In recent years, there has been a growing interest amongst commentators in the degree to which the law is capable of protecting features of ‘identity’ or ‘persona’, with particular attention bestowed upon the category of ‘celebrity’ identity. This has led to both Australian and international interest in the so-called ‘right of publicity’, a doctrine developed in the United States which recognises the commercial value attaching to identity as a form of assignable personal property. Despite growing interest in the doctrine in Australia and some support for its adoption, the right of publicity has largely escaped detailed critical appraisal here. This article therefore seeks to critically evaluate the US right of publicity and to outline its conceptual and practical implications. In particular, this article will consider the jurisprudential consequences of such a development. As this article will demonstrate, detailed consideration of the right of publicity reveals considerable disunity within that body of law and significant conceptual difficulties with employing the language of property in order to protect ‘identity’ and ‘image’. The questions raised by the US approach are particularly instructive given the current crossroads in the Australian treatment of celebrity identity within the confines of the tort of passing off, as well as the privacy law developments that are currently taking place in this country.

CONTENTS

I Introduction ............................................................................................................ 691
II The Australian Position on the Protection of ‘Identity’ .......................................... 693
III Introducing the United States Right of Publicity — Outline of the Key ‘Certainties’ ............................................................................................................ 699
   A A Relatively New and Unique Concept .......................................................... 699
   B Acceptance .................................................................................................... 700
   C The Right of Publicity Defined as the Right to Control the Commercial Use of Identity .................................................................................. 701
   D A Freely Assignable Right ........................................................................... 702
   E Remedies for Breach ..................................................................................... 702
   F Limits on the Right of Publicity ..................................................................... 703
   G Unresolved Issues and Remaining Uncertainty ........................................... 704
IV The Difficult Property–Privacy Divide — The Controversy Surrounding Descendibility ........................................................................................................ 705
V The Difficulty of Establishing a Test Based on ‘Identity’ ...................................... 709
VI Situating the Right of Publicity within the Intellectual Property Regime — A ‘Concept in Search of a Principle’ ........................................................................ 715
   A The Importance of Providing Theoretical Justifications for the Existence of the Right ...................................................................................... 715

* BA (Hons), LLB (Hons) (Melb); Barrister and Solicitor of the Supreme Court of Victoria. The author wishes to thank Dr David Brennan for his encouragement, guidance, and comments on earlier drafts of this paper, as well as the anonymous referees for their constructive comments. An earlier draft of this article was submitted as part of the Advanced Legal Research subject undertaken in the Faculty of Law, The University of Melbourne. The author is currently residing in California, and can be contacted at the following email address: rosinaz@yahoo.com.
In recent years, there has been a growing interest amongst commentators in the degree to which the law is capable of protecting features of human ‘identity’ or ‘persona’ such as a person’s name, likeness, voice, and image.¹ In Australia, the advertising practice of ‘character’ or ‘personality’ merchandising — that is, use of the names or likenesses of well-known personalities or public figures in connection with the merchandising of goods and services² — has received substantial judicial and critical attention.³ In addition, cultural critics have documented the ways in which notions of ‘celebrity’ and ‘fame’ occupy an increasingly important position in 21st century culture, with a growing recognition of the commercial value attaching to celebrity identity.⁴ These developments have placed pressure on existing Australian legal doctrines to protect features of a celebrity’s ‘identity’ or ‘personality’, as evidenced by a string of cases argued in the Federal Court in the 1980s and 1990s involving well-known Australian identities including Kieren Perkins and Paul Hogan.⁵ This has led some commentators to look abroad to the United

⁵ See, eg, Pacific Dunlop Ltd v Hogan (1989) 23 FCR 553; Hogan v Koala Dundee Pty Ltd (1988) 20 FCR 314; Talmax Pty Ltd v Telstra Corporation Ltd [1997] 2 Qd R 444. For a good overview
States, in order to compare the current Australian position with US law.\textsuperscript{6} Commonly, it is suggested that Australian law compares unfavourably with a recently developed branch of intellectual property law in the US referred to as the ‘right of publicity’.\textsuperscript{7} This right recognises the commercial value attaching to identity as a form of assignable personal property.\textsuperscript{8} For example, in a 2001 article surveying the protection of celebrity identity under existing Australian law, the author refers to the ‘relatively meagre’ protection offered in Australia, contending that there is a ‘need for an Australian right of publicity’\textsuperscript{9} and that ‘the right [of publicity] is consistent with the fundamental rationales underlying intellectual property law.’\textsuperscript{10} Another author suggests that ‘[t]he position … in the United States, is straightforward in relation to the common law right of publicity’,\textsuperscript{11} and argues in favour of the US and Canadian approaches.

Given this developing interest amongst Australian commentators, both in protecting celebrity identity and in the US treatment of publicity rights,\textsuperscript{12} a need to fully understand the complexities attaching to the doctrine arises. Further, from a comparative viewpoint, the US position is of particular interest because it offers a unique conceptual approach that differs from the Australian treatment of celebrity identity under the tort of passing off.\textsuperscript{13} Indeed, when the ‘right of

\begin{itemize}
  \item Ralston, above n 6, 9 (emphasis added).
  \item Ibid 11.
  \item McMullan, above n 6, 95.
  \item See, eg, Black, ‘Corporations Law Goes into Bat for Bradman’, above n 6, 99, who states that ‘[g]iven the lack of comprehensive [protection] … under Australian law, there has been considerable academic and some judicial support for an American style “right of publicity” in Australia in recent years.’ See also Sony Music Australia Ltd v Tansing (t/a Apple House Music) (1993) 27 IPR 649, where the appellant asserted, inter alia, a breach of a right of publicity. The court found it unnecessary to make findings on the issue and asserted that a US-style right of publicity ‘has not been held to be part of the law of Australia at this stage of this country’s development’: at 653–4 (Lockhart J). However, the court also appears to leave the question of the future development of the law in this direction open, stating that ‘[i]n the appropriate case, courts will examine and decide that question’: at 654 (Lockhart J).
  \item The discussion of the right of publicity in this article accepts the view propounded by Robert Howell that a right of publicity is, in conceptual terms, a specific instance of a general tort of misappropriation. That is, the right of publicity adopts a ‘misappropriation’ or ‘property style’ approach (van Caenegem, ‘Different Approaches’, above n 6, 458) in the ‘specific circumstance of personality rights’: Howell, ‘The Common Law Appropriation of Personality Tort’, above n 1,
2004] Propertising Identity 693

publicity’ is carefully examined, it becomes evident that the conceptual approach taken in the US has far-reaching implications for an Australian understanding of, and the future development of, the concept of ‘property’.14 This article will therefore critically evaluate the US right of publicity, outlining some of its most apparent doctrinal difficulties.

A need for detailed consideration of the justifications for, and implications of, importing this US doctrine into Australian law is evident when one considers the so-called ‘dangers’ associated with the phenomenon of ‘transplantation’ of one legal doctrine into another, foreign system.15 As comparative law scholars have recognised for some time, there is a distinct possibility of ‘rejection’ when wholesale adoption of a foreign legal doctrine takes place.16 This suggests that comparative analysis requires a thorough understanding of the foreign doctrine in question, as well as the unique cultural and social framework in which the law operates.17 F Jay Dougherty points to this in a symposium surveying the international treatment of publicity rights when noting that:

With the increasing incorporation of intellectual property into the domain of world trade, a true ‘international law’ concerning the right of publicity is likely. [However, if] there is going to be ‘harmonization’ of this right, scholars and legislators should have an understanding of what is to be harmonized.18

Thus, this article seeks to further the Australian understanding of the US right of publicity and illuminate some of the complexities associated with protecting celebrity identity in this way. Following a brief survey of the Australian position on the protection of celebrity identity, this article will detail the origin of the US right and its essential features. An emphasis is placed on the conceptual difficulties surrounding the development of the right of publicity, and the challenges that a proprietary right in identity poses to established understandings of intellectual property law.

II THE AUSTRALIAN POSITION ON THE PROTECTION OF ‘IDENTITY’

Australian law, following the traditional United Kingdom approach, does not currently embrace a discrete legal category known as a ‘right of publicity’.19 As a

14 Van Caenegem, ‘Different Approaches’, above n 6, 455.
18 Dougherty, above n 15, 422 (emphasis added) (citations omitted).
19 See Lynne Weathered, ‘Trade Marking Celebrity Image: The Impact of Distinctiveness and Use as a Trade Mark’ (2000) 12 Bond Law Review 161, 164. But note that in England there has been a recent ‘process of judicial re-examination’ of the action for breach of confidence and the extent
result, there is no comprehensive protection of the commercial value attaching to features of celebrity identity such as name, likeness and image.20 This is despite calls for the statutory development of such a right,21 and the recent development of a broad-ranging doctrine protecting against ‘appropriation of personality’ in another Commonwealth country, Canada.22 Nor does Australia have a developed body of law protecting the ‘personality rights’ of individuals on the basis of privacy concerns.23 Thus, a celebrity seeking to prevent or be compensated for

to which it can be adapted so as to protect personal privacy: David Lindsay, ‘Playing Possum? Privacy, Freedom of Speech and the Media following ABC v Lenah Game Meats Pty Ltd — Part II: The Future of Australian Privacy and Free Speech Law, and the Implications for the Media’ (2002) 7 Media & Arts Law Review 161, 164. An example of a case where breach of confidence was successfully used to protect privacy interests is Douglas v Hello! Ltd [No 3] [2003] 3 All ER 996. In that case, Michael Douglas and Catherine Zeta-Jones successfully sued a celebrity magazine for, amongst other things, breach of confidence, when it published unauthorised photographs of the wedding between the celebrity couple. The couple had already entered an agreement with a rival magazine, OK! Magazine, granting it exclusive rights to publish the wedding photographs. In his decision of 7 November 2003, Lindsay J awarded the claimants £1 047 756 in damages, with £14 600 going to the Douglasses and £1 033 156 going to OK! Magazine: Douglas v Hello! Ltd [2004] EMLR 2, 36. Most interesting for the purposes of this article is the fact that the decision essentially utilises the breach of confidence action to compensate for the unauthorised use of celebrity image, and recognises the publicity value attaching to those identities. Although a more considered treatment of developments in the area of breach of confidence in Australia and the UK is beyond the scope of the current article, see generally Lindsay’s discussion, referred to above, for an excellent discussion of the difficulties associated with expanding the breach of confidence action, Megan Richardson, ‘The Private Life after Douglas v Hello!’ [2003] Singapore Journal of Legal Studies 311, for an excellent account of the historical development of the law of confidence (and privacy), as well as an overview of the complex litigation and numerous proceedings between the parties; Simon Smith, Image, Persona and the Law: Special Report (2001) 85.


23 Harvey, above n 20, 183–4; McMullan, above n 6, 86. This is in contrast with the approach in a number of civil law jurisdictions: see Henry, above n 1. The concept of ‘personality rights’ in the civil law has a long history: see generally Reiter, above n 22. See Bergmann, above n 8, 480 for a discussion of a ‘general right of personality’ in Germany. Note, however, that the recent case of Australian Broadcasting Corporation v Lenah Game Meats (2001) 208 CLR 199 (‘Lenah Game Meats’), has, to a degree, re-opened the debate over the protection of individual privacy interests at common law, thought to have been long settled by the decision in Victoria Park Racing and Recreation Grounds Co Ltd v Taylor (1937) 58 CLR 479 (‘Victoria Park’). In Lenah Game Meats (2001) 208 CLR 199, Gaudron, Gummow, Hayne and Callinan JJ expressed the view that Victoria Park does not necessarily preclude the development of a tort of unjustified invasion of privacy: at 248 (Gummow and Hayne JJ), 231 (Gaudron J agreeing), 320–4 (Callinan J). Interestingly, Callinan J, reflecting on the decision in Victoria Park, states that: ‘It may be that the time is approaching … for the recognition of a form of property in a spectacle. There is no reason why the law should not, as they emerge, or their value becomes evident, recognise new forms of property’: at 321 (emphasis added). See also the case of Grosse v Parvis [2003] Aust Torts Reports ¶81-706, 64 184, 64 187, where the District Court of Queensland granted the plaintiff damages for breach of privacy, with Skoien J stating:

in my view within the individual judgments [of the Lenah Game Meats decision] certain critical propositions can be identified with sufficient clarity to found the existence of a common law cause of action for invasion of privacy. … It is a bold step to take … [b]ut I see it as a logical and desirable step.
the use, without consent, of his or her identity in an advertising or merchandising context, must seek to fit his or her claim within one of the common law or statutory intellectual property regimes such as trade mark, copyright and design law, trade practices legislation, and common law passing off. Whilst some protection may be offered to celebrity identity through these regimes, this protection is necessarily limited, being ‘incidental, in the sense that it is a by-product of the protection of some other subject-matter.’

However, recent developments in the area of trade practices law, and a considerable expansion of the tort of passing off, have led to a number of

24 For a consideration of the ability of trade mark law to protect celebrity personality as a result of changes to the Trade Marks Act 1995 (Cth), see Hilary May Black, ‘The Role of Trade Mark Law’ (2002) 7 Media & Arts Law Review 101; Weathered, above n 19.

25 Section 52 of the Trade Practices Act 1974 (Cth) (‘TPA’) prohibits a corporation, in trade or commerce, from engaging in misleading or deceptive conduct, or conduct likely to mislead or deceive. For a good example of the ability of s 52 of the TPA to accommodate celebrity claims, see Talmax Pty Ltd v Telstra Corporation Ltd [1997] 2 Qd R 444. This case involved the use of a photograph of well-known sporting personality, Kieren Perkins, in association with a Telstra advertisement. The Full Federal Court granted a remedy which in part sought to compensate for the fact that the unauthorised publication ‘diminished [Perkins’] opportunity to exploit his name, image and reputation’: at 451. Section 53 of the TPA is also of relevance to character merchandising. Section 53 concerns the supply or promotion of goods or services by a corporation with the representation that the corporation, or the goods or services, have sponsorship or approval that they do not in fact have. For a consideration of the application (and limitations) of s 53 to character merchandising, see S G Corones, ‘Basking in Reflected Glory: Recent Character Merchandising Cases’ (1990) 18 Australian Business Law Review 5, 23–4; Ricketson, ‘Character Merchandising’, above n 2, 197–8; Mathew Alderson, ‘Privacy and Publicity — Whose Life is it Anyway?’ in Mathew Alderson (ed), Passing Off — Personality Rights and Trade Practices Law (1997) 4, 7.


27 See especially the developing jurisprudence in relation to trade marking famous celebrity identity: Black, ‘The Role of Trade Mark Law’, above n 24; Weathered, above n 19. See also the recent developments in relation to the action for breach of confidence in the UK, discussed in above n 19. For an excellent discussion of the policy considerations associated with an expanded breach of confidence action in Australia, see Lindsay, above n 19. For an interesting discussion of the potential protection of a celebrity’s name offered by amendments to statutory corporations law, see Black, ‘Corporations Law Goes into Bat for Bradman’, above n 6.

28 Ricketson, ‘Character Merchandising’, above n 2, 192.

29 Note that for the purposes of this discussion s 52 of the TPA will be considered together with the passing off action. Although conceptually distinct, the two actions have been described as ‘coextensive’ and displaying ‘considerable overlap’ in the character merchandising context: Andrew Terry, ‘Exploiting Celebrity: Character Merchandising and Unfair Trading’ (1989) 12 University of New South Wales Law Journal 204, 209–12; Katekar, above n 2, 187; Hutchence v South Sea Bubble Co Pty Ltd (1986) 64 ALR 330, 339 (Wilcox J); Corones,
decisions — known as the ‘character merchandising’ cases — which have accommodated claims by celebrities to prevent the unauthorised use of their image or name for commercial gain. The tort of passing off was traditionally formulated to protect a trader’s ‘goodwill’ or ‘reputation’ by preventing one trader from representing their goods or services as the goods or services of another. It has expanded considerably following relaxation of the ‘common field of activity’ doctrine in Radio Corporation Pty Ltd v Henderson. In this expanded form, the modern tort is said to protect ‘promotional goodwill’, that is, ‘the ability to recommend or promote … goods and services — or merchandising rights’. In short, passing off may be established where a celebrity’s image or name is used on a defendant’s goods or services so as to deceive consumers that there is a ‘business connection’ between the celebrity and the defendant. Thus, the action requires the plaintiff to establish a misrepresentation which creates a false belief in the minds of consumers that the


31 Note that the nature of the interest protected by passing off has historically been an area of uncertainty: see further Staniforth Ricketson, The Law of Intellectual Property (1984) 535–6. Indeed, the action itself has been described as ‘amorphous’ in nature: William van Caenegem, Intellectual Property (2001) 206. Broadly, proprietary protection is bestowed on the goodwill or reputation a trader has built up in relation to a mark, name or get-up and so does not protect the name or mark itself: Ricketson, above, at 534; Law Book Company, Laws of Australia, vol 23 (at 24 October 2004) Intellectual Property, ‘23.7 Passing Off & Related Torts’ [1].


33 [1960] NSWR 279; Terry, ‘Exploiting Celebrity’, above n 29, 215–16. In contrast, English courts have traditionally taken a very conservative approach to the common field of activity requirement: W R Cornish, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights (4th ed, 1999) 640–3. However, the case of Irvine v Talksport Ltd [2002] 2 All ER 414 could signal a significant expansion of the traditional boundaries of passing off in that jurisdiction. It has been described as follows:

The case … acknowledges, arguably for the first time in English law, that a false representation by a trader that its product or service is endorsed by an individual may give rise to a cause of action in passing off. As the judge … noted, this is an important point of principle, as it recognises that in some circumstances the tort of passing off may give one an enforceable right in one’s own name and image.


34 For a discussion of the ‘classic’ and ‘extended’ forms of passing off and the interests protected by these forms, see Corones, above n 25, 6–8; Murumba, above n 26, 65; Harvey, above n 20, 186.

35 Murumba, above n 26, 65 (emphasis in original). Such an approach therefore does not protect indicia of identity directly as property: Harvey, above n 20, 183. Contrast this with the implications of an approach based on misappropriation: see below n 41 and accompanying text.

36 Law Book Company, above n 31, [15].
parties have a ‘commercial arrangement’ (such as, for example, approval or endorsement by the famous personality of the product being advertised).

Therefore, at least in an overt sense, Australian courts reject a model that provides protection against all unauthorised uses of celebrity identity in favour of a model based largely on misrepresentation and the requirement of public deception or confusion. The need to establish a misrepresentation is said to limit the use of the tort of passing off where character merchandising is concerned. Such a model is at odds with the North American approach which revolves around a different conceptual model — one based on misappropriation and focused upon the fact of an unconsented taking of property, without the additional requirements of public deception and misrepresentation.

37 Ibid; Hintz, above n 32, 118. The nature of the ‘association’ or ‘arrangement’ required to be established between the parties is an area of uncertainty. It is not entirely clear from the cases whether the public needs to be likely to believe that the celebrity is ‘endorsing’, ‘sponsoring’ or ‘licensing’ the product in question, or whether it is sufficient that there is a misrepresentation that the celebrity ‘approved’, ‘authorised’ or was ‘associated’ commercially with the defendant or his or her product: Howell, ‘Personality Rights’, above n 22, 216. See also Rickenton, ‘Character Merchandising’, above n 2, 193–6; Mark Davison, Kate Johnston and Patricia Kennedy (eds), Shanagan’s Australian Law of Trade Marks and Passing Off (3rd ed, 2003) 572; Twentieth Century Fox Film Corporation v South Australian Brewing Co Ltd (1996) 34 IPR 225, 242 (Tamberlin J) (‘Duff Beer’), stating that ‘[t]he precise nature of the association is difficult to define’.

38 It has been argued that the misrepresentation required by the character merchandising cases is so minimal that extended passing off in the character merchandising context has begun to resemble, covertly, a tort of misappropriation of personality: see Howell, ‘Personality Rights’, above n 22, 217; Terry, ‘Exploiting Celebrity’, above n 29, 239; Hintz, above n 32, 118; Todd and Smith, above n 26, 19, 36. This leaves open the question of whether Australian courts ‘will take [the] further step in the direction of a sui generis right of publicity, that is, one not tied to passing off’: Law Book Company, above n 31, [15], despite the rejection of a general tort of unfair competition in Moosegate Tobacco Co Ltd v Philip Morris Ltd [No 2] (1984) 156 CLR 414. If it is accepted that the Australian approach is substantially one of misappropriation in the guise of passing off, then it becomes even more pertinent for Australian courts to consider the body of American publicity law.

39 See Howell, ‘The Common Law Appropriation of Personality Tort’, above n 1, 154. The circularity evident in the treatment of consumer deception in the character merchandising cases (that is, in establishing an ‘erroneous’ conclusion on the part of a substantial number of consumers: van Caenegem, Intellectual Property, above n 31, 219–20) has not escaped criticism. A number of critics and judges have noted the artificiality involved in finding an actionable misrepresentation on the basis of whether the public believed approval was necessary, as it is public perception of licensing that forms the basis for the protection of the rights licensed: Jill McKeeough and Andrew Stewart, Intellectual Property in Australia (2nd ed, 1997) [16.29], [16.30], [18.16]; Davison, Johnston and Kennedy, above n 37, 582. This means that ‘if enough people thought that the plaintiff’s permission was needed, it would be needed since otherwise there would be deceptive conduct’: Jill McKeeough and Andrew Stewart, Intellectual Property in Australia (2nd ed, 1997) [18.16] (emphasis added). For judicial consideration of the issue of causation and the doctrine of ‘erroneous assumption’, see Campomar Sociedad Limitada v Nike International Ltd (2000) 202 CLR 45, 83–6. Not surprisingly, then, the search for a misrepresentation for the purposes of passing off has been described as a ‘sometimes artificial’ device: Ralston, above n 6, 10. See also McMullan, above n 6, 86–7, 89, 95, who describes the requirement as ‘fictitious’: at 89; Howell, ‘Personality Rights’, above n 22, who describes it as ‘diminished in its content’: at 234; Rickenton, ‘Character Merchandising’, above n 2, 196, referring to its ‘artificial quality’. See also Katekar, above n 2, 188–92 for a discussion of two lines of reasoning evident in the current judicial treatment of misrepresentation. One is based upon the concept of ‘misappropriation’ whilst the other is concerned with the test of ‘reasonable likelihood of confusion’: at 178.

40 Ibid 153. Broadly, the two models offer a conceptual ‘dichotomy’: at 153. In contrast to the ‘property style’ approach of misappropriation, the passing off/misrepresentation model is
Therefore, in confining analysis to the ‘traditional nomenclature’ of passing off,\textsuperscript{42} Australian courts have largely been concerned with fitting contemporary marketing practices within the doctrinal confines of an action developed long before such practices were a commercial reality. Such an ‘incremental’ approach\textsuperscript{43} has been criticised as ‘artificial’ and ‘straining’ the boundaries of passing off beyond rational limits.\textsuperscript{44} Thus, a number of critics have argued in favour of a more direct treatment of unauthorised use of celebrity identity under Australian law. Hilary May Black asserts:

> these areas of law focus on the misrepresentation of a connection between the celebrity and the unauthorised user when the mischief these actions seek to remedy is misappropriation. [What is needed is] more comprehensive protection of celebrity personality to prevent the misappropriation of the personality directly.\textsuperscript{45}

Despite the frequency of statements of this kind, Australian courts have largely failed to openly address policy issues such as whether an expansion is desirable.\textsuperscript{46} For example, in \textit{Pacific Dunlop Ltd v Hogan,}\textsuperscript{47} by treating the Paul centrally concerned with the \textit{conduct} of the defendant; it is not a ‘taking \textit{simpliciter}’ but depends upon the public perception or confusion resulting from the representational conduct of the defendant: at 154. See also van Caenegem, ‘Different Approaches’, above n 6, 455, 458. Thus, at least implicit in the US model is the notion that what is protected by the action is a form of property, that is, a proprietary right in features of identity: McGee, Gale and Scanlan, above n 13, 240 fn 84. Importantly, this conceptual distinction has practical consequences. For example, a ‘property style’ approach lends the rights protected to the ‘traditional consequential effects’ of a property classification, such as assignability and descendibility: van Caenegem, ‘Different Approaches’, above n 6, 455, 456, 458. In contrast, it is still an open question whether passing off can be argued by the estate of a deceased personality: Black, ‘The Role of Trade Mark Law’, above n 24, 105 fnn 37–8. In addition, the proprietary interest protected by passing off — goodwill — is subject to historical limitations, such as the fact that an outright transfer or assignment of goodwill is not possible without an accompanying transfer of the business to which the goodwill is attached: \textit{Federal Commissioner of Taxation v Just Jeans Pty Ltd} (1987) 16 FCR 110, 121–4; Law Book Company, above n 31, [23].

\textsuperscript{42} See Howell, ‘Personality Rights’, above n 22, 221.

\textsuperscript{43} See van Caenegem, ‘Different Approaches’, above n 6, 453, who refers to the ‘flexible, case by case approach to commercial problems typical of the common law.’

\textsuperscript{44} See above n 39 and accompanying text. See especially Howell, ‘Personality Rights’, above n 22. A similar argument can be raised in relation to the expansion of confidentiality to accommodate invasion of privacy claims. For example, David Lindsay, in considering the choices facing Australian courts in relation to privacy protection following the decision in \textit{Lenah Game Meats}, states:

> The choice facing the Australian legal system is … stark: whether to reflexively adopt the developments taking place under English confidentiality law [or] to independently assess the form that general law protection of privacy should take under Australian conditions … [It is] argued that it is more appropriate for individual privacy to be protected by a tort of privacy than by extending the action for breach of confidence. The reason for this is that the protection of privacy is conceptually distinct from the protection of confidentiality or secrecy. In other words, individual privacy can be best protected by laws crafted to achieve that objective, rather than by the extension of existing causes of action aimed at protecting other economic interests or social values.

Lindsay, above n 19, 190–1.

\textsuperscript{45} Black, ‘Corporations Law Goes into Bat for Bradman’, above n 6, 99 (emphasis added).

\textsuperscript{46} See further Ricketson, ‘Character Merchandising’, above n 2, 205, who, after surveying the considerable development of the tort of passing off in accommodating the reality of character merchandising, states: ‘While this development is now an established fact, there has been surprisingly little judicial or scholarly consideration of the merits of such an extension.’

\textsuperscript{47} (1989) 23 FCR 553 (Sheppard, Beaumont and Burchett JJ).
Hogan-created ‘Crocodile Dundee’ character as simply an extension of Hogan’s personality and dismissing a ‘parody defence’, the Federal Court failed to explicitly address difficult issues such as how an expanded legal doctrine ought to define the concept of ‘identity’ and whether Australian law ought to recognise a parody defence to the commercial exploitation of personality.

These are issues the US courts have grappled with since the inception of the right of publicity, and it is inevitable that Australian courts will be faced with these issues in the future, regardless of whether they continue to accommodate novel claims within old causes of action or move to a more explicit acceptance of a broad doctrine based on misappropriation, as is suggested by some commentators. As Robert Todd and Ian Smith write, the piecemeal nature of personality protection in Australia is a product both of history and expediency, allowing law and policy makers to shirk the fundamental questions that would be raised in any attempt to reconstitute these laws into a coherent regime. Eventually it seems inevitable that the nettle will have to be grasped and these laws will have to be reformulated.

Thus, an understanding of the complexities attaching to the US right of publicity can inform the future development of Australian intellectual property law, particularly given the current lack of clarity in the Australian treatment of celebrity identity.

III INTRODUCING THE UNITED STATES RIGHT OF PUBLICITY — OUTLINE OF THE KEY ‘CERTAINTIES’

A A Relatively New and Unique Concept

The right of publicity is a relatively new concept in US legal history, said to have originated in a seminal 1953 decision by the US Court of Appeals for the Second Circuit and to have been fuelled by academic support. A survey of the protection accorded to identity and image in other jurisdictions suggests that, at least in conceptual terms, the US right of publicity is a distinct and unique phenomenon. Whilst civil law jurisdictions such as France and Germany, under
the influence of Roman law, have long protected attributes of human personality including name, reputation, voice and image, the civil law conceptualisation of personality rights has traditionally been strongly ‘extrapatrimonial’, viewing such rights as an aspect of personal privacy and therefore non-proprietary and without monetary value.53 This is in contrast to the general view in the US that the right of publicity is a type of proprietary right.54

B Acceptance

In addition, the right of publicity has been recognised by at least 27 states, through either the common law or statute, and in some states, most notably California, both a statutory and common law action is available.55 Thus, the right of publicity is a creation of state law, with judges playing a key role in the ‘discovery’ of the doctrine and in shaping its development.56 Although there have been calls for a federal statute to provide the country with uniform law in the

Keeping the Right of Publicity Out of Canadian Law’ (1999) 13 Intellectual Property Journal 179. Similarly, Germany has long recognised the commercial exploitation of identity as a violation of personal rights, and France recognised a right of privacy — the precursor to the US right of publicity — as early as 1858: Dougherty, above n 15, 425. What is of particular interest to this discussion, however, is the acceptance in the US of this right as a type of property interest — it is in this conceptual approach that the US is unique: Roberta Kwall, ‘Fame’ (1997) 73 Indiana Law Journal 1, 16, writing that ‘[t]he United States … appears to be relatively unique in its recognition of the right of publicity as a species of property.’ In terms of the commercial treatment of identity, then, the US jurisprudence is particularly advanced: Julius Pinckaers, From Privacy Toward a New Intellectual Property Right in Persona: The Right of Publicity (United States) and Portrait Law (Netherlands) Balanced with Freedom of Speech and Free Trade Principles (1996) 15; cf Dougherty, above n 15, 245. A comprehensive international survey of publicity rights is beyond the scope of this discussion, but for an excellent discussion, see Henry, above n 1.

53 Reiter, above n 22, 675, 679. The increasing commercialisation of identity internationally has put pressure on civil law systems to reformulate traditional understandings of personality rights. Therefore, there is an ongoing contemporary debate in the civil law as to whether personality rights should be treated as personal rights, property rights, or a combination of both: see Reiter, above n 22; Bergmann, above n 8, 518–22; Dougherty, above 15, 433–9.

54 See below Part IV.

55 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, vol 4 (at September 2003) § 28.1; Bruce Keller et al, ‘United States of America’ in Michael Henry (ed), International Privacy, Publicity and Personality Laws (2001) 455, 477. For an example of the statutory treatment of the right of publicity, see, eg, the CAL CIVIL CODE §§ 3344, 3344.1 (West 1997 & Supp 2002). Section 3344(a) provides that

: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 … without such person’s prior consent … shall be liable for any damages sustained by the person or persons injured as a result thereof.

In addition, § 3344.1 regulates the use of the name, voice, signature, photograph or likeness of a ‘deceased personality’. For discussion of the relationship between the common law and statutory provisions in California, see below n 136. In contrast, in New York the right of publicity is exclusively statutory: see Stephan o v News Group Pub, Inc, 64 NY 2d 174 (1984), which held that New York Civil Rights Law NY CIV RTS LAW §§ 50–1 (McKinney 2004) is the exclusive source of rights of publicity in New York: Restatement (Third) of Unfair Competition § 46 reporters’ note cmt g (1995).

56 Pinckaers, above n 52, 21. Note that the focus of this article is the right of publicity developed at common law, rather than the statutory treatment of the doctrine. The common law position provides the most interesting analogy with developments in the Australian common law of passing off and offers broader insights into the law-making process.
area, there is currently no federal right of publicity. Consequently, the scope of the right varies considerably from state to state, with entertainment and media centres such as California having the most developed case law. Key variations between the states relate most notably to the treatment of post-mortem rights and the duration of publicity rights, as well as to the breadth of the statutory language adopted (and therefore the range of features of identity that can be protected). In 1995, the right of publicity received recognition in the influential Restatement (Third) of Unfair Competition (1995). Paragraph 46, which is contained in Chapter 4, dealing with ‘appropriation of trade values’, provides that ‘[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.’

C The Right of Publicity Defined as the Right to Control the Commercial Use of Identity

As the Restatement (Third) of Unfair Competition suggests, the right of publicity ‘limits unauthorised uses of the name, likeness, and other aspects of the identity of individuals.’ Although descriptions vary, it is succinctly described by the leading treatise writer, J Thomas McCarthy, as a ‘right of every human being to control the commercial use of his or her identity … and recover in court damages and the commercial value of an unpermitted taking.’ As McCarthy explains: ‘This legal right is infringed by unpermitted use which will likely damage the commercial value of this inherent right of human identity and which is not immunized by principles of free speech and free press.’ Thus, the right is aimed at preventing the commercial use, without a licence, of the identity of a person to attract attention to a product or advertisement. It is for this reason

58 Pinckaers, above n 52, 21.
59 Keller et al, above n 55, 477. The treatment of the right in another media centre, New York, has been somewhat inconsistent. For a more detailed discussion, see McCarthy, The Rights of Publicity and Privacy, above n 51, § 6.1[B].
60 The treatment of post-mortem rights is discussed at length in Part IV below.
62 Keller et al, above n 55, 476.
63 McCarthy, The Rights of Publicity and Privacy, above n 51, § 1.1 (emphasis added). See also the description in Carson v Here’s Johnny Portable Toilets, Inc, 698 F 2d 831, 835 (6th Cir, 1983) (‘Carson’): The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.
64 McCarthy, Trademarks and Unfair Competition, above n 55, § 28.1.
that McCarthy describes the action as ‘a commercial tort and a form of unfair
competition.’66 Although McCarthy suggests that a publicity right attaches to all
individuals as their ‘inherent right’,67 the case law is not so self-evident. A
survey of key decisions suggests that the right is most commonly invoked by
celebrities and public figures,68 and there are some decisions that support the
view that an action is only available to those who have attained some measure of
celebrity.69

D A Freely Assignable Right

As made clear in Haelan Laboratories, Inc v Topps Chewing Gum, Inc,70 the
right of publicity is freely assignable and provides the basis for endorsement
transactions.71 Therefore, the right of publicity can be enforced by the individual
whose identity is infringed and, where relevant, by an assignee or exclusive
licensee of the celebrity.72 A right of publicity can be transferred in gross without
the need for a transfer of any accompanying goodwill or business.73 Unlike a
trade mark, a right of publicity does not depend upon the public associating the
celebrity with a commercial source for goods or services.74 Unlike claims of
false endorsement, deceptive marketing, and trade mark infringement, deception
or a likelihood of public confusion is not required to establish infringement.75

E Remedies for Breach

Remedies for breach of the right of publicity include injunction and damages,
with courts on occasion awarding punitive damages.76 Although the courts have
been inconsistent in their approach to the appropriate measure of damages for
breach of the right of publicity, the generally accepted principle is that the
measure of damages reflects the pecuniary/commercial loss suffered by the
plaintiff or the ‘unjust’ monetary gain to the defendant.77 In a case involving the

67 Ibid.
70 202 F 2d 866 (2nd Cir, 1953).
71 Bergmann, above n 8, 479.
72 Keller et al, above n 55, 479.
73 Restatement (Third) of Unfair Competition § 46 cmt g (1995); McCarthy, Trademarks and Unfair Competition, above n 55, §§ 28.8–28.9.
74 Restatement (Third) of Unfair Competition § 46 cmt g (1995).
77 Restatement (Third) of Unfair Competition § 49 cmt b (1995).
singer Tom Waits, well known for his stance against celebrity endorsement, an appeals court upheld a jury award of over US$2 million, including punitive damages, for the use of an imitation of Waits’ voice in a corn chip advertisement. As this case suggests, damages awards flowing from a breach of the right can be considerable.

**F Limits on the Right of Publicity**

The First Amendment of the *United States Constitution*, which seeks to safeguard freedom of expression and the press, operates as a limit upon the right of publicity. As a general principle, where an individual’s identity is used in the reporting of news, in commentary or entertainment, or in works of fiction or non-fiction (creative works), this will not result in a breach of the right. There will generally be no infringement where a celebrity’s name or photograph is used in connection with a fan magazine or feature story; nor will infringement occur where an unauthorised biography is disseminated or incidental use takes place. However, while the above principles may appear fairly ‘certain’, the practical application of the First Amendment to the right of publicity has received considerable critical attention. Indeed, it is widely acknowledged that the approach of US courts to the ‘inherent tension’ between right of publicity and First Amendment interests has ‘varied widely (and wildly)’ and that US courts currently ‘lack a principled and consistent method of resolving the conflict’.

78 Waits, 978 F 2d 1093, 1104 (9th Cir, 1992); Keller et al, above n 55, 480.
79 See Keller et al, above n 55, 480; Bergmann, above n 8, 499–500; see also Ted Gerdes, ‘The Unbearable Lightness of Being: Recent Court Decisions Highlight the Tension between Entrepreneurs’ First Amendment Rights and Celebrities’ Rights of Publicity’ (2002) 25 Los Angeles Lawyer 44, 47.
80 Ralston, above n 6, 9; McCarthy, ‘The Human Persona as Commercial Property’, above n 65, 21; Keller et al, above n 55, 480; McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28:40. Note also that where the right of publicity is governed by statute, the statutory framework may contain its own exceptions. For example, state statutes frequently contain an express exemption relating to news reporting: see, eg, CAL CIVIL CODE § 3344(d) (West 1997 & Supp 2002) which provides that ‘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’; *Restatement (Third) of Unfair Competition* § 47 reporters’ note cmt c (1995). See also CAL CIVIL CODE (West 1997 & Supp 2002) § 3344.1(2), which sets out protected uses in relation to a ‘deceased personality’.
83 Keller et al, above n 55, 482.
85 See Kwall, ‘The Right of Publicity’, above n 84, 47.
86 Haemmerli, above n 57, 457.
87 Kwall, ‘The Right of Publicity’, above n 84, 47. See generally *Restatement (Third) of Unfair Competition* § 47 reporters’ notes (1995). For an instance of the divergent judicial treatment of
In addition to the relationship between the right of publicity and the First Amendment,88 other unresolved issues in relation to the right include: the phenomenon of ‘[v]irtual kidnapping’89 (the use of a person’s likeness on the internet without their permission); application of the rules of private international law to the right of publicity;90 whether the right of publicity is pre-empted by the federal copyright statute;91 and the application of the right of publicity to fictional characters.92 Thus, the outer boundaries of the right remain unclear, so that some describe the right of publicity as a ‘dynamic and fluid’93 area of law whilst others accuse it of being ‘contradictory’ and even ‘schizophrenic’.94 Although one advocate of the right has described it as having reached ‘a point of maturity’,95 thus moving beyond ‘forty years of wandering in a definitional wilderness’,96 it is widely acknowledged that considerable confusion pervades nearly every aspect of the law in this area.97 Julius Pinckaers summarises the current position as follows: ‘The American right of publicity is a well-recognized legal doctrine in approximately half of the states. Disagreement still exists with respect to its subject, object, scope, content, duration and remedies.’98 Three particularly contentious issues that will be examined in detail here are the descendibility of the right, the parameters of the test of ‘identity’, and the jurisprudential basis of the right.99

89 Haemmerli, above n 57, 389 fn 21.
90 See Dougherty, above n 15, 426–33.
91 See Dawson, above n 57, 659–62; Singer, above n 1, 37–46.
92 See Dawson, above n 57, 663–7 for a good discussion of the debate.
94 Choi, above n 57, 121.
96 Ibid 853.
97 Dougherty, above n 15, 421, 423; Haemmerli, above n 57, 389, 405 fn 84.
98 Pinckaers, above n 52, 433 (emphasis added). See also Dougherty, above n 15, 423. For an example of a statutory attempt to delineate content, scope, duration and remedies, see, eg, CAL CIVIL CODE §§ 3344, 3344.1 (West 1997 & Supp 2002). The Restatement (Third) of Unfair Competition §§ 46–9 (1995) is also a non-binding but influential attempt to summarise the current state of the law.
99 Note that a full discussion of all the unresolved issues surrounding the right of publicity is beyond the scope of this article. The three issues selected here, however, are chosen to illuminate
IV THE DIFFICULT PROPERTY–PRIVACY DIVIDE — THE CONTROVERSY SURROUNDING DESCENDIBILITY

One area that has been particularly plagued by uncertainty is the question of the conceptual nature of the right of publicity. This is brought into focus by debates surrounding the descendibility of the right, that is, whether it can pass to, and so be enforced by, the heirs of a deceased celebrity. An apparent ‘certainty’ that now exists in the US is the categorisation of the right of publicity as a form of ‘property’. For example, McCarthy points to the right as a form of ‘intellectual property’. In addition, most, but not all, commentators now adopt this property formulation. Similarly, the more recent court decisions largely accept this approach, as evidenced by a 1996 decision which recognised the right as involving, ‘[l]ike trademark and copyright, … a cognizable property interest.’ Whilst seemingly straightforward, such statements belie the considerable confusion that has historically surrounded the conceptual basis of the right of publicity since it was first coined by Frank J in 1953.

Indeed, the development of the right has been correctly described as taking place in ‘a kind of analytical fog’. Although early proponents of the right of publicity were divided as to the doctrinal basis of the right and in so doing, better inform Australian debates about what kind of model, if any, ought to be adopted for the protection of identity.

100 Put another way, the question is whether there is a post-mortem right of publicity, that is, can a right of publicity survive the death of the celebrity in question, or does the action die with the person? Note that for the purposes of this discussion the terms ‘descendibility’ and ‘inheritability’ will be used interchangeably. ‘Inheritability’ is helpfully defined as including ‘inheritance in either testate or intestate situations, that is, where the famous ancestor dies with or without a will that directs the distribution of various assets perhaps including the right of publicity’: Timothy Terrell and Jane Smith, ‘Publicity, Liberty, and Intellectual Property: A Conceptual and Economic Analysis of the Inheritability Issue’ (1985) 34 Emory Law Journal 1, 2 fn 2.

101 McCarthy, The Rights of Publicity and Privacy, above n 51, § 1.1(C); above n 87, §§ 10.2[A], 10.2[B].

102 For recognition of the right as property, see, eg, Nimmer, above n 51, 203, 216; McCarthy, The Rights of Publicity and Privacy, above n 87, § 10.2[A] and accompanying notes; Bergmann, above n 8, 479, 500; Kwali, ‘Fame’, above n 52, 15 (‘a property-based conception for publicity rights is the natural outgrowth of our cultural norms as well as our theoretical conceptions of property’); Dawson, above n 57, 639; Haemmerli, above n 57, 385 (‘[t]he right of publicity can … be viewed as a property right grounded in human autonomy’); Armstrong, above n 4, 443, 461–2. Contrast this with the following descriptions: right of publicity as a ‘subset of the right of privacy’ (Keller et al, above n 55, 476); right of publicity as ‘a tangled web of privacy and property’ and ‘a loosely defined property with hazy contours’ (Reiter, above n 22, 711); right of publicity as ‘an amalgam of property and privacy rights’ (Steven Clay, ‘Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts’ (1994) 79 Minnesota Law Review 485, 490–91). See also Terrell and Smith, above n 100, 1, arguing that the right of publicity should not be characterised as a property interest as it fails to exhibit traditionally accepted characteristics of property, particularly the quality of specificity.

103 Cardtoons, 95 F 3d 959, 967 (10th Cir, 1996). See also Zucchinii, 433 US 562, 573 (1977) (White J, delivering the judgment of the court); Restatement (Third) of Unfair Competition § 46 cmt g, d (1995); Keller et al, above n 55, 476. See also the comments in Bi-Rite Enterprises, Inc v Button Master, 555 F Supp 1188, 1199–200 (SDNY, 1983).

104 See, eg, Haemmerli, above n 57, 406–9; Flagg, above n 52, 195–201. See also Pinckaers, above n 52, 27–8 and references cited therein.

105 Terrell and Smith, above n 100, 3. See also McCarthy, The Rights of Publicity and Privacy, above n 51, §§ 1.1–1.11.
publicity did not consider it necessary to define the right with exactitude, the unique historic relationship of the right of publicity to privacy law in the US is significant and has meant that labels have become particularly important in discerning the parameters of the right. In essence, it is widely accepted that the right of privacy in the US developed in the early 1900s so as to protect private individuals from unwanted media publicity. With time, celebrity plaintiffs sought to use the ‘misappropriation of name or likeness’ branch of privacy law to obtain compensation not for injured feeling but for damage to their economic interests in not being paid for the publicity use of their image or name. Yet privacy law was inadequate as a cause of action due to its concern with compensating injured feelings and protecting personal, dignitary interests rather than pecuniary interests. Thus, a separate right of publicity was developed, largely in response to the needs of celebrity plaintiffs and the perceived limitations of privacy law.

As a consequence, the right of publicity is, and continues to be, closely aligned with a branch of privacy law based on misappropriation. It is this relationship with privacy law that has led to confusion surrounding the conceptual basis of the right and which has coloured much of the current debate about its extension, particularly whether the right of publicity is transmissible to heirs (that is, the descendibility debate). This is because, historically, rights of privacy have


107 See generally Terrell and Smith, above n 100.


109 Clay, above n 102, 487; Goodenough, ‘The Price of Fame’ (Pt 1), above n 108, 56; Madow, above n 4, 167–74.


111 Madow, above n 4, 169–78.

112 Ibid.

113 Haemmerli, above n 57, 407–9; Legal Information Institute, above n 110. See, eg, *Restatement (Second) of Torts* § 652C (1977). See also the special case of New York where the right of publicity is explicitly treated as an aspect of privacy law and is now only recognised as part of New York’s privacy statute: McCarthy, *Trademarks and Unfair Competition*, above n 55, §§ 28.32–28.33.

114 Haemmerli, above n 57, 407–9; Singer, above n 1, 23–6; Reiter, above n 22, 709–11.
been viewed as an entirely different species to rights in rem. That is, privacy interests have been viewed as personal, non-assignable and incapable of passing to heirs; in contrast, rights of property can be assigned, licensed, transmitted inter vivos and are devisable post-mortem. As Alice Haemmerli summarises:

The doctrine … developed in a schizoid manner: publicity rights were purely economic rights, as distinct from ‘personal’ privacy rights (thereby enabling publicity rights to become transferable and descendible); but publicity rights, even though economic in nature, were also part of the tort of invasion of privacy, thereby implying that they should be viewed as a species of personal privacy rights, and as such nonassignable and nondescendible. The makings of a doctrinal mess were therefore apparent at least as early as 1960…

Thus, a tension between these competing conceptual models of the right of publicity — as a subset of privacy on one view, and as an independent property right on another — exists and is evident in the continued struggle of courts and legislatures over the question of whether the right is descendible and so enforceable by the family of a deceased celebrity. This issue has divided courts considering common law publicity actions, and the current statutory treatment of descendibility remains ad hoc, with considerable inconsistency between state regimes. For example, as of 2003, only 15 states had recognised a post-mortem right of publicity: 11 by way of statute and 4 at common law.

115 See, eg, the discussion of the treatment of privacy and ‘personality rights’ under Roman, medieval and early modern law in Reiter, above n 22, 675–9. See also the treatment of privacy as a personal right in the Restatement (Second) of Torts § 652I cmts a, b (1977), which provides that [t]he right protected by the action for invasion of privacy is a personal right, peculiar to the individual whose privacy is invaded. The cause of action is not assignable, and it cannot be maintained by other persons such as members of the individual’s family … In the absence of statute, the action … cannot be maintained after the death of the individual whose privacy is invaded.

See also Bergmann, above n 8, 493. Note that appropriation of name or likeness, embodied in § 652C of the Restatement (Second) of Torts (1977) is given special treatment. See also McCarthy, Trademarks and Unfair Competition, above n 55, § 28.6.

116 See Reiter, above n 22, 709; Singer, above n 1, 26; McCarthy, Trademarks and Unfair Competition, above n 55, § 28.6.

117 Haemmerli, above n 57, 407–8.

118 Keller et al, writing in 2001, refer to the right in this way: Keller et al, above n 55, 476.

119 Reiter, above n 22, 709–11.

120 See, eg, the divergent treatments of the issue in Lugosi v Universal Pictures, 25 Cal 3d 813 (1979) (‘Lugosi’); Groucho Marx Productions, Inc v Day & Night Co, Inc, 689 F 2d 317 (2nd Cir, 1982); Martin Luther King, Jr, Center for Social Change, Inc v American Heritage Products, Inc, 296 SE 2d 697 (Ga, 1982); Memphis Development Foundation v Factors Etc, Inc, 616 F 2d 956 (6th Cir, 1980); cert denied 449 US 953 (1980). As recently as 1995, the Restatement (Third) of Unfair Competition (1995) described the common law position in California, one of the country’s biggest entertainment centres, as ‘unclear’: § 46 reporters’ note cmt h. Indeed, one of the key cases to consider the issue under Californian common law, Lugosi 25 Cal 3d 813 (1979), has been described as giving rise to four opinions containing four different conceptual characterisations of the right: see Kevin Marks, ‘An Assessment of the Copyright Model in Right of Publicity Cases’ (1982) 70 California Law Review 786, 786. See generally Singer, above n 1, 20–32; Terrell and Smith, above n 100, 12–22; Reiter, above n 22, 710–11.

121 See Haemmerli, above n 57, 389; Singer, above n 1, 31. But see Kwall, ‘The Right of Publicity’, above n 84, 53.

122 McCarthy, Trademarks and Unfair Competition, above n 55, § 28.45. For an example of a statutory resolution of the issue (enacted in response to the Lugosi, 25 Cal 3d 813 (1979) litigation: McCarthy, Trademarks and Unfair Competition, above n 55, § 28.27) see CAL CIVIL
The duration accorded to post-mortem rights by those state statutes varies from periods of between 10 and 100 years. As Eric Reiter asserts, this issue exemplifies "a continuing uneasiness about the degree to which the right of publicity is a property, rather than a personality, right." Whilst some may counter that the law is now free of such conceptual uncertainty, one need only point to the confusion over the appropriate measure of damages in *Waits v Frito Lay, Inc* — where the court awarded damages for mental distress even though the right of publicity is said to be concerned with economic injury — to recognise that the law continues to remain unsettled in relation to this property–privacy divide. In addition, some current state statutes require proof that a defendant ‘knowingly’ appropriated the plaintiff’s identity, even though a mental element is not usually required for enforcement of a property right. Similarly, courts have limited the right to natural persons only, the reason for this being that "[t]he interest in personal dignity and autonomy that underlies both publicity and privacy rights limits application of the right of publicity" in this way. A property right that exhibits many of the limitations of a personal right is a unique type of right, situated within a ‘tangled web’ of rights in rem and rights in personam. In addition, ‘semantic confusion’ pervades much of the academic literature concerned with whether the right of publicity is overextended or justified at all, with supporters of the right of publicity relying upon its ability

CODE § 3344.1 (West 1997 & Supp 2002) which protects certain features of the identity of a deceased celebrity. Section 3344.1(b) provides that the ‘rights recognized under this section are property rights, freely transferable, in whole or in part, by contract or by means of trust or testamentary documents’. Further, § 3344.1(g) establishes the duration of the post-mortem right of publicity as 70 years, so that an action for breach of the right of publicity expires 70 years after the death of the deceased personality.

124 Reiter, above n 22, 709.
125 See Halpern, above n 95, 853–73; McCarthy, ‘The Human Persona as Commercial Property’, above n 65, 21–3; McCarthy, *The Rights of Publicity and Privacy*, above n 51, § 1.10[C].
126 978 F 2d 1093, 1103–5 (9th Cir, 1992).
127 See Flagg, above n 52, 197–8. See, eg, § 3344(a) of the California statute which requires that a person ‘knowingly uses’ the plaintiff’s identity: McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28.29; CAL CIVIL CODE § 3344(a) (West 1997 & Supp 2002). See also *Restatement (Third) of Unfair Competition* § 46 reporters’ note cmt e (1995). Note that as a general rule, unless required by a state statute, intent is not an element of liability: *Restatement (Third) of Unfair Competition* § 46 cmt e (1995). The example does, however, remain instructive.
129 Reiter, above n 22, 711. See also Clay, above n 102, 490–1, who describes the right of publicity as an ‘amalgam of property and privacy rights’. See also Madow, above n 4, 173 fn 229, who states: ‘an assignable interest that dies with its assignor is a very queer kind of property’. Note, however, that such grey areas of property law are not just confined to the US. For a critical discussion of the uncertain nature of ‘information’ as a form of property, see Brendan Edgeworth, Christopher Rossiter and Margaret Stone, *Sackville and Neave: Property Law: Cases and Materials* (7th ed, 2004) 54; see also Sam Ricketson, ‘Confidential Information — A New Proprietary Interest?’ (Pt 1) (1977) 11 *Melbourne University Law Review* 223; Mark Thomas, ‘Information as Property: Humanism or Economic Rationalism in the Millenium?’ (1998) 14 *Queensland University of Technology Law Journal* 203.
to protect dignitary interests — characteristics related more to the underlying rationales of privacy law than the law of property.\textsuperscript{131}

This ‘doctrinal incoherence’ surrounding the US right of publicity is instructive for any legal system looking to adopt this body of law, particularly when one considers the ‘immense strategic value’ that the ‘property’ label bestows.\textsuperscript{132} As Timothy Terrell and Jane Smith write (referring to the descendibility debate):

> the present chaos of inconsistent academic and judicial conclusions is a rare object lesson in the importance to the law of fundamental conceptual analysis — that is, the investigation of the basic legal categories, and accompanying methods of reasoning, that may be at stake in a legal dispute.\textsuperscript{133}

Although the right of publicity is largely accepted as an emerging area of intellectual property law,\textsuperscript{134} it is evident that its conceptual basis remains unclear.

V THE DIFFICULTY OF ESTABLISHING A TEST BASED ON ‘IDENTITY’

A further difficulty surrounding the current state of the law on the right of publicity is the question of the parameters of the test for determining infringement.\textsuperscript{135} Broadly, infringement requires use by the defendant, without permission, of an aspect of the identity or persona\textsuperscript{136} of the plaintiff in such a way that the plaintiff is identifiable from the defendant’s use and the use is likely to cause damage to the commercial value of the plaintiff’s identity.\textsuperscript{137} As the key test of infringement is ‘identifiability’,\textsuperscript{138} deception or false endorsement (that is, a misrepresentation) is not required to establish infringement.\textsuperscript{139} For example, where the alleged appropriation consists of the use of a name by the defendant,

\begin{itemize}
  \item \textsuperscript{131} See, eg, Haemmerli, above n \textsuperscript{57}. See also Kwall, ‘The Right of Publicity’, above n 84, 54–6; Kwall, ‘Fame’, above n \textsuperscript{52}.
  \item \textsuperscript{132} Davies and Naffine, above n 1, 39; Flagg, above n \textsuperscript{52}, 196. See Howell, ‘The Common Law Appropriation of Personality Tort’, above n 1, for a good consideration of these conceptual difficulties in both US and Canadian law.
  \item \textsuperscript{133} Terrell and Smith, above n \textsuperscript{100}, 1–2.
  \item \textsuperscript{135} Reiter, above n \textsuperscript{22}, 708.
  \item \textsuperscript{136} Note that some statutes confine the right of publicity to specifically defined features of identity: McCarthy, \textit{The Rights of Publicity and Privacy}, above n \textsuperscript{51}, §§ 3.1[B], 6.3[A]. See, eg, § 3344(a) of the \textit{CAL CIVIL CODE} (West \textsuperscript{1997} & Supp \textsuperscript{2002}) which refers to ‘name, voice, signature, photograph, or likeness’. It is now accepted that, unlike the statutory provision, the common law of California is not ‘so confined’ as to be limited to these indicia of identity: see \textit{White I}, 971 F 2d \textsuperscript{1395}, 1397 (9th Cir, 1992) (Goodwin J), establishing that the common law right of publicity in California is broader than the statutory right and not restricted to the features proscribed; see also \textit{Wendt v Host International, Inc}, 125 F 3d \textsuperscript{806}, 811 (9th Cir, 1997) (‘Wendt I’). In California, the right of publicity is a common law and statutory right: \textit{Gionfriddo v Major League Baseball}, 114 Cal Rptr 2d \textsuperscript{307}, 408 (Ct App 1st D, 2001).
  \item \textsuperscript{137} McCarthy, \textit{The Rights of Publicity and Privacy}, above n \textsuperscript{51}, § 3.1[B].
  \item \textsuperscript{138} Ibid [3.2]; McCarthy, ‘The Human Persona as Commercial Property’, above n \textsuperscript{65}, 23.
  \item \textsuperscript{139} McCarthy, ‘The Human Persona as Commercial Property’, above n \textsuperscript{65}, 23; Ralston, above n \textsuperscript{6}, 10.
\end{itemize}
the name must be recognised by the audience as referring to the plaintiff.\textsuperscript{140}

Similarly, where there is an allegation of appropriation of the plaintiff’s visual likeness, it must be possible to reasonably identify the plaintiff from the photograph or other depiction in question.\textsuperscript{141} Yet, as Mitchell Flagg notes, “[p]ersonality, image, and identity are among the most ephemeral concepts known to humanity” and “[t]here is no widely accepted meaning for these terms” so that expecting the law to adequately deal with such concepts presents a difficult task.\textsuperscript{142} Indeed, in recent years, the US courts, particularly in the celebrity-friendly jurisdiction of California, have extended the right of publicity to the protection of personal attributes far beyond the traditionally protected categories of name and likeness.\textsuperscript{143} Consequently, infringement has been established on the basis of ‘lookalikes’,\textsuperscript{144} ‘sound alikes’ (adoption of the unique singing style of a famous performer in an advertising campaign),\textsuperscript{145} the use of distinctive objects such as an image of the plaintiff’s sports car,\textsuperscript{146} and nicknames and commonly used slogans such as ‘Here’s Johnny’.\textsuperscript{147}

In particular, the decisions in \textit{White v Samsung Electronics America, Inc.}\textsuperscript{148} and \textit{Wendt v Host International, Inc.}\textsuperscript{149} have been criticised both judicially\textsuperscript{150} and by commentators as exemplifying an unwarranted expansion of the ‘purview of publicity protection’.\textsuperscript{151} Both cases involved the use by the defendants of robots bearing a remote likeness to the plaintiffs.\textsuperscript{152} In \textit{White}, Vanna White, hostess and famous letter-turner on the popular US television series ‘Wheel of Fortune’, successfully sued Samsung Electronics for breach of her right of publicity at

\textsuperscript{140} Restatement (Third) of Unfair Competition § 46 cmt d (1995).

\textsuperscript{141} Restatement (Third) of Unfair Competition § 46 cmt d (1995).

\textsuperscript{142} Flagg, above n 52, 180.

\textsuperscript{143} Keller et al, above n 55, 478; Dawson, above n 57, 639–40.


\textsuperscript{145} Wait, 978 F 2d 1093 (9th Cir, 1992); Midler v Ford Motor Co, 849 F 2d 460 (9th Cir, 1988) (‘Midler’); Keller et al, above n 55, 478.

\textsuperscript{146} Motschenbacher v J Reynolds Tobacco Co, 498 F 2d 821 (9th Cir, 1974) (‘Motschenbacher’); Keller et al, above n 55, 478.

\textsuperscript{147} See especially Carson, 698 F 2d 831 (6th Cir, 1983); Keller et al, above n 55, 478. An excellent overview of cases expanding the reach of the right of publicity is provided by Dawson, above n 57, 640–3.

\textsuperscript{148} White I, 971 F 2d 1395 (9th Cir, 1992). See also White II, 989 F 2d 1512 (9th Cir, 1993). Note that this discussion relates both to the initial Court of Appeals decision, \textit{White I}, and to the subsequent petition for rehearing (containing the Kozinski J dissent), \textit{White II}.

\textsuperscript{149} Wendt I, 125 F 3d 806 (9th Cir, 1997). See also Wendt v Host International, Inc., 197 F 3d 1284 (9th Cir, 1999) (‘Wendt II’); cert denied Paramount Pictures v Wendt, 531 US 851 (2000). Note that ‘Wendt I’ and ‘Wendt II’ are used to distinguish between key Court of Appeals decisions.

‘Wendt I’ refers to the Court of Appeals decision reversing the decision of the District Court. ‘Wendt II’ refers to a subsequent Court of Appeals decision pertaining to a petition for rehearing, wherein the majority denied the petition, thus adhering to the decision in \textit{Wendt I}. \textit{Wendt II} contains the Kozinski J dissent.

\textsuperscript{150} See, eg, the strong dissents by Kozinski J in \textit{White II}, 989 F 2d 1512 (9th Cir, 1993) and \textit{Wendt II}, 197 F 3d 1284 (9th Cir, 1999).

\textsuperscript{151} Choi, above n 57, 145; Dawson, above n 57, 643. For critical treatments, see Barnett, ‘At a Crossroads’, above n 84, 35–71; Flagg, above n 52, 204; Bergmann, above n 8, 487–8.

\textsuperscript{152} Keller et al, above n 55, 478; Dawson, above n 57, 639–40.
common law when it produced a parodic television advertisement featuring a female-shaped robot clad in jewellery, a long gown and a blonde wig. The robot was depicted turning letters on what appeared to be a ‘Wheel of Fortune’ game show set. The advertisement was for Samsung videocassette recorders and featured the caption, ‘[l]ongest running game show. 2012 AD’. The advertisement was one of a series featuring cultural icons depicted in humorous situations; the idea behind the commercial was apparently to suggest the reliability and longevity of Samsung products.

In *Wendt*, George Wendt and John Ratzenberger, the actors best known for their portrayal of the characters Norm and Cliff in the famous long-running television series ‘Cheers’, brought an action for, amongst other things, breach of their right of publicity in these fictional characters when the defendant created animatronic robots allegedly based on the actors’ likenesses. The robotic figures were used without the permission of the actors and were placed in airport bars that were modelled on the set of the television show. At first instance, the District Court found in favour of Host, the creator of the animatronic robots. Essentially, the District Court was of the view that the robots did not look like the plaintiffs and that no reasonable jury could find that the robots were ‘similar in any manner whatsoever to the plaintiffs’. The District Court held that it could not ‘find, by viewing both the robotic s and the live persons of Mr Wendt and Mr Ratzenberger, that there is any similarity at all … except that one of the robots, like one of the plaintiffs, is heavier than the other’.

---

153 Importantly, Vanna White’s claim under the Californian statutory provision, § 3344 of the CAL CIVIL CODE (West 1997 & Supp 2002) was unsuccessful because the court did not consider that the robot in issue satisfied the meaning of ‘likeness’ for the purposes of § 3344: *White I*, 971 F 2d 1395, 1397 (9th Cir, 1993) (Goodwin J). The Court did, however, make this determination ‘[w]ithout deciding for all purposes when a caricature or impressionistic resemblance might become a “likeness”: at 1397 (Goodwin J). The finding on the statutory provision was not challenged in the subsequent decision rejecting a petition for rehearing: *White II*, 989 F 2d 1512 (9th Cir, 1993).

154 *White I*, 971 F 2d 1395, 1396 (9th Cir, 1992); *White II*, 989 F 2d 1512 (9th Cir, 1993).

155 *White I*, 971 F 2d 1395, 1396 (9th Cir, 1992).

156 Ibid.

157 Flagg, above n 52, 203.

158 As with most actions of this kind, an action was brought under the statutory right of publicity, the common law right of publicity, and § 43(a) of the federal Lanham Act, 15 USC § 1125(a) (1988): *Wendt I*, 125 F 3d 806, 809–14 (9th Cir, 1997) (Fletcher J). The case also raised the issue of whether the actors’ state law causes of action were pre-empted by federal copyright law: see further *Wendt v Host International, Inc*, 50 F 3d 18 (9th Cir, 1995).

159 *Wendt I*, 125 F 3d 806, 809 (9th Cir, 1997) (Fletcher J).

160 Ibid 809.

161 The District Court also granted summary judgment in favour of Paramount Pictures Corp, the holder of copyright in the program ‘Cheers’, which had intervened in the proceeding: see *Wendt I*, 125 F 3d 806, 809 (Fletcher J).

162 *Wendt II*, 197 F 3d 1284, 1285 (9th Cir, 1997) (Kozinski J, in dissent); ibid 806 (Fletcher J, citing the decision of the District Court).

163 *Wendt I*, 125 F 3d 806, 809 (9th Cir, 1997) (Fletcher J).
The Court of Appeals for the Ninth Circuit disagreed, reversing the decision of the District Court. It stated that ‘we conclude from our own inspection of the robots that material facts exist that might cause a reasonable jury to find them sufficiently “like” the appellants’. The Court of Appeals therefore held in favour of the actors, even though the creators of the robots had obtained a licence from Paramount, the copyright holder in the program ‘Cheers’, to open a line of ‘Cheers’ airport bars. The Court of Appeals held that an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character. In this way, the Court of Appeals rejected the argument raised by Host that the robotic figures appropriated only the identities of the ‘Cheers’ characters Norm and Cliff (which were subject to copyright owned by Paramount) and not the identities of the actors, Wendt and Ratzenberger, themselves. This aspect of the Court of Appeals decision has been the subject of particular criticism.

Similarly, the decision in White has been criticised on the basis that it significantly expands traditional understandings of what constitutes ‘identity’ for the purposes of right of publicity infringement, whilst failing to provide any kind of concrete test. For example, the court, after making reference to the earlier expansive cases of Motschenbacher v R J Reynolds Tobacco Co, Midler v Ford Motor Co and Carson v Here’s Johnny Portable Toilets Inc, stated:

These cases teach not only that the common law right of publicity reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff’s identity.

The court continued in this type of circular reasoning when it concluded that ‘[i]t is not important how the defendant has appropriated the plaintiff’s identity,'
but whether the defendant has done so. Thus, the majority appeared to adopt an extremely expansive ‘appropriation of identity’ test, whilst failing to delineate the precise parameters of this test.

Indeed, the majority suggest a type of impressionistic ‘evocation’ test — that infringement will be established whenever the combination of features used in the advertisement merely reminds the audience of the plaintiff in question. Kozinski J notes in his subsequent dissent from the order denying a petition for rehearing that such a broad-ranging test is a potentially ‘dangerous’ advancement:

The panel’s opinion is a classic case of overprotection ... 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.

Similarly, Alarcon J, dissenting in part from the Court of Appeals’ majority decision, noted the fact that the majority appear to identify particular characteristics as ‘belonging’ to White, when they in fact are only associated with a role that she performs as game show hostess. Alarcon J argued that elements including ‘attractive appearance, a graceful pose, blond hair, an evening gown, and jewellery’ are characteristics that White shares in common with many others and so these characteristics ‘are not unique attributes of Vanna White’s identity.’ He therefore went on to reject the majority finding on the common law right of publicity claim. As the difference between the majority and the dissenting judgments illuminates, the decision in White highlights a fundamental difficulty with translating an amorphous concept such as ‘identity’ — a concept that has been the subject of endless philosophical debate — into a concrete legal test. As Flagg writes in an article urging Canadian judges to keep the US right of publicity out of Canadian courts: ‘This “we know it when we see it” sort of test builds maximum uncertainty and discretion into the law.

Furthermore, the decisions in both White and Wendt exemplify the difficulty courts have in balancing the private property interests of individuals with public access to cultural forms where the property in question is human identity. Thus,
not surprisingly, these decisions have been criticised by many as exemplifying an unwarranted excursion into the public domain. For example, Kozinski J is particularly vocal in his dissenting judgments in both of these cases. In his dissenting judgment in White II, Kozinski J argues that both the nature of the test created by the majority and its rejection of any kind of defence for parodic, humorous use of celebrity identity, strike a balance that weighs too heavily in favour of celebrity entitlement at the expense of creative expression. Kozinski J writes:

The intellectual property right created by the panel here has none of [the] essential limitations [present in other intellectual property regimes]: 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. … 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.

Further, he asks a question that many US courts have failed to address:

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. … 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? 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?

This question of whether the right of publicity is justified at all, and whether it strikes the right balance, is a fundamentally important one, and needs to be considered by any legal system considering adoption of a US-style approach.

See eg, Stack, above n 178, 1202–22; Flagg, above n 52, 224–35; Clay, above n 102, 487, 501–13. See generally Madow, above n 4; Rosemary Coombe, ‘Authorizing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders’ (1992) 10 Cardozo Arts and Entertainment Law Journal 365. A particular criticism levelled at the decision in White I is the rejection by the majority of a parody defence. See further below n 190 and accompanying text.

See White II, 989 F 2d 1512 (9th Cir, 1993); Wende II, 197 F 3d 1284, 1287 (Kozinski J, in dissent), 1285 (Kleinfeld and Tashima JJ agreeing).

Ibid 1516–17. In some right of publicity cases, courts have applied an analysis which is similar to the determination of whether there has been a fair use in copyright law: Restatement (Third) of Unfair Competition § 47 cmt d (1995). For a further consideration of the fair use doctrine of copyright law applied to the right of publicity, see Restatement (Third) of Unfair Competition § 47 cmts c, d (1995); Dawson, above n 57, 649–53; see generally Marks, above n 120. In contrast to the US (see Campbell v Acuff-Rose Music, Inc, 510 US 569 (1994)), the ‘fair dealing’ doctrine in Australian copyright law does not explicitly embrace parody: David Brennan, ‘Copyright and Parody in Australia: Some Thoughts on Suntrust Bank v Houghton Mifflin Company’ (2002) 13 Australian Intellectual Property Journal 161, 163. However, it has been asserted that there is a ‘tendency for [Australian] courts to treat parody as non-infringing exercises of copyright under some unwritten rule’: at 164. Whether Australian courts are willing to provide an exception for parody in character merchandising cases is an open question. For consideration of the uncertain status of parody as a ‘defence’ to a claim of passing off under Australian law, see Michael Spence, ‘Intellectual Property and the Problem of Parody’ (1998) 114 Law Quarterly Review 594, 598–9. For consideration of the fair use defence to copyright infringement in the US, see generally Richard Posner, ‘When Is Parody Fair Use?’ (1992) 21 Journal of Legal Studies 67.

Ibid 1516–17. In some right of publicity cases, courts have applied an analysis which is similar to the determination of whether there has been a fair use in copyright law: Restatement (Third) of Unfair Competition § 47 cmt d (1995). For a further consideration of the fair use doctrine of copyright law applied to the right of publicity, see Restatement (Third) of Unfair Competition § 47 cmts c, d (1995); Dawson, above n 57, 649–53; see generally Marks, above n 120. In contrast to the US (see Campbell v Acuff-Rose Music, Inc, 510 US 569 (1994)), the ‘fair dealing’ doctrine in Australian copyright law does not explicitly embrace parody: David Brennan, ‘Copyright and Parody in Australia: Some Thoughts on Suntrust Bank v Houghton Mifflin Company’ (2002) 13 Australian Intellectual Property Journal 161, 163. However, it has been asserted that there is a ‘tendency for [Australian] courts to treat parody as non-infringing exercises of copyright under some unwritten rule’: at 164. Whether Australian courts are willing to provide an exception for parody in character merchandising cases is an open question. For consideration of the uncertain status of parody as a ‘defence’ to a claim of passing off under Australian law, see Michael Spence, ‘Intellectual Property and the Problem of Parody’ (1998) 114 Law Quarterly Review 594, 598–9. For consideration of the fair use defence to copyright infringement in the US, see generally Richard Posner, ‘When Is Parody Fair Use?’ (1992) 21 Journal of Legal Studies 67.
VI SITUATING THE RIGHT OF PUBLICITY WITHIN THE INTELLECTUAL PROPERTY REGIME — A ‘CONCEPT IN SEARCH OF A PRINCIPLE’

A The Importance of Providing Theoretical Justifications for the Existence of the Right

As suggested above, the last 10 years have seen a renewed interest, from both commentators and some members of the judiciary, in the question of whether the right of publicity strikes an appropriate balance between providing property protection and fostering creativity through public access. Whilst such an argument may seem odd in relation to a legal right originating in privacy law and said to protect human identity, it is a fundamental question that arises due to the largely accepted classification of the right of publicity as a form of property and, particularly, as a new and fast developing area of intellectual property. Thus, a fundamental question arises as to whether the existence of the right of publicity is theoretically justified in the same way that more established rights of intellectual property such as trade mark, copyright and patent rights have been justified on economic and policy grounds.

This is a particularly important question in the comparative context, given that Australian courts, perhaps more so than the US courts, are suspicious of creating new property rights without very sound policy reasons and economic and social justifications. This position is evident in the comment of Dixon J, writing for the majority in *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor*, that ‘courts of equity have not in British jurisdictions thrown the protection of an injunction around all intangible elements of value … which may flow from the exercise by an individual of his powers or resources’.

---


193 See, eg, Fisher, above n 134, 168, 194–6. For a good discussion of the ways in which the right of publicity resembles and is different from other intellectual property regimes such as trade marks and copyright, see McCarthy, *Trademarks and Unfair Competition*, above n 55, §§ 28.8–28.9; *Restatement (Third) of Unfair Competition § 46 cmt i* (1995). See *Copyright Act*, 17 USC § 102(a) (1976). See also n 103 and accompanying text regarding acceptance of the property formulation in recent judgments.


196 *Victoria Park* (1937) 58 CLR 479, 508–9 (emphasis added). This was affirmed in the 1984 High Court decision in *Moorgate Tobacco Co Ltd v Philip Morris Ltd [No 2]* (1984) 156 CLR 414. See also the discussion of Dixon J’s judgment in *Victoria Park*, in *Moorgate Tobacco Co Ltd v Philip Morris Ltd [No 2]* (1984) 156 CLR 414, 444–5 (Deane J). See also the more recent approval of the statement provided by the High Court in *Campomar Sociedad Limitada v Nike International Ltd* (2000) 202 CLR 45, 54–5. See also Katekar, above n 2, 179 for a good overview of the Australian approach.
B Questioning the Treatment of the Right of Publicity as a 'Natural Right'

In the US, a group of scholars led by Michael Madow have criticised the leading proponents of the right of publicity, and the courts responsible for its development, for failing to address the question of why the right exists and for suggesting that the right of publicity is a ‘natural right’\(^\text{197}\) that is ‘self-evident’ and based on ‘common sense’.\(^\text{198}\) For example, the judgment of Frank J in *Haelan Laboratories*,\(^\text{199}\) the decision responsible for the ‘creation’ of the right, gives little attention to the issue of whether expansion of the law is justified.\(^\text{200}\) Rather, it accepts that the celebrity baseball players in question have a right to assign the exclusive right to the publicity value in their photographs on the basis of common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements … This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.\(^\text{201}\)

As this suggests, legal protection is bestowed on the basis of perceived public expectation and in response to pre-existing commercial practices.\(^\text{202}\) Yet there is a problematic circularity evident in such reasoning, in that a false expectation of protection on the part of the celebrities forms the basis of the very rights ultimately protected.\(^\text{203}\) In addition, the fact that celebrities will receive greater remuneration if an assignable legal right is created is not an adequate justification for the grant of a potentially broad-ranging right of property.\(^\text{204}\) Indeed, close examination of the key decisions in the area, particularly those expanding the scope of the right, give credence to Madow’s assertion that the expansion of the right of publicity has not been accompanied by an adequate ‘initial phase of questioning’\(^\text{205}\) by US courts. For example, the early case of

\(^{197}\) Madow, above n 4, 136. See also at 133–4, 142, 174; Dougherty, above n 15, 423. See also McCarthy, *The Rights of Publicity and Privacy*, above n 51, § 1.1, who describes the right of publicity as ‘the inherent right of every human being to control the commercial use of his or her identity’ (emphasis added).

\(^{198}\) McCarthy, *The Rights of Publicity and Privacy*, above n 51, §§ 1.1[B][2], 1.11[C], 2.1[B], cited in Madow, above n 4, 136.

\(^{199}\) *Haelan Laboratories*, 202 F 2d 866 (2nd Cir, 1953) (Frank J) (emphasis added).

\(^{200}\) Madow, above n 4, 173–4. See also Armstrong, above n 4.

\(^{201}\) See generally Madow, above n 4, 172–8; Armstrong, above n 4. An analogous circularity is evident in the Australian ‘character merchandising’ cases, which have expanded the traditional boundaries of common law passing off on the basis, inter alia, of a perceived public understanding of celebrity endorsement and licensing arrangements. For further discussion of the tendency of some Australian courts to enforce legal rights on the basis of public perception or ‘common knowledge’, see above n 39 and accompanying text. The artificiality of this approach was suggested by Pincus J in *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314, 323–5, who noted the ‘incongruity of basing this sort of suit on the issue of whether the public has been misled about licensing arrangements.’ See also McKeough and Stewart, above n 39, [16.29], [16.30], [18.16].

\(^{202}\) Madow, above n 4, 173, 173 fn 231.

\(^{203}\) Ibid 133–4.
which extended the right of publicity to the distinct ‘individualized’ features of the plaintiff’s race car even where the ‘likeness’ of the plaintiff was not recognisable, gives no consideration to the issue. The case merely accepts the commercial reality that identity can have a commercial value. Other key cases in the area suggest a ‘grab bag’ of rationales, including: the reward of labour and investment in the creation of valuable identities; providing an economic incentive to create valuable identities; and the prevention of unjust enrichment. For example, in the case of *Uhlaender v Henricksen*, Neville J relies on the labour justification, asserting that:

A celebrity must be considered to have invested his years of practice and competition in a public personality which eventually may reach marketable status. That identity, embodied in his name, likeness, statistics, and other personal characteristics, is the *fruit of his labors* and is a type of property.

In *Carson* — a case giving the famous ‘Tonight Show’ host a monopoly right in the phrase ‘Here’s Johnny’ and so preventing its use by the defendant portable toilet business — we see a mixture of moral and economic rationales being offered, almost as an afterthought:

Carson’s achievement has made him a celebrity … Vindication of the right will tend to encourage achievement in Carson’s chosen field. Vindication of the right will also tend to prevent unjust enrichment by persons such as [the] appellee who seek commercially to exploit the identity of celebrities without their consent.

The need to encourage creative innovation — that is, the economic incentive rationale raised in *Carson* and implicit in other judgments — recurs in the only US Supreme Court decision on the right of publicity, *Zacchini v Scripps-Howard Broadcasting Co*. This case concerned a right of publicity action brought by a person who performed a 15-second ‘human cannonball’ act at a county fair, which was subsequently broadcast in its entirety by a local television station. In recognising the right of publicity as a cause of action, the Supreme Court stated that the

---

206 498 F 2d 821 (9th Cir, 1974).
207 Ibid 822 (Koelsch J).
208 Ibid 825 (Koelsch J).
210 Pinckaers, above n 52, 30; Clay, above n 102, 491–2; Restatement (Third) of Unfair Competition § 46 cmt c (1995).
211 316 F Supp 1277, 1282 (Minn D Ct, 1970) (emphasis added).
212 698 F 2d 831 (6th Cir, 1983).
214 Ibid 837 (Bailey Brown J) (emphasis added).
215 433 US 562 (1977). But note that the case is considered to be of limited precedential value given its concern with performance and not advertising use. Advertising use is considered the most common form of right of publicity infringement: see McCarthy, ‘The Human Persona as Commercial Property’, above n 65, 21–2.
act is the product of petitioner’s own talents and energy, the end result of much
time, effort, and expense. ... [T]he protection provides an economic incentive
for him to make the investment required to produce a performance of interest to
the public. This same consideration underlies the patent and copyright laws
long enforced by this Court.217

Other rationales that have been asserted by commentators and/or courts
include: the potential protection of consumers against deception; preventing the
‘dilution’ of valuable identities through overuse; and arguments based on the
need to protect the ‘dignitary’ interests of plaintiffs, which assert that the right of
publicity is ‘an extension of human worth and autonomy’.218

C Economic Incentive Rationale and Lockean Labour Theory

As the above judgments illustrate, two rationales heavily relied upon in
support of the right of publicity are the economic incentive rationale and the
property claim grounded in Lockean labour theory.219 Lockean theory is one of
the predominant justifications for the institution of private property more
generally and has also played a primary role in the debates over the justifications
for intellectual property in both Australia and the US.220 Broadly, Lockean labour
or natural rights theory asserts that an individual is entitled to the fruits of their
labor.221 This is an essentially moral argument which accepts that a person who
expends effort and labour upon a resource that is unowned or ‘held in common’

218 Haemmerli, above n 57, 390. For a summary of arguments based on ‘personhood’, see Dawson,
Law Review 957.
219 Haemmerli, above n 57, 388; cf Kwall, ‘The Right of Publicity’, above n 84, 62, who describes
unjust enrichment as ‘one of the fundamental rationales’. Note that the further rationale of unjust
enrichment commonly appears in court decisions as support for the right of publicity. See, eg, Bi-Rite
Enterprises, Inc v Button Master, 555 F Supp 1188, 1198 (SDNY, 1983), where it was
stated that the right ‘prevents unjust enrichment by providing a remedy against exploitation of
the goodwill and reputation that a person develops in his name or likeness through the
investment of time, effort, and money’ (emphasis added). This rationale, largely based on a moral
claim, asserts that the right of publicity prevents ‘unfair’ conduct through preventing the
defendant from ‘reaping where s/he has not sown’: Madow, above n 4, 196. As this rationale is
often closely tied to the assertion that property rights are derived through the expenditure of
labour, criticisms of the Lockean labour rationale, discussed below, also tend to weaken the
argument based on unjust enrichment. As Haemmerli asserts: ‘[i]f unjust enrichment is intended
to prevent reaping where others have sown, and the celebrity has not sown … then prevention of
unjust enrichment is clearly a weak rationale for publicity rights’: Haemmerli, above n 57,
412 fn 117. The unjust enrichment rationale will not be given detailed consideration in this
discussion as it is not heavily relied upon by even those scholars who advocate the right of
publicity, due to its emphasis on ‘intuition rather than analysis’: Dougherty, above n 15, 440. In
addition, the circularity evident in arguments based on unjust enrichment has been noted
elsewhere: see Pinckaers, above n 52, 259–60. See also Michael Spence, ‘Passing Off and the
simply, if the ‘injustice’ of the defendant’s enrichment is the unauthorised use of another’s
property, then it is problematic to use this as the justification for the creation of a property right:
Quarterly Review 472, 491.
220 Davies and Naffine, above n 1, 134; Fisher, above n 134, 170–1. See generally Seana Shiffrin,
‘Lockean Arguments for Private Intellectual Property’ in Stephen Munzer (ed), New Essays in
221 Dawson, above n 57, 644.
has a natural property right to the outcome of his or her effort which the state is required to enforce.\(^\text{222}\) As applied to the right of publicity, the Lockean view asserts that ‘right-of-publicity plaintiffs’\(^\text{223}\) have carefully and judiciously developed their public image and expended much time and effort in attaining celebrity status, so that legal protection of this image is warranted.\(^\text{224}\)

Similarly, the economic incentive rationale is at the heart of copyright, patent and trade mark law policy, and so it too has featured heavily in the broader rationales for intellectual property.\(^\text{225}\) This rationale asserts that people require an inducement to expend the time, effort and resources required to produce a socially beneficial product and the institution of private property provides this incentive.\(^\text{226}\) Thus, in the right of publicity context, the monopoly protection offered by the right of publicity provides an economic incentive to expend the energy required to attain fame, as this is an enterprise which ultimately enriches society, just as providing an incentive to harvest farm land benefits society.\(^\text{227}\)

\[\text{D Lockean Labour Theory Deconstructed}\]

Yet, as some critics and even courts\(^\text{228}\) have begun to realise, these rationales, even if persuasive in the context of other key intellectual property regimes, are not persuasive when translated to the right of publicity. For example, in relation to Lockean labour theory, a number of difficulties have been highlighted. In addition to the more general challenges to Lockean theory,\(^\text{229}\) as Madow asserts, the notion that celebrities expend much effort and energy in achieving fame ignores the often unpredictable, serendipitous and fortuitous nature of contemporary fame.\(^\text{230}\)

As one critic states, ‘celebrities do not always work hard for their fame; sometimes they become well-known as a result of dumb luck, serendipitous involvement in public affairs, or even criminal conduct’.\(^\text{231}\) In addition, such a view undervalues the considerable efforts of others in the production of fame,
particularly in the American world of entertainment. Indeed, ‘[t]he work of “fashioning the star out of the raw material of the person” is done not only by the star herself, but by an army of specialists — consultants, mentors, coaches, advisors, agents, photographers, and publicists.’

Similarly, cultural anthropologists have recently catalogued the ways in which the public and the media play a crucial and constructive role in the production of ‘celebrities’ — that is, famous personae have meaning (and therefore commercial value) only because of the meanings that the public and media bestow upon the ‘raw material’ of identity. Such a view challenges the individualistic notion of identity underlying the traditional rationales for the right of publicity and posits a more ‘relational’ approach.

If such a view is accepted, an interesting question about public entitlement to the value of celebrity identity arises. Whilst some may reject such a view as entirely too ‘postmodern’, in a recent article arguing against the extension of the tort of passing off into a more general action for misappropriation, Spence notes that even ‘without tapping the complexities of post-modernist perspectives’ the notion of creation and an argument based on desert is underpinned by an enormous assumption about the processes of creation. Taking the ‘Mick Dundee’ character which was the subject of a successful claim in Hogan v Pacific Dunlop Ltd as an example, Michael Spence notes the difficulty of identifying the ‘creator’ of the product endorsement value of the character, given the fact that the character was successful because it built upon a long tradition of bushman stereotypes central to Australian culture and without this tradition the character would never have resonated with audiences.

E Economic Incentive Rationale Deconstructed

In addition, the economic incentive argument has been subjected to considerable scrutiny. Some critics argue that without the protection offered by the right of publicity, celebrities would be dissuaded from ‘pursuing a career in the limelight’. However, the considerable financial benefits that attach to

232 Madow, above n 4, 191.
233 Richard Dyer, Heavenly Bodies: Film Stars and Society (1987) 5 (citations omitted); ibid 191. See also at 138–47.
235 Madow, above n 4, 188, 194, 195.
236 Clay, above n 102, 502.
240 See, eg, Madow, above n 4, 205–29; Clay, above n 102, 505–6; Dawson, above n 57, 654–9, for a good overview of the economic debates and a defence of the right of publicity. For a discussion of the application of different economic theories to the protection of personality, see Frazer, above n 26, 305–7, who concludes that in some circumstances legal protection of personality is economically efficient: at 307, 309. Cf Ernest Weinrib, The Idea of Private Law (1995) 46–8, who challenges the assertion that the promotion of economic efficiency is the aim of law.
fame — one need only consider the earning capacity of stars like Michael Jordan and Tom Cruise — present a powerful incentive for ordinary individuals to achieve entertainment and sporting success without the need for the right of publicity to provide a ‘collateral’ source of income.\textsuperscript{242} Thus, ‘[a]bolition of the right of publicity would leave entirely unimpaired a celebrity’s ability to earn a living from the activities that have generated his commercially marketable fame.’\textsuperscript{243} In contrast to copyright law, which generally protects the primary source of a writer’s income through provision of a monopoly grant,\textsuperscript{244} the right of publicity merely protects a ‘by-product of [celebrity’s] performance values’ by preventing unauthorised advertising or merchandising use of celebrity image, with sports and entertainment celebrities generating significant income from their primary activities.\textsuperscript{245} In this way, the analogy to copyright and other forms of intellectual property has been acknowledged in one Court of Appeals decision as being ‘overstated’ and ‘strained’.\textsuperscript{246} As Tacha J writes in a case concerning the production of parody baseball cards:

The extra income generated by licensing one’s identity does not provide a necessary inducement to enter and achieve in the realm of sports and entertainment. Thus, while publicity rights may provide some incentive for creativity and achievement, the magnitude and importance of that incentive has been exaggerated. … [T]he inducements generated by publicity rights are not nearly as important as those created by copyright and patent law, and the small incentive effect of publicity rights is reduced or eliminated in the context of celebrity parodies.\textsuperscript{247}

Further, it has been argued that unlike copyright and patent rights, which are ultimately designed to serve the public so that the public comes to eventually control the products in question, the right of publicity ‘attempts to hold celebrity image from the public domain for as long as possible, yielding only to public influence with the utmost reluctance.’\textsuperscript{248} Thus, granting a property right in persona is ‘inconsistent with the \textit{quid pro quo} requirement of intellectual property law that the celebrity also contribute something of value to society.’\textsuperscript{249}

\textsuperscript{242} Madow, above n 4, 209–10 (emphasis in original). See also \textit{Cardtoons}, 95 F 3d 959, 973–4 (10th Cir, 1996) (Tacha J). It is noteworthy that Kwall, an advocate of the right of publicity, describes the incentive to innovate argument as ‘admittedly speculative’: Kwall, ‘The Right of Publicity’, above n 84, 85.

\textsuperscript{243} Madow, above n 4, 209.

\textsuperscript{244} But see an interesting discussion by Ernest Weinrib, above n 240, 468, who challenges the assertion that the promotion of economic efficiency is the aim of private law.

\textsuperscript{245} \textit{Cardtoons}, 95 F 3d 959, 973 (10th Cir, 1996) (Tacha J); Madow, above n 4, 209. Note the counterargument that a legal right ought not to be denied simply on the basis that a celebrity has no need for the financial benefits attaching to the right: Dawson, above n 57, 655–6. According to Dawn Dawson, ‘the law has never withheld a legitimate property right from the owner of that right because he already possesses an abundance of the benefits which accrue from that right’: at 655.

\textsuperscript{246} \textit{Cardtoons}, 95 F 3d 959, 973 (10th Cir, 1996) (Tacha J). See also Frazer, above n 26, who suggests that on the basis of a \textit{utilitarian} economic argument, the right of publicity is unnecessary. This is because societal wealth would be unaffected by the celebrity’s ability to recover a fee for use of his/her identity: at 302–3.

\textsuperscript{247} \textit{Cardtoons}, 95 F 3d 959, 974 (10th Cir 1996).

\textsuperscript{248} Clay, above n 102, 507.

\textsuperscript{249} Flagg, above n 52, 190.
Indeed, some critics have even gone so far as to suggest that the expansive nature of the current right of publicity, as seen in the denial of a parody defence in *White*, acts as a disincentive to artists, including satirists, cartoonists, comedians and advertisers, who rely financially on the exploitation of celebrity identity.250 In this way the right of publicity may in fact be socially detrimental.251 Thus, the *Restatement (Third) of Unfair Competition* is well-judged in noting that the rationales often asserted in favour of the right of publicity are ‘less compelling’ than those justifying other intellectual property rights such as trade marks.252

VII Conclusion

As comparative law scholars have written, comparative study is a ‘two-dimensional’ process which not only leads to a better understanding of the foreign legal system under review, but also deepens our understanding of the domestic legal scene.253 Thus, by reflecting upon a foreign legal system, ‘[c]omparative study leads to a querying of… those aspects of domestic law that otherwise would be taken for granted.’254

By immersing the researcher in foreign and unfamiliar legal territory there is the ‘potential for sharpening, deepening and expanding the lenses through which one perceives law’.255 Thus, this survey of the US right of publicity has revealed considerable conceptual difficulties with both the American and Australian approaches to the protection of identity. In adhering to the traditional model of passing off whilst also attempting to accommodate demands for greater protection of celebrity identity, Australian courts have strained and problematised the conceptual basis of this cause of action. The US, in adopting a proprietary model for the protection of identity, offers a fascinating example of the expansion of existing categories of intellectual property. However, this article has shown that a number of conceptual difficulties exist with the US formulation, and that the adoption of the ‘property’ label in the absence of considered analysis has significant implications for the practical application of the law. Similarly, protecting ‘identity’ without attempting a definition of this amorphous concept at common law creates uncertainty.

The US controversy over protection of ‘identity’ as a form of property is therefore instructive for Australian courts and legislatures in a number of ways. First, it illustrates the power that the ‘property’ label continues to command in legal and social discourse, and cautions against the adoption of such a label

250 Clay, above n 102, 506; see generally Madow, above n 4, 212, 216, suggesting the possibility that the right of publicity may even encourage a socially detrimental ‘overinvestment’ in celebrity production. See generally Dawson, above n 57, 655.
251 Dawson, above n 57, 655.
253 Vranken, above n 17, 4–8; see also Roger Blanpain, ‘Comparativism in Labour Law and Industrial Relations’ in Roger Blanpain and Christian Engels (eds), *Comparative Labour Law and Industrialized Market Economies* (7th ed, 2001) 3, 4–5.
254 Vranken, above n 17, 6.
without reasoned consideration of the consequences.\textsuperscript{256} Indeed, the US example has shown the malleable nature of the concept of property, as well as the doctrinal ‘muddles’ that result when existing legal categories (such as, in the US context, rights of privacy) are stretched beyond the ambit of their original rationales and purpose.

Second, the considerable academic debate that has taken place in the US in recent years can assist Australian courts and legislatures to think more broadly about the place of identity protection in the intellectual property regime, and to carefully consider the validity of commonly-cited rationales for its protection.\textsuperscript{257} Is a legal doctrine that accepts human identity as essentially a commodity warranted or desirable? Given the difficulty of rationalising publicity rights as proprietary in nature, is a more desirable approach to overtly treat publicity rights as purely personal, and thereby restrict remedies to only those necessary to address harm to the dignitary interests of claimants? This process of questioning and determining a supportable basis for the expansion of legal doctrine will potentially allow Australian courts and legislatures to learn from the ‘mistakes’\textsuperscript{258} of their US counterparts.

Most importantly, the US example does highlight a need for well-constructed limits on the scope of any action for the protection of identity, and the need to carefully balance the competing demands of celebrities with those who seek to utilise aspects of celebrity identity for the purposes of parody or other creative endeavours. Therefore, it may be that an openly debated sui generis legislative regime is better able to set these limits than the current ‘incremental’ approach of the common law.

\textsuperscript{256} Davies and Naffine, above n 1, 6.

\textsuperscript{257} For a good discussion of the ‘value of theory’ in assisting in the practical development of intellectual property law, see Fisher, above n 134, 194–9.

\textsuperscript{258} See Goodenough, ‘The Price of Fame’ (Pt 2), above n 108, 90, 95.