait” of plaintiff.

More helpful are a line of cases holding that any recognizable likeness, not just an actual photograph, may qualify as a “portrait or picture.” . . .

Therefore, if defendants had used, for example, a clearly recognizable painting or cartoon of plaintiff, it would certainly constitute a “portrait or picture” within the meaning of the statute. The case of a look-alike, however, is more problematic. A painting, drawing or manikin [sic] has no existence other than as a representation of something or someone; if the subject is recognizable, then the work is a “portrait.” Defendant Boroff, however, is not a manikin [sic]. He is a person with a right to his own identity and his own face. Plaintiff’s privacy claim therefore requires the court to answer the almost metaphysical question of when one person’s face, presented in a certain context, becomes, as a matter of law, the face of another.

This question is not merely theoretical. The use in an advertisement of a drawing, which has no other purpose than to represent its subject, must give rise to a cause of action under the Civil Rights Law, because it raises the obvious implication that its subject has endorsed or is otherwise
involved with the product being advertised. There is no question that this amounts to an appropriation of another’s likeness for commercial advantage.

A living and breathing actor, however, has the right to exploit his or her own face for commercial gain. This right is itself protected by the Civil Rights Law. The privacy law does not prohibit one from evoking certain aspects of another’s personality, but it does prohibit one from actually representing oneself as another person. The look-alike situation falls somewhere in between and therefore presents a difficult question.

As you can see, New York’s approaches to publicity and privacy rights are both simpler and more complex than California’s. California has overlapping statutory and common law publicity rights, while New York has only statutory privacy rights.


We are dealing here with actuality and appearance, where illusion often heightens reality and all is not quite what it seems. Is the illusionist to be free to step aside, having reaped the benefits of his creation, and permitted to disclaim the very impression he sought to create? If we were to permit it, we would be sanctioning an obvious loophole to evade the statute. If a person is unwilling to give his or her endorsement to help sell a product, either at an offered price or at any price, no matter—hire a double and the same effect is achieved. The essential purpose of the statute must be carried out by giving it a common sense reading which bars
easy evasion. If we truly value the right of privacy in a world of exploitation, where every mark of distinctiveness becomes grist for the mills of publicity, then we must give it more than lip service and grudging recognition. Let the word go forth—there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.

Like the *Allen* court, the judge recognized the need to balance the look-alike's own privacy interests, but the court did not demonstrate much sympathy for her plight:

To paint a portrait of Jacqueline Kennedy Onassis is to create a work of art; to look like Jacqueline Kennedy Onassis is not.
Miss Reynolds may capitalize on the striking resemblance of facial features at parties, TV appearances, and dramatic works, but not in commercial advertisements. Similarly, defendant Ron Smith Celebrity Look-Alikes can market its clients for fun and profit in various areas, but may not capitalize on natural resemblance to a well-known person for trade or advertising. No one has an inherent or constitutional right to pass himself off for what he is not.

Another way that advertisers might try to work around the general prohibition against depicting people in ads is by showing only a seemingly unidentifiable portion of the person. For example, the following case addresses ad copy where the people’s faces were not shown.

**Cohen v. Herbal Concepts, 63 N.Y.2d 379 (N.Y. 1984)**

Plaintiffs bring this action pursuant to section 51 of the Civil Rights Law seeking damages from defendants for publishing photographs of them for advertising purposes. It is conceded for purposes of this appeal that plaintiffs are the persons shown in the photographs and that defendants used the photographs as claimed without their consent. The legal issue submitted is whether a photograph of the nude plaintiffs, mother and child, which shows their bodies full length as viewed from a position behind and to the right of them, and which does not show their faces, reveals sufficiently identifiable likenesses to withstand defendants’ motions for summary judgment. We hold that it does.

The action arises from these facts.

On the July 4th weekend in 1977, plaintiffs were visiting friends in Woodstock, New York, and Susan Cohen and her four-year-old daughter, Samantha, went bathing in a stream located on their
friends’ private property. Without their consent, defendant James Krieger took photographs of plaintiffs and subsequently sold them to defendant Herbal Concepts, Inc., a seller and advertiser of consumer products. Herbal Concepts used one of the photographs in an advertisement for Au Naturel, a product designed to help women eliminate body cellulite, those “fatty lumps and bumps that won’t go away.” The advertisement appeared in two editions of *House and Garden*, which is published by defendant Condé Nast Publications, Inc., and in single editions of *House Beautiful* and *Cosmopolitan*, which are published by defendant Hearst Corporation. Ira Cohen subsequently recognized his wife and daughter in the advertisements while reading one of the magazines and this action followed. . . .
... [I]n New York privacy claims are founded solely upon sections 50 and 51 of the Civil Rights Law. The statute protects against the appropriation of a plaintiff’s name or likeness for defendants’ benefit. Thus, it creates a cause of action in favor of “[a]ny person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without . . . written consent.” The action may be brought to enjoin the prohibited use and may also seek damages for any injuries sustained including exemplary damages for a knowing violation of the statute. We are concerned in this case with the appropriation of plaintiffs’ likenesses. Defendants claim that there has been no wrong because even if the photograph depicts plaintiffs, they are not identifiable from it.

The statute is designed to protect a person’s identity, not merely a property interest in his or her “name”, “portrait” or “picture”, and thus it implicitly requires that plaintiff be capable of identification from the objectionable material itself. That is not to say that the action may only be maintained when plaintiff’s face is visible in the advertising copy. Presumably, by using the term “portrait” the Legislature intended a representation which includes a facial reproduction, either artistically or by photograph, but if we are to give effect to all parts of the statute, it applies also to the improper use of a “picture” of plaintiff which does not show the face. Manifestly, there can be no appropriation of plaintiff’s identity for commercial purposes if he or she is not recognizable from the picture and a privacy action could not be sustained, for example, because of the nonconsensual use of a photograph of a hand or a foot without identifying features. But assuming that the photograph depicts plaintiff, whether it presents a recognizable likeness is generally a jury question unless plaintiff cannot be identified because of the limited subject matter revealed in the photograph or the quality of the image. Before a jury may be permitted to decide the issue, to survive a motion for summary judgment, plaintiff must satisfy the court that the person in the photograph is capable of being identified.
from the advertisement alone and that plaintiff has been so identified.

The sufficiency of plaintiff's evidence for purposes of the motion will necessarily depend upon the court's determination of the quality and quantity of the identifiable characteristics displayed in the advertisement and this will require an assessment of the clarity of the photograph, the extent to which identifying features are visible, and the distinctiveness of those features. This picture depicts two nude persons, a woman and a child, standing in water a few inches deep. The picture quality is good and there are no obstructions to block the view of the subjects. The woman is carrying a small unidentified object in her left hand and is leading the child with her right hand. Neither person's face is visible but the backs and right sides of both mother and child are clearly presented and the mother's right breast can be seen. The identifying features of the subjects include their hair, bone structure, body contours and stature and their posture. Considering these factors, we conclude that a jury could find that someone familiar with the persons in the photograph could identify them by looking at the advertisement. Although we do not rely on the fact, it is also reasonable to assume that just as something in the advertising copy may aid recognition, identifiability may be enhanced also in photograph depicting two persons because observers may associate the two and thus more easily identify them when they are seen together.

The plaintiffs also submitted evidence that they were identified as the persons in defendants' advertisement by Ira Cohen's affidavit in which he stated that while leafing through one of defendants' magazines he “recognized [his] wife and daughter immediately.” That was prima facie sufficient.

Defendants contend Mr. Cohen's affidavit is not probative on the issue of identification because he was present when the photograph
was taken, as indeed he was. He was not only present, he was incensed by the photographer’s intrusion and chased him away. Essentially, defendants’ contention is that Mr. Cohen’s identification is tainted by this independent knowledge that plaintiffs were photographed by defendant Krieger while bathing. Although Mr. Cohen’s presence when the photograph was taken may have increased his ability to identify his wife and child, the motion court or the jury at trial could conclude that he also recognized them from the photograph and his presence when it was taken, standing alone, does not disqualify him from offering evidence that he did so. . . .

NOTES AND QUESTIONS

Other Causes of Action? Could the Cohens have sued the photographer for harassment or public disclosure of private facts (discussed in Chapter 14)? Would the property owner have a claim against the photographer for trespass? Could the advertisers be secondarily liable for that trespass? See the Burgess case discussed in Chapter 16 as well as California Civil Code § 1708.08 (colloquially referred to as the “California anti-paparazzi statute”), which says in part:

(a) A person is liable for physical invasion of privacy when the defendant knowingly enters onto the land of another person without permission or otherwise committed a trespass in order to physically invade the privacy of the plaintiff with the intent to capture any type of visual image, sound recording, or other physical impression of the plaintiff engaging in a personal or familial activity and the physical invasion occurs in a manner that is offensive to a reasonable person . . .

(f) (1) The transmission, publication, broadcast, sale, offer for sale, or other use of any visual image, sound recording, or other physical impression that was taken or captured in
violation of subdivision (a) . . . shall not constitute a violation of this section unless the person, in the first transaction following the taking or capture of the visual image, sound recording, or other physical impression, publicly transmitted, published, broadcast, sold or offered for sale, the visual image, sound recording, or other physical impression with actual knowledge that it was taken or captured in violation of subdivision (a) . . . and provide compensation, consideration, or remuneration, monetary or otherwise, for the rights to the unlawfully obtained visual image, sound recording, or other physical impression.

Under a statute like this, could Herbal Concepts have been liable for buying the photos from Krieger? How would this statute fare in a constitutional challenge?

**Recreating the Photo.** If the advertiser and photographer liked the scene so much, would there be any restrictions on them recreating the scene with paid models?

**Identifiability.** Has the identifiability of people gone up over time? For example, many people now have distinctive tattoos, and automatic facial recognition technology continues to improve. Furthermore, it has become fairly common for a seemingly obscure person in a photograph to become uniquely identified when seen by millions of Internet users. See, e.g., Jonathan Krim, *Subway Fracas Escalates into Test of the Internet’s Power to Shame*, WASH. POST, July 7, 2005 (discussing the naming and shaming of the South Korean “dog poop girl”). More generally, the segregation of information into “personally identifiable” (like a face) and “non-personally identifiable” (like a photo of a person’s back) may be a technological and legal fiction. Cf. Paul Ohm, *Broken Promises of Privacy: Responding to the Surprising Failure of Anonymization*, 57 UCLA L. REV. 1701 (2010).
One possible inference is that it may be impossible to use an unconsented photograph of a person in ad copy, even if his or her face isn’t shown, because anyone in ad copy can become personally identifiable if enough people see the photo; inevitably, someone will personally know the individual and be able to connect the identity. In the Cohen case, recall the only person who could identify the depicted individuals definitively was the husband, who was at the scene.

**Identifiability When the Person Isn’t Shown at All.** Because the photos depicted the individuals’ backside, the Cohen case involves somewhat attenuated identifiability. But just how far can we push the identifiability concept? Could a person be visually identified if you couldn’t see the person at all?

Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) involved the following facts:

Plaintiff Motschenbacher is a professional driver of racing cars, internationally known and recognized in racing circles and by racing fans. He derives part of his income from manufacturers of commercial products who pay him for endorsing their products.

During the relevant time span, plaintiff has consistently “individualized” his cars to set them apart from those of other drivers and to make them more readily identifiable as his own. Since 1966, each of his cars has displayed a distinctive narrow white pinstripe appearing on no other car. This decoration has adorned the leading edges of the cars’ bodies, which have uniformly been solid red. In addition, the white background for his racing number “11” has always been oval, in contrast to the circular backgrounds of all other cars.
In 1970, defendants, R. J. Reynolds Tobacco Company and William Esty Company, produced and caused to be televised a commercial which utilized a “stock” color photograph depicting several racing cars on a racetrack. Plaintiff’s car appears in the foreground [sic], and although plaintiff is the driver, his facial features are not visible.

In producing the commercial, defendants altered the photograph: they changed the numbers on all racing cars depicted, transforming plaintiff’s number “11” into “71”; they “attached” a wing-like device known as a “spoiler” to plaintiff’s car; they added the word “Winston,” the name of their product, to that spoiler and removed advertisements for other products from the spoilers of other cars. However, they made no other changes, and the white pinstriping, the oval medallion, and the red color of plaintiff’s car were retained. They then made a motion picture from the altered photograph, adding a series of comic strip-type “balloons” containing written messages of an advertising nature; one such balloon message, appearing to emanate from plaintiff, was: “Did you know that Winston tastes good, like a cigarette should?” They also added a sound track consisting in part of voices coordinated with, and echoing, the written messages. The commercial was subsequently broadcast nationally on network television and in color.
Several of plaintiff’s affiants who had seen the commercial on television had immediately recognized plaintiff’s car and had inferred that it was sponsored by Winston cigarettes.

On the question of identifiability, the court concluded:

[T]he “likeness” of plaintiff is itself unrecognizable; however, the [district] court’s further conclusion of law to the effect that the driver is not identifiable as plaintiff is erroneous in that it wholly fails to attribute proper significance to the distinctive decorations appearing on the car. As pointed out earlier, these markings were not only peculiar to the plaintiff’s cars but they caused some persons to think the car in question was plaintiff’s and to infer that the person driving the car was the plaintiff.
As a result, the court said that Motschenbacher stated a cause of action for a publicity/privacy rights violation. In effect, the court said that even though viewers could not see Motschenbacher personally, his rights were nevertheless violated because his uniquely identifiable car was depicted. Thus, publicity/privacy rights can extend much further than simply protecting depictions of people.

*Scope of Consent.* Advertisers can run into trouble even when they get consent from the depicted individual. Consider the following ad for a law firm:

The depicted firefighter, Robert Keiley, joined the FDNY in 2004—three years after 9/11. Therefore, he was not “there.” Keiley signed a
broad publicity consent, but he says he thought that his depiction would be used in a fire prevention ad and the 9/11 picture was photoshopped into his hands. See Reuven Fenton & Jennifer Fermino, Law Firm’s Ad Trick a 9/11 ‘Insult,’ N.Y. POST, March 28, 2011. Did the law firm or its ad agency do anything wrong?

Labor Union Relations. Many advertising agencies and some large advertisers have signed agreements with actors’ labor unions, such as the Screen Actors Guild (SAG) and the American Federation of Television and Radio Artists (AFTRA). Each agreement should be reviewed carefully, but in general they (1) require that advertisers use only union members as actors in advertisements (with some exceptions, such as showing a company employee doing his or her normal job), and (2) specify minimum payments to actors, including payments for pensions and health benefits as well as “residuals” (ongoing payments for continued use of the ad copy).

D. Evoking a Persona

As we’ve seen, courts apply the publicity/privacy rights doctrines quite expansively when ad copy includes any potentially identifiable part of a person—his or her face, body or voice (even a sound-alike). But what if ad copy incorporates none of these personal attributes, and no one would think that a celebrity actually appeared in the ad (as viewers might have in Motsenbacher), and yet a celebrity persona is still identifiable? As the next case indicates, publicity rights can be stretched to cover that situation too.

White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9th Cir. 1993)

KOZINSKI, Circuit Judge, dissenting from a request for an en banc rehearing.
. . . The panel’s opinion is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority’s opinion, it’s now a tort for advertisers to remind the public of a celebrity. Not to use a celebrity’s name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity’s image in the public’s mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright Clause. It raises serious First Amendment problems. It’s bad law, and it deserves a long, hard second look.

II

Samsung ran an ad campaign promoting its consumer electronics. Each ad depicted a Samsung product and a humorous prediction: One showed a raw steak with the caption “Revealed to be health food. 2010 A.D.” Another showed Morton Downey, Jr. in front of an American flag with the caption “Presidential candidate. 2008 A.D.” The ads were meant to convey—humorously—that Samsung products would still be in use twenty years from now.

The ad that spawned this litigation starred a robot dressed in a wig, gown and jewelry reminiscent of Vanna White’s hair and dress; the robot was posed next to a Wheel-of-Fortune-like game board. The caption read “Longest-running game show. 2012 A.D.” The gag here, I take it, was that Samsung would still be around when White had been replaced by a robot.*

* [Editor’s note: As of 2014, Vanna White still works on Wheel of Fortune, a position she has held since 1982, though she actually stopped physically turning letters in 1997. For what it’s worth, steak became a central part of the Atkins Diet fad in the early 2000s, and although Morton Downey Jr. did not run for president in 2008, actor Fred Thompson did, and many other actors have won high office, including Ronald Reagan (president), Al Franken]
(U.S. senator from Massachusetts), Jesse Ventura (Minnesota governor) and Arnold Schwarzenegger (California governor).]
Perhaps failing to see the humor, White sued, alleging Samsung infringed her right of publicity by “appropriating” her “identity.” Under California law, White has the exclusive right to use her name, likeness, signature and voice for commercial purposes. But Samsung didn’t use her name, voice or signature, and it certainly didn’t use her likeness. The ad just wouldn’t have been funny had it depicted White or someone who resembled her—the whole joke was that the game show host(ess) was a robot, not a real person. No one seeing the ad could have thought this was supposed to be White in 2012.

The district judge quite reasonably held that, because Samsung didn’t use White’s name, likeness, voice or signature, it didn’t violate her right of publicity. Not so, says the panel majority: The California right of publicity can’t possibly be limited to name and likeness. If it were, the majority reasons, a “clever advertising strategist” could avoid using White’s name or likeness but nevertheless remind people of her with impunity, “effectively eviscerat[ing]” her rights. To prevent this “evisceration,” the panel majority holds that the right of publicity must extend beyond name and likeness, to any “appropriation” of White’s “identity”—anything that “evoke[s]” her personality.
But what does “evisceration” mean in intellectual property law? Intellectual property rights aren’t like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant. They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation. I can’t publish unauthorized copies of, say, *Presumed Innocent*; I can’t make a movie out of it. But I’m perfectly free to write a book about an idealistic young prosecutor on trial for a crime he didn’t commit. So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I “eviscerated” Scott Turow’s intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy.

The majority isn’t, in fact, preventing the “evisceration” of Vanna White’s existing rights; it’s creating a new and much broader property right, a right unknown in California law. It’s replacing the existing balance between the interests of the celebrity and those of the public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her. After all, that’s all Samsung did: It used an inanimate object to remind people of White, to “evoke [her identity].”

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It’s not the robot’s wig, clothes or jewelry; there must be ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White’s. It’s that the robot is posed near the “Wheel of Fortune” game board. Remove the game board from the ad, and no one would think of Vanna White.
But once you include the game board, anybody standing beside it—a brunette woman, a man wearing women’s clothes, a monkey in a wig and gown—would evoke White’s image, precisely the way the robot did. It’s the “Wheel of Fortune” set, not the robot’s face or dress or jewelry that evokes White’s image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living . . .

The intellectual property right created by the panel here has [no] essential limitations: No fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of “appropriation of identity,” claims often made by people with a wholly exaggerated sense of their own fame and significance. Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own. The public will be robbed of parodies of celebrities, and our culture will be deprived of the valuable safety valve that parody and mockery create.

Moreover, consider the moral dimension, about which the panel majority seems to have gotten so exercised. Saying Samsung “appropriated” something of White’s begs the question: Should White have the exclusive right to something as broad and amorphous as her “identity”? Samsung’s ad didn’t simply copy White’s schtick—like all parody, it created something new. True, Samsung did it to make money, but White does whatever she does to make money, too; the majority talks of “the difference between fun and profit,” but in the entertainment industry fun is profit. Why is Vanna White’s right to exclusive for-profit use of her persona—a persona that might not even be her own creation, but that of a writer, director or producer—superior to Samsung’s right to profit by creating its own inventions?
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Why should she have such absolute rights to control the conduct of others, unlimited by the idea-expression dichotomy or by the fair use doctrine? . . .

VI

Finally, I can’t see how giving White the power to keep others from evoking her image in the public’s mind can be squared with the First Amendment. Where does White get this right to control our thoughts? The majority’s creation goes way beyond the protection given a trademark or a copyrighted work, or a person’s name or likeness. All those things control one particular way of expressing an idea, one way of referring to an object or a person. But not allowing any means of reminding people of someone? That’s a speech restriction unparalleled in First Amendment law. . . .

The majority dismisses the First Amendment issue out of hand because Samsung’s ad was commercial speech. So what? Commercial speech may be less protected by the First Amendment than noncommercial speech, but less protected means protected nonetheless. And there are very good reasons for this. Commercial speech has a profound effect on our culture and our attitudes. Neutral-seeming ads influence people’s social and political attitudes, and themselves arouse political controversy. “Where’s the Beef?” turned from an advertising catchphrase into the only really memorable thing about the 1984 presidential campaign. Four years later, Michael Dukakis called George Bush “the Joe Isuzu of American politics.”

In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared. Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a
celebrity’s identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add something, perhaps something worthwhile and memorable, perhaps not, to our culture. Both are things that the people being portrayed might dearly want to suppress.

Commercial speech is a significant, valuable part of our national discourse. The Supreme Court has recognized as much, and has insisted that lower courts carefully scrutinize commercial speech restrictions, but the panel totally fails to do this.

VII

For better or worse, we are the Court of Appeals for the Hollywood Circuit. Millions of people toil in the shadow of the law we make, and much of their livelihood is made possible by the existence of intellectual property rights. But much of their livelihood—and much of the vibrancy of our culture—also depends on the existence of other intangible rights: The right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun, the cultural icons of our time.

In the name of avoiding the “evisceration” of a celebrity’s rights in her image, the majority diminishes the rights of copyright holders and the public at large. In the name of fostering creativity, the majority suppresses it. Vanna White and those like her have been given something they never had before, and they’ve been given it at our expense. I cannot agree.
NOTES AND QUESTIONS

Denouement. White ultimately won $403,000 in damages in the case.

Who Owns the Right? Let’s assume that Samsung did, in fact, tortiously evoke White’s role in its ads. Who is the proper plaintiff—White, the Wheel of Fortune producers, both, or neither?

In Wendt v. Host International, Inc., 197 F.3d 1284 (9th Cir. 1999), Judge Kozinski again dissented from the denial of an en banc hearing. He summarized the case:

Robots again. In White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992), we held that the right of publicity extends not just to the name, likeness, voice and signature of a famous person, but to anything at all that evokes that person’s identity. The plaintiff there was Vanna White, Wheel of Fortune letter-turner extraordinaire; the offending robot stood next to a letter board, decked out in a blonde wig, Vanna-style gown and garish jewelry. Dissenting from our failure to take the case en banc, I argued that our broad application of the right of publicity put state law on a collision course with the federal rights of the copyright holder.

The conflict in White was hypothetical, since the defendant (Samsung) did not have a license from the Wheel of Fortune copyright holder. Here it is concrete: The panel holds that licensed animatronic figures based on the copyrighted Cheers characters Norm and Cliff infringe on the rights of the actors who portrayed them. As I predicted, White’s voracious logic swallows up rights conferred by Congress under the Copyright Act.
Though a bit dated now, Cheers remains near and dear to the hearts of many TV viewers. Set in a friendly neighborhood bar in Boston, the show revolved around a familiar scene. Sam, the owner and bartender, entertained the boys with tales of his glory days pitching for the Red Sox. Coach piped in with sincere, obtuse advice. Diane and Frasier chattered self-importantly about Lord Byron. Carla terrorized patrons with acerbic comments. And there were Norm and Cliff, the two characters at issue here. Norm, a fat, endearing, oft-unemployed accountant, parked himself at the corner of the bar, where he was joined by Cliff, a dweebish mailman and something of a know-it-all windbag. After eleven years on the air, the gang at Cheers became like family to many fans, ensuring many more years in syndication.

Defendant Host International decided to tap into this keg of goodwill. After securing a license from Paramount, the copyright holder, Host opened a line of Cheers airport bars. To help get patrons into a Cheers mood, Host populated the bars with animatronic figures resembling Norm and Cliff: One is fat; the other is dressed as a mailman.\footnote{In a half-hearted attempt to avoid litigation, Host changed the robots’ names to “Hank” and “Bob.”}
Plaintiffs George Wendt and John Ratzenberger, the only actors who ever portrayed Norm and Cliff, sued Host for unfair competition and violation of their right of publicity. Paramount intervened, claiming that its copyright preempted any claim Wendt and Ratzenberger might have under state law. The district court granted summary judgment for the defendants because it found that the robots didn’t look like the plaintiffs: “[T]here is [no] similarity at all . . . except that one of the robots, like one of the plaintiffs, is heavier than the other. . . . The facial features are totally different.” Relying on White, the panel here reverses but offers little explanation beyond the curt assertion that “material facts exist that might cause a reasonable jury to find [the robots] sufficiently ‘like’ [Wendt and Ratzenberger] to violate” their right of publicity.

After the case was remanded to the district court, the parties settled.

While Wendt is not an advertising law case per se, it does indicate that obtaining a copyright license to fictional characters may not be enough to use the fictional characters in ad copy. Where an actor may be publicly associated with the character, the actor’s publicity rights mean consent also may be necessary. Ideally, the producers of the fictional work obtain permission from the actor to relicense his or her publicity rights as part of a copyright license. Otherwise, separate permissions from both the copyright holder and the actor may be required.

For more on the White case and its implications for the boundaries of publicity rights, see Stacey Dogan, An Exclusive Right to Evoke, 44 B.C. L. REV. 291 (2003).

Under this precedent, if ad copy depicts an empty Cleveland Cavaliers jersey with the number 23, has the advertiser violated LeBron James’s publicity rights? (Ignore any trademark issues, and
assume this is during the time when LeBron James is a member of the Cavaliers’ team).

3. **Endorsements and Testimonials**

As the previous sections have explored, ads using real people may require their consent even if the ad contains nothing untruthful about them. Still, under certain circumstances, consent may be insufficient.

When ad copy depicts a person voicing a fact or opinion, the person’s statements might qualify as an endorsement or testimonial. The FTC’s Guides Concerning the Use of Endorsements and Testimonials in Advertising (16 C.F.R. Part 255), designed to clarify the FTC’s Section 5 powers, define an “endorsement” and “testimonial” (the FTC equates the two) as:

> any advertising message (including verbal statements, demonstrations, or depictions of the name, signature, likeness or other identifying personal characteristics of an individual or the name or seal of an organization) that consumers are likely to believe reflects the opinions, beliefs, findings, or experiences of a party other than the sponsoring advertiser, even if the views expressed by that party are identical to those of the sponsoring advertiser.

While this definition is not especially clear, it is intended to exclude the statements of people that consumers are likely to recognize as actors hired by the advertiser. A paradigmatic endorsement is when a celebrity personally vouches for the product’s quality; a paradigmatic testimonial is when a person describes his or her experiences with the product (such as the amount of weight lost using a diet aid) or is depicted in before/after pictures. Actors playing out an obviously fictional or hypothetical scripted scene in an advertisement aren’t making endorsements or testimonials.
Some of the key portions of the Endorsement and Testimonials Guidelines provide that:

- endorsements must reflect the endorser’s actual beliefs or experiences
- endorsers may not make representations that would be deceptive if made by the advertiser
- if the ad copy says an endorser uses the product, that must be true
- if the ad copy represents that the endorser is an expert, the endorser must have the requisite qualifications
- the advertiser must disclose any unexpected connections with the endorser that would affect the endorsement’s credibility

Many of these guidelines are not controversial in the abstract. They are logical extensions of general false advertising principles. However, specific applications can raise tricky issues.

For example, in the fall of 2009, the FTC amended the guidelines to expressly govern online product reviews. The FTC stated particular concern about situations where an advertiser provided some financial benefit–such as free product samples—to a blogger to write a blog post. When the advertiser gives the blogger a benefit, even as tiny as a free product sample, the FTC believes the blog post becomes a paid endorsement or testimonial, so the blogger must prominently disclose the payment to avoid misleading the readers about the putative authenticity of the blogger’s views.

The FTC’s position creates some awkward line-drawing between traditional journalists, who the FTC thinks do not need to disclose receiving free product samples if they do so as part of their jobs, and identically situated bloggers, who do need to make such disclosures. Not only did the FTC have weak justifications for its Internet exceptionalism, but the FTC’s position purports to regulate what
most people would consider “editorial content” (the blog post), not commercial speech or advertising.

New ad contexts are also relevant. When a celebrity appears in a traditional thirty-second ad, her status as paid endorser is obvious to consumers. But what if the celebrity appears on a nighttime talk show and casually mentions how much better she’s doing now that she’s using a particular weight loss program? The FTC’s guidelines specify that, if it would not be obvious to most consumers that she was being paid as a spokesperson by the weight loss program, then her casual reference to the weight loss program would be a paid endorsement/testimonial—meaning she would need to disclose that fact when she drops the casual reference; and, because she is a spokesperson, what she says on the talk show is subject to the same substantiation requirements as an ordinary ad would be.

In one case, the security company ADT paid three people over $300,000 to appear on television shows, including the Today Show and local newscasts, and post content online, including on blogs. These endorsers were touted as “The Safety Mom,” a home security expert, or a tech expert. They reviewed products including ADT’s security system, which they described as “amazing” or “incredible,” and touted its capabilities, safety benefits, and cost. ADT set up these interviews through its PR firms and booking agents, providing reporters and anchors with suggested interview questions and background video. The experts never disclosed their payments from ADT.

The FTC brought an enforcement action against ADT. The resulting consent order prohibited ADT from misrepresenting that any discussion or demonstration of its products or services was an independent review by an impartial expert, required ADT to clearly and prominently disclose any material connections with the experts, and required ADT to remove existing reviews and endorsements that
had been misrepresented as independent or that failed to disclose a material connection. See In re ADT LLC, FTC File No. 122 3121 (Mar. 11, 2014).

Why do you think the FTC is concerned with such situations? Without this rule, would advertisers be able to disseminate unsubstantiated claims, or are there other constraints on advertisers that might block abuse of this loophole? What do reasonable consumers expect when they see a celebrity or “expert” touting some product or service in an “interview” by a reporter associated with a TV station? If the interviewee makes only vague, general statements, would that be puffery? Even if consumers don’t understand that she’s a paid spokesperson, are they harmed if all she does is puff?

Fabricated Endorsements and the David Manning Incident

Sometimes, advertisers simply fabricate endorsements, such as fake online consumer reviews touting the advertiser’s offerings or bashing rivals’ offerings. See, e.g., Press Release, New York Office of the Attorney General, A.G. Schneiderman Announces Agreement With 19 Companies To Stop Writing Fake Online Reviews And Pay More Than $350,000 In Fines, Sept. 23, 2013 (announcing settlements with numerous companies that had written fake consumer reviews for themselves on websites such as Yelp, Google Local, and CitySearch).

However, fake endorsements are hardly new. Sony’s David Manning incident provides a useful case study.

For about a year starting in 2000, Sony’s Columbia Pictures ran advertisements for several movies containing laudatory comments from “David Manning,” identified as a movie reviewer for the Ridgefield (Conn.) Press. While the Ridgefield Press is a real newspaper, David Manning was a fictitious person, and the quotes attributed to Manning were all fabricated. Why a Sony employee
chose to engage in this artifice is baffling; as one journalist wrote, “[t]he shocking part is that practically every movie these days, good or bad, garners [a] poster-friendly blurb from some critic—even no-name hacks toiling for virtually unknown publications.” Josh Grossberg, *Sony’s Fake Critic Fallout*, E! Online, June 6, 2001.

A *Newsweek* article on June 2, 2001, exposed Sony’s ruse. Legal proceedings ensued.

Several private consumer class action lawsuits were brought against Sony for false advertising, unfair competition and related claims. Sony tried to dismiss one such lawsuit on the grounds that its advertisements were protected by California’s anti-SLAPP statute, which applies to certain types of speech. In *Rezec v. Sony Pictures Entertainment*, 116 Cal. App. 4th 135 (Cal. App. Ct. 2004), a divided California appellate court rejected Sony’s dismissal attempt because the ads were commercial speech, which the court said is not protected by anti-SLAPP laws.

Sony subsequently settled the class action lawsuit for an announced value of $1.5 million, including $500,000 allocated to consumers who saw some of the movies advertised using the fake quotes. Perhaps not surprisingly, only 170 consumers’ claims—totaling less than $5,100—were tendered. See William Booth, *Big Payday for Lawyers In Sony Fake-Blurb Deal*, WASH. POST, Sept. 10, 2005. Sony gave the remaining amount to charity.

Several attorneys general also explored actions against Sony. Sony settled with Connecticut’s attorney general for $325,000, plus the promise to stop using fake quotes and showing ads depicting employees giving enthusiastic fake testimonials (a common practice among movie studios at the time).
Although legitimate advertisers like Sony can be caught playing around with fake endorsements, it’s more likely you’ll be asked if an advertiser can republish a truthful endorsement. For example, assume that a consumer voluntarily publishes a favorable experience with the advertiser’s product on the consumer’s blog, or a newspaper publishes an interview with a celebrity where the celebrity mentions that she enjoys the advertiser’s product (or recall the Katherine Heigl situation discussed above, where a photo depicted her carrying a Duane Reade bag in public). The advertiser might wish to republish these favorable statements in its ad copy.

Obviously, the advertiser could do so if it procures the person’s consent, but is consent required? As we have seen often, advertisers can have difficulty obtaining consent, especially from celebrities. The endorser has already publicly made the favorable statements, so the advertiser just wants to disseminate these already-expressed views more broadly.

Although republishing unconsented endorsements or testimonials in ads may sound innocuous, it is a legally uncertain practice. The multi-year legal battle between the Consumers Union (the publisher of Consumer Reports) and Regina (a vacuum manufacturer) illustrates some of the legal conundrums posed by the truthful republication of an endorsement. See Consumers Union of United States, Inc. v. The New Regina Corp., 664 F. Supp. 753 (S.D.N.Y. 1987). The court describes the background:

The July 1983 issue of Consumer Reports contained an article that evaluated and compared eighteen different models of lightweight vacuum cleaners. Defendant Regina manufactured four of the models tested. The article judged Regina’s Elictrikbroom Powerteam HB 6910 (“Powerteam...
6910”) to be the best of all models tested. CU check-rated the model, signifying that the model was of high quality and appreciably superior to the other models that had not been check-rated. CU rated the three other Regina models from fair to poor.

On June 28, 1983, counsel for Regina requested permission from Consumers Union to quote the favorable evaluation of the Powerteam 6910 in an advertising campaign. Through counsel, CU denied permission. Sometime between July and September, 1983, Regina hired Grey Advertising to create a series of television commercials for the Powerteam 6910. Two of the commercials were eventually broadcast on network television. On September 27, 1983, Regina notified Consumers Union that it had begun airing the television commercials which quoted verbatim from the evaluation of the Powerteam 6910. The first commercial, entitled “Squid,” featured a voice over announcer who states that the Powerteam 6910 is “the only lightweight that Consumer Reports says was an adequate substitute for a full size vacuum.” While the announcer is speaking, a disclaimer appears on the screen noting that “Consumer Reports is not affiliated with Regina and does not endorse products.” The second commercial, entitled “Consumer Reports,” includes several verbatim quotations from the evaluation of the Powerteam 6910. [The four quotes: (1) And Consumer Reports states, “Regina Powerteam—far ahead of the pack in cleaning ability.” (2) Of all the lightweights tested “only one worked well.” (3) On medium pile carpeting Powerteam “did the job with the least effort.” (4) In fact, it’s the only one Consumer Reports calls an “adequate substitute for a full-sized vacuum.”] These quotations flash on the screen as the announcer reads them. Each time the announcer mentions
Consumer Reports, the same disclaimer used in Squid appears on the screen.

After viewing the commercials, CU demanded that Regina withdraw them immediately. Regina refused. The company did, however, alter the disclaimer to read that “Consumer Reports is not affiliated with Regina and does not endorse Regina products or any other products.”
On the surface, the legal problems may be hard to see. Regina used, at most, five short quotations, attributed its source (as, indeed, it may be required to do), and disclaimed any affiliation with the source.

Perhaps some of the problem lies with the unique nature of Consumers Union and *Consumer Reports*. The court describes:

CU is a New York not-for-profit corporation organized in 1936. CU’s primary purpose is independently to test consumer products and to publish the test results and evaluations in its monthly magazine *Consumer Reports*. Circulation of *Consumer Reports* exceeds three million copies per month. CU copyrights each issue of *Consumer Reports*.

CU alleges that it has gained a reputation over the past fifty years for impartial and objective testing of and reporting on consumer products. To foster and maintain its reputation for objectivity, CU follows a non-commercialization policy. Under that policy the organization accepts no outside advertising in any of its publications and has steadfastly refused to grant permission to others to use its name or copyrighted materials in advertisements.\(^2\) CU contends that this arms-length relationship with manufacturers distinguishes it from other testing organizations and publishers which provide consumer advice. CU further asserts that were manufacturers routinely permitted to utilize its published evaluations and to associate its name with their products in advertising

\(^2\) Since 1936 each issue of *Consumer Reports* has stated in substance: Consumers Union accepts no advertising or product samples and is not beholden in any way to any commercial interest. Its Ratings and product reports are solely for the use of readers of *CONSUMER REPORTS*. Neither the Ratings nor the reports may be used in advertising or for any commercial purpose. CU will take all steps open to it to prevent such uses of its material, its name, or the name of *CONSUMER REPORTS*. 
campaigns, the public would lose confidence in CU’s neutrality.

As a result, Consumers Union sued Regina for the advertisements principally on trademark and copyright grounds. The district court initially granted Consumers Union a preliminary injunction on copyright grounds. Regina appealed that to the Second Circuit, which reversed the injunction and sent the case back to the district court. Consumers Union of United States, Inc. v. General Signal Corp. 724 F.2d 1044 (2d Cir. 1983), *reh’g and reh’g en banc denied*, 730 F.2d 47 (2d Cir. 1984), *cert. denied*, 469 U.S. 823 (1984). In the 1987 ruling, Regina sought summary judgment. The district court refused.

On the copyright claim, Regina argued fair use, so the court assumed the validity of Consumers Union’s copyright and “that defendants’ quotation of portions of the Consumer Reports evaluation infringed CU’s copyright.” That seems like a significant concession for Regina to make. Do you think Regina took copyrightable portions of Consumers Union’s copyrights? (Would you have noticed the potential copyright issue in quoting a consumer’s online review of your client’s product?)

With respect to Regina’s copyright fair-use argument, “drawing the necessary inferences in plaintiff’s favor, the Court concluded 1) that defendants have not demonstrated that they are entitled to prevail on the defense of fair use as a matter of law, and 2) that triable issues of fact concerning harm to CU’s copyright remain.”

Regarding the Lanham Act claim, the court said that the “ultimate issue in this case is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled into believing that CU sponsored or otherwise approved the use of its mark in defendants’ advertisements.” To establish this,
Consumers Union conducted two consumer surveys. The surveys indicated that 19% of consumers who saw the “Squid” ad and 23% of those who saw the “Consumer Reports” ad agreed that *Consumer Reports* was “affiliated” with Regina. The remainder either could not tell (48% for “Squid”/22% for “Consumer Reports”) or answered “no” (33%/55%). Based on the ad, 9% of those who saw “Squid” thought Consumer Reports had been paid for the use of its name, and 25% of those who saw “Consumer Reports” did so. Similar percentages of consumers thought Regina had paid *Consumer Reports* to test its product.

In a second survey, “27% of those viewing ‘Squid’ and 45% of those viewing ‘Consumer Reports’ believed, based on the Commercial, that *CONSUMER REPORTS* had authorized the use of its name in the Commercials (those who responded “cannot tell” numbered 64%/46%); while “13% of those viewing ‘Squid’ and 19% of those viewing ‘Consumer Reports’ believed, based on the Commercial, that *CONSUMER REPORTS* was affiliated with Regina (those who could not tell numbered 52%/29%); “15% of those viewing ‘Squid’ and 16% of those viewing ‘Consumer Reports’ believed, based on the Commercial, that *CONSUMER REPORTS* had been paid for the use of its name;” and nearly identical percentages believed that Regina had paid *Consumer Reports* to test its product.

As usual, Regina objected to the survey, but let’s assume the survey results are scientifically defensible. What do the results tell you about likely confusion over endorsement? In general, the ad where Regina mentioned *Consumer Reports* four times had more problematic numbers than the ad where Regina mentioned the magazine only once. What do you think the “baseline” level of confusion is?

Based on the survey numbers, the court also said that it was not clear whether Regina’s disclaimers had effectively dispelled the confusion.
The court also sidestepped Regina’s First Amendment defense. Thus, Regina could not avoid a trial on these claims.

NOTES AND QUESTIONS

Would it change the result if Regina used the same quotes but attributed them in a different manner? Say, “to a leading independent testing organization” or “a leading consumer review publication.” That would not resolve any copyright problems, but does it resolve the implied endorsement problem? Would such an ad be as desirable to Regina? Under the substantiation doctrine, how precisely must Regina identify the source of comparative factual claims?

When publicity rights are in play, the legal decisions are even less clear. For example, in 2007, Oprah said Ciao Bella Blood Orange Sorbetto was one of her “favorite things.” Can Ciao Bella advertise this fact without obtaining Oprah’s permission? Without Oprah’s permission, Ciao Bella would have to avoid any copyright issues, trademark issues (“Oprah” is a trademark) and publicity rights issues for using Oprah’s name in the ad copy. How would the publicity rights analysis look? How does the general lack of judicial sympathy shown toward advertisers in this chapter color your analysis?

New York Times reviewer A.O. Scott found a partial tweet of his displayed in a full-page ad for a film, edited to look like a complete tweet. Scott was disturbed by this result, and suggested that it shouldn’t have happened without his approval. What’s different here than the standard practice of quoting published film reviews in movie ads (often without the reviewer’s permission)? See Margaret Sullivan, *When a (Partial) Tweet Becomes an Ad, What Are the Rules?*, N.Y. TIMES, Jan. 6, 2014. Is the standard practice itself a publicity rights problem?
Pinterest. eSalon makes custom hair color. It has a Pinterest page called Hair Colors We Love with pictures of celebrities. (Pinterest is a website where users can easily curate and present photos from other sources by “pinning” the photos to a user-controlled page). The NAD found that the photos implied that the celebrities endorsed eSalon products, and recommended that eSalon only pin photos of celebrities who used eSalon. eSalon, NAD Case No. 5645 (Oct. 17, 2013). Do you agree that pinning photos with the caption “Hair Colors We Love” implies endorsement? Even if it doesn’t imply endorsement, is there a right of publicity issue?

Are Celebrity Endorsements Worth It? There is some evidence that celebrity endorsements are not necessarily a good deal for advertisers. See Peter Dabol, Celebrities in Advertising Are Almost Always a Big Waste of Money, Advertising Age, Jan. 12, 2011 (“[A] celebrity has little to no impact on an ad’s effectiveness. In fact, regardless of gender or age, ads without celebrities out-performed ads with them”). In contrast, consumer “word-of-mouth” recommendations have substantial selling power. See, e.g., Jack Neff, GE Study Proves Consumers Respond More to Shared Content Than to Paid Placements, Advertising Age, Jan. 25, 2012.