

2010

# Modern Application of The Right of Publicity To Virtual Avatars

Elina Slavin  
*Seton Hall Law*

Follow this and additional works at: [https://scholarship.shu.edu/student\\_scholarship](https://scholarship.shu.edu/student_scholarship)



Part of the [Constitutional Law Commons](#), [First Amendment Commons](#), and the [Internet Law Commons](#)

---

## Recommended Citation

Slavin, Elina, "Modern Application of The Right of Publicity To Virtual Avatars" (2010). *Law School Student Scholarship*. 78.  
[https://scholarship.shu.edu/student\\_scholarship/78](https://scholarship.shu.edu/student_scholarship/78)

*Modern Application of The Right of Publicity To Virtual Avatars*

Elina Slavin

April 22, 2010

**TABLE OF CONTENTS**

INTRODUCTION ..... 1

I. The Origins of the Right of Publicity ..... 2

II. The Right of Publicity Defined..... 5

    A. Defining Persona ..... 7

    B. What Is “Commercial Use?” ..... 12

III. Recent Cases Concerning the Right of Publicity ..... 13

IV. The Right of Publicity vs. The First Amendment ..... 16

V. Do Avatars Have a Right of Publicity?..... 22

    A. Celebrity “Look-Alike” Avatars ..... 23

    B. Creation of an Avatar Based on Another Avatar ..... 23

    C. Choice of Law ..... 28

CONCLUSION..... 31

## INTRODUCTION

A principle tenet of Anglo-American jurisprudence is that every person is entitled to the “fruit of his labors” unless public policy considerations justify otherwise.<sup>1</sup> As a result, the right of publicity doctrine has been developed. This doctrine prevents unauthorized commercial gain resulting from the use of an individual’s name, likeness, or persona.<sup>2</sup> The right of publicity gives the individual the exclusive right to control and profit from the use of their identity for commercial promotion.<sup>3</sup> In order for an individual to bring a claim for damages using the right of publicity doctrine, the individual must have achieved “publicity values of substantial pecuniary worth.”<sup>4</sup> Most of the time this is only possible if the individual has put in a great deal of time, effort, skill, and [usually] even money in order to develop their public image.<sup>5</sup>

Previously, the right of publicity has been used to protect humans, but not the likeness of non-human characters. More recently, however, the right of publicity has expanded to protect the likeness of sports figures in video games and superheroes in comic books. Furthermore, current law dictates that only a person whose image is appropriated may bring a claim for damages under the right of publicity, such as when the appearance resembles a famous human personality and is used for commercial gain in a virtual environment.

This paper will discuss whether avatars in virtual environments have a right of publicity. A virtual environment is “an interactive computer simulation which lets its participants see, hear, use, and even modify the simulated objects in the computer-generated environment.”<sup>6</sup> The

---

<sup>1</sup>Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS 203 (1954).

<sup>2</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (2008) (“[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules state in §§ 48 and 49”).

<sup>3</sup> Woodrow Barfield, *Intellectual Property Rights in Virtual Environments: Considering the Rights of Owners, Programmers and Virtual Avatars*, 39 Akron L. Rev. 649, 675 (2005).

<sup>4</sup> Nimmer, *supra* note 1.

<sup>5</sup> *Id.*

<sup>6</sup> Barfield, *supra* note 3, at 649.

specific type of virtual environment that this paper will focus on is one kind of massively multi-player online role-playing game, (“MMORPG”), called Second Life<sup>7</sup>. Once a player enters a MMORPG, they participate in a variety of activities with other players who are accessing the game the same way from all over the world.<sup>8</sup> A participant in a MMORPG is allowed to design a virtual representation of his/her identity, an avatar, which is displayed in the online virtual environment. “Virtual avatars may represent the actions of a user, different aspects of a user’s persona, or the user’s social status in the virtual environment.”<sup>9</sup> Furthermore, an avatar can take on any form, whether a realistic representation of the user who created it, another person’s identity, an animal, or a mythical creature.<sup>10</sup>

Part I will discuss the origins of the right of publicity. Part II will define the right of publicity. Part III will look at the early cases concerning the right of publicity. Part IV will analyze how courts attempt to balance the rights of publicity versus the right to free speech. Part V will determine whether the right of publicity doctrine may be further expanded to protect the likeness of non-human virtual avatars including celebrity “look-alike” avatars and avatars created based on another avatar. Part V will also discuss the choice of law that would likely be applied in a right of publicity case brought involving Second Life violations of the right of publicity.

## **I. The Origins of the Right of Publicity**

The right of publicity did not come to be recognized overnight. The process took several decades, with many improvements over the years.<sup>11</sup> The first step taken towards the recognition

---

<sup>7</sup> Second Life, available at <http://secondlife.com/?v=1.1> (last visited on February 11, 2010) (Second Life is a free 3D virtual world where users can socialize, connect and create using free voice and text chat).

<sup>8</sup> Barfield, *supra* note 3, at 650.

<sup>9</sup> *Id.* at 651.

<sup>10</sup> *Id.*

<sup>11</sup> J. Thomas McCarthy, THE RIGHTS OF PUBLICITY & PRIVACY, § 1:4 (explains the historical landmarks which led to the legal recognition of publicity and privacy rights in a person's identity).

of the right of publicity was an article written by Louis Brandeis and Samuel Warren titled “The Right to Privacy” which discussed the creation of the theory of a broad “right of privacy” focusing upon the “affront to human dignity caused by public disclosure of embarrassing private facts.”<sup>12</sup> Brandeis and Warren were concerned with preserving privacy against a press who overstepped the bounds of “propriety and decency” by broadcasting details of sexual relations in daily newspapers. The next step was the rejection of common law privacy rights in New York in 1902 in the *Roberson* case.<sup>13</sup> In *Roberson*, the New York Court of Appeals held that a woman had no right to stop the unauthorized use of her portrait captioned by “Flour of the Family,” to advertise flour.<sup>14</sup> As a result of public outcry stemming from the disapproval of this decision, New York enacted its first right of privacy law in 1903.<sup>15</sup> Two years later, in 1905, Georgia<sup>16</sup> and then 14 other states began to recognize a common law right of privacy.<sup>17</sup> These developments were the first steps taken to extend the “right of privacy” to the legal recognition of the “unpermitted advertising or other commercial use of a person’s identity.”<sup>18</sup> The next developments included (1) the creation of a “right of publicity,”<sup>19</sup> in the 1953 *Haelan* case and

---

<sup>12</sup> *Id.*; see Louis Brandeis & Samuel Warren, *The Right to Privacy*, 4 HARV. L. REV. 193, 196 (1890).

<sup>13</sup> *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538 (1902) (a picture of Abby Roberson was plastered over town on a flier advertising a baking flour company, which used the picture without permission or compensation. The family claimed that the unwanted attention caused the girl severe embarrassment and humiliation. The N.Y. Court of Appeals said there was no law against it).

<sup>14</sup> Anthony L. Pessino, *Mistaken Identity: A Call to Strengthen Publicity Rights for Digital Personas*, 4 VA. SPORTS & ENT. L.J. 86, 98 (2005).

<sup>15</sup> *Id.*

<sup>16</sup> *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190 (1904) (the state high court determined that a man had a valid invasion of privacy claim against an insurance company for the unauthorized commercial use of his name and picture. This was the first state case to recognize such a right).

<sup>17</sup> Alabama, Arizona, California, Florida, Illinois, Indiana, Kansas, Kentucky, Michigan, Missouri, Montana, North Carolina, Oregon, and Pennsylvania.

<sup>18</sup> McCarthy, *supra* note 11.

<sup>19</sup> *Haelan Labs v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953) (a bubble gum manufacturer who had obtained contracts with big-league baseball players for the exclusive right to use their names and likenesses in connection with the sale of gum or candy sought to enjoin defendant who used these advertising devices in the promotion of his candy. Defendant had argued that the ball players possessed no legal interest in their photographs other than the right of privacy, which could not be assigned to plaintiff. The court stated that, in addition to his privacy right, a man has a “right in the publicity of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture”).

(2) the 1954 article by Professor Nimmer which built a legal framework for the “right of publicity.”<sup>20</sup> The *Haelan* right of publicity gave a person more than the right to assign an interest in his name or photograph.<sup>21</sup> By allowing a person to make a grant of the publicity value of his name or photograph, the *Haelan* case gave protection to a person’s commercial interest in his/her personality independent of his/her privacy interest.<sup>22</sup> This implied that such commercial interest might justify legal protection of an individual against unauthorized use of his name or picture aside from any privacy interest.<sup>23</sup> The court reasoned that although a famous person may generally invoke the right of privacy against an advertiser who appropriates his name or picture without permission, this right may not always afford adequate protection to his commercial interest in his personality.<sup>24</sup> The reason is because celebrities complaining of the unauthorized use of their name or likeness have sometimes been held to have waived their right of privacy because of their publicity.<sup>25</sup> Professor Nimmer’s article identified two policy considerations that he believed provide compelling support for the right of publicity: “first, the economic reality of pecuniary values inherent in publicity and, second, the inadequacy of traditional legal theories in protecting such publicity values”.<sup>26</sup>

In 1960 Professor Prosser wrote a law review article in which he broke down all privacy rights into four distinct and different torts: (1) intrusion; (2) disclosure; (3) false light; and (4) appropriation.<sup>27</sup> His theory was extremely influential and is not only embodied in the Restatement of Torts but has also been uniformly accepted by the courts.<sup>28</sup> Lastly in the 1970s,

---

<sup>20</sup> Nimmer, *supra* note 1.

<sup>21</sup> *Haelan Labs*, 202 F.2d 866.

<sup>22</sup> *Id.*

<sup>23</sup> Joseph R. Grodin, *The Right of Publicity: A Doctrinal Innovation*, 62 Yale L.J. 1123 (1953).

<sup>24</sup> *Id.* (citing *Haelan Labs*, 202 F.2d 866).

<sup>25</sup> *Id.*

<sup>26</sup> Nimmer, *supra* note 1.

<sup>27</sup> William Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960).

<sup>28</sup> McCarthy, *supra* note 11.

Congress, in response to various social concerns coined as invasions of “privacy” passed laws aimed at problems such as electronic eavesdropping, government computerized record keeping, confidentiality of credit and educational records, and intrusive acts by bill collectors.<sup>29</sup> “These statutes illustrate that ‘privacy’ is no longer a single, unified body of law, but rather, it has been subdivided into a series of discrete parts, each addressing a specific social concern.”<sup>30</sup>

The latest major development in the establishment of the right of publicity doctrine was the 1977 case *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>31</sup> In *Zacchini*, the Supreme Court provided important recognition that publicity rights are a legitimate economic interest which can be recognized by states.<sup>32</sup> The state’s interest in recognizing a right of publicity is in “protecting the proprietary interest of the individual in his act in part to encourage such entertainment.”<sup>33</sup> The *Zacchini* decision established that state publicity rights were not automatically preempted by the First Amendment.<sup>34</sup>

## II. The Right of Publicity Defined

In the United States, (“U.S.”), the right of publicity exists in twenty-eight states and is largely protected by state common, statutory law, or both.<sup>35</sup> Some states consider the right to be a property type right while other states consider it a tort type right stemming from the right to privacy.<sup>36</sup> New York, for example, recognizes it as part of the right of privacy within its civil rights law and not a standalone right.<sup>37</sup> Eighteen states have enacted statutory protections for the

---

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

<sup>32</sup> Jon M. Garon, *Publicity Rights in Bytes: Contemporary Issues in Entertainment and Sports Law*, 11 Chap. L. Rev. 465, 484 (2008) (citing *Zacchini*, 433 U.S. at 572).

<sup>33</sup> Grodin, *supra* note 23.

<sup>34</sup> *Id.*

<sup>35</sup> Barfield, *supra* note 3 (internal citation omitted).

<sup>36</sup> Joel Anderson, *What’s Wrong With this Picture? Dead or Alive: Protecting Actors in the Age of Virtual Reanimation*, 25 LOY. L.A. ENT. L. REV. 155, 161 (2005).

<sup>37</sup> Barfield, *supra* note 3.

right of publicity but these differ on points such as the extent of protection, its application to non-celebrities, and the available remedies for violations.<sup>38</sup> The California right of publicity statute, Cal. Civ. Code § 3344, has been the most tested right of publicity statute. The statute states,

(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

To establish a common law prima facie case for the violation of the right of publicity, the plaintiff must prove the following elements: (1) that he is the owner of the recognizable identity or a licensee; (2) that the defendant commercially used the identity; (3) that plaintiff did not authorize such use; and (4) that such appropriation resulted in economic harm to the plaintiff.<sup>39</sup>

Early right of publicity cases only recognized a right of publicity of individual celebrities because celebrities are more widely known and therefore have more identifiable indicia of identity.<sup>40</sup> Now, the prevailing view is that the right of publicity also extends to non-celebrities so long as they can prove a recognizable identity.<sup>41</sup> Courts, however, are still reluctant to extend

---

<sup>38</sup> Anderson, *supra* note 36 (“Indiana offers the broadest right of publicity protection; its statute protects a personality’s economic interest in his name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms. California limits its protection to unauthorized usage of name, voice, signature, photograph, or likeness. Kentucky limits its right of publicity protection to unauthorized appropriations of name and likeness, while New York protects against the unauthorized use of name, portrait, picture, or voice”) (internal citations omitted).

<sup>39</sup> See, e.g., *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (plaintiff must establish the defendant commercially exploited the plaintiff’s identity without consent to obtain a commercial advantage).

<sup>40</sup> See, e.g., *Haelan Labs.*, 202 F.2d at 868 (professional baseball players had a commercial, proprietary interest in their names and likenesses; *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622 (N.Y. App. Div. 1977) (“there is no question but that a celebrity has a legitimate proprietary interest in his public personality”).

<sup>41</sup> Stacy Allen et al., *Non-Human Persons and the Right of Publicity*, <http://images.jw.com/com/publications/1185.pdf> (internal citations omitted).

the right of publicity beyond individual persons.<sup>42</sup> They have uniformly denied attempts by non-human “persons,” such as corporations or institutions, to claim a right of publicity.<sup>43</sup> Such entities must rely on trademark, trade name, and trade dress law for protection.<sup>44</sup>

### A. Defining Persona

Numerous cases have expanded what constitutes a persona protectable by a right of publicity. The most prominent cases are *Pesina v. Midway Manufacturing Co.*,<sup>45</sup> *Newcombe v. Adolf Coors Co.*,<sup>46</sup> and *Abdul-Jabbar v. General Motors Corp.*<sup>47</sup> In *Pesina v. Midway Manufacturing Co.*, plaintiff Pesina, a martial artist, was hired to model for characters of a coin operated video game for the video game manufacturer.<sup>48</sup> The martial artist’s movements were videotaped by a computer and extensively edited.<sup>49</sup> The arcade game was then licensed to the home video market and a home version was created by reformatting the software.<sup>50</sup> Pesina brought an action in Illinois against various game manufacturers for infringement of the common law right of publicity based on the unauthorized use of his persona, name, and likeness in the home version of *Mortal Kombat*, *Mortal Kombat II*, and the related products.<sup>51</sup> The court stated that “[a] plaintiff claiming the infringement of this right must show that, prior to the defendant’s use, the plaintiff’s name, likeness, or persona had commercial value.”<sup>52</sup> The court granted defendants’ motion for summary judgment because Pesina’s name, likeness, or persona lacked

---

<sup>42</sup> *Id.*

<sup>43</sup> McCarthy, *supra* note 11 at §3:74 (citing *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 15 N.Y.2d 940 (1965) (education institution not a “living person” under the New York statute); *Shubert v. Columbia Pictures Corp.*, 189 Misc. 734 (Sup 1947) (corporation not a “living person” protected by New York publicity law)).

<sup>44</sup> *Id.*

<sup>45</sup> 948 F. Supp. 40 (N.D. Ill. 1996).

<sup>46</sup> 157 F.3d 686 (9th Cir. 1998).

<sup>47</sup> 85 F.3d 407 (9th Cir. 1996).

<sup>48</sup> *Pesina*, 948 F. Supp. at 42.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.*

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* (internal citation omitted).

value prior to the plaintiff's association with Mortal Kombat and Mortal Kombat II.<sup>53</sup> The court continued to say, "[a] plaintiff alleging unauthorized use of his likeness must show that the likeness was recognizable."<sup>54</sup> The district court found that Pesina offered no evidence to support the assertion that his likeness the recognizable while the defendants presented convincing evidence that the public did not recognize Pesina in the home version of Mortal Kombat, Mortal Kombat II, and the related products.<sup>55</sup> The defendants showed that after a comparison of Pesina and the game character, Johnny Cage, who allegedly resembled the plaintiff, only 6% of 306 Mortal Kombat users identified Pesina as the model.<sup>56</sup> As to the defendants' use of Pesina's name, it appeared only in Mortal Kombat, only for eight seconds, and only when a player won the game.<sup>57</sup> Pesina could have argued that he became so associated with Johnny Cage that the character invoked Pesina's identity, but to prevail on this theory, Pesina would have to show that his identity became "inextricably intertwined" in the public mind with Johnny Cage.<sup>58</sup> Providing such evidence would prove that his right to publicity was invaded by the defendants' use of Johnny Cage.<sup>59</sup> Pesina could not prove this since the evidence showed that Pesina was neither a widely known martial artist nor that the public recognized him as a model for Johnny Cage.<sup>60</sup>

In *Newcombe v. Adolf Coors Co.*, Killian's Irish Red Beer, owned by Coors Brewing Co., published an advertisement in a *Sports Illustrated* "swimsuit edition" that featured a drawing of an old-time baseball game.<sup>61</sup> The baseball scene focused on a pitcher in the windup position and

---

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*

<sup>59</sup> *Id.*

<sup>60</sup> *Id.* at 42-43.

<sup>61</sup> *Newcombe*, 157 F.3d at 689.

the background included a single infielder and an old-fashioned outfield fence.<sup>62</sup> The players' uniforms did not depict an actual team, and the background did not depict an actual stadium.<sup>63</sup> Newcombe, a former major league baseball all-star, recognized the pitcher in the ad as himself in his earlier days and filed suit.<sup>64</sup> Among other claims, Newcombe alleged that his identity had been misappropriated in violation of California statutory and common law.<sup>65</sup> Comparing the advertisement's drawing to an old newspaper photograph of Newcombe, the court noted that they were "virtually identical, as though the black and white photo had been traced and colored in."<sup>66</sup> The minor differences were that the pitcher's number had been changed from "36" to "39," and the color of the bill of his hat had been changed.<sup>67</sup> In finding a genuine issue of fact in dispute, the court denied summary judgment for the defendant, and held that the Newcombe was identifiable as the pitcher in the advertisement.<sup>68</sup> The court noted that the drawing in the advertisement and the newspaper photograph of Newcombe upon which the drawing was based were virtually identical.<sup>69</sup> The pitcher's stance, proportions and shape were identical to the newspaper photograph of Newcombe; even the styling of the uniform was identical, such as the wrinkles in the pants.<sup>70</sup> The court found that there was no genuine issue of material fact as to whether Newcombe's identity was used in the advertisement and reversed the district court's grant of summary judgment in favor of the defendant.<sup>71</sup>

In *Abdul-Jabbar v. General Motors Corp.*, the Court of Appeals for the Ninth Circuit addressed the issue of whether a person has a right of publicity in their former name. The case

---

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

<sup>66</sup> *Id.* at 690.

<sup>67</sup> *Id.* at 693.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> *Id.* at 696.

involved a television advertisement General Motors ran during the 1993 NCAA men's basketball tournament which used Abdul Jabbar's former name without his consent.<sup>72</sup> Abdul Jabbar contended that this improper use of his likeness violated California's statutory and common law right of publicity in addition to his federal and state trademark rights under Lanham Act, 15 U.S.C.S. § 1125(a).<sup>73</sup>

The district court had ruled against Abdul-Jabbar finding that he had abandoned his use of the name and therefore General Motors' use of it could not be construed as an endorsement.<sup>74</sup> The Court of Appeals reversed and remanded stating that the "right of publicity protects celebrities from appropriations of their *identity* not strictly definable as 'name or picture.'"<sup>75</sup> The Court of Appeals determined that a person retained an interest in their name and that its use in advertising still required consent.<sup>76</sup>

The general rule is that appropriation that does not involve a person's identity usually does not violate publicity rights.<sup>77</sup> The most common appropriation of identity includes the commercial exploitation of a person's name, voice, likeness, photograph, or signature.<sup>78</sup> The use of a person's name nevertheless may not violate that statute if it does not constitute the taking of "identity," but merely uses the name to identify another individual or character in a fictional work.<sup>79</sup> On the other hand, one may violate a person's common law right of publicity by using much more indirect indicia of identity than name, voice, likeness, or signature where the appropriation is such that the public is nevertheless able to identify the person whose publicity

---

<sup>72</sup> *Abdul-Jabbar*, 85 F.3d at 409.

<sup>73</sup> *Id.* at 410.

<sup>74</sup> *Id.* at 409.

<sup>75</sup> *Id.* at 415.

<sup>76</sup> *Id.* at 409.

<sup>77</sup> Nimmer, *supra* note 1.

<sup>78</sup> CAL. CIV. CODE §§ 3344, 3344.1 & App. B-1 (West 2009).

<sup>79</sup> *Newton v. Thomason*, 22 F.3d 1455 (9th Cir. 1994).

rights are infringed.<sup>80</sup> For example, using a name with other words that evoke the celebrity, such as “Here’s Johnny,” or “Velvet Elvis,” can be actionable.<sup>81</sup> Also using an individual’s nickname, pen name, or stage name can violate the right of publicity.<sup>82</sup> Furthermore, the use of a celebrity look alike in advertising may violate the right of publicity if the use is intended to evoke the celebrity’s identity for commercial purposes.<sup>83</sup> Use of a “sound alike” singer can also violate the original musician’s right of publicity.<sup>84</sup> Additionally, use of a unique pose can violate the common law right of publicity, even if the individual’s likeness is not used, if the individual is readily identifiable by that pose.<sup>85</sup> Occasionally an actor’s identity will be intertwined with a fictional character the actor portrays in the mind of the public.<sup>86</sup> The characters themselves are often independently protected by copyright, and are owned by someone other than the actor portraying them.<sup>87</sup> Commercial exploitation of the character may nevertheless violate the right of publicity of the individual portraying the character, even if permission was obtained from the copyright owner, if the exploitation elicits the identity of the actor to the public.<sup>88</sup> However, the

---

<sup>80</sup> Mark S. Lee, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW, §3:56 (2009).

<sup>81</sup> *Id.* at §3:57 (citing *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (use of phrase “Here’s Johnny” in connection with a portable toilet violated Johnny Carson’s right of publicity); *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998) (use of “velvet Elvis” to identify a bar and an advertising violated rights of Elvis Presley)).

<sup>82</sup> Mark S. Lee, *supra* note 80, at §3:57; (citing *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, (S.D. N.Y. 1978) (use of nickname “the greatest” to identify Muhammad Ali together with a silhouetted image, violated his right of publicity); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379 (1979) (use of “crazy legs” to identify a shaving gel violated plaintiff’s publicity rights, because he was well known as “crazy legs” based on his football exploits)).

<sup>83</sup> Mark S. Lee, *supra* note 80, at §3:58; (citing *Allen v. Men’s World Outlet, Inc.*, 679 F. Supp. 360 (S.D. N.Y. 1988) (use of Woody Allen look alike in magazine advertisement for clothing store enjoined); *Presley’s Estate v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (Elvis impersonator violated right of publicity)).

<sup>84</sup> Mark S. Lee, *supra* note 80 at §3:59; (citing *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (use of “sound alike” singer in advertising violated Bette Midler’s common law rights of publicity)).

<sup>85</sup> Mark S. Lee, *supra* note 80, at §3:60; (citing *Newcombe v. Adolf Coors Co.*, 157 F.3d 686 (9th Cir. 1998) (drawing of pitcher in pose identical to that of Don Newcombe violated right of privacy even though face not visible)).

<sup>86</sup> Mark S. Lee, *supra* note 80, at §3:65.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* (citing *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 845 (S.D. N.Y. 1975) (recognizing rights of publicity of Laurel & Hardy against use of characters authorized by copyright owner); *Chaplin v. Amador*, 93 Cal. App. 358 (1st Dist. 1928) (actor and movie studio enjoined from imitating the appearance and mannerisms of Charles Chaplin’s “Little Tramp”).

individual has the burden of proving that the public identifies him or her when they see the character rather than simply the character itself, or there is no right of publicity violation.<sup>89</sup>

### **B. What Is “Commercial Use?”**

Not all uses of a person’s identity violate the right of publicity. Only those uses which qualify as unauthorized commercial use are disallowed. Generally, advertising, merchandising, and exploitative media uses constitute commercial use.<sup>90</sup> Using an individual’s identity in advertising usually violates publicity rights as this is at the core of the right of publicity protection.<sup>91</sup> The most common violation of the publicity right often involves use of some aspect of an individual’s identity to advertise a product without the individual’s permission.<sup>92</sup> The bottom line is that advertising is anything which seeks to sell a product or service.<sup>93</sup> It can, however, be difficult to determine whether a particular use is an advertising use, a media use, or both.<sup>94</sup>

Furthermore, merchandising uses such as the use of a celebrity’s name or likeness on merchandise or memorabilia including but not limited to t-shirts, bumper stickers, coffee mugs, computer mouse pads, posters, are generally thought to violate the right of publicity.<sup>95</sup>

---

<sup>89</sup> Mark S. Lee, *supra* note 80, at §3:65 (citing *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000) (actor’s right of publicity was not violated when character he played in motion picture was reproduced in an “action figure,” since the physical image was not the same and the public did not identify him from that role); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989) (court dismissed the right of publicity claim on the ground her previous portrayals of a character called “Vampyra” were not evoked by Defendant’s portrayal of the character “Elvira”).

<sup>90</sup> Mark S. Lee, *supra* note 80, at §3:69-3:71.

<sup>91</sup> *Id.* at §3:69.

<sup>92</sup> *Id.* (citing *Newcombe v. Adolf Coors Co.*, 157 F.3d 686 (9th Cir. 1998) (polls in advertising); *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254 (Sup 1984) (look alike in advertising); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (sound alike in advertising); *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (identifiable object in advertising); *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (evocative setting in advertisement); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620 (2d Dep’t 1977) (use of “signature sound” in advertising).

<sup>93</sup> Mark S. Lee, *supra* note 80, at §3:69

<sup>94</sup> *Id.*

<sup>95</sup> *Id.* at §3:70 (citing *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860, (1979) (characterizing use of a celebrity’s likeness in “the sale of such commercial products as plastic toy pencil sharpeners, soap products, target games, candy dispensers, and beverage stirring rods” as within the traditional purview of the right of publicity);

Additionally, uses of an individual's image in news media may violate the right of publicity if such use is aimed at exploiting the individual.<sup>96</sup> Such uses, however, raise First Amendment issues<sup>97</sup> which will be discussed later in this paper.

### III. Recent Cases Concerning the Right of Publicity

In *Carson v. Here's Johnny Portable Toilets, Inc.*,<sup>98</sup> Johnny Carson sued the maker and marketer of portable toilets dubbed "Here's Johnny: The World's Foremost Comedian," under the common law right of publicity claiming that the usage appropriated his signature Tonight Show greeting without his permission.<sup>99</sup> The district court dismissed Carson's right of publicity claim because the maker of the toilets did not use Carson's name or likeness.<sup>100</sup> The Court of Appeals felt that the district court's approach was too narrow.<sup>101</sup> The court stated that when the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his "name or likeness" is used.<sup>102</sup> Moreover, Carson's identity may be exploited even if his name, John W. Carson, or his picture is not used.<sup>103</sup> The Sixth Circuit Court of Appeals therefore held that the use of the phrase "Here's Johnny: The World's Foremost Comedian," was a violation of Mr. Carson's common law right of publicity.<sup>104</sup>

In 1985 in *Midler v. Ford Motor Co.*,<sup>105</sup> Ford Motor Company and its advertising agency, Young & Rubicam, Inc., advertised the Ford Lincoln Mercury with a series of nineteen 30 or 60

---

*Brockum Co., a Div. of Krimson Corp. v. Blaylock*, 729 F. Supp. 438, 446 (E.D. Pa. 1990) ("event" T-shirts violated publicity rights); *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D. N.Y. 1983) (posters, buttons, patches, bumper stickers, and other novelty items bearing images of rock musicians infringed their rights of publicity).

<sup>96</sup> Mark S. Lee, *supra* note 80, at §3:71.

<sup>97</sup> *Id.*

<sup>98</sup> 698 F.2d 831 (6th Cir. 1983).

<sup>99</sup> *Carson*, 698 F.2d 833.

<sup>100</sup> *Id.* at 835.

<sup>101</sup> *Id.*

<sup>102</sup> *Id.*

<sup>103</sup> *Id.*

<sup>104</sup> *Id.* at 836.

<sup>105</sup> 849 F.2d 460 (9th Cir. 1988).

second television commercials in what the agency called “The Yuppie Campaign.”<sup>106</sup> The aim was to make an emotional connection with Yuppies, bringing back memories of when they were in college.<sup>107</sup> Different popular songs of the seventies were sung on each commercial.<sup>108</sup> The agency tried to get “the original people,” that is, the singers who had popularized the songs, to sing them.<sup>109</sup> Where the agency failed, the agency had the songs sung by “sound alike.” Bette Midler, the plaintiff was done by a sound alike.<sup>110</sup> The “sound alike” imitated plaintiff to the best of her ability.<sup>111</sup> After the commercial was aired, plaintiff and the “sound alike” were told by a number of people that it sounded exactly like plaintiff.<sup>112</sup> Neither plaintiff’s name nor her picture was used in the commercial, and the agency had a license from the copyright holder to use the song.<sup>113</sup> Plaintiff sued for the unauthorized use of her voice under the California Civil Code § 3344 and the California common law right of publicity.<sup>114</sup> The district court believed there was no legal principle preventing imitation of plaintiff’s voice and granted summary judgment in favor of defendants.<sup>115</sup> On appeal, the court reversed.<sup>116</sup> The Court of Appeals for the Ninth Circuit held 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.”<sup>117</sup> The court reasoned that plaintiff made a

---

<sup>106</sup> *Id.* at 461.

<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 461-62.

<sup>112</sup> *Id.* at 462.

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* at 463.

<sup>117</sup> *Id.*

showing, sufficient to defeat summary judgment and that the defendants for their own profit in selling their product did appropriate part of her identity.<sup>118</sup>

In *White v. Samsung Electronics America, Inc.*,<sup>119</sup> Vanna White sued Samsung under the California Civil Code § 3344 and the California common law right of publicity for creating an ad that included a robot in a blond wig and fancy dress standing on a game show set similar to the set used on the television show “Wheel of Fortune.”<sup>120</sup> The district court in *White* relied on the *Eastwood v. Superior Court* to establish the pleading requirements for the common law right of publicity cause of action. *Eastwood* held that the right of publicity “may be pleaded by alleging (1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”<sup>121</sup> The district court dismissed White’s claim for failure to satisfy *Eastwood*’s second prong, reasoning that defendants had not appropriated White’s “name or likeness” with their robot ad.<sup>122</sup> The court of Appeals in *White* agreed with the lower court’s dismissal of the statutory right of publicity claim because the robot ad did not make use of White’s name or likeness, however, they felt that the common law right of publicity was not so confined.<sup>123</sup> The court of Appeals held that the robot was a sufficient likeness to Vanna White to support a common law right of publicity claim,<sup>124</sup> saying “it is not important how the defendant appropriated the plaintiff’s identity, but whether the defendant has done so.”<sup>125</sup>

---

<sup>118</sup> *Id.* at 463-64.

<sup>119</sup> 971 F.2d 1395 (9th Cir. 1992).

<sup>120</sup> *Id.* at 1396.

<sup>121</sup> *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 417 (1983), (citing Prosser, Law of Torts (4th ed. 1971) § 117, pp. 804-807).

<sup>122</sup> *White*, 971 F.2d at 1397.

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 1399.

<sup>125</sup> *Id.* at 1398.

In 1997, following in the footsteps of the *White* decision, the Court of Appeals for the Ninth Circuit heard a case similar to *White*. In *Wendt v. Host Int'l, Inc.*,<sup>126</sup> Host International created robotic figures resembling George Wendt's and John Ratzenberger's figures and placed them in airport bars without their permission. Wendt and Ratzenberger brought a common law right of publicity claim, a statutory right of publicity claim under Cal. Civ. Code § 3344, and a trademark infringement action under 15 U.S.C.S. § 1125(a) of the Lanham Act.<sup>127</sup> The appellate court reversed the district court's ruling which granted summary judgment in favor of Host International and remanded.<sup>128</sup> The appellate court reasoned that summary judgment was not appropriate because the degree to which these robots resemble, caricature, or bear an impressionistic resemblance to Wendt and Ratzenberger was clearly material to a claim of violation of Cal. Civ. Code § 3344.<sup>129</sup>

#### **IV. The Right of Publicity vs. The First Amendment**

The right of publicity implicates speech because it involves the monitoring of an individual's image, name, or information that appears in the media.<sup>130</sup> Therefore, the individual's exercise of the right of publicity may hinder society's First Amendment right to this information.<sup>131</sup> The key is to balance a person's right of publicity against society's First Amendment right which entails determining where the boundaries between the right of publicity and the First Amendment lie.<sup>132</sup>

As discussed, the right of publicity is an intellectual property right where a defendant may not take, without permission, a plaintiff's image for commercial use to support the

---

<sup>126</sup> 125 F.3d 806 (9th Cir. 1997).

<sup>127</sup> *Id.* at 807.

<sup>128</sup> *Id.* at 810.

<sup>129</sup> *Id.*

<sup>130</sup> Cristina Fernandez, *The Right of Publicity on the Internet*, 8 MARQ. SPORTS L. J. 289, 322 (1998).

<sup>131</sup> *Id.*

<sup>132</sup> *Id.*

defendant's message.<sup>133</sup> On the other hand, "courts protect the constitutional right to free dissemination of ideas."<sup>134</sup> The Restatement of Unfair Competition restricts the right of publicity from, "the use of a person's identity in news reporting, commentary, entertainment, in works of fiction or in advertising that is incidental to such uses."<sup>135</sup> It has therefore been necessary for courts to balance the right of publicity and speech to make sure that neither a person's right of publicity nor society's First Amendment right is curtailed.

In *Zacchini*, the only right of publicity Supreme Court case, the Court considered whether a media company should be allowed to air an entire circus act on an evening newscast, despite the objection of the circus performer.<sup>136</sup> The Court held that although public figures are entitled to less First Amendment protection, the First Amendment does not protect the media where it attempts to broadcast a performer's entire performance without his consent.<sup>137</sup> The Court rationalized that "a performance is the product of petitioner's own talents and energy, the end result of much time, effort, and expense..."<sup>138</sup> Thus, the Court held it was necessary to allow *Zacchini* to have control over his own image, even though it meant preventing a television newscast broadcast.<sup>139</sup>

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,<sup>140</sup> Comedy III brought an action against an artist, Saderup, seeking damages and injunctive relief for infringement of the right of publicity under former Cal. Civ. Code §§ 990 (now Cal. Civ. Code §§ 3344.1<sup>141</sup>).<sup>142</sup> Comedy III

---

<sup>133</sup> *Id.* at 324.

<sup>134</sup> *Id.*

<sup>135</sup> *Id.* (quoting *supra* note 2, at § 47).

<sup>136</sup> *Zacchini*, 433 U.S. at 563.

<sup>137</sup> Gil Peles, *The Right of Publicity Gone Wild*, 11 UCLA Ent. L. Rev. 301, 307 (2004) (citing *Zacchini*, 433 U.S. at 575).

<sup>138</sup> *Zacchini*, 433 U.S. at 575.

<sup>139</sup> Peles, *supra* note 60.

<sup>140</sup> *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

<sup>141</sup> Cal. Civ. Code § 3344.1 → Same as Cal. Civ. Code § 3344, but applies to a "deceased personality."

was the registered owner of all rights to the former comedy act known as the Three Stooges, which are now deceased personalities.<sup>143</sup> Saderup had many years experience in making charcoal drawings of celebrities which are used to create lithographic and silkscreen masters, which are then used to produce lithographic prints and silkscreened images on T-shirts.<sup>144</sup> Saderup created the original drawings and was actively involved in the ensuing lithographic and silkscreening processes.<sup>145</sup> Without securing Comedy III's consent, Saderup sold lithographs and T-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing he had made.<sup>146</sup> The California Supreme Court affirmed the judgment of the Court of Appeals.<sup>147</sup> The Court agreed that by producing and selling these T-shirt products, defendants used the likeness of personalities on products, merchandise, or goods within the meaning of the statute.<sup>148</sup>

The California Supreme Court held that there was no significant transformative or creative contribution in defendants' work.<sup>149</sup> It used the concept of transformative fair use from copyright law as the foundation for balancing the rights of publicity and speech.<sup>150</sup> As it explained, "both the First Amendment and copyright law have a common goal of encouragement of free expression and creativity..."<sup>151</sup> Having identified fair use as the framework, the California court created a rule for analyzing right of publicity cases:

when artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest

---

Enacted in reaction to *Lugosi v. Universal Pictures*, 25 Cal. 3d 813 (1979), where court held that right of publicity, having its roots in right of privacy, are personal rights and therefore not descendible.

<sup>142</sup> *Id.* at 797.

<sup>143</sup> *Id.* at 800.

<sup>144</sup> *Id.*

<sup>145</sup> *Id.*

<sup>146</sup> *Id.* at 801.

<sup>147</sup> *Id.*

<sup>148</sup> *Id.*

<sup>149</sup> *Id.* at 799.

<sup>150</sup> Garon, *supra* note 32, at 485.

<sup>151</sup> *Id.* (citing *Comedy III Productions*, 21 P.3d 797 at 808 (footnote omitted) (internal citations omitted)).

in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity. As has been observed, works of parody or other distortions of the celebrity figure are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.<sup>152</sup>

The court in *Comedy III* continued to say that “[a]nother way of stating the inquiry is whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”<sup>153</sup>

The California Supreme Court reaffirmed its approach in *Winter v. DC Comics*<sup>154</sup> in which the work in question was a comic book. In the comic book, Texas recording artists, Johnny and Edgar Winter alleged that the comics falsely portrayed them as “vile, depraved, stupid, cowardly, subhuman individuals who engage in wanton acts of violence, murder and bestiality for pleasure and who should be killed.”<sup>155</sup> By determining that the use of the redrawn figures could be used for the comic books, the California court made clear that most insertions of caricatures of celebrities in other literary works would be considered a transformative use protected by the First Amendment.<sup>156</sup> Furthermore, the court added that when the artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, it is a direct violation of the right of publicity absent any expressive elements beyond the appropriation.<sup>157</sup>

---

<sup>152</sup> *Id.* (quoting *Comedy III Productions*, 21 P.3d 797 at 808).

<sup>153</sup> *Comedy III Productions*, 21 P.3d 797 at 808.

<sup>154</sup> *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

<sup>155</sup> *Winter v. DC Comics*, 69 P.3d at 476.

<sup>156</sup> Garon, *supra* note 32, at 487.

<sup>157</sup> *Winter v. DC Comics*, 69 P.3d at 477.

In contrast to the transformative, fair use analysis adopted by California, an Oklahoma court did not incorporate the fair use doctrine when analyzing publicity rights.<sup>158</sup> Instead, in *Cardtoons, L.C. v. Major League Baseball Players Ass'n*,<sup>159</sup> the court directly balanced the interest of the First Amendment rights against the benefits of protecting publicity rights<sup>160</sup> by looking to the “social purpose” of the use.<sup>161</sup> The court held that works parodying and caricaturing celebrities are protected by the First Amendment.<sup>162</sup> In *Cardtoons*, a baseball card company produced comic-book style artwork of baseball players. The court reasoned that the defendant, by poking fun at baseball players, provided, “an important form of entertainment and social commentary.”<sup>163</sup> To arrive at its holding, the court balanced the “underprotection” and “overprotection” of the right of publicity in question.<sup>164</sup> According to the court, “underprotection of intellectual property reduces the incentive to create; overprotection creates a monopoly over the raw material of creative expression.”<sup>165</sup>

In *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P., et al.*,<sup>166</sup> the court decided whether fantasy sports operators can use professional athletes’ names and historical statistics without a license from the players, the players association and/or the relevant league.<sup>167</sup> C.B.C. Distribution and Marketing, Inc., (hereinafter, “CBC”) brought this action for a declaratory judgment against Major League Baseball Advanced Media, L.P.,

---

<sup>158</sup> Garon, *supra* note 32, at 488.

<sup>159</sup> *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996).

<sup>160</sup> Garon, *supra* note 32, at 487 (citing *Cardtoons*, 95 F.3d at 968) (This case requires directly balancing the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property right. The analysis begins by first examining the importance of *Cardtoons*’ right to free expression and the consequences of limiting that right and second, weighing those consequences against the effect of infringing on MLBPA’s right of publicity).

<sup>161</sup> Peles, *supra* note 140.

<sup>162</sup> Garon, *supra* note 32, at 487 (citing *Cardtoons*, 95 F.3d at 968).

<sup>163</sup> Peles, *supra* note 140 (citing *Cardtoons*, 95 F.3d at 976).

<sup>164</sup> *Id.*

<sup>165</sup> Peles, *supra* note 140.

<sup>166</sup> 505 F.3d 818 (8th Cir. 2007).

<sup>167</sup> *Id.* at 820.

(hereinafter, “MLB”) to establish its right to use, without license, the names of and information about major league baseball players in connection with its fantasy baseball products.<sup>168</sup> MLB counter-claimed, maintaining that CBC’s fantasy baseball products violated rights of publicity belonging to major league baseball players and that the players, through their association, had licensed those rights to Advanced Media, the interactive media and Internet company of major league baseball.<sup>169</sup> At the trial court level, MLB argued that CBC was violating the baseball players’ individual rights of publicity, which are protected under Missouri state law. Although the trial court held that MLB failed to establish these state-law rights, the Court of Appeals for the Eighth Circuit reversed this determination and found that state-law rights of publicity were implicated. It further held, however, that First Amendment considerations trumped these state-law rights since the baseball players’ names and their corresponding statistics used in CBC’s fantasy baseball games were all readily available in the public domain and therefore should be usable by anyone.<sup>170</sup> Because no one can exercise exclusive control over information in the public domain, the Court of Appeals affirmed the trial court’s judgment in favor of CBC, thus allowing CBC to continue using MLB players’ names and statistics without a license.<sup>171</sup>

The *CBC* court used *Zacchini* to justify employing a balancing test weighing First Amendment free speech concerns against any potential claim Advanced Media may have to right of publicity protection.<sup>172</sup> The *CBC* court also looked at CBC’s basis for using the identities of Major League Baseball players, whether it was for commercial value or for some other

---

<sup>168</sup> *Id.*

<sup>169</sup> *Id.*

<sup>170</sup> *Id.* at 823.

<sup>171</sup> *Id.* at 824.

<sup>172</sup> Gabriel Grossman, *Switch Hitting: How C.B.C. v. MLB Advanced Media Redefined the Right of Publicity*, 14 *UCLA ENT. L. REV.* 285, 305 (2007).

expressive purpose.<sup>173</sup> The court argued the use of the players' names was merely for the purpose of identifying the statistics necessary for the functioning of the game.<sup>174</sup>

## V. Do Avatars Have a Right of Publicity?

A "virtual avatar" (hereinafter, "avatar") is often used to describe "the simulation of a graphical form representing a particular person in a virtual environment."<sup>175</sup> An avatar is created using software and algorithms.<sup>176</sup> A recent development in avatars is that they are getting more intelligent.<sup>177</sup> Avatars are capable of performing many tasks such as writing poetry, playing chess, composing music, and exemplifying a range of emotions and facial expressions.<sup>178</sup>

There are a couple of applications of the right of publicity in the context of avatars. The most common application is the creation of an avatar based on a real celebrity. This application is the easiest for recognition of a right of publicity claim. Another application is the creation of an avatar based on another avatar. The analysis for the latter application is trickier as will be discussed below. Common to both applications, however, is the question of whether the avatar needs to show financial gain from its publicity in order to have a valid right of publicity claim.

Another important consideration when considering a right of publicity claim based on Second Life is the choice of law that will apply. Will Second Life's Terms of Service govern, meaning that California's right of publicity law will control, or will it be based on where the players reside? Additionally, what if a celebrity wants to bring a right of publicity action because an avatar is misappropriating his/her likeness, will Second Life's choice of law clause govern or can the celebrity bring a claim in the state he/she resides?

---

<sup>173</sup> *Id.* at 308.

<sup>174</sup> *Id.*

<sup>175</sup> Barfield, *supra* note 3, at 651.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.* (internal citation omitted).

<sup>178</sup> *Id.* (internal citation omitted).

### **A. Celebrity “Look-Alike” Avatars**

A celebrity has a right to prevent people from using his or her image by bringing a right of publicity claim. Therefore, if an avatar was created which resembled the image of the celebrity, it would probably be treading on the celebrity’s rights. In the event of a suit, the avatar’s owner would have a possible defense. The owner could claim that the images are sufficiently artistic and interpretative to give them First Amendment protection as artistic works. Although the First Amendment does provide some protection, commercial speech is entitled to less protection than other kinds of speech and therefore the burden would be on the owner to prove that the use was not for a commercial purpose.

### **B. Creation of an Avatar Based on Another Avatar**

If the copied avatar is famous because it was created by a famous person then only the famous person will be able to bring a right of publicity claim. However, if the copied avatar is itself a celebrity and the creator of the avatar has no celebrity of his own apart from that of the avatar then the analysis is more complicated. Imagine the avatar has become so famous that people in both Second Life and the real world recognize its identity or indicia of identity such as name, voice, likeness, or signature. Will the avatar be able to stop the unauthorized commercial use of his identity or indicia of identity? What if a voice sound-alike or look-alike of the avatar was used? Will the avatar be able to bring a right of publicity claim in a real-world court or in Second Life? If we were discussing an individual, the individual would be allowed to bring a claim in a real-world court. The issue, however, is that an avatar is not an individual.<sup>179</sup>

---

<sup>179</sup> Merriam-Webster Online Dictionary, “avatar” (2010), <http://www.merriam-webster.com/dictionary/avatar> (retrieved February 28, 2010) (An “avatar” is an electronic image that represents and is manipulated by a computer user (as in a computer game)).

Since the right of publicity is largely protected by state common, statutory law, or both, the avatar would not be able to rely on any one body of law.<sup>180</sup> Furthermore, since most state statutes currently only recognize a right of publicity for individuals, unless the statute specifically excluded an avatar, we would have to determine whether an avatar could be classified as an individual. The logical analysis may be that since an avatar does not look like a living person and is not a living person it should not be characterized as an individual and should therefore not have a right of publicity.

Some courts, however, have ruled that likeness is not a requirement which may leave open the possibility that an avatar may one day have a right of publicity. The key case here is *Motschenbacher v. Reynolds*,<sup>181</sup> which examined whether under California state law the use of a distinctively marked car in a commercial infringed a driver's right of publicity.<sup>182</sup> Plaintiff Motschenbacher was an internationally known professional driver of racing cars who was recognized in racing circles and by racing fans.<sup>183</sup> He derived part of his income from manufacturers of commercial products who paid him for endorsing their products.<sup>184</sup> Plaintiff consistently "individualized" his cars to set them apart from those of other drivers.<sup>185</sup> In 1970, defendants, R. J. Reynolds Tobacco Company and William Esty Company, produced a commercial which utilized a "stock" color photograph depicting several racing cars on a racetrack.<sup>186</sup> Plaintiff's car appeared in the foreground, and although plaintiff was the driver his facial features were not visible.<sup>187</sup> Plaintiff Motschenbacher appealed from the district court's order granting summary judgment in favor of defendants in his suit seeking injunctive relief and

---

<sup>180</sup> Barfield, *supra* note 3 (internal citation omitted).

<sup>181</sup> 498 F.2d 821 (9th Cir. 1974).

<sup>182</sup> *Id.*

<sup>183</sup> *Id.* at 822.

<sup>184</sup> *Id.*

<sup>185</sup> *Id.*

<sup>186</sup> *Id.*

<sup>187</sup> *Id.*

damages for the alleged misappropriation of his name, likeness, personality, and endorsement in nationally televised advertising for Winston cigarettes.

The Court of Appeals agreed with the district court in that the plaintiff's "likeness" was itself unrecognizable; however, it felt that the court's further conclusion of law that the driver was not identifiable as the plaintiff was erroneous in that it failed to attribute proper significance to the distinctive decorations appearing on the car.<sup>188</sup> The markings were not only peculiar to the plaintiff's car but they made some persons think the car in question was the plaintiff's and to infer that the person driving the car was the plaintiff.<sup>189</sup> The holding of this case may suggest that an individual would have a right of publicity if the avatar is identifiable as the individual. Whether an avatar that is identifiable with another avatar has a right of publicity is a question that has yet to be answered.

Although current case law does not extend to non-human personas, there have been a number of cases which have left open the possibility that avatars may one day have a right of publicity. For example, the *White* decision involved the use of a robot in a blonde wig and fancy dress standing on a game show set similar to the "Wheel of Fortune."<sup>190</sup> The court rejected Samsung's parody defense because the ad's spoof of Vanna White was not its primary purpose; the main purpose was to sell Samsung VCR's.<sup>191</sup> This case leaves open the possibility that if avatars were to receive legal rights, the use of an avatar which exactly resembles another avatar, even if part of its purpose is for parody, could be actionable if the other elements of the right of

---

<sup>188</sup> *Id.* at 827.

<sup>189</sup> *Id.*

<sup>190</sup> *White*, 971 F.2d 1395.

<sup>191</sup> Barfield, *supra* note 3, at 676.

publicity are met.<sup>192</sup> Moreover, the *White* case implies that a virtual avatar could be found to have violated the right of publicity of a human.<sup>193</sup>

Another case that may be important for virtual avatars involved a sound-alike of the actress and singer Bette Midler in *Midler v. Ford Motor Co.*<sup>194</sup> The Ninth Circuit found that use of the sound-alike in a commercial was a violation of Midler's right of publicity.<sup>195</sup> According to this case, a virtual avatar should not copy the voice of a famous person because this would probably be a violation of the person's right of publicity.<sup>196</sup> Furthermore, if an avatar has legal rights, a court can find a right of publicity violation if an avatar's voice was copied assuming that the avatar's voice was used for commercial gain and so long as the voice had prior commercial value and was recognizable.

An important case for virtual avatars is *Eros v. John Doe* since it was the first case where a player claimed copyright and trademark infringement by another player, of a product which was created in Second Life specifically for use in Second Life.<sup>197</sup> Although this case did not deal with the right of publicity issue, it did acknowledge that avatars may have rights and may bring claims in a real-world court for violations that occur within Second Life. The parties, however, settled the case before the courts were given the opportunity to decide the legal issues, such as whether virtual goods used wholly within a virtual world are indeed goods as legally defined, and therefore have the rights that are attached to goods.<sup>198</sup> In an amended complaint, Eros claimed John Doe had been making and selling illegal copies of the adult-themed virtual objects

---

<sup>192</sup> *Id.*

<sup>193</sup> *Id.* at 677.

<sup>194</sup> *Midler*, 849 F.2d 460.

<sup>195</sup> *Id.*

<sup>196</sup> *Id.*

<sup>197</sup> Brandy Tricker, *Taming the Wild West: solving virtual world disputes using non-virtual law*, 35 RUTGERS COMPUTER & TECH. L.J. 138, 150 (2008) (citing Compl., *Eros, LLC. v. John Doe*, No. 8:07-CV-01158-SCB-TGW (M.D. Fla. 2007) [hereinafter "John Doe Compl."].

<sup>198</sup> Tricker, *supra* note 200, at 150.

(SexGen Platinum Base Unit v4.01 and the SexGen Platinum+Diamond Base v5.01) to other Second Life residents in violation of Eros' exclusive copyrights.<sup>199</sup>

If Second Life had virtual laws and courts then an avatar would be able to bring his/her right of publicity claim within Second Life<sup>200</sup> The issue, here, however, is that the avatar would have a potential remedy within Second Life but not in the real-world, so if the avatar's likeness was commercially used by someone in the real-world the avatar would have no recourse against the infringer since most states currently do not allow a non-individual to bring a claim for right of publicity.

The difficulty in assigning rights to avatars is that an avatar is nothing more than code. The avatar does what the person at the computer commands him/her to do. The avatar is not capable of acting on its own and therefore should not be recognized as a person and afforded the rights of a person. Unless an avatar becomes intelligent enough where it can act on its own, states will not recognize avatars as deserving of the right of publicity. Additionally, as virtual avatars gain intelligence and create works independently of the user controlling them, significant legal and policy issues will arise.<sup>201</sup> Courts will need to decide what legal rights should be afforded to avatars and how far these rights should extend.

Even if an avatar could bring a right of publicity claim, the avatar would first need to show that the infringer gained financially from its publicity. This factor, however, depends on the statutory law defining the right of publicity. As an example, California's right of publicity statute states that a violation of the right of publicity includes "the *commercial* exploitation of a person's name, voice, likeness, photograph, or signature."<sup>202</sup>

---

<sup>199</sup> *Id.* at 151 (citing John Doe Compl., at P. 2).

<sup>200</sup> *Id.* at 157.

<sup>201</sup> Barfield, *supra* note 3, at 654.

<sup>202</sup> See, *supra* at note 81 (emphasis added).

### C. Choice of Law

Before entering Second Life a user must agree to a set of terms called the “Terms of Service” (“ToS”).<sup>203</sup> A key provision in the ToS is the “Governing Law” clause which tells the users which state’s or country’s law will be applied if there is a dispute about the contract. According to Second Life’s “Governing Law” clause, the choice of law will be California law.<sup>204</sup> Another important clause is the Choice of Forum clause which refers to the geographic region where the complaint must be filed, and where the arbitration or trial will be held to decide any dispute. Second Life’s Choice of Forum clause, called “Forum for Disputes” states that the venue shall be the City and County of San Francisco, California except as provided in the optional arbitration section which is for all matters under \$10,000.<sup>205</sup> This means that for all matters over \$10,000 the venue shall be the City and County of San Francisco, California.<sup>206</sup>

Several scenarios concerning Second Life’s choice of law should be examined: (1) a real life celebrity sues a Second Life user who has given his/her avatar an appearance, voice, etc. that resembles the celebrity and which is being used for commercial gain; (2) where one user has an avatar who has become a celebrity in Second Life and another user whose avatar infringes on that celebrity; and (3) a celebrity avatar and a real world Infringer.

Online worlds are generally hosted at a central location and serve a widespread user base.<sup>207</sup> Although no case has tested a Choice of Law provision of a virtual world or game yet, courts have generally upheld provisions where similarly positioned companies (AOL, Dell,

---

<sup>203</sup> Second Life, Terms of Service, available at <http://secondlife.com/corporate/ToS.php> (last visited on March 25, 2010).

<sup>204</sup> *Id.* (“This Agreement and the relationship between you and Linden Lab shall be governed in all respects by the laws of the State of California without regard to conflict of law principles or the United Nations Convention on the International Sale of Goods.”).

<sup>205</sup> *Id.*

<sup>206</sup> *Id.*

<sup>207</sup> Jay Moffitt, *Click to Agree: Where and How Disputes with Virtual World and Game Providers Are Settled*, Virtually Blind, (2007), available at <http://virtuallyblind.com/2007/09/30/choice-of-forum-law/> (last visited on March 25, 2010).

Gateway, etc.) imposed Choice of Law provisions choosing the law of their state of incorporation or headquarters.<sup>208</sup> Since Second Life's Governing Law provision provides that California shall be the choice of law, any dispute between a user and Second Life will likely be governed by that provision and so California law will apply regardless of where the user resides. Although the user may argue that this provision is unreasonable this argument will probably not prevail.

If, however, a non-party decides to sue a user for violation of the right of publicity or a celebrity avatar sues an infringer, the analysis becomes more difficult because SecondLife's ToS will not apply. In these instances, right of publicity claims will be governed by the substantive law of the plaintiff's domicile because rights of publicity constitute personalty.<sup>209</sup> Furthermore, if the state whose law must be applied has not yet determined the scope of the common law right of publicity in that state, then the court must predict what the courts in that state would rule as to the contours of a right of publicity.<sup>210</sup> An example of how the domicile principle has played out in a right of publicity action is the case *Shaw Family Archives Ltd v. CMG Worldwide*<sup>211</sup>. In *Shaw Family*, plaintiffs sought a judgment declaring that Marilyn Monroe was domiciled in New York, not California, at the time of her death.<sup>212</sup> If she was, defendants would "hold no right to publicity in Ms. Monroe's image, because New York did not at the time of Monroe's death, and does not today, recognize a posthumous right to publicity."<sup>213</sup> The court held that defendants were judicially estopped from asserting that Monroe was anything other than a New York

---

<sup>208</sup> *Id.*

<sup>209</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1002 (2d Cir. 1989) (Case was brought in a NY Court. Rogers was an Oregon domiciliary, and thus Oregon law governed the right of publicity claim).

<sup>210</sup> *Id.* (Oregon courts, however, have not determined the scope of the common law right of publicity in that state. We are therefore obliged to engage in the uncertain task of predicting what the New York courts would predict the Oregon courts would rule as to the contours of a right of publicity under Oregon law).

<sup>211</sup> 2008 U.S. Dist. LEXIS 67529 at \*4.

<sup>212</sup> *Id.*

<sup>213</sup> *Id.*

domiciliary at the time of her death and that plaintiffs were thus entitled to summary judgment on their claims relating to the photographs.<sup>214</sup>

What happens if the person who wants to bring the right of publicity claim resides overseas? Does this person have any right of publicity rights in the U.S? It would seem that a non-U.S. resident should have no protected right of publicity in the U.S. Courts have found that for a foreign plaintiff it will be important to consider where the plaintiff has developed and exploited his right of publicity through licensing agreements, assignments or merchandising schemes.<sup>215</sup> Therefore, even if the plaintiff resides abroad, as long as he/she has exploited his/her rights in the U.S., the state in which this exploitation occurred will be the state whose right of publicity law is applied.<sup>216</sup> For example, in *Bi-Rite Enterprises, Inc. v. Bruce Miner Co.*, the plaintiff members of the groups resided both in the U.S. and abroad but they all exploited their rights in the U.S. through licensing agreements with Artemis, Inc. and Bi-Rite.<sup>217</sup> Therefore, the court concluded although all of the members lived in Great Britain, the law of Georgia governed the rights of Judas Priest, Iron Maiden, and Duran Duran since their merchandising representative was located in Macon, Georgia and was responsible for policing and protecting the use of the groups' names, logos, and likenesses.<sup>218</sup>

As for Choice of Forum clauses, many people have challenged these clauses, and the results vary.<sup>219</sup> Some courts have allowed companies with central distribution of products to a world-wide consumer base to require lawsuits to be filed near their home bases, but some cases have also gone the other way.<sup>220</sup> At the very least, if a user attempts to bring a claim outside the

---

<sup>214</sup> *Id.* at \*5.

<sup>215</sup> *Bi-Rite Enterprises, Inc. v. Bruce Miner Co.*, 616 F. Supp. 71, 74 (1st Cir. Mass. 1985).

<sup>216</sup> *Id.* at 75.

<sup>217</sup> *Id.*

<sup>218</sup> *Id.*

<sup>219</sup> Moffitt, *supra* note 210.

<sup>220</sup> *Id.*

specified choice of forum as provided by the ToS, Second Life will likely move to dismiss the case since it was filed in another jurisdiction.<sup>221</sup>

## **CONCLUSION**

Currently, the right of publicity protects famous individuals from having their identity appropriated by both real-world and virtual world designers. In the future, it may be possible for an avatar to bring a right of publicity claim if the avatar's visual appearance or voice is copied, assuming the avatar has gained celebrity status, and the copied avatar is used for commercial gain.

---

<sup>221</sup> *Id.*