

PROPERTISING IDENTITY: UNDERSTANDING THE UNITED STATES RIGHT OF PUBLICITY AND ITS IMPLICATIONS — SOME LESSONS FOR AUSTRALIA

ROSINA ZAPPARONI*

[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.]

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* 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.

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I INTRODUCTION

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

¹ See generally Michael Henry (ed), *International Privacy, Publicity and Personality Laws* (2001). As Barbara Singer notes, the parameters of the concepts of ‘persona’ and ‘identity’ are difficult to define. For the purposes of this discussion, however, the terms ‘persona’ and ‘identity’ will be used interchangeably, and a broad definition of ‘persona’ adopted — that is, ‘persona’ will refer to ‘any unique aspect of the individual capable of appropriation by a third party’: Barbara Singer, ‘The Right of Publicity: Star Vehicle or Shooting Star?’ (1991) 10 *Cardozo Arts and Entertainment Law Journal* 1, 2 fn 8. Often the terms ‘persona’ and ‘personality’ are used interchangeably in the literature in this area. This article will adopt a broad definition of ‘personality’ as referring to ‘the physical, mental and social characteristics that publicly identify an individual or character’: Robert Howell, ‘The Common Law Appropriation of Personality Tort’ (1986) 2 *Intellectual Property Journal* 149, 151 fn 4.

² Andrew Terry, ‘The Unauthorised Use of Celebrity Photographs in Advertising’ (1991) 65 *Australian Law Journal* 587, 587. See also Sam Ricketson, ‘Character Merchandising in Australia: Its Benefits and Burdens’ (1990) 1 *Intellectual Property Journal* 191, 191. Benjamin Katekar provides the following examples of character merchandising: ‘Madonna T-shirts. Greg Norman endorsing Cobra golf clubs and Holden cars. Oscar the grouch plush dolls. T-shirts and calendars commemorating the beatification of Mary McKillop’: Benjamin Katekar, ‘Coping with Character Merchandising: Passing Off Unsurpassed’ (1996) 7 *Australian Intellectual Property Journal* 178, 178.

³ See, eg, discussion of the practice in Ricketson, ‘Character Merchandising’, above n 2, 192; Owen Morgan, ‘“Mmmmm Beeeer”: Character Merchandising in Australia and the *Duff Beer* Case’ in Mathew Alderson (ed), *Passing Off — Personality Rights and Trade Practices Law* (1997) 22, 23–4 which also delineates the distinction between ‘character’ and ‘personality’ merchandising: at 25 fn 35. See judicial acknowledgement of the practice in, for example, *Hogan v Pacific Dunlop Ltd* (1988) 12 IPR 225, 234–7 (Gummow J).

⁴ George Armstrong, Jr, ‘The Reification of Celebrity: Persona as Property’ (1991) 51 *Louisiana Law Review* 443, 444; Michael Madow, ‘Private Ownership of Public Image: Popular Culture and Publicity Rights’ (1993) 81 *California Law Review* 127, 147–67.

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.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’.⁷ This right recognises the commercial value attaching to identity as a form of assignable personal property.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’⁹ and that ‘the right [of publicity] is consistent with the fundamental rationales underlying intellectual property law.’¹⁰ Another author suggests that ‘[t]he position ... in the United States, is straightforward in relation to the common law right of publicity’,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,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.¹³ Indeed, when the ‘right of

of the key decisions, see Susan Crennan, ‘The Commercial Exploitation of Personality’ (1995) 8 *Australian Intellectual Property Law Bulletin* 129, 135–7.

⁶ See, eg, Owen Morgan, ‘“Mmmmm Beeeer”: Character Merchandising in Australia and the *Duff Beer Case*’ (Pt 2) (1997) 10 *Australian Intellectual Property Law Bulletin* 23, 23; Mathew Alderson, ‘Privacy and Publicity: Whose Life Is it Anyway?’ (1996) 9 *Australian Intellectual Property Law Bulletin* 110, 110–11; Scott Ralston, ‘Australian Celebrity Endorsements: The Need for an Australian Right of Publicity’ (2001) 20(4) *Communications Law Bulletin* 9; David Moen, ‘“Lifestyles of the Rich and Famous”: Personality Rights — A Canadian-American Perspective’ (1995) 6 *Australian Intellectual Property Law Journal* 30; William van Caenegem, ‘Different Approaches to the Protection of Celebrities against Unauthorised Use of Their Image in Advertising in Australia, the United States and the Federal Republic of Germany’ (1990) 12 *European Intellectual Property Review* 452; John McMullan, ‘Personality Rights in Australia’ (1997) 8 *Australian Intellectual Property Journal* 86, 92–5; Hilary May Black, ‘Corporations Law Goes into Bat for Bradman’ (2000) 4 *Telemedia* 97, 98–9.

⁷ See, eg, McMullan, above n 6, 95; Ralston, above n 6, 10–11; Moen, above n 6, 30, 59. Cf Deirdre Gruzauskas, ‘Performers’ Rights: The Right of Personality and the Possibility of a Proprietary Right’ (1995) 6 *Australian Intellectual Property Journal* 92, 115.

⁸ Susanne Bergmann, ‘Publicity Rights in the United States and Germany: A Comparative Analysis’ (1999) 19 *Loyola of Los Angeles Entertainment Law Journal* 479, 479.

⁹ Ralston, above n 6, 9 (emphasis added).

¹⁰ *Ibid* 11.

¹¹ McMullan, above n 6, 95.

¹² 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).

¹³ 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,

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

161 (emphasis omitted). See also Andrew McGee, Sarah Gale and Gary Scanlan, 'Character Merchandising: Aspects of Legal Protection' (2001) 21 *Legal Studies* 226, 240, 240 fn 89. Broadly, then, the right of publicity is based on misappropriation — that is a 'taking' of property belonging to the plaintiff. In contrast, the passing off action is founded upon misrepresentation and depends upon public deception and confusion: Howell, 'The Common Law Appropriation of Personality Tort', above n 1, 153–4. For further discussion of the conceptual consequences of such a model, see below n 41 and accompanying text.

¹⁴ Van Caenegem, 'Different Approaches', above n 6, 455.

¹⁵ F Jay Dougherty, 'Foreword: The Right of Publicity — Towards a Comparative and International Perspective' (1998) 18 *Loyola of Los Angeles Entertainment Law Journal* 421, 422–3.

¹⁶ See Otto Kahn-Freund, 'On Uses and Misuses of Comparative Law' (1974) 37 *Modern Law Review* 1, 1–6, 27.

¹⁷ Dougherty, above n 15, 422. See Martin Vranken, *Fundamentals of European Civil Law and Impact of the European Community* (1997) ch 1.

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 Douglases 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.

²⁰ McMullan, above n 6, 86; Cameron Harvey, ‘The Medium Is the Message’ (1996) 1 *Media & Arts Law Review* 182, 183.

²¹ See, eg, Law Reform Commission, *Unfair Publication: Defamation and Privacy*, Report No 11 (1979) 133–4. See generally Black, ‘Corporations Law Goes into Bat for Bradman’, above n 6.

²² For an excellent discussion of developments in Canada, see Eric Reiter, ‘Personality and Patrimony: Comparative Perspectives on the Right to One’s Image’ (2002) 76 *Tulane Law Review* 673. See also Robert Howell, ‘Personality Rights: A Canadian Perspective: Some Comparisons with Australia’ (1990) 1 *Intellectual Property Journal* 212; Louise Potvin, Robert Howell and Tom McMahon, ‘Canada’ in Michael Henry (ed), *International Privacy, Publicity and Personality Laws* (2001) 73, 73–92.

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 Purvis* [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,²⁴ copyright and design law, trade practices legislation,²⁵ and common law passing off.²⁶ Whilst some protection may be offered to celebrity identity through these regimes,²⁷ this protection is necessarily limited, being ‘incidental, in the sense that it is a by-product of the protection of some other subject-matter.’²⁸

However, recent developments in the area of trade practices law, and a considerable expansion of the tort of passing off,²⁹ 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.

²⁶ Robert Todd and Ian Smith, ‘Australia’ in Michael Henry (ed), *International Privacy, Publicity and Personality Laws* (2001) 19, 22, 33; Ralston, above n 6, 9. For a more detailed discussion of the extent to which such regimes protect aspects of a person’s identity, see Howell, ‘Personality Rights’, above n 22, 215–30; Katekar, above n 2, 178, 184–96; Ricketson, ‘Character Merchandising’, above n 2, 192–203; Jill McKeough, ‘Character Merchandising: Legal Protection in Today’s Marketplace’ (1984) 7 *University of New South Wales Law Journal* 97; Andrew Terry, ‘Proprietary Rights in Character Merchandising Marks’ (1990) 18 *Australian Business Law Review* 229; Tim Frazer, ‘Appropriation of Personality — A New Tort?’ (1983) 99 *Law Quarterly Review* 281. Other relevant causes of action include breach of confidence and defamation. See above n 19 for a discussion of recent developments in relation to breach of confidence. Although defamation law has been applied successfully in the context of false endorsement actions, it is limited by the difficulty of establishing that commercial misappropriation is defamatory in the relevant sense: Samuel Murumba, *Commercial Exploitation of Personality* (1986) 75–80; Jill McKeough, ‘Character Merchandising: Legal Protection in Today’s Marketplace’ (1984) 7 *University of New South Wales Law Journal* 97, 110; Howell, ‘Personality Rights’, above n 22, 230; the discussions in Todd and Smith, and Frazer, above.

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.³⁰ The tort of passing off was traditionally formulated to protect a trader’s ‘goodwill’ or ‘reputation’³¹ by preventing one trader from representing their goods or services as the goods or services of another.³² It has expanded considerably following relaxation of the ‘common field of activity’ doctrine in *Radio Corporation Pty Ltd v Henderson*.³³ In this expanded form,³⁴ the modern tort is said to protect ‘promotional goodwill’, that is, ‘the ability to *recommend* or *promote* ... goods and services — or merchandising rights’.³⁵ 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.³⁶ Thus, the action requires the plaintiff to establish a *misrepresentation* which creates a false belief in the minds of consumers that the

above n 25, 5. For a detailed discussion of the relationship between s 52 and passing off, see Judy Gardiner, “‘It’s None of Your Business!’: Section 52 and the Tort of Passing Off” (1996) 4 *Trade Practices Law Journal* 60.

³⁰ See, eg, *Radio Corporation Pty Ltd v Henderson* [1960] NSW 279; *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. Cf the more conservative approaches adopted in *Honey v Australian Airlines Ltd* (1989) 14 IPR 264 (Northrop J); aff’d (1990) 18 IPR 185 (Full Court of the Federal Court) and *Newton-John v Scholl-Plough (Australia) Ltd* (1986) 11 FCR 233. Other cases where ‘celebrities’ have sought to engage passing off include: *Wickham v Associated Pool Builders Pty Ltd* (1988) 12 IPR 567; *Shoshana Pty Ltd v 10th Cantanae Pty Ltd* (1987) 18 FCR 285 (Burchett J); (1987) 79 ALR 299 (Full Court of the Federal Court); *Hutchence v South Sea Bubble Co Pty Ltd* (1986) 6 IPR 473.

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].

³² See *Reddaway v Banham* [1896] AC 199, 204 (Halsbury LC); Larissa Hintz, ‘Is the Beer Really Better, Drunk by Your Idol? The *Duff Beer* Case’ (1997) 19 *Sydney Law Review* 114.

³³ [1960] NSW 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*.

Alexander Learmonth, ‘Eddie, Are You Okay? Product Endorsement and Passing Off’ [2002] *Intellectual Property Quarterly* 306, 306 (emphasis added).

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’³⁷ (such as, for example, approval or endorsement by the famous personality of the product being advertised).

Therefore, at least in an overt sense,³⁸ 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.³⁹ The need to establish a misrepresentation is said to limit the use of the tort of passing off where character merchandising is concerned.⁴⁰ 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.⁴¹

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 Ricketson, ‘Character Merchandising’, above n 2, 193–6; Mark Davison, Kate Johnston and Patricia Kennedy (eds), *Shanahan’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 *Moorgate 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 McKeough 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 McKeough 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; Ricketson, ‘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 Howell, ‘The Common Law Appropriation of Personality Tort’, above n 1, 154.

⁴¹ 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,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’ approach⁴³ has been criticised as ‘artificial’ and ‘straining’ the boundaries of passing off beyond rational limits.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.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.⁴⁶ For example, in *Pacific Dunlop Ltd v Hogan*,⁴⁷ by treating the Paul

centrally concerned with the *conduct* of the defendant; it is not a ‘taking *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: *Federal Commissioner of Taxation v Just Jeans Pty Ltd* (1987) 16 FCR 110, 121–4; Law Book Company, above n 31, [23].

⁴² See Howell, ‘Personality Rights’, above n 22, 221.

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.’

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 *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.

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

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.’

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.⁴⁸ 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 [however] it seems inevitable that the nettle will have to be grasped and these laws will have to be reformulated.⁴⁹

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 Circuit⁵⁰ and to have been fuelled by academic support.⁵¹ 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.⁵² Whilst civil law jurisdictions such as France and Germany, under

⁴⁸ See above n 38.

⁴⁹ Todd and Smith, above n 26, 38 (emphasis added).

⁵⁰ See *Haelan Laboratories, Inc v Topps Chewing Gum, Inc*, 202 F 2d 866 (2nd Cir, 1953); cert denied 346 US 816 (1953) (*‘Haelan Laboratories’*).

⁵¹ See especially Melville Nimmer, ‘The Right of Publicity’ (1954) 19 *Law and Contemporary Problems* 203. Nimmer is said to have played an instrumental role in the development of the right of publicity. See J Thomas McCarthy, *The Rights of Publicity and Privacy*, vol 1 (at March 1997) § 1.8, who writes that ‘[i]f Judge Frank was the architect of a “right of publicity”, then Professor Nimmer was the first builder.’

⁵² This is not to suggest that the US is the only nation to protect the commercial value attaching to identity. For example, Japan has recognised the right of publicity as distinct from privacy and, more recently, as a property right: Dougherty, above n 15, 438–9; Yoshimi Ohara, ‘Japan’ in Michael Henry (ed), *International Privacy, Publicity and Personality Laws* (2001) 269, 289–93. The law in Canada also appears to be moving toward a US-style approach, with acceptance in the common law of Ontario of a tort of ‘commercial appropriation of personality’. However, the law in this area is still in a developmental stage. See generally Mitchell Flagg, ‘Star Crazy:

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, 500, 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

[a]ny 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 *Stephano 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,⁵⁷ there is currently no federal right of publicity.⁵⁸ 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.⁵⁹ Key variations between the states relate most notably to the treatment of post-mortem rights and the duration of publicity rights,⁶⁰ as well as to the breadth of the statutory language adopted⁶¹ (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.’⁶² 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*.’⁶³ 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.’⁶⁴ 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.⁶⁵ It is for this reason

⁵⁷ For a discussion of this debate, see Dawn Dawson, ‘The Final Frontier: Right of Publicity in Fictional Characters’ (2001) 2 *University of Illinois Law Review* 635, 662–3. See also Jennifer Choi, ‘“No Room for Cheers”: Schizophrenic Application in the Realm of Right of Publicity Protection’ (2002) 9 *Villanova Sports and Entertainment Law Journal* 121, 148–50; Alice Haemmerli, ‘Whose Who? The Case for a Kantian Right of Publicity’ (1999) 49 *Duke Law Journal* 383, 477–87.

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.

⁶¹ See further discussion in *Restatement (Third) of Unfair Competition* § 46, reporters’ note cmts d, e (1995).

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.

⁶⁵ J Thomas McCarthy, ‘The Human Persona as Commercial Property: The Right of Publicity’ (1996) 7 *Australian Intellectual Property Journal* 20, 21.

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

⁶⁶ McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28.1.

⁶⁷ *Ibid.*

⁶⁸ *Restatement (Third) of Unfair Competition* § 46 cmt d (1995). Cf Alicia Hunt, ‘Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech’ (2001) 95 *Northwestern University Law Review* 1605, 1605. See the definition of the right of publicity provided by the court in *Estate of Presley v Russen*, 513 F Supp 1339, 1353 (NJ D Ct, 1981) for an emphasis on the common plaintiff being a ‘public figure or a celebrity’.

⁶⁹ See *Brewer v Hustler Magazine, Inc*, 749 F 2d (9th Cir, 1984); *Ali v Playgirl, Inc*, 447 F Supp 723 (SD NY, 1978); *Martin Luther King Jr Centre for Social Change, Inc v American Heritage Products, Inc*, 296 SE 2d 697 (Ga, 1982); *Restatement (Third) of Unfair Competition*, § 46 reporters’ note cmt d (1995).

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).

⁷⁵ *Restatement (Third) of Unfair Competition* § 46 reporters’ note cmt b (1995); McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28.14.

⁷⁶ Keller et al, above n 55, 479–80; Dawson, above n 57, 639. See, eg, *Waits v Frito-Lay, Inc*, 978 F 2d 1093, 1104–6 (9th Cir, 1992) (‘Waits’).

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.⁷⁸ As this case suggests, damages awards flowing from a breach of the right can be considerable.⁷⁹

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.⁸⁰ 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.⁸¹ 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 disseminated⁸² or incidental use takes place.⁸³ 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.⁸⁴ Indeed, it is widely acknowledged that the approach of US courts to the 'inherent tension'⁸⁵ between right of publicity and First Amendment interests has 'varied widely (and wildly)'⁸⁶ and that US courts currently 'lack a principled and consistent method of resolving the conflict'.⁸⁷

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'.

⁸¹ *Restatement (Third) of Unfair Competition* § 47 cmts a, c (1995).

⁸² *Restatement (Third) of Unfair Competition* § 47 cmt c (1995).

⁸³ Keller et al, above n 55, 482.

⁸⁴ Indeed, the complexities of the relationship are such that a full discussion is beyond the scope of this article. For more in-depth discussion, see Pinckaers, above n 52, 281–335; Stephen Barnett, 'The Right of Publicity versus Free Speech in Advertising: Some Counterpoints to Professor McCarthy' (1995) 18 *Hastings Communications and Entertainment Law Journal* 593; Stephen Barnett, 'At a Crossroads: The Right of Publicity in the United States' (1994) 160 *Revue Internationale du Droit D'Auteur* 5, 23–5, 49–51; Roberta Kwall, 'The Right of Publicity vs the First Amendment: A Property and Liability Rule Analysis' (1994) 70 *Indiana Law Journal* 47; Haemmerli, above n 57, 441–59.

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

G *Unresolved Issues and Remaining Uncertainty*

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

the issue compare the acceptance of parody in a commercial context in *Cardtoons LC v Major League Baseball Players Association*, 95 F 3d 959, 972 (10th Cir, 1996) (‘*Cardtoons*’) with the decision of the majority in *White v Samsung Electronics America, Inc*, 971 F 2d 1395 (9th Cir, 1992) (‘*White I*’), petition for rehearing denied 989 F 2d 1512 (9th Cir, 1993) (‘*White II*’); cert denied 508 US 951 (1993). The only US Supreme Court decision to consider the relationship between the right of publicity and the First Amendment is the case of *Zacchini v Scripps-Howard Broadcasting Co*, 433 US 562 (1977) (‘*Zacchini*’). This case is widely accepted to be of limited value in resolving the ‘tension’ referred to above due to the fact that it is a ‘narrowly drawn decision’ because of its emphasis on the right of publicity as protecting *performance* value rather than *identity*: McCarthy, *The Rights of Publicity and Privacy*, vol 2 (at March 1997) §§ 8.4[B][3], 8.4, 8.5; McCarthy, *Trademarks and Unfair Competition*, above n 55, §§ 28.40–28.41 and discussion of contradictory decisions therein; Haemmerli, above n 57, 401–3.

⁸⁸ See above n 84 and accompanying text. For a general discussion of the constitutional landscape, see Cass Sunstein, *Democracy and the Problem of Free Speech* (1993) xi–xx, 1–16, 121–65.

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.

⁹³ Kevin Fisher, ‘Which Path to Follow: A Comparative Perspective on the Right of Publicity’ (2000) 16 *Connecticut Journal of International Law* 95, 95.

⁹⁴ Choi, above n 57, 121.

⁹⁵ Sheldon Halpern, ‘The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality’ (1995) 46 *Hastings Law Journal* 853, 873.

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.¹⁰⁰ 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’.¹⁰¹ In addition, most, but not all, commentators now adopt this property formulation.¹⁰² 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.’¹⁰³ 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 1953.¹⁰⁴

Indeed, the development of the right has been correctly described as taking place in ‘a kind of analytical fog’.¹⁰⁵ Although early proponents of the right of

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; Kwall, ‘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 ‘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 *Zacchini*, 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,¹⁰⁶ 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.¹⁰⁷ In essence, it is widely accepted that the right of privacy in the US developed in the early 1900s¹⁰⁸ so as to protect private individuals from unwanted media publicity.¹⁰⁹ 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.¹¹⁰ 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.¹¹¹ Thus, a separate right of publicity was developed, largely in response to the needs of celebrity plaintiffs and the perceived limitations of privacy law.¹¹²

As a consequence, the right of publicity is, and continues to be, closely aligned with a branch of privacy law based on misappropriation.¹¹³ 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).¹¹⁴ This is because, historically, rights of privacy have

¹⁰⁶ See, eg, *Haelan Laboratories*, 202 F 2d 866, 868 (2nd Cir, 1953); Reiter, above n 22, 715; McCarthy, *The Rights of Publicity and Privacy*, above n 51, §§ 1.7, 1.8; Madow, above n 4, 173. See Madow for an excellent critical discussion of the *Haelan* decision: at 172–4. See also William Prosser, ‘Privacy’ (1960) 48 *California Law Review* 383, 406.

¹⁰⁷ See generally Terrell and Smith, above n 100.

¹⁰⁸ The development of the right of publicity and its origin in US privacy law has been exhaustively treated elsewhere in the literature. For more detailed accounts, see Oliver Goodenough, ‘The Price of Fame: The Development of the Right of Publicity in the United States’ (Pt 1) (1992) 3 *European Intellectual Property Review* 55 and Oliver Goodenough, ‘The Price of Fame: The Development of the Right of Publicity in the United States’ (Pt 2) (1992) 3 *European Intellectual Property Review* 90; McCarthy, *The Rights of Publicity and Privacy*, above n 51, §§ 1.1–1.6; Singer, above n 1, 6–20. Succinct overviews are provided by Clay, above n 102, 487–91; Choi, above n 57, 121, 132–4. For in-depth discussions of the commodification of identity, see Madow, above n 4; Armstrong, above n 4. For a general treatment of doctrinal confusion between the categories of privacy, publicity and property, see Kathleen Dangelo, ‘How Much of You Do You Really Own? A Property Right in Identity’ (1989) 37 *Cleveland State Law Review* 499.

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

¹¹⁰ Haemmerli, above n 57, 404–9. For a discussion of William Prosser’s widely accepted formulation of privacy law as comprising four torts/branches, see Reiter, above n 22, 706; Legal Information Institute, Cornell Law School, *Right of Publicity and Right of Privacy: An Overview* (1998) <<http://www.law.cornell.edu/topics/publicity.html>> 1. See also *Restatement (Second) of Torts* § 652C cmts a, b (1977); *Restatement (Third) of Unfair Competition* § 46 cmt b (1995).

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.¹¹⁵ 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.¹¹⁶ 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...¹¹⁷

Thus, a tension between these competing conceptual models of the right of publicity — as a subset of privacy on one view,¹¹⁸ 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.¹¹⁹ This issue has divided courts considering common law publicity actions,¹²⁰ and the current statutory treatment of descendibility remains *ad hoc*, with considerable inconsistency between state regimes.¹²¹ 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.¹²²

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, *The Rights of Publicity and Privacy*, above n 51, §§ 1.1–1.6, detailing the historical treatment of privacy as a personal right.

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.¹²³ 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.’¹²⁴ Whilst some may counter that the law is now free of such conceptual uncertainty,¹²⁵ one need only point to the confusion over the appropriate measure of damages in *Waits v Frito Lay, Inc*¹²⁶ — 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.¹²⁷ 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.¹²⁸ 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.¹²⁹ In addition, ‘semantic confusion’¹³⁰ 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.

¹²³ McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28.45.

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.

¹²⁸ *Restatement (Third) of Unfair Competition* § 46 cmt d (1995) (emphasis added).

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.

¹³⁰ McCarthy, *The Rights of Publicity and Privacy*, above n 51, § 1.1[B][1]; see McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28. 6.

to protect dignitary interests — characteristics related more to the underlying rationales of privacy law than the law of property.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.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.¹³³

Although the right of publicity is largely accepted as an emerging area of intellectual property law,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.¹³⁵ Broadly, infringement requires use by the defendant, without permission, of an aspect of the identity or persona¹³⁶ 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.¹³⁷ As the key test of infringement is ‘identifiability’,¹³⁸ deception or false endorsement (that is, a misrepresentation) is not required to establish infringement.¹³⁹ For example, where the alleged appropriation consists of the use of a name by the defendant,

¹³¹ See, eg, Haemmerli, above n 57. See also Kwall, ‘The Right of Publicity’, above n 84, 54–6; Kwall, ‘Fame’, above n 52.

¹³² Davies and Naffine, above n 1, 39; Flagg, above n 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.

¹³³ Terrell and Smith, above n 100, 1–2.

¹³⁴ See, eg, its treatment as such in William Fisher, ‘Theories of Intellectual Property’ in Stephen Munzer (ed), *New Essays in the Legal and Political Theory of Property* (2001) 168, 168; McCarthy, *Trademarks and Unfair Competition*, above n 55, § 28.1.

¹³⁵ Reiter, above n 22, 708.

¹³⁶ Note that some statutes confine the right of publicity to specifically defined features of identity: McCarthy, *The Rights of Publicity and Privacy*, above n 51, §§ 3.1[B], 6.3[A]. See, eg, § 3344(a) of the CAL CIVIL CODE (West 1997 & Supp 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 *White I*, 971 F 2d 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 *Wendt v Host International, Inc*, 125 F 3d 806, 811 (9th Cir, 1997) (*‘Wendt I’*). In California, the right of publicity is a common law and statutory right: *Gionfriddo v Major League Baseball*, 114 Cal Rptr 2d 307, 408 (Ct App 1st D, 2001).

¹³⁷ McCarthy, *The Rights of Publicity and Privacy*, above n 51, § 3.1[B].

¹³⁸ *Ibid* [3.2]; McCarthy, ‘The Human Persona as Commercial Property’, above n 65, 23.

¹³⁹ McCarthy, ‘The Human Persona as Commercial Property’, above n 65, 23; Ralston, above n 6, 10.

the name must be recognised by the audience as referring to the plaintiff.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.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.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.¹⁴³ Consequently, infringement has been established on the basis of 'lookalikes',¹⁴⁴ 'sound alikes' (adoption of the unique singing style of a famous performer in an advertising campaign),¹⁴⁵ the use of distinctive objects such as an image of the plaintiff's sports car,¹⁴⁶ and nicknames and commonly used slogans such as 'Here's Johnny'.¹⁴⁷

In particular, the decisions in *White v Samsung Electronics America, Inc.*,¹⁴⁸ and *Wendt v Host International, Inc.*,¹⁴⁹ have been criticised both judicially¹⁵⁰ and by commentators as exemplifying an unwarranted expansion of the 'purview of publicity protection'.¹⁵¹ Both cases involved the use by the defendants of robots bearing a remote likeness to the plaintiffs.¹⁵² In *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

¹⁴⁰ *Restatement (Third) of Unfair Competition* § 46 cmt d (1995).

¹⁴¹ *Restatement (Third) of Unfair Competition* § 46 cmt d (1995).

¹⁴² Flagg, above n 52, 180.

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

¹⁴⁴ *Onassis v Christian Dior — New York, Inc.*, 472 NYS 2d 254 (1984), aff'd 488 NYS 2d 943 (Ct App, 1985); Keller et al, above n 55, 478.

¹⁴⁵ *Waits*, 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.

¹⁴⁶ *Motschenbacher v R J Reynolds Tobacco Co.*, 498 F 2d 821 (9th Cir, 1974) ('*Motschenbacher*'); Keller et al, above n 55, 478.

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.

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, *White I*, and to the subsequent petition for rehearing (containing the Kozinski J dissent), *White II*.

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 811 (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 *Wendt I*. *Wendt II* contains the Kozinski J dissent.

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

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.

¹⁵² Keller et al, above n 55, 478; Dawson, above n 57, 639–40.

common law¹⁵³ when it produced a parodic television advertisement featuring a female-shaped robot clad in jewellery, a long gown and a blonde wig.¹⁵⁴ The robot was depicted turning letters on what appeared to be a ‘Wheel of Fortune’ game show set.¹⁵⁵ The advertisement was for Samsung videocassette recorders and featured the caption, ‘[L]ongest running game show. 2012 AD’.¹⁵⁶ 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.¹⁵⁷

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 publicity¹⁵⁸ in these fictional characters when the defendant created animatronic robots allegedly based on the actors’ likenesses.¹⁵⁹ 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.¹⁶⁰ At first instance, the District Court found in favour of Host, the creator of the animatronic robots.¹⁶¹ 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’.¹⁶² The District Court held that it could not ‘find, by viewing both the robotics 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’.¹⁶³

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,¹⁶⁴ 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’.¹⁶⁵ 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.¹⁶⁶ 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.¹⁶⁷ 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.¹⁶⁸ This aspect of the Court of Appeals decision has been the subject of particular criticism.¹⁶⁹

Similarly, the decision in *White*¹⁷⁰ 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.¹⁷¹ For example, the court, after making reference to the earlier expansive cases of *Motschenbacher v R J Reynolds Tobacco Co*,¹⁷² *Midler v Ford Motor Co*¹⁷³ and *Carson v Here’s Johnny Portable Toilets Inc*,¹⁷⁴ 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.¹⁷⁵

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,

¹⁶⁴ See *Wendt I*, 125 F 3d 806 (9th Cir, 1997), and the decision in *Wendt II*, 197 F 3d 1284 (9th Cir, 1999) where the majority (Kozinski J was joined in dissent by Kleinfeld and Tashima JJ) essentially agreed with the decision in *Wendt I*, thereby denying a petition for rehearing and rejecting a petition for rehearing.

¹⁶⁵ *Wendt I*, 125 F 3d 806, 810 (9th Cir, 1997) (Fletcher J).

¹⁶⁶ *Wendt II*, 197 F 3d 1284, 1285 (9th Cir, 1999) (Kozinski J, in dissent).

¹⁶⁷ *Wendt I*, 125 F 3d 806, 811 (9th Cir, 1997) (Fletcher J).

¹⁶⁸ See *ibid*. This aspect of the judgment, particularly, was the subject of a strong critique by Kozinski J in his dissenting judgment in *Wendt II*. Kozinski J states:

Copyright or no copyright, anyone who wants to use a figure, statue, robot, drawing or poster that reminds the public of Wendt and Ratzenberger must first obtain (and pay for) their consent. This cannot be squared with the right of the copyright holder to recreate Norm and Cliff however it sees fit. ... It’s inevitable that so broad and ill-defined a property right will trench on the rights of the copyright holder.

Wendt II, 197 F 3d 1284, 1286 (9th Cir, 1999) (Kozinski J, in dissent).

¹⁶⁹ See *Wendt II*, 197 F 3d 1284, 1285–9 (9th Cir, 1999) (Kozinski J, in dissent).

¹⁷⁰ *White I*, 971 F 2d 1395 (9th Cir, 1992); *White II*, 989 F 2d 1512 (9th Cir, 1993).

¹⁷¹ Flag, above n 52, 203–4.

¹⁷² 498 F 2d 821 (9th Cir, 1974).

¹⁷³ 849 F 2d 460 (9th Cir, 1988).

¹⁷⁴ 698 F 2d 831 (6th Cir, 1983).

¹⁷⁵ *White I*, 971 F 2d 1395, 1398 (9th Cir, 1992) (Goodwin J) (emphasis added).

but *whether* the defendant has done so.¹⁷⁶ Thus, the majority appeared to adopt an extremely expansive ‘appropriation of identity’ test, whilst failing to delineate the precise parameters of this test.¹⁷⁷

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.¹⁷⁸ 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:¹⁷⁹

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.¹⁸⁰

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.¹⁸¹ Alarcon J argued that elements including ‘attractive appearance, a graceful pose, blond hair, an evening gown, and jewellery’¹⁸² are characteristics that White shares in common with many others and so these characteristics ‘are not unique attributes of Vanna White’s identity.’¹⁸³ He therefore went on to reject the majority finding on the common law right of publicity claim.¹⁸⁴ 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.¹⁸⁵ 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.’¹⁸⁶

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,

¹⁷⁶ *Ibid* (emphasis in original).

¹⁷⁷ Dawson, above n 57, 641; Flagg, above n 52, 181–2, 203.

¹⁷⁸ See *White II*, 989 F 2d 1512, 1514 (9th Cir, 1993) (Kozinski J, in dissent); Flagg, above n 52, 203–4; Dawson, above n 57, 641; Linda Stack, ‘*White v Samsung Electronics America, Inc*’s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech’ (1995) 89 *Northwestern University Law Review* 1189, 1202.

¹⁷⁹ *White II*, 989 F 2d 1512, 1513 (9th Cir, 1993) (Kozinski J, in dissent).

¹⁸⁰ *Ibid* 1514 (second emphasis added).

¹⁸¹ *White I*, 971 F 2d 1395, 1404 (9th Cir, 1992).

¹⁸² *Ibid* 1404, 1405.

¹⁸³ *Ibid* 1405.

¹⁸⁴ *Ibid*.

¹⁸⁵ Flagg, above n 52, 180–1, 203.

¹⁸⁶ *Ibid* 203–4.

not surprisingly, these decisions have been criticised by many as exemplifying an unwarranted excursion into the public domain.¹⁸⁷ For example, Kozinski J is particularly vocal in his dissenting judgments in both of these cases.¹⁸⁸ 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.¹⁸⁹ 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.¹⁹⁰

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?¹⁹¹

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.

¹⁸⁷ 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, 'Author/izing 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.

¹⁸⁸ See *White II*, 989 F 2d 1512 (9th Cir, 1993); *Wendt II*, 197 F 3d 1284, 1287 (Kozinski J, in dissent), 1285 (Kleinfeld and Tashima JJ agreeing).

¹⁸⁹ 989 F 2d 1512, 1514–22 (9th Cir, 1993).

¹⁹⁰ *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.

¹⁹¹ *White II*, 989 F 2d 1512, 1517 (9th Cir, 1993) (emphasis in original).

VI SITUATING THE RIGHT OF PUBLICITY WITHIN THE
INTELLECTUAL PROPERTY REGIME — A ‘CONCEPT IN SEARCH OF A
PRINCIPLE’¹⁹²

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.¹⁹³ 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.¹⁹⁴

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.¹⁹⁵ 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’.¹⁹⁶

¹⁹² This phrase alludes to the concept of a ‘fiduciary’ in the law of equity which, like the right of publicity, has been the subject of expansion and uncertainty. Thus, Sir Anthony Mason has described the concept as ‘in search of a principle’: Sir Anthony Mason, ‘Themes and Prospects’ in Paul Finn (ed), *Essays in Equity* (1985) 246. See also Rosemary Teele, ‘The Search for the Fiduciary Principle: A Rescue Operation’ (1996) 24 *Australian Business Law Review* 110, 110–11.

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, ‘The Human Persona as Commercial Property’, above n 65, 22–3; 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 above n 103 and accompanying text regarding acceptance of the property formulation in recent judgments.

¹⁹⁴ See generally Fisher, above n 134, 194–9.

¹⁹⁵ Katekar, above n 2, 179. See also Hazel Carty, ‘Character Merchandising and the Limits of Passing Off’ (1993) 13 *Legal Studies* 289, 303–4.

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'¹⁹⁷ that is 'self-evident' and based on 'common sense'.¹⁹⁸ For example, the judgment of Frank J in *Haelan Laboratories*,¹⁹⁹ the decision responsible for the 'creation' of the right, gives little attention to the issue of whether expansion of the law is justified.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.²⁰¹

As this suggests, legal protection is bestowed on the basis of perceived public expectation and in response to pre-existing commercial practices.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.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.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'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.

¹⁹⁹ 202 F 2d 866 (2nd Cir, 1953).

²⁰⁰ See Madow, above n 4, 173–4. See also Armstrong, above n 4.

²⁰¹ *Haelan Laboratories*, 202 F 2d 866, 868 (2nd Cir, 1953) (Frank J) (emphasis added).

²⁰² Madow, above n 4, 174; see also Armstrong, above n 4, 464.

²⁰³ 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].

²⁰⁴ Madow, above n 4, 173, 173 fn 231.

²⁰⁵ *Ibid* 133–4.

Motschenbacher,²⁰⁶ 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,²⁰⁷ gives no consideration to the issue. The case merely accepts the commercial reality that identity can have a commercial value.²⁰⁸ Other key cases in the area suggest a ‘grab bag’²⁰⁹ 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.²¹⁰ 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.²¹¹

In *Carson*²¹² — 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 business²¹³ — 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.²¹⁴

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.*²¹⁵ 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.²¹⁶ 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).

²⁰⁹ Goodenough, ‘The Price of Fame’ (Pt 1), above n 108, 59.

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).

²¹³ *Ibid* 832–3 (Bailey Brown J).

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.

²¹⁶ *Zacchini*, 433 US 562, 563–4 (1977) (White J).

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 labour.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'

²¹⁷ *Zacchini*, 433 US 562, 575–6 (1977) (emphasis added).

²¹⁸ Haemmerli, above n 57, 390. For a summary of arguments based on 'personhood', see Dawson, above n 57, 645–6. See generally Margaret Radin, 'Property and Personhood' (1982) 34 *Stanford 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 Misappropriation of Valuable Intangibles' (1996) 112 *Law Quarterly Review* 472, 489–91. Put 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: Michael Spence, 'Passing Off and the Misappropriation of Valuable Intangibles' (1996) 112 *Law 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 the Legal and Political Theory of Property* (2001) 138.

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.²²² As applied to the right of publicity, the Lockean view asserts that ‘right-of-publicity plaintiffs’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.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.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.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.²²⁷

D *Lockean Labour Theory Deconstructed*

Yet, as some critics and even courts²²⁸ 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,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.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’.²³¹ In addition, such a view undervalues the considerable efforts of others in the production of fame,

²²² Fisher, above n 134, 170.

²²³ The term ‘right-of-publicity plaintiff’ is adopted from Kwall, ‘The Right of Publicity’, above n 84, 69, 48 fn 10. As noted by Kwall, where the owner of the persona is deceased, the plaintiff maintaining the action will actually be the relative(s) or assignee(s) of the deceased personality: at 48 fn 10.

²²⁴ Clay, above n 102, 491–2, 497–8; Madow, above n 4, 182.

²²⁵ Fisher, above n 134, 170; Dougherty, above n 15, 443.

²²⁶ Madow, above n 4, 205; Clay, above n 102, 491–2; Pinckaers, above n 52, 245.

²²⁷ Madow, above n 4, 205; Clay, above n 102, 491–2; Pinckaers, above n 52, 245. See also the discussion of the related economic argument that the right encourages the efficient use of resources in Pinckaers, above n 52, 245–8.

²²⁸ *Cardtoons*, 95 F 3d 959 (10th Cir, 1996). See also the discussion of recent cases in Fisher, above n 134, 195–6.

²²⁹ See the discussion of Robert Nozick’s critique in Madow, above n 4, 175 fn 239. Nozick asks: ‘why isn’t mixing what I own with what I don’t own a way of losing what I own rather than a way of gaining what I don’t. If I own a can of tomato juice and spill it into the sea ... do I thereby come to own the sea, or have I foolishly dissipated my tomato juice?’: Robert Nozick, *Anarchy, State, and Utopia* (1974) 174–5.

²³⁰ Clay, above n 102, 502; Madow, above n 4, 160–6, 179–80, 182–5.

²³¹ Fred Weiler, ‘The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity’ (1994) 13 *Cardozo Arts and Entertainment Law Journal* 233, 241.

particularly in the American world of entertainment.²³² 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.”²³³

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.²³⁴ Such a view challenges the individualistic notion of identity underlying the traditional rationales for the right of publicity and posits a more ‘relational’ approach.²³⁵

If such a view is accepted, an interesting question about public entitlement to the value of celebrity identity arises.²³⁶ 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.²³⁷ Taking the ‘Mick Dundee’ character which was the subject of a successful claim in *Hogan v Pacific Dunlop Ltd*²³⁸ 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.²³⁹

E Economic Incentive Rationale Deconstructed

In addition, the economic incentive argument has been subjected to considerable scrutiny.²⁴⁰ Some critics argue that without the protection offered by the right of publicity, celebrities would be dissuaded from ‘pursuing a career in the limelight’.²⁴¹ 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.

²³⁴ Dyer, above n 233, 5; Madow, above n 4, 138–47, 191. See generally Coombe, above n 187; David Lange, ‘Recognizing the Public Domain’ (1981) 44(4) *Law and Contemporary Problems* 147.

²³⁵ Madow, above n 4, 188, 194, 195.

²³⁶ Clay, above n 102, 502.

²³⁷ Michael Spence, ‘Passing Off and the Misappropriation of Valuable Intangibles’ (1996) 112 *Law Quarterly Review* 472, 479.

²³⁸ (1988) 12 *IPR* 225.

²³⁹ Spence, ‘Passing Off’, above n 237, 479–80.

²⁴⁰ See, eg, Madow, above n 4, 205–28; 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.

²⁴¹ Kwall, ‘The Right of Publicity’, above n 84, 79.

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.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.’²⁴³ In contrast to copyright law, which generally protects the primary source of a writer’s income through provision of a monopoly grant,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.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’.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.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.’²⁴⁸ Thus, granting a property right in persona is ‘inconsistent with the *quid pro quo* requirement of intellectual property law that the celebrity also contribute something of value to society.’²⁴⁹

²⁴² Madow, above n 4, 209–10 (emphasis in original). See also *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.

²⁴³ Madow, above n 4, 209.

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.

²⁴⁵ *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.

²⁴⁶ *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 *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.

²⁴⁷ *Cardtoons*, 95 F 3d 959, 974 (10th Cir 1996).

²⁴⁸ Clay, above n 102, 507.

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.

²⁵² *Restatement (Third) of Unfair Competition* § 46 cmt c (1995).

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.

²⁵⁵ Vivian Curran, ‘Dealing in Difference: Comparative Law’s Potential for Broadening Legal Perspectives’ (1998) 46 *American Journal of Comparative Law* 657, 658.

without reasoned consideration of the consequences.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.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’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.

²⁵⁶ Davies and Naffine, above n 1, 6.

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.

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